

# **THOUGHTS ON INTELLECTUAL PROPERTY RIGHTS**

**By CA (Dr.) Adukia Rajkumar Satyanarayan**

Mobile: 9820061049

Email: rajkumar@cadrrajkumaradukia.com

## **INTRODUCTION**

Intellectual property Right (IPR) is a term used for various legal entitlements which attach to certain types of information, ideas, or other intangibles in their expressed form. The holder of this legal entitlement is generally entitled to exercise various exclusive rights in relation to the subject matter of the Intellectual Property. The term intellectual property reflects the idea that this subject matter is the product of the mind or the intellect, and that Intellectual Property rights may be protected at law in the same way as any other form of property. Intellectual property laws vary from jurisdiction to jurisdiction, such that the acquisition, registration or enforcement of IP rights must be pursued or obtained separately in each territory of interest.

Intellectual property rights (IPR) can be defined as the rights given to people over the creation of their minds, and usually gives the creator an exclusive right over the use of his/her creations for a certain period of time. Intellectual Property Rights provide means by which an owner or an innovator can protect his innovation etc. from being imitated and safeguard the fruits of his valuable labor and investment. IPRs is a collective term that includes the following independent IP rights which can be collectively used for protecting different aspects of an inventive work: Patents, Trade Marks, Geographical Indication of Goods, Industrial Designs, Copyrights, Integrated Circuit layout design, Plant Variety and Farmers Rights, Biological Diversity, Undisclosed Information etc.

## **IP Trends in India**

IP applications in 2023-2024:

- Patent- 92168

- Design- 30388
- Trade mark- 476274
- Geographical Indication- 134
- Copyrights- 36744
- Semiconductor Integrated Layout Designs (SCILD) (2022-2023) - 23

As per the Press Information Bureau's Press Release on 16.3.2024:

Patents - Every 6 minutes one technology is seeking IP protection in India. In 2023, an all-time high of 90,300 patent applications were received. Patent office granted over one lakh patents in the last one year (March 15, 2023 to March 14, 2024). Every working day, 250 patents were granted.

Geographical Indications - There has been a notable surge in Geographical Indication (GI) registrations, demonstrating a threefold increase compared to the previous year. As on 16<sup>th</sup> March 2024, a total of 573 GIs are registered in India.

Copyright - The fiscal year 2023-24 witnessed a record-breaking number of copyright registrations, totaling 36,378, thus underscoring the vast potential within the creative sector.

Design - During the fiscal year 2023-24, the highest number of design registrations to date, totaling 27,819, were recorded, alongside final disposal of 30,450 applications.

## **INTELLECTUAL PROPERTY TREATIES & ORGANIZATIONS**

Intellectual property (IP) is governed by both national and international laws. International IP law protects IP across borders through treaties, agreements, and organizations.

The World Intellectual Property Organization (WIPO) is one of the 15 specialized agencies of the United Nations (UN). Headquartered in Geneva, WIPO helps in collaborating with its member states for the formation of laws, registration of intellectual properties and protection of intellectual properties. In 1978, WIPO's PCT international patent system began operation and expanded rapidly

to become WIPO's largest international IP filing system today. The Patent Cooperation Treaty (PCT) assists applicants in seeking patent protection internationally for their inventions, helps patent offices with their patent granting decisions, and facilitates public access to a wealth of technical information relating to those inventions. By filing one international patent application under the PCT, applicants can simultaneously seek protection for an invention in a large number of countries. WIPO administers 26 treaties including the WIPO Convention.

The World Trade Organization (WTO) is the legal and institutional foundation for the administration and development of trade relations among its members at the multilateral level. The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is the most comprehensive multilateral agreement on intellectual property (IP), which is administered by the WTO that sets down minimum standards for many forms of intellectual property (IP) regulation as applied to nationals of other WTO Members. The TRIPS agreement introduced intellectual property law into the international trading system for the first time and remains the most comprehensive international agreement on intellectual property to date.

Some important Intellectual Property Treaties are:

1. The Paris Convention for the Protection of Industrial Property, signed in Paris, France, on March 20, 1883, was one of the first intellectual property treaties. It established a Union for the protection of industrial property. India is a member of the Convention.
2. The Berne Convention for the Protection of Literary and Artistic Works, usually known as the Berne Convention, is an international agreement governing copyright, which was first adopted in Bern, Switzerland in 1886. India is a member of this Convention.
3. The Madrid Protocol is the primary international system for facilitating the registration of trademarks in multiple jurisdictions around the world. It was established pursuant to the Protocol Relating to the Madrid Agreement and the Madrid Agreement Concerning the International Registration of Marks. India has acceded to the Madrid Protocol, which is a simple, facilitative and cost effective system for international registration of trademarks.
4. Universal Copyright Convention 1952. It was adopted in Geneva, Switzerland, in 1952. It created a legal structure which could accommodate the United States, the USSR, the

industrially developed countries and the developing countries. It was revised in 1971. India signed this convention on 6th September, 1952.

5. Convention Establishing the World Intellectual Property Organization (WIPO Convention), was signed at Stockholm on July 14, 1967, entered into force in 1970 and was amended in 1979. WIPO is an intergovernmental organization which in 1974 became one of the specialized agencies of the United Nations system.
6. World Trade Organization (WTO) agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) was adopted on April 15, 1994 at Marrakesh and entered into force on January 1, 1995. The TRIPS agreement covers various types of intellectual property and provides guidelines for minimum standards for protection, procedures and remedies for enforcement of IPR rights and for issues related to dispute settlement. India became a member on January 1, 1995.
7. The Patent Cooperation Treaty (PCT) is an international treaty administered by the World Intellectual Property Organization (WIPO). The treaty was done at Washington on June 19, 1970. India acceded to the treaty and came into force in India from December 7, 1998.
8. World Intellectual Property Organization Copyright Treaty (1996 December 20) is a special agreement under the Berne Convention which deals with the protection of works and the rights of their authors in the digital environment. In addition to the rights recognized by the Berne Convention, they are granted certain economic rights.
9. World Intellectual Property Organization Performances and Phonograms Treaty (1996 December 20) deals with the rights of two kinds of beneficiaries, particularly in the digital environment: (i) performers (actors, singers, musicians, etc.); and (ii) producers of phonograms (persons or legal entities that take the initiative and have the responsibility for the fixation of sounds).
10. Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure was adopted in 1977. All states party to the Treaty are obliged to recognize microorganisms deposited as a part of the patent procedure, irrespective of where the depository authority is located. India is a party to this treaty.

## **CONSTITUTIONAL PROVISIONS**

The Seventh Schedule to the Constitution of India specifies the allocation of powers and functions between the Union and the State legislatures. It embodies three lists; namely, List I-the Union List, List II-the State List, and List III-the Concurrent List. Entry 49 of List I of Seventh Schedule of the Indian Constitution provides for Patents, inventions and designs; copyright; trade-marks and merchandise marks. Thus, it gives power to the Parliament to enact law relating to Intellectual property rights. However, it does not specifically mention the intellectual property related to traditional knowledge, biodiversity, geographical indications.

Since Article 248 confers exclusive power to parliament to make law on any matter not listed in State List (List-II) and Concurrent List (List III), and traditional knowledge, biodiversity, geographical indications are not mentioned in either of these Lists, hence it can be assumed that such IPRs would also be included in Entry 49 of List I as IPRs, and Parliament can make laws related to them. Also, Article 253 of the Constitution of India deals with the law to give effect to international agreements. It states that Parliament has the power to make laws for the whole or any part of the country for carrying into effect the agreements with one or more countries. Also, it has the power to decide in respect of such matters at any international conference or on other occasions. Thus, the Parliament has power to implement international conventions, agreement and treaties relating to Intellectual property rights.

## **ADMINISTRATIVE FRAMEWORK FOR IPRs IN INDIA**

India has a well-established legislative, administrative and judicial framework to safeguard Intellectual Property Rights (IPRs), which meets its international obligations. Being a member of World Intellectual Property Organization (WIPO), India complies with the WIPO treaties on intellectual property to which it's a signatory. The Department for Promotion of Industry and Internal Trade under the Ministry of Commerce & Industry is the nodal Department in the Government of India for all matters concerning WIPO.

India is also a member of the World Trade Organization (WTO), and thereby also complies with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). India's has

amended/enacted IP laws and its IPR regime is compliant with the obligations contained in the TRIPS Agreement.

The Department for Promotion of Industry and Internal Trade under the Ministry of Commerce and Industry is the nodal department and handles matters related to Protection of Intellectual Property Rights (IPR) and administers acts related to IPRs - <https://dpiit.gov.in/>

Other Administrative Bodies in-charge of IP administration are:

- The Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM), a subordinate Office under the Department for Promotion of Industry and Internal Trade, carries out statutory functions related to Patents, Trade Marks, Designs, Copyrights, Geographical Indications and Semiconductor Integrated Circuits Layout Designs. - <https://ipindia.gov.in/>
- Copyright Office, under The Department for Promotion of Industry and Internal Trade, Ministry of Commerce and Industry - <https://copyright.gov.in/>
- The Semiconductor Integrated Circuits Layout-Design Registry, under the Ministry of Commerce and Industry - <https://sicldr.gov.in/>
- The National Biodiversity Authority (NBA), under the Ministry of Environment, Forests and Climate Change - <http://nbaindia.org/>
- Protection of Plant Varieties and Farmers' Rights Authority, under the Ministry of Agriculture and Farmers' Welfare - <https://plantauthority.gov.in/>
- Competition Commission of India, under the Ministry of Corporate Affairs - <https://www.cci.gov.in/>

## **LAWS GOVERNING IPRs IN INDIA**

India's legal framework of Intellectual Property (IP) laws caters to the various areas of IP viz. Trademarks, Copyrights, Patents etc. Furthermore, if there are any amendments to the IP Treaties to which India is a signatory, then accordingly the IP laws in India are amended to give effect to the amendments brought forth by those Treaties.

## Legislations

The Laws governing Intellectual Property Rights in India are as follows:

1. Copyright- The Copyright Act, 1957 and The Copyright Rules, 2013
2. Patent-The Patents Act, 1970 and The Patents Rules, 2003
3. Trademarks- The Trade Marks Act, 1999 and The Trade Marks Rules, 2017
4. Geographical Indications-The Geographical Indications of Goods (Registration and Protection) Act, 1999 and The Geographical Indications of Goods (Registration and Protection) Rules, 2002 & other rules under the Act
5. Designs- The Designs Act, 2000 and The Designs Rules, 2001
6. Layout Designs- The Semiconductors Integrated Circuits Layout-Design Act, 2000 and The Semiconductors Integrated Circuits Layout-Design Rules, 2001
7. Plant varieties-The Protection of Plant varieties and Farmers' Rights Act, 2001 and The Protection of Plant varieties and Farmers Rights' Rules, 2003 & other rules under the Act
8. Biological Diversity-The Biological Diversity Act, 2002 and The Biological Diversity Rules, 2004
9. IP Related Business Practices - The Competition Act, 2002
10. Undisclosed Information/Trade Secrets - principles of equity and/or through common law approach. The Indian courts regularly pass orders/ Judgments protecting trade secrets/confidential information.
11. The Information Technology Act, 2000 plays an important role in relation to areas of inter-phase between Information Technology and Intellectual Property Rights. It provides for legal recognition for transactions carried out by means of electronic data interchange and other means of electronic communication.

## IPR Policy 2016

The National Intellectual Property Rights (IPR) Policy was adopted on 12.05.2016. The main goal of the policy is "Creative India; Innovative India".

The National IPR Policy is a vision document that encompasses and brings to a single platform all IPRs. It views IPRs holistically, taking into account all inter-linkages and thus aims to create and exploit synergies between all forms of intellectual property (IP), concerned statutes and

agencies. It sets in place an institutional mechanism for implementation, monitoring and review. It aims to incorporate and adapt global best practices to the Indian scenario.

Objectives of the Policy are:

1. IPR Awareness - To create public awareness about the economic, social and cultural benefits of IPRs among all sections of society
2. Generation of IPRs - To stimulate the generation of IPRs
3. Legal and Legislative Framework - To have strong and effective IPR laws, which balance the interests of rights owners with larger public interest
4. Administration and Management - To modernize and strengthen service oriented IPR administration
5. Commercialization of IPRs - Get value for IPRs through commercialization
6. Enforcement and Adjudication - To strengthen the enforcement and adjudicatory mechanisms for combating IPR infringements
7. Human Capital Development - To strengthen and expand human resources, institutions and capacities for teaching, training, research and skill building in IPRs

#### MOUs signed with various Countries and Inter-Governmental Organizations

DPIIT has entered into a Memorandum of Understanding (MoU) with various countries so as to establish a wide ranging and flexible mechanism for cooperation in the field of intellectual property and information technology services related to this field. Currently 13 MoUs with various countries / intergovernmental organizations are active. The MoUs, lay the foundation for a technical cooperation between the two countries/regions with the aim of strengthening the protection of intellectual property rights for the benefit of innovation and sustainable economic growth.

#### **COPYRIGHTS**

Copyright is a right given by the law to creators of literary, dramatic, musical and artistic works and producers of cinematograph films and sound recordings. In fact, it is a bundle of rights including, inter alia, rights of reproduction, communication to the public, adaptation and



translation of the work. Copyright ensures certain minimum safeguards of the rights of authors over their creations, thereby protecting and rewarding creativity. The protection provided by copyright to the efforts of writers, artists, designers, dramatists, musicians, architects and producers of sound recordings, cinematograph films and computer software, creates an atmosphere conducive to creativity, which induces them to create more and motivates others to create.

The Copyright office was established in 1958 under section 9(1) of the Copyright Act, 1957. It is situated in Delhi. The main function of the Copyright Office is to undertake registration of copyrights. Since the Copyright Office has been merged with the Office of CGPDTM w.e.f. 16.12.2020, the administration of the Copyright Act, 1957 along with related matters is now under the purview of the Department for Promotion of Industry and Internal Trade. The CGPDTM has been appointed as ex-officio Registrar of Copyright.

India acceded to two WIPO treaties on Copyrights i.e. WIPO Copyright Treaty & WIPO Performances and Phonograms Treaty in 2018. The treaties came into force on 25th December 2018.

### **Copyright law in India**

The Copyright Act, 1957, The Copyright Rules, 2013 and the International Copyright Order, 1999 governs the copyright protection in India. The Copyright Act, 1957 was notified on 4th June, 1957. It consists of XV Chapters, 79 Sections.

The Copyright Act, 1957 intends to safeguard the rights of the owner as well as the author, whether the copyrightable work is published or unpublished. The author is the first owner of the Copyright.

Copyright subsists in the following classes or works:

- i. Original literary, dramatic, musical, and artistic works;
- ii. Cinematographic films; and
- iii. Sound Recording.

It also applies to architectural works and computer program/software.

Section 14 of the Copyright Act specifies the meaning of copyright and lays down the rights

which are granted via Copyright which inter alia include right to reproduce the work, to issue copies, to perform the work or communicate it to the public, to make any cinematograph film or sound recording or to make any adaptation or translation of the work etc. The Act also provides certain rights like Author's special rights, Performer's Rights etc.

### **Registration of a work under the Copyright Act, 1957**

Copyright comes into existence as soon as a work is created and no formality is required to be completed for acquiring copyright. However, certificate of registration of copyright and the entries made in the Register of Copyrights maintained in the Copyright Office, serve as *prima facie* evidence in a court of law with reference to dispute relating to ownership of copyright.

### **Term of Copyright**

The general rule is that copyright lasts for 60 years. In case of original literary, dramatic, musical, and artistic works the time period of copyright in India is 60 years in addition to the author's lifespan. For cinematograph films, sound recordings, photographs, posthumous publications, anonymous and pseudonymous publications, works of government, public undertakings and works of international organizations, Copyright protection subsists for a period of 60 years from the year of publication. Copyright for Sound recordings is valid for 60 years from the end of the year in which that sound recording is published for the first time.

Broadcast reproduction rights are valid for 25 years from the year of broadcast and performers rights last for 50 years from the year the performance was made.

### **International Copyright**

Copyrights of works of the countries mentioned in the International Copyright Order are protected in India, as if such works are Indian works. Copyright of nationals of countries who are members of the Berne Convention for the Protection of Literary and Artistic Works, Universal Copyright Convention and the TRIPS Agreement are protected in India through the International Copyright Order. The list of such countries is mentioned in the schedule of the International Copyright Order, 1999.

## **Copyright Infringements**

Copyright in a work shall be deemed to be infringed, when any person, without a licence granted by the owner of the copyright or the Registrar of Copyrights or in contravention of the conditions of a licence so granted, does anything, the exclusive right to do which is conferred upon the owner of the copyright, or permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work.

Some of the commonly known acts deemed to be infringement of copyright:

- Making infringing copies for sale or hire or selling or letting them for hire;
- Permitting any place for the performance of works in public where such performance constitutes infringement of copyright;
- Distributing infringing copies for the purpose of trade or to such an extent so as to affect prejudicially the interest of the owner of copyright;
- Public exhibition of infringing copies by way of trade; and
- Importation of infringing copies into India.

## **PATENTS**

A Patent is a statutory right for an invention granted for a limited period of time to the patentee by the Government, in exchange of full disclosure of his invention for excluding others, from making, using, selling, importing the patented product or process for producing that product for those purposes without his consent. It is an exclusive right granted by law to applicants / assignees to make use of and exploit their inventions for a limited period of time (generally 20 years from filing). The patent holder has the legal right to exclude others from commercially exploiting his invention for the duration of this period. In return for exclusive rights, the applicant is obliged to disclose the invention to the public in a manner that enables others, skilled in the art, to replicate the invention. The patent system is designed to balance the interests of applicants / assignees (exclusive rights) and the interests of society (disclosure of invention).

Patent protection is a territorial right and therefore it is effective only within the territory of India.

There is no concept of global patent. However, filing an application in India enables the applicant to file a corresponding application for the same invention in convention countries or under Patent Cooperation Treaty (PCT), within or before expiry of twelve months from the filing date in India. PCT is an international treaty with 157 Contracting States (as on December 2022), making it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an international patent application.

### **Legislation governing Patent system in India**

The patent system in India is governed by the Patents Act, 1970 (No.39 of 1970) as amended and the Patents Rules, 2003. The Patent Act 1970 was notified on 19<sup>th</sup> September, 1970. It contains XXIII Chapters, 163 Sections and the Schedule. The Patent Rules are regularly amended in consonance with the changing environment, most recent being in 2024.

The Ministry of Commerce and Industry has notified and published the Patent (Amendment) Rules, 2024 on March 15, 2024 which have come into effect immediately from the date of the publication. These rules introduce several provisions aimed at simplifying the process of obtaining and managing patents, thereby facilitating a conducive environment for inventors and creators. Some salient features of the revamped Rules are as follows:

- Introduction of unique provision for ‘Certificate of Inventorship’ to acknowledge the contribution of inventors in the patented invention. As the Indian patent certificate does not identify the inventors, this provision will allow inventors to be identified for their inventions.
- The Amended Rules have shortened certain timelines, such as those for requesting examinations and opposition proceedings, while relaxing the timelines for submission of working statements (in Form 27) and details of corresponding foreign applications (in Form 3). Additionally, the Amended Rules have relaxed the provisions for seeking extensions.
- Provision for claiming benefits of Grace period under section 31 has been streamlined by incorporating new form, i.e., Form 31.
- Time limit to furnish foreign application filing details in Form 8 has been changed from

six months from the date of filing of application to three months from the date of issuance of first examination report.

- The timeline for filing the Request for Examination (RFE) is now reduced from 48 months to 31 months from the priority date of application or from the date of filing of application, whichever is earlier. The reduced timeline for filing a RFE will accelerate the patent examination process.
- Frequency to file the statements of working of patents in Form 27 has been reduced from once in a financial year to once in every three financial years. Further, the provision to condone delay in filing of such statement for a period up to three months upon a request in prescribed manner has been incorporated.
- Provision to extend time limit and condone delay in filing has been further simplified and made more explicit to ease in practice. Now, the time for doing any act/proceeding may be extended any number of times up to six months by a request in prescribed manner.
- Renewal fee has been reduced by 10% if paid in advance through electronic mode for a period of at least 4 years.
- The procedure to file and dispose the Pre-grant representation by way of opposition under section 25(1) has been further streamlined and made more explicit by providing ways to dispose of the representation and fixing fees to file such representation in order to curb benami and fraudulent pre-grant oppositions and simultaneously encouraging the genuine oppositions. The official fee for filing a pre-grant opposition is now INR 20,000 for large entities and INR 4,000 for others.

### **What can be Patented?**

An invention relating either to a product or process that is new, involving inventive step and capable of industrial application can be patented. However, it must not fall into the categories of inventions that are non-patentable under sections 3 and 4 of the Act.

“invention” means a new product or process involving an inventive step and capable of industrial application; “new invention” means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date

of filing of patent application with complete specification i.e. the subject matter has not fallen in public domain or that it does not form part of the state of the art;

A product requires to satisfy the following tests in order to qualify as “invention”:

An invention is patentable subject matter if it meets the following criteria –

- i) It should be novel.
- ii) It should have inventive step or it must be non-obvious
- iii) It should be capable of Industrial application.
- iv) It should not attract the provisions of section 3 and 4 of the Patents Act 1970.

### **Applications for Patents**

A patent application can be filed either by true and first inventor or his assignee, either alone or jointly with any other person. Legal representative of any deceased person can also make an application for patent. Application is required to be filed according to the territorial limits if filing offline. Patent applications can be filed through the online filing system at <https://ipronline.ipindia.gov.in/epatentfiling/goForLogin/doLogin>. A patent application can be filed by way of filing Provisional specification (if the invention is still under experimentation stage) or Complete specification (if the invention is fully developed).

Procedure for e-filing:

1. Acquire Class 3 Digital Signatures either from (n) Code Solutions, Tata Consultancy Services (TCS) & Safe Script.
2. New users (Applicants, Agents or Attorneys), can complete online registration by providing Digital Signature details to get a User ID and Password for using the e-Filing System of Indian Patent Office (IPO).
3. Secure Login into the system with created User Id and the Password.
4. Download the Client Software for preparing Patent Application Offline with required documents and Digitally Sign it for uploading on IPO Server.
5. Fill Patent Application offline and generate an XML file using Client Software.

6. After creating application (XML) file offline, Digitally Sign the XML file (Max. file size permitted 5MB) for uploading on to the IPO Server.
7. Login into e-Patent portal (<http://ipindia.gov.in>) for uploading Application XML file on IPO Server.
8. Upload & Submit Digitally Signed XML file to IPO Server
9. Process Application for EFT (Electronic Fund Transfer) using State Bank of India(SBI) & Axis Bank Payment Gateways.
10. Review Application Status on e-Patent Portal.
11. On successful EFT acknowledgement details would be displayed/ generated.
12. Print Acknowledgement. Click on "Print" to generate printout of acknowledgement.

Apart from an ordinary patent application, there are various other types of patent applications:

- Convention application – where applicant is claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries
- PCT International application – patent application filed in India as Receiving Office (RO) under Patent Cooperation Treaty is an international application which can be considered as deemed filed in all member countries of PCT, by a single application.
- An international application made to PCT, designating India, an applicant can file the national phase application in India within 31 months from the international filing date or the priority date, whichever is earlier.
- Patent of Addition application in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed, for which he has already applied for or has obtained patent

The application for patent can be withdrawn at least 3 (Three) months before the first publication which will be 18 (Eighteen) months from the date of filing or date of priority whichever is earlier. The application can also be withdrawn at any time before the grant of the patent. The application withdrawn after the date of publication cannot be filed again as it is already laid open for public inspection. However, application withdrawn before the publication can be filed again provided it is not opened to public otherwise.

Once the patent is granted, a patentee enjoys the exclusive right to make and use the patented invention. The patentee also has the right to assign the patent, grant licences, or otherwise deal with the patent, for any consideration. These rights, created by statute, are circumscribed by various conditions and limitations as prescribed under the Patents Act.1970.

### **Term and Date of Patent**

Term of every patent will be 20 years from the date of filing of patent application, irrespective of whether it is filed with provisional or complete specification. Date of patent is the date on which the application for patent is filed. The term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, will be 20 years from the International filing date accorded under the Patent Cooperation Treaty. A patent will have cease to effect on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period.

## **TRADEMARKS**

A trade mark (popularly known as brand name) is a word, phrase, symbol, design, signature, name, device, label, numerals or combination of colors used by one undertaking on goods or services or other articles of commerce to distinguish it from other similar goods or services originating from a different undertaking. These distinctive symbols, signs and logos help consumers to distinguish between competing goods or services and individualizes the enterprise in consumer's mind.

The Controller General of Patents, Designs and Trade Marks heads the Trade Marks Registry offices and functions as the Registrar of Trademarks. Presently all the functions of the Trade Marks Registry are performed through an automated Trade Marks System.



## **Trade Marks law of India**

The Trade Marks Act, 1999 and the Trade Marks Rules, 2017 govern the law relating to Trade Marks in India. The Trade Marks Act, 1999 (TMA) protects a trade mark for goods or services, on the basis of either use or registration or on basis of both elements. It was notified on 30<sup>th</sup> December, 1999. It contains XIII Chapters, 159 Sections and the Schedule.

Section 2 (1) (zb) of the Trademark Act, 1999 defines a trademark as “a mark capable of being represented graphically and which is capable of distinguishing the goods and services of one person from those of others and may include shape of goods, their packaging and combination of colours”. According to Section 2(1)(m), mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

### **Application for registration**

The process whereby a trade mark is entered on the Register of Trademarks (at the Head Office of the Trade Marks Registry) is referred to as registration. An application for the registration of a trade mark in respect of specification of goods or services shall be made in TM-A and shall be signed by the applicant or his agent. Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark.

The registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

Particulars to be filed with application for registration are:

- (a) the application number or numbers, if any;
- (b) the date and place of filing;
- (c) the appropriate class or classes, as the case may be, in relation to which the application is filed;

(d) an address for communication; and

(e) the concerned agent's code, if any, and the concerned Proprietor's code, if allotted.

Other Particulars:

(1) Names and addresses of the applicants and other persons shall be given in full, together with their nationality, and such other particulars as may be necessary for identification.

(2) In the case of a partnership firm, the full name and nationality of every partner thereof shall be given.

(3) In the case of an application from a convention country and persons having no principal place of business in India, their addresses in their home country shall be given in addition to their address for service in India.

(4) In the case of a body corporate or firm, the country of incorporation or the nature of registration, if any, as the case may be, shall be given.

### **Procedure for series registration**

Section 15 (3) makes provision for registration of trade mark as series in respect of the same or similar goods /services where the marks, while resembling each other in the material particulars thereof and yet differ in respect of –

1. Statement of goods or services in relation to which they are respectively used or proposed to be used; or
2. Statement of number, price, quality or names of places; or
3. Other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
4. Colour

Though it is permissible to file a single application for registration of trade mark in more than one class, it is to be noted that each series marks must be in respect of the same goods or services or description of goods/services. Where a group of marks are applied for registration as series in one registration and the Registrar does not consider them eligible for registration of series marks under section 15 the applicant will be required to delete any of the mark which

is under objection.

Where an application is made for the registration of trade marks as a series under, copies of representation of each trade mark of the series shall accompany the application in the manner set forth in Rule 26.

The Registrar, if satisfied that the trademarks constitute a series, shall proceed further with the applications. At any time before the publication of the application in the Journal, the applicant may request in Form TM-M, for the division of the application into separate application or applications, as the case may be, in respect of one or more trade marks in that series and the Registrar shall, if he is satisfied that the division requested conforms with sub-section (3) of Section 15, divide the

application or applications accordingly on payment of divisional fees.

### **Registration of Collective Marks**

Special provisions have been made for registration of collective marks in section 61 to 68 of the Act. “Collective mark” is defined to mean a trade mark distinguishing the goods or services of members of an association of persons (not being a partnership within the meaning of the Indian Partnership Act, 1932) which is the proprietor of the mark from those of others”- section 2(1) (g). To be registerable, the collective mark must be capable of being represented graphically and meet other requirements as are applicable to registration of trade marks in general. The following points should be noted for registering collective marks -

- The collective mark is owned by an association of persons not being a partnership.
- The collective marks belong to a group and its use thereof is reserved for members of the group.
- The association may not use itself the collective mark but it ensures compliance of certain quality standards by its members who may use the collective mark.
- The primary function of a collective mark is to indicate a trade connection with the association or organization who is the proprietor of the mark.

### **Administrative procedure of registration of trademarks**

To register a trademark, the owner needs to go through the following steps:

- Conducting an exhaustive trademark search;
- Filing an application with necessary documents;
- Examination of the application by the Trademark Registry;
- Post examination procedures;
- Advertisement of the application in the Trademark Journal;
- Opposition by any third party;
- Registration and renewal of the same after every 10 years.

An application for registration of trademarks is received at the Head office of Trademark Registry, Mumbai and its branches according to territorial jurisdiction. Applications are then examined mainly with regard to the distinctiveness, possibility of deceptiveness and conflicting trademarks. The registrar on consideration of the application and any evidence of use or distinctiveness decides whether the application should be accepted for registration or not, and if accepted, publishes the same in the official gazette i.e., Trade Marks Journal (published in CD- Rom). Within a prescribed period, any person can file an opposition, a copy of which is served to the applicants who is required to file a counterstatement within two months failing which the application shall be treated as abandoned.

Thereafter, the opponent leads evidence in support of his case by way of affidavit followed by the applicant's evidence also by way of affidavit in support of the application. After that the opponent files evidence by way of rebuttal. On completion of evidence, the matter is set down for a hearing and the case is decided by a Hearing officer.

### **E-filing of Trademark application**

E-filing is the service provided by the Trademark Registry in order to enable customers to apply for a Trade Mark on-line allowing from the applicant's browser to:

- Complete an electronic application form;
- Provide the associated attachments;
- Complete the necessary payment details

## **Procedure for e-filing**

In order to submit an electronic application form, following steps should be followed -

- 1) Acquire Class 3 Digital Signatures from Licensed Certifying Authority like (n)Code Solutions or Tata Consultancy Services (TCS) or SafeScripT from Sify Technologies Ltd. The Procedure for getting the Digital Signature and the location of their Offices is available at their website.
- 2) For users (Proprietors/Agents or Attorneys), already registered with TMR (Trademark Registry) Office India can complete online registration by providing a desired User ID, their User Type (Proprietor/Agent/Attorney) and User Code.
- 3) For Users who are not registered as Proprietor / Attorney with TMR Office, they can search and fill online form to obtain User code (Party Code).
- 4) Secure Login into the system with created User Id and the Digital Signatures.
- 5) Obtain a New Reference Number for New Application. Use this option when the applicant wants to apply for a new Trademarks Application.
- 6) Update Application Details: Use this option to edit / update the application details along with relevant images and attached documents. Final Submission to TMR-India with Digital Signature is included in this option after which application cannot be edited.
- 7) The Cases which are Digitally Submitted to TMR, India are available for online payment. The applicant can pay for more than one application in a single transaction. Once the payment is realized as confirmed by the Payment Gateway, an acknowledgement receipt for the fees paid is generated by the system indicating the Receipt Number, Application Number and Date of Filing.
- 8) An applicant can also view online History and status of the applications filed by him / her by clicking Status of Filed Application.
- 9) An applicant can also view the online status of e-Payments

## **Term of Trademark**

As per section 25 of the Act, the registration of a trade mark, shall be for a period of 10 years, but may be renewed from time to time in accordance with the provisions of the Act. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of 10 years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as the expiration of the last registration).

## **GEOGRAPHICAL INDICATION OF GOODS**

Geographical Indications of Goods are defined as that aspect of industrial property which refers to the geographical indication referring to a country or to a place situated therein as being the country or place of origin of that product. A geographical indication is an indication used to identify goods having special characteristics originating from a definite geographical territory. As per DPIIT's Annual Report 2023-24, a total of 635 Geographical Indications (GIs) have been registered as on 31st March 2024 in India, including 37 foreign products. The list of Geographical Indications registered from 2004-05 till date is available at <http://www.ipindia.nic.in/registered-gls.htm>.

### **What is a Geographical Indication?**

- It is an indication
- It originates from a definite geographical territory.
- It is used to identify agricultural, natural or manufactured goods
- The manufactured goods should be produced or processed or prepared in that territory.
- It should have a special quality or reputation or other characteristics

### **Few Examples of Indian Geographical Indications –**

- Basmati Rice,
- Alphanso Mango,
- Nagpur Orange,

- Kolhapuri Chappal,
- Bikaneri Bhujia,
- Agra Petha,

### **Legislation governing Geographical Indications of Goods**

The Geographical Indications of Goods (Registration and Protection) Act, 1999, which came into force on September 15, 2003 and The Geographical Indications of Goods (Registration and Protection) Rules, 2002 deal with registration and better protection of geographical indications relating to goods.

The Object of the Geographical Indications of Goods (Registration and Protection) Act, 1999 is three fold, firstly by specific law governing the geographical indications of goods in the country which could adequately protect the interest of producers of such goods, secondly, to exclude unauthorized persons from misusing geographical indications and to protect consumers from deception and thirdly, to promote goods bearing Indian geographical indications in the export market.

The Geographical Indications Registry (GIR) is a statutory organization set up for the administration of the Geographical Indications of Goods (Registration and Protection) Act, 1999. The Controller-General of Patents, Designs and Trade Marks is the Registrar of Geographical Indications.

### **Registration of Geographical Indication**

The registration of a geographical indication is not compulsory; however, it offers better legal protection to facilitate an action for infringement. The registered proprietor and authorized users can initiate infringement actions. The authorized users can exercise the exclusive right to use the geographical indication.

Every application for the registration of a geographical indication shall be made in the prescribed form (GI-1A to ID) accompanied by the prescribed fee. It shall be signed by the applicant or his agent and must be made in triplicate along with three copies of a Statement of Case accompanied by five additional representations.

### **Signing of documents**

1. In case of
  - i. An association of persons or producers shall be signed by the authorized signatory.
  - ii. A body corporate or any organization or any authority established by or under any law for the time being in force shall be signed by the Chief Executive, or the Managing Director or the secretary or other principal officer.
  - iii. In case of partnership it shall be signed by at least one of the partners.
2. The capacity in which an individual signs a document shall be stated below his signature.
3. Signatures shall be accompanied by the name of the signatory in English or in Hindi and in capital letters.

### **Principal place of business in India**

1. Every application for registration of a G.I shall state the principal place of business in India.
2. A body corporate should state the full name and nationality of the Board of Directors.
3. Foreign applicants and persons having principal place of business, in their home country should furnish an address for service in India.
4. In the case of a body corporate or any organization or authority established by or under any law for the time being in force, the country of incorporation or the nature of registration, if any, as the case may be shall be given.

### **Convention Application should contain the following**

1. A certificate by the Registry or competent authority of the Geographical Indications Office of the convention country.
2. The particulars of the geographical indication, the country and the date or dates of filing of the first application.
3. The application must be the applicants' first application in a convention country for the same geographical indications and for all or some of the goods.
4. The application must include a statement indicating the filing date of the foreign application, the convention country where it was filed, the serial number, if available.



## **Statement of user in applications**

An application to register a geographical indication shall contain a statement of user alongwith an affidavit.

## **Content of Application**

Every application shall be made in the prescribed forms and shall contain the following:

1. A statement as to how the geographical indication serves to designate the goods as originating from the concerned territory in respect of specific quality, reputation or other characteristics.
2. The three certified copies of class of goods to which the geographical indication relates
3. The geographical map of the territory.
4. The particulars of the appearance of the geographical indication words or figurative elements or both;
5. A statement containing such particulars of the producers of the concerned goods proposed to be initially resisted. Including a collective reference to all the producers of the goods in respect of which the application is made.
6. The statement contained in the application shall also include the following:
  - An affidavit as to how the applicant claim to represent the interest of the association of persons or producers or any organization or authority established under any law.
  - The standards benchmark for the use of the geographical indication or the industry standard as regards the production, exploitation, making or manufacture of the goods having specific quality, reputation or other characteristic of such goods that is essentially attributable to its geographical origin with the detailed description of the human creativity involved, if any or other characteristic;
  - The particulars of the mechanism to ensure that the standards, quality, integrity and consistency or other special characteristic are maintained by the producers, or manufacturers of the goods.
  - Three certified copies of the map of the territory, region or locality;
  - The particulars of special human skill involved or the uniqueness of the geographical environment or other inherent characteristics associated with the geographical indication.

- The full name and address of the association of persons or organization or authority representing the interest of the producers of the concerned goods;
- Particulars of the inspection structure;
- In case of a homonymous indication, the material factors differentiating the application from the registered geographical indications and particulars of protective measures adopted.

### **Term of Geographical Indication**

The registration of a geographical indication is valid for a period of 10 years. It can be renewed from time to time for further period of 10 years each. If a registered geographical indication is not renewed it is liable to be removed from the register.

### **When is a registered Geographical Indication said to be infringed?**

- When an unauthorized user uses a geographical indication that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which mislead the public as to the geographical origin of such goods.
- When the use of geographical indication result in an unfair competition including passing off in respect of registered geographical indication.
- When the use of another geographical indication results in false representation to the public that goods originate in a territory in respect of which a registered geographical indication relates.

### **DESIGNS**

A Design refers to the features of shape, configuration, pattern, ornamentation or composition of lines or colours applied to any article, whether in two or three dimensional (or both) forms. This may be applied by any industrial process or means (manual, mechanical or chemical) separately or by a combined process, which in the finished article appeals to and judged solely by the eye. Design does not include any mode or principle of construction or anything which is a mere mechanical device. It also does not include any trade mark or any artistic work.

## **The Designs Act, 2000**

The Designs Act, 2000 and the Designs Rules, 2001 presently govern the design law in India. The Act came into force on 25<sup>th</sup> May 2000 while the Rules came into effect on 11<sup>th</sup> May 2001. The essential purpose of design law is to promote and protect the design element of industrial production. It is also intended to promote innovative activity in the field of industries.

## **Essential requirements for registration of Design**

A design should -

- Be new or original
- Not be disclosed to the public anywhere by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration.
- Be significantly distinguishable from known Designs or combination of known designs.
- Not comprise or contain scandalous or obscene matter.
- Not be a mere mechanical contrivance.
- Be applied to an article and should appeal to the eye.
- Not be contrary to public order or morality.

## **Exclusion from scope of Design**

Designs that are primarily literary or artistic in character are not protected under the Designs Act. These will include:

- Books, jackets, calendars, certificates, forms-and other documents, dressmaking patterns, greeting cards, leaflets, maps and plan cards, postcards, stamps, medals.
- Labels, tokens, cards, cartoons.
- Any principle or mode of construction of an article

- Mere mechanical contrivance.
- Buildings and structures.
- Parts of articles not manufactured and sold separately.
- Variations commonly used in the trade.
- Mere workshop alterations of components of an assembly.
- Mere change in size of article.
- Flags, emblems or signs of any country.
- Layout designs of integrated circuits

### **Registration of Design**

Any person or the legal representative or the assignee can apply separately or jointly for the registration of a design. The term "person" includes firm, partnership and a body corporate. An application may also be filed through an agent in which case a power of attorney is required to be filed.

Steps to file a Design Application:

1. Through Assistance from Design Office, first find out whether any Design registration already exists
2. Application duly filed in on the prescribed form (Form-1) along with the prescribed fees
3. Prepare a representation of the article on which Design is purported to be applied for. Representation (in quadruplicate) of the article where drawings, photographs, tracings or other representations including computer graphics should clearly show the features of the design from different views
4. Identify the Class of Design. For the purpose of registration of Design, articles are classified as specified in the Third Schedule to the Design Rules 2001. There are 32 Classes specified in the Third Schedule, which are further divided into sub-classes. A Design may be registered in not more than one class, and may be registered in respect of any or all of the articles comprised in a prescribed class of articles.
5. Provide a Statement of Novelty in order to specify the claims for the design. A statement

of novelty and disclaimer (if any) in respect of mechanical action, trademark, work, letter, numerals should be endorsed on each representation sheet which should be duly signed and dated

6. Priority documents (if any) in case of Convention application
7. If the Design Office seeks additional information or clarifications after preliminary examination, ensure that these are provided promptly.

The Controller shall grant a certificate of registration to the proprietor of the design when registered. Information relevant to any registered designs are entered in Register of Designs kept in Patent Office. The register is prima facie evidence of any matter to be entered therein. Any person can inspect the Register of Designs upon request to the Controller with prescribed fees.

The registration of a design confers upon the registered proprietor the exclusive right to apply a design to the article in the class in which the design has been registered. A registered proprietor of the design is entitled to a better protection of his intellectual property. He can sue for infringement, if his right is infringed by any person. He can license or sell his design as legal property for a consideration or royalty.

### **Term of registration**

Registration initially confers this right for 10 years from the date of registration. It is renewable for a further period of five years. If the fee for extension is not paid for the further period of registration within the period of initial registration, this right will cease. There is provision for the restoration of a lapsed design if the application for restoration is filed within one year from the date of cessation in the prescribed manner.

### **Cancellation of registration of Design**

The registration of a design may be cancelled at any time after the registration of design on the following grounds:

1. That the design has been previously registered in India or
2. That it has been published in India or elsewhere prior to date of registration or

3. The design is not new or original or
4. Design is not registrable under the Design Act 2000 or
5. It is not a design as defined under the Design Act 2000.

### **SEMICONDUCTOR INTEGRATED CIRCUITS LAYOUT-DESIGN**

A semiconductor layout design means a layout of transistors and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in semiconductor integrated circuits.

The objective of implementing Semiconductor Integrated Circuits Layout Design Act 2000 is to act as a catalyst for generation of Intellectual Property relating to Semiconductor Integrated Circuits Layout Designs. The Registry was established with Head Office at Ministry of Electronics and Information Technology (MeitY), the erstwhile DeitY, vide notification dated 1st March 2004 and was operationalized w.e.f. 1st May 2011. In order to bring all IPR- related activities under a single umbrella, administration of the Semiconductor Integrated Circuits Layout-Design (SICLD) Act 2000 and the semiconductor Integrated Circuit Layout-Design (SICLD) Rules 2001 has been transferred to Department for Promotion of Industry and Internal Trade under the Ministry of Commerce and Industry in December 2016, consequent to amendment in the Government of India (Allocation of Business) Rules, 1961. The Registry examines layout designs of the Integrated circuits and issues Registration Certificate to the original layout designs of semiconductor integrated circuits.

#### **The Semiconductor Integrated Circuits Layout-Design (SICLD) Act, 2000**

The Semiconductor Integrated Circuits Layout-Design Act, 2000 was passed to fulfill India's obligations as a TRIPS signatory. It provides protection for semiconductor Integrated Circuit layout designs. The main purpose of the Act is to provide for routes and mechanism for protection of IPR in Chip Layout Designs created and matters related to it. It contains X Chapters and 96 Sections.

#### **Registration of Circuit Layout Design**

Integrated Circuit Layout Design satisfying following criteria can be registered under this Act:

- Original
- Distinctive
- Capable of distinguishing from any other layout design
- Have not been commercially exploited anywhere in India or in a convention country.

A creator of a layout design, an Indian national or national of country outside India which accords to citizens of India similar and has principal place of business in India or if he does not carry out business in India, has place of service in India can apply for registration.

### **Steps for registration of a layout-design**

- 1) Filing of application by the creator of the layout-design at the SICLD Registry.
- 2) The Registrar may accept, refuse the application or accept with some modifications.
- 3) The accepted applications shall be advertised within 14 days of acceptance.
- 4) Any opposition to the advertisement can be filed within 3 months from the date of advertisement.
- 5) The counter-statement to the notice of opposition, if any, to be filed within 2 months from the date of receipt of copy of notice of opposition from the Registrar.
- 6) A copy of the counter statement provided to the opposing party.
- 7) The Registrar may take hearing with the parties.
- 8) The Registrar will decide on the originality of the layout-design and grant or reject the application for registration based on the conclusions reached by him.
- 9) Aggrieved party can appeal to Appellate Board or in its absence Civil Court for relief on any ruling of the Registrar.

### **Documents to be submitted along with application**

- 1) 3 sets of 2D/3D drawings which describe the layout-design applied for registration and or 3 sets of photographs of masks used for the fabrication of the semiconductor integrated circuit by using of the layout-design applied for registration, and or drawings which describe the pattern of such masks.
- 2) Semiconductor integrated circuit [where an integrated circuit has been made using

layout-design applied for registration].

- 3) Details of Fee deposited
- 4) Any related information sought by Registry/Registrar.

In case the applicant for registration of layout-design makes a request in writing for maintaining the secrecy of the layout-design, he may attach in place of the drawings or photographs, the three sets of partially blocked drawings or photographs of such layout-design to the satisfaction of the Registrar. The Registrar may inspect the complete drawing or photographs of such layout-design. The blocking of such drawing or photograph shall be to the satisfaction of the Registrar such that it does not hamper the identification of the applied-for layout-design. The blocked-out area of such drawing or photograph should not be greater than the area of the remaining portion of layout-design.

### **Prohibition from registration**

A layout-design is prohibited from registration if -

- i. It is not original.
- ii. It has been commercially exploited in India or in a convention country.
- iii. It is not inherently distinctive. Also, those which are not capable of being distinguishable from any other registered layout-design cannot be registered.

### **Term of Registration**

The registration of a layout-design shall be for a period of 10 years counted from the date of filing an application for registration or from the date of first commercial exploitation anywhere in India or in any convention country or country specified by Government of India whichever is earlier.



## **Penalties**

Infringing the rights of a registered proprietor of a layout-design is considered a criminal offence. The infringer is punishable with imprisonment for a term that may extend to three years or fine which shall not be less than Rs. 50,000/- but which may extend to Rs. 10 lakhs or with both.

It is a criminal offence to falsely represent a layout-design as registered. If a person does so, he can be punished with imprisonment for a term that may extend to 6 months or with fine, which may extend to Rs. 50,000/- or with both.

## **Semiconductor Integrated Circuits Layout-Design Registry- <https://sicldr.gov.in/>**

Semiconductor Integrated Circuits Layout-Design Registry (SICLDR) is the office where the applications on Layout-Designs of integrated circuits are filed for registration of created IPR. The jurisdiction of this Registry is whole of India.

## **BIOLOGICAL DIVERSITY**

Biodiversity in short, refers to all living organisms and the variety and variability of different species, including plants, animals and microorganisms. India has been a party to the Convention on Biological Diversity (CBD) and ratified the Convention on 18 February 1994. The preservation of biological diversity in India is under the Ministry of Environment, Forests and Climate Change. India's Biological Diversity Act 2002 was enacted for implementation of three objectives of the Convention namely the conservation of biological diversity, sustainable use of components of biological diversity and the fair and equitable sharing of the benefits arising out of the utilization of genetic resources. India is also a signatory to Cartagena Protocol on Biosafety which it ratified on 11 September 2003.

## **Structure for regulation and access to Biological Diversity**

The National Biodiversity Authority (NBA) was established in 2003 by the Central Government to implement India's Biological Diversity Act (2002). The NBA is a Statutory body and that performs facilitative, regulatory and advisory function for Government of India on issue of

conservation, sustainable use of biological resource and fair equitable sharing of benefits of use.

The provisions of the Biological Diversity Act 2002 are implemented through a three-tier institutional structure comprising of NBA at the National level, State Biodiversity Boards (SBBs)/ Union Territory Biodiversity Councils at the State/Union Territory level and the Biodiversity Management Committees (BMCs) at the local body level.

The Functions of the above structure can broadly be summed up as –

National Biodiversity Authority (NBA): Advise on matters relating to conservation of biodiversity, sustainable use of its components and fair and equitable sharing of benefits arising out of the utilization of biological resources; regulating activities and issuing guidelines for access to biological resources and/or associated knowledge and fair and equitable sharing; taking necessary measures to oppose the grant of Intellectual Property Rights in any country outside India on any biological resource obtained from India or knowledge associated with such biological resources derived from India illegally; providing guidance and technical support to Biodiversity Management Committees through State Biodiversity Boards for preparing People's Biodiversity Registers.

State Biodiversity Boards (SBB): Advise the State Governments, subject to guidelines issued by the Central Government, on matters relating to conservation of biodiversity, sustainable use of its components and fair and equitable sharing of benefits arising out of the utilization of biological resources; Regulating by granting approvals or otherwise, the request for commercial utilization of biological resources by Indians.

Biodiversity Management Committees (BMCs): Promote conservation, sustainable use, and documentation of biodiversity and chronicling of knowledge relating to biodiversity.

### **The Biodiversity Act, 2002**

The Government of India enacted The Biological Diversity Act, 2002 and notified The Biological Diversity Rules, 2004 to fulfill its commitments in the Convention on Biological

Diversity and in the Cartagena Protocol on Biosafety.

The Act was enacted to provide for the conservation of biological diversity, sustainable use of its components and fair and equitable sharing of the benefits arising out of the use of biological resources, knowledge and for matters connected therewith or incidental thereto. It was notified on 5th February, 2003. The Act contains XII Chapters and 65 Sections. It primarily aims at giving effect to the provisions of the CBD suiting to our national needs and requirements. The provisions of the Nagoya Protocol on Access and Benefit Sharing (to the CBD), to which India is a Party, are also being implemented through the Biological Diversity Act.

The Biological Diversity (Amendment) Act, 2023 was passed in the Lok Sabha on 25th of July 2023 and Rajya Sabha on 01st August 2023 respectively, and received the assent of the President on 03rd of August 2023. The Biological Diversity (Amendment) Act, 2023 came into force from 1st April 2024. The amendments sought to:

- i. Reduce the pressure on wild medicinal plants by encouraging cultivation of medicinal plants
- ii. Encourage Indian system of medicine
- iii. Facilitate fast-tracking of research, patent application process, transfer of research results while utilizing the biological resources available in India without compromising the objectives of United Nation Convention on Biological Diversity and its Nagoya Protocol
- iv. Decriminalize certain provisions
- v. Bring more foreign investments in the chain of biological resources, including research, patent and commercial utilization, without compromising the national interest.

### **Access to Biological Diversity**

According to Section 2(b) of the Biological Diversity Act, 2002 “Biological Diversity means the variability among living organisms from all sources and the ecological complexes of which they are part and includes diversity within species or between species and of eco-systems.”

Chapter II of the Biological Diversity Act, 2000 lays down certain regulations with reference to access to Biological Diversity. The following regulations have been placed in Section 3 to 7 of the said act. Section 3 of the above referred act, requires the following categories of persons to seek previous permission of the National Biodiversity Authority, to obtain any biological

resource occurring in India or knowledge associated thereto for research or commercial utilization or for bio-survey and bio-utilization –

- A person who is not a citizen of India.
- A citizen of India who is a non-resident as per section 2(30) of the Income-tax Act, 1961.
- A body corporate, association, organization –
  - Not incorporated or registered in India; or
  - Incorporated or registered in India under any law for the time being in force which has any non-Indian participation in its share capital or management.

Rule 14 of the Biological Diversity Rules, 2004 mentions the procedure for access to biological resources and associated traditional knowledge.

Section 4 of the above referred act requires that every person shall seek the previous approval of the national bio-diversity authority before transferring the results of any research related to any biological resources occurring in, or obtained from India to any person as referred to in section 3 above. Rule 17 of the Biological Diversity Rules, 2004 mentions the procedure for seeking approval for transferring results of research.

Section 5 of the Biological Diversity Act, 2002 provides that section 3 and 4 above shall not apply to collaborative research projects involving transfer of biological resources, between institutions including government sponsored institutions of India and such institutions in other countries if –

- If they conform to policy guidelines issued by central government in this behalf;
- Be approved by the central government

Section 6 of the Biological Diversity Act, 2002 (18 of 2003) requires that every person applying for any intellectual property rights in or outside India for any invention based on any research or information on a biological resource which is accessed from India, including those deposited in repositories outside India, or traditional knowledge associated thereto,

shall obtain prior approval of the National Biodiversity Authority before grant of such Intellectual Property Rights.

The provisions of this section are however not applicable on rights relating to protection of plant varieties. Rule 18 of the Biological Diversity Rules, 2004 mentions the procedure for seeking prior approval before applying for intellectual property protection.

Section 7 of the said Act requires every Indian citizen or a body corporate, association or organization registered in India to prior intimate the State Biodiversity Board of the concerned area from which it plans to access any biological resource and its associated knowledge for commercial utilization. The Act empowers State Biodiversity Board, to restrict or reject such activity if it is of opinion that such activity is detrimental or contrary to the objectives of conservation and sustainable use of biodiversity.

### **Exclusion under the Biological Diversity Act, 2002**

The Act excludes Indian biological resources that are normally traded as commodities. Such exemption holds only so far the biological resources are used as commodities and for no other purpose. The Act also excludes traditional uses of Indian biological resources and associated knowledge and when they are used in collaborative research projects between Indian and foreign institutions with the approval of the central government.

### **PROTECTION OF PLANT VARIETIES AND FARMERS' RIGHTS**

A plant variety represents a more precisely defined group of plants, selected from within a species, with a common set of characteristics. The major objectives of the Protection of Plant Varieties and Farmer's Rights Act (PPV&FRA), 2001, which was enacted as part of India's obligation towards Trade Related Aspects of Intellectual Property Rights (TRIPs) Agreement of the World Trade Organization (WTO), are to provide an effective system for the protection of plant varieties and the rights of farmers and plant breeders and to encourage the development of new varieties of plants.

The Protection of Plant Varieties and Farmers' Rights Authority was set up in 2005, with Head

office at New Delhi, and inter alia provides a system for IP protection on the plant varieties to the plant breeders, the rights of farmers either as cultivators of the varieties or plant breeders and to encourage the development of new varieties of plants.

### **Rights under the Act**

The PPV&FR Act 2001, enables a farmer in the same manner as a plant breeder to breed and register the variety keeping value of novelty, distinctiveness, uniformity and stability of the new variety.

**Breeders' Rights:** Breeders will have exclusive rights to produce, sell, market, distribute, import or export the protected variety. Breeder can appoint agent/ licensee and may exercise for civil remedy in case of infringement of rights.

**Researchers' Rights:** Researcher can use any of the registered variety under the Act for conducting experiment or research. This includes the use of a variety as an initial source of variety for the purpose of developing another variety but repeated use needs prior permission of the registered breeder.

### **Farmers' Rights**

- A farmer who has evolved or developed a new variety is entitled for registration and protection in like manner as a breeder of a variety;
- Farmers variety can also be registered as an extant variety;
- A farmer can save, use, sow, re-sow, exchange, share or sell his farm produce including seed of a variety protected under the PPV&FR Act, 2001 in the same manner as he was entitled before the coming into force of this Act provided farmer shall not be entitled to sell branded seed of a variety protected under the PPV&FR Act, 2001;
- Farmers are eligible for recognition and rewards for the conservation of Plant Genetic Resources of land races and wild relatives of economic plants;
- Right to seek compensation in the event a registered variety fails to return expected performance after following the prescribed package of practices

## **Plant Variety**

Under the PPV&FR Act 2001, variety is defined as follows:

A group of plants together belonging to a known botanical species or subspecies which can be (i) defined by the expression of the characteristics resulting from a given genotype of the group of plants; (ii) distinguished from any other group of plants on the basis of difference in the expression of at least one of its characteristics; and (iii) considered as a unit with regard to its suitability for being propagated, which remains unchanged after such propagation.

A plant variety includes propagating material of new variety, extant variety, transgenic variety, farmers' variety and essentially derived variety (EDV).

Under PPV&FR Act, 2001, New; Essentially Derived Varieties (EDV), Extant varieties notified under the Seeds Act, 1966; Extant varieties about which there is common knowledge (VCK) and Farmer's varieties can be registered, provided, the variety must fulfill the criteria of Distinctiveness, Uniformity and Stability (DUS) and novelty (in the case of new variety) and should also have a single and distinct denomination.

## **Protection of Plant Variety**

The protection on the variety means no one can sell, export, import or produce the seed or propagating materials of such protected (registered) plant variety without the registered breeder's (owner's) permission.

Protection of a plant variety is an intellectual property right that the breeder (who could be an individual, farmer, community of farmers, institution or a government) enjoys over the variety along with its denomination as its owner who is entitled to rights on the variety that shall remain with the breeder till he assigns it to anyone else, for the entire period of protection for the purpose of preventing any other person from making economic benefit from it or from assuming any of the rights to which the breeder is entitled to without the permission of the breeder in whose name the variety is registered.

The protection of the plant variety also means that no one including the registered breeder can sell any other variety with the same denomination or sell the protected variety with any other denomination, commitment of which is also a punishable act of infringement.

## **Registration of Plant Varieties**

Registration of a plant variety gives protection only in India and confers upon the rights holder, its successor, agent, or licensee the exclusive right to produce, sell, market, distribute, import, or export the variety.

The major steps in registration of plant varieties under the Act includes filing of application, examination of application and conduct of suitable DUS test, evaluation of DUS test results, publication of passport data in the Plant Variety Journal of India (PVJI) for calling objections, if any, within a specified time frame and issuance of registration certificate to the applicant / breeder.

The application for protection under the Act can be made by any of the following persons:

- Any person claiming to be the breeder of the variety;
- Any successor of the breeder of the variety;
- Any person being the assignee of the breeder of the variety in respect of the right to make such application;
- Any farmer or group of farmers or community of farmers claiming to be breeder of the variety;
- Any person authorized to apply on behalf of farmers; or
- Any organization having an establishment or representative claiming to be breeder of the variety.

In respect of filing applications, there is territorial jurisdiction of branch offices of PPV&FRA which are at Pune (Maharashtra), Shivamogga (Karnataka), Ranchi (Jharkhand), Guwahati (Assam) and Palampur (Himachal Pradesh). In respect of states not covered in territorial jurisdiction of the branch offices, application form may be filed in the Head Office at New Delhi.

The breeder shall be required to deposit the seed of a non-hybrid variety and hybrid variety along



with its parental lines (male, female and maintainers as the case may be), at the time of filing (submission) of the application for registration in person or by postal or courier services.

However, in the case of non-seed based vegetative propagules or on-site testing-based applications in the case of perennials, the propagules have to be reached to the designated field gene bank of the species of crop within 10 days. The date of receiving the application shall be the date on which the seeding material is received at the field gene bank.

### **Criteria for registration of new variety**

**Novelty** - A new variety is deemed to be novel if, at the date of filing of the application for registration for protection, the propagating and harvested material of such variety has not been sold or otherwise disposed of by or with the consent of its breeder or his successor for the purposes of exploitation of such variety for a certain period of time before the date of filing of the application. For sale or disposal of a new variety in India, this time period is earlier than one year. Outside of India, in the case of trees and vines, the time period is earlier than six years. In any other case in India, it is earlier than four years

**Distinctiveness** - A new variety is deemed distinct if it is clearly distinguishable by at least one essential characteristic from any other variety whose existence is a matter of common knowledge in any country at the time of filing of the application.

**Uniformity** - A new variety is deemed uniform if subject to the variation that may be expected from the particular features of its propagation it is sufficiently uniform in its essential characteristics.

**Stability** - A new variety is deemed stable if its essential characteristics remain unchanged after repeated propagation or, in case of a particular cycle of propagation, at the end of each such cycle.

### **Term of protection of a registered plant variety**

The certificate of registration shall be valid initially for 9 years in the case of tree and vines and 6 years for other crops and may be renewed for remaining period on payment of prescribed fee.

The total period of validity of certificate of registration shall not exceed 18 years in case of trees and vines and 15 years in case of other crops, from the date of registration of the variety.

### **TRADE SECRET/ UNDISCLOSED INFORMATION**

A trade secret or undisclosed information is any information that has been intentionally treated as secret and is capable of commercial application with an economic interest, provided such information is not readily available with or discernible by the competitors. They include technical data, internal processes, methodologies, survey methods, a new invention for which a patent application has not yet been filed, list of customers, process of manufacture, techniques, formulae, drawings, training material, source code, etc. It therefore becomes imperative to strengthen the confidentiality around the trade secret by ensuring that contractual obligations are enforced on persons who are allowed to use the trade secret, especially, when it is licensed to a third party. Knowhow is another important form of intellectual property generated by R&D institutions that do not have the benefit of patent or copyright protection. Such know-how is kept undisclosed as trade secrets.

Since there is no documentary evidence such as a Letters Patent or a Copyright registration or a Trademark Registration to prove that the trade secret was originally created by the proprietor, it is essential to maintain proof of creation of trade secret. Trade secret remains confidential for indefinite period of time as per the will of the proprietor provided the security and its confidentiality is not breached.

Trade secret law, like other forms of IP, is governed by national legal systems. However, international standards for protecting secrets (called “undisclosed information”) were established as part of the TRIPS Agreement in 1995. Some general standards on trade secret law are found in Article 39 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Article 39 of the agreement provides that member states shall protect “undisclosed information” against unauthorized use “in a manner contrary to honest commercial practices” (this includes breach of contract, breach of confidence and unfair competition).

There is no specific legislation regulating the protection of trade secrets in India. Trade secrets are protected in India on the basis of the principles of equity and/or through common law approach. The Indian courts regularly pass orders/ Judgements protecting trade secrets/confidential information. Matters related to protection of trade secrets and rights in respect of trade secrets can be enforced under various legislations viz. The Indian Contract Act 1872; The Bharatiya Nyaya Sanhita (BNS) 2023; The Information Technology Act 2000; The Competition Act 2002; IP legislations like the Patents Act, 1970, the Trade Marks Act, 1999, the Copyright Act, 1957, the Designs Act, 2000 etc.

### **What qualifies as a trade secret?**

In general, to qualify as a trade secret, the information must be:

- commercially valuable because it is secret,
- be known only to a limited group of persons, and
- be subject to reasonable steps taken by the rightful holder of the information to keep it secret, including the use of confidentiality agreements for business partners and employees.

The unauthorized acquisition, use or disclosure of such secret information in a wrong manner is regarded as an unfair practice and a violation of the trade secret protection.

### **Examples of Trade secrets**

- Google's Search Algorithm
- Coca-Cola's Coke Syrup Formula
- KFC's Original Recipe
- McDonald's Big Mac Special Sauce
- WD-40's Multi-Use Product Formula

## **PROFESSIONAL OPPORTUNITIES UNDER INTELLECTUAL PROPERTY RIGHTS**

In today's world, the opportunities under IPR for professionals are increasing day by day. As we know the laws are amending and responsibilities of the companies are also increasing. We Professionals can explore more and more opportunities under this area. Some of them are:

1. Intellectual Property registration – Patent searches, Process of registration of Patent, Trademark, Copyright with the Office of the Controller General of Patents, Designs & Trade Marks, filing of application, e-filing, renewal etc.
2. IP Audit- IP Audit involves assessment and review of a company's IP (Intellectual Property), procedures to trace and protect the wealth of intangible assets followed by recommendations on how to improve the processes to safeguard and prevent misappropriation of sensitive forms of IP such as confidential information and trade-secret.
3. IP pricing, tax and IP transactions- Treatment of income from an intellectual property rights, tax provisions, pricing and various transactions can be another area of professional opportunities. Accounting Standard, the Income Tax Act provisions, treatment of expenses on R &D.
4. Management, strategy and licensing services- Preparation of Company's plan of action to manage and protect its intangible assets. Various types of Licensing services can be provided- Technology License Agreement, Franchise or Trademark License Agreement, Copyright License Agreement
5. Documentation for Trade Marks, Copyright, Patents and other Intellectual properties and Drafting of various documents: It Includes-Drafting and filing a patent specification, contract drafting, license agreement.
6. Valuations of IP and intangible assets
7. Advice regarding reverse engineering of intellectual property for identifying infringement
8. Data Analytics: Data analytics in IP helps businesses make informed decisions, stay competitive, and innovate. IP analytics, involves analyzing data related to IP assets like patents, trademarks, copyrights, and trade secrets
9. Technology Transfer Agreements and Advisory
10. Software and Technology Licensing Agreements
11. Regulatory Compliances

12. IPR investigation
13. Setting up R&D hubs
14. Courses on IPR-Creating Various courses on IPR like Online Certificate Course on IP, PG Diploma in IPR, online e-learning platform,
15. Blogs, journals- Publishing articles & blogs on Intellectual Property Rights, creating awareness about the laws.
16. Consultancy on Indian Patent, Trademark Agent examination- Consultancy can be provided on examination related matters, how to apply, study material and other memory techniques.