

INTELLECTUAL PROPERTY LAW

A Complete Book for All Universities

With

Important Notes

Including All Question Papers With Solutions

ALL IN ONE

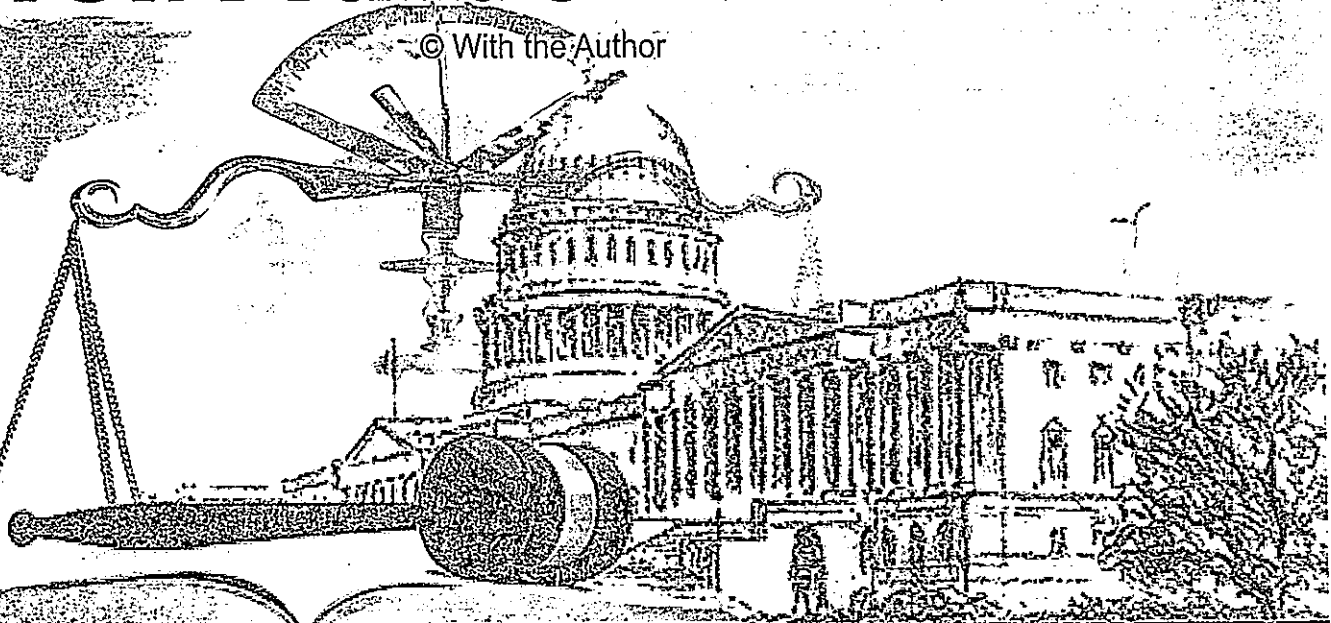
For

Five Years 10th Semester & Three Years 6th Semester L.L.B. Exam

Author

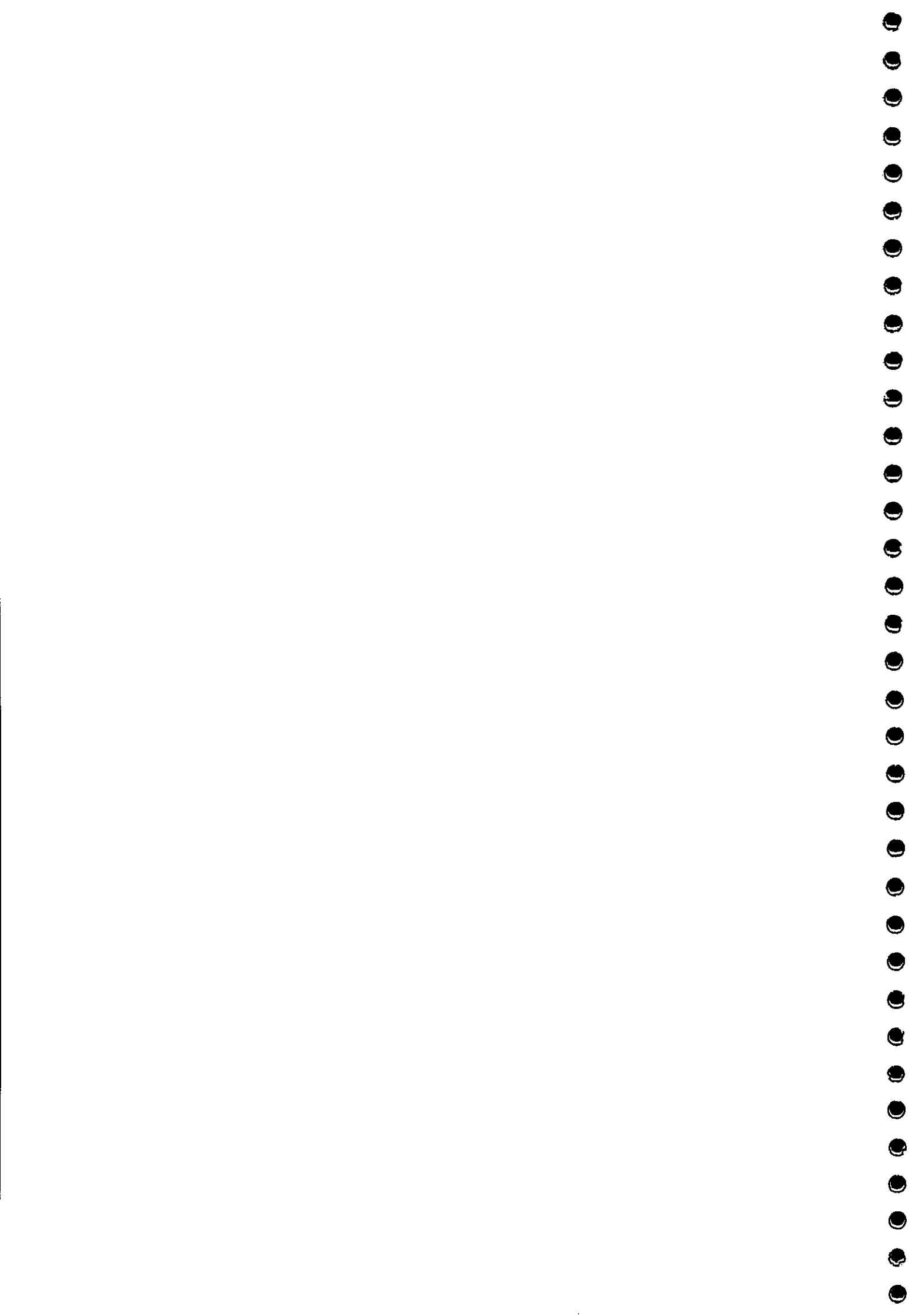
Prof. Prakash K. Mokal

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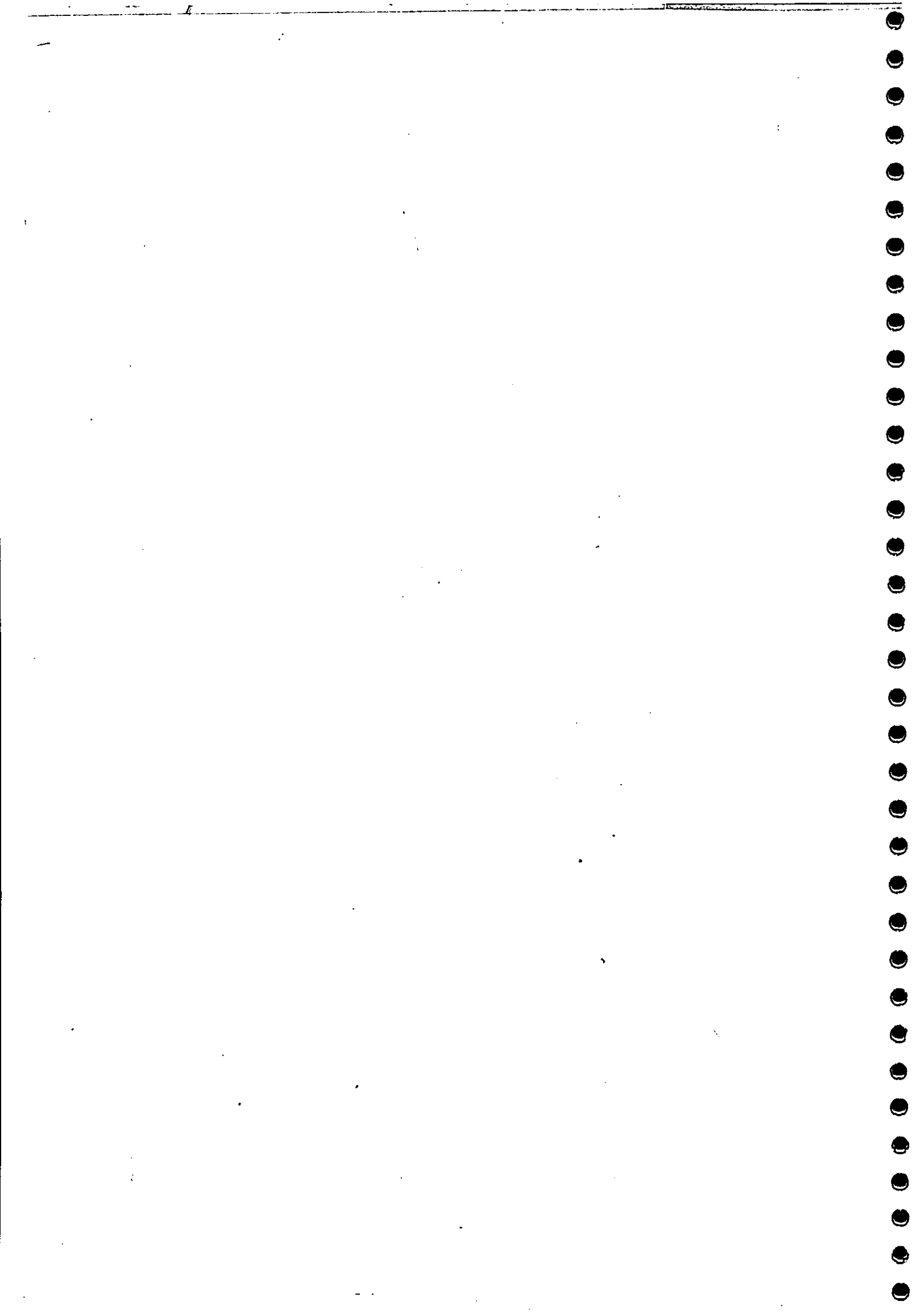
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["Nihil Nisi Bonum" ("Only the Best Will Do")].

Salient features of the Book

- 1) This Book is based on the University recommended Books.
 - 2) Full coverage is given to the syllabus prescribed by the University. Therefore, this Book is complete and exhaustive from the examination point of view.
 - 3) This Book is arranged Chapter-wise with the Important Questions – Answers appeared in the past University Examinations.
 - 4) Leading Case Law is cited wherever necessary, in order to make the concept clear.
 - 5) Important points have been highlighted and clarity of expression is maintained all through this Book by using lucid simple language.
 - 6) Important "Questions for Short Answers", including "Situation based Problems" have been given with solutions at the end of this Book.
 - 7) University Examination Question Papers update (i.e. from 2004 to Nov. 2017) With Solutions have been given with solutions at the end of this Book.
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“INTELLECTUAL PROPERTY LAW”

Brief introduction to the revised syllabus :

The syllabus of the University given below, is primarily based on, the three enactments.

They are –

- [I] “The Copyright Act, 1957”;
- [II] “The Trade Marks Act, 1999”;
- [III] “The Patents Act, 1970”.

The syllabus given below consists mainly of Four Chapters. They are as under –

(1) Introduction to the Intellectual Property Law –

This Chapter consists of the following topics :

- Meaning of intellectual property;
- Protection of intellectual property;
- The main forms of intellectual property : i) copyrights, ii) trade marks, iii) patents, and designs;
- Protection of intellectual property rights in – i) copyrights, ii) trade marks, iii) patents and designs, etc.;
- Leading international instruments concerning intellectual property rights : i) Berne Convention, ii) Rome Convention, iii) Universal Copyright Convention, iv) TRIPs Paris Convention;
- International Organization relating to IPRS – WIPO, WTO.

(2) Selected Aspects of the Law of Copyright in India – (The Copyright Act, 1957).

(3) Intellectual Property in Trade Marks – (The Trade Marks Act, 1999).

(4) Patents – (The Patents Act, 1970).

Revised Syllabus ad verbatim is as under :

CHAPTER – I: Introductory –

- i) The meaning of intellectual property;
- ii) Competing rationales of the legal regimes for the protection of intellectual property.
- iii) The main forms of intellectual property : copyright, trademarks, patents, designs;
- iv) The competing rationales for protection of rights in :
a) Copyrights; b) Trademarks; c) Patents; d) Designs; e) Trade secrets; f) Other new forms, such as, plant varieties and geographical indications.
- v) Introduction to the leading international instruments concerning intellectual property rights : The Berne Convention, Rome Convention, Universal Copyright Convention, TRIP's Paris Convention.
- vi) International Organisation relating to IPRS – WIPO, WTO.

CHAPTER II – : Select aspects of the law of Copyright in India –

- i) Historical evolution of the Copyright Act, 1957;
- ii) Meaning of copyright;
- iii) Copyright in literary, dramatic and musical works;
- iv) Copyright in sound records and cinematographic films;
- v) Copyright in computer programmes;
- vi) Ownership of copyright;
- vii) Assignment of copyright;
- viii) Author's special rights;
- ix) Notion of infringement;
- x) Criteria of infringement;
- xi) Infringement of copyright by films of literary and dramatic works;
- xii) Importation and infringement;
- xiii) Fair use provisions;
- xiv) Piracy of internet;
- xv) Aspects of copyright justice;
- xvi) Remedies, especially, the possibility of Anton pillar injunctive relief in India.

CHAPTER–III : Intellectual Property in Trade Marks (Trade Marks Act, 1999) –

- i) The rationale of protection of Trade marks as – a) an aspect of commercial, and, b) of consumer rights;
- ii) Definition and concept of Trade Marks;
- iii) Registration of Trade Marks;

- iv) Distinction between Trade Mark and Property Mark;
- v) The doctrine of Honest Current User;
- vi) The doctrine of Deceptive Similarity;
- vii) Protection of Well-known Marks;
- viii) Passing off and infringement;
- ix) Criteria of infringement;
- x) Standards of proof in passing off action;
- xi) Remedies.

CHAPTER – IV : Patents –

- i) Patent Act, 1970;
- ii) Concept of Patent;
- iii) Historical view of patents law in India;
- iv) Patentable inventions with special reference to bio-technology products entailing creation of new forms of life;
- v) Patent protection for computer programmes;
- vi) Process of obtaining a patent : application, examination, opposition and sealing of patents : general introduction;
- vii) Procedure for filing patents : Patent Co-operation Treaty;
- viii) Some grounds of opposition;
- ix) The problem of limited *locus standi* to oppose, specially in relation to inventions having potential of ecological and mass disasters;
- x) Wrongfully obtaining the invention;
- xi) Prior publication or anticipation;
- xii) Obviousness and the lack of inventive step;
- xiii) Insufficient description;
- xiv) Rights and obligations of a patentee;
- xv) Patents as chose in action;
- xvi) Duration of patents – Law and policy considerations;
- xvii) Use and exercise rights;
- xviii) Right to secrecy;
- xix) The notion of 'abuse' of patent rights;
- xx) Compulsory license;
- xxi) Remedies;
- xxii) Infringement;
- xxiii) Criteria of infringement;
- xxiv) Onus of Proof;
- xxv) Modes of infringement; The doctrine of Colourable variation;
- xxvi) Defences in suits of infringement;
- xxvii) Injunctions and related remedies.

RECOMMENDED READINGS :

- 1) Cornish W. R. – Intellectual Property, Patents, Trade marks, Copyrights and Allied Rights;
 - 2) P. Narayanan – Intellectual Property law;
 - 3) Wadhera – Intellectual Property Law.
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CHAPTER – I

“Introduction to the Intellectual Property Law”

This Chapter consists of the following topics :

- Meaning of intellectual property;
- Protection of intellectual property;
- The main forms of intellectual property : i) copyrights, ii) trade marks, iii) patents, and designs;
- Protection of intellectual property rights in – i) copyrights, ii) trade marks, iii) patents and designs, etc.;
- Leading international instruments concerning intellectual property rights : i) Berne Convention, ii) Rome Convention, iii) Universal Copyright Convention, iv) TRIPs Paris Convention;
- International Organization relating to IPRS – WIPO, WTO.

Meaning of Intellectual Property :

Intellectual property is a category of intangible rights protecting commercially valuable products of the human intellect. The category comprises primarily trademark, copyright, and patent rights, but also include trade-secret rights, publicity rights, and rights against unfair competition.

There is a close relationship between intangible property and the tangible objects in which they are embodied, intellectual property rights are distinct and separate from property rights in tangible goods. For example, when a person posts a letter to someone, the personal property in the ink and parchment is transferred to the recipient. But the sender (as author) retains intellectual property rights in the letter – *Lionel Bently & Brad Sherman on “Intellectual Property Law”* – 1-2 (2001).

Creative genius of human being creates intellectual property; which in turn when properly exploited, can earn wealth. Since it is essentially a creation of mind, therefore, it is called intellectual property : inventions, industrial designs, literary and artistic works, symbols used to promote commerce are some commonly known forms of intellectual property.

Incorporeal Property or Intangible Property:

“Property” and “Proprietary rights”, and Intangible Property:

Meaning of Property : The term “property” is of wide import. In the widest sense of the term, property includes all legal rights of a person. Thus, incorporeal right, such as,

'right to life', 'right to personal liberty', right to marriage, etc. is the incorporeal property of the person.

The term "property" for the purposes of the Transfer of Property Act, can be used to include proprietary rights concerning corporeal or incorporeal property, for instance, corporeal property, such as, land, buildings, machinery, tools, shares, goodwill. In other words, corporeal right is the right of ownership of a tangible (material) object only.

Meaning of corporeal property : Corporeal property or tangible property has a body or material existence. It includes all material objects or things, such as, land, buildings, car, machinery, tools, money, coins, gold, ornaments, etc. Thus, anything that can be seen, touched, felt, or perceived is a material or corporeal object. Corporeal property is divided into : i) movable property, and ii) Immovable property.

Meaning of Intellectual Property : -

Incorporeal (intangible) property includes i) the ownership of intangible objects, such as, intellectual property – copy-rights, patents, good will, designs and trade-marks, etc. and ii) the ownership of a right in someone else's property (*Jura in re aliena*), such as, Lease, Servitudes, Securities, Trusts, etc.

Basic concepts of Intellectual Property Law :

The law relating to intellectual property is based on certain basic concepts.

Copyright:

Copyright is based on concepts of originality and reproduction of the work in any material form.

Section 14 of the Copyright Act, 1957 defines copyright as, "an exclusive right to make a copy, and an adaptation and exercise of other rights, with reference to tangible works, examples, literary, dramatic, musical, artistic, cinematograph films and sound recording".

The term 'copyright' simply means, 'right to copy'. It comprises the exclusive right of the owner of the works to make copies thereof, and to exclusively exercise various other rights granted to him by law.

The copyright protects rights over certain objects such as, literary, musical, dramatic works, pantomime, choreographic works, pictorial, graphic, architectural and sculptural works, motion pictures and other audio-visual works and sound recordings, computer soft-wares, email, etc.

Patents:

The Patent law centres round the concepts of novelty and inventive step. Patent is an exclusive right granted to an inventor to exploit and market the fruit of his innovative technical or scientific talent for a period of twenty years computed from the date of the filing of the application. In this period of twenty years, he has also got right to prevent others from copying his invention. After the expiry of twenty years of monopoly, the right passes into the public domain.

Trade Mark:

The Trademarks Law is based on the concepts of distinctiveness and similarity of marks and similarity of goods. "Trademark" means, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours;

Mark:

"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".

Design :

The Design Law is based on originality, which not previously published in any other country as well as in India.

Graphical representation:

"Graphical representation means, a representation of a trademark in a paper form". In a paper form does not mean that it must be on a piece of paper or must be written or printed on a piece of paper; it simply means that, the trademark should be capable of being put on the Register in the physical form and also capable of being published in the journal. Thus, the graphic representation facilitates the registration of all trademarks. In other words, all trademarks can be registered by their graphical representations.

Protection of Intellectual Property :

Salmond says that – "the unnatural products of man's brains may be as valuable as is hands or his goods. The law, therefore, gives him a proprietary right in it" – *Salmond on jurisprudence*.

Every human endeavour which promote economic, social, scientific and cultural development of society must be encouraged and the creator must be suitably rewarded by affording legal protection to his intellectual creation. The intellectual property rights are the legal rights governing the use of creations of human minds.

IPR 11. Authors – Prof. Prakash K. Mokal & Adv. Ishwarlal Agarwal.

The intellectual property law regulate the creation, use and exploitation of mental or creative labour. It prevents third parties from becoming unjustly enriched by reaping what they have not sown. This is the branch of law which protects some of the finer manifestations of human achievements.

Lord Atkins in *Macmillan & Co. Ltd. v/s. K. & J.*, quotes Lord Halsbury as follows – “I shall very much regret if I were compelled to come to the conclusion that the state of law permitted one man to make the profit and to appropriate to himself what has been produced by labour, skill and capital of another”. AIR 1924 Privy Council 75, at page 81.

COPYRIGHT ACT, 1957

The Copyright Act, 1957 which is prescribed for the syllabus is given as under –

The Copyright Act, 1957, which is prescribed for the syllabus, is discussed under Eight Chapters :

CHAPTER – I

“WORKS IN WHICH COPYRIGHTS SUBSISTS”

[I] General Nature of copy Rights :

1. Introduction :

Meaning of ‘copyright’ –

The word ‘copyright’ means – “sole legal right, held for certain number of years, by the author or composer of a work, or by someone delegated by him, to print, publish, sell, broadcast, perform, film, or record his work or any part of it” – *“Idiomatic and Syntactic English Dictionary” – Published in the year 1942, Tokyo.*

The word ‘copyright’ is derived from the expression ‘copier of words’ first used in the context, according to *Oxford Dictionary, in 1586.*

The word ‘copyright’ means – “a property right in an original work of authorship (including literary, musical, dramatic, choreographic, pictorial, graphic, sculptural and architectural work; motion pictures and other audiovisual works; and sound recordings) fixed in any tangible medium of expression, giving the holder the exclusive right to reproduce, adapt, distribute, perform and display the work” – *“Black’s Law Dictionary” Eighth Edition, 2004.*

Object of the copyright law –

The object of the copyright law is to protect the author of the copyright work from an unlawful reproduction or exploitation of his work by others.

Copyright protection is essential to encourage exploitation of copyright for the benefit of the public.

The exploitation of the copyright is done by entrepreneurs like publishers, film producers or sound recording producers to whom the owner of the copyright assigns or licences the particular rights.

Inventions in ancient times, creative writers, musicians and artists, wrote, composed or made their works mainly for fame and recognition and not to earn a living or make profits.

The importance of copyright protection was recognised only after the invention of the printing press in the 15th Century which enabled the reproduction of books in large numbers.

The main objects of the copyright law are :

1. Protection of individual commercial interest in an intellectual work – No other than the owner of the copyright can do anything with respect to the work in which the copyright subsists. However, the Copyright Law permits the owner of the copyright to assign the copyright either wholly or partially to any other person or to grant a licence in the favour of any other person in consideration of monetary gain. Thus, copyright law not only protects the creative genius of human mind, but also entitles a person (i.e. author) to earn monetary gain from a work produced by his intellectual labour.

Hon'ble Justice V. R. Krishna Iyer in *Indian Performing Rights Society Ltd. v/s. Eastern India Motion Pictures Association*, observed – “The creative intelligence of man is displayed in multifarious ways of aesthetic expression but it often happens that economic system so operates that the priceless divinity which we call artistic or literary creativity in man is exploited and, masters whose works are valuable, are victims of pitfalling payment. World opinion in defence of human rights to intellectual property led to international conventions and municipal laws, commission codes, and organizations calculated to protect works of art. India responded to this universal need by enacting the Copyright Act, 1957”.

2. Protection of social interest – By protecting the copyright of the authors and artists in their literary or artistic work, the copyright law protects the culture of the society. The Delhi High Court has observed that – “Copyright is a property right and throughout the world, it has been regarded as a form of property working for special protection in the ultimate public interest” – *Penguin Books Ltd., England v/s. Indian Book Distributors* [Del. H.C.AIR 1985, Del. 68].

Again the Delhi High Court observed that the social interest is served by the Copyright Law, in the following words – “The hallmark of any culture is excellence of arts and literature. Quality of creative genius of artists and authors determine the maturity and vitality of any culture. Art needs healthy environment and adequate protection. The protection which law offers, is thus, not the

protection of the artist or author alone. Enrichment of culture is of vital interest to each society. Copyright Law protects this social interest” – *Delhi H.C. AIR, 1987, Del. 13.*

2. Scope of Copyright :

- Copyright is a creation of the statute.
- Its object is to protect the writer or the creator of the Original Work (literature or arts) from unauthorised reproduction or exploitation of his materials.
- The right also extends to prevent others from exercising without authority, any other form of right attached to the copyright.

Example : In the case of Literary Works –

- The right of making a dramatic version;
- Cinematographic version;
- Translation;
- Adaptation;

Copyright is a multiple right – consisting of bundle of different rights in the same work. These rights can be assigned or censed, either as a whole or separately.

3. Ideas :

- There is no Copyright in ideas.

Copyright subsists only in material form; the material form in which the ideas are expressed.

- It is not an infringement of Copyright to adopt the ideas of another.

4. Original :

- Copyright subsists only in original work, i.e. it should originate from the author.

5. Formalities :

- No formalities like registration, etc. are required to acquire copyright.
- Copy right in a work automatically subsists, as soon as, the work comes into existence provided it is original.
- Although, there is a provision for registration of the copyright work, it does not confer any special right or privilege on owner of the copyright.

6. Nature of rights :

- Right to ‘Reproduction’ and ‘Publication’
- There is no Copyright in live events.

[III] Subject Matter of Copyright:

Works in which Copyright subsists (Section 13):

Copy right subsists only in certain classes of works :

- a) Original Literary, Dramatic, Musical and Artistic Works.
- b) Cinematographic Films.
- c) Sound Recordings.

(A) *Original Literary, Dramatic, Musical and Artistic works :*

1) Literary Works –

- Written or printed matter, so long as, there is sufficient skill and labour in creating the work, and includes computer programmes; tables, compilations, including computer database, etc.

2) Dramatic Works –

- Includes any piece for recitation, choreographic work or entertainment in a dumb show, the scenic arrangement or acting form of which is fixed in writing, or otherwise. But it does not include cinematograph film.

3) Musical work –

- Means, a work consisting of music and includes any graphic notation of such work. But it does not include any word or any action intended to be sung, spoken or performed with the music.

Example: An actors movements while performing on the song in movies, cannot be copyrighted.

4) Artistic Work –

- Means, a Painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality : a work of architecture. A work of architecture means, any building or structure having an artistic character or design or any model for such building or structure.

(B) *Cinematograph Films :*

- Means, any work of visual recording on any medium, produced through a process from which a moving image may be produced by any means, and includes a sound recording accompanying such visual recording, and

cinematograph shall be construed as including any work produced by a process analogous to cinematography including video films.

Examples: films, video compact disc, video tape films.

(C) Sound Recording :

Means, a recording of sounds from which such sounds may be re-produced regardless of the medium on which such recording is, or the method by which the sounds are produced.

Examples : Audio cassettes, Compact Disc, Records.

(D) Engravings :

Engravings includes, - etchings, lithographs, wood-cuts, prints and other similar works, not being photographs. 'Photograph' includes photo-lithograph and any work produced by any process analogous to photography, but does not include any part of cinematographic film.

A work of sculpture includes casts and models.

From the above list, it may be seen that, copyright subsists in a wide variety of articles created by man – provided, they are original in the copyright sense.

In fact, one can have a copyright in almost every thing created by man which is original.

CHAPTER – II

“CONCEPT OF ORIGINALITY”

[I] Concept of Originality :

“Original”

Copyright subsists only in original work.

The word “original” does not mean that the work must be the expression of original or inventive thought.

The originality which is required, relates to the expression of the thought, but the expression need not be in an original or novel form, but that the work must not be copied from another work – that is, it should originate from the author.

No formalities like registration, are required to acquire copyright.

- Copyright in a work comes into existence, provided it is original.

Although, there are provisions for the registration of copyright work, it does not confer any special right or privilege on the owner of the copyright.

[II] Works in which Copyright subsists :

Copyright subsists only in certain classes of works.

They are –

- a) Original Literary, Dramatic, Musical and Artistic work;
- b) Cinematographic Films; and
- c) Sound Recordings.

In order to qualify for copyright of works, the first condition is that, it should be original.

Copyright subsists in a wide variety of articles created by a man, provided, they are original in the copyright sense. In fact, one can have a copyright in almost everything created by him which is original.

1. Literary Works :

Copyright subsists in original literary work.

Originality for the purpose of copyright law relates to expression of thought, but the expression need not be original or novel. What is important is that, the work must not be copied from another work, but must originate from the author.

Thus, two authors independently producing identical works, though improbable, will get copyright for their respective works.

The degree of originality required for copyright protection is minimal; the emphasis is more on the labour, skill, judgment and capital expended in producing the work.

a) So also, Copyright subsists in the original adaptation of a literary work. Adaptation means, the conversion of the work into a dramatic work by way of performance in public or otherwise.

b) Any abridgement of the work or any version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book or in a newspaper, magazine or periodical.

A genuine abridgement of a literary work is an original work and can be the subject of copyright.

Example : A comic book of pictures is made, based on a story published in another Copyrighted book or film, etc. – the comic book is an original work and can be copyrighted, e.g. a Comic book based on the film Lagan was recently published.

c) **Collective works** – are compilations which include encyclopedias, dictionaries, newspapers, etc. In collective works there are two Copyrights –

i) Copyright in the separate parts which are vested in the respective authors of the parts;

ii) The Copyright in the collective work as a whole – which is vested in a person who collects the various articles from different authors, arranges and edits them.

The preparation of a collective work requires considerable amount of labour, skill, judgment and investment of capital, and is therefore, original literary work, entitled to copyright protection.

2) Dramatic Works :

Copyright subsists in original dramatic work and its adaptation. A dramatic work includes – (1) piece of recitation, (2) choreographic work, or (3) entertainment in dumb show, (4) or acting form – which is fixed in writing or otherwise, but does not include a cinematograph film.

Although, cinematograph film is not a dramatic work, (5) the script or scenario for cinematograph film, is a dramatic work.

In order that dramatic work qualifies for a copyright protection, it must be reduced to writing, usually in the form of some notation and notes.

3) Musical Work :

Copyright subsists in original Musical Work.

“Musical work” means, a work consisting of music and includes graphical notations of such work, but does not include any word or any action, intended to be seen or spoken or performed with music.

An original adaptation of a musical work also entitled to copyright.

Original –

A musical work must be original in order to qualify for copyright protection.

In relation to musical work, as in literary and dramatic work, the answer to the question "Is this an original work?"

4) Artistic Work :

Artistic work means, –

i) a painting, a sculpture, a drawing, an engraving or a photograph;

ii) a work of architecture;

iii) any other work of artistic craftsmanship. Work of sculpture includes casts and models.

Original –

As in the case of other works to qualify for copyright protection, an artistic work must be original, i.e., it must originate from the author.

In respect of painting, sculpture, drawing, engraving or photograph – the work need not possess any artistic quality – but the author must have bestowed skill, judgment and effort upon the work.

The skill, judgment and effort required may be minimal, but there must be some skill, judgment, effort put into the work.

For example : a) A simple drawing of a human hand showing voters where to mark their cross on a voting paper, was held entitled to protection. b) A poster used in advertisement, is an artistic work.

CHAPTER – III

“RIGHTS OF AN AUTHOR OF THE WORK”

[I] Who can claim ownership of Copyright ?

Section 2 (d) states, –

“The author of the work is the first owner of the Copyright”.

Thus, the author can claim ownership of the copyright if he fulfils the requirement of nationality, given under Section 18 (2) of the Act.

[II] Who is the author ?

An author of the work is the person who creates the work.

a) In case of Literary, Dramatic Work, – the author of the work is the person who Creates the work.

b) In case of Musical Work, – the author of the musical work is the **Composer**.

c) In case of Artistic Work (except photograph), – the author of the artistic work is the **Artist**.

d) In case of a Photograph, – the author of the photograph is the person who takes the photograph.

e) In case of Cinematograph Film, – the author is the **Producer of film** at the time of completion.

f) In case of Sound Recording, – the author is the **Producer**.

g) No copyright in ideas.

Case Law :

Donoghue v/s. Allied Newspapers –

In this case, it was held that, if a person has a brilliant idea for a story, play, or picture and he communicates that idea to another person, this another person who clothes the idea in the form of a book, or play, or picture, – he becomes the author of the work, and can claim ownership of the copyright.

The person who has given the idea, has no right to the product.

For, Copyright exists not in ideas, but in tangible form in which it is expressed.

Where a person provides the material to another for writing a book and the later (Ghost writer) writes the book on the basis of the owner of the copyright in the book.

[III] Author and Ownership of Copyright :

An author may create a work –

- a) on his own behalf.
- b) at the instance of another person for valuable consideration.
- c) in the course of employment of another person.

1) On his own behalf :

In this case, – the author is the owner of the Copyright in the work.

2) At the instance of another person for valuable consideration :

- In this case, – in an absence of an agreement to the contrary, –

- The person at whose instance the work is made – is the owner of the copyright work

3) In the course of employment of another person :

- In this case, – the ownership depends on the nature of the employment.

[IV] Section – 17 :

1) Author an employee of a Newspaper :

- Where a work is made by the author in the course of his employment by the proprietor of a newspaper, periodical, or magazine under a contract of service or apprenticeship for the purpose of publication in the newspaper, magazine, or periodical.

- In the absence of a contract to the contrary, – the proprietor of the Newspaper, etc., will be the first owner of the Copyright in the work, in so far as, it relates to the publication of the work in the newspaper, magazine or periodical or the reproduction for the said purpose.

- In all other respects, – the author will be the first owner of the Copyright.

2) Photograph, Painting, Portrait by Newspaper employee :

- The same rule applies to photographs taken, painting or portrait drawn by a Newspaper employee in the course of employment.

3) Work made in the course of the Employment :

- Where a work is made in the course of the author's employment under a contract of service, in the absence of a contract to the contrary, – the employer (not being the proprietor of a newspaper) will be the first owner of the copyright under the work.

4) Lectures delivered in public :

- Where any person has delivered a speech in public, – that person shall be the first owner of the copyright.

- If the speech is delivered on behalf of any other person, – the other person will be the owner of the Copyright.

5) Where employer is Government department :

- Where the employer is the Government department, the Government is the first owner of the Copyright in a work made by its employee, in the absence of a contract to the contrary.

6) Work made on behalf of a Public Undertaking :

- Where the work is made under the direction or control of any public undertaking, by its employee, – in the absence of a contract to the contrary – the public undertaking shall be the first owner of the Copyright therein.

7) Works of international organisations :

- In the case of works of international organisations, the organisation is the first owner of the Copyright.

- The general principle is that, if a person is employed to do a job of work and paid for his services, the product of his services, –

- subject to any contract to the contrary, – belongs to the employer.

Now let us differentiate between –

Contract of service – Employer – Employee relation ;

Contract of service – Independent – Person relation ;

Contractor who engages a person.

8) Contract for consideration (Commissioned work) :

- When a person has done some work under a contract for consideration – then the provider of the consideration will be the owner of the Copyright, in the absence of a contract to the contrary.

Example : Person engaged by a company to write on a subject, the company is the owner of the copyright.

9) Composer composing a song for a film company :

- A composer of a song for a film company, in the absence of a contract to the contrary – the film company is the owner of the Copyright.

10) Photographer – taking a photo at the instance of another :

- A photographer taking a photo at the instance of another person, in the absence of a contract to the contrary – the another person is the owner of the Copyright.

11) Short-hand Writer :

- If a shorthand writer takes down some matter, word by word, dictated by a person, – the person who dictated the matter, is the author and the Copyright owner of the work.

12) Employee Teacher :

- If an employee teacher writes a text-book on the subject he teaches – he is the author of the work and the owner of the Copyright; since he is employed to teach and not to write text- books.

13) Collective works :

- Collective works include Encyclopedias, Dictionary, Year Book, etc., – the person who collected, edited and organised the work is the first owner of the Copyright.

14) Examination papers :

- Copyright for exam papers – is with the paper setter, as he is the author, and not the Board of Exams, for whom the papers are set.

15) Musical Works :

a) The first owner of the Copyright in musical work – is the composer of the music;

b) However, where the work is composed in the course of employment under a contract of service, –

- The employer will be the first owner of the Copyright.

c) Person who Commissions a Musical work :

- The person who commissions a Musical Work, is not the owner of the Copyright, – but he gets a licence to use the work for the purpose for which it is commissioned.

- Thus, when a film producer commissions a Musical Work for remuneration – he gets a right to incorporate the music in all other respects.

16) Artistic Work :

a) The artist who created the work – is the first owner of the Copyright in the work.

b) Where the work is created in the course of employment, – the employer will be the owner of the Copyright.

c) In the case of commissioned work for valuable consideration – the person who commissioned the work, will be the owner of the Copyright.

d) If the employer, is the owner of Newspaper, Magazine or Periodical, — his right is restricted to the use of the work for publication in the newspaper or magazine or periodical.

- All the above rules are applicable in the absence of a contract to the contrary.

e) Plan by Architect :

In the absence of a contract to the contrary, —

The Copyright in a plan of a building — remains with the Architect, and the client for whom the plan is made, cannot make copies of the plan except for private study.

- He cannot use the plan or design of the existing building, even for the purpose of making extensions to that building without the permission of the architect.

f) Engravings :

Engraving is an artistic work, and includes etchings, lithograph, wood-cuts, or prints — the rights of ownership of Copyright is the same as those for artistic work.

g) Photograph :

i) The person who takes the Photograph — is the author of the work and is the owner of the Copyright in it.

ii) Where the Photograph is taken in the course of employment or at the instance of any person for valuable consideration, — the ownership is determined in the same manner, as in the case of artistic work, discussed above.

17) Cinematograph Film :

The author and owner of a Copyright in a cinematography film, is the producer.

18) Sound Recording :

The author and owner of a sound recording — is the producer.

- The producer of Cinematograph Film and a Sound Recording, is the person who takes the initiative and responsibility for making the work.

CHAPTER – IV

“RIGHTS CONFERRED BY COPYRIGHT”

Rights Conferred by Copyright:

[I] General :

1) It is a Negative Right –

- Copyright is not a positive right, but a negative right. It means, this right stops others from exploiting the work without the copyright owner's consent or licence.

2) It is a Multiple Right –

- It is not a single right, but a bundle of rights which can exist and be exploited independently.

- The nature of these multiple rights, depends upon the categories of work.

- The literary, dramatic and musical works are grouped together for the purpose of defining these exclusive rights.

- The rights relating to Artistic works are distinct from those relating to Cinematograph films and Sound recordings.

3) Economic Right –

- The author may exploit the work himself or licence others to exploit any one or more of the rights for consideration – which may be in the form of Royalty, a lump sum payment. This is the economic benefit to the author.

[II] Moral Rights :

1) Right of Publication –

- The author has a right to publish it, or not to publish it.

2) Right to claim Authorship –

- The author has the right to claim authorship of a published work or exhibited work.

3) Right of Integrity –

- The right to prevent alterations and other actions that may damage the author's honour or reputation.

[III] Author's Special Right :

- a) To claim authorship of the work.
- b) To restrain or claim damages in respect of any distortion, mutilation, modification or other acts – in relation to the work which is done before the expiration of the term of copyright, - If such distortion, etc, would damage his honour or reputation.
 - These rights remain with the author, even after the transfer of copyright, and these rights remain operative till the term of the copyright.
 - The author of computer programme is treated differently, and he does not have the right to restrain or claim damages, when the making of copies or adaptation is done,
 - i) in order to utilise the computer programme for the purpose for which it was supplied,
 - ii) to make back-up copies, purely as temporary protection against loss, destruction or damage.

Statutory Limitations –

Section 52 enables other persons to exercise the rights comprised in a copyright for specified purposes under specified circumstances – and their acts would not amount to infringement.

[IV] Main Rights :

The Copyright in a work is a Creation of Statute.

Copy Right – Definition (Section – 14) :

Copyright means, the exclusive right to do or to authorise the doing any of the following acts in respect of the work or substantial part thereof, namely, –

1) In case of Literary, Dramatic or Musical Work, not being a Computer Programme,

- i) To reproduce the work in any material form including the storing of it in any medium by electronic means.
- ii) To issue copies of the works to the public, not being copies already in circulation.
- iii) To perform the work in public or communicate to the public.
- iv) To make any cinematograph film or sound recording in respect of such work.
- v) To make any translation of the work.
- vi) To make an adaptation of the work.
- vii) To do, in relation to a translation or an adaptation of the work, any of the acts specified invention (i) to (vi), in relation to the work.

2) In case of Computer Programme,

- i) To do any of the acts specified in clause (i) above.
- ii) To sell or give on hire, or offer for sale or hire – any copy of the Computer Programme, regardless of whether such copy has been sold or given on earlier occasions.

3) In case of Artistic Works,

- i) To reproduce the work in any material form – including depiction in two dimensions of a three dimensional work, or depiction in three dimensions of a two dimensional work.
- ii) To communicate the work to the public.
- iii) To issue copies of the work to the public, not being copies already in circulation.
- iv) To include the work in any cinematograph film.
- v) To make adaptation of the work.
- vi) To do in relation to the adaptation of the work, - any of the acts specified in (i) to (v) in relation to the work.

4) In case of Cinematograph Films,

- i) To make a copy of the film, including the photograph of any image forming a part thereof.
- ii) To sell or give on hire, or offer for sale or hire, – any copy of the film, regardless of whether such copy has been sold or given on hire on earlier occasion.

5) In case of Sound Recording,

- i) To make any other sound recording embodying it.
- ii) To sell or give on hire, or offer for sale or hire, any copy of the sound recording, regardless of whether such copy has been sold or given on hire on earlier occasions.
- iii) To communicate the sound recording to the public.

Explanation : For the purpose of this Section, a copy which has been sold once, shall be deemed to be a copy already in circulation.

Rights –

- 1) Right of assignment.
- 2) Right of Transmission.
- 3) Right of Relinquishment.

CHAPTER – V

“TERM OF COPYRIGHT”

(Sections 22 to 29)

Term of copyright in published literary, dramatic, musical and artistic works : (Section 22) –

Copyright shall subsist in any literary, dramatic, musical or artistic work (other than a photograph) published within the lifetime of the author until sixty years from the beginning of the calendar year, next following the year, in which the author dies. In the case of a work of joint authorship, the term author shall be construed as a reference to the author who dies last.

Term of copyright in anonymous and pseudonymous works : (Section 23) –

(1) In the case of a literary, dramatic, musical or artistic work (other than a photograph), which is published anonymously or pseudonymously, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the work is first published :

Provided that, where the identity of the author is disclosed before the expiry of the said period, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the author dies.

(2) In sub-section (1), references to the author shall, in the case of an anonymous work of joint authorship, be construed, –

- (a) where the identity of one of the authors is disclosed, as references to that author;
- (b) where the identity of more authors than one is disclosed, as references to the author who dies last from amongst such authors.

(3) In sub-section (1) references to the author shall, in the case of a pseudonymous work of joint authorship, be construed, –

- (a) where the names of one or more (but not all) of the authors are pseudonymous and his or their identity is not disclosed, as references to the author whose name is not a pseudonym, or, if the names of two or more of the authors are not pseudonyms, as references to such of those authors who dies last;
- (b) where the names of one or more (but not all) of the authors are pseudonyms and the identity of one or more of them is disclosed, as references to the author who dies last from amongst the authors whose names are not pseudonyms, and the authors whose names are pseudonyms and are disclosed; and
- (c) where the names of all the authors are pseudonyms and the identity of one of them is disclosed, as references to the author whose identity is disclosed or if the identity of

two or more of such authors is disclosed, as references to such of those authors who dies last, but which, or any adaptation of which, has not been published before that date, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the work is first published or, where an adaptation of the work is published in any earlier year, from the beginning of the calendar year, next following that year.

Explanation: For the purposes of this section, the identity of an author shall be deemed to have been disclosed, if either identity of the author is disclosed publicly, by both, the author, and the publisher, or is otherwise established to the satisfaction of the Copyright Board by that author.

Term of copyright in the posthumous work : (Section 24) –

(1) In the case of a literary, dramatic or musical work or an engraving, in which copyright subsists at the date of the death of the author or, in the case of any such work of joint authorship, at or immediately before the date of the death of the author who dies last, but which, or any adaptation of which, has not been published before that date, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the work is first published or, where an adaptation of the work is published in any earlier year, from the beginning of the calendar year, next following that year.

(2) For the purposes of this Section, a literary, dramatic or musical work or an adaptation of any such work, shall be deemed to have been published, if it has been performed in public or if any records made in respect of the work have been sold to the public or have been offered for sale to the public.

Term of copyright in photographs : (Section 25) –

In the case of a photograph, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the photograph is published.

Term of copyright in cinematograph films : (Section 26) –

In the case of a cinematograph film, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the film is published.

Term of copyright in records : (Section 27) –

In the case of a sound recording, copyright shall subsist until sixty years from the beginning of the calendar year, next following the year in which the sound recording is published.

Term of copyright in Government work : (Section 28) –

In the case of Government work, where Government is the first owner of the copyright therein, copyright shall subsist until Sixty years, from the beginning of the calendar year, next following the year in which the work is first published.

Term of copyright in works of public undertakings : (Section 28A)

In the case of a work, where a public undertaking is the first owner of the copyright therein, copyright shall subsist until sixty years, from the beginning of the calendar year, next following the year in which the work is first published.

Term of copyright in works of international organizations : (Section 29) –

In the case of a work of an international organisation to which the provisions of section 41 apply, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published.

CHAPTER – VI

“ASSIGNMENT TRANSMISSION AND RELINQUISHMENT”

(Sections 18 to 21)

[1] Assignment :

It is seldom that the author of a copyright work himself to exploit the work for monetary benefit.

a) Ordinarily, he either assigns the whole or part of his right to exploit economically for a lump sum consideration

b) In the alternative, he may licence some or all of his rights to others usually on the basis of a royalty payment.

c) An assignment may be general, i.e. without limitations, or it may be subject to limitations.

d) It may be for the whole term of the copyright or for any part thereof.
An assignment is, in essence, a transfer of ownership even if it is partial.

Section 18 :

Under this Section, –

The owner of the Copyright in an existing work or the prospective owner of the copyright in future work, –

May assign to any person the copyright :

- i) Either wholly or partially the copyright;
- ii) Either generally or subject to limitation; and
- iii) Either for the whole term of the Copyright.

Provided that, in the case of assignment of in any future work, the assignment shall take effect only when the work comes into existence. If the owner of the copyright dies before the work comes into existence, then the legal representatives would take the place of the owner of the copyright.

** Copyright is a movable property and can be assigned by unregistered deed.

** Instrument of assignment must be in writing.

Requirements of Assignment :

- 1) It must be in writing, and signed;
- 2) It must identify the work and specify the rights, its duration and territorial extent;
- 3) It must state the amount of royalty;
- 4) When the period of assignment is not stated, – the period shall be deemed to be five years from the date of the assignment;
- 5) If the territorial extent is not specified, – it shall be presumed to extend within India;
- 6) Transmission of rights can be operative by a Will or Intestate Succession.

Where the assignee does not exercise the rights assigned to him within a period of one year from the date of assignment, – the assignment in respect of the rights, will be deemed to have lapsed after the expiry of the said period, unless otherwise specified in the agreement.

[2] Transmission – by operation of law :

- Copyright is a kind of personal movable property.
- It can, therefore, be transferred by a testamentary disposition or by the operation of law.
- When the owner of the copyright dies, – the copyright will pass to his personal representatives, if he dies intestate.
- If the manuscript of a Literary Dramatic or Musical Work, or Artistic Work has been bequeathed to a beneficiary without specifically bequeathing copyright, the bequest will carry with it, the Copyright also – unless a contrary intention appears from the will.

[3] Relinquishment of Copyright :

- The author of a work may relinquish all or any of the rights comprised in the copyright in the work by giving notice to the Registrar of Copyright in the prescribed form.

- The Registrar will cause the notice to be published in the Official Gazette and in other ways.

- The relinquishment of the rights will not affect any rights subsisting in favour of any person on the date of the notice. For example, the rights of an assignee or licensee.

CHAPTER – VII

“INFRINGEMENT OF COPYRIGHT”

[I] General :

The owner of a Copyright has the exclusive right to do certain acts in respect of the work.

- If any person does any of these acts without the authority of the owner, he will be committing an infringement of the Copyright in the work.

- The nature of right depends upon the nature of the work –

- 1) Reproduction of the work in any material form,
 - 2) Performance of the work in public,
 - 3) Communication of the work to the public in certain forms,
- are the usual methods by which the copyright in any work is commercially exploited for profit.

If any person without authority, – commercially exploits the work for profit, – he will be infringing the Copyright.

There are 3 types of Remedies available against the infringement of copyright, namely,

- 1) Civil;
- 2) Criminal;
- 3) Administrative.

[II] “Infringement” – Definition :

Copyright in any work is deemed to be infringed –

a) When any person without Licence from the Owner of the Copyright, or the Registrar of Copyrights or in contravention of the conditions of the Licence granted or any condition imposed by the Competent Authority under the Act,

i) does anything – the exclusive right to do which is conferred upon the owner of the copyright; or

ii) 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, unless he was not aware and had no reasonable grounds for believing that such communication to the public would be an infringement of copyright; or

- b) Where a Person, —
- i) makes for sale or hire, or sell or lets for hire, or by way of trade displays or offers for sale or hire, any infringing copies of the work; or
 - ii) distributes, either for the purpose of trade or to such an extent as to affect prejudicially, the owner of the copyright, any infringing copies of the work.
 - iii) exhibits to public by way of trade, any infringing copies of the work; or
 - iv) imports into India any infringing copies of the work except one copy of the work for the private and domestic use of the importer.

The reproduction of a Literary, Dramatic, Musical or Artistic Work in the form of a Cinematograph Film, will be deemed to be an infringing copy.

- In general, it is the commercial exploitation of the work in any form, by a person without authority, that constitutes infringement.

Acts of Infringing Copyright (Section 51) :

- 1) In relation to Literary, Dramatic, Musical or Artistic Works – a reproduction thereof, otherwise than in the form of a cinematograph film.
- 2) In relation to a Cinematograph Film – a copy of the film or a record embodying the recording of any part of the sound track associated with the film.
- 3) In relation to a Sound Recording – any such record embodying the same recording.
- 4) In relation to a Programme in which a broadcast reproduction subsists – a record, recording the programme.

[III] Acts which do not constitute infringement (Section 52) :

1) Fair Dealing/Fair Use –

- a) Fair dealing with a Literary, Dramatic, Musical or Artistic work, not being a computer programme – for the purpose of private use, including research, criticism or review.
- b) Making copies of computer programme for certain purposes.
- c) Reporting current events in newspaper and magazines or by broadcasting or in a cinematograph film or by means of photographs.

2) Reproduction for Judicial Proceedings and Reports –

- a) Reproduction for judicial proceedings and reports thereof.
- b) Reproduction exclusively for the use of members of the legislature.
- c) Reproduction in a certified copy supplied in accordance with law (artistic works excluded).

3) Reading or recitation in public of extracts –

- Reading or recitation in public, of extracts of literary or dramatic work.
- 4) **Publication in a collection for the use of educational institutions in certain circumstances.**
- 5) **Reproduction by a teacher or pupil in the course of instructions or question papers.**
- 6) **Performance in the course of activities of educational institutions in certain circumstances.**
- 7) **The making of sound recording under certain circumstances.**
- 8) **The causing of a sound recording to be heard in public by utilising it in an enclosed room or clubs in certain circumstances.**
- 9) **Performance in an amateur club given to a non-paying audience or for religious institutions.**
- 10) **Reproduction in newspaper and magazine, of an article on current economic, political, social or religious topics in certain circumstances.**
- 11) **Making a maximum of 3 copies for the use of a public library.**
- 12) **Reproduction of unpublished work kept in a museum or library for the purpose of study or research.**
- 13) **Publication in newspaper or magazine, a report of a lecture delivered in public.**
- 14) **Reproduction or publication of any matter published in Official Gazette or reports of Government.**
- 15) **Reproduction of any judgment or order of Court, Tribunal or other judicial authority, not prohibited from publication.**
- 16) **Reproduction or Publication of a translation of Acts of legislature or Rules.**
- 17) **Making or publishing of a painting, drawing or photographs of works of architecture.**
- 18) **Making or publishing of a painting, drawing or photograph or engraving of sculpture or other artistic work permanently situate in a public place.**

19) Inclusion in a cinematograph film of any artistic work permanently situated in a public place, and other artistic work by way of background or incidental to the principal matter represented in the film.

20) In case of Computer Programmes – acts which do not constitute infringement.

21) Broadcasting Reproduction Rights – No acts of infringement, –

i) Making of any sound recording or visual recording :

- for private use; or
- for *bona fide* teaching; or
- for research purpose;

ii) Fair dealing on current events, –

- *Bona fide* review, teaching or research.

iii) Such other acts with necessary adaptations and modification which do not constitute infringement under Section 52.

22) Performers Right – acts which do not constitute infringement –

i) Making of sound recording or visual recordings, –

- for private use; or
- for teaching or research; or

ii) Fair dealing, – for review, teaching, research.

iii) Reproduction for, – judicial proceedings, members of the legislature, certified copy for judicial proceedings, educational institution.

CHAPTER – VIII

“REMEDIES AGAINST INFRINGEMENT”

Remedies against infringement :

The Copyright Owner has got 3 kinds of remedies available against the infringer of Copyright. They are –

- 1) Civil Remedy;
- 2) Criminal Remedy;
- 3) Administrative Remedy.

[I] Civil Remedy :

- The owner of the Copyright is the plaintiff.
- An exclusive licensee, can also file a suit in which case the owner of the Copyright has to be made the co-plaintiff.
- The civil suit may be filed for –
 - 1) **Injunction** – stopping such an infringement;
 - 2) **Damages** – in the form of money;
 - 3) **Account of profit** – i.e. the profit which the defendant made by the wrong done by selling of the infringing copies.
 - 4) **Damages for tort of conversion.**

1) Injunction (Temporary) :

- A temporary injunction can be granted by the Court to secure the immediate protection of the copyright.
- The Court directs the defendant to refrain from infringing the right of the plaintiff.

In this case :

- a) The plaintiff will have to make out a *prima facie* case.
- b) The Balance of convenience in his favour.
- c) Refusal to grant temporary injunction, would cause irreparable loss to the plaintiff.

Anton Pillar Order :

- a) This is an ex-parte order.
- b) This order is passed by the Court where urgent and immediate action is required in the interest of justice.
- c) This order states that, – the defendant should allow the plaintiff accompanied by the Attorney, to enter his premises and take inspection of

relevant documents and articles, and take copies thereof or remove them for safe custody.

- d) Such an order is made, where there is a great danger that, the relevant documents and infringing articles being removed or destroyed, – and thereby the ends of justice would be defeated.
- e) Such an order is called, an Anton Pillar Order – named after a Plaintiff in a case where such an order was first passed.

2) Damages or Account of Profit :

- The Plaintiff is entitled to 2 types of damages. They are –

- a) Damages for the infringement of his Copyright;
- b) Damages for the infringement of his Copyright into another form.

[II] Criminal Remedy :

- In addition to civil remedy, – the owner of the Copyright can take criminal proceedings against an infringer.

- Knowledge or '*mens rea*', is an essential ingredient of the offence.

- These two remedies (Civil and criminal), are distinct and independent, and can be taken simultaneously.

- The offence of infringement – punishment – imprisonment from 6 months to 3 years and with fine from Rs. 50,000/- to Rs. 2 lakhs.

- A police officer of the rank of sub-inspector and above, is given the power to seize without warrant. All infringing copies, wherever found and to be produced before Magistrate.

- A Metropolitan Magistrate or a Judicial Magistrate First Class, can try an offence under the Act.

- Any person can make a complaint, however, ordinarily it is the Owner of the Copyright or the Licencee who makes the criminal complaint, and then the Magistrate takes cognizance of the offence.

[III] Administrative Remedy :

- The Copyright Act provides for the establishment of offices and institutions, like

1. The Registrar of Copyrights.
2. The Copyright Board.
3. Copyright Societies.

- They also have certain powers to give certain remedies for violation of Copyright.

CHAPTER - IX

"RIGHTS OF BROADCASTING ORGANISATIONS AND PERFORMERS"

Section 37 of the Copyright Act, 1957, deals with broadcasting reproduction rights.

Section 38 deals with performer's rights.

[I] Broadcasting reproduction rights and infringement :

Every broadcasting organization, will have a special right known as, "Broadcasting Reproduction Right" in respect of its broadcasts.

- This right will subsist for 25 years from the year of the broadcast.

- During this period, if anybody does the following acts without the license from the owner of the right, he will be deemed to have infringed the broadcast reproduction right -

[A] Acts constituting Infringement, -

1) Re-broadcasting the broadcast;

2) Causing the broadcast to be heard or seen by the public, on payment of any charge. (e.g : cable operator);

3) Making any sound recording or visual recording of the broadcast;

4) Making any reproduction of such sound recording or visual recording, where such initial recording was done without the license, or where it was recorded for any purpose not envisaged by such license;

5) Selling or hiring to the public, or offers for sale or hire, any such sound recording or visual recording referred to in (3) and (4) above.

[B] Acts not constituting infringement of broadcast reproduction Right -

1) Making of any sound recording or visual recording :

- For the private use, of the person making the recording.

- Recording for purpose of bona fide teaching or research.

2) The use consistent with fair dealing of excerpts of a broadcast in :

- the reporting of current events, or
- for bona fide review, or
- teaching or research.

3) Such other acts with necessary adaptations and modifications, which do not constitute infringement of Copyright under Section 52.

Clause (3) above is difficult to interpret and apply. Section 52 deals with exceptions to infringement in respect of all works in various situations, according to this, there is no infringement if the prohibited acts are done for the following purposes –

- i) Private use, use by a society for bona fide teaching, or research.
- ii) Fair dealing of excerpts in the reporting of current events, bona fide review, teaching or research.
- iii) Reproduction for use in judicial proceedings.
- iv) Reproduction for use of the members of a legislature.
- v) The use in a certified copy, in accordance with any law in force.
- vi) Use of sound recording or visual recording of the broadcast, in the course of the activities of an educational institution, if the audience are limited to students, and parents and guardians of the students, and persons directly connected with the activities of the institutions.

- The above said acts can be done only with the help of a sound recording or a visual recording of the performance. Accordingly, the making of such recording for the purpose, cannot be an infringement.

[C] Copyright subsisting in the contents of the Broadcast :

- A programme broadcast usually includes literary, dramatic or musical works or records in which independent copyright may subsist.
- In such cases, the broadcasting organisation should obtain the consent or license of the Copyright owners in the work in question, because, copyright in such works includes the right to communicate the work to the public.

[III] Performers Rights (Section 38) :

Performer's right for the benefit of various kinds of performers, like actors, dancers, musicians, jugglers, acrobats, and so on, are contained in Section 38.

- These rights are somewhat analogous to broadcast reproduction rights.

“Performers” include an acrobat, musician, singer, actor, juggler, snake charmer, a person delivering lecture, or any other person who makes a performance.

“Performance” in relation to performer’s right means, any visual or acoustic presentation made by one or more performers.

The Performer has the exclusive right to do the following –

- a) To make sound recording or visual recording of the performance.
- b) To reproduce a sound recording or visual recording of the performance.
- c) To broadcast the performance.
- d) To communicate the performance to the public, otherwise than the broadcast.

[A] Infringement of Performer’s Right :

If, any person during the continuance of a performer’s right and without the consent of the performer, does any of the following acts in respect of the performance or a substantial part thereof,

he will be deemed to have infringed the performer’s rights –

- 1) Makes a sound recording or visual recording of the performance; or
- 2) Reproduces a sound recording or visual recording of the performance, which was :

i) Made without the performer’s consent.

ii) Made for purposes different from those, for which the performer gave his consent.

iii) Made for purposes different from those, referred to in Section 39, from sound recording or visual recording which was made in accordance with Section 39 (Section 39 deals with acts which do not constitute infringement).

3) Broadcasts the performance, except where the broadcast is made from a sound recording or visual recording, other than one made in accordance with Section 39, or is re-broadcast which did not infringe the performer’s right.

4) Communicates the performance to the public, otherwise than by broadcast, except where such communication to the public is made from sound recording or a visual recording or broadcast.

- Where a performer has consented to the incorporation of his performance in a cinematograph film, the performer loses the right to complain of infringement of that performance which means, he assigned his entire rights on that performance to the producer of the cinematograph film.

[B] Acts not constituting infringement of a performer’s right (Section 39) :

- The following acts do not constitute infringement of a performer’s right, in his performance –

- 1) – for private use or for bona fide teaching or research.

2) – Fair dealing of excerpts in the reporting of current events, bona fide review, teaching or research.

3) – Other acts under Section 52, such as, –

a) Reproduction for the use in judicial proceedings.

b) Reproduction for the use of the members of a legislature.

c) The use in a certified copy, in accordance with any law in force.

d) Use of sound recording, visual recording of the performance, in the course of the activities of an educational institution, if the audience are limited to the students, and parents and guardians of the students, and persons directly connected with the activities of the institution.

- The aforesaid acts, can only be done with sound recording or visual recording of performance. Accordingly, the making of sound recording or visual recording for the aforesaid purpose, cannot also be an infringement.

- Where copyright or performer's right subsists in respect of any work or performance that has been broadcast, a license to reproduce such broadcast, will require the consent of the owner of the right, or performer, as the case may be.

CHAPTER – X

“COPYRIGHT SOCIETIES”

Registration of Copyright Society : (Section 33) –

(1) No person or association of persons, shall, after coming into force of the Copyright (Amendment) Act, 1994, commence or, carry on the business of issuing or granting licences in respect of any work in which copyright subsists on respect or in respect of any other rights conferred by this Act, except under, or in accordance with the registration granted under sub-section (3):

Provided that, owner of a copyright shall, in his individual capacity, continue to have the right to grant licences in respect of his own works consistent with his obligations as a member of the registered copyright society:

Provided further that, the performing rights society functioning in accordance with the provisions of Section 33, on the date immediately before the coming into force of the Copyright (Amendment) Act, 1994, shall be deemed to be a copyright society for the purposes of this Chapter; and every such society shall get itself registered within a period of one year, from the date of commencement of the Copyright (Amendment) Act, 1994.

(2) Any association of persons, who fulfils such conditions, as may be prescribed, may apply for permission to do the business specified in sub-section (1), to the Registrar of Copyrights, who shall submit the application to the Central Government.

(3) The Central Government may, having regard to the interests of the authors and other owners of rights under this Act, the interest and convenience of the public, and in particular of the groups of persons who are most likely to seek licences in respect of the relevant rights and the ability and professional competence of the applicants, register such association of persons as a copyright society, subject to such conditions as may be prescribed:

Provided that, the Central Government shall not, ordinarily, register more than one copyright society to do business in respect of the same class of works.

(4) The Central Government may, if it is satisfied that, a copyright society is being managed in a manner detrimental to the interests of the owners of rights concerned, cancel the registration of such society after such inquiry, as may be prescribed.

(5) If the Central Government is of the opinion that, in the interest of the owners of rights concerned, it is necessary so to do, it may, by order, suspend the registration of

such society pending inquiry for such period not exceeding one year, as may be specified in such order under sub-section (4) and that, Government shall appoint an administrator to discharge the functions of the copyright society.

Administration of rights of owner by copyright society : (Section 34) –

(1) Subject to such conditions, as may be prescribed, –

(a) a copyright society may accept from an owner of rights, exclusive authorisation to administer any right in any work, by issue of licences or collection of licence fees or both; and

(b) an owner of rights, shall have the right to withdraw such authorisation without prejudice to the rights of the copyright society under any contract.

(2) It shall be competent for a copyright society, to enter into agreement with any foreign society or organisation administering rights corresponding to rights under this Act, to entrust to such foreign society or organization, the administration in any foreign country of rights administered by the said copyright society in India, or for administering in India, the rights administered in a foreign country by such foreign society or organisation:

Provided that, no such society or organization, shall permit any discrimination in regard to the terms of licence or the distribution of fees collected between rights in India and other works.

(3) Subject to such conditions, as may be prescribed, a copyright society may, –

(i) issue licences under Section 30, in respect of any rights under this Act;

(ii) collect fees in pursuance of such licences;

(iii) distribute such fees among owners of rights, after making deductions for its own expenses;

(iv) perform any other functions consistent with the provisions of Section 35.

Payment of remuneration by copyright society : (Section 34A) –

(1) If the Central Government is of the opinion that, a copyright society for a class of work, is generally administering the rights of the owners of rights in such work throughout India, it shall appoint that society for the purpose of this Section.

(2) The copyright society shall, subject to such rules, as may be made in this behalf, frame a scheme –

for determining the quantum of remuneration payable to individual copyright owners, having regard to the number of copies of the work in circulation:

Provided that, such scheme shall restrict payment to the owners of rights, whose works have attained a level of circulation, which the copyright society considers reasonable.

Control over the copyright society by the owner of rights: (Section 35) –

(1) Every copyright society shall be subject to the collective control of the owners of rights under this Act, whose rights it administers [not being owners of rights under this Act administered by a foreign society or organisation referred to in sub-section (2) of section (34)] and shall, in such manner as may be prescribed, –

- (a) obtain the approval of such owners of rights for its procedures of collection and distribution of fees;
- (b) obtain their approval for the utilisation of any amounts collected as fees for any purpose, other than distribution to the owner of rights; and
- (c) provide to such owners, regular, full and detailed information concerning all its activities, in relation to the administration of their rights.

(2) All fees distributed among the owners of rights shall, as far as may be, be distributed in proportion to the actual use of their works.

Submission of returns and reports : (Section 36) –

(1) Every copyright society shall submit to the Registrar of Copyrights, such returns as may be prescribed.

(2) Any officer duly authorised by the Central Government in this behalf, may call for any report, and also call for any records of any copyright society, for the purpose of satisfying himself that, the fees collected by the society in respect of rights administered by it, are being utilised or distributed in accordance with the provisions of this Act.

Rights and liabilities of performing rights societies :**(Section 36A) –**

Nothing in this Chapter shall affect any rights, or liabilities in any work, in connection with a performing rights society, which had accrued or were accrued on or before the day prior to the commencement of the Copyright (Amendment) Act, 1994, or any legal proceedings in respect of any such rights or liabilities pending on that day".

Full Questions and Short Notes on

"Copyright Act, 1957"

Full Questions –

- 1) "There is no copyright in ideas" – Elucidate. (April, 2004; Nov. 2007).
- 2) State the works in which copyright subsists. Who is an Author in the works in which copyright exists ? (April, 2004; May, 2014).
- 3) Explain the meaning of the expression "infringement of copyright". State the defences available in an action for infringement of copyright. (April, 2004).
- 4) Discuss the remedies in cases of infringement of copyright. (April, 2004).
- 5) Explain and discuss the meaning of the term 'copyright' under the Copyrights Act, 1957. (Nov. 2005).
- 6) What is copyright ? Who is the Author in the various works in which copyright subsists (Nov. 2005).
- 7) State the term of copyright in various works. (Nov. 2005; April, 2007).
- 8) Compulsory Licence in work withheld from public. (Nov. 2007).
- 9) State the rights of Broadcasting Organization and of Performers under the Copyright Act, 1957/Define the terms "Broadcast" and "Performer" Discuss the rights of the Broadcasting Organization and of Performers. (Nov. 2005; May, 2016).
- 10) State acts which do not constitute infringement of copyright/What does not amount to an infringement of a copyright ?/Critically analyze Section 52 of the Copyright Act, 1957. (Nov. 2005; Nov. 2008; Nov. 2009; Nov. 2010; April, 2011; Nov. 2014; Nov. 2015; Nov. 2017).
- 11) State and discuss the works in which copyright may subsist under the Copyright Act, 1957. (April, 2005; Nov. 2005; May, 2006; Nov. 2008)
- 12) "Under Section 13 of the Copyright Act, 1957, copyright shall subsist in original literary, dramatic, musical and artistic works". Explain the concept of 'original' as given under Section 13. Give examples. (Nov., 2006)
- 13) State the term of copyright in various works. (April, 2007)
- 14) Compulsory licence in work withheld from public. (Nov., 2007)
- 15) "There is no copyright in ideas" – Elucidate. (Nov., 2007)
- 16) What are the rights conferred by the Copyrights Act, 1957 ? (April, 2008).
- 17) What is infringement of a copyright ? /Discuss the law relating to infringement of copyrights. (April, 2009; December, 2012; May, 2013).
- 18) When is copyright infringed ? State and discuss the exceptions thereto. (Nov. 2011).
- 19) Explain the concept of ownership under the Copyright Act, 1957. (April, 2009; Nov. 2016).

- 20) Explain the procedure for grant of Licence to produce and publish translations of literary and dramatic work in any language. (Nov. 2009).
- 21) Define Broadcasting Reproduction Rights and its scope of infringement. (Nov. 2009).
- 22) Discuss the rights of broadcasting Organisation and Performers. (Nov. 2011).
- 23) Explain copyright and assignment, transmission and relinquishment of copyright under the Copyright Act, 1957. (Nov. 2009).
- 24) Discuss features of copyright. What are the rights of an author of a work? What are the Economic Rights available to an owner of a copyright? (April, 2010).
- 25) Discuss the various rights which Copyright Act protects. Explain the concept of copyright. (April, 2011).
- 26) Explain the concept of copyright and state the various rights which are comprised in copyrights. (May, 2012; December, 2012; May, 2013).
- 27) Discuss the provisions of the Copyright Act, 1957 in relation to copyright societies. (May, 2012).
- 28) Discuss the doctrine of Deceptive Similarity. (December, 2013; May, 2016).
- 29) What is passing off? State the modes of passing off. (December, 2013; Nov. 2014; May, 2015; Nov. 2015; May, 2017).
- 30) "Copyright is a bundle of rights" – Explain. (December, 2013; May, 2015; May, 2016; May, 2017).

Short Notes –

- 1) Musical Work. (April, 2004).
- 2) Artistic Work. (Nov. 2004).
- 3) Deceptive Similarity. (Nov. 2004).
- 4) Copyright Societies/Rights and Liabilities of Copyright Societies. (April, 2005; Nov., 2005; Nov., 2007; April, 2009; April, 2010; April, 2011; Nov. 2011; December, 2012; December, 2013; May, 2014; Nov. 2014; May, 2015; Nov. 2015; May, 2017)
- 5) Adaptation under Copyright Act, 1957. (April, 2005; Nov., 2005)
- 6) Fair Use. (Nov. 2005; May, 2006; April, 2007; April, 2008; April, 2011).
- 7) Performer's Rights. (Nov. 2005; April, 2008; December, 2012; December, 2013).
- 8) Passing Off. (Nov. 2005; May, 2006; Nov. 2006; Nov. 2007; April, 2010).
- 9) Anton Pillar Injunction/Anton Pillar Order. (May, 2006; Nov. 2010; Nov. 2011; May, 2012)
- 10) Meaning of Copyright. (Nov., 2006)
- 11) Geographical Indications. (Nov., 2006)
- 12) Injunction. (April, 2007)
- 13) Mareva Injunction. (April, 2008; April, 2011; Nov. 2014; Nov. 2015)
- 14) Concept of Author and Owner of a copyright protected work. (Nov., 2007).

- 15) Author's special rights. (Nov. 2008; Nov. 2009; Nov. 2010).
- 16) Protection of Computer Software. (April, 2009).
- 17) Broadcast reproduction right. (April, 2009).
- 18) Transmission of copyright by operation of law. (Nov. 2009).
- 19) Universal Copyright Convention. (April, 2010).
- 20) Copyright Board. (Nov. 2010; May, 2012; Nov. 2017).
- 21) Copyright in case of Literary, Dramatic or Musical Work. (April, 2011).
- 22) Assignment of Copyright. (May, 2013).
- 23) Producer. (December, 2013).
- 24) Commercial rental. (May, 2015).
- 25) Joint Authorship. (May, 2016).
- 26) Infringing Copy. (Nov. 2016)..
- 27) Communication to the public. (Dec. 2013; May, 2014; Nov. 2015).
- 28) Doctrine of Honest Concurrent Use. (May, 2015).
- 29) Fair Dealing. (May, 20014; May, 2015).

“TRADE MARKS”

“THE TRADE MARKS ACT, 1999”

The Trade Marks Act, 1999, which is prescribed for the syllabus, is discussed under Ten Chapters :

CHAPTER – I

“TRADEMARK – MEANING AND FUNCTIONS”

[I] Trade Mark :

A Trade Mark is a visual symbol in the form of Word, Device or Label applied to articles of commerce; to tell the purchasing public –

- That they are goods manufactured or dealt with, by a particular person – as distinguished from similar goods manufactured and dealt with, by other person.
- A person who sells his goods under a particular Trade Mark, acquires limited exclusive right to use the trademark in relation to those goods.
- Such an exclusive right acquired by use, is recognised as a form of property in Trade Mark, and is protected in common law.
- The law as to Trademark is based on 2 concepts, namely, –
 - i) Distinctiveness; and
 - ii) Deceptive Similarity.
- In India, two enactments for protecting Trade Marks are in operation. They are –
 - 1) The Trade and Merchandise Mark Act, 1958;
 - 2) The Trade Marks Act, 1999.

Period :

In Trade Mark, – No period is prescribed for using the Trade Mark,

- Once it has been granted,
- The only responsibility of the User of Trade Mark, is to protect it, and if it is registered Trade Mark, then to get it renewed periodically.

Types of Trade Marks :

There are two types of Trade Marks. They are –

Registered Trade Marks;

Unregistered Trade Marks;

[1] Registered Trade Marks :

Registered Trade Marks can be protected against unauthorised use, by an action of infringement; and this is a statutory remedy.

- Registered Trade Mark has to be renewed periodically.

[2] Unregistered Trade Mark :

An Unregistered Trade Mark can be protected against unauthorised use by the other, by an action of Passing off which is a common law remedy.

- Unregistered Trade Mark can be protected by — continuous use.

[II] Trade Mark Act (New Act of 1999) :

As per the new Act, the definition of Trade Mark includes 'Goods' and 'Services'.

1. Trade Mark must be a mark, which included — a Device, Brand, Heading, Label, Ticket, Name, Signature, Word, Letter, Numerical, Shape of Goods, Packaging, Combination of Colours — or any combination thereof;
2. Marks must be capable of being represented Graphically;
3. It must be capable of distinguishing goods or services of one person from those of others;
4. It may include — shape of Goods, their Packaging and Combination of Colours;
5. It must be used or proposed to be used in relation to goods or services;
6. The use must be for the purpose of indicating the connection between the goods or services, and some persons having the right as proprietor to use the mark in the course of trade;
7. The right to proprietorship of Trade Mark, may be acquired by —
Registration under the Act; or
By use.

[III] Functions of Trade Mark :

Indication as to the manufacture or quality of goods —

- The function of the trade mark, is to give an indication to the purchaser or possible purchaser, as to the manufacture or quality of goods.

Trade Sources or Trade Hands —

- To give an indication to his eye of the trade source from which the goods come or the Trade — Hands, when they pass on their way to the market.

Tells the buyer — something known to him —

- It tells the buyer, what he has been presented, is something known to him under similar name or coming from a source which he is acquainted with.

Assurance of the make and quality –

- It gives the purchaser, a satisfactory assurance of the make and quality of the article he is buying.

Main Functions –

Under modern business conditions, trade mark functions are :-

- i) It identifies the Product and its Origin.
- ii) It guarantees its unchanged Quality.
- iii) It Advertises the product.
- iv) It creates an Image for the product.

[IV] Object of Trade Mark Law :

- i) Deals with precise nature of the rights which a person can acquire in respect of Trade Marks.
- ii) The mode of acquisition of these rights.
- iii) The method of transfer of these rights.
- iv) The nature of infringement of these rights.
- v) The remedies available in respect of these rights.

[V] What is a Good Trade Mark :**1. Easy to pronounce and remember – Word :**

- It should be easy to pronounce and remember, if the mark is a 'Word'.

2. Device Mark – Single Word :

- In case of device mark, – device should be capable of being described by a single word.

3. Easy to spell and write :

- Trade mark must be easy to spell correctly, and write legibly.

4. Not Descriptive, but Suggestive :

- It should not be descriptive of the goods, but suggestive of the goods.

5. Short :

- It should be short.

6. Appeal to the Eyes and Ears :

- It should appeal to the eyes, as well as, the ears.

7. Satisfy requirements of Registration :

- It should not belong to the class of Marks prohibited for registration.

[VI] Different Forms of Protecting Trade Marks :

- Trade Marks which are registered, are called Statutory Trade Marks.

- Other Trade Marks – are those which are used.
 - In a Patent, registration is compulsory. Here, public interest is important in Patent Act as well as the interests of the individual – Patents are for a time period.
 - Registered Trade Marks can be protected against unauthorised use –
 - by an action of infringement;
 - this is a statutory remedy.
- Unregistered Trademarks can be protected against unauthorised use, by an action of passing off – this is a common law remedy.

[VII] Time Period :

Trade Mark has no limit or time period.

1st Trade Mark was registered in 1856 and still it continues. It is in respect of alcoholic beverages.

- Trade Mark need not be registered, the only condition is that, it must be used.
 - Unregistered Trade Mark comes under common law.
 - Registered Trade Marks – protection can be availed by statutory provisions, viz.
 - Suit for action against infringement in court of law;
 - Specific performance;
 - Damages;
 - Restraints.
 - In case of unregistered Trade Mark, it can be protected by one action – Action of Passing Off.
 - One common action application to both of them, whether registered or unregistered, is :-
 - Criminal proceedings for unauthorised use of Trade Mark. This is based on two concepts –
 - Distinctiveness;
 - Deceptive Similarity.
- Because, it is a criminal offence, as you are causing fraud due to deceptive similarity, there is cheating.

CHAPTER – II

“RIGHTS OF REGISTERED PROPRIETOR OF TRADEMARK”

[I] Rights of a Registered Trade Mark Proprietor :

A registered proprietor of Trade Mark, gets the following rights –

1. Exclusive Right to use :

- The exclusive right to use the Trade Mark in relation to the goods or services for which it is registered.

2. Right to take action :

- The right to take action, in case of the Trade Mark's infringement, against those who might be infringing it –

(a) by using it, or (b) a deceptively similar Trade Mark in relation to their goods or services.

- If the Trade Mark is not registered, –

no action for infringement can be taken on the basis of Trade Mark.

[III] Effect of Registration :

Registration of Trade Mark has the Following effects –

1. Proprietor gets certain rights to use exclusively for benefit :

- It confers certain rights to the registered proprietor to use it exclusively for his own benefit.

2. Evidence of Validity :

- It is *Prima facie* evidence of Validity of the Trade Mark.

3. Protected – Distinctiveness :

- It is Protected on the ground of Distinctiveness.

4. Acquiescence :

- Acquiescence, effect of acquiescence is recognized.

5. Not to interfere with vested rights :

However, proprietor is not supposed to interfere with vested rights.

6. Not to interfere with *bona fide* use :

- Proprietor not to interfere with *bona fide* use of name, address or description of goods or services.

7. Validity of registration, not affected :

- Validity of registration not affected by words used as name or description of substance, or service.

[III] Rights conferred by Registration of Trade Marks :

- The registration of trade Marks confers many rights on the proprietor of the Trade Mark.

- These right are not absolute.

- They are subject to the other provisions of the Act, and to any conditions and limitations to which registration is subject.

Section 28 of the Act, deals with rights conferred by registration. They are as follows :-

A) Exclusive Right to Use –

- The exclusive right to use the Trade Mark, in relation to the goods or services in respect of which the trade mark is registered.

B) Right to Take Action and Use –

- The right to take action, and obtain relief in case of infringement of the Trade Mark.

- In case, if there are more proprietors than one, each of them has the same rights against other persons, not being registered users, using by way of permitted use, as he would have, if he was the sole registered proprietor.

C) Other Rights –

1. To Assign and to Licence :

Registered Proprietor of Trade Mark is entitled to assign the Trade Mark, and give receipt for any consideration for such assignment.

2. To Apply for Correction :

a) He has right to apply for correction of the register, – to correct name, address or description of registered proprietor.

b) To enter any change in the name, etc. of the registered proprietor;

c) To cancel the entry of trademark on the Register; and

d) To strike out any goods or classes of goods or services, from the Register.

3. To make Alterations of the Trade Mark –

Registered proprietor of Trade Mark, may apply to Registrar for leave to make alterations in the Trade mark without changing identity.

4. Registered User – Infringement Proceedings –

- A registered user of Trade Mark, may take up infringement proceedings, as if, he were the registered proprietor.

5. Reliefs – After institution of infringement proceedings, the registered proprietor of Trade Mark, may have the following reliefs :-

- a. Injunctions – Temporary or Permanent; b. Damages; c. Accounts of Profit.

Case Law :

(A)

Jindal Industries v/s. Nirmal Steel Tubes (P) Ltd.
In this case, both the parties published Map of India, and the plaintiff contended that, he had exclusive right to publish the Map of India.

- The Delhi High Court rejected his contention, and ruled that, no person can have an exclusive right to use the device of Map of India. – It was further laid down that, the owner of a Registered Trade Mark cannot be restrained by an order of injunction, from using the Registered Trade Mark.

(B)

P.M. Diesel Pvt. Ltd. v/s. Thukral Mechanical Works.
In this case—Where the Plaintiff and defendant, both, are the proprietors of Registered Trade Mark “Field Marshall”,—None of them can be deemed to have acquired exclusive right to use the Trade Mark. Both of them, otherwise, have the same rights as against other persons, Section 28 (3) would protect the proprietary right of both the persons.

6. Transfer of Right by way of Licencing :

Licencing is generally available, like in Patent Law – but in the Patent Law there is compulsory licencing, because of public interest.

- Compulsory licencing is not present in Trade Mark. Because, there is no public interest involved. This right has an individual aspect i.e. to differentiate his goods from other goods.

- Therefore, licencing of Trade Mark is not a general practice, but now-a-days, licencing is done, because trade and commerce has increased.

- But, if licence has to be given, then it is necessary that, it be registered.

Registered Trade Mark can only be given on licence and the transaction should be registered also. If the transaction is not registered, the licensee cannot take action in case of infringement.

CHAPTER – III

“INFRINGEMENT AND PASSING-OFF”

[I] Infringement of Trade Mark :

Infringement of Trade Mark takes place, when a person other than the Registered Proprietor or the Registered user,

- 1) Uses the same Trade Mark; or
 - 2) Uses a deceptively similar mark, in relation to some goods or services, for which the trademark is registered.
- The infringing Trade Mark – Should be such, as to cause confusion or deception in the minds of the purchasers of the given goods or services.

In order to be successful, that the infringement has taken place –

- 1) It has to be shown by proof that, confusion has, in fact taken place.
- 2) That the infringing trade mark is deceptively similar to infringed trademark.

Essentials of Infringement :

1) Use of Registered Trade Mark by unauthorised persons –

- One of the important essentials of infringement is that, – the trade mark has been used by a person, other than its registered proprietor or registered user.

2) Use of registered Trade Mark – by making few additions and alterations –

- When a person uses a trademark by making a few additions or alterations to the trademark, – such an act amounts to infringement of the registered trade mark.

3) Infringing Trade Mark used by a person – in relation to regular trade of the registered proprietor –

- Where a person uses a Trade Mark by making a few additions or alterations to the trademark, – such an act amounts to infringement of the registered trade mark.

4) Infringing Trade Mark is similar to the registered trademark –

- The infringing Trade Mark is similar or identical to the registered Trade Mark.

5) Likely-hood of confusion –

- Infringing Trade Mark is so deceptively similar, that it is likely to cause confusion amongst the buyers.

6) Creating false impression among the people –

- The trade Mark is so advertised, – that it causes a false impression among the public, that the unauthorised person is authorised to use the Trade Mark.

- In any of the above mentioned circumstances, it would constitute an infringement of a registered trade mark.
- The most common form of infringement – an unscrupulous trader uses the trade mark, or uses an infringing trade mark, and thereby, takes undue advantage. He, thereby, causes harm to the interests of a registered proprietor or user.

[III] Remedies Available Against Infringement of Trade Mark :

There are three kinds of remedies available in case of infringement of Trade Mark. These remedies are –

- 1) Civil Remedies;
- 2) Criminal Remedies;
- 3) Administrative Remedies.

1. Civil Remedies :

Whenever a registered Trade Mark is violated or infringed, – the aggrieved person may move the Civil Court, by instituting a suit in, such Court, with the purpose of restraining the infringer or defendant from using the registered trademark of the plaintiff; or a suit to claim damages.

A) Injunctions :

- The registered proprietor or user of the Trade Mark may pray for an injunction – restraining the defendant from making further use of such trade mark, and for this purpose, he may seek the following reliefs –

i) Anton Pillar Injunction :

- The order is passed *ex-parte* – to inspect the premises of the defendant without notice, where there is a possibility of the defendant destroying or disposing off the incriminating material.

The Anton Piller order is an order so called because the practice of its issue was confirmed and consolidated in the case of *Anton Piller K.G. v/s. Manufacturing Process Ltd. (1976) All E.R., 779.*

ii) Mareva Injunction :

- This is an injunction order passed by the Court, under which the Assets of the defendant are freezed, where there is a possibility that the assets may be dissipated or cancelled, so as to render a judgment against the defendant, ineffective and unenforceable.

iii) Interlocutory Order :

- This order is intended to attach the property before the judgment under C.P.C., 1908.

iv) Perpetual Injunction :

- This order is passed on hearing the suit fully.
- Restraining the defendant from making use of the infringing Trade Mark.

B) Damages :

- The person aggrieved by an act of the infringer (defendant), may claim damages for the loss suffered by him due to the acts of the defendant.

C) Order – Directing delivery of labels and marks for destruction :

The Court may, also pass an order, directing the defendant to deliver the labels and the marks, – so that, the same are destroyed, and thus, the defendant is restrained permanently from making use of the infringing marks.

2. Criminal Remedies :

Offence –

- The Offences for which criminal action can be taken, are as under:-

- i) Falsifying and falsely applying Trade Mark.
- ii) Selling goods or providing services to which false Trademark as applied.
- iii) Falsely representing that – a trademark is registered, when actually it is not registered.
- iv) Falsifying entries in the Register.
- v) Abetting in India, of acts done outside India.

Punishment :

Punishment for these offences, include a minimum imprisonment of 6 months, and a minimum fine of Rs.50,000/- which may extend upto 3 years and Rs. 2,00,000/-

3) Administrative Remedies :

These remedies are available to an aggrieved person, and are such, which are provided by the administrative authorities.

The concerned Administrative Remedies may provide, remedies in the following ways –

i) Classify the Goods and Services :

The Administrative Authority may make the classification of goods and services.

ii) Publish Alphabetical Index :

Administrative Authority may publish, the alphabetical index of the classification of goods and services.

iii) Grant or Refuse Trade Mark :

- The Administrative Authority may grant to register the Trade Mark, or may refuse to register the trademark.

iv) Correct or Amend the Register :

- The concerned Administrative Authority may correct or amend the Register.

v) Remove / Review / Restore – registration :

- The concerned Administrative Authority may remove, review, or restore registration.

vi) Assign and Transmit Registered Trademark :

- The Administrative Authority may assign and transmit registered trademark.

vii) Registration of Assignment and Transmission :

- The Administrative Authority may register the assignment and transmission of registered trademarks.

[III] Passing Off :

- Passing off action, is a common law remedy, available to the proprietor of an unregistered Trade mark.

Passing Off,

- Means, a person tries to pass off his goods or business, as that of the goods or business of another person, by whatever means, so that, the result may be achieved.

“No man is entitled to represent that, his goods are the goods of another man, and no person is permitted to use a mark, whereby without making a direct false representation to the purchaser, he thereby, lies to the customer”.

Case Law :

Singer v/s. Loog –

- The basis of passing off action is false representation.

- The object of passing off action, is to restrain a trader from passing off his goods, as and for, the goods of another trader.

- The basis of such an action, is the deception and false representation by the defendant, in regard to the trade origin of the goods.

How Passing – Off may be done ?

Passing off may be done by, –

1) Direct false representation.

- 2) Adaptation of a trademark which is the same, – or colourable imitation of the trade mark of the rival traders.
- 3) Adaptation of an essential part of the rival traders name.
- 4) Copying the colour scheme of the label.
- 5) Imitating the design or shape of goods.

Purpose of test of passing off :

- The purpose of test of passing off, is to protect commercial goodwill, – to ensure that people’s business reputation is not exploited.

Essential characteristics which must be present :

In order to create a valid cause of action of passing off, Justice, Loog Diplock, in Advocates Case, has spelt out the essential characteristics in the following Case

Case Law :

Warnik v/s. Towned –

1. Misrepresentation;
2. Made by a person in the course of trade;
3. To prospective customers of his, or ultimate consumers of the goods or services supplied by him;
4. Which is calculated to injure the business or good will of one trader;
5. Which causes actual damage to the business or good will of one trader by whom the action is brought.

[IV] Distinction between Passing Off and Infringement of Trade Mark :

Infringement Action	Passing Off
<ol style="list-style-type: none"> 1. An action for infringement is a statutory remedy, conferred on the registered proprietor of Registered Trade Mark. 2. Defendant must use the infringing mark on the same goods for which the plaintiff’s mark is registered. 3. If marks are identical or deceptively similar to it, – no further proof is 	<ol style="list-style-type: none"> 1. An action for passing off is a common law remedy, – based on an action for deceit. 2. Defendant’s goods need not be same, – it may be allied or even different. 3. Identical or similarity of marks, not sufficient, – the use of the mark must be likely to deceive or cause confusion. 4. Use of mark by defendant, must be likely to cause injury or damage to the plaintiff’s good will. 5. Use of plaintiff’s trade mark not essential – use of get up, colour scheme,

<p>required.</p> <p>4. Use of the mark by the defendant, – need not cause any injury or damage to the plaintiff.</p> <p>5. Use of the registered trade mark or mark similar to it – necessary and sufficient to constitute infringement.</p> <p>6. Applies only to goods.</p> <p>7. Based on property acquired by registration of Trade Mark – use of mark not relevant.</p> <p>8. If the defendant shows that, he has additional matter to indicate a different trade source – not material – He will be liable, if he has used the trademark of the plaintiff.</p> <p>9. Infringement need not necessarily lead to passing off.</p>	<p>shape of goods, trade name etc. – sufficient. – passing off can be committed orally also.</p> <p>6. Applies to any business or professions or services.</p> <p>7. Based on property in goodwill acquired by use of the mark – Registration not relevant.</p> <p>8. The defendant may set off the plaintiff's objection – by trade mark not essential, – use of get up, colour scheme, shape of goods, trade name, etc. sufficient. Passing Off can be committed orally also.</p> <p>9. Applies to any business or professions or services.</p> <p>10. Based on property in goodwill acquired by use of the mark – Registration not relevant. The defendant may set off the plaintiff's objection, by showing that he has added matter clearly distinguishing the defendant's goods from the plaintiffs.</p> <p>11. Passing off, by use of mark, need not necessarily lead to infringement.</p>
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Difference Between Infringement and Passing Off :

1. Remedy :

- An action for infringement is a statutory remedy.
- An action of passing off is a common law remedy.

2. Applicable to :

- An action for infringement is applicable to Registered Trade Mark.
- An action of passing off is applicable to Unregistered Trade Mark.

3. Goods :

- The defendant must use the infringing mark on the same goods on which the plaintiff's mark is registered.
- The defendant's goods need not be the same, they could allied or different.

4. Use of Identical or Similar Mark :

- In infringement, the Marks are identical or deceptively similar, it constitutes infringement – nothing further needs to be proved.
- In Passing off, the marks used may be identical or similar, but still further proof is required to show that, the use of the mark is likely to deceive or cause confusion.

5. Terms :

- Infringement action applies only to goods.
- Passing off action applies to any business, or profession, or services.

6. Based on :

- Infringement action is based on property acquired by registration of Trade Mark – and the use is not relevant.
- Passing off action is based on property acquired by good-will by use of the Trade Mark.

7. How it takes place :

- An infringement takes place, by use of the registered Trade mark or a deceptively similar mark by unauthorised person.
- A passing off takes place, when the defendant uses get up colour scheme, shape of goods, so as to pass off his goods as that of another.

8. Additional Matter :

- In infringement, if the defendant shows that, he used additional matter to the registered Trademark, so as to indicate a different trade source, – it is irrelevant, and he will yet be held liable.
- But in passing off, the defendant may set off the plaintiff's objection by showing that, he used additional matter to clearly distinguish the goods from that of the plaintiff's.

9. Need not Lead to :

- Infringement need not, necessarily lead to passing off.
- Passing off by use of mark need not, necessarily lead to infringement.

10. Injury :

- In Infringement – the use of the registered Trademark by the defendant, need not cause any injury or damage to the plaintiff; In passing off, the use of the mark by the defendant, should be likely to cause injury or damage to the plaintiff's good-will.

CHAPTER – IV

“OFFENCES AND PENALTIES”

[A] Nature of offences (Sections 101 & 102) :

- There are certain criminal offences relating to trade marks, trade description, etc. which are punishable with imprisonment, or fine or with both.

The following is the list of such offences :-

- i) Falsifying a trade mark.
- ii) Falsely applying a Trade mark to goods or services.
- iii) Making or possessing instruments for falsifying trade marks.
- iv) Applying false trade description to goods.
- v) Applying false indication of country of origin.
- vi) Tampering with an indication of origin, already applied to goods.
- vii) Causing any of the above acts.
- viii) Selling goods or possessing or exposing for sale of goods, falsely marked.
- ix) Removing piece goods, cotton yarn and threads from the factory, before stamping certain particulars like length, weight, counts, etc.
- x) Falsely representing that, a Trade mark is registered, when actually it is not registered.
- xi) Improperly describing a place of business, as connected with the Trade Mark office.
- xii) Falsification of entries in the Registrar.

Onus of proof :

- The Onus of establishing the criminal liability of the accused is on the prosecution.

- But, when the accused pleads that, he acted innocently, or without intent to defraud, or sets up any other defence, – the burden of proof is on him.

- A master is held liable for the acts done by his servants in the course of employment.

(B) Penalties :

[I] Penalty for applying false Trade marks, trade descriptions, etc.

(Section 103) :

Any Person who, –

- 1) Falsifies any trade mark;
 - 2) Falsely applies to goods or services, any trade mark;
 - 3) Makes, or possesses any instrument like dyes, block machine, plate used for falsifying a trade mark;
 - 4) Applies a false trade description, to goods or services;
 - 5) Applies false indication of country of origin;
 - 6) Tampers with an indication of origin, already applied to any goods;
 - 7) Causes any of the above mentioned things,
- Shall, unless he proves that, he acted without intent to defraud
- be punished from 6 months which may extend upto 3 years, and shall also be held liable to fine from Rs. 50,000/- to Rs.2,00,000/-

Provided that : The Court may, for adequate and special reasons to be mentioned in the judgment, - impose a sentence of infringement for a term less than 6 months, or a fine less than Rs. 50,000/-.

[II] Penalty for selling goods or providing services to which false trade mark or false trade description is applied (Section 104) :

- Any person who sells goods, or possesses or exposes for sale goods falsely marked, shall be punished with imprisonment for 6 months up to 3 years, and shall also be held liable to fine from Rs. 50,000/- up to Rs. 2,00,000/-.

Provided:

The Court may reduce the sentence of imprisonment, and reduce the fine for special reasons to be recorded.

The accused may prove that, -

- 1) At the time of commission of the alleged offence, he had no reason to suspect the genuineness of the trade mark or trade description; or
- 2) That he gave all information to the prosecutor, regarding the person from whom he obtained such goods.
- 3) That otherwise, he had acted innocently.

[III] Enhanced penalty on second or subsequent conviction :

Any person, who has already been convicted under Section 103 or Section 104, and thereafter, if he is again convicted -

Punishment : Imprisonment of minimum 1 year upto 3 years, and fine minimum Rs. 1 Lakh upto Rs. 2 lakhs.

Provided :

The Court can reduce the punishment or fine, for adequate reason to be recorded in the judgment.

Provided :

A conviction made before the commencement of the Act, will not be considered.

[IV] Penalty for removing piece goods (Section 106):

If any person removes, or attempts to remove for sale, any piece goods, cotton yarn, or thread from the factory before stamping certain particulars like length, weight, etc.

Punishment : Such goods will be forfeited to the Government, and such person shall be punishable with fine, which may extend Rs. 1,000/-

[V] Falsely Representing a Trade mark as registered (Section 107) :

Falsely representing that a trade mark is registered, is an offence for which the punishment is upto 3 years, or fine, or both.

[VI] Improperly describing a place of business as connected with the Trade Marks office (Section 108) :

- Imprisonment up to 2 years, or fine, or both.

[VII] Falsifying entries in Register (Section 109) :

- Imprisonment upto 2 years, or fine, or both.

(C) Defences :

Defences available to the accused are, –

1. He may Deny allegation made by the prosecution.
2. He has Acted without intent to defraud.
3. Use of Mark by him was Permitted under the Act or under any other law in force.
4. He Acted under a mistake of fact or that he had no knowledge that, the trademark in question belonged to any particular person – provided the defendant had taken all reasonable precautions.
5. He otherwise Acted innocently.

(D) Persons exempted from punishment :

- In committing an offence, apart from the trader who is interested in making profit by the commission of the offence,
- Other persons like printers and block makers may be involved who have no intention to commit the offence, but are employed by the trader to manufacture the offending labels or other instruments for the commission of the offence,
- Such person may be acquitted, if he proves –
 - 1) That he is a person, who in the ordinary course of his business, is employed by other persons to apply trade marks or trade description or to make dyes, blocks or other instruments for making trademarks.

- 2) That in the particular case, - he was not interested in the goods.
- 3) That he has taken reasonable precautions, and he had no reason to suspect the genuineness of the trademark.
- 4) That on demand by the prosecutor, - he gave all information required.

(E) Offences by Companies :

- If the offence is committed by a Company, - the Company, as well as, every person responsible to the Company for the conduct of its business at the time of the commission of the offence, will be deemed to be guilty of the offence, and liable to be proceeded against.

- If the person accused, however, proves that the offence was committed without his knowledge, or that he had exercised due diligence to prevent the commission of such offence, - he will not be liable to any punishment.

- The protection is not available to any Director, Manager, Secretary of the Company, if it is proved that the offence was committed with his consent or connivance.

(F) Criminal Proceedings :

- If a person copies a Trade Mark of another, whether registered or unregistered, the owner of the mark may file a criminal complaint against the offender.

- 'Mens Rea' is not necessary in order to constitute an offence, however, if fraudulent intention is shown on the part of the accused, it may help the plaintiff in securing the conviction of the accused.

- In offences like, -

i) False representation that a trade mark is registered;

ii) Improperly describing a place of business as connected with trade Marks office;

iii) False entries in Register, the Registrar of Trade Marks alone, can make a complaint.

1) Forfeiture of Goods (Section 111)

- Where a person has been convicted under Section 103, 104 or 105, the Court may direct the forfeiture to the Government, of all goods and things concerned.

- An appeal lies against conviction, as well as, forfeiture.

2) Jurisdiction of Courts :

- No Court, inferior to that of a Sessions Judge, Presidency Magistrate or Magistrate of 1st Class, has power to try an offence relating to Trade Mark or false trade description.

- The complaint should be lodged in the Court, within whose territorial jurisdiction, the offence was committed.
- Offences relating to Trade marks, are bailable, but not compoundable.
- The criminal complaint may be filed simultaneously, along with a suit for infringement, in a Civil Court, or a passing off action, in a Civil Court.

(G) Importation of goods bearing false trade Mark:

- The goods bearing false trade mark, are prohibited from being imported into India under the Customs Act, and if imported, then they are liable to detention or confiscation.
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CHAPTER – V

“REGISTRATION OF TRADEMARKS”

Registerability of Trade Marks :

[A] Basic Qualification for Registerability of Trade Mark –

- 1) Capable of being represented Graphically.
- 2) Capable of distinguishing the goods or services of one person, from those of others.

[B] Marks not Registerable –

There are five categories of such marks, which are not registerable. They are as under –

1) Will deceive the public or cause confusion :

- A mark by its very nature, which will deceive the public or cause confusion amongst public.

2) Mark likely to hurt religious feelings :

- A mark which is likely to hurt religious feelings of any section of the people of India.

3) Obscene / Scandalous Marks :

- A mark, which contains scandalous or obscene matter.

4) Prohibited under Emblems Acts :

- A mark, the use of which, is prohibited under the Emblems and Names (Prevention of Improper Use) Act – 1950.

5) Shape of goods purely functional or which results from the nature of goods themselves :

- The shape of goods, which are purely functional or necessary to obtain technical result or which gives substantial value of goods.

[C] Registration can be refused on certain grounds:

There are two categories of grounds on which, registration can be refused. They are –

- i) Absolute grounds of Refusal;
- ii) Relative grounds of Refusal.

(1) Absolute grounds of Refusal :

The following three circumstances, are considered to be absolute grounds for refusal of registration. They are –

a) A trade mark which is not capable of distinguishing goods or services of one person, from those of others.

b) A Trade mark which indicates quality or other descriptive character of goods or services.

c) A Trade mark which has become customary invention current language, or invention the *bona fide* or established practice of trade.

- This may relate to generic names or marks, common to the trade.

(2) Relative Grounds :

a) A mark, which is identical or similar to an earlier Trade mark, and the respective goods or services are identical or similar.

b) A mark, which is identical or similar to an earlier Trade mark, and the respective goods or services are not identical or similar.

CHAPTER - VI

"PROCEDURE FOR REGISTRATION AND EFFECTS OF REGISTRATION"

- (A) Procedure and Duration of Registration of Trade Mark : (Ss: 18 to 26);
(B) Effect of Registration (Ss. 27 to 36).

[A] Procedure and Duration of Registration of Trade Mark : (Sections 18 to 26) -

1) Who may Apply ?

- Any person claiming to be proprietor of trade mark, used or proposed to be used by him.
- The application may be made in the name of an individual, partners of a Firm, a Corporation, any Government department, a Trust or Joint applicants.

2) Procedure -

- The person may apply to the Registrar, in writing in the prescribed manner, for registration of trade mark.
- The application must be filed in the office of Trade Mark Registrar, within whose territorial limits, the applicant's principal place of business is situated.
- A single application can be made for registration of trademark for different classes of goods or services, and the fee payable shall be in respect of each class of goods or services.

3) Preliminary Advice and Search -

- Before or after applying for registration, the applicant may apply for a report, as to whether the mark, or one similar to it, has already been registered or applied for.
- He may also request for the Registrar's opinion, as to the distinctive character of the mark.
- However, the Registrar's search report or opinion, is not binding on him.

4) Search, Examination and Objections -

- On the receipt of the application, a search is made amongst the registered trademarks, and amongst pending applications for the purposes of ascertaining whether there is on record, any Trade Mark identical with, or deceptively similar to the mark sought to be registered.

- The application is also examined to see that, it complies with all the requirements of the Trade Mark Act, 1999, and the Trade Mark Rules, 2002.
- The Registrar will cause the application to be examined, and communicate to the applicant, any objection to the mark which mainly relates to distinctive character and similarity with already registered marks.
- Upon examination, the Registrar may refuse the application, or accept it subject to such amendment, modification, conditions or limitations, as he may think fit; And he has to record in writing, the grounds for such refusal or conditional acceptance –
 - i) He may accept the application, unconditionally.
 - ii) The acceptance may be withdrawn, if the application has been accepted in error, or if the trade mark should not be registered, or if registered subject to conditions or limitations or subject to condition or different from those of conditional acceptance.

5) Discretion of Registrar –

- The discretion has been vested in Registrar for protection of the interests of the general public.
- The Registrar has to observe the following facts, before acceptance of application for registration –
 - a) Claim of honest concurrent user;
 - b) Deception or confusion occurring by reasons of rival marks;
 - c) Distinctiveness of marks as to goods or services.
 - d) Proprietary mark.

Case Law :

“Sharp” Japanese Case –

In this Case, –

- Goods of a Japanese firm, having trade mark of “Sharp” in Japan, and never having this trade mark in the Indian market. Japanese firm agrees to supply Kits of transistor radio to India. The Indian firm assembled Kits in India, and marketed final goods as its own goods.
- Even prior to agreement, Indian firm used trade mark ‘Sharp’ for certain of its goods.
- It was held by the Court that, Indian firm acquired proprietary right to Trade mark ‘Sharp’ and was entitled to registration.
- The Registrar can decide matters on Affidavit evidence. The onus in the first place, is on the applicant to show that, he is within law prima facie and he has not infringed Sections 18 to 24 of the Trade Marks Act, 1999.
- It is only when he has discharged the primary onus, that the application can be accepted by the Registrar. After advertisement, the burden lies on the opposer.

- If the application is accepted, it will be advertised in the Trade Mark Journal.

6) Advertisement –

- The Registrar shall cause the application advertised in the prescribed manner, as accepted together with the conditions or limitations, if any.

7) Duration and Renewal –

- Basic Trade Mark can be granted for 10 years, thereafter, it will continue till renewal.

[B] Effects of Registration (Sections 27 to 36) :

It gives the following two rights, –

1) The exclusive right to use the Trade mark, in relation to the goods or services for which it is registered.

2) The right to take action, in case of infringement against those who might be infringing it by using it, or a deceptive similar trademark in relation to their goods or services.

- If trade mark is not registered, no action for infringement can be taken on the basis of trade mark.

Registration of Trade Mark has the following effects :-

1) It confers certain rights to the registered proprietor to use it exclusively for his own benefit.

2) It is *prima facie* evidence of validity.

3) It is protected on the ground of Distinctiveness.

4) Acquiescence, effect of.

5) Proprietor not to interfere with vested rights.

6) Proprietor not to interfere with *bona fide* use of name, address or description of goods or services.

7) Validity of registration not affected by words used as name or description of an article.

CHAPTER – VII

“REMOVAL AND CANCELLATION”

[I] The Trade Mark can be removed from the Register on the following grounds :-

1) Non use – for 5 years :

- The registration may be cancelled, only after the uninterrupted period of at least five years of non use of the trademark. Use can be in any form or way, and does not necessarily mean and imply actual physical sale.

- Even, mere advertisement without the production of goods, can be said to be use of the mark.

2) No *Bona fide* Intention to use the Trade Mark :

- Mere recital of intention to use the trade mark is not sufficient. Actual use necessary, *Bona fide* has to be made out.

- If the proprietor intends use of trade mark by a Company, he must register the Company and start use of it. If this is not done, then trade mark can be removed.

3) No *Bona fide* Use –

- If the primary purpose is not to trade under the mark, but to validate the registration, the use is not *bona fide*.

4) Non Use is not Due to Special Circumstances in the Trade –

- If the non-use is not due to special circumstances of the trade, not only of the trader only; But circumstances are special, peculiar or abnormal and which are experienced by all persons in the trade i.e. external factor and not voluntary act of registered Trade mark holder.

5) Intention to Abandon the Trade Mark –

- The intention must be to abandon the use of trade mark which must be evident, and there is no possibility of any future use of the trade mark.

6) Non Use and the Uruguay Round –

- The registration can be cancelled, only after an uninterrupted non use for 3 years without valid reason.

- The valid reason can be, import restriction or other Government requirement for goods or services protected by the Trade mark.
- When the registered owner retains control, and uses the trade name by another person, it does amount to non-use.

[III] The registration can be cancelled on the following grounds –

- 1) The registered user has used the trade mark otherwise than by way of permitted use, or in such a way, as to cause or likely to cause deception or confusion.
- 2) The proprietor or the registered user has misrepresented or failed to disclose some facts, material to the application for registration.
- 3) Changed circumstances, which would have justified the refusal of application for registration of the registered user.
- 4) Any stipulation in the agreement between the registered proprietor and the registered user, regarding the quality of the services or goods, are not enforced or followed.
- 5) The Trade mark is no longer in use.
 - The Registrar must give Notice and Hearing to the affected parties before taking any action of Cancellation.

CHAPTER – VIII

“INFRINGEMENT – CIRCUMSTANCES”

The Infringement of Trade Mark may take different Forms :

They are as under –

- a) It may be by using of Marks identical or similar to the trademark by unauthorised persons in relation to the similar or same trade.
- b) It may be by using identical or similar marks which are like those of registered trademarks in non-similar or different trades, would also amount to infringement.
- c) It may be by advertising the registered trademark of another, to promote one's trade, is also infringement.
- d) Where the distinctive elements of a registered trademark consist of words, the trademark may be infringed by the spoken use of those words, as well as, by their visual representation.

1] Using a Deceptively Similar Mark :

A person may use a mark which is deceptively similar to registered trademark, – and that act itself amounts to infringement.

The deception or confusion may be, –

a) As to the Goods or Services themselves :

Here, a person may buy the goods seeing one mark, thinking that it is a brand, which is in his mind, which in fact may not be the same.

This is the most common type of confusion or deception.

b) As to the Trade Origin :

Here, a person looking at a Mark, may buy the goods thinking that it is coming from the same source as some other goods having a similar mark with which he is familiar.

c) As to Trade Connection :

Here, a person looking at the mark may not think that it is the same with that brand which is in his mind, – but the similarity may make him believe that the two are, in some way or the other, connected with each other.

Case Law :

Lakme v/s. Subhash Trading Co. –

- The defendant was using the trademark “Like-me” which was similar to “Lakme”
- Both the Companies dealt in the same cosmetic products.
- Phonetically, both sounded the same.

Court held it to be deceptively similar, and likely to cause confusion.

***Sai Agencies v/s. Rama Rao* –**

Trademark was “Mathura Ghee” and the defendants have used trademark “Mathurag Ghee”.

Court held it to be deceptively similar, likely to cause confusion.

***Cox Distillery v/s. M’cDowell and Co.* –**

Trademark was “Cox Diplomat Premium Whiskey” and the defendants have used trademark “Diplomat”.

Court held it to be deceptively similar likely to cause confusion, and amounts to infringement of the plaintiff’s trademark.

***P.M. Diesel v/s. S.M. Diesel* –**

Trademark was “Field Marshal”, and the defendants have used trademark “Sona Marshal” pertaining to the same product, i.e. diesel engines.

Court held it to be deceptively similar, likely to cause confusion, and amounts to infringement of the plaintiff’s trademark.

[2] Taking Substantial Features of a Mark :

- Taking substantial features of the mark already registered and in use – would amount to infringement.

[3] Using Plaintiff’s Mark on Reconditioned Goods:

- Would amount to infringement

[4] Printing of Labels :

- Printing of labels of the plaintiff without authorisation – would amount to infringement.

[5] Using the Registered Trademark – along with a Name, other than that of the registered proprietor :

Using the registered trade mark – along with a name, other than of the registered proprietor, would amount to infringement.

[6] Copying a Trademark :

Copying a Trade mark, amounts to infringement.

- In all the above cases, the actual deception need not be proved – what is required is, the likely-hood of deception.

CHAPTER – IX

“POWERS AND DUTIES OF REGISTRAR”

Every person appointed under the Trade Marks Act, and every member of the Appellate Tribunal is a “public servant” within the meaning of Section 21 of the Indian Penal Code, 1860.

Powers and Functions of the Registrar :

I) Power of a Civil Court –

- The Registrar shall have the powers of a Civil Court for the purposes of, –
 - 1) Receiving evidence.
 - 2) Administering oaths.
 - 3) Enforcing the attendance of witnesses.
 - 4) Compelling the discovery and production of documents.
 - 5) Issuing commissions for the examination of witnesses.

II) Can pass order for costs –

- Registrar can pass an order for costs as he considers reasonable, and his order is executable as a decree of the Civil Court.

III) Power to review his own decision –

- The Registrar can review his own decision, if he deems it just and fair in the interest of justice.

IV) Discretionary Powers –

- The Registrar has to exercise his discretionary powers under the principles of Natural Justice, i.e. due notice to the other side, hearing, reasoned order, etc.

V) Can receive evidence on Affidavit or Oral evidence –

- Generally, evidence is received by way of affidavit.
- But, the Registrar has power to call for oral evidence in lieu, or in addition to evidence by affidavit.

VI) Power to bring Legal Heirs on record –

- The Registrar has got power to bring the legal heirs or legal representatives on record, on the death of the contesting parties to the proceeding.
- If the Registrar is of the opinion that, the surviving parties can safe-guard the interests of the deceased, – then the Registrar may not bring the legal heirs on the record.

VII) Power to Grant Time –

- The Registrar has the power to grant time (i.e. extension of time) to any party to perform any acts.

VIII) Power to allow the applicant to Amend the Application –

- Where in the opinion of the Registrar, an applicant is in default in processing the application, –

- The Registrar may, by notice, require the applicant, if he so desires, to amend the application.

- The Registrar can even abandon the application, after giving an opportunity of being heard – unless the default is remedied within the time specified in the Notice.

IX) Preliminary Advice by Registrar as to Distinctiveness –

- When an application is made to the Registrar for registering a Trade Mark, –

- The Registrar can give an advice to the applicant, as to whether the Trade Mark appears to him “Prima facie”, to be distinctive.

- The Registrar may give the advice within 3 months in the affirmative.

- But on further investigation, if the Registrar raises any objection to the distinctiveness, – then the Registrar shall refund the fees paid by the applicant.

X) Register and Index under the Control of Registrar –

- The Register of Trade Marks and the Index, are under the control of the Registrar.

- These documents are public Documents, and can be inspected by the public on payment of the inspection charges.

- A certified copy of the document will be given by the Registrar on the payment of fees; and the certified copy is a proof of the contents of it.

CHAPTER – X

“ASSIGNMENT AND TRANSMISSION”

[1] Scope of Assignment or Transmission (Sections 37 to 45) :

- A registered Trademark can be assigned or transmitted whether with or without the good-will of the business concerned.

- Under the Trade Marks Act, 1999, an unregistered Trademark is also assignable or transmissible with or without the good-will of the business concerned.

- Certain restrictions on assignment or transmission are imposed to prevent the creation of multiple exclusive rights.

- Where the assignment is without the good-will of the business, special conditions are imposed.

They are as under –

i) Associated Trade Marks can be assigned or transmitted only as a whole.

ii) Certification Trade Marks cannot be assigned or transmitted without the consent of the Registrar of trademark.

iii) An assignment of Trade Mark must be in writing.

- No specific form has been prescribed.

- Transmission means, transmission by operation of law – it devolves on the personal representative of a deceased person.

- The law relating to transmission of a Trademark is the same as that of assignment.

- Sale and transfer of good-will of business, will transfer to the purchaser/transferee – the Trademark used in the business by implication, even if the Trademarks are not specifically mentioned in the deed of assignment. This is because a Trademark is a part of the good-will of the business.

[2] Assignment of an unregistered Trade Mark (Section 39) :

- An unregistered Trade Mark can be assigned with or without the good-will of the business concerned.

- If an unregistered Trade Mark which has been used is assigned without the good-will of the business – the assignee will not be able to protect the trademark.

- Since, in the absence of the good-will of business, – no action for passing off will lie. However, a criminal prosecution may be available.

[3] Restrictions on Assignment and Transmission (Ss. 40 & 41)

- Assignment or transmission, should not result in the creation of concurrent exclusive rights in more than one person, to use the same mark or similar mark in

respect of the same or similar goods or services – if such would be likely to deceive or cause confusion.

- Confusion or deception can be avoided, by territorial limitation or the limitation of the goods.

- Confusion or deception can be avoided, if conditions are imposed to prevent use within India, except for export to other countries.

- Where the proposed assignment is likely to create multiple exclusive rights, – the proprietor of the registered trade mark may submit to the Registrar, a statement of case, setting out the circumstances, and the Registrar may issue a Certificate stating whether the proposed assignment would or would not be valid.

- If the Certificate is in favour of the assignment, – an application for registration of the assignment should be made within 6 months from the date of issue of the certificate.

- Assignment or transmission which would create exclusive right to use mark in different parts of India – is not permitted. In such a case, the proprietor of the mark may apply to the Registrar for approval of the proposed assignment or transmission.

[4] Assignment without goodwill of business :

- In case of an assignment of a Trade mark, whether registered or unregistered – without the goodwill of the business, – the assignment will not take effect, unless the assignee advertises the assignment in newspapers in accordance with the direction of the Registrar.

- The purpose of the advertisement is to give notice of the assignment to the public.

- Advertisement may be necessary, only where the mark has been in use. In case of unused Trademark, since no public confusion would follow their assignment, advertisement may not be necessary.

[5] Registration of Assignments and Transmissions :

- The procedure for entering the name of the subsequent proprietor of the Trademark, because of assignment or transmission is contained in Section 45.

- An application for registration of a subsequent proprietor, should be accompanied by proof of the title of the Mark. This may be in the form of a deed of assignment, deed of partnership or dissolution or any other document or transmission is necessary to establish title to the registered Mark.

- A document which is not registered, is not ordinarily admissible as evidence of the title to the Trademark by assignment or transmission, unless the Registrar or Appellate Board otherwise directs.

Full Questions and Short Notes on**"Trade Marks Act, 1999"****Full Questions –**

- 1) Explain the procedure for the registration of trademarks under the Trademarks Act, 1999. (April, 2004; Nov. 2004; April, 2009; Nov. 2009; April, 2011).
- 2) Explain the procedure for registration of trademark and its renewal under the Trademark Act, 1999. (April, 2008).
- 3) Discuss the procedure for the registration of trademarks. What are the effects of registration? (Nov. 2011; May, 2012).
- 4) Explain the various circumstances in which registered trademarks can be removed from the Register of Trademarks. (April, 2004; Nov. 2004).
- 5) What amounts to an infringement of a Trademark? (Nov. 2008).
- 6) What is the distinction between an "infringement action" and "passing off action"? Discuss the issues involved, and the nature of relief which can be granted or sought for, in the said two actions. (April, 2004; Nov. 2004; Nov. 2010)
- 7) What is the distinction between an "infringement action" and "passing off action"? Discuss the issues involved, and the nature of relief which can be granted or sought for, in the said two actions. (April, 2004; Nov. 2004; May, 2014; Nov. 2016)/What is Passing Off? Distinguish between Infringement and Passing Off? (Nov. 2017).
- 8) Explain the meaning of "Permitted use" and "Registered user" under the Trade Marks Act, 1999. State the provisions regarding Registered Users of a trademark. (April, 2004).
- 9) What is a Trade mark? How can a person become a proprietor of a trademark? How can a proprietor of a trademark protect his mark? (Nov. 2004).
- 10) What is a Trademark? What are the qualities of a good Trademark? Explain the trademarks which cannot be registered. (Nov. 2010).
- 11) State the effect of registration of Trademark under the Trade Marks Act, 1999. (April, 2005; Nov., 2005)
- 12) Discuss the grounds for refusal of registration of a Trademark under the Trade Marks Act, 1999. (Nov. 2005; April, 2006; April, 2007; Nov., 2007; April, 2009; Nov. 2010; Nov. 2014)
- 13) What is Trademark? Discuss the various grounds of refusal of registration of trademarks. (May, 2013; May, 2015; Nov. 2015; May, 2016).
- 14) Discuss the relative grounds for refusal of registration under the provisions of the Trade Marks Act, 1999. (Nov. 2008).

- 15) State the absolute grounds for refusal of registration of a Trademark under the Trade Marks Act, 1999. (May, 2006; Nov., 2006; April, 2007; Nov. 2007; Nov. 2016; May, 2017).
- 16) Explain the provisions relating to "Assignment and Transmission" under the Trade Marks Act. (April, 2010).
- 17) Distinguish between trademark and Copyright. What are the advantages of registering them. (April, 2010).
- 18) Who can file the suit for the infringement of a trademark? What are the defences available to the defendant? What reliefs can the Court pass in a suit for infringement? (Nov. 2011; December, 2012; Nov. 2016).
- 19) Explain the defences available to the Defendant in the suit for infringement of Trademark. (May, 2014).
- 20) What are the various forms Trade Marks? What are the qualities of good Trade Mark? (Nov. 2017).

Short Notes –

- 1) Certification of Trade Mark. (April, 2004; May, 2006; May, 2017).
- 2) Qualities of a good trademark. (Nov. 2014; May, 2015; May, 2016).
- 3) Registered User under the Trade Marks Act, 1999. (April, 2005; Nov., 2005).
- 4) Assignment of Trade Marks. (Nov. 2005; April, 2008).
- 5) Collective Trade Mark. (April, 2005; Nov., 2005; Nov., 2007; April, 2010; Nov. 2011; May, 2012; Nov. 2017).
- 6) Passing Off Action. (April, 2006; April, 2011)
- 7) Certification of Trademarks. (April, 2006)
- 8) Meaning and Purpose of Trademarks. (Nov., 2006).
- 9) Rights conferred by registration of trademarks. (April, 2007).
- 10) Passing Off. (Nov., 2006; Nov., 2007)
- 11) Rights conferred by registration of Trade Marks Act, 1999. (April, 2007)
- 12) Well-known Trademarks. (Nov., 2007; Nov. 2008; December, 2012; May, 2013; Nov. 2016)
- 13) Permitted User. (April, 2009; Nov. 2009).
- 14) Non-user Trademark. (Nov. 2009).
- 15) Functions of Trademark. (May, 2013; May, 2016; Nov. 2017).
- 16) Objectives of trademark law. (December, 2013).
- 17) Prohibition of registration of certain names of chemical elements or international non-proprietary names. (Nov. 2016).
- 18) Ghost marks. (May, 2017).

“PATENTS ACT, 1970”

With

THE PATENTS (AMENDMENT) ACT, 2005 (Act No. 15 OF 2005)

[4th April, 2005]

An Act further to amend the Patents Act, 1970.

BE it enacted by Parliament in the Fifty-sixth Year of the Republic of India as follows
:-

Statement of Objects and Reasons –

The law relating to patents is contained in the Patents Act, 1970 (39 of 1970) which came into force on the 20th April, 1972. This Act was amended in March, 1999 and June, 2002 to meet India's obligations under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), which forms part of the agreement establishing the World Trade Organization (WTO).

(1) The amendments primarily focused on the obligations which came into force from 1st January, 1995 and obligations which came into force from 1st January, 2000.

(2) The first amendment to the Patents Act introduced a transitional facility (“mail box”) from January, 01, 1995 to receive and hold product patent application in the fields of pharmaceuticals and agricultural chemicals till January 01, 2005 and also for grant of exclusive marketing rights (EMRs) for a period of 5 years or till the product patent is granted or patent application is rejected, whichever is earlier.

(3) The earlier amendments had, *inter alia*, provided for the modalities for a ten-year transition facility (which India had negotiated at the of its accession to the WTO (World Trade Organization), commencing from the 1st January, 1995. As a consequence, the law was required to be amended further in respect of India's obligations under the TRIPS Agreement, due from 1st January, 2005.

(4) The President promulgated the Patents (Amendment) Ordinance, 2005 (Ord. 7 of 2004) on the 26th December, 2004.

(5) While considering the third set of amendments to the Act, efforts have been made not only to fulfil our final obligation under the TRIPs Agreement, but also to simplify and rationalize the procedure governing grant of patents so as to make the system more efficient and user-friendly.

Some of the salient features of the Bill (Amendment Act 38 Of 2002) are as under

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- (a) to define the term “invention” in consonance with international practices and consistent with TRIPS Agreement;
- (b) to modify Section 3 of the present Act to include exclusions permitted by TRIPS Agreement and also subject-matters like discovery of any living or non-living substances occurring in nature in the list of exclusions which in general do not constitute patentable invention;
- (c) to align rights of patentee as per Article 28 of the TRIPS Agreement;
- (d) to add provision for reversal of burden of proof in case of infringement suit on process patent in accordance with Article 34 of the TRIPS Agreement;
- (e) to provide uniform term of patent protection of 20 years for all categories of inventions as per Article 33 of the TRIPS Agreement;
- (f) to align the provisions relating to compulsory licensing and to omit provisions relating to licensing of rights;
- (g) to provide provisions relating to parallel import of patented products;
- (h) to make a provision for enabling persons other than patent holder to obtain marketing approval from the appropriate regulatory authorities within 3 years before the expiration of the term of the patent;
- (i) to incorporate measures for protection of bio-diversities and traditional knowledge;
- (j) to provide an Appellate Board for speedy disposal of appeals and rectification of register of patent which at present lie before High Court;
- (k) to amend the provisions relating to national security;
- (l) to amend several provisions of the Act with a view to simplifying and rationalizing the procedures aimed at benefiting users.

“PATENTS” :

The Patents Act, 1970, which is prescribed for the syllabus is discussed under Eight Chapters :

CHAPTER – I

“AIMS AND OBJECTS OF THE PATENTS ACT, 1970”

The salient features of the amendments contained in the said Ordinance (Amendment Act 15 of 2005) are as follows : –

- (a) to introduce product patent protection in all fields of technology (that is drugs, food and chemicals since product patent protection already exists for all other fields), as per Article 27 of the TRIPs Agreement;

- (b) to modify the provisions relating to exclusive marketing rights (EMRs) since these were part of the transitional arrangements;
- (c) to modify and clarify the provisions relating to patenting of software related inventions when they have technical application to industry or in combination with hardware;
- (d) to modify the provisions relating to opposition procedure with a view to streamline the system by having both, pre-grant and post-grant opposition in the Patent Office;
- (e) to introduce a provision for enabling grant of compulsory licence for export of medicines to countries which have insufficient or no manufacturing capacity, to meet emergent public health situations (permissible under paragraph 6 of the Doha Declaration on TRIPs and Public Health);
- (f) to amend and strengthen the provisions relating to national security to guard against patenting abroad of dual use technologies;
- (g) to amend the provisions relating to the Intellectual Property Appellate Board with a view to extending its jurisdiction to revocation of patents also;
- (h) to amend certain provisions with a view to harmonizing them with the Patent Cooperation Treaty to which India is signatory;
- (i) to rationalize the provisions relating to time-lines with a view to reducing the processing time for patent applications, and to simplify the procedure.

[I] Nature of Intellectual Property :

Intellectual property is an intangible, incorporate property.

Intellectual property includes, Patents, Trademark, Copyrights, and Industrial Designs.

Patents : relates to novel products or process of manufacture.

Trademark : relates to word /name /device used in relation to particular goods to indicate the source of manufacture or trade origin of the goods.

Copyright : relates to Literary, Dramatic, Musical, Artistic Works, Cinematograph Films and Sound Recordings.

Patent is also an Intellectual Property, and the Statute Governing it, is "the Patents Act, 1970".

[II] What is Patent ?

A Patent is a Monopoly right granted to a person who has, –

a) invented a new and useful article, or

b) made the improvement of an existing article or a new process of making an article.

Thus, a Patent is granted for :-

- new product invented;
- improvement on an existing product;
- new process for making an article.

It consists of exclusive right to manufacture the new article invented; or manufacture an article to the invented process for limited period.

After the expiry of the duration of Patent, any one can make use of the patented invention or process.

A Patent is a form of industrial property, or as it is now called, intellectual property.

The owner of the Patent –

1. can sell the Patent;
2. he can also grant licences to others to exploit the Patent.

A Patent, being a creation of Statute, is territorial in extent. A Patent granted in one State, cannot be enforced in another State, unless the invention concerned is also patented in that state.

[III] Objects of Patent Law :

Following are the objects of the Patent Law –

1) Encourage and Develop new Technology and Industry :

The object of granting Patent, is to encourage and develop new technology and industry.

2) Induce an inventor to disclose his discoveries :

It induces an inventor to disclose his discoveries instead of keeping them as a trade secret.

An Inventor may disclose the new invention, only if, he is rewarded, otherwise, he may work it secretly.

In consideration of grant of monopoly for a limited period, the inventor discloses the details of the new invention and the method of working it, so that, after the expiry of the monopoly period, others can use the invention or improve upon it.

3) Reward for expenses of developing inventions :

It offers a reward for the expenses of developing inventions, to the stage at which they are commercially practicable.

4) Inducement to Invest Capital :

It provides an inducement to invest capital in new lines of production.

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;

- (la) “**Opposition Board**” means an Opposition Board constituted under sub-section (3) of Section 25;
 - (m) “**patent**” means a patent for any invention granted under this Act;
 - (n) “**patent agent**” means a person for the time being registered under this Act as a patent agent;
 - (o) “**patented article**” and “**patented process**” means respectively an article or process in respect of which a patent is in force;
 - (p) “**patentee**” means the person for the time being entered on the register as the grantee or proprietor of the patent;
 - (q) “**patent of addition**” means a patent granted in accordance with Section 54;
 - (t) “**person interested**” includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;
 - (ta) “**pharmaceutical substance**” means any new entity involving one or more inventive steps;
 - (y) “**true and first inventor**” does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.
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CHAPTER II

"INVENTIONS WHICH CAN BE PATENTED AND WHICH CANNOT BE PATENTED"

[I] Inventions which can be patented :

All inventions are patentable, subject to the exceptions under the Act. Always, in any legal provision, there are certain exceptions. Accordingly, there are certain inventions which are not patentable.

"Invention"

Invention means, any new and useful -

- 1) Art, Process, Method or Manner of manufacture.
- 2) Machine, Apparatus or other Articles.
- 3) Substance produced by manufacture; and includes any new and useful improvement of any of them.

Explanation : A Method or process is a Manufacture, if it -

- i) Results in the production of some vendible product.
- ii) Improves or restores to its former condition a vendible product.
- iii) Has the effect of preserving the vendible product from deterioration.

Ingredients of the definition of "invention" :

Following are the essentials of invention -

- 1) An invention which is new and useful;
- 2) It must relate to a machine, article or substance produced by manufacture or the process of manufacture of an article;
- 3) It must be an improvement of an article or of a process of manufacture.

Allied Provisions :

- 1) The applicant for the patent, must be true and 1st inventor, or a person who has derived title from him, the right to apply for patents being assignable.
- 2) The applicant must give full and sufficient disclosure of the invention, and specify the precise limit of the monopoly claimed.

Example : General products - 14 years.
Specified products - 7 years.

Essential requirements of invention -

Novelty;

Inventiveness;

Utility.

[III] Inventions not Patentable or what are not inventions :
Section 3 –

- Following are the 12 cases of Invention to which Patent right will not be granted

1) Frivolous or Obvious or Contrary to Natural Law :

- An Invention which is frivolous or which is obvious or which claims anything obvious or contrary to well established natural law.

2) Contrary to Morality (Public Health / Law) :

- An invention, the primary or intended use of which would be contrary to law or morality or injurious to public health.

3) Discovery of a Scientific / Abstract Theory :

- The mere discovery of a scientific principle or the formulation of an abstract theory.

4) Method of Agriculture or Horticulture.

5) Invention Relating to Atomic Energy.

6) Mere Discovery of New Property or New use :

- A mere discovery of a new property or a new use of a known substance, or of the mere new use of known process, machine or apparatus, unless such known process results in a new product or employs at least one new reactant.

7) Mere Admixture :

- A substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof, or a process for producing such substance.

8) Mere Arrangement or Rearrangement :

- A mere arrangement or rearrangement or duplication of known devices, each functioning independently of one another in a known way.

9) Method or process of Testing :

- A Method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient, or for the improvement or restoration of the existing machine, apparatus or other equipment, or for the improvement or control of manufacture.

10) Medical Treatment of Humans / Animals / Plants :

- A process of the Medical, Surgical, Curative, Prophylactic treatment (treatment serving to protect from disease, e.g. vaccine) or other treatment of human beings, or any process for a similar treatment of animals or plants to render them free of disease or to increase their economic value or that of their products.

11) Food – Drug – Medicine – No Patent for Substance :

- In respect of food – medicine – drugs, patents are granted for the process of manufacture of the substance, but not for the substance itself.

12) Only Chemical Process – No Patent for Substance :

- In respect of substances produced by chemical process, – patents are granted only for the chemical process of manufacture, but not for the substance itself.

Section 4 : Inventions relating to atomic energy not patentable : –

No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962.

CHAPTER - III

"APPLICATIONS FOR PATENTS"

(PROCEDURE FOR OBTAINING A PATENT)

The procedure to be followed for the grant of Patent under the Patent Act, 1970 :-

[I] Section 6 : Who can make an application ?

In order to obtain a Patent under the Act, any of the following 3 types of persons can make an application -

1. Any person claiming to be true and first inventor of the invention.
2. A Person to whom the right to make an application has been assigned (ie : assignee)
3. The legal representative of either of these two above mentioned persons.

a) Assignment should be in writing :

Here, it may be noted that, an assignment of right for making an application, must be in writing. It should be express and not implied.

b) Joint application :

Sometimes, application is made jointly by the actual inventor and some other person. But, it is a must that, - one of the joint applicant is the original inventor, unless and until, the original inventor is a party to the application, the application is void.

c) Applicant - employee :

If a particular person is an employee of a corporation, firm, or Government, etc.

If A has made a particular invention, can the employer claim to the invention ?

Answer is 'No'.

Employer cannot claim, unless and until, there is a specific agreement to that effect between the employer and employee.

- If the employee is employed only for the purpose of Research in that case, - the employer is entitled for the invention, and can make an application for the Patent of the Invention.

[II] Filing of application for a Patent, accompanied by either provisional specifications or complete specifications :

The application has to be made in the prescribed form and filed in the Patent office, -

- When such application is made by an assignee, he must submit proof of his right to make such an application.

Section 7: Form of application –

S. 7 (1) : Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

S. 7 (3) : Provides that, the application must state the following –

The applicant is in Possession of the invention.

The Name of the owner claiming to be true and first owner. Section 7 (4) provides that every such application should be accompanied by a provisional or complete specifications of the invention.

Section 9 : Provisional and Complete Specifications –

(1) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.

(2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of the opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications :

Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.

(3) Where an application for a patent is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.

Section 10 : Contents of specifications –

(1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

(2) If the Controller so requires, the drawings shall be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification.

- (3) If the Controller considers it necessary that the application shall further be supplemented by a model or sample of anything illustrating the invention, such model or sample shall be furnished, but such model or sample shall not be deemed to form part of the specification.
- (4) Every complete specification shall –
 - a) fully and particularly describe the invention and its operation;
 - b) describe the use and the method by which the invention is to be performed;
 - c) disclose the best method of performing the invention;
- (5) The complete specification should state the claim or claims – defining the scope of the invention for which the protection is claimed.

Why provisional specifications are filed ?

Answer : To get advantage of a prior date of the Patent.

Complete specifications to be filed within 15 months :

- The applicant should file the complete specifications within 15 months after filing the provisional specifications.

[III] Scrutiny of the Application :

- For this purpose, examiners have been provided under the Act.
- They have the responsibility of deciding the validity of the application. Scrutiny may be either formal or substantive.

Formal scrutiny :

- It is ascertained whether the application complies with the prescribed conditions, viz :
 - That the prescribed form of an application is used;
 - Payment of prescribed fees is made;
 - Furnished the particulars prescribed, etc.

Substantive Scrutiny :

It is ascertained whether –

- The matter is an invention, or not;
- The requirements as to the specifications have been complied with, or not.
- This includes a search to determine – prior use, prior claims, prior publication and prior public working.

Two Tests :

- The examiner should examine the test of the definition of the invention. Novelty and Utility – by the National standards; Inventiveness and Non-Obviousness.

[IV] Acceptance of the application and Advertisement of such application in the Official Gazette :

- The examiner submitting his report to the Controller –

1) May Reject the application

- If the report is adverse to the applicant, or requires any amendment to it or to the specifications.

- The Controller, before disposing of the application, informs the applicant about such deficiencies, before the application is disposed.

Section 15: Provides that, the Controller should consider the application, and if the Controller finds that the application or any specification does not comply with the requirements of the Act, he may either –

- i) Refuse to proceed with the application; or
- ii) Require the application, specification to be amended.

- The Controller is also empowered to reject the application, if he finds that –

The invention claimed in the specifications, is not an invention within the meaning of the Act; or

The invention is not patentable under the Act; or

If he is of the opinion that, the invention may be used in contravention of the law.

2) May accept the application and Advertise in the Official Gazette.

- If the Controller is satisfied that, the application is correct and all the specifications are as per the requirements, and all the other requirements have been complied with –

- He may accept the application, and cause the application to be advertised in the Official Gazette – stating that the application has been accepted, giving reasons, and calling for any opposition from any person interested.

[V] Opposition :

Who and on what grounds the grant of patent can be opposed ?

Opposition to be made within 4 months of the advertisement.

Any person interested, may oppose the grant on the following grounds only, and no other, –

- a) Invention unlawfully obtained.
- b) Prior publication in any Indian specifications, or any other document in India or elsewhere.
- c) Prior claim in concurrent application.
- d) Prior public use or public knowledge in India.
- e) Obviousness and Lack of inventive step.
- f) Invention not Patentable under the Act.

- g) Insufficient description of the invention.
- h) Failure to disclose information relating to foreign applications.
- i) In case of convention application, – it is not made within prescribed time.

[VI] Incorporation of name of the Inventor in the Register of Patents :

If there is no opposition to the application, or when the Controller finds that there is no substance in the opposition to the claim of the applicant, – The controller may grant Patent to the applicant.

- Once the Controller has granted a patent to the applicant, it is entered in the Register of patents.
- However, it should be noted that, mere entry in the Patents Register, does not confer any right under the Patent.

[VII] Sealing of the Patent :

When an application has been accepted, and :-

- a) The application has not been opposed within the time limit prescribed (4 months), or
 - b) The application has been opposed, and it has been decided in favour of the applicant, or
 - c) The application has not been refused by the Controller.
- The applicant makes request to the Controller to seal the patent.
 - The request should be made within 6 months from the date of Advertisement of acceptance.
 - However, the delay may be condoned if there are proceedings pending before the Controller himself or before the High Court.
 - On receiving the request, the Controller directs the patent to be sealed with the seal of the patent office, and the date on which the Patent is sealed should be entered in the Register.
 - It may be noted that, – the original period of 6 months may be extended by a maximum of 3 months.

[VIII] Date of Patent :

Section 45 states that – (1) Every patent shall be dated as of the date on which the application for patent was filed. (2) The date of every patent shall be entered in the register.

- Thus, the actual date would be previous date i.e. the date prior to the final disposal of the proceedings.

[IX] Term of Patent :

Section 53 (1) states that subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.

Section 53 (2) states that - a patent shall cease to have 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 or within such extended period as may be prescribed.

CHAPTER – IV

“PATENTS OF ADDITION”

(Sections 54 to 56)

Section 54 : Patents of addition –

- (1) Subject to the provisions contained in this Section, –
where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the “main invention”) and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.
- (2) where an invention being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.
- (3) A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.
- (4) A patent of addition shall not be granted before grant of the patent for the main invention.

Section 55 : Term of patents of addition –

- (1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer :
Provided that if the patent for the main invention is revoked under this Act, the Court, or, as the case may be, the Controller, on request made to him by the patentee in prescribe manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.
- (2) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (1), the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

Section 56 : Validity of patents of addition –

- (1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of –
- (a) the main invention described in the complete specification relating thereto;
 - or
 - (b) any improvement in or modification of the main invention described in the complete specification of a patent of addition, to the patent for the main invention or of an application for such a patent of addition,
- and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been subject of an independent patent.
- (2) For the removal of doubts, it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition, regard shall be had also to the complete specification in which the main invention is described.

CHAPTER - V

"RIGHTS AND OBLIGATIONS OF PATENTEE

LIMITATIONS OF THE RIGHT OF PATENTEE"

[I] Nature of Patent Rights :

- A Patent is a statutory grant conferring certain monopoly right on the grantee for a definite period, subject to certain conditions :

a) a patent grant gives the patentee, the exclusive right to make use of the patented article or use the patented process.

- As a consequence flowing from this, -

b) he can prevent all others from making or using the patented article or using the patented process.

c) a Patentee has also the power to assign the patent.

d) a Patentee can grant licences, or

e) otherwise deal with it for any consideration.

f) he can prevent others from making or using the patented article or patented process. He can take action against others who violate his right of the patent.

[III] Rights of the Patentee :

1) Right to exploit -

- To exploit or make use of the Patent.

- A patentee has the exclusive right to make use, exercise, sale or distribute the patented article or substance in India.

2) Right to use the process -

- To use or exercise the method or process, if the patent is for a process.

- This right can be exercised either by the patentee himself, or by his licensee or by his agent.

- The right of patentee can be exercised during the life of the patent.

- There are two types of patents -

a) Article Patented;

b) Process or method which is Patented.

other points - tenure - medicine and food product 5 years from sealing of the patent; - And in general, 14 years from grant of Patent.

Patent is granted when complete specifications have been fulfilled after filing of application. After specifications are made, then only sealing of a Patent is done.

3) Right to Assign or giving on Licence –

a) – These rights depend on the agreement, on the terms and conditions between the patentee and assignee or licensee.

b) – Sometimes, patent is owned by the proprietor of the patent, there are co-owners or co-proprietors, and when this patent has to be assigned or licensed – then there should be assent from all the co-proprietors.

- If there is some dispute between the joint owners, then under circumstances it is required that the patent has to be assigned or licensed – then it can be done by the controller of Patents.

c) – There are 3 kinds of assignments –

- legal assignment;

- equitable assignment;

- mortgages.

- transmission of patent by operation of law. (when Patentee dies or becomes bankrupt – or Invention case of company when company is dissolved)

d) – Central Government has power to acquire a Patent from Patentee or an Invention which is subject of an application for Patent, from applicant, for public purpose.

4) Right to Surrender –

- No specific reason or ground required.

- Application has to be made to the Controller of Patents.

- Then the Controller will have to advertise that, this particular Patentee wants to surrender his Patent rights.

- Why this procedure is to be followed ?

- To Protect the interest of any 3rd person involved in the Patent.

- After meeting all the objections, the Controller can accept the surrender of the Patent.

5) Right before Sealing –

- In certain cases, application has been made for grant of Patent, provisional specifications have been submitted.

- If the Authority is of the opinion that, the applicant has to use the patent (under emergency), the applicant will have to satisfy the Controller for what purpose or circumstance, he requires that patent immediately.

- The Controller can even grant him to use the patent even before the patent has been Sealed.

- However, he has to give a declaration, that he will fulfill all the specifications within time prescribed.

[III] Obligations of Patentee :

- The possession of a Patent confers on the patentee, not only certain valuable monopoly rights and privileges, but also certain obligations and duties as follows :-

1) Inventions are worked in India on commercial scale –

- Patents are granted, not only to encourage inventions, but also to secure that, the inventions are worked in India on a commercial scale and to the fullest extent that is practicable without delay.

2) Should not unfairly prejudice the interests of the public –

- It is also essential that, the monopoly created by the patent, should not unfairly prejudice the interests of the public.

- If the patent is not used, or the monopoly abused, compulsory licence may be granted to any person who is willing to work the patent, or the patent may even be revoked.

3) Patented products are made available at reasonable price –

- It is an implied responsibility of the patentee to work the patent in India, in such a manner that, the reasonable requirements of the public with respect to the patented invention, are satisfied, and the products of the invention is made available to the public at a reasonable price.

- Failure to discharge this obligation, may amount to abuse of the monopoly granted.

4) Patentee restrained from making unjustifiable threats –

- Further, the patentee may be restrained from making unjustifiable threats of an action for infringement of the Patent.

5) Furnish periodical statements –

- Every patentee and licensee should furnish to the Controller, periodical statements as to the extent to which the patented invention has been worked on a commercial basis in India. Failure to supply such information, is a punishable offence.

[IV] Limitations of the Right of Patentee :

- The right can be used by some other persons without the permission of the patentee under certain circumstances given as under : viz,

1) For use in experiment and research or instruction purpose –

- Any person may, for the purpose merely of experiment or research, or for the purpose of imparting instructions to pupils, make or use a patented article or use a

patented process without the consent of the patentee and without payment of any royalty.

2) Use by the Government –

- Government use of Patent :

Under certain circumstances, Government can make use of patented articles or patented process without the consent of the patentee or without paying any royalty to the patentee.

The Government can acquire for its use, under certain circumstances. This provision is applicable only in certain cases, i.e. medicine, food and drugs (because, these are essential commodities).

- Not only Government can use the patent, but Government can also acquire the Invention on which the patent right is based. The Government may, or may not pay some royalty to the patentee.

Question :

Write a short note on : Compulsory licensing in Patents.

3) Compulsory License –

These provisions are to be complied by a particular Authority.

- Powers have been given to the particular Authority – i.e. the Controller of Patents under the Patent Act.

- **Under what circumstances, compulsory licence has to be granted ?**

If the Patent is not worked, so as to satisfy the reasonable requirements of the public at a reasonable price, the Controller may grant compulsory licence to any other person to work the patent.

- In this case, the Controller can give licence, here the licensee can part with the patent (licence of right), but with the endorsement (permission) by the Controller of patents.

This is called the 'Licence of Right'.

- The Controller will, accordingly, specify the terms and conditions as to what royalty has to be paid to the patentee, etc., according to compulsory licence.

4) Invention for Defence purpose –

If the invention is required by the defence :

- The Controller has a right to grant the use of the patent for defence, without the permission of patentee.

5) Use on Foreign Vessel –

A patent is not deemed to be infringed by the use of the invention in a foreign vessel or aircraft or a vehicle owned by foreign company, which comes into India or its territorial waters temporarily, or accidentally, if it satisfies certain conditions.

6) Limitations on Restored Patents

There are certain circumstances, when Patents can be revoked; but it can be restored by the Controller (Patent can be revoked when fees are not paid).

- When application is made for restoration, then Controller can grant restoration of patent subject to certain limitations.

CHAPTER - VI

"GROUNDS FOR OPPOSITION TO THE GRANT OF PATENT"

(Sections 25 to 28)

OPPOSITION PROCEEDINGS TO GRANT OF PATENTS:

Section 25 : Opposition to the patent—

(1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground—

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document :

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of Section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

- (h) that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge;
- (i) that in the case of convention application, the application was not made within 12 months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;
- (j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- (k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground and the controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.
- (2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely: –
- (a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;
- (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim – (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or (ii) in India or elsewhere, in any other document;
- (c) that the invention so far as claimed in claim of the complete specification in claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;
- (d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim;
- (e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to what was used in India before the priority date of the claim;
- (f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

- (g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
 - (h) that the patentee has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge;
 - (i) that in the case of a patent granted on convention application, the application for patent was not made within 12 months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;
 - (j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;
 - (k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground.
- (3)(a) Where such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.
- (b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submissions of its recommendations to the Controller.
- (c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.
- (4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

Question :

State the grounds of opposition of patents under the Patents Act, 1970. (April, 2009; Nov. 2017) or

Who can oppose grant of patent and on what grounds ? What is the procedure for opposing a patent ? (Nov. 2010; April, 2011)

The Grounds for opposition to the grant of Patent (Section 25

(1) to (4) :

Opposition to the grant of patent may be made, once the Controller has accepted the complete specifications, and it is advertised in the Official Gazette giving reasons for such acceptance.

- It is thrown open to the public to oppose the grant, if there are any reasonable grounds for the same.

- Within 4 months from the date of advertisement of the acceptance of the complete specifications, any person interested, may give notice to the Controller, stating his opposition to the grant of patent:

“Any Person Interested”

“Person interested” includes a person engaged in, or promoting, research in the same field as that of the invention.

Thus, he can establish *locus standi* on the following grounds:

- i) He has in his possession, patents relating to the same subject matter.
- ii) Bona fide manufacturer of an article or based on a similar process as that of the invention.
- iii) Trading interest.

[I] Grounds for Opposition :

An application for a patent may be opposed by any person interested, on one or more of the following 9 grounds, and no other –

- 1) Invention wrongfully obtained.
- 2) Prior publication in any Indian specification, or prior publication in any other document in India or elsewhere.
- 3) Prior claim in a concurrent application.
- 4) Prior public use or public knowledge in India.
- 5) Obviousness and Lack of Inventive step.
- 6) Invention not patentable under the Act.
- 7) Insufficient description of the invention.
- 8) Failure to disclose information relating to foreign application.
- 9) In the case of convention application not made within the prescribed time.

All the above 9 Grounds, on which Application for Patent can be opposed, are discussed in detail as under –

1) Invention wrongfully obtained –

- The invention sought to be patented, must have been obtained wrongfully from the opponent.
- The applicant must have obtained the invention wrongfully from the opponent.
- Even if a part of the invention has been obtained wrongfully, it is sufficient ground for opposition.
- When there is a doubt regarding wrongful obtainment, application should be allowed to proceed, and it may be later revoked by the Court.

2) Prior publication in any Indian specification, or prior publication in any other document in India or elsewhere

- Prior publication of any of the claims in any Indian specification or in any document in India or elsewhere, is a ground of opposition.

- The Prior publication must have been effected before the priority date claimed in the application.

- 'Publication' means, making publicly known, and 'Publish' means, make generally known.

- The publication must be such that the persons to whom the information is communicated, must be free to use it as they please. Thus, where the document was sent from one person to another confidentially, such transmission will not make the document public.

3) Prior claim in a concurrent application -

- If any claim made in the applicant's specification as is claimed in a specification, with a priority date earlier than that of the applicant's claim.

4) Prior public knowledge or public use in India:

- If the invention claimed by the applicant in any claim, was publicly known or publicly used in India before the priority date of that claim, - it is a ground for opposition.

- If the invention claimed is a process, it will be deemed to have been publicly known or used in India, if the product made from the process has been already imported into India before that date.

5) Obviousness or lack of Inventive Step -

- The presence of inventive step is a '*sine qua non*' for any patentable invention, therefore, if any claim for invention is obvious, and clearly does not involve inventive steps, - then it is a ground for opposing the grant of patent.

- However, this question must be decided in the context of any prior publication or public user except secret use.

- In order to succeed on this ground, the claim must have been obvious to a man skilled in the particular art on the priority date of the claim.

6) Invention not Patentable under the Act -

- This ground includes those cases where the patent Act, 1970 has specifically laid down that certain inventions are not patentable.

- There are 12 such cases. They are -

1. Frivolous or obvious, or contrary to Natural Law.
2. Contrary to Law, or Morality, or Public Health.
3. Mere Discovery of a scientific principle or abstract theory.

4. Method of Agriculture or Horticulture.
5. Inventions relating to Atomic energy.
6. Mere Discovery of New Property or use.
7. Mere Admixture.
8. Mere Arrangement or Re-arrangement.
9. Method or Process of Testing.
10. Medical, Surgical, Curative or prophylactic treatment of Humans or Animals or Plants.
11. Food, Drug, Medicine - Patent only for process, not the substance.
12. Chemical Substances - Patent only for the process, not the substance.

7) Invention or Method not sufficiently and clearly described -

- Opposition can also be made on the ground that, the complete specification submitted, does not sufficiently describe the invention or the method by which the same is performed.

- In this, the sole question to be decided is, whether the information given is sufficient to enable a person who is reasonably skilled in a particular field to make an embodiment of the invention.

8) Failure to disclose information relating to Foreign Application -

- The applicant has failed to disclose to the Controller, the information as required under Section 8 of the Act - i.e. the information and undertaking relating to foreign applications, or that he has furnished false information, and it is known to him that he has furnished false information.

- The applicant for patent is required to disclose the particulars regarding any applications in respect of the same invention which he might be processing in foreign country.

9) Convention Application time barred -

- In case of convention application, - the application was not made within 12 months from the date of the first application for the protection of the invention made in convention country by the applicant or a person from whom the applicant has derived the title.

[III] Procedure for Opposition :

- a) It may be pointed out that, a person who desires to oppose the patent, should give notice of such opposition to the Controller as provided under Section 25 of the Patent Act.
- b) Once a notice is given to the Controller, the Controller has to notify the applicant of such opposition, to give him an opportunity of being heard before the case is decided.

- c) If the Controller is of the opinion that, the concerned invention was obtained by the applicant from the opponent, — then he is empowered to direct that the application should be proceeded with in the name of the opponent, as if the application and specification were filed by him (opponent) on the date on which they were actually filed as provided under Section 26 of the Act.
- d) In this connection, it may be pointed out that, the Controller may also refuse to grant patent even without opposition, if he finds that the invention was already published and dated on or before 1st January, 1912.

CHAPTER – VII

“COMPULSORY LICENCES – CIRCUMSTANCES AND GROUNDS”

[I] Object of Granting Patents :

Patent are granted to encourage inventions and to ensure that the inventions are worked in India on a commercial scale, and to the fullest extent that is reasonably practicable without undue delay.

- Patents are not granted merely to enable the patentee to enjoy the monopoly for the importation of the patented articles.
- An obligation is, therefore, imposed on a patentee to work the Patent in India on a commercial scale, and to the fullest extent.
- The patent may be worked by the patentee himself or through licensees.
- Failure to fulfill this obligation will call for the granting of compulsory licences or the revocation of the Patent itself.

[II] Abuse of Patent Rights :

- Abuse of monopoly right granted under a Patent, is a common phenomenon in all countries.
- Abuse can take place in the following ways –
 - i) Meeting the demand for the patented articles – solely by importation from abroad and not manufacturing the patented articles locally, thereby discouraging the establishment of new Trade and Industry.
 - ii) Refusing to grant licences to work the patents locally.
 - iii) Imposing unreasonable terms on the licensees, there by discouraging voluntary licencing.
 - iv) Imposing restrictive conditions on the use, sale or lease of the patented articles, thereby prolonging the patent monopoly right, even after the patent has expired.
- These are the circumstances, and therefore, to remedy this evil a system of compulsory licences by a statutory Authority, and revocation of the patent for non-working, has been adopted in almost all countries including the United Kingdom.

[III] “The Indian Patents Act, 1970” :

- As per the Patent Act, 1970 – The Controller of Patent has the power for granting compulsory licences and revocation of Patents for non-working of the Patents.
- His orders passed in this respect, are appealable to the high Court.

[IV] Types of Licences :

(A) Compulsory Licences :

There are 3 types of Compulsory Licences. They are -

1) When Reasonable Requirements of Public not satisfied :

A Compulsory licence to work a Patented invention, may be granted by the Controller to an interested person on the ground that:

- a) the reasonable requirements of the public with respect to the patented invention have not been satisfied; or
- b) the Patented invention is not available to the public at a reasonable price.

Only after 3 years :

An application for licence under this category can be entertained, only after 3 years from the date of sealing.

2) Causes for failing to satisfy reasonable requirements :

- i) Demand for the Patented articles being met by importation from abroad and not manufacturing the Patented articles, locally, thereby hindering the working of the patent in India.
 - ii) Inadequate manufacture in India or failure to grant licence on reasonable terms - Resulting in prejudice to Indian industry and commercial activities.
 - iii) Imposing restrictive conditions by the patentee - resulting in prejudice to the industry or trade in goods not protected by the patent.
 - iv) Imposing unreasonable terms on the licensees - thereby discouraging voluntary licensing & resulting Invention prejudice to the industry.
- Non-working of the patent on a commercial scale in India.

3) Bonafide interest + Prima facie Case :

The applicant (who wants a licence) must establish that, he has *bona fide* interest and also make out a *prima facie* case.

- When he shows a *prima facie* case, and that he has a *bona fide* interest, - the patentee will be called upon to show cause as to why the compulsory license should not be granted.

- The terms and conditions of the license will be determined by the Controller.

4) Where another patent cannot be worked :

Compulsory license may be granted in respect of a patent, without the use of which, another patent cannot be worked.

5) Central Government notifies that certain for patents, compulsory licence should be granted.

- The Central Government may notify in the Official Gazette that, compulsory licences should be granted in respect of certain patents or classes of patents.
- The Controller will grant a licence to any person interested and who applies for such licence.

Question :

Write a short note on : Compulsory licensing in patents.

(B) Licence of Right :

A patent may be endorsed with the words "Licence of Right" after 3 years from the date of sealing of the patent.

- Where a Patent is so endorsed, – any person who is interested in working of the patented invention, may require the patentee to grant him a licence.
- If the terms of the licence cannot be mutually agreed upon, they will be settled by the Controller.
- Thus, any person may obtain a licence as a matter of right without having to establish a *prima facie* case as in a compulsory licence.

Examples : Patents for invention relating to food and medicine, are deemed to be endorsed with the words "Licences of Right" immediately on completion of 3 years from the date of sealing of the patent.

(C) Revocation for Non-Working :

- It may so happen that, in spite of grant of Compulsory licence or the Endorsment "Licences of Right" having been made, – the reasonable requirements of the public with respect to the patented invention remains unsatisfied, or that the product of the patented invention is not available to the public at a reasonable price.
- In such a case, the patent may be revoked by the Controller of Patents under Section 89 of the Act, on the application made to him, by either the Central Government or any person interested.

CHAPTER - VII

"REVOCATION AND RESTORATIONS OF PATENTS"

Question :

Write a short note on : **Revocation of Patent.**

Answer :

Revocation of Patent -:

[I] General :

A Patent is a kind of limited monopoly, granted to the true and first inventor as a reward for the creation of something new and useful, which might benefit the public.

- Whether the Patentee is the true and first inventor ?
- Whether what he has claimed as invention, is really new, or merely what is already known dressed up in a new form ?
- Whether he has disclosed the invention completely, so that a person skilled in the art, could use the invention after the expiry of the term without employing further inventive skill ?

These are all questions, which can seldom be finally determined at the application stage by the Patent Office.

- The public should, therefore, be given an opportunity to challenge the validity of the grant of Patent, if the patent does not fulfill any of the conditions laid down under the Act for the grant of monopoly.

There are various modes of revocation of a Patent, namely :

1. Revocation of Patent in public interest, by the Central Government.
2. Revocation of Patent relating to atomic energy, by the Controller.
3. Revocation for non-working.
4. Revocation by the High Court, on petition for failure to comply with the requirements of the Central Government to use the invention.
5. Revocation by the High Court, on petition by a person interested on various specified grounds.

The most common form of revocation is the last one.

[II] Revocation by an Interested Person:

Only a "person interested" can make an application for revocation.

This includes a person -

- Who has manufacturing or trading interest in the patented article; or
- Who has financial interest in concerns manufacturing such articles; or
- Who possesses patents relating to the same subject; or
- Who is engaged in research in the same field as the invention relates.
- Also a defendant in a suit for infringement, can counter claim for revocation.

Jurisdiction :

- A petition for revocation, should be filed before a High Court.
- The High Court, within whose jurisdiction the petitioner stays or has his business interest, has jurisdiction to entertain the petition.

[III] Grounds for Revocation :

There are three classes of grounds for the revocation of a patent. They are as under -

- a) Grounds relating to right of the patentee and his conduct.
- b) Grounds relating to the invention and its quality.
- c) Grounds relating to the description of the invention.

(A) Grounds relating to the right of the Patentee and his conduct :

These are the following -

- i) Patentee is not entitled to the Patent.
- ii) Patent wrongfully obtained as against the person entitled.
- iii) Patent obtained by false suggestion or representation.
- iv) Failure to disclose information regarding foreign applications.
- v) Non compliance with direction for secrecy.
- vi) Amendment of specifications obtained by fraud.

(B) Grounds relating to the invention and its quality :

The following grounds come under this category -

- a) Subject of claim, not an invention.
- b) Subject claim, not a patentable invention.
- c) Invention claimed was secretly used before the priority date.
- d) Invention claimed already the subject of a prior grant.
- e) Invention claimed lacks novelty, having regard to prior knowledge or prior use.
- f) Invention is obvious and does not involve inventive step having regard to prior knowledge or prior use.
- g) Invention not useful.

All the above 7 Grounds are discussed in detail as under -

1) Subject of claim not a invention -

An invention means, any new and useful :

- Art, Process, Method or Manner of manufacture;

- Machine, Apparatus or other Articles;
- Substance produced by manufacture and include any new and useful improvement of any of them;
- Thus, invention which is new and useful –
- it must relate to a machine, article or substance produced by manufacture or the process of manufacture of an article; or
- it must be an improvement of an article or of a process of manufacture – Novelty – Inventiveness – Utility.

If an article or a process does not satisfy the above conditions of the definition of invention, then it is not an invention, and hence, cannot be patented.

2) **Subject claim not a Patentable invention –**

As per the Act, certain inventions are not Patentable. They are –

- Frivolous / Obvious – Contrary to Natural Law;
- Contrary to Morality / Public Health / Law;
- Mere discovery of Scientific principle or the formulation of an abstract theory;
- Method of agriculture or horticulture;
- Mere discovery of a new property or new use of a known substance;
- Mere admixture;
- Mere Arrangement or Rearrangement;
- Method or Process of testing;
- Medical treatment of Humans / Animals / Plants
- Food – Drug – Medicine – No Patent for substance;
- Only for chemical process patent can be granted – No Patent for the substance itself.

Thus, if a patent has been granted for the above inventions, which are not patentable as per the statute, then they can be revoked.

3) **Prior Secret Use –**

Prior Secret use will invalidate a patent unless such use was made for the purpose of reasonable trial or experiment – or by Government authority to whom the invention was communicated by the applicant – or by a 3rd person without the consent of the patentee.

4) **Prior Grant :**

If any claim made in the complete specifications, has already been claimed in a valid claim of earlier priority date in another patent, the subsequent claim can be revoked.

- This is based on the general principle that, a patent for an invention is granted only to one person.

- Thus, a Patent can be revoked if it is shown that, it is the subject matter of a prior grant.

5) Lacks novelty or anticipation –

The definition of 'invention' states that, the invention must be new. Thus, novelty in an alleged invention, is an essential condition for obtaining a Patent grant, lack of novelty is, therefore, a ground for revocation.

- Lack of novelty is also referred to as anticipation.

- Lack of novelty has to be determined, having regard to what was publicly known or publicly used in India before the priority date of the claim, or what was published in India or elsewhere in any document.

6) Obviousness or lack of inventive step –

The definition of 'invention' does not refer to the need for an inventive step, as a necessary condition of patentability. It only stipulates that, the invention must be new and useful.

- However, the necessity for the existence of inventiveness in a Patent, is recognised as the very foundation of patent law.

- Hence, if the invention is obvious or lacks inventive step, it is not Patentable, and therefore, a ground of revocation.

'Obvious' means, – which is plain or open to the eye or mind. Obviousness and Inventiveness are antithesis.

- What is obvious cannot be inventive, and what is inventive cannot be obvious.

7) Invention not useful –

For a thing to qualify as an invention, – it should be new and useful.

- If it is not useful, then it is not an invention which can be patented.

- Hence, an invention which is not useful, can be revoked.

- A Patent which is not useful, must be capable of being revoked on the ground of inutility.

- The practical usefulness or commercial usefulness of the invention does not matter, nor does it matter whether the invention is of any real benefit to the public

– what the patent law says it that, if it does not produce the result promised, it will invalidate the Patent.

(C) Grounds relating to the description of invention

a) Invention not sufficiently described – and the best method of performing it, not disclosed.

b) Claims not clearly defined or not fairly based.

(a) Invention not sufficiently described :

It is duty of the Patentee to describe fully the invention and its operation or use and the method of performing it.

- Failure to perform this duty, is a ground for revocation.

(b) Non-Disclosure of the best method known :

The complete specification should disclose the best method of performing the invention which is known to the application at the time of filing it, and for which he is entitled to claim protection. Non-compliance of this requirement is made a ground for revocation of the patent.

- The best method should be disclosed, only if, the patentee is entitled to claim protection for it.

(c) Claim not clearly defined or not fairly based :

The specification should contain a distinct statement of what is the invention:

- If the specification does not clearly define what the invention is, then this is ground for revocation of the patent.

(d) Claim not fairly based :

- A Patentee is granted his monopoly in order to protect the invention which in his specification he has communicated to the public.

- He is not entitled to claim a monopoly more extensive than is necessary to protect that, which he has himself said in his invention.

- The fundamental rule of the patent law is that, the monopoly claimed, must not go beyond the consideration.

Broad and indeterminate claims of a speculative character are not allowed.

[IV] Surrender of Patents :

A Patentee may, at any time, offer to surrender his patent by giving notice to the Controller. When such notice is received, the Controller will advertise the offer, and also notify every person whose name appears in the Register, as having an interest in the Patent.

- Any Person interested, may give notice of opposition to the surrender. The Controller, after completing the procedure, and hearing the parties, may accept the offer and revoke the patent if he is satisfied.

- The Procedure for advertisement of the offer, and inviting notice of opposition, is necessary in order to protect the interest of persons like licensees, equitable assignees, etc. with whom the patentee might have contracted obligations which are dependent upon the continuance of the patent.

[V] Limitations on restored Patents :

When a patent, which has once lapsed, has been restored, certain limitations are imposed on the right of the Patentee.

** If any infringement was committed during the period between the date of lapse and the date of advertisement of the application for the restoration, – the patentee is debarred from taking any action in respect of the infringement.

** The Controller may also impose conditions for the protection or compensation of persons who have begun to make use of the invention or avail themselves of the invention during the period when the patent was not effective, due to the lapse.

[VI] Ground for Restoration :

The Patentee has paid prescribed fees.

CHAPTER – VIII

“INFRINGEMENT”

Infringement of Patents :

- What is infringement ?
- What is onus of infringement ?
- Defences available in an infringement suit.
- Remedies available to the petitioner

[I] What is Infringement ?

What constitutes infringement, is not defined in the Patent Act; but, obviously, infringement of Patent is a violation of monopoly right conferred by the grant of patent, – It is the exclusive right to make, use, exercise, sell or distribute the invention in India, hence, infringement consists in the violation of any of these rights.

In determining that, doing a particular act by the alleged infringer amounts to infringement of a patent.

The following 3 questions are to be considered, in this regard –

- 1) The extent of monopoly right conferred by the Patent, - which is to be ascertained by the construction of specification particularly the claim. (To consider whether provisionally granted, or fully granted patent; If provisionally granted – then on infringement, cannot have legal remedies);
- 2) Whether the alleged act amounts to making, using, exercising selling or distributing a product or exercising, using, a method or process under the grant of patent;
- 3) Whether doing any act by the alleged infringer, amounts to infringement of the monopoly right conferred by the Patent grant.
(Answer should be ‘yes’ – then only, it will amount to infringement).

[II] Onus in an act of Infringement :

Onus of proving an act of infringement, is on the plaintiff.

- There is no infringement of an invalid patent.
- In infringement, it is immaterial whether the alleged infringement is doing the act of infringement with or without intention.
- If the defendant did not know that the patent is existing, he will not be liable for the consequence of the infringement action, i.e. damages or account of profit in such cases, the immediate remedy – is injunction.

- Thus, to avoid the consequences, the onus is on the defendant to prove that he was innocent at the date of infringement.
- The mere application of the word 'Patent' or 'Patented', is not sufficient to show that the article is Patented, unless it is accompanied by the Patent Number.

[III] Scope of Infringement :

In the following 3 circumstances, the act will not amount to infringement –

1) Declaration from Court:

When a Person has obtained a declaration from the Court to the effect that, the use by him of any process or the making the use of or sell of an article, does not constitute infringement.

- This is called Anticipatory action

2) Research or experimentation :

When a Patented invention is used for the purpose merely of experiment or Research, – it is not an infringement.

3) Imparting instruction to students :

When a Patented article or the patented process is used for imparting instruction to students, – do not amount to infringement of patents.

4) Use in foreign Vessel / Aircraft / Land vehicle :

When there is the use of the patented invention in a foreign vessel or aircraft or land, vehicle which temporarily happens to be within the territory of India – is not deemed to be an infringement.

[IV] What constitutes infringement ?

(Essential features of Infringement) :

In order to constitute infringement, – the defendant must be shown to have taken the invention claimed in the substance.

- It is seldom that the infringer takes the whole of the invention, - he may omit some unessential part or step, and substitute another step or part.
- But, if he takes all the essential features of the invention, – he has done infringement.

This leads to the question – What are the essential features of the invention claimed ?

The Patentee himself specified in his claims with particularity, those elements of his invention, which he claims to be essential.

Thus, if the alleged infringer has taken all the essential features claimed in the Patent, but has altered one or more unessential features. or has added feature which may or may not itself involves a new inventive step, – it is called **Colour Imitation.**

Copying the 'essential features' of the invention, is sometimes referred to as taking the 'Pith and Marrow' of the invention.

[V] Remedies available in case of Infringement:

The reliefs available to a successful plaintiff in a suit for infringement, are as follows –

1. An injunction;
2. Damages;
3. An account of profits.

An action for infringement of a Patent, must be instituted by way of a suit in – Any District Court or a High Court having jurisdiction to try the suit.

- Where the defendant counter-claims for revocation of the Patent,
- The suit, along with the counter-claim, will be transferred to the High Court for decision.
- The cause of action must have arisen, in a place within the jurisdiction of the Court where the suit is to be filed.

1) Injunctions :

i) Interlocutory injunction;

ii) Final injunction.

- The power to grant reliefs is subject to certain restrictions. Thus, where the Patent is endorsed, –
 - a) "Licence of Right" and the infringing defendant is ready and willing to take a compulsory licence, – no injunction will be granted.
 - b) In the case of innocent infringement, – no damages or account of profits will be granted.
 - c) Damages or account of profits may be refused in respect of any infringement committed after failure to pay the renewal fee within the prescribed period.

(i) Interlocutory Injunction –

The plaintiff may, at the commencement of the action, move for an interim injunction to restrain the defendant from committing the acts complained of, until the hearing of the action or further orders.

- The principles on which an interlocutory injunction may be granted, are –
- The plaintiff should make out a *prima facie* case; and
- The balance of convenience lies in his favour.

(ii) Final injunction –

An injunction granted after trial of the suit, will be limited for the duration of the Patent.

- Injunction will be granted, even where the defendant has not committed infringement – and only threatens to infringe, but damages will not be granted in such a case.
- When the infringement relates to a patent endorsed “Licences of Right”, – no injunction will be granted, if the defendant is willing to take a licence.

2) Damages or Account of Profit :

A successful plaintiff, in a suit for infringement, entitled to the relief of damages or an account of a profits, with certain exceptions.

The exceptions are :-

- The infringement was innocent.
- The infringement was committed after failure to pay the renewal fee within the prescribed period.
- Where the specification has amendment; and the infringement was committed before the date of amendment.
- Where the Patent was held partially valid, – damages or account of profits in respect of the valid claims, will be granted only under certain circumstances.
- In assessing the damages, the sole question is, what is the loss sustained by the Patentee, by reason of the unlawful sale of the defendant’s goods ?
- The loss must be natural and direct consequences of the defendant’s acts.
- The object of damages, is to compensate for loss or injury.
- The general rule is that, the measure of damages is to be, so far as possible, – that sum of money which will put injured party in the same position as he would have been in, if he had not sustained the wrong.
- There are two essential principles in valuing the damages First, that the plaintiff has the burden of proving his loss; Second, that the defendant being wrong-doer, damages should be liberally assessed, – but the object is to compensate the plaintiff, and not punish the defendant.

3) Order for Delivery – up, or Destruction:

An order for delivery – up or destruction is made with a view to prevent the defendant from making use of the infringing articles which might be in his possession. It is a discretionary order. The property in the articles which are made in violation of a Patent resides in the infringer though he is prevented from using them.

[VI] Defences :

The defendant, in a suit for infringement of a patent, may plead one or more of the following defences –

- 1) Plaintiff not entitled to sue for infringement.

- 2) Denial of infringement of any threat or of intention to infringe.
- 3) Express leave or licence, or implied leave or licence, to use the invention.
- 4) Estoppel or Res-judicata.
- 5) Claims alleged to be infringed, are invalid on certain grounds (Revocation of Patents).

(Right of patentee and his conduct) –

Patentee is not entitled to the Patent, if –

1) Patent was obtained by false suggestion or representation.

- Patent wrongfully obtained.

- Patentee did not disclose information regarding foreign applications.

(Invention and its quality)

- Subject claim not an invention.

- Non compliance with direction of secrecy.

- Amendment of specifications obtained by fraud.

- Invention not useful.

- Invention is obvious and does not involve inventive step.

- Prior grant.

- Subject claim not Patentable invention (as per the Act)

(Description of Invention)

- Invention not sufficiently described.

- Non disclosure of best method known.

- Claim not clearly defined or not fairly based.

6) The acts complained of, are in accordance with the condition specified in Section 47.

- Government use – Experiment – Research – Education;

7) Existence of a restrictive act by Plaintiff, declared unlawful.

8) Acts complained of, come within the scope of –

- innocent infringement;

- done after failure to pay renewal fee

- done after the date of amendment of the specifications.

9) Alleged invention not novel, or is obvious (Lord Moutons defence or Gillette defence)

10) Counter claim for revocation may be made by the defendant in his written statement, instead of a separate petition for revocation.

Full Questions and Short Notes on "Patents Act, 1970"

Full Questions –

- 1) "An invention to be patentable must be new, non-obvious and useful" – Elaborate. (April, 2004). / "All inventions are not patentable" – Discuss. (Dec., 2013; Nov. 2016; May, 2017)/ Discuss the inventions which are not patentable. (Nov. 2017).
- 2) Discuss the characteristics which an invention must have to be entitled for a patent. (May, 2015).
- 3) Explain the procedure for restoration of lapsed patents. State the rights of a patentee in respect of a restored patent. (April, 2004).
- 4) State the grounds of revocation of patents under the Patents Act, 1970. (April, 2004; April, 2005; Nov., 2005; Nov. 2014)
- 5) State the provisions of the Patents Act, 1970, in respect of suits concerning infringement of patents/Discuss the defences which may be pleaded in suit for infringement under the Patents Act, 1970. (April, 2004; May, 2006; April, 2008)
- 6) Explain the circumstances under which a Patent is deemed to be infringed. (Nov. 2009)
- 7) Discuss the procedure for grant of a patent/obtaining patent under the Patents Act, 1970./What is a Patent? Elaborate the procedure for obtaining a patent (April, 2004; Nov. 2004; Nov., 2006)
- 8) Define the term 'invention' and enumerate the inventions not patentable under the Patents Act, 1970. (April, 2007; April, 2009; December, 2012)
- 9) Discuss a) the rights of a patentee, and b) the defences available to a defendant in a patent infringement suit under the Patents Act, 1970. (Nov., 2007)
- 10) Provisional and Complete Specifications./Discuss the provisions of the Patents Act with respect to provisional and complete specifications. (Nov., 2007; May, 2013)
- 11) What is a Patent? What are not regarded as inventions under the Patents Act, 1970. (Nov. 2004; Nov. 2005; Nov. 2007)
- 12) What is Patent? Can a patent be granted for every invention? (April, 2010).
- 13) What is a Patent? What is the object of the patent law? What are the rights and obligations of a patentee? (April, 2010; April, 2011).
- 14) State the rights of a Patentee and Limitations on the rights. (Nov. 2004).
- 15) Explain the limitations on the rights of a patentee. (Nov. 2015).
- 16) What are the rights and duties of a patentee in respect of the patent granted to him. (May, 2016).
- 17) What is anticipation? Discuss the various ways in which a patent may be anticipated. (Nov. 20011).
- 18) State the grounds of revocation of patents under the patents Act, 1970. (Nov. 2008; May, 2014; May, 2017)

- 19) Explain the process of registration of a patent under the Patents Act, 1970. (Nov. 2008)
- 20) State the grounds of opposition of patents under the Patents Act, 1970./Who can oppose grant of patent and on what grounds? What is the procedure for opposing a patent? (April, 2009; Nov. 2010; April, 2011; Nov. 2011; Nov. 2017)
- 21) Discuss the powers of the Controller in granting compulsory licences: What are the terms and conditions on which such licence may be granted? (May, 2012)
- 22) What is convention application? What are the special; and supplementary provisions relating to convention applications under the Patents Act, 1970? (May, 2012).

Short Notes -

- 1) Patent of Addition. (Nov. 2004; April, 2005; Nov., 2005; April, 2009; Nov. 2009; Nov. 2011; May, 2012).
- 2) Priority Date. (April, 2004).
- 3) Specifications. (Nov. 2004; April, 2005; Nov., 2005; April, 2008; April, 2011; May, 2012; December, 2013; Nov. 2014; Nov. 2015).
- 4) Patent Co-operation Treaty. (Nov. 2005; May, 2006; Nov. 2010)
- 5) Rights and Obligations of Patentee. (May, 2006; May, 2017)
- 6) Patent Agents. (April, 2004; Nov., 2006; April, 2007)
- 7) Rights of a Patentee. (Nov. 2006; Nov. 2008)
- 8) Patent protection for micro-organisms. (Nov. 20011).
- 9) Provisional and Complete Specifications. (April, 2007; Nov. 2007; May, 2015; May, 2017).
- 10) Restored Patent. (Nov. 2005).
- 11) Surrender of Patents. (Nov. 2009; May, 2013).
- 12) Date of Patent and Priority Date. (April, 2010; Nov. 2014; Nov. 2015)
- 13) Process of patent. (Nov. 2010)
- 14) Transfer of Patent. (December, 2012; May, 2013).
- 15) Revocation of Patents. (December, 2012).
- 16) Compulsory licensing in patents. (Nov. 2010; May, 2014; May, 2016; Nov. 2016; Nov. 2017).
- 17) Object of Patent law. (May, 2015).
- 18) Classification of Patents. (Nov. 2017).
- 19) Right Management Information. (Nov. 2014).
- 20) Reasonable requirements of the public. (May, 2016; Nov. 2016).
- 21) Anticipation. (May, 2017).

Full Questions and Short Notes on

"Geographical Indications & Designs Act"

Full Questions –

- 1) State the effects of registration of Geographical Indications. (December, 2013; Nov. 2014).
- 2) Explain the prohibition on registration of certain indications as geographical indication. (May, 2015).
- 3) Explain the procedure of registration of Geographical Indications. (Nov. 2015).
- 4) Explain in detail, the term "Industrial Design". Enumerate the procedure of registration of Industrial Design. (December, 2012; May, 2013).
- 5) State the law on registration of Designs. (May, 2014).
- 6) Explain various forms of Intellectual Property and the Legislations in India for protection thereof. (April, 2010).
- 7) Explain the nature and scope and types of Intellectual Property. (Nov. 2014; Nov. 2015).
- 8) Define the term "Intellectual Property". Explain the main features of this property. Whether it is different from other kinds of intellectual property? Explain. (Nov. 2010; Dec. 2012; May, 2013; Dec. 2013; May, 2014; May, 2015; May, 2016).
- 9) Discuss the classification of Intellectual Property. (May, 2017).
- 10) Explain the term property. Analyze Intellectual Property as a form of property. (Nov. 2017).
- 11) Explain the need for protection of Intellectual Property Rights. (Nov. 2016).
- 12) Discuss and compare the salient features of trademarks, Patents, Designs and Copyright as Intellectual Property. (April, 2011).
- 13) What is meant by the term "Intellectual Property Rights"? What is the justification for the protection of Intellectual Property Rights? (May, 2012).

Short Notes –

- 1) Geographical Indications (Nov. 2006; Nov. 2007; April, 2008; Nov. 2008; April, 2009; May, 2012; May, 2014).
- 2) Prohibition of registration of certain geographical indications. (Nov. 2011).
- 3) Prohibition of Registration of certain Design. (May, 2016).
- 4) Designs which are prohibited for registration under the Designs Act, 2000. (Nov. 2008).
- 5) Requirements of Registration of Designs. (May, 2014).
- 6) Piracy of a registered design. (December, 2012; May, 2013).
- 7) Intellectual Property Appellate Board (IPAB) (Nov. 2008).

8) World Intellectual Property Organisation (WIPO). (April, 2010).

9) Berne Convention. (Nov. 2016; Nov. 2017).

Q. 3 : Problems –

1) Dhoni has been granted a patent by the Indian Patents Office on 31st December, 2007 –

a) For how long will Dhoni have the patent over his invention?

Answer : Under Section 53 (1) of the Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of the patent which has not expired and has not ceased to have effect on the date of such commencement, under this Act, shall be 20 years from the date of filing of the application for the patent.

b) If Ganguly wants to challenge the patent, in which Court has he to file a suit?

Answer : A suit has to be instituted in a District Court or in appropriate cases, the High Court.

c) Can Dhoni file an action for infringement against manufacturer who is making the invention in Nepal? Why?

Answer : No, because, the patent is not registered in Nepal. If Nepal is a convention country, then only the infringement action can be initiated.

d) Can Dhoni get a patent in England in respect of the same invention, if he applies in 2008? Why?

Answer : Yes, provided, that no other similar invention has already been granted a patent.

e) If Dhoni had initially applied under the PCT then, would he have gained any advantage?

Answer : The advantage would be the crystallizing of the priority date for the same invention in multiple countries simultaneously.

2) A detective agency wants to register the trademark "I Section I Section I" for its firm. The Controller General of Patents, Designs and Trademarks has refused to grant trademark on the plea that it sounds similar to the trademark ICICI.

a) Is the stand of the Controller correct?

Answer : Yes, the Controller refusing to grant/register trademark is correct. Under Section 9 (d) of the Act, there is the 'absolute' ground for refusal, that is, if the trademark is of such nature as to deceive the public or cause confusion, then the trademark shall not be registered.

b) Can there be any other ground of refusal?

Answer : Yes, under Section 11 of the Act, if the trademark is 'relative' in nature (i.e. 'relative' grounds for refusal. It means – (a) if there is likelihood of confusion caused to the public including the likelihood of association with an earlier trademark by virtue of its identity with the earlier trademark and similarity of goods or services caused by the earlier trademark, (b) if the earlier trademark is well-known trademark in India and the later mark would take unfair advantage of the earlier mark or would be detrimental to the distinctive character or repute of the earlier trademark.

c) What are the remedies available against the refusal?

Answer : The remedies that the consent of the proprietor is obtained and it is for honest concurrent use [Section 12 of the Act].

3) Hari has written a book on Graphology. The book has been published by Penguin.

a) Who is the author of the work?

Answer : Hari is the author.

b) A journalist uses extracts of the book in the review of the book published in a magazine. Will this amount to infringement? Why?

Answer : No. Covered under Section 52 as Fair Use – criticism or review not amounting to infringement.

c) A student extensively quotes from this book in his exam. Will this amount to infringement? Why?

Answer : No. Covered under Section 52 as Fair Use – reproducing for exam purpose not amounting to infringement.

d) Hari's friend Suresh makes 20 photocopies of this book and distributes it amongst his friends. Will this amount to infringement? Why?

Answer : Yes, it will certainly amount to infringement. Because, reproduction of whole or part of the work/book shall not be allowed except for grounds enumerated in Section 52. Making 20 copies and distributing among friends certainly amounts to infringement. Both, Hari and the person making photocopies are liable for civil, as well as, criminal action.

4) Reebok Pvt. Ltd., an Indian Company, is long-standing manufacturer of Sports goods under a registered trademark 'RK', having sales in India. Only recently, Nike UK has launched its sports goods in Delhi, and in the UK under the trademark "RK-1".

i) Reebok desires to commence legal proceedings against Nike in India. Advise on options available and reliefs that may be prayed for.

Answer : Reliefs – Ex-parte Injunction, Injunction, Damages or an account of profits, Delivery of infringing labels/marks for destruction.

ii) Reebok desires to commence legal proceedings against Nike in U.K. Advise.
Answer : Legal proceedings in the U.K. would not be entertained. Trade Marks Act, 1999 is a territorial law having applicability in India. The cause of action has arisen in India and therefore, courts in India are the appropriate forum for adjudication.

iii) Assume 'RK' was an unregistered trademark, what option would Reebok then have ?

Answer : Reebok would have a common law relief, viz. a suit for passing off against Nike U.K.

5) Sanchit and Sagar filed patent application with provisional specification on the same date for the same invention. After that, Sanchit filed a complete specification much earlier to Sagar, both filed within the allowed period. Examine the status of the patent applications filed by both, Sanchit, and Sagar.

i) If Sanchit adopted the idea from Sagar dishonestly.

Answer : If Sanchit adopted the idea from Sagar dishonestly, then it will amount to infringement of Sagar's rights to patent. And hence, Sagar will have right to institute suit for Declaration, Injunction and also for damages and accounts of profits.

ii) Both Sanchit and Sagar are honest independent inventors conducting their own separate experiments.

Answer : As Sanchit has filed a complete Specification much earlier to Sagar; Sanchit will have exclusive right to make or use the patented article or use of the patented process. But if Sagar has discovered new process other than Sanchit's experimental process, Sagar can get patent on his new process; which will be improvement in Sanchit's patented process, but Sagar have to get consent and permission from Sanchit, because, Sanchit has filed complete Specification much earlier to Sagar. So, Sanchit is the exclusive owner (i.e. First Inventor) of patented process.

6) Sameer-Raja, a team of music directors, create a musical work. Lyrics written by Sameer, are blended to create a song. T-Series video company acquires rights enabling them to make a sound recording.

i) List the various classes of works in which copyright subsists.

Answer : Musical works, Literary works, Sound recording, etc.

ii) List the Authors in relation to those classes of works created.

Answer : Musical works – Authors : Sameer-Raja.

Literary works – Author : Sameer.

Sound recording – Author : T-Series video company.

iii) What must T-Series video company have done to acquire rights to make the sound recording ?

Answer : T-Series video company would have either procured a licence or an assignment in the musical works and the lyrics. It would have enabled to produce the sound recording embodying the two works protected under the Copyright Act, 1957.

7) Anil a research scientist, discovers a new phenomenon in physics. Using principles underlying this new discovery, Anil and Amit invent a product having substantial commercial potential. Anil and Amit have come to you for advice.

a) Would you advise Anil to obtain a patent in respect of his discovery ? Give reasons either way.

Answer : No, Anil would be advised against making any effort to obtain a patent in respect of the said discovery. Under the Patents Act, 1970, only inventions are capable of securing patents and Section 3 of the said Act also discusses "what are not inventions" –

Section 3 (c) : What are not inventions – mere discovery of a scientific principle of the formulation of or the discovery of any living thing or non-living substance occurring in the nature.

Since Anil's work clearly falls under Section 3 (c), the same would not be granted a patent.

b) Would Anil and Amit together, be eligible for a patent ? If no, who amongst them would have a better right ?

Answer : Yes, Anil and Amit would be eligible for applying for a patent grant in respect of the product developed by them.

c) The inventor(s) would like to file a Complete Specification, but their claims are not yet ready. What advice would you give them under the circumstances ?

Answer : The inventors should draft and file the 'provisional specifications' in respect of the patentable invention. They are not required to file their claims at this stage; however, the applicants must file the complete specifications within one year from the filing of the provisional specifications.

d) Further, the inventor(s) would like to discuss the discovery and the product at a scientific conference. What advice would you give them ?

Answer : Since the discovery is not the subject matter of the patent, the scientist can discuss the same at the scientific conference. However, they are advised not to make any mention of the product, unless they have filed at least a provisional specification in respect of the invention embodied in the product.

8) Mr. Mulla forms brilliant idea about how a beautiful girl can madly fall in love with a lazy boy, on which a beautiful and thought provoking story can be written. He communicates it to Mr. Dalla. Dalla appreciates the idea given to him by Mulla. Dalla clothes the idea in the form of a book, which he publishes in his own name. Mulla claims that the original idea belongs to him.

i) Can Mulla claim a joint ownership over a copyright in the book so to claim royalty in the book? If yes/No why?

Answer : No, Mulla cannot claim joint ownership over a copyright. Dalla is the first owner of the copyright. Because, there is no copyright in ideas. Copyright subsists only in material form in which the ideas are expressed. It is not an infringement of copyright to adopt the ideas of another.

According to Old Question Paper Pattern
University Examination Question Papers [1] to [10]

“INTELLECTUAL PROPERTY LAW”

[April, – 2004]

(Old and Revised Course)

Time: 3 Hours

Marks 100

N.B.

1. All Questions are compulsory.
2. Marks assigned to each Question are shown on the right side.

Q. 1 : “An invention to be patentable must be new, non-obvious and useful” – Elaborate.

OR

Explain the procedure for obtaining a patent.

= 12.

Q. 2 : State the grounds for revocation of a patent.

OR

Explain the procedure for restoration of lapsed patents. State the rights of a patentee in respect of a restored patent.

= 12.

Q. 3 : Explain the procedure for registration of trademarks under the Trade Marks Act, 1999.

OR

Explain the various circumstances in which registered trademarks can be removed from the Register of Trade Marks.

= 12.

Q. 4 : What is the distinction between an “infringement action” and “passing off action” ? Discuss the issues involved, and the nature of relief which can be granted or sought for, in the said two actions.

OR

Explain the meaning of “Permitted Use” and “Registered User” under the Trade Marks Act, 1999. State the provisions regarding Registered Users of a trade mark.

= 12.

Q. 5 : “There is no copyright in ideas” – Elucidate.

OR

State the works in which copyright can subsists. Who is an Author in the works in which copyright exists ?

= 12.

Q. 6 : Explain the meaning of the expression “infringement of copyright”. State the defences available in an action for infringement of copyright.

Q. 6 : Discuss the remedies in cases of infringement of copyright. = 12.

Q. 7 : Write short notes on Any Two : = 14.

- a) Priority Date.
- b) Certification Trade Mark.
- c) Patent Agents.
- d) Musical Work.

Q. 8 : Answer the following giving reasons (Any Three) : = 14.

- a) 'P' is the registered proprietor of the trade mark "WHISPER". On a trip to Delhi, 'P' comes across a similar product displayed with the words "WHISPER" with same colour combination as his own. 'P' comes to you for advice. Set out in detail the advice you will give to 'P'.
- b) 'A' a fitness instructor applies for a patent for a special reducing programme devised by him. If you are the controller, how would you decide the application ?
- c) 'N' applies for registration of a trade mark "HERBY" for herbal biscuits. How would you, as the Registrar of Trade Marks decide the application ?
- d) 'J' compiles examination question papers and claims copyright over it. Is J's claim proper ?

[2]

[November, – 2004]

(Old and Revised Course)

N.B.

- 1. All Questions are compulsory.
- 2. Marks assigned to each Question are shown on the right side.

Q. 1 : What is Patent ? Elaborate the procedure for obtaining a patent.

OR

State what are not inventions under the Patents Act, 1970. = 12.

Q. 2 : Discuss the defence which may be pleaded in a suit for infringement under the Patents Act, 1970.

OR

State the rights of a Patentee and the limitations on the rights. = 12.

Q. 3 : Explain the procedure for registration of trade marks under the Trade Mark Act, 1999.

OR

What is a Trade Mark ? How can a person become a proprietor of a Trade Mark ?
How can a proprietor of a Trade Mark protect his Mark ? = 12.

Q. 4 : Explain the circumstances in which a registered Trade Mark can be removed from the Register of Trade marks.

OR

What is the difference between an infringement action and passing off action ? What are the issues involved in each of these actions ? = 12.

Q. 5 : What is copyright ? Who is the Author in the various works in which copyright subsists ?

OR

State the term of copyright in various works. = 12.

Q. 6 : State the rights of Broadcasting Organization and of Performers under the Copyright Act, 1957.

OR

State acts which do not constitute infringement of copyright. = 12.

Q. 7 : Write short notes on Any Two : = 10.

- a) Patents of Addition.
- b) Specifications.
- c) Artistic Work.
- d) Deceptive Similarity.

Q. 8 : Attempt Any Three giving reasons : = 18:

- a) 'A' declares that he has invented a ball which instead of falling towards the ground, rises up in the air defying the principle of gravity. Can he seek a patent for his invention ?
- b) A neurologist invents the cure for epilepsy by delivery of mild electric shocks to the brain. Will he be entitled to claim a patent for such a method of treatment ?
- c) The Himachal Emporium sells Kullu Shawls. It applies for registration of the Trade Mark "KULLU" for such shawls. Can such Trade Mark be registered ?
- d) A student submits a dissertation for his Ph. D degree. His guide copies a portion of it and uses it in his new book. Can the student claim copyright on his dissertation and take an action against his guide ?

[3]

[April, -2005]

(Old and Revised Course)

N.B.

1. All Questions are compulsory.
2. Marks assigned to each Question are shown on the right side.

Q. II : Answer Any Two : = 20.

1. State and discuss the works in which copyright subsists under the Copyright Act, 1957.
2. State the grounds of revocation of patents under the Patents Act, 1970.
3. State the effect of registration of a Trade Mark under the Trade Marks Act, 1999.

Q. III : Write short notes (not exceeding 10 sentences) on Any Four : = 20.

1. Copyright Societies.
2. Registered users under the Trade Marks Act, 1999.
3. Patent of Addition.
4. Specification.
5. Collective Marks.
6. Adaptation under the Copyright Act, 1957.

Q. IV : Attempt Any Two : = 20.

1. Ganesh applies for a patent in respect of an invention and the same is granted by the Indian Patent Office in July, 2003.
 - a) For how long would Ganesh have the exclusive right in respect of the invention ?
 - b) If Ramesh wants to challenge the patent, in which Court he has to file a suit ?
 - c) Can Ganesh take an action for Infringement against a manufacturer who is making the invention in Pakistan ?
 - d) Can ganesh get a patent in U.S.A. in respect of the same invention, if applies in 2005 ? Why ?
 - e) If Ganesh had initially filed a PCT application, what would have been the advantage ?
2. Dr. Singh has written a book on Intellectual Property Law. The book has been published by Western Law House.
 - a) Who is the author of the work ?
Answer : Dr. Singh is an author of the book on Intellectual Property Law.
 - b) A journalist uses extracts of the book in the review of the book published in a magazine. Will this amount to infringement ? Why ?
Answer : No, this will not amount to infringement as extracts can be used for review purpose, under Section 52 of the Copyright Act, 1957, certain acts does not amount to infringement of copyright.
 - c) A student extensively quotes from Dr. Singh's book in his law examination. Will this amount to infringement ? Why ?

Answer : No, this will also not amount to infringement, under Section 52 of the Copyright Act, 1957, certain acts not to be infringement of copyright.

d) Shyam makes 10 photocopies of the book and distributes them amongst his friends. Will this amount to infringement? Why?

Answer : Yes, this will certainly amount to infringement, because, under Section 51 of the Copyright Act, 1957, making photocopy of the book and distributing the same amounts to infringement of copyright.

3. A man by the name Shahrukh want to apply for registration of his personal name "Shahrukh" as a Trade mark for Cola drinks.

- Will the Mark be regarded as distinctive? Why?
- Can he sell his drink as "Shahrukh's Cola"? Why?
- Can Mr. Shahrukh Khan, the actor, oppose the application? Why?
- Will it make any difference, if the name was a famous and historical name?

[4]

[November, – 2005]

(Old and Revised Course)

N.B. :

- Answer Section I on the Question Paper itself;
- Use Answer Sheets and Additional Sheets for Section II;
- Section I shall be collected at the end of the first hour of the examination.

SECTION – I (40 Marks) :

Q. I : Tick the appropriate option :

- A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his –
 - Design.
 - Trademark.
 - Copyright.
 - Patent.
- Define the term 'invention' under the Patents Act, 1970. (Answer in a single sentence).
.....
- One of the grounds for refusal of registration is when a mark comprises or contains scandalous or obscene matter.
 - proper.
 - absolute.
 - relative.
 - legal.

- 4) When the identity of the author is not known, copyright in literary work subsists until from the following calendar year after the year in which the literary work was published.
- 20 years.
 - 40 years.
 - 60 years.
 - 75 years.
- 5) Define the term 'goods' under the Trade Marks Act, 1999. (Answer in one sentence).
- 6) What is meant by the term "performance" under the Copyright Act, 1957? (Answer in a single sentence).
- 7) The Registrar shall classify goods and services, as far as may be, in accordance with the classification of goods and services for the purposes of registration of trade marks:
- National.
 - International.
 - Global.
 - American.
- 8) An individual can apply for a patent as an inventor.
- True.
 - False.
- 9) Which of the following would be a 'permitted use' as per Section 2 (r) of the Trade Marks Act, 1999?
- Use of a trade mark by a register user of the trade mark in relation to goods or services with which he is connected in the course of trade.
 - Use of trade mark by an unauthorized user in relation to goods or services which are identical to the goods and services of the registered user.
 - Use of trade mark by a registered user of the trade mark in relation to goods or services, such use being in non-compliance of the conditions and limitations of registration.
 - Use of a trade mark by any user so as to tantamount to passing off goods as those belonging to the registered user.
- 10) The definition of the term 'mark' under the Trade Marks Act, 1999, is an inclusive definition.
- True.
 - False.
- 11) What is an 'international application' under the Patents Act, 1970? (Answer in a single sentence).
- 12) Match of the following in column 'A' with the correct classification from column 'B' whether they are patentable or not patentable under the Patents Act, 1970 :
- | 'A' | 'B' |
|--|--------------------|
| 1) Algorithms. | a) Patentable. |
| 2) An invention which is new and useful. | b) Not patentable. |

- 3) System of aiding hearing. (c) Not patentable.
- 4) Discovery of a scientific principle. (d) Patentable.
- 13) Third parties can commercially exploit a patented product without obtaining the patentee's consent.
- True.
 - False.
- 14) Which of the following would be entitled to copyright protection?
- Inventions.
 - Logos.
 - Paintings.
 - Hybrid Seeds.
- 15) The re-arrangement of known devices, each functioning independently of one another in a known way, is an invention which is patentable under the Patents Act, 1970.
- True.
 - False.
- 16) A mark shall be deemed to be to another mark if it so nearly resembles that, other mark as to be likely to deceive or cause confusion.
- Identically similar.
 - Perceptively similar.
 - Deceptively similar.
 - Similar.
- 17) Copyright in a work, can subsist even if that work is not registered under the Copyright Act, 1957.
- True.
 - False.
- 18) If an application for a patent is filed along with a provisional specification, then a complete specification is required to be filed within months from the date of the filing of the application.
- three.
 - six.
 - twelve.
 - eighteen.
- 19) means, a trade mark distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others.
- Certification Trade Mark.
 - Collective Mark.
 - Trade Mark.
 - Geographical Indication

- 20) Which of the following is invention under the Patents Act, 1970 ?
- a) Frivolous invention.
 - b) Method of horticulture.
 - c) A computer program per Section.
 - d) Presentation of information.
 - e) None of the above.
- 21) Which of the following civil remedy can be used to protect a copyright in India ?
- a) Injunction.
 - b) Damages.
 - c) Account for profit.
 - d) All of the above.
- 22) The Patents Act, 1970 extends to the whole of India excluding Jammu and Kashmir.
- a) True.
 - b) False.
- 23) According to Section 18 of the Trade Marks Act, 1999, a registered trade mark may be
or transmitted with or without the goodwill of the business concerned.
- a) assigned.
 - b) sold.
 - c) licensed.
 - d) transferred.
- 24) What are the two rights of patent agents under the Patents Act, 1970 ? (Answer in a single sentence).
- 25) What is the purpose of a certification trade mark ? (Answer in a single sentence):
- 26) Broadcast means communication to the public by any means, of wireless diffusion.
- a) True.
 - b) False.
- 27) Which of the following is a right conferred by copyright under the Copyright Act, 1957 ?
- a) Statutory Right.
 - b) Moral Right.
 - c) Multiple Right
- 28) Match the question in column 'A' with the correct intellectual property right from column 'B' :
- | 'A' | 'B' |
|--|---------------|
| 1) Logo for identifying the goods of a shoe company. | a) Copyright. |
| 2) New method of producing electricity. | b) Trademark. |
| 3) Dance performance. | c) Patent. |
- 29) The Paris Convention is not an international patent filing system.

- a) True.
- b) False.

- 30) An application for patenting an invention, may be made by any person claiming to be the inventor of the invention.
- a) first.
 - b) true and first.
 - c) sole.
 - d) only.
- 31) A trade mark identifies the product and its origin, and guarantees its quality.
- a) True.
 - b) False.
- 32) Define the term 'registered proprietor' under the Trade Marks Act, 1999. (Answer in a single sentence).
- 33) What is the term of copyright in literary, dramatic, musical, and artistic works, other than photographs, which are published during the lifetime of the author ? (Answer in a single sentence).
- 34) PCT is an acronym for –
- a) Public Copyrights Treaty.
 - b) Patent Co-operative Treaty.
 - c) Patent Copyrights Treaty.
 - d) Patent, Copyrights and Trade Marks.
- 35) Every performer shall have a special right to be known as in respect of any performance.
- a) broadcast marketing right.
 - b) performer's right.
 - c) performer's reproduction right.
 - d) exclusive reproduction right.
- 36) is an example of a certification trade mark.
- a) Zandu.
 - b) ISI.
 - c) Cadburys.
 - d) ICICI.
- 37) What is meant by adaptation in relation to a dramatic work ? (Answer in a single sentence).
- 38) A movie whose screen play is based on an adaptation of a well known novel. Which intellectual property right can give it a protection ?
- a) Trademark.
 - b) Related Rights.
 - c) Patent.
 - d) Copyrights.

39) What is meant by the term 'capable of industrial application' under the Patents Act, 1970?
(Answer in a single sentence).

SECTION – II (60 Marks) :

Q. II : Answer Any Two : = 20.

- 1) State and discuss the works in which copyright subsists under the Copyright Act, 1957.
- 2) State the grounds of revocation of patents under the Patents Act, 1970.
- 3) State the effect of registration of a Trademark under the Trade Marks Act, 1999.

Q. III : Write short notes (not exceeding 10 sentences) on Any Four : = 20.

- a) Copyright Societies.
- b) Registered User under the Trade Marks Act, 1999.
- c) Patent of Addition.
- d) Specification.
- e) Collective marks.
- f) Adaptation under the Copyright Act, 1957.

Q. IV : Attempt Any Two : = 20.

(a) Ganesh applies for a patent in respect of an invention, and the same is granted by the Indian Patent Office in July, 2003.

- a) For how long Ganesh have the exclusive right in respect of the invention ?
- b) If Ramesh wants to challenge the patent, in which Court has he to file a suit ?
- c) Can Ganesh take an action for Infringement against a manufacturer who is making the invention in Pakistan ? Why ?
- d) Can Ganesh get a patent in USA in respect to the same invention, if he applies in 2005 ? Why ?
- e) If Ganesh had initially filed a PCT application, what would have been the advantage ?

(b) Dr. Singh has written a book on Intellectual Property Law. The book has been published by Western Law House.

a) Who is the author of the work ?

Answer : Dr. Singh is an author of the book on Intellectual Property Law.

b) A journalist uses some extracts of the book in the review of the book published in a magazine. Will this amount to infringement ? Why ?

Answer : No, this will not amount to infringement as extracts can be used for review purpose, under Section 52 of the Copyright Act, 1957, certain acts does not amount to infringement of copyright.

c) A student extensively quotes from Dr. Singh's book in his law examination. Will this amount to infringement ? Why ?

Answer : No, this will also not amount to infringement, under Section 52 of the Copyright Act, 1957, certain acts not to be infringement of copyright.

d) Shyam makes 10 photocopies of the book and distributes them amongst his friends. Will this amount to infringement ? Why ?

Answer : Yes, this will certainly amount to infringement, because, under Section 51 of the Copyright Act, 1957, making photocopy of the book and distributing the same amounts to infringement of copyright.

(c) A man, by the name Shahrukh, wants to apply for registration of his personal name "Shahrukh" as a trademark for Cola drinks.

- Will the Mark be regarded as distinctive? Why?
- Can he sell his drink as "Shahrukh's Cola"? Why?
- Can Mr. Shahrukh Khan, the actor, oppose the application? Why?
- Will it make any difference, if the name was a famous and historical name?
- Will the mark be regarded as distinctive? Why?

[5]

[November, – 2005 (22/11/05)]

(Old and Revised Course)

Instructions :

- Answer SECTION I and SECTION II separately;
- Answer SECTION I on the question paper itself;
- Answer all questions.

With Solution

N.B.

Section I contains Question No. 1 only having 40 Objective Questions which are not relevant in the context of present Question paper pattern, hence not included here.

SECTION – II

Q. 2 : Answer Any Two : = 20.

- Explain and discuss the meaning of the term 'copyright' under the Copyrights Act, 1957.
- State the grounds of refusal of registration of a Trade mark under the Trade Marks Act, 1999.
- What are not inventions under the Patents Act, 1970?

Q. 3 : Write short notes (not exceeding 10 sentences) on Any Four : = 20.

- Fair Use.
- Assignment of Trade Marks.
- Patent Co-operation Treaty.
- Performer's Rights.
- Restored Patent.
- Passing Off.

Q. 4 : Attempt Any Two : = 20.

- B D Pvt. Ltd. launched a range of readymade garments for men under the name "Preity" in the year 2000.

a) If the Trade mark has not been applied for registration, does BD Pvt. Ltd. Have any rights in the said ? Why ?

Answer : Yes, BD PVT. Ltd. have a right as they have designed and made the tail-work job of exclusive ready-made garments for men, so they have a right to sell the goods in the market as the company is not registered, it cannot file a suit of infringement or passing off or any kind of misappropriation.

b) If BD Pvt. Ltd. were to apply for registration of the mark will it be granted ? Why ?

Answer : Application of registration to be made to Patents and Trade Mark Registry to the Registrar. So as to have the exclusive rights of their product.

c) Can actress Preity Zinta oppose the grant of the Mark ? Why ?

Answer : No, actress Preity Zinta cannot oppose as she is not manufacturing the similar type of garments. Opposition is to be made by the same kind of product owner (i.e. first owner and true owner).

d) If another garment manufacturer brings out a similar range of products under the Mark "Preity" will it amount to infringement of BD's Mark ? Why ?

Answer : Yes, it will amount to infringement of BD's Mark as the sound and letters are deceptively similar.

2) Scientist 'A' working in B.A.R.C. and involved in atomic energy research, discovers a scientific principle. His colleague, Scientist 'B' uses the principle and invents a novel, inventive, and useful working device based on the principles.

a) Will Scientist 'A' be granted a Patent for his discovery ? Why ?

Answer : No, Scientist 'A' will not be granted a Patent for his discovery under Section 4 of the Patents Act, 1970, inventions relating to atomic energy are not patentable.

b) Will Scientist 'B' be granted a Patent for his invention ? Why ?

Answer : No, Scientist 'B' will not be granted Patent for his invention, as his invention is related to the principles of atomic energy which is not patentable.

c) What will be your answer to b) above, if the invention is not related to atomic energy ? Why ?

Answer : In such a case, the Scientist will be granted Patent if his invention is not related to atomic energy, as his invention will be treated as a novel, inventive and useful working device.

3) Dr. Singh has written a book on Intellectual Property Law. The book has been published by Western Law House.

a) Who is the author of the work ?

Answer : Dr. Singh is an author of the book on Intellectual Property Law.

b) A journalist uses extracts of the book in the review of the book published in a magazine. Will this amount to infringement ? Why ?

Answer : No, this will not amount to infringement as extracts can be used for review purpose, under Section 52 of the Copyright Act, 1957, certain acts does not amount to infringement of copyright.

c) A student extensively quotes from Dr. Singh's book in his law examination. Will this amount to infringement ? Why ?

Answer : No, this will also not amount to infringement, under Section 52 of the Copyright Act, 1957, certain acts not to be infringement of copyright.

d) Shyam makes 10 photocopies of the book and distributes them amongst his friends. Will this amount to infringement ? Why ?

Answer : Yes, this will certainly amount to infringement, because, under Section 51 of the Copyright Act, 1957, making photocopy of the book and distributing the same amounts to infringement of copyright.

[6]

[May, 2006 (02/05/06)]

(Old and Revised Course)

Instructions :

- 1) Answer Section I on the Question Paper itself;
- 2) Use Answer Sheets and Additional Sheets for Section II;
- 3) Section I shall be collected at the end of the first hour of the examination.

SECTION – I (40 Marks)

Q. I : Tick the appropriate option :

- 1) Invention : Novel : Idea : ?
 - i) Utility, ii) Expression, iii) Publication, iv) Protection.
- 2) What is the term of copyright in literary, dramatic, musical and artistic works, other than photographs which are published during the lifetime of the author ? (Answer in a single sentence).
- 3) Match the questions in column 'A' with the correct intellectual property right from column 'B'.

'A'	'B'
1. New form of jet Engine.	Copyright.
2. Shape of a soft drink bottle.	Trademark.
3. Logos of a product.	Patent.
4. Books.	Industrial design.
- 4) Anton Pillar Orders : Interlocutory Injunction : Damages.
 - i) They are civil remedies to which a plaintiff is entitled in a suit for infringement.
 - ii) They are criminal remedies to which a defendant is entitled in a suit for infringement.
 - iii) They are issues in a suit for infringement of copyright.
- 5) Once an inventor has patent application ready, it may be sent straight to the Indian –
 - i) Patent and Trade Mark Office.
 - ii) Department of Commerce.
 - iii) Patent Examiner.
 - iv) Both i) and ii).
- 6) What are the obligations of a Patentee ?
- 7)is the authority to determine and decide the terms and conditions of compulsory licence.

- i) Controller.
- ii) Central Government.
- iii) State Government.
- iv) Registrar.

- 8) FDA, FPO, AGMARK, IDA are –
- i) Registered trade Marks.
 - ii) Certification Marks.
 - iii) Service Marks.
 - iv) Collective marks.

- 9) Licence Deed and Assignment of Patents are to be –
- i) In writing and registered in the patent office.
 - ii) Published/Advertised in the official gazette.
 - iii) Sealed under the seal of the patent registry.
 - iv) All of the above.

10) What is a Patent of Addition ?

- 11) India has been recognizing products patents in food and drug industry since –
- i) 2000.
 - ii) 2002.
 - iii) 2005.
 - iv) 1999.

12)indicates the characteristics qualities of a product that originates from a particular place or region.

- 13) The term patent is –
- i) 10 years.
 - ii) 20 years.
 - iii) 40 years.
 - iv) 65 years.

- 14) Painting : Artist : Music ?
- i) Composer.
 - ii) Writer.
 - iii) Dancer.
 - iv) Lyricist.

- 15) Colorable imitation : Immaterial; Variation : Mechanical Equivalents.
- i) These are grounds for refusal of registration of a Trademark.
 - ii) These are essential requirements for granting a patent.
 - iii) These acts amount to infringement of a patent.

- 16) Which of the following would be entitled to protection under Intellectual Property Rights ?
- i) Performances.

- ii) Broadcasts.
- iii) Integrated Circuits.
- iv) Inventions.

17) UPOV is an acronym for -

- i) International Union for the Protection of Plant Varieties.
- ii) Universal Protection of Varieties of Plants.
- iii) Union for the Preservation and Protection of Plant Varieties.

18) Which of the following is false concerning the claims under patents specifications ?

- i) They define the scope of the invention.
- ii) They should be put at the beginning of the specification.
- iii) They must explicitly describe the invention.
- iv) They set the boundaries for the invention.

19)identifies the product and its origin, it also creates an image of the product.

- i) Trademark.
- ii) Certification Mark.
- iii) Collective Mark.
- iv) Service Mark.

20) What most accurately describes a Trade mark ?

- i) An original literary work registered by a company.
- ii) A protected ornamental design for an article of manufacture.
- iii) A brand name.
- iv) A protected original work of authorship like a novel.

21) I can use the symbol ® to claim my right in a trademark before I apply for a trademark registration.

- i) True.
- ii) False.

22) Methods of surgery or medical treatment are not patentable in India.

- i) True.
- ii) False.

23) Invention : Patent : Signature.

- i) Copyright.
- ii) Trademark.
- iii) Design.
- iv) Patent.

24) WIPO is an acronym from -

- i) World Industrial Property Organization.
- ii) Women's Intellectual Property Organization.
- iii) World Intellectual Property Organization.
- iv) World Indian People's Organization.

25) means, a Trademark distinguishing the goods or services of members or association of persons which is the proprietor of the mark from those of the others.

- i) Certification mark.
- ii) Collective Mark.
- iii) Trademark.
- iv) Geographical Indication.

26) Why is it necessary to protect the Intellectual Property Rights ?

- i) Because, it is both, just and appropriate that the person putting in the work and effort into or intellectual creation has some benefit as a result of this endeavour.
- ii) Because, by giving protection to intellectual property many such endeavours are encouraged, and industries based on such work can grow as people see that such work brings financial returns.
- iii) Because, India is developing country and it must create at least 25 new laws every year.

27) is a treaty that provides for the filing of application with a view to obtaining patent protection in a large number of countries.

- i) Paris Convention.
- ii) Patent Co-operation Treaty.
- iii) TRIP's Text.
- iv) Bern Convention.

28) What do you mean by Deceptive Similarity ?

29) Section of the Trademark Act, 1999 defines the term trademark.

- i) 2 (1) (za).
- ii) 2 (1) (zb).
- iii) 2 (1) (j).
- iv) 2 (1) (zc).

30) All the collective marks are trademarks, but all trademarks are not collective marks.

- i) True.
- ii) False.

31) Exclusive Marketing Rights refer to the exclusive rights toan article or substance in India.

- i) Manufacture.
- ii) Market.
- iii) Sell or distribute.
- iv) Assign.

32) According to Section 13 of the Copyright Act, 1957, what are the classes of work in which copyright subsists ? (Answer in a single sentence).

33) What is meant by the term 'publication' under the Copyright Act, 1957 ? (Answer in a single sentence).

34) Which of the following would be entitled to Copyright protection?

- i) Books.
- ii) Music.
- iii) Invention.
- iv) Logos.

(v) Paintings:

35) A new way to process milk, so that, there is no fat in any cheese made from it! Which IPR can give it protection ?

- i) Trademark.
- ii) Patent.
- iii) Copyright.
- iv) Service Mark.

36) What do you mean by Abridgment under the Copyright Act, 1957 ?

37) What do you mean by Adaptation under the Copyright Act, 1957 ?

38) Match the works in column 'A' with the correct acts that are authorized to be done from column 'B' under the Copyright Act, 1957.

- | 'A' | 'B' |
|--------------------------|---|
| 1. Musical Work. | a) To sell or give on commercial rental any copy. |
| 2. Computer prog Ramesh. | b) To make any adaptation of the work. |
| 3. Artistic Work. | c) To make a copy including a photograph of any image forming part thereof. |
| 4. Cinematograph film. | d) Depiction in 3 dimensions of a 2 dimensional work. |

39) Define an Indian work under the Copyright Act, 1957. (Answer in a single sentence).

40) Define the term 'Performer' under the Copyright Act, 1957. (Answer in a single sentence).

SECTION - II (60 Marks)

Q. II : Answer Any Two : = 20.

- 1) State and discuss the works in which copyright may subsist under the Copyright Act, 1957.
- 2) State the provisions of the Patents Act, 1970 in respect of suits concerning infringement of patents.
- 3) Discuss the grounds for refusal of registration of a Trademark under the Trade Marks Act, 1999.

Q. III : Write short notes (not exceeding 10 sentences) on Any Four : = 20.

- a) Patent Co-operation Treaty.
- b) Rights and Obligations of Patentee.
- c) Fair Use.
- d) Passing off Action.
- e) Certification of Trademarks.
- f) Anton Pillar Injunction.

Q. IV : Attempt Any Two : = 20.

(1) Ramesh and Dinesh filed patent application with provisional specification on the same date for the same invention. After that, Ramesh filed a complete specification much earlier to

Dinesh, both filed within the allowed period. Examine the status of the patent applications filed by both Ramesh and Dinesh.

a) If Ramesh adopted the idea from Dinesh dishonestly.

Answer : As Ramesh filed the complete specification much earlier than to Dinesh, it will not amount to infringement.

b) Both Ramesh and Dinesh are honest independent inventors conducting their own separate experiments.

Answer : The inventions will be patented of both, Ramesh, and Dinesh, as they are their own separate experiments.

(2) Rayaana, a chocolate company, marketed its product, Dollops Cake in a brown wrapper with a distinct white creamish font and a small girl wearing a white frock holding one piece of Dollops Cake. The wrapper was very familiar with kids, and on seeing the wrapper they were able to identify Dollops Cake. Fletcher, another chocolate company, came up with a product, Dollops Cream Cake using Rayaana's idea. The wrapper was brown in colour with the white creamish font but with smaller letters and little grammatical changes. A small boy wearing white trousers holding a piece of Dollops Cream Cake, was displayed on the wrapper.

a) Can Rayaana apply for registration of the word Dollops Cake as a Trademark in respect of his product ?

Answer : Yes, Rayaana can apply for registration of the word 'Dollops Cake' as a Trade Mark in respect of his product.

b) Can Rayaana claim protection under common law ?

Answer : Yes, Rayaana can claim protection under the Common Law by making an application for registration of Trade Mark.

c) Does Fletcher's action amount to passing off ?

Answer : Yes, Fletcher's action amounts to passing off as the Ice-cream wrapper colour and letters are identical and deceptively similar.

d) State which Court Rayaana to approach to seek relief ?

Answer : Rayaana can approach any Court inferior to a District Court having jurisdiction to try a suit.

e) Can Rayaana make a criminal complaint ?

Answer : Yes, Rayaana can make a criminal complaint.

(3) Joy, a company, brought into market, a play toy named "Popper", a spring balance on which children can stand on and jump, and it became instantly famous. The spring was made of iron, and hence, it had many practical problems. Freek, another company, came up with the same toy with a different name "Snooper", made of a material which solved all the practical problems which "Popper" had.

a) Whether Freek can claim patent protection for "Snooper", a modified version of "Popper" ?

Answer : Yes, Freek can claim patent protection for "Snooper", a modified version of "Popper".

b) Would "Popper" anticipate "Snooper" ?

Answer : Yes, it can. The modified version is always possible.

c) Can Freek file a PCT application to get a global patent ?

Answer : Yes, Freek can file PCT application to get global patent.

d) Would it make any difference to the patent prospect if "Snooper" was displayed at an exhibition before the date of making the patent application ?

Answer : No, it would have made no difference.

e) Added to the above facts, assume Freek adopted the same logo and style of writing, as that of Joy in such a way that, it was strikingly similar to that of Joy. Can Joy proceed against Freek for copyright infringement in respect to the style of writing?
Answer : Yes, certainly, Joy can proceed against Freek for infringement.

[7]

[November, 2006]

(Old and Revised Course)

With Solutions

N.B. :

- 1) Answer Section I on the Question Paper itself;
- 2) Use Answer Sheets and Additional Sheets for Section II;
- 3) Section I shall be collected at the end of the first hour of the examination.

SECTION – I (40 Marks) :

Q. I : Tick the appropriate option :

- 1) A mechanical product patent expires after years from the date of filing the patent application.
 - a) Fourteen.
 - b) Seven.
 - c) Sixty.
 - d) Twenty.
- 2) Opposition to the grant of a patent, must be filed before the expiry of a period of months from the date of publication of grant of a patent.
 - a) 24.
 - b) 18.
 - c) 12.
 - d) None of the above.
- 3) Copyright does not subsist in identical works.
 - a) True.
 - b) False.
- 4) Ordinarily, application for patents shall be open to the public, after a period of months from the date of application.
 - a) 24.
 - b) 18.
 - c) 16.
 - d) 3.
- 5) A method of playing game(s) is a patentable subject matter under the Patents Act, 1970.

- a) True.
- b) False.

6) Define a 'Registered User' as under Section 2 (x) of the Trade Marks Act, 1999.

Answer : A "Registered User" as defined under Section 2 (x) of the Trade Marks Act, 1999, is a person other than the registered proprietor of a trademark, who is registered as a registered user in respect of any or all of the goods or services in respect of which the trademark is registered.

7) Meaning of 'publication' as under the Copyright Act, 1957. (Answer in a single sentence).

Answer : Under Section 3 of the Copyright Act, 1957, 'publication' means, making a work available to the public by issuing copies or by communicating the work to the public.

8) Registration of registered trademark must be renewed every years.

- a) 5.
- b) 10.
- c) 7.
- d) 15.

9) Preliminary advice as to distinctiveness of a Trademark can be obtained from the Registrar of trademarks.

- a) True.
- b) False.

10) Under the Copyright Act, 1957, Copyright shall subsist in an Artistic Work during the life of the Author plus years following the year in which the author dies.

- a) 65.
- b) 20.
- c) 50.
- d) 60.

11) Define the term 'invention' as under the Patents Act, 1970.

Answer : 'Invention' as defined under Section 2 (i) (j) of the Patents Act, 1970, means, a new product or process involving an inventive step and capable of industrial application.

12) Unless otherwise stated, the rights assigned under the Copyright Act, 1957, must be exercised within year(s).

- a) 1.
- b) 2.
- c) 3.
- d) 4.

13) Who amongst the following, is not a 'Performer' ?

- a) A Magician.
- b) A Singer.
- c) A Lecturer.
- d) A Lyricist.

14) An honest concurrent user of a trademark, may be permitted registration of the mark by the Registrar.

a) True.

b) False.

15) Acquiescence could be a good defence in an action for infringement of trade mark.

a) True.

b) False.

16) Ordinary dictionary words like Cycle, Parachute, Parrot are not registerable as trade marks.

a) True.

b) False.

17) Opposition to the registration of a trade mark must be filed within months of its advertisement.

a) 3 + 1.

b) 1 + 1.

c) 2 + 1.

d) 5.

18) An individual cannot apply for a patent as its inventor.

a) True.

b) False.

19) Under the Copyright Act, 1957, an Author of a work may relinquish all or any of the rights in his works.

a) True.

b) False.

20) The Copyright Act, 1957, does not extend to the whole of India.

a) True.

b) False.

21) For Copyrights to subsist in a particular work, the work must be –

a) Novel.

b) Different.

c) Original.

d) Unusual.

22) Commercial (business) secrets can be protected under –

a) Trade Marks Act, 1999.

b) Patents Act, 1970.

c) Official Secrets Act.

d) None of the above.

23) The date of the is the relevant date for setting the priority date of the patent.

a) Patent grant.

- b) Examination report.
- c) Patent application.
- d) Publication.

24) Means, a mark distinguishing the goods and service of member of an association of persons which is the proprietor of the mark from those of others.

- a) Certification Mark.
- b) Collective Mark.
- c) Geographical Indication.

25) Translation of a book would be protected under –

- a) Derivative Rights.
- b) Copyrights.
- c) Related Rights.
- d) Personal Rights.

26) Which of the following are the rights conferred by the Copyright Act, 1957 ?

- a) Statutory Rights.
- b) Multiple Rights.
- c) Moral Rights.
- d) All the above.

27) Match the questions in column 'A' with the correct intellectual property from column 'B'.

- | 'A' | 'B' |
|-------------------|-----------------------------|
| 1. A Pharma Drug. | a) Copyrights. |
| 2. Kodak. | b) Geographical Indication. |
| 3. Champagne. | c) Patent. |
| 4. A Painting. | d) Trade Mark. |

Answer :

1. c. 2. d. 3. b. 4. a.

28) What are the two rights of a Patent Agent under the Patents Act, 1970 ?

Answer : 1) Every Patent Agent whose name is entered in the register, shall be entitled to practice before the Controller; and 2) shall be entitled to prepare all documents, transact all business and discharge such other functions, as may be prescribed, in connection with any proceeding before the Controller, under this Act.

29) Copyrights in sound recordings shall subsist until 60 years from the date of its

- a) Recording.
- b) Publication.
- c) First Sale.

30) A trade mark proposed to be used is registrable under the Trade Marks Act, 1999.

- a) True.
- b) False.

31) A mere arrangement of known devices each functioning independently, is not patentable.

2. Computer Programs (per se). b) Patentable.
3. Discovery of a natural phenomenon. c) Not Patentable.
4. A new type of vehicle. d) Not patentable.

Answer :

1. b. 2. a. 3. c. 4. d.

SECTION - II (60 Marks)

Q. II: Answer Any Two : Use a statutorii provision if it is applicable and answer in not more than 200 words = 20.

1) Procedure for grant of a Patent as under the Patents Act, 1970.

Answer :

- a) File application in the Patent office along with the prescribed fees;
- b) Accompanied by provisional / Complete Specification.
- c) Specification should give the details of the invention and claims which the Patentee wishes to protect;
- d) On receiving such application, the Controller forwards the application to an examiner to conduct a thorough scrutiny of the application, whether it is in conformity with the rules prescribed under the Act;
- e) Where the examiner determines some objections or amendments that are to be made with respect to the invention, he informs the Controller, who in turn puts it to the notice of the applicant;
- f) Post alterations / amendments, if the application is approved, it is published in the Official Gazette;
- g) If the application is unopposed within a period of 3 + 1 months from the date of publication, a Patent is granted to the applicant.

2) Under Section 13 of the Copyright Act, 1957, copyright shall subsist in original literary, dramatic, musical, and artistic works. Explain the concept of 'Original' as under Section 13. Give examples.

Answer :

Copyright as defined under Section 14 of the Copyright Act, 1957, means the exclusive right to do or authorize others to do certain acts in relation to -

Original, Literary, Dramatic, musical Works;

Artistic Works;

Cinematograph Films; and

Sound Recording.

Copyright subsists only in a original work. The word 'original' does not mean that the work must be the expression of original or inventive thought. The originality which is required, relates to the expression of the thought, but the expression need not be in an original or novel form.

There is no copyright in ideas, however original or brilliant they may be.

3) State the grounds for absolute grounds for refusal of registration of a trade mark under the Trade Marks Act, 1999.

Answer :

Section of the Trade Marks Act, 1999, lists the following grounds being absolute grounds for refusal of a trademark registration -

1. Such trademarks which are devoid of any distinctive character, i.e. not capable of distinguishing the goods or services of one person from those of another.

2. Trademarks which consist exclusively of such marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin, etc.
3. Such trademarks which consist exclusively of marks or indications which have become customary in the current language or in the bonafide or established practices of the trade.
4. Such trademarks which are of such nature as to deceive the public or cause confusion.
5. If it contains any matter likely to hurt the religious sentiments of any class / section of society.
6. If it comprises or contains scandalous or obscene matter.
7. If its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.
8. A mark shall also be not registered as a trademark if it consists exclusively of the shape of goods which results from the nature of goods themselves or the shape which gains substantial value to the goods.

Q. III : Write short notes (not exceeding 10 sentences) Any Four : = 20.

a) Patent Agent.

Answer :

(Sections 125 to 130) – A person shall be qualified to be a patent Agent, if he is a citizen of India, has completed 21 years of age, has obtained a degree in science, engineering or technology from a recognized University in India and, in addition, has passed the qualifying examination.

Every Patent Agent shall be entitled to practice before the Controller and prepare all documents, transact all business and discharge such other functions as may be prescribed by the Controller.

The Patent Agent is authorized to sign all applications and communications to the Controller on behalf of the Patentee, who has duly authorized him in writing to do so.

b) Meaning of Copyright.

Answer :

The statutory definition of copyright is given under Section 14 of the Copyright Act, 1957. It means the exclusive right to do or authorize others to do certain acts in relation to –

Original literary, dramatic, musical Works;

Artistic Works;

Cinematographic Works;

Sound Recording.

Copyright subsists only in original work. The word 'original' does not mean that the work must be the expression of original or inventive thought. The originality which is required, relates to the expression of the thought, but the expression need not be in an original or novel form.

There is no copyright in ideas, however original or brilliant they may be.

c) Meaning and purpose of Trade Marks.

Answer :

Section 2 (1) (zb) – "trade mark" means, a mark capable of being represented geographically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and –

1. in relation to Chapter XII (i.e. "Offences, Penalties and Procedure", other than Section 107), a registered trade mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

2. in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by

way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

A trade mark is a visual symbol in the form of word, device, label applied to articles of commerce with a view to indicate to the purchasing public that they are goods manufactured or otherwise dealt in by a particular person or organization as distinguished from similar goods manufactured or dealt in by others.

In essence, a trademark is a visual representation attached to the goods for the purpose of indicating their trade origin.

A patent is a statutory grant containing certain monopolistic rights on the grantee for a definite period, subject to certain conditions.

d) Rights of a Patentee.

Answer :

Subject to other provisions contained in the Patents Act, 1970, and the conditions specified in Section 47, a patent granted under this Act shall confer upon the patentee -

- a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;
- b) where the subject matter of patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India.

e) Geographical Indications.

Answer :

According to Section 2 (e), "Geographical Indications" in relation to goods means, an indication which identifies such goods as agricultural goods, natural goods, manufactured goods as originating or manufactured in the territory where a given quality, reputation or other characteristics of such goods as essentially attributable to its geographical origin and in case where such goods are manufactured goods, one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region, or locality, as the case may be.

f) Passing off.

Answer :

Passing off is a form of tort. The object of this law is to protect the goodwill and reputation of a business from encroachment by dishonest competitors.

No man is entitled to represent his goods as being the goods of another man and no man is permitted to use any mark, sign, symbol, device, or other means, whereby he makes a false representation to somebody else, who is the ultimate customer.

The law of passing off has been extended to profession and non-trading activities.

Q. IV : Attempt Any Two :

= 20.

- 1) Zel Pvt. Ltd., an Indian company, is long-standing manufacturer of sports goods under a registered trademark OZONE, having sales in India. Only recently, Strauss USA has launched its sports goods in Mumbai, and in the USA, under the trademark OZ-1.

a) Zel desires to commence legal proceedings against Strauss in India. Advise on options available and reliefs that may be prayed for.

Answer : 1) Ex-parte Injunction; 2) Injunction (subject to such terms as the Court may deem fit); 3) Damages or an account of profits; 4) Delivery of infringing labels/marks for destruction.

b) Zel desires to commence legal proceedings against Strauss in the USA. Advise.

Answer : Legal proceedings in the U.S.A. would not be entertained. Trade Marks Act, 1999 is a territorial law having applicability in India. The cause of action has arisen in India and the Courts in India are the appropriate forum for adjudication.

c) Strauss has made a trademark application in India for their mark OZ-1. Advise Zel.

Answer : The application must be strenuously/carefully followed and if the same is accepted by the Registrar, Zel must oppose the application under Section 21 of the Trade Marks Act, 1999. The opposition must be filed within 3 + 1 months of mark being advertised in the Trade Mark Journal.

d) Assume Ozone was an unregistered trademark, what option/s would Zel then have ?

Answer : Zel would have a common law relief, viz. a suit for passing-off against Strauss.

2) Mr. Desai invents (i) a new kind of a weapon, capable of locating and killing human targets in the dark, and (ii) he uses the same invention to manufacture a rescue device capable of locating victims trapped underneath structures.

a) Mr. Desai desires to patent both his inventions. Advise.

Answer : In view of the fact that the invention can be clearly used purposes other than killing humans, the use of the invention is, and can be put to legitimate industrial use. Hence, Mr. Desai's patent application as a source device would be a good application. However, the first application of the invention would fail under Section 3 of the Patents Act, 1970.

b) M/s Gunner Corp. is willing to pay substantial money to Mr. Desai provided they are acknowledged as co-inventors. Mr. Desai likes the idea but wants clarifications. Advise Mr. Desai.

Answer : Section 6 of the Patents Act, 1970 refers to the "Persons Entitled to Apply" for a patent. Accordingly, M/s. Gunner Corpn. cannot apply as the co-inventor, because only the true and first inventor can file for a patent under sub-section 1 (a). However, M/s. Gunner Corpn. may obtain an assignment from Desai, and may then apply for a patent under sub-section 1 (b).

c) What steps and care must Mr. Desai be advised to take in relation to making of a PCT application ?

Answer : i) Must have filed a Complete Specification in a Convention country; ii) Must file a PCT application within 12 months of having filed the Complete Specification in a Conventional country.

d) Mr. Desai unfortunately dies before making a patent application. Would his legal representatives be eligible to make a patent application ?

Answer : Yes, under Section 6 (1) (c) of the Patents Act, 1970.

3) Universal Law Books (ULB) commissions Dr. Sengupta to write a book on Copyrights. The book is written and published and is available in the market.

a) Who is the Author of the book thus created ?

Answer : Dr. Sengupta is the Author – Definition Section 2 (d).

b) ULB distorts a few chapters in the book such that they are prejudicial to Dr. Sengupta's honour. Which right of Dr. Sengupta has been affected ?

Answer : The right under Section 17 and Moral Rights.

c) A student quotes extensively from Dr. Sengupta's work in his law exams. Would this amount to infringement ? Give reasons.

Answer : No. This is a permitted act under Section 52 of the Copyright Act, 1957.

d) Mr. Swami wants to translate the book into Tamil. Whose permission must he obtain ?

Answer : Permission from the owner of the Literary Works, i.e. ULB has to be obtained.

[April, 2007]

(Old and Revised Course)

With Solutions

N.B. :

- 1) Answer Section I on the Question Paper itself;
- 2) Use Answer Sheet and Additional Sheets for Section II;
- 3) Section I shall be collected at the end of the first hour of the examination.

SECTION – I (40 Marks) :

Q. I : Please tick the appropriate option :

1. means, the making of copies of a work, by photocopying or similar means.
 - a) Photography.
 - b) Cyclostyling.
 - c) **Reprography.**
 - d) Xeroxing.
2. What is the term of copyright in a cinematographic film ?
Answer : In the case of cinematographic film, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the film is published.
3. The right to sue for infringement cannot subsist unless that mark is registered under the Trade Marks Act, 1999:
 - a) **True.**
 - b) False.
4. A person shall not be qualified for appointment as the of the Intellectual Property Appellate Board, unless
 - a) President; he has been a Judge of the Supreme Court.
 - b) Vice Chairman; he has been a Judge.
 - c) **Chairman; he has or has been a Judge of a High Court.**
 - d) Vice Chairman; he is or has been a Judge of a High Court.
5. What is meant by the term 'performance' under the Copyright Act, 1957 ? (Answer in a single sentence).
Answer : "Performance", in relation to a performer's right, means any visual or acoustic presentation made live by one or more performers.
6. What is an 'international application' under the Patents Act, 1970 ? (Answer in a single sentence).

Answer : An 'international application' means, an application for patent made in accordance with the Patent Co-operation Treaty.

7. One of the grounds for refusal of registration is when a mark comprises or contains scandalous or obscene matter.
- proper.
 - absolute.
 - relative.
 - legal.
8. PCT is an acronym for -
- Public Copyright Treaty.
 - Patent Co-operation Treaty.
 - Patent Co-operative Treaty.
 - Patent Corporation Treaty.
9. If a person is aggrieved by an order of the Registrar of Trade Marks, then he can prefer an appeal to which court ?
- District Court.
 - High Court.
 - Intellectual Property Appellate Board.
 - Supreme Court.
10. Which of the following would be entitled to trademark protection ?
- Inventions.
 - Logos.
 - Paintings.
 - Hybrid Seeds.

11. What is the purpose of a certification trade mark ? (Answer in a single sentence).

Answer : The purpose of a certification trade mark is to show that the goods on which the mark is used, have been certified by some competent person in respect of certain characteristics of the goods, such as, origin, mode of manufacture, quality, etc.

12. Match the following in column 'A' with the correct rights from column 'B' which are granted under the Copyright Act, 1957.

- | 'A' | 'B' |
|--|---------------------|
| 1. Right to make a translation of any literary work. | a) Economic Right. |
| 2. Right to stop others from exploiting the work of the author. | b) Moral Right. |
| 3. Exploiting the work to bring economic benefit. | c) Negative Right. |
| 4. Right to prevent alterations that may damage the author's reputation. | d) Statutory Right. |

Answer : 1. - d); 2. - c); 3. - a); 4. - b).

13. A patentee has the exclusive right to prevent third parties from using the patented product unless such third parties obtain the patentee's consent.
- True.
 - False.
14. When the Government is not the first owner of a copyright in a Government work, then what is the term of copyright in such a work?
- 60 years.
 - 60 years from the beginning of the calendar year next following the year in which the work is first published.
 - 60 years from the ending of the calendar year next following the year in which the work is first published.
 - None of the above.
15. Which of the following statements is the correct statement ?
- Any person claiming to be the registered proprietor of a mark used or 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.
 - Any person claiming to be the proprietor of a 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 mark.
 - 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.
 - Any person claiming to be the registered 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.
16. The Trade Marks Act, 1999 has replaced the –
- The Trade Marks Act, 1940.
 - The Trade and Merchandise Marks Act, 1958.
 - The Trade Marks Act, 1958.
 - The Trade Merchandise Marks Act, 1957.
17. A photo-lithograph is a photograph, however, a lithograph is an engraving.
- True.
 - False.
18. If an application for a patent is filed along with a provisional specification, then a specification is required to be filed within twelve months from the date of the filing of the application.
- final.
 - absolute.
 - complete.
 - final and complete.
19. Means, a trade mark distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others.

- a) Certification Trade Mark.
b) Collective Mark.
c) Trade Mark.
d) Geographical Indication.
20. Where a patent granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to in the patent.
a) an equal individual share.
b) a joint share.
c) a joint undivided share.
d) an equal share.
21. Which of the following remedies can be used to protect an intellectual property right in India ?
a) Injunction.
b) Anton Pillar Order.
c) Account for Profit.
d) All of the above.
22. The Madrid System is related to which of the following ?
a) Copyrights.
b) Trade Marks.
c) Patents.
d) Designs.
23. The Vice-Chairman of the Intellectual Property Appellate Board may, by notice in writing under his hand, addressed to, resign his office.
a) The Chairman.
b) The Central Government.
c) The President of India.
d) The Governor.
24. Define the term 'person interested' under the Patents Act, 1970. (Answer in a single sentence).
Answer : 'person interested' includes a person engaged in, or in promoting, research in the same field as that to which the invention relates.
25. What is the purpose of a certification trade mark ? (Answer in a single sentence).
Answer : The purpose of certification trade mark is to show that the goods on which the mark is used, have been certified by some competent person in respect of certain characteristics of the goods, such as, origin, mode of manufacture, quality, etc.
26. Cinematographic film as defined under the Copyright Act, 1957, includes video tape.
a) True.
b) False.
27. There is a special provision which has been recently inserted in the Trade Marks Act, 1999 which allows an action for infringement of an unregistered trade mark.

- a) True.
- b) False.

28. Which of the following will not be considered as a ground for prohibition of registration of a design under the Designs Act, 2000 ?

- a) It is not new or original.
- b) It has been disclosed to the public.
- c) It is not useful.
- d) It contains scandalous or obscene matter.

29. Using the provisions of the Patents Act, 1970, identify which of the following will/will not be considered as inventions. Mention your answer in column 'B' as either Invention/Not an invention.

- | | |
|---|--------------------------|
| 1. Presentation of information. | <u>Not an Invention.</u> |
| 2. A device to create rain anytime, anywhere. | <u>Not an Invention.</u> |
| 3. System of aiding hearing. | <u>Invention.</u> |
| 4. Discovery of scientific principle. | <u>Not an Invention.</u> |

30. A body corporate shall be deemed to be domiciled in India if it is –

- a) Doing business in India.
- b) Incorporated under any law in force in India.
- c) Having its registered office in India.
- d) having its principal place of business in India.

31. An application for patenting an invention may be made by any person claiming to be the Inventor of the invention.

- a) first.
- b) true and first.
- c) sole.
- d) only.

32. One of the main purposes of enacting the Trade Marks Act, 1999, is to prevent the use of fraudulent marks.

- a) True.
- b) False.

33. Define the term 'notify' under the Trade Marks Act, 1999. (Answer in a single sentence).

Answer : According to Section 2 (1) (p) of the Trade Marks Act, 1999, 'notify' means, to notify in the Trade Mark journal published by the Registrar.

34. Define 'invention' (Answer in a single sentence).

Answer : According to Section 2 (1) (i), of the Patents Act, 1970, "invention" means, a new product or process involving an inventive step and capable of industrial application.

35. Which of the following are the rights conferred by copyright under the Copyright Act, 1957 ?

- a) Statutory Right.

- b) Moral Right.
- c) Negative Right.
- d) Multiple Rights.
- e) All of the above.

36. Every broadcasting organization shall have a special right to be known as in respect of its broadcasts.

- a) broadcast marketing right.
- b) exclusive marketing right.
- c) broadcast reproduction right.
- d) exclusive-reproduction right.

37. It is not necessary that every literary and artistic work for the purpose of copyright protection, should have artistic merit.

- a) True.
- b) False.

38. Define 'work of sculpture' under the Copyright Act, 1957? (Answer in a single sentence).

Answer : Under Section 2 (za) of the Copyright Act, 1957, "work of sculpture" includes casts and models.

39. Which of the following is the oldest agreement governing copyright?

- a) Berne Convention.
- b) Paris Convention.
- c) TRIPS Agreement.
- d) Simla Agreement.

40. State the works in which copyright subsists. (Answer in a single sentence).

Answer : Copyright subsists in the following works –

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

SECTION – II (Marks : 60)

Q. II : Each question carries 10 marks. Answer Any Two :

= 20.

A) State the term of copyright in various works.

Answer :

Section 22 – Subsistence of Copyright :

Section 22 of the Copyright Act, 1957, states in which work the "copyright" shall subsist for how many years. Accordingly, : "Term "copyright" in published literary, dramatic, musical and artistic works – Except as otherwise hereinafter provided, copyright shall subsist in any literary, dramatic, musical or artistic work (other than a photograph) published within the lifetime of the author until sixty years from the beginning of the calendar year next following the year in which the author dies.

Explanation – In this Section, the reference to the author shall, in the case of a work of joint authorship, be construed as a reference to the author who dies last.

Section 23 – Term of copyright in anonymous and pseudonymous works (other than photograph)

In the case of literary, dramatic, musical or artistic work (other than a photograph), which is published anonymously or pseudonymously, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published, or – If the identity of the author is disclosed before the expiry of the said period, the copyright shall subsist until sixty years from the beginning of the calendar year following the year in which the author dies.

Section 24 – Term of copyright in posthumous work :

In the case of literary, dramatic, musical work or an engraving, in which copyright subsists at the date of the death of the author, or – In the case of any such work of joint authorship, at or immediately before the date of the death of the author who dies last – work or any adaptation has not been published before that date copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published, or – If an adaptation of the work is published in any earlier year, the copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published.

Section 25 – Term of copyright in photographs :

In the case of a photograph, copyright shall subsist until 60 years from the beginning of the calendar year next following the year in which the photograph is published.

Section 26 – Term copyright in cinematograph films :

In the case of a cinematograph film, copyright shall subsist until 60 years from the beginning of the calendar year next following the year in which the film is published.

Section 27 – Term copyright in sound recording :

In the case of a sound recording, copyright shall subsist until 60 years from the beginning of the calendar year next following the year in which the sound recording is published.

Section 28 – Term copyright in Government works :

In the case of Government work, where the Government is the first owner of the copyright therein, copyright shall subsist until 60 years from the beginning of the calendar year next following the year in which the record is first published.

Section 28A – Term copyright in works of public undertakings :

In the case of Government work, where the public undertaking is the first owner of the copyright therein, copyright shall subsist until 60 years from the beginning of the calendar year next following the year in which the work is first published.

Section 29 – Term copyright in works of international organizations :

In the case of Government work of any international organization to which the provisions of Section 41 apply, copyright shall subsist until 60 years from the beginning of the calendar year next following the year in which the work is first published.

B) Define the term ‘invention’ and enumerate the inventions not patentable under the Patents Act, 1970.

Answer :

Section 2 (1) (i) of the Patents Act, 1970, defines –

“invention” means, a new product or process involving an inventive step and capable of industrial application”.

Section 2 (1) (ja) of the Patents Act, 1970, defines –

“inventive step” means, a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both, and that makes the invention not obvious to a person skilled in the art”.

Section 2 (1) (ac) of the Patents Act, 1970, defines “capable of industrial application”, in relation to an invention, means that, the invention is capable of being made or used in an industry”.

Section 3 (a) to (p) of the Patents Act, 1970, gives the list of inventions which are not patentable.

They are as under –

i) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

ii) an invention, the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;

iii) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature;

iv) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance, or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;

Explanation – For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;

v) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;

vi) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

omitted by Act 38 of 2002 Section 4 w.e.f. 20-5-2003;

vii) a method of agriculture or horticulture;

viii) any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;

ix) plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;

x) a mathematical or business method or a computer program per Section or algorithms;

xi) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;

xii) a mere scheme or rule or method of performing mental act or method of playing game;

xiii) a presentation of information;

xiv) topography of integrated circuits;

xv) an invention which is in effect, in traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

Section 4 : Inventions relating to atomic energy not patentable –

“No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962.

Section 5 : Inventions where only methods or processes of manufacture patentable – (Repealed by the Patents (Amendment) Act, 2005 w.e.f. 01-01-2005).

C) Discuss the grounds of refusal of registration of trade marks.

Answer :

Section 9 : Absolute Grounds for refusal –

No distinctive character – deceive the public or cause confusion – cause hurt to religious susceptibilities of any class or sections of citizens of India – scandalous or obscene matter – prohibited under Emblems and Names (Prevention of Improper Use) Act, 1950.

Section 11 : Relative Grounds for refusal of registration –

Identity with an earlier trade mark – similarity of goods and services covered by the trade mark – similarity to an earlier trade mark and the identity or similarity of goods or services covered by the trade mark.

Q. III : Write Short notes on Any Four of the following : = 20.

a) Fair use.

Answer :

Section 52 of the Copyright Act, 1957 –

Fair dealing with literary, dramatic, musical or artistic work except computer program for private use including research and criticism or review – Example, reproduction for the purpose of a judicial proceeding or of a report of a judicial proceeding – in any work prepared by the Secretariat of a Legislature – reading or recitation in a public of any reasonable extract from a published literary or dramatic work – educational purpose, etc.

b) Provisional and Complete Specifications.

Answer :

Section 9 and 10 of the Patents Act, 1970 –

Full description of the invention – Contents – Title – full and particular description – disclosure of the best method of working the invention – scope of the invention – drawings.

S. 9 : Provisional and Complete Specifications –

- 1) “Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within 12 months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned”.
- 2) “Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications. Provided that, the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification”.
- 3) “Where an application for a patent is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within 12 months from the date of filing the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly”.
- 4) “Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification”.

Section 10 gives the contents of the specifications :

- 1) “Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates”.
- 2) “Every complete specification shall –
 - a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;
 - b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
 - c) end with a claim or claims defining the scope of the invention for which the protection is claimed;
 - d) be accompanied by an abstract to provide technical information on the invention”.

c) Provisional Specification :

When inventor is in the process of finalising his “invention”, he may file a specification (i.e. details/description for the product, design, material) known as “Provisional Specification” which is not a full and specific description, as it contains only a general description of the invention, its field of application and anticipated results. The Provisional Specification need not contain the claim(s).

Why Provisional Specification is required to be filed ?

A provisional specification is filed in order to fix “priority date” of the “patent”. The Indian Patent Law recognizes “first-to-apply” principle, therefore, the inventor who first files the provisional specification with claim(s), he only can secure his invention against a similar claim for a patent being applied later by another inventor.

Note : Definitions of the following terms given in the Patents Act, 1970 –

“invention” means, a new product or process involving an “inventive step” and capable of “industrial application” – [Section 2 (1) (j)];

“inventive step” means, a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both, and that makes the invention not obvious to a person skilled in the art” – [Section 2 (1) (ja)];

“capable of industrial application”, in relation to an invention, means that, the invention is capable of being made or used in an industry” – [Section 2 (1) (ac)];

“priority date”

Priority date of a claim is the date on which a provisional specification containing the claim is filed;

“patent” means, a patent for any invention granted under this Act” – [Section 2 (1) (m)].

d) Rights conferred by registration of trade marks.

Answer :

Exclusive right to use the mark in relation to goods or services – Right to file suit for infringement and obtain injunction, damages, account of profits – Use of mark beyond the scope of rights granted by the Registrar is not protected – Registration does not entitle proprietor to file infringement suit against proprietor of identical or similar registered mark – registered mark can be used by any person to identify goods or services if use is in accordance with honest practices.

e) Injunction.

Answer :

Civil remedy – Judicial process or order restraining a person from continuing a wrongful act – Anton Pillar Order – Mareva – Interlocutory – Permanent Ad-interim.

f) Patents Agents.

Answer :

Qualifications – Citizen of India, 21 years of age, degree in science, technology, engineering from any recognized university, passed qualifying exam or Advocate or minimum 10 years experience as an Examiner or Controller – Rights of Patent Agents – entitled to practice before Controller, prepare all documents, sign all applications.

Satyam Infoway v/s. Siffynet Solutions; AIR 2004 S.C. 3540.

Answer :

Appellant having business under domain name siffy.com – Respondent begins business under siffynet.com – Domain name considered to have characteristics of trade mark – Similar domain names creating confusion – Passing of action by Siffy against Siffynet – Held – visually and phonetically similar, causing confusion, no possible reason given by Siffynet to use Siffynet as domain name, therefore, seeking to cash in on the reputation and goodwill of Siffy – Respondent restrained from using the name Siffynet.

Q. IV : Attempt Any Two : = 20.

1) Samir has written a book on Mathematics. The book has been published by leading publisher Barber Collins.

a) Who is the author of the work ?

Answer : Samir is the author of the book.

b) A journalist uses extracts of the book in the review of the book published in the magazine. Will this amount to infringement ? Why ?

Answer : Not infringement, Private use, including research, Fair use and criticism or review, whether of that work or other work. – Section 52 of the Copyright Act, 1957.

c) A student extensively quotes from this book in his Maths exam. Will this amount to infringement ? Why ?

Answer : No, this will not amount to infringement, as a student in examination writes with his own intelligence and words in his own with quotes from the similar book, which does not amount to infringement under the Copyright Act, 1957.

d) Another person Anand makes 8 photocopies of this book and distributes it among his friends. Will this amount to infringement ? Why ?

Answer : It will certainly constitute infringement, as making photocopies and distributing among friend is itself an infringement of copyright. Copies made without consent of the author Samir, the action can be taken by the first owner of the copyright i.e. Samir.

2) Bhosale's, an ice cream company, manufactured and sold ice creams under the brand name 'Ice Kreem' written in bright red colour with a picture of white whipped cream on top of the letters. The brand was a huge success and was a big hit with the kids. Reddy's another rival ice cream company came up with a brand of its own 'I Scream' using Bhosale's idea, and here also, the words were written in combination of red and white. They were similar to the way Jello was written. Even the wrappers on the cones looked alike.

a) Can Bhosale's apply for registration of the word 'Ice Kreem' as a trade mark in respect of its product ?

Answer : Yes. Bhosale can apply for registration of the word 'Ice Kream' as a Trade Mark in respect of its product as it is distinctive and inventive.

b) Can Bhosale's claim protection under the Trade Marks Act, 1999 ?

Answer : Yes. Bhosale's can claim protection under the Trade Marks Act, 1999.

c) Will Reddy's action amount to passing off ?

Answer : Yes. Reddy's action will amount to passing off and not infringement.

d) Bhosale should approach which Court to seek relief ?

Answer : Bhosale's should approach any Court inferior to a District Court having jurisdiction to try a suit.

e) Can Bhosale's make a criminal complaint ?

Answer : Yes. Bhosale can file a criminal complaint.

3) Ajit has been granted a patent by the Indian Patents Office. He finds that Sujit has been copying his patent and creating similar articles and selling them in the market.

a) For how long will Ajit have the patent over his invention ?

Answer : 20 years from the date of filing of the patent application over his invention.

b) If Ajit wants to file a suit for infringement, in which Court has he to file a suit ?

Answer : Section 104 of the Patent Act, provides that the suit for infringement shall not be instituted . A suit has to be instituted in a District Court or in appropriate cases, in the High Court.

c) Can Ajit file an action for infringement if the term of patent has expired but infringement took place during the term of patent ?

Answer : Yes. Suit can be filed even after expiry if infringement occurred during the term of patent.

d) Apart from Ajit who could be the persons entitled to sue for infringement ?

Answer : Apart from the Patentee, his legal representative or exclusive licensee, compulsory licensee, Assignee, co-owners of a patent.

[9]

[November, 2007]

(Old and Revised Course)

With Solutions

N.B. :

- 1) Answer Section I on the Question Paper itself;
- 2) Use Answer Sheet and Additional Sheets for Section II;
- 3) Section I shall be collected at the end of the first hour of the examination.

SECTION – I (40 Marks) :

Q. I : Tick the appropriate option :

1. The date of the is the relevant date for setting the priority date of the patent.
 - a) Patent grant.

- b) Examination report.
- c) Patent application.
- d) Publication.

2. Match the questions in column "A" with the correct intellectual property right from column "B".

- | "A" | "B" |
|---|-----------------------|
| 1) A process to manufacture a chemical. | a) Copyright. |
| 2) Shape of a mobile phone. | b) Trademark. |
| 3) AMUL butter. | c) Patent. |
| 4) A Painting. | d) Industrial Design. |

Answer : 1. – c); 2. – d); 3. – b); 4. – a).

3. may give Notice of Opposition to the grant of a patent.

- a) Another Patent Holder.
- b) The Controller of Patent.
- c) Any Person.
- d) None of the Above.

4. A mechanical product patent has not expired at the commencement of the Patents (Amendment) Act, it shall have a term of Years from the date of filing of the patent application.

- a) 20.
- b) 14.
- c) 7.
- d) 10.

5. A discovery of any living thing or a non-living substance occurring in nature is not patentable under the Patents Act, 1970.

- a) True.
- b) False.

6. AGMARK –

- a) Corporate Trade Mark.
- b) Certification Marks.
- c) Geographical indication.
- c) Collective Marks.

7. In India, computer programs can be protected under –

- a) Trade Marks Law.
- b) Patent Law.
- c) Copyright Law.

8. An owner of a registered trade mark must renew the registration of the mark every year.

- a) 1.
- b) 7.
- c) 5.
- d) 10.

9. For the purposes of registrations under the Trade Marks Act, 1999, goods and services have been classified under the –
- Global Schedule.
 - First Schedule.
 - Berne Convention.
 - Fourth Schedule.**
10. Copyright in sound recordings shall subsist until 60 years following the calendar year in which the sound recording is –
- recorded.
 - published.**
 - first sold.
11. If the period of copyright assignment is not stated, it shall be deemed to be Years.
- 10.
 - 5.**
 - 2.
 - None of the above.
12. A singer has a right.
- Patent.
 - Design.
 - Musical.
 - Performers.**
13. The Registrar may permit the registration of trade marks which are identical or similar, in respect of the same goods, by more than one proprietor.
- True.**
 - False.
14. A picture/drawing of a cycle is registrable trade mark for use in connection with the cycle business.
- True.
 - False.**
15. What is meant by the term 'Performance' under the Copyright Act, 1957 ? (Single sentence answer).
- Answer : Section 2 (q) : 'performance', in relation to performer's right, means any visual or acoustic presentation made live by one or more performers.**
16. To be entitled to remedies under the law, it is mandatory that a trade mark be registered under the Trade Marks Act, 1999.
- True.
 - False.**
17. The Convention protects Literary and Artistic Works.
- Berne.**

- b) Milan.
c) Madrid.
c) Lagos.
18. A trade mark proposed to be used is registrable under the statute.
a) True.
b) False.
19. A mere arrangement of known devices, each functioning independently, is not patentable.
a) True.
b) False.
20. A true and first inventor of an invention passes away before making an application for a patent. The legal representatives of the deceased inventor seek advice in their right to make an application. Advice would be –
a) Can make the application.
b) Cannot make the application.
21. Unless otherwise stated, the rights assigned under the Copyright Act, 1957, must be exercised within year(s).
a) one.
b) two.
c) three.
d) four.
22. Under the Copyright Act, 1957, copyright shall subsist in a Dramatic Work during the life of the owner plus 60 years following the year in which the owner dies.
a) True.
b) False.
23. Which of the following civil remedies can be used in the defence of a copyright in India ?
a) Injunctions.
b) Damages.
c) Account for profit.
d) All the above.
24. Are the following trade marks registrable under the Trade Marks Act, 1999 ?
(Assumption : no other supporting material is available except as mentioned in the question).
- | <u>Trade Mark</u> | <u>Goods</u> | <u>Evidence of Use</u> | <u>Answer</u>
(Y/N) |
|-------------------|------------------|------------------------|------------------------|
| a) Dustic | Adhesives | Nil | _____ |
| b) Pizza | Ready-made Pizza | 2 years | _____ |
| c) Needle-Tip | Shoes | Nil | _____ |
| d) Excellent | Shirts | 5 years | _____ |
- Answer : a) – Y; b) – N; c) – Y; d) – N.

25. An Artistic Work is used as a trademark, which of the following Acts would assist its owner in its protection ?

- a) Trade Marks Act.
- b) Copyrights Act.
- c) Both the above.

26. What is a Collective Mark ? (Answer in brief).

Answer : Section 2 (g) : "collective mark" means a trade mark distinguishing the goods or services of members of an association of persons (not being a partnership within the meaning of Partnership Act, 1932) which is the proprietor of the mark from those of others.

27. As a business person, you would primarily adopt a trade mark-

- a) for tax purposes.
- b) because every business must have a trade mark.
- c) it identifies the product and its origins and guarantees quality.

28. Would China as a trade mark invite objections as to its registerability from the Registrar of trade marks ?

- a) Yes.
- b) No.

29. A suit for infringement cannot be instituted in any Court inferior to a Court.

- a) District.
- b) High.
- c) Magistrates.
- d) Any of the above.

30. Opposition to the grant of a patent must be filed before the expiry of period of months from the date of publication of grant of a patent.

- a) 24.
- b) 18.
- c) 12.
- d) none of the above.

31. A method of treating animals is a patentable subject matter under the Patents Act, 1970.

- a) True.
- b) False.

32. Commercial/business secrets can be protected under –

- a) Trade Marks Act.
- b) Patents Act.
- c) Official Secrets Act.
- d) None of the above.

33. Define the term 'invention' as under the Patents Act, 1970.

Answer : Invention means, a new product or a process involving an inventive step and capable of industrial application.

34. An honest concurrent user of a trade mark may be permitted registration of the mark by the Registrar.

- a) True.
- b) False.

35. What are Geographical Indications ?

Answer : Section 2 (e) of the Geographical Indication of Goods Act, 1999 : "Geographical Indication" means, an indication which identifies such goods as agricultural goods, natural goods or manufactured goods or originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristics of such goods are essentially attributable to its geographical origin (e.g. Sihor wheat – M. P.).

36. Under the Copyright Act, 1957, an Author of a work may relinquish all or any of the rights in his works.

- a) True.
- b) False.

37. Match the questions in column "A" with the correct answer from column "B".

Column "A"

Column "B"

- | | |
|--|--------------------|
| 1) Process Patents. | a) Not Patentable. |
| 2) Mere discovery of a non-living substance. | b) Patentable. |
| 3) Business Methods. | c) Not Patentable. |
| 4) Method of Agriculture. | d) Not Patentable. |

Answer : 1) Patentable. 2) Not Patentable. 3) Not Patentable. 4) Not Patentable.

38. An invention which in effect is a traditional knowledge is patentable.

- a) True.
- b) False.

39. A patent grant gives absolute monopoly which can never be diluted or over-ridden.

- a) True.
- b) False.

40. AIR (All India Reporter) can claim copyright in the head-notes appearing in their publications.

- a) True.
- b) False.

SECTION – II (Marks : 60)

Q. II : Answer Any Two :

= 20.

1) Compulsory Licence in work withheld from public.

Answer :

Section 31 of the Copyright Act, 1957 : Compulsory Licence in works withheld from public –

“If at any time during the term of copyright in any Indian work which has been published or performed in public, a complaint is made to the Copyright Board that the owner of copyright in the work –

a) has refused to re-publish or allow the re-publication of the work or has refused to allow the performance in public of the work, and by reason of such refusal, the work is withheld from the public; or

b) has refused to allow communication to the public by broadcast of such work or in the case of a sound recording, the work recorded in such sound recording, on terms which the complainant considers reasonable,

the Copyright Board, after giving the owner of the copyright in the work, a reasonable opportunity of being heard and after holding such inquiry as it may deem necessary, may, if it is satisfied that the grounds for such refusal are not reasonable, direct the Registrar of Copyrights to grant to the complainant a licence to re-publish the work, perform the work in public or communicate the work to the public by broadcast, as the case may be, subject to payment to the owner of the copyright of such compensation and subject to such other terms and conditions as the Copyright Board may determine; and thereupon, the Registrar of Copyrights shall grant the licence to the complainant in accordance with the directions of Copyrights Board, on payment of such fee as may be prescribed.

Explanation – In this sub-section, the expression “Indian work” includes –

i) an artistic work, the author of which is a citizen of India; and

ii) a cinematograph film or a sound recording made or manufactured in India.

“Where two or more persons have made a complaint under sub-section (1), the licence shall be granted to the complainant who in the opinion of the Copyright Board would best serve the interests of the general public”.

It may be noted here that, a question of grant of compulsory licence would arise only when the artistic work has been withheld from public. Compulsory licence need not be issued to all who apply and are ready to pay fee – *Super Cassette Industries Ltd. v/s. Entertainment Network (India) Ltd., AIR 2004 Del. 326.*

2) **Discuss :** a) the rights of a patentee; and b) the defences available to a defendant in a patent infringement suit under the Patents Act, 1970.

Answer :

Section 48 of the Patents Act, 1970 : Rights of Patentees –

“Subject to the other provisions contained in this Act, and the conditions specified in Section 47, a patent granted under this Act, shall confer upon the patentee –

1. where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

2. where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India.

Defences available to a defendant in a patent infringement suit –

In any suit for infringement of a patent, every ground on which it may be revoked under Section 64, shall be available as a ground for defence.

In any suit for infringement of a patent by the making, using or importation of a machine, apparatus or other article or by the using of any process or by importation, use or distribution or any medicine or drug, it shall be a ground for defence that, such making, using, importation or distribution is in accordance with any one or more of the conditions specified in Section 47.

3) Discuss the grounds for refusal of registration of a trade mark under the Trade Marks Act, 1999.

Answer :

Section 9 lays down the absolute grounds for refusal of registration. They are as under –

1) “The trade marks –

a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

c) which consist exclusively of marks or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;

shall not be registered :

Provided that, a trade mark shall not be refused registration, if before the date of application for registration, it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

2) A mark shall not be registered as a trade mark if –

a) it is of such nature as to deceive public or cause confusion;

b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

c) it comprises or contains scandalous or obscene matter;

d) its use is prohibited under the Emblems and names (Prevention of Improper Use) Act, 1950.

3) A mark shall not be registered as a trade mark if it consists exclusively of –

a) the shape of goods which results from the nature of the goods themselves; or

b) the shape of goods which is necessary to obtain a technical result; or

c) the shape which gives substantial value to the goods.

Explanation – For the purposes of this Section, the nature of goods or services in relation to which the trade mark is used or proposed to be used, shall not be a ground for refusal or registration”.

Thus, this Section makes it clear that the trade marks which are devoid of any distinctive character or which consists exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of goods or rendering of services or other characteristics of the goods or services or which consists exclusively of marks or indications which have become customary in the current language or in the *bona fide* and established practice of the trade, shall not be registered, unless it is shown that the mark has in fact acquired a distinctive character as a result of use before the date of application.

It also makes it clear that, a mark shall not be registered as a trade mark if – i) it deceives the public or causes confusion, ii) it contains or comprises of any matter likely to hurt the religious susceptibilities, iii) it contains scandalous or obscene matter, iv) its use is prohibited.

It further makes it clear that if a mark consists exclusively of a) the shape of goods which from the nature of the goods themselves, or b) the shape of goods which is necessary to obtain a technical result, or c) the shape which gives substantial value of the goods, then it shall not be registered as trade mark.

4) “There is no copyright in ideas” – Elucidate.

Answer :

Copyright does not subsist in “mere ideas”, but “in the expression of the ideas into the works” as mentioned in Section 13.

Section 13 : Works in which copyright subsists –

Copyright shall subsist throughout India in the following classes of works, that is to say, –

- a) Original, Literary, Dramatic, Musical Works;
- b) Artistic Works;
- c) Cinematograph Films; and
- d) Sound Recording.

Copyright shall not subsist in any work specified in sub-section (1), other than a work to which the provisions of Section 40 apply, unless, –

- a) in the case of a published work, the work is first published in India, or where the work is first published outside India, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of India;
- b) in the case of an unpublished work other than work of architecture, the author is at the date of the making of the work a citizen of India or domiciled in India; and
- c) in the case of work of architecture, the work is located in India.

Explanation – In the case of a work of joint authorship, the conditions conferring copyright specified in this sub-section, shall be satisfied by all the authors of the work.

Copyright shall not subsist –

- a) in any cinematograph film if a substantial part of the film is an infringement of the copyright in any other work;
- b) in any sound recording made in respect of a literary, dramatic or musical work, if in making the sound recording, copyright in such work has been infringed.

The copyright in a cinematograph film or a sound recording shall not affect the separate copyright in any work in respect of which or a substantial part of which, the film, or, as the case may be, the sound recording is made.

In the case of work of architecture, copyright shall subsist only in the artistic character and design and shall not extend to processes or methods of construction”.

Copyright subsists only in an original work. The word ‘original’ does not mean that the work must be the expression of original or inventive thought. The originality which is required, relates to the expression of the thought, but the expression need not be in an original or novel form.

There is no copyright in ideas, however original or brilliant they may be.

Section 14 of the Copyright Act, 1957, gives the meaning of the Copyright. It means, the exclusive right to do or authorize others to do certain acts in relation to certain classes of works specified under Section 13 as stated above.

5) Provisional and Complete Specifications.

(For answer, refer April, 2007 Question paper given above).

6) What is a Patent ? What are not regarded as inventions under the Patents Act, 1970 ?

Answer :

Section 2 (1) (m) of the Patents Act, 1970 (Amendment Act of 2005) defines “patent” as under – “patent” means, a patent for any invention granted under this Act”.

“invention” means, a new product or process involving an “inventive step” and capable of “industrial application” – [Section 2 (1) (i)];

“inventive step” means, a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art” – [Section 2 (1) (ja)];

“capable of industrial application”, in relation to an invention, means that, the invention is capable of being made or used in an industry”.

Section 3 (a) to (p) of the Patents Act, 1970, gives the list of inventions which are not patentable.

They are as under –

- a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- b) an invention, the primary or intended use or commercial exploitation of which could be contrary public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
- c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature;
- d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance, or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;

Explanation – For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance, shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;

- e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- g) omitted by Act 38 of 2002 Section 4 w.e.f. 20-5-2003;
- h) a method of agriculture or horticulture;
- i) any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- j) plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- k) a mathematical or business method or a computer program per Section or algorithms;
- l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever, including cinematographic works and television productions;
- m) a mere scheme or rule or method of performing mental act or method of playing game;
- n) a presentation of information;
- o) topography of integrated circuits;
- p) an invention which is in effect, in traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

Section 4 : Inventions relating to atomic energy not patentable –

“No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962.

Section 5 : Inventions where only methods or processes of manufacture patentable. (Repealed by the Patents (Amendment) Act, 2005 w.e.f. 01-01-2005)

Q. III : Write Short Notes (not exceeding 10 sentences) Any Four : = 20.

a) Copyright Societies.

Answer : Section 2 (ff) of the Copyright Act, 1957, defines "copyright society" as under – "copyright society" means, a society registered under sub-section (3) of Section 33".

Section 33 : Registration of copyright society –

- 1) No person or association of persons shall, after coming into force of the Copyright (Amendment) Act, 1994 commence or, carry on the business of issuing or granting licences in respect of any work in which copyright subsists or in respect of any other rights conferred by this Act except under or in accordance with the registration granted under sub-section (3) : Provided that, an owner of copyright shall, in his individual capacity, continue to have the right to grant licences in respect of his own works consistent with his obligations as a member of the registered copyright society:
Provided further that, a performing rights society functioning in accordance with the provisions of Section 33 on the date immediately before the coming into force of the Copyright (Amendment) Act, 1994, shall be deemed to be a copyright society for the purposes of this Chapter, and every such society shall get itself registered within a period of one year from the date of commencement of the Copyright (Amendment) Act, 1994".
- 2) "Any association of persons who fulfils such conditions as may be prescribed, may apply for permission to do the business specified in sub-section (1) to the Registrar of Copyrights who shall submit the application to the Central Government".
- 3) "The Central Government may, having regard to the interests of the authors and other owners of rights under this Act, the interest and convenience of the public and in particular of the groups of persons who are most likely to seek licences in respect of the applicants, register such association of persons as a copyright society subject to such conditions as may be prescribed :
Provided that, the Central Government shall not ordinarily register more than one copyright society to do business in respect of the same class of works".
- 4) "The Central Government may, if it is satisfied that a copyright society is being managed in a manner detrimental to the interests of the owners of rights concerned, cancel the registration of such society after such inquiry as may be prescribed".
- 5) "If the Central Government is of the opinion that in the interest of the owners of rights concerned, it is necessary so to do, it may, by order suspend the registration of such society pending inquiry for such period not exceeding one year as may be specified in such order under sub-section (4) and that Government shall appoint an administrator to discharge the functions of the copyright society".

Section 34 : Administration of rights of owner by copyright society –

"Subject to such conditions as may be prescribed, –

- a) a copyright society may accept from an owner of rights exclusive authorization to administer any right in any work by issue of licences or collection of licence fees or both; and
- b) an owner of rights shall have the right to withdraw such authorization without prejudice to the rights of the copyright society under any contract":

"It shall be competent for a copyright society to enter into agreement with any foreign society or organization administering rights corresponding to rights under this Act, to entrust to such foreign society or organization the administration in any foreign country of rights administered by the said

copyright society in India, or for administering in India the rights in a foreign country by such foreign society or organization :

Provided that, no such society or organization shall permit any discrimination in regard to the terms of licence or the distribution of fees collected between rights in Indian and other works”.

“Subject to such conditions as may be prescribed, a copyright society may, –

- i) issue licences under Section 30 in respect of any rights under this Act;
- ii) collect fees in pursuance of such licences;
- iii) distribute such fees among owners of rights after making deductions for its own expenses;
- iv) perform any other functions consistent with the provisions of Section 35”.

b) Concept of Author and Owner of a Copyright protected work.

Answer :

Section 2 (d) of the Copyright Act, 1957 defines “author” as under –
“author” means, –

- a. in relation to a literary or dramatic work, the author of the work;
- b. in relation to a musical work, the composer;
- c. in relation to an artistic work other than a photograph, the artist;
- d. in relation to a photograph, the person taking the photograph;
- e. in relation to a cinematograph film or sound recording, the producer; and
- f. in relation to any literary, dramatic, musical or artistic work which is computer-generated, the person who causes the work to be created”

Section 17 : First owner of copyright –

“Subject to the provisions of this Act, the author of the work shall be the first owner of the copyright therein :

provided that –

- a) in the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship, for the purpose of publication in a newspaper, or similar periodical, the said proprietor shall, in the absence of any agreement to the contrary, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical, or to the reproduction of the work for the purpose of its being so published, but in all other respects the author shall be the first owner of the copyright in the work;
- b) subject to the provisions of clause (a), in the case of a photograph taken, or a printing or portrait drawn, or an engraving or a cinematograph film made, for valuable consideration at the instance of any person, such person shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;
- c) in the case of a work made in the course of the author’s employment under a contract of service or apprenticeship, to which clause (a) or clause (b) does not apply, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;
- cc) in the case of any address or speech delivered in public, the person who has delivered such address or speech or if such person has delivered such address or speech on behalf of any other person, such other person shall be the first owner of the copyright therein notwithstanding that the person who delivers such address or speech, or, as the case may be, the person on whose behalf such address or speech is delivered, is employed by any other person who arranges such address or speech or on whose behalf or premises such address or speech is delivered;

d) in the case of a Government work, Government shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

dd) in the case of a work made or first published by or under the direction or control of any public undertaking, such public undertaking shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

Explanation – For the purposes of this clause and Section 28A, “public undertaking” means –

- i) an undertaking owned or controlled by Government; or
 - ii) a Government Company as defined in Section 617 of the Companies Act, 1956; or
 - iii) a body corporate established by or under any Central, Provincial or State Act;
- e) in the case of a work to which the provisions of Section 41 apply, the international organization concerned, shall be the first owner of the copyright therein”.

No ownership in case of mere ‘idea’ :

Donoghue v/s. Allied Newspaper Ltd. (1937) 3 ChD 503 –

A person may have a brilliant idea for a story, or for a picture, or for a play, which is his original idea; But if he communicates that idea to an author or a playwright or an artist, who clothes that idea in a form of a product – book, a play or a picture, such author, playwright or artist will have the copyright; and the owner of the idea has no rights in such product – book, play, picture, etc.

c) Collective Trademarks.

Answer :

Section 2 (1) (g) of the Trade Marks Act, 1999, defines the term “collective mark” as under – “collective mark” means, 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) (zb) of the Trade Marks Act, 1999, defines the term “trade mark” as under – “trade mark means, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours”.

Sections 61 to 68 of the Trade Marks Act, 1999, deal with Collective Marks. They are as under –

Section 61 : Special provisions for collective marks –

“The provisions of this Act shall apply to collective marks subject to the provisions contained in this Chapter”.

“In relation to a collective mark, the reference in clause (zb) of sub-section (1) of Section 2 to distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others”.

Section 62 : Collective mark not to be misleading as to character or significance –

“A collective mark shall not be registered if it is likely to deceive or cause confusion on the part of public in particular if it is likely to be taken to be something other than a collective mark, and in such case the Registrar may require that a mark in respect of which application is made for registration comprises some indication that it is a collective mark”.

Section 63 : Application to be accompanied by regulations governing use of collective marks –

1) “An application for registration of a collective mark shall be accompanied by the regulations governing the use of such collective mark”.

- 2) “The regulations referred to in sub-section (1) shall specify the persons authorized to use the mark, the conditions of the membership of the association, and the conditions of use of the mark, including any sanctions against misuse and such other matters as may be prescribed”.

Section 64 : Acceptance of application and regulations by Registrar –

“If it appears to the Registrar that the requirements for registration are satisfied, he shall accept the application together with the regulations, either unconditionally or subject to such conditions including amendments of such regulations, if any, as he may deem fit or refuse to accept it, and if accepted, shall notify the regulations”.

Section 65 : Regulations to be open to inspection –

“The regulations referred to in sub-section (1) of Section 63 shall be open to public inspection in the same way as the register as provided in Section 148”.

Section 66 : Amendment of regulations –

“Any amendment of regulations referred to in sub-section (1) of Section 63 shall not be effective unless the amended regulations are filed with the Registrar, and accepted and published by him in accordance with Section 64”.

Section 67 : Infringement proceedings by registered proprietor of collective mark –

“In a suit for infringement instituted by the registered proprietor of a collective mark as plaintiff, the Court shall take into account any loss suffered or likely to be suffered by authorized users and may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such authorized users”.

Section 68 : Additional grounds for removal of registration of collective mark –

“The registration of a collective mark may also be removed from the register on the ground –

1. that the manner in which the collective mark has been used by the proprietor or authorized user, has caused it to become liable to mislead the public as a collective mark; or
2. that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.

Explanation : I – For the purpose of this Chapter, unless the context otherwise requires, “authorized user” means, a member of an association authorized to use the registered collective mark of the association.

Explanation : II – For the purposes of this Act, use of a collective mark by an authorized user referred to in **Explanation I** shall be deemed to be the use by the registered proprietor thereof”.

d) Well-Known Trademarks.

Answer :

Section 2 (1) (zg) of the Trade Marks Act, 1999, defines the term “well-known trade mark” as under

“well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services would be likely to be taken as indicating a connection in the course of a trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services”.

e) Geographical Indications.

Answer :

Section 2 (1) (e) of the Geographical Indications of Goods Act: 1999, defines “geographical indication” as under –

“geographical indication”, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of goods concerned takes place in such territory, region or locality, as the case may be”.

Explanation – For the purposes of this clause, any name which is not the name of a country, region or locality of that country shall also be considered as the geographical indication if it relates to a specific geographical area and is used upon or in relation to particular goods originating from that country, region or locality, as the case may be.

A geographical indication is a sign used on goods that have a specific geographical origin and possesses qualities of a reputation that are due to that place of origin. In recent years, geographical indication has emerged as one of the most important instruments of protecting the quality, reputation or other characteristics of goods which are essentially attributable to their geographical origin. Geographical indication has proved to be very valuable as it identifies the source of the product and is an indicator of a quality. Most commonly, a geographical indication consists of the name of the place, which is the origin of the goods, such as “Darjeeling” (India) for tea, “Stilton” (England) for cheese, “Swiss” (Switzerland) for chocolate, “Roquefort” (France) for cheese, etc.

f) Passing-off.

Answer :

Passing-off is a tort that protects unregistered trade marks. Essentially, a trader must not sell their own goods under the pretence that they are the goods of another trader. Passing-off is a tort that is of strict liability i.e. the intention of the person passing itself off as another trader, is irrelevant.

The law of passing-off is based on common law. The object of this law is to protect the goodwill and reputation of a business from encroachment by dishonest competitors. Therefore, law of torts provides for the remedy for passing-off in an action against a person, who passes off his goods as the goods of another, for the civil wrong or tort of ‘deceit’.

Passing-off is the area of law that entitles a business to prevent businesses from unfairly using its goodwill. Goodwill is the attractive force that brings in customers and is the essence of what passing off protects. Otherwise known as the law of unregistered trade marks, it protects against all activities of a business that may lead the public into believing that they are the goods of actual trader who is famous in the market.

When a business misleads the prospective buyers into believing that his goods are those of another business of repute, and thus, it causes damage to that another business of repute or its goodwill; The damaged business in such cases, will be able to prevent that conduct of misleading customers. It does not matter whether the trader intended to mislead the customers/public. Thus, “passing off” protects the relationship of a business to its public. Goodwill may exist in a business name, packaging, branding, in a fictional character’s name, someone’s name [“image rights”].

Though, sub-section (1) of Section 27 of Trade Marks Act, 1999, states that, no action for infringement of unregistered trade mark would lie, sub-section (2) of the same Section 27 categorically states that, “Nothing in this Act shall be deemed to affect the rights of an action or remedies in respect thereof against any person for passing off goods or services as the goods or services of another person”.

Thus, Section 27 provides that no infringement action will lie in respect of an unregistered trade mark; but recognizes the common law rights of the trade mark owner to take action against any

person/trader for passing off goods as the goods of another person or as services provided by another person or the remedies thereof.

Q. IV : Attempt Any Two :

= 20.

1) Anil a research scientist, discovers a new phenomenon in physics. Using principles underlying this new discovery, Anil and Amit invent a product having substantial commercial potential. Anil and Amit have come to you for advice.

a) Would you advise Anil to obtain a patent in respect of his discovery? Give reasons either way.

Answer : No, Anil would be advised against making any effort to obtain a patent in respect of the said discovery. Under the Patents Act, 1970, only inventions are capable of securing patents and Section 3 of the said Act also discusses "what are not inventions" –

Section 3 (c) : What are not inventions – mere discovery of a scientific principle of the formulation of or the discovery of any living thing or non-living substance occurring in the nature.

Since Anil's work clearly falls under Section 3 (c), the same would not be granted a patent.

b) Would Anil and Amit together, be eligible for a patent? If no, who amongst them would have a better right?

Answer : Yes, Anil and Amit would be eligible for applying for a patent grant in respect of the product developed by them.

c) The inventor(s) would like to file a Complete Specification, but their claims are not yet ready. What advice would you give them under the circumstances?

Answer : The inventors should draft and file the 'provisional specifications' in respect of the patentable invention. They are not required to file their claims at this stage; however, the applicants must file the complete specifications within one year from the filing of the provisional specifications.

d) Further, the inventor(s) would like to discuss the discovery and the product at a scientific conference. What advice would you give them?

Answer : Since the discovery is not the subject matter of the patent, the scientist can discuss the same at the scientific conference. However, they are advised not to make any mention of the product, unless they have filed atleast a provisional specification in respect of the invention embodied in the product.

2) Dilip-Aziz, a team of music directors, create a musical work. Lyrics written by Aziz are blended to create a song. Amazing Video Company acquires rights enabling them to make a sound recording.

a) List the three classes of works in which copyright subsists.

Answer : i) Musical Works (the tune/melody); ii) Literary Works (the lyrics); iii) Sound Recording (the sound recording itself).

b) List the Authors in relation to the above three classes of works created.

Answer : i) Musical Works – Authors : Dilip Aziz; ii) Literary Works – Author : Aziz; iii) Sound Recording – Author : Amazing Video Company.

c) What must Amazing Video Company have done to acquire rights to make the sound recording?

Answer : Amazing Video Company would have either procured a licence or an assignment in the musical works and the lyrics. It would have enabled them to produce the sound recording embodying the two works protected under the Copyright Act, 1957.

d) If the song is to be later performed in an orchestra, whose permission must be obtained?

Answer : The permission of the Authors/Owners in the lyrics (literary works) and the tune/melody must be obtained. The Authors and First Owners being Aziz and Dilip Aziz, respectively. The Owner could also be Amazing Video Company, if an assignment has been affected.

3) Zel Pvt. Ltd., an Indian company, is long-standing manufacturer of sports goods under a registered trademark OZONE, having sales in India. Only recently, Strauss USA has launched its sports goods in Mumbai under the trademark OZ-1.

a) Zel desires to commence legal proceedings against Strauss in India – Advise on options available and reliefs that may be prayed for.

Answer : In an infringement suit filed before the appropriate Court, Zel Pvt. Ltd. may pray for, i) an injunction against Strauss restraining them from manufacturing any sports goods under the mark which is either the same or similar or deceptively similar to Zel's registered trade mark Ozone; ii) discovery of documents; iii) preserving of infringing goods, documents or other evidence which are related to the subject matter of the suit; iv) restraining the defendant from disposing of or dealing with his assets in any manner.

b) Strauss USA is of the opinion that since they are the prior users of the mark OZ-1 in the USA, Zel's mark should be removed from the register. Advise.

Answer : Unless Strauss can prove that their mark has achieved cross-border reputation in India; and further that there was no acquiescence on their part; and unless they can show any dishonesty on the part of Zel in use of the mark Ozone, Strauss would not have much hope of success in view of the fact that the Trade Mark Act, 1999 is a territorial statute.

c) Strauss is desirous of making a trademark application in India for their mark OZ-1. Briefly advise on the steps to adopt and the process involved.

Answer : Without addressing the question of registrability, Strauss would have to take the following steps, statutory and non-statutory, in the making of an application of registration of trade mark in India –

- Carry-out a search in the trade mark office for a conflict check;
- Carry-out market search for any conflicting marks;
- Make an application on Form TM-1 along with additional representation;
- Pay a Government fees of Rs. 2,500/-.

d) Assume Ozone was an unregistered trademark, what option/s would Zel then have ?

Answer : Zel would then not be entitled to file an infringement action, but would rather have to file an action for "Passing-off".

[10]

[April, 2008]

(Old and Revised Course)

With Solutions

N.B. :

- 1) Answer Section I on the Question Paper itself;
- 2) Use Answer Sheet and Additional Sheets for Section II;
- 3) Section I shall be collected at the end of the first hour of the examination.

Section – I (Marks : 40)

Q. I : Tick the correct option/Do as directed :

1. The Trade Marks Act applies –

- a) only to goods.
- b) only to service.
- c) to goods and services.
- d) neither to goods nor to services.

2. What does "bootlegging the recordings of performances" as decided in 'Exparte Island (1978) 3 ALL ER 824 (CA) Case – mean ?

- a) Making and selling unauthorized patent items.
- b) Making and selling unauthorized trade mark goods.
- c) Making and selling unauthorized recordings of live performances without the consent of the performers.
- d) None of the above.

3. An application for registration of Trademark for MRF4 (MRF Ltd. v/s. Faridabad, 1998 PTC (18) 485 Delhi, was refused on the ground of –

- a) Deceptive Similarity.
- b) No Distinctiveness.
- c) No Innovative.
- d) None of the above.

4. The English case of Erven Warnink v/s. Townend (1980 RPC 31) deals with the essential characteristic which must be present in order to create a valid cause of action for 'Passing off', are misrepresentation and it is made by a person in the course of trade. This case is known as –

- a) Lawyer Case.
- b) Advocate Case.
- c) Doctor Case.
- d) Professional Case.

5. Moral right relates to –

- a) Patent.
- b) Trademark.
- c) Design.
- d) Copyright.

6. Under Section 120 of the Patents Act, 1970, if any person falsely represents that any article sold by him is patented in India, then he is punishable with fine which may extend to –

- a) Ten Thousand Rupees.
- b) Fifty Thousand Rupees.
- c) One Lakh Rupees.
- d) Ten Lakh Rupees.

7. Literary work includes –

- a) drama.
- b) dance.
- c) photograph.
- d) computer programmes.

8. If a work is made or published by or under the direction or control of any Court, Tribunal or other judicial authority in India, it is known as a –

- a) Judicial Work.
- b) Tribunal Work.
- c) Government Work.
- d) Statutory Work.

9. Post-grant opposition means –

- a) opposition after the person applies for patent.
- b) opposition before the person applies for patent.
- c) opposition after grant of patent.
- d) opposition before grant of patent.

10. The Anton Piller order is an order so called, because, the practice of its issue was confirmed and consolidated in the case of –

- a) S.C. Advocate On-Record v/s. U.O.I., AIR 1999 SC 1.
- b) Ex-parte Island case (1978) 3 All ER 824 (CA).
- c) Keshavanand Bharati v/s. State of Kerala.
- d) Anton Piller K.G. v/s. Manufacturing Process Ltd. (1976) All ER 779.

11. The principles of national treatment is based on –

- a) Geneva Convention.
- b) Paris Convention.
- c) Berne Convention.
- d) Rome Convention.

12. The principle of "musical work is not merely a combination of melody and harmony or either of them. It must necessarily also have been printed, reduced to writing or otherwise graphically produced or reproduced for copyright" was held in –

- a) Anton Pillar K.G. v/s. Manufacturing Process Ltd. (1976) All ER 779.
- b) Ex-parte Island case (1978) 3 All ER 824 (CA).
- c) Gramo-phone Co. v/s. Super Cassette Industries, 1996 PTC 252 (Delhi).
- d) Govindan v/s. Gopal Krishnan (AI 1955 Mad 39).

Fill in the blank :

13. The may, by notification in the Official Gazette, appoint a person to be known as the Controller General of Patents, Designs and Trade Marks.

- a) State Government.
- b) Central Government.
- c) Central and State Government jointly.
- d) President of India.

14. Under the International Organizations relating to intellectual property rights, the term 'WIPO' represents

Answer : World Intellectual Property Organisation.

15. The performer's right subsists until years from the beginning of the next calendar year following the year in which the performance is made.

- a) 20.
- b) 25.
- c) 50.
- d) 60.

16. means, the making of copies of a work, by photocopying or similar means.

- a) Photography.
- b) Cyclostyling.
- c) Reprography.
- d) Xeroxing.

17. The treaty on Intellectual Property in respect of Integrated Circuits aims primarily at protection of

- a) Integrated Circuits and audio-designs (topographs).
- b) Integrated Circuits and electronic-designs (topographs).
- c) Integrated Circuits and layout-designs (topographs).
- d) Integrated Circuits and construction-designs (topographs).

18. The Report of the Canadian Royal Commission on Patents, Copyrights, Trademarks and Industrial Designs, 1957 says "....." is in effect a right to prevent the appropriation of the expressed results of the labours of an author by other person -

- a) Patents.
- b) Copyrights.
- c) Trademarks.
- d) Industrial Designs.

19. An application for a patent for an invention may be made by any person claiming to be the inventor of the invention.

- a) True and first.
- b) Sole.
- c) Original.
- d) None of the above.

20. According to Section 2 (n) of the Copyright Act, 1957, "lecture" includes address, speech and

- a) talk.
- b) oration.
- c) sermon.
- d) announcement.

21 means, any product or process involving an invention steps and capable of industrial application.

- a) Invention.
- b) Patent.
- c) Trademark.
- d) Lettermark..

State whether True or False :

22. A permitted user of a trademark can sue for infringement of that trademark.

- a) True.
- b) False.

23. The TRIPS agreement has been divided into Seven Parts and contains 73 Articles.

- a) True.
- b) False.

24. All unregistered trademarks can be assigned or transmitted with or without the goodwill of the business concerned.

- a) True.
- b) False.

25. The Supreme Court "in buyer's ignorance in chances of deception" while dealing the case in S.M. Dychem Ltd. v/s. Cadbury (India) Ltd., 2000 PTC 397 SC held that though two trademarks, namely, PIKNIK and PICNIC appear to be phonetically similar, in view of the difference in their essential features, the defendants would be restrained from using their trademark PICNIC.

- a) True.
- b) False.

26. The term patents is 20 years –

- a) True.
- b) False.

27. Description of invention is called specification and it is an essential part of patent.

- a) True.
- b) False.

28. Once the Registrar of Trade Marks has accepted an application for registration, then the acceptance cannot be withdrawn.

- a) True.
- b) False.

29. If a person is aggrieved by an order of the Controller of Patents, then he can prefer an appeal to the High Court.

- a) True.
- b) False.

30. Once the whole of a copyright is assigned, the author has no right to claim authorship of the work.

a) True.

b) False.

Answer in One sentence :

31. What is meant by the term 'duplicating equipment' ?

Answer : It means, any mechanical contrivance or device used or intended to be used for making copies of any work.

32. Under Patent law, the term EMRs represents ?

Answer : EMR refers to Exclusive Marketing Rights.

33. What is the difference between a trademark and property mark (write any one) ?

Answer : A mark used for denoting that movable property belongs to a particular person is called a property mark; While, a mark which is capable of distinguishing goods or services of one person from another is a trade mark.

34. Write any one of the differences between Product Patent and Process Patent under the Patents Act, 1970.

Answer : A product patent allows exclusive rights relating to the object or the end-product, while a process patent relates to a means to achieving an end product, therefore, the product patent gets more benefits for the patent owner.

35. Define 'Patent Co-operation Treaty' under the Patents Act, 1970.

Answer : It means, the Patent Co-operation Treaty done at Washington on the 19th day of June, 1970, as amended and modified from time to time.

36. What is meant by the term 'goods' under the Copyrights Act, 1957.

Answer : Goods means, anything which is the subject of trade or manufacture.

37. Define the term 'copyright society' under the Copyright Act, 1957.

Answer : It means, a society registered under sub-section (3) of Section 33.

38. Define the term 'literary work' under the Copyrights Act, 1957.

Answer : Literary Work includes computer programmes, tables and compilations including computer databases.

39. Write anyone of the distinction between 'Passing Off' and 'Infringement' under the intellectual property law.

Answer : For an action of passing, the trademark need not be registered, however, for an action of infringement, the trademark is compulsorily required to be registered.

40. What is the Budapest Treaty ?

Answer : It means, the "Budapest Treaty on the International Recognition of the Deposit of Micro-Organisms for the Purpose of Patent Procedure done at Budapest on 28th day of April, 1977 as amended and modified from time to time.

SECTION - II (Marks : 60)

Q. II : Answer Any Two :

a) Explain the procedure for registration of trademark and its renewal under the Trademark Act, 1999.

Answer :

Procedure for Recognition and Renewal :

Application to be filed by proprietor of trademark with Registrar of Trademarks in prescribed manner;

Application to be filed in prescribed form in the Trademark office within whose territorial limits the principal place of business in India of the applicant is situated;

Principal place of business in India has to be explained - Where a person carries on business in the goods concerned and where a person is not carrying on a business in the goods concerned and where a person does not carry on any business in India but is resident in India;

Every application to contain a recognition of the mark, it is to be filed in India within 6 months of filing an application in convention country;

After submission of application, acceptance as it is or acceptance subject to certain conditions or acceptance but later found to be accepted in error or rejection;

After acceptance application to be advertised in Trade Marks Journal, any person may oppose registration within 3 months of advertisement;

Registrar to serve copy of opposition on applicant within 2 months of receipt; applicant to send a counter statement, else application is deemed to be abandoned;

Hearing of both the parties based on the principles of Natural Justice;

If decision is in favour of applicant, then trademark is registered; If against, then an applicant can appeal to the High Court;

Trademark is registered for initial period of 10 years and renewable for further period of 10 years.

b) Write an essay on the "Threat of infringement proceedings" under Section 106 - 107 of The Patent Act, 1970 with case laws.

Answer :

Any person aggrieved can file a suit in cases of groundless threats of infringement proceedings for relief that - a declaration to the effect that the threats are unjustifiable, an injunction against the continuance of the threats and such damages, if any, as he has sustained thereby - Defendant in such suit, must prove that the act in respect of which proceedings were threatened, constituted infringement, else all or any relief claimed by plaintiff, will be granted by Court;

What is a threat - whether the communication by the other person constitutes a threat;

What plaintiff must prove - allegation that he has committed infringement and that he has been threatened with proceedings for that infringement;

Persons aggrieved - any person who is threatened with an action for infringement is a person aggrieved - Remedies available Injunction, Ex-parte order, Damages;

c) What are the rights conferred by the Copyrights Act, 1957 ?

Answer :

Rights conferred by Copyrights Act – Statutory Rights – Section 14 – Literary, dramatic, musical not being computer programme – artistic work – cinematographic film – sound recording; Negative Right; Multiple Rights; Economic Rights; Moral Rights

Q. III : Write notes on Any Four of the following : = 20.

a) Geographical indication.

Answer :

Geographical Indication : A form of intellectual property which identifies goods as originating from a particular territory or region in a country to which a given quality, reputation or other characteristics of goods is essentially attributable; Examples – Swiss chocolates, basmati rice, champagne, etc.

b) Specification.

Answer :

Specification : Description of a patent; Contents – title, full description, claim abstract, drawings, declaration; provisional specification followed by complete specification within 12 months.

c) Fair Use.

Answer :

Fair Use : Section 52 of the Copy Rights Act, 1957; exception to infringement; permitted for research, private study, criticism, review, reporting current events in newspaper or periodical or broadcast or photograph; it is a question of fact and circumstances.

d) Performer's Rights.

Answer :

Performers Rights : definition of performance and performer; exclusive right – to make sound or visual recording of performance – to reproduce the sound and visual recording of performance – to broadcast the performance – to communicate the performance to the public otherwise than by broadcast; performer's right for 50 years.

e) Assignment.

Answer :

Assignment : Transfer of ownership in rights to the assignee; legal – equitable – mortgage; territorial; general; may be for full term of patent/trademark/copyright; may be for whole rights or part rights; must be in writing and signed by assignor or authorized agent; description of assignment instrument; if period not stated, then deemed to be for 5 years from the date of assignment.

f) Mareva Injunction.

Answer :

Mareva Injunction : It is an order by which the Court has power to freeze defendant's assets where there is a possibility of the assets being dissipated or cancelled, so as to make, a judgment against him worthless and unenforceable.

Q. IV : Answer Any Two :

= 20.

1) Dhoni has been granted a patent by the Indian Patents Office on 31st December, 2007 –

- a) For how long will Dhoni have the patent over his invention ?
Answer : 20 years upto 30th December, 2027.
- b) If Ganguly wants to challenge the patent, in which Court has he to file a suit ?
Answer : District Court and where High Court has original jurisdiction, then in the High Court.
- c) Can Dhoni file an action for infringement against manufacturer who is making the invention in Nepal? Why ?
Answer : No. The patent is not registered in Nepal. If Nepal is a convention country then infringement action can be initiated.
- d) Can Dhoni get a patent in England in respect of the same invention, if he applies in 2008 ? Why ?
Answer : Yes. Provided, no other similar invention has already been granted a patent.
- e) If Dhoni had initially applied under the PCT, then would he have gained any advantage ?
Answer : The advantage would be the crystallizing of the priority date for the same invention in multiple countries simultaneously.
- 2) A detective agency wants to register the trademark "ISI SI" for its firm. The Controller General of Patents, Designs and Trademarks has refused to grant trademark on the plea that it sounds similar to the trademark ICICI.
- a) Is the stand of the Controller correct ?
Answer : Yes. MRF Ltd. v/s. NR Faridabad. Phonetic similarity (MRF/NRF). Court will uphold the decision of Controller.
- b) Can there be any other ground of refusal ?
Answer : Yes. Sections 9 and 11. Absolute and Relative grounds of refusal – to be enumerated.
- c) What are the remedies available against the refusal ?
Answer : Consent of proprietor or honest concurrent use.
- 3) Hari has written a book on Graphology. The book has been published by Penguin.
- a) Who is the author of the work ?
Answer : Hari is the author.
- b) A journalist uses extracts of the book in the review of the book published in a magazine. Will this amount to infringement ? If Yes/No, Why ?
Answer : No. Covered under Section 52 as Fair Use – criticism or review not amounting to infringement.
- c) A student extensively quotes from this book in his exam. Will this amount to infringement ? Why ?
Answer : No. Covered under Section 52 as Fair Use – reproducing for exam purpose not amounting to infringement.
- d) Hari's friend Suresh makes 20 photocopies of this book and distributes it amongst his friends. Will this amount to infringement ? Why ?
Answer : Yes, it will certainly amount to infringement. Reproduction of whole or part of the work/book shall not be allowed except for grounds enumerated in Section 52. Making 20 copies and distributing among friends certainly amounts to infringement. Both, Hari and the person making photocopies are liable for civil, as well as, criminal action.

[According to New Question Paper Pattern]
University Examination Question Papers [11] to [29]

[11]

"INTELLECTUAL PROPERTY LAW"

[November, 2008 (03/11/08)]

(Revised Course)

Time: 3 Hours

Marks 100

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) What is the purpose of trade mark ?

Answer : The purpose of trade mark is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of goods.

b) What is the term of a copyright in published literary, dramatic, musical and artistic works ?

Answer : The term/period of a copyright in published literary, dramatic, musical and artistic works will subsist within the lifetime of an author until 60 years from the beginning of the next calendar year next following the year in which the author dies.

c) When can patent opposition proceedings be initiated under the Patents Act, 1970 ?

Answer : Where an application for the patent has been published but a patent has not been granted, the opposition proceedings be initiated under the Patents Act, 1970.

d) State the intellectual property rights which require mandatory statutory protection.

Answer : The intellectual property rights which require mandatory statutory protection are - industrial property, which includes inventions (patents), trademarks, industrial designs, and geographical indications of source.

e) Define 'collective trademark'.

Answer : Collective Trade Mark means a trade mark distinguishing the goods or services of members of an association of persons (not being a partnership firm within the meaning of the Indian Partnership Act, 1932) which is the proprietor of the mark, from those of other proprietors.

f) If not specifically stated in the agreement, what is the period of assignment and territorial extent of the assignment of rights under the Copyrights Act, 1957 ?

Answer : . If the period is not specifically stated in the agreement, the period of assignment will be of 5 years, and the territorial extent of the assignment of rights under the Copyright Act, 1957 will be presumed to extend to India.

g) What is Section 3 (d) of the Patents Act, 1970 ?

Answer : Section 3 (d) of the Patents Act, 1970 states that - The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus, unless such known process results in a new product or employs at least one new reactant.

h) The acronyms - WIPO, PCT, TRIPs and IPRS stand for

Answer : The World Intellectual Property Organization, Patents Co-operation Treaty, Trade Related Aspects of Intellectual Property Rights, and Intellectual Property Rights.

i) Define the term 'performance' under the Copyrights Act, 1957.

Answer : "Performance in relation to performer's rights means any visual or acoustic presentation made live by one or more performers - [Section 2 (q)].

j) Give two examples of inventions which are not inventions within the Patents Act, 1970.

Answer : 1. An invention which is frivolous or 2. which claims anything obviously contrary to well established natural laws.

Q. 2 : Write short notes on Any Four :

= 20.

a) Geographical Indications.

b) Designs which are prohibited for registration under the Designs Act, 2000.

- c) Rights of a patentee.
- d) Well-known trade mark.
- e) Author's special rights.
- f) Intellectual Property Appellate Board (IPAB).

Q.3: Attempt Any Two with reasoned answers : = 12.

a) In 2007, Labila Pharmaceuticals adopts and starts using the words 'SALT FREE' in relation to salt substitutes for blood pressure patients. Subsequently, Labila Pharmaceuticals obtains registration of a trade mark label with the words SALT FREE. The trade mark label is registered with a condition that the registration of the trade mark shall give no exclusive right to the use of the words SALT FREE either individually or to be used in conjunction. In 2008, BP Protect Incorporation launches its salt substitutes advertising its products as BP SALT FREE.

i) Are the words SALT FREE distinctive in relation to salt substitutes? If no, can such words acquire distinctiveness?

Answer : Yes, the words SALT FREE is distinctive in relation to salt substitutes.

ii) Can Labila Pharmaceuticals file an infringement action against BP Protect Inc. for restraining BP Protect Inc. from using the words SALT FREE?

Answer : No, Labila Pharmaceuticals cannot file an infringement action against BP Protect Incorporation from using the words SALT FREE.

iii) What other actions can Labila Pharmaceuticals take against BP Protect Incorporation if infringement action is not possible?

Answer : No other action can be taken by Labila, as it is not an infringement under the Trade Marks Act, 1999.

b) A writes a story and assigns the copyright subsisting in the literary work of the story to a film producer named B. B desires to produce cinematographic film based on the said story and employs A to write the dialogues of the proposed cinematographic film. By a deed of assignment of copyright, A assigns to B, all his copyrights, which will subsist in the literary work of the dialogue to be written by him.

i) Who is the author of the cinematographic film?

Answer : 'A' is the author of the cinematographic film.

ii) Who is the author of the dialogues?

Answer : 'A' is the author of the dialogues in the film.

iii) Can 'A' assign to 'B' his copyrights in the dialogues, which are not already written?

Answer : Yes, 'A' can assign to 'B' his copyrights in the dialogues which are not already written.

iv) Can 'B' be the owner of the copyrights in the dialogues assuming 'A' and 'B' do not enter into a separate Deed of Assignment?

Answer : No. 'B' cannot be the owner of the copyrights in the dialogues assuming 'A' and 'B' do not enter into separate Deed of Assignment.

c) Ram, an employee working with Corla Ltd., invents a novel, inventive and useful working device. Ram leaves Corla Ltd., and joins Morta Ltd., a company engaged in a similar business as Corla Ltd. The Morta Ltd. files an application for patent, which gets published in the Official Gazette under the '18 months publication'.

i) What are the remedies available to Corla Ltd. ?

Answer : Corla Ltd. Has a right for opposition under the Patents Act, 1970.

ii) Can Corla file a patent application for their invention ?

Answer : Yes, Corla Ltd. Can file a patent application for the invention.

Q. 4 : Answer Any Four of the following : = 48.

- a) State the grounds of revocation of patents under the Patents Act, 1970.
- b) Discuss the relative grounds for refusal of registration under the provisions of the Trade Marks Act, 1999.
- c) State and discuss the works in which copyright subsists under the Copyrights Act, 1957.
- d) What amounts to an infringement of a trade mark ?
- e) What does not amount to an infringement of a copyright ?
- f) Explain the process of registration of a patent under the Patents Act, 1970.

[12]

“INTELLECTUAL PROPERTY LAW”

[April, 2009]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) Define 'certification Trade Mark'.

Answer : Section 2 (e) of the Trade Marks Act.

b) Which orders are appealable under the Intellectual Property Appellate Board?

Answer : Section 9 (1) of the Trade Marks Act.

c) State the term of the each of the intellectual property rights.

Answer : Trade Marks – 10 years; Patents – 20 years; Copyright – 60 years.

d) State the works in which copyright subsists.

Answer : Section 13 of the Copyrights Act.

e) What is a Patent?

Answer : Section 2 (m) of the Patents Act.

f) If not specifically stated in the agreement, what is the period of assignment and territorial extent of the assignment of rights under the Copyrights Act, 1957?

Answer : Section 19 (5) of the Copyrights Act (i.e. 5 years).

g) What do you mean by Design?

Answer : Section 2 (d) of the Designs Act, 2000.

h) Explain 'adaptation' under the Copyrights Act, 1957.

Answer : Section 2 (a) of the Copyrights Act.

i) Define 'inventive step'.

Answer : Section 2 (ja) of the Patents Act.

j) Define 'well-known' trade mark.

Answer : Section 2 (zg) of the Trade Marks Act.

Q. 2 : Write short notes on Any Four of the following : = 20.

a) Geographical Indications..

Answer : Section 2 (e) of the Geographical Indications Act.

b) Protection of Computer Software.

Answer : Section 2 (ffc) and Section 14 of the Copyrights Act.

c) Patent of addition.

Answer : Sections 54, 55 and 56 of the Patents Act.

d) Permitted user.

Answer : Answer Section 2 (r) of the Trade Marks Act.

e) Copyright Societies.

Answer : Section 2 (ff) and Sections 33 to 36A of the Copyrights Act.

f) Broadcast reproduction right.

Answer : Section 37 of the Copyright Act.

Q. 3 : Attempt Any Two with reasoned answers : = 12.

a) In 2003, Knikoff Camera Ltd. invents and adopts the trade mark "THADAX" in relation to cameras and obtains registration of the same. "THADAX" in a short while, becomes a well-known trade mark. Knikoff Camera Ltd. easily obtains registration of the trade mark "THADAX" considering it is invented and inherently distinctive. In 2005, Sluurpp Cakes Ltd. launches their cakes under the trade mark "THADAX".

i) Can Knikoff Camera Ltd. file an action against Sluurpp Cakes Ltd. for restraining Sluurpp Cakes Ltd. from using the trade mark "THADAX" considering cameras and cakes are not similar/allied or cognate goods?

Answer : Yes. According to Section 11 (2) of the Trade marks Act, 1999.

ii) Can Knikoff Camera Ltd. succeed in the action against Sluurpp Cakes Ltd., if the trade mark "THADAX" is not well-known?

Answer : Yes, Knikoff Camera Ltd. can succeed.

iii) Slurrpp Cakes Ltd. has filed a trade mark application for THADAX for cakes. Advise Knikoff Camera Ltd.

Answer : Yes, File opposition proceedings under Section 21 and to state the grounds for refusal of registration to the Registrar of the Trade Marks under Section 11 of the Trade Marks Act, 1999.

b) Rakha, a snake charmer and magician, earns his living by his shows, which are performed on streets of Mumbai. Due to Rakha's stellar performances, he has become known to the public. Owing to his popularity, a tabloid named Siesta, publishes a cover article on Rakha and his growth on streets of Mumbai. A film producer records one of Rakha's street shows and uses it as a part of his film without Rakha's consent.

i) Can Rakha file an action against the film producer for recording his performance without his consent? If so, what right does Rakha have to file such an action?

Answer : Yes, Rakha can file an action against the film producer for an infringement under Section 38 of the Copyright Act, 1957.

ii) Can Rakha file an action against film producer for recording his performance without his consent, if the film is to be only used for bonafide teaching and research ?

Answer : No according to Section 39 of the Copyright Act, 1957, Rekha cannot file an application for action for teaching and research purposes.

iii) Can Rakha file an action against the tabloid Siesta for publishing a cover article on him ?

Answer : Yes, Rekha can file an action against a Tabloid Siesta for publishing a cover on him.

c) 'X', a company has filed a patent application for a machine in June, 2006, which gets published in the Official Gazette under the '18 months' publication'. 'Y', a competitor is using substantially similar machine since January, 2005.

i) Can 'X' sue 'Y' for infringement of patent ?

Answer : No, 'X' cannot.

ii) What are the remedies available for 'Y' ?

Answer : 'Y' has a right for Opposition under Section 25, Defending the suit.

Q. 4 : Answer Any Four of the following : = 48.

a) State the inventions which are not patentable under the Patents Act, 1970.

Answer : Section 3 and 4 of the Patents Act.

b) Discuss the absolute grounds for refusal of registration under the provisions of the Trade Marks Act, 1999.

Answer : Section 9 of the Trade Marks Act.

c) What is infringement of a copyright ?

Answer : Section 51 of the Copyrights Act.

d) State the grounds of opposition of patents under the Patents Act, 1970.

Answer : Section 25 of the Patents Act.

e) Explain the process of registration of a trade mark under the Trade Marks Act, 1999.

Answer : Sections 18 to 23 of the Trade Marks Act.

f) Explain the concept of ownership under the Copyright Act, 1957.

Answer : Section 17 of the Copyrights Act.

[November, 2009]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) What are the reliefs available in passing off actions ?

Answer : The reliefs available in passing off action are – 1. Injunction in order to restrain further use of infringing mark; 2. Damages on account of profit; and 3. An order of delivery of infringing labels and marks for destruction or erasures.

b) Which Intellectual Property Rights are protected under the TRIPs Agreement ?

Answer : The Copyright and Related Rights, trade Mark, Geographical Indications, Industrial Designs, Patents, Layout- designs, topographies of Integrated Circuits, Protection of Undisclosed Information, Control of Anti-competitive Practices in Contractual Licences, are protected Intellectual Property Rights under the TRIPS Agreement.

c) Define 'Service Mark'.

Answer : 'Service' means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters; 'Marks' means marks or names used by business rendering various kinds of services. Such marks are called 'Service marks'.

d) What is the term of Copyright in artistic and literary works ?

Answer : The term/period of a copyright in published literary, dramatic, musical and artistic works will subsist within the lifetime of an author until 60 years from the beginning of the next calendar year next following the year in which the author dies.

e) Can Geographical Indications be registered as a Trademark ?

Answer : The Geographical Indication itself is registered under the Geographical Indications of Goods (Registration & Protection) Act, 1999.

f) Define the term 'Performance' under the Copyright Act, 1957.

Answer : 'Performance', in relation to performer's rights, means any visual or acoustic presentation made live by one or more performers.

g) Define 'Associated Trade Marks'.

Answer : Associated Trade Marks' means trade marks deemed to be or required to be registered as associated trade marks under the Trade Marks Act, 1999.

h) What is period of Assignment of Copyright?

Answer : The First Owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign to any person the copyright wholly or partially, and either generally or subject to limitations, and either for the whole term of copyright or any part thereof.

i) Who may apply to register a trademark?

Answer : The proprietor of a mark capable of being represented graphically, and which is capable of distinguishing goods or services of one person from those of others, can apply to register a trade mark.

j) When can Patent opposition proceedings be initiated under the Patents Act, 1970 ?

Answer : Where an application for a patent has been published, but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent.

Q. 2 : Write short notes on Any Four of the following : = 20.

- a) Transmission of Copyright by operation of law.
- b) Author's Special Right.
- c) Non-User trademark.
- d) Permitted User.
- e) Patent of Addition.
- f) Surrender of Patents.

Q. 3 : Attempt Any Two with reasoned answers : = 12.

- a) Sheetal, who operates a website where writers can automatically publish articles to the world without any editorial oversight from Sheetal. Sheetal will allow writers to submit articles on any topic, but not every article has the same potential value to Sheetal. Further, inevitably some writers will try to exploit any deficiencies in the formula to generate earnings without doing the associated work. To ensure the best return for its compensation, Sheetal has developed a unique "exploitation-resistant" formula to automatically determine how much each article should earn. Currently, to make

exploitation harder, the exact formula has not been publicly disclosed, although it has been used to determine compensation for writers for a number of months. Sheetal is considering applying for an intellectual property protection.

i) Advise whether Sheetal can apply for a patent or copyright for its payment determination formula.

Answer : Sheetal can apply for patent for 'payment determination formula'.

ii) Discuss the pros and cons of doing so.

Answer : If patented Sheetal's invention will be on her name (i.e. She being the First Inventor) by which she can exploit it and no other person can use Sheetal's invention.

b) CAM Motors Ltd. is a well known Company involved in the manufacture of various kinds of Cars. Mr. Charan Singh was using the trade name CAM for 'Pressure Cookers' which they are manufacturing in India and even when their application for registration of this trademark had been rejected by the registrar, they continued using it.

i) Can CAM Motors Ltd. file a suit for infringement against Mr. Charan Singh ?

Answer : Yes, CAM Motors Ltd. Can file a suit for infringement against Mr. Charan Singh.

ii) Under which grounds can CAM Motors Ltd. succeed in the infringement suit ?

Answer : Under Section 29 of the Trade Marks Act, 1999, under the ground of infringement of trade marks.

c) B Ltd. owned a website through which it made available certain items in printed form through its newspaper. Y Ltd. also owned a website on which they published a news reporting service. Y Ltd. at various times, copied headlines from the B Ltd.'s website and hyperlinked them to the internal pages of the B Ltd.'s website.

i) Under which law and on what grounds, can B Ltd. file a suit against Y Ltd. ?

Answer : Under the Copyright Act, 1957 and Information Technology Act, 2000.

ii) Under what grounds, can B Ltd. succeed in the infringement suit ?

Answer : On the ground of Cyber Crimes – stealing computer time, stealing software and committing theft of information and equipment.

Q. 4 : Answer Any Four out of the following : = 48.

a) Explain the procedure for grant of License to produce and publish translations of literary and dramatic work in any language.

- b) Define Broadcasting Reproduction Rights and its scope of infringement.
- c) Explain the process of Registration of Trademarks under the Trade Marks Act, 1999.
- d) Explain the circumstances under which a Patent is deemed to be infringed.
- e) What does not amount to infringement of copyright under the Copyrights Act, 1957?
- f) Explain Copyright and assignment, transmission and relinquishment of Copyright under the Copyright Act, 1957.

[14]

[April, 2010 (28/4/10)]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) What do you mean by Deceptive Similarity ?.

Answer : A mark shall not be registered as trademark if it is of such a nature as to deceive the public or cause confusion. Similarly, a trademark shall not be registered if because of – i) its identity with an earlier trademark and similarity of goods or services covered by the trade, or ii) its similarity to an earlier trademark and the identity or similarity of the goods or services covered by the trademark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trademark.

It can be seen that likelihood of deception and confusion and similarity and identical nature of the trademark are the grounds for refusal to register them either as an absolute ground or relative ground for refusal of registration, depending on facts and circumstances of each case.

b) What do you mean by a Patent Agent ?

Answer: The patent agent is authorized to sign all applications and communications to the controller on behalf of the patentee, who has duly authorized him in writing to do so (Sections 125 to 130 of the Patents Act).

c) **What is meant by the term 'Publication' under the Copyright Act, 1957?**

Answer : 'Publication' means, making a work available to the public by issuing copies or by communicating the work to the public. (Section 3 of the Copy Right Act).

d) **What constitutes infringement of Trade Mark ?**

Answer : Infringement of trademark takes place when a person other than the registered proprietor a) uses the same trademark, or b) uses a deceptively similar mark, in relation to some goods or services for which the trademark is registered (Section 29).

e) **State the characteristics of Intellectual Property ?**

Answer : i) Intellectual Property is property of intellect. ii) It exists only in law. iii) Intellectual Property confers rights on intangibles. iv) It is treated as movable property for the purpose of transfer, assignment, stamp duty and taxation. v) The unique or fragile nature of Intellectual Property make it easily exploitable, etc.

f) **What is meant by the adaptation in relation to a dramatic work ?**

Answer : Adaptation means – Modification in the work to create another work e.g. adapting a novel to make a motion picture and the modification of the work in a manner that suits different conditions of exploitation e.g. to make a text book suitable for students of lower level, where translation and adaptations are made by different individuals, the copyright may rest with both.

The one who seeks to adapt translated adaptation, has to obtain permission from original author , as well as, the author of the translated work.

g) **Define the term 'Invention' as under the Patent Act.**

Answer : 'Invention' as defined under Section 2 (i) (j) of the Patent Act, 1970 means, a new product or process involving an inventive step and capable of industrial application.

h) **Which are the Civil remedies available under the Copyright Law in India ?**

Answer : i) To file suit for Injunction. ii) To file suit for damages. iii) Account of profit and damages for tort of conversion, etc.

i) **The acronyms – WTO, PCT, GATT and WIPO stand for ...**

Answer : World Trade Organisation; Patent Co-operation Treaty; General Agreement on Tariffs and Trade; World Intellectual Property Organisation.

j) What constitutes a Good Trade Mark?

Answer : A good trademark possesses the following attributes apart from distinctiveness –

i) It should be easy to pronounce and remember, if the mark is a 'word'. ii) In case of device mark, the device should be capable of being described by single word. iii) It should be short. iv) It must be easy to spell correctly and write legibly. v) It should not be descriptive but may be suggestive of the quality of the goods. vi) It should appeal to the eye, as well as, to the ear. vii) It should satisfy the requirement of registration.

Q. 2 : Write short notes on Any Four of the following: = 20.

a) Collective Trademarks.

Answer :

Section 2 (g) : "Collective mark" means, a trade mark distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others. The association of persons, however, includes partnership within the meaning of Indian Partnership Act, 1932.

Explanation; Section 2 (1) (g), Section 2 (i) (zb); Sections 61 to 68).

b) Passing Off.

Answer :

Passing Off action is a common law remedy available to the proprietor of an unregistered Trademark. It means, a person tries to pass off his goods or business as that of the goods or business of another person by whatever means, so that, the result may be achieved.

"No man is entitled to represent that his goods are the goods of another man, and no person is permitted to use a mark whereby without making a direct false representation to the purchaser, he thereby, lies to the Customer".

Case Law – Singer v/s. Loog; Warnik v/s. Towned.

c) Date of Patent and Priority Date.

Answer :

Every patent shall be dated as of the date on which the complete specification was filed. The date of every Patent shall be entered in the register. No suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of advertisement of the acceptance of the complete specification (Section 45).

Priority Date – There shall be a priority date for each claim of a complete specification where a complete specification is filed in pursuance of a single application accompanied by a) provisional specification or b) a specification which

is treated by virtue of a direction under Section 9 (3) as a provisional specification, and the claim is fairly based on the matter disclosed in the specification referred to and the claim is fairly based on the matter disclosed in the specification referred to in clause a) or clause b), the priority date of that claim shall be the date of filing of the relevant specification.

d) **Universal Copyright Convention.**

Answer :

In 1952, UNESCO conducted an international conference seeking a worldwide workable unity in copyright law worldwide. It wanted to unite the efforts of Berne Convention and various inter-American Conventions for the welfare of the authors worldwide. As a result, the UCC was established at Geneva on 06/9/1952. This Convention was signed by 40 members.

By the UCC, an author's work are protected in other nations to the same degree as the works of authors native to that country. It is the most characteristic feature of UCC. It also gives the author the control over the translative rights throughout the world.

e) **World Intellectual Property Organisation (WIPO).**

Answer :

The WIPO is a specialized agency of the UNs. It is dedicated to developing a balanced and accessible international Intellectual Property System, which rewards creativity, stimulates innovation and contributes to economic development while safeguarding the public interest. WIPO was established by the WIPO Convention in July 14, 1967 with mandate from its member states to promote the protection of the Intellectual Property throughout the world through co-operation among states and in collaboration with other International Organization. Its headquarters are in Geneva, Switzerland. The Director-General is Francis Gurry.

Objectives of WIPO;

Functions of WIPO.

f) **Copyright Societies.**

Answer :

Section 2 (ff) of the Copyright Act, 1957 defines "Copyright Society".

"Copyright Society means, a society registered under sub-section (3) of Section 33".

Q. 3 : Attempt Any Two with reasoned answers : = 12.

a). **Reebok Pvt. Ltd., an Indian Company, is long-standing manufacturer of Sports goods under a registered trademark 'RK', having sales in India. Only**

recently, nike UK has launched its sports goods in Delhi, and in the UK under the trademark "RK-1".

i) Reebok desires to commence legal proceedings against nike in India. Advise on options available and reliefs that may be prayed for.

Answer : Reliefs – Ex-parte Injunction, Injunction, Damages or an account of profits, Delivery of infringing labels/marks for destruction.

ii) Reebok desires to commence legal proceedings against nike in U.K. Advise.

Answer : Legal proceedings in the U.K. would not be entertained. Trade Marks Act, 1999 is a territorial law having applicability in India. The cause of action has arisen in India and therefore, courts in India are the appropriate forum for adjudication.

iii) Assume 'RK' was an unregistered trademark, what option would Reebok then have ?

Answer : Reebok would have a common law relief viz. a suit for passing off against nike U.K.

b) Sanchit and Sagar filed patent application with provisional specification on the same date for the same invention. After that, Sanchit filed a complete specification much earlier to Sagar, both filed within the allowed period. Examine the status of the patent applications filed by both Sanchit and Sagar.

i) If Sanchit adopted the idea from Sagar dishonestly.

Answer : If Sanchit adopted the idea from Sagar dishonestly, then it will amount infringement of Sagar's rights to patent. And hence, Sagar will have right to institute suit for Declaration, Injunction and also for damages and accounts of profits.

ii) Both Sanchit and Sagar are honest independent inventors conducting their own separate experiments.

Answer : As Sanchit has filed a complete Specification much earlier to Sagar; Sanchit will have exclusive right to make or use the patented article or use of the patented process. But if Sagar has discovered new process other than Sanchit's experimental process, Sagar can get patent on his new process; which will be improvement in Sanchit's patented process, but Sagar have to get consent and permission from Sanchit, because, Sanchit has filed complete Specification much earlier to Sagar. So, Sanchit is the exclusive owner (i.e. First Inventor) of patented process.

c) Sameer-Raja, a team of music directors, create a musical work. Lyrics written by Sameer are blended to create a song. T-Series video company acquires rights enabling them to make a sound recording.

i) List the various classes of works in which copyright subsists.

Answer : Musical works, Literary works, Sound recording, etc.

ii) List the Authors in relation to those classes of works created.

Answer : Musical works – Authors : Sameer-Raja.

Literary works – Author : Sameer.

Sound recording – Author : T-Series video company.

iii) What must T-Series video company have done to acquire rights to make the sound recording?

Answer : T-Series video company would have either procured a licence or an assignment in the musical works and the lyrics. It would have enabled to produce the sound recording embodying the two works protected under the Copyright Act, 1957.

Q. 4 : Answer Any Four out of the following : = 48.

a) What is Patent ? Can a patent be granted for every invention ? Discuss.

Answer :

A patent is a monopoly right granted to a person who has –

a) invented a new and useful article, or

b) made the improvement of an existing article or a new process of making an article.

A patent is granted for – New product invented; Improvement on an existing product; New process for making an article.

[Refer this Book].

b) Discuss the features of copyright. What are the rights of an author of a work ? What are the Economic Rights available to an owner of a copyright ?

Answer :

Copyright shall subsist through India in the following classes of works –

i) Original literary, dramatic, musical and artistic works;

ii) Cinematograph films and

iii) Sound recording.

Subject matter of copyright.

- Rights conferred on the Author :

- i) Right of assignment – mode of assignment.

- ii) Right of Author to relinquish copyright.

- iii) Right to grant licences.

- iv) Collective right to control administration of owners rights by Copyright Society.

- Broadcast reproduction right.

- Special rights of Authors.

- Resale share right in original copies, etc.

- Economic rights –

The rights conferred by Section 14 on a copyright owner, are economic rights, because, the exploitation of the work by the Author by exercising these rights, may bring economic benefit. The Author may exploit any one or more of the rights for a consideration which may be in the form of royalty, a lump sum payment.

c) Explain the provisions relating to 'Assignment and Transmission' under Trade Marks Act.

Answer :

Copyright subsists only in original work. The word "original" does not mean that the work must be the expression of original or inventive thought. The originality which is required, relates to the expression of the thought but the expression need not be in original or novel form but that the mark must be not copied from other work i.e. it should originate from the author.

No formalities like registration are required to acquire copyright. Copyright is a work automatically subsists as soon as the work comes into existence, provided it is original. Although there is a provision for registration of copyright work, it does not confer any special right or privilege on the owner of the copyright.

The nature of right conferred on the owner of the copyright depends upon the nature of the work, but it could be observed that there is one feature which is common to all kinds of the work and that is the right to reproduction in a material form and right to publication. There is no copyright in live events, as it conferred special rights on performers. No copyright is granted to the work which is grossly immoral, illegal, defamatory, seditious, deceive to public and contrary to public policy.

Scope of Assignment or Transmission [Sections 37 to 45].

Assignment of an unregistered Trade Mark [Section 39].

Restrictions on Assignment and Transmission [Sections 40 and 41].

Assignment without goddwill of business.

Registration of Assignments and Transmissions : [Refer this Book].

d) Distinguish between Trademark and Copyright. What are the advantages of registering them ?

Answer :

Trade mark : Trade Mark means, a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark.

Thus, trade mark is a visual symbol in a form of a word, device or a label applied to articles of commerce with a view to indicate to purchasing public, that they are the goods manufactured or otherwise, dealt in by a particular person as distinguished from similar goods, manufactured or dealt in by other person. A person who sells his goods

under a particular trade mark, acquires a sort of limited exclusive right to use of mark in relation to these goods. Each right acquired by use is recognized as a form of property in trade mark and protected under Common Law.

Effect of Registration (Sections 27 to 36) :

- a) Exclusive right to use a trade mark.
- b) Right to take action in case of Infringement.
- c) Prima facie evidence of validity.
- d) Acquiescence, effect of, etc.

[Refer this Book].

e) **What is a Patent ? What is the object of the patent law ? What are the rights and obligations of a patentee ?**

Answer :

The word 'patent' originated from the Latin word "patente" which means "to open". A Patent is a legal document issued by the Government to an inventor, his assigns, etc. It defines an invention and grants the right to prevent others from making, using or selling the invention in the country.

Object of the Patent law –

To encourage research and promote the inventive genius.

To secure for inventors awards for inventing useful inventions.

To give protection to inventors by conferring them a monopoly in commercially exploiting their inventions.

To induce industries to undertake research and development.

To aid the industrial growth of the country and improve the quality of life of the people.

Case Law –

M/S Bishwanath Prasad Radhey Shyam v/s. M/S Hindustan Metal Industries.

Rights of Patentee –

Right to exploit.

Right to use the process.

Right to assign or give on Licence.

Right to surrender.

Right before sealing.

Obligations of Patentee –

Inventions should not unfairly prejudice the interests of the public.

Patented products are made available at reasonable price.

Furnish periodic statements, etc.

f) **Explain various forms of Intellectual Property and the Legislations in India for protection thereof.**

Answer :

Various forms of Intellectual Property –

Copyrights, Patents, Trademarks, Industrial designs, Lay-out designs of Integrated Circuits and protection of undisclosed information, etc.

Various Legislations –

TRIPS (history), WTO, The Patent Act, 1970, Copyright Act, 1957, The Trade and Merchandise Marks Act, 1958, The Designs Act, 1911, etc.

[15]

[November, 2010 (25/11/10)]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) State in which 'works' copyright subsists ?

Answer : Works in which Copyright subsists is – a) Original literary, dramatic, musical and artistic work; b) Cinematograph films; and c) Sound recording.

b) What amounts to infringement of patent ?

Answer : If the infringer takes all the essential features of the invention, it amounts to infringement of patent; where the infringer has taken all the essential features claimed in the patent but has altered one or more unessential feature, or has added some additional feature which may or may not of itself involves a new inventive step, it is called colourable imitation.

c) Define a 'registered user' under the Trade Marks Act, 1999.

Answer : Registered user means person who is for the time being registered as such under Section 49 of the Act.

d) Who can apply for registration of Design ?

Answer : The proprietor of a new or original design can apply for registration of Design.

e) What are not inventions under the Patents Act, 1970 ?

Answer : The following are not inventions within the meaning of the Patents Act, 1970 –

- a) An invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- b) An invention, the primary or intended use or commercial exploitation of which would be contrary to public order or morality, or which causes serious prejudice to human, animal or plant life or health or to the environment;
- c) The mere discovery of a scientific principle or the formulation of or discovery of any living thing or non-living substance occurring in nature;
- d) The mere discovery of new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use of a known or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

f) **What is period of Assignment of Copyright ?**

Answer : The period of assignment of copyright will be the period agreed upon by the author and assignee, or if the period of assignment is not stated there in agreement, it shall be deemed to be 5 years from the date of assignment.

g) **Define 'Collective Trade Mark'.**

Answer : A collective trade mark means a trade mark distinguishing the goods and services of the members of an association of persons being a partnership firm, which is the proprietor of the mark, from those of others.

h) **What do you understand by the term 'Bio-technology' ?**

Answer : Bio-technology is a technology which has produced high-yielding varieties of agricultural seeds, creation of plants by tissue culture and micro-organisms and new products based on them which have been found beneficial in industry, medicine and food production.

i) **What do 'Geographical Indication' under Section 2 (e) means ?**

Answer : Geographical Indication, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods or originating, or manufactured in the territory of a country, or a region, or locality in that territory, where a given quality, reputation or other characteristics of such goods is essentially attributable to its geographical origin, and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned, takes place in such territory, region, or locality, as the case may be.

j) Why, according to you there should be protection of Intellectual Property Rights?

Answer : There should be protection of Intellectual Property Rights so as to get benefits to the real, original owner or inventor of the property, and he should be protected from infringement, and should get damages.

Q. 2 : Write short notes on Any Four of the following : = 20.

- a) Process patent.
- b) Copyright Board.
- c) Anton Pillar Injunction.
- d) Patent Co-operation Treaty.
- e) Author's Special Rights.
- f) Compulsory Licences.

Q. 3 : Attempt Any Two with reasoned answers : = 12.

a) A actress named 'Britney', wants to apply for registration of her personal name "BRITNEY" as a trademark for "Beauty Salon".

Will the mark be regarded as distinctive? Why?

Answer : Yes, the Mark will be regarded as distinctive, as 'BRITNEY' as a trade mark for 'Beauty Salon' is not available, so it will be new, innovative and distinctive.

b) Aneel applies for a patent in respect of an invention and the same is granted by the patent office in India in the Year 2000.

i) How long can Aneel have the Exclusive right in respect of the invention?

Answer : For the period of 20 years from the date of filing of the application for a patent.

ii) Can Aneel take an action for Infringement against a manufacturer who is making the invention in foreign country? Why?

Answer : No, Aneel cannot file an application for infringement against a manufacturer who is making the invention in foreign countries as it is out of jurisdiction of India under the Patents Act, 1970.

iii) Can Aneel get a patent in UK in respect to the same invention, if he applies in 2002? Why?

Answer : Yes, if Aneel files convention application or a 'basic application' for the protection of his patent under the 2002 (Amendment) Act, which provides for filing of an International Application under the Patents Co-operation Treaty (PCT).

c) Dr. Nishant has written a book on Intellectual Property Rights. The Book has been published by leading Publisher Butterworths.

i) Who is the author of the work?

Answer : Dr. Nishant is the author of the work.

ii) A student from Law College quoted from this Book in their LL.B Examination. Will this amount to infringement ? Why ?

Answer : No, this will not amount to infringement, as a student for his study purpose can quote from the book.

iii) One Mr. Raj made 10 photocopies of this Book and distributed among his friends. Will this amount to infringement ? Why ?

Answer : Yes, this will certainly amount to infringement as photocopies of the book is an infringement of a copyright, and he is liable for both, civil, and criminal action under the Copyright Act, 1957.

Q. 4 : Answer Any Four out of the following : = 48.

- a) What is a trademark ? What are the qualities of a good trademark ? Explain the trade marks which cannot be registered.
- b) Who can oppose grant of patent & on what grounds ? What is the procedure for opposing a patent ?
- c) Distinguish between :
 - i) Passing off and Infringement Action of Trademark.
 - ii) Write short note on 'fair use'.
- d) Define the term Intellectual Property. Explain the main features of this property. Whether it is different from other kinds of property ? Explain.
- e) Describe in detail the acts which do not constitute an infringement of copyright under the Copyright Act, 1957.
- f) Discuss the grounds for refusal of registration of a trademark under the Trade Marks Act, 1999.

[16]

[April, 2011 (28/4/11)]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) What is meant by the 'goods' under the Copyrights Act, 1957 ?

Answer : "Goods" means, anything which is the subject of trade or manufacture.

b) What is an 'International application' under the Patents Act, 1970 ?

Answer : An "International application" under the Patents Act means, an application for patent made in accordance with the Patent Co-operation Treaty.

c) Define 'well-known' Trade Mark.

Answer : Section 2 (1) (zg) of the trade marks Act, 1999 – "well-known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services would be likely to be taken as indicating a connection in the course of a trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services".

d) What is meant by 'publication' under the Copyrights Act, 1957 ?

Answer : Under Section 3 of the Copyrights Act, 1957, 'publication' means making a work available to the public by issuing copies or by communicating the work to the public.

e) What is a Patent of Addition ?

Answer : "Patent of Addition shall be granted for improvement or modification of patented invention". Sections 54 to 56 of the Patents Act deal with it.

f) What are the various types of Intellectual Property ?

Answer : i) Patents, ii) Trademarks, iii) Copyrights, iv) Designs, v) Geographical Indications, etc.

g) What do you mean by Deceptive Similarity ?

Answer : Deceptive Similarity means a trade mark shall not be registered i) if it identifies with an earlier trade mark, ii) if there exists a likelihood of confusion on the part of the public, or it can be seen that likelihood of deception and confusion and similarity and identical nature of the trade mark are the grounds for refusal of registration.

h) State the difference between Product patent and Process patent under the Patents Act, 1970.

Answer : Product patent allows exclusive rights relating to the object or the end product; while a Process patent relates to a means to achieving an end product, therefore, the Product patent gets more benefits for the patent owner.

i) Why is it necessary to protect the intellectual property rights ?

Answer : Because, i) it is both, just, and appropriate that the person putting in the work and effort into or intellectual creation has same benefit as a result of the endeavour. ii) by giving protection to intellectual property, many such endeavours are encouraged and industries based on such work bring financial returns.

j) **Who is the first owner of a work ?**

Answer : According to the provisions of Section 17 of the Copyrights Act, the author of the work is the first owner of the copyright in the work, for e.g. in musical work – the composer, is the author, in photograph – the person who takes the photograph, in cinematograph film – the producer, and so on.

Q. 2 : Write short notes on Any Four of the following : = 20.

a) **Fair use.**

Answer :

Section 52 of the Copyrights Act, 1957 – Fair dealing with literary, dramatic, musical or artistic work, except computer for private use, including research and criticism or review example, reproduction for the purpose of a judicial proceedings or of a report of a judicial proceedings in any work prepared by the secretarial of a Legislature – Reading or recitation in a public of any reasonable extract from a published literary or dramatic work – Educational purpose, etc.

b) **Copyright in case of Literary, Dramatic or Musical Work.**

Answer :

Section 13 of the Copyrights Act – Works in which Copyright subsists [Section 13 (1), (2)]; Works in which Copyright shall not subsist [Section 13 (3)].

c) **Passing Off (Trade Mark Act).**

Answer :

Passing Off action is a Common Law remedy available to the Proprietor of an Unregistered Trade Mark – How Passing Off may be done (Explanation), Essential characteristics which must be present to validate cause of action of Passing Off (Explanation in brief).

d) **Copyright Society.**

Answer :

“Copyright Society” means, a society registered under Sub-Section 3 of Section 33, (Explanation) i.e. registration of Copyright Society and Section 34 : Administration of rights of owner by Copyrights Society (Explanation in detail).

e) **Mareva Injunction.**

It is an order by which the Court has power to freeze defendants assets, when there is possibility of the assets beings dissipated or cancelled, so as to make a judgement against him worthless and unenforceable.

f) **Specification.**

Section 9 and 10 of the Patents Act, 1970 – Provisional and complete specifications under Section 9 (state Explanation); Section 10 which states the contents of the specification in brief.

Q. 3 : Attempt Any Two with reasoned answers. = 12.

a) Mr. Khanna forms a brilliant idea about how a beautiful girl can madly fall in love with a crazy boy on which a beautiful and thought provoking story can be written. He communicates it to Mr. Jacob. Jacob appreciates the idea given to him by Khanna. Jacob clothes the idea in the form of a book which he publishes in his own name. Khanna claims that the original idea belongs to him.

i) Can Khanna claim a joint ownership over a Copyright in the book so to claim royalty in the book? If yes/no why?

Answer : Mr. Khanna cannot claim joint ownership over a copyright in book, because, copyright does not subsist in "mere ideas" but in the expression of the ideas into the work.

ii) State the leading case law related to the above facts.

Answer : Donoghue v/s. Allied Newspapers Ltd. (1937) 3 Ch D 508.

b) Yuvaraj has been granted a patent by the Indian Patents Office on 31st December, 2008 –

i) For how long will Yuvaraj have patent over his Invention?

Answer : For 20 years, i.e. upto 30th December, 2028.

ii) If Virat wants to challenge the patent, in which Court he to file a suit?

Answer : District Court and where High Court has original jurisdiction, then in the High Court.

iii) Can Yuvaraj get a patent in Ireland in respect of the same invention, if he applies in 2009? Why?

Answer : Yes, provided no other similar invention has already been granted a patent.

c) Toyota cars wants to Register the trade mark "T" for their new Launch of cars. The Controller General of Patents, Designs and Trademarks has refused to grant trademark on the plea that it sounds similar to the trademark of Tata Motors '8' i.e. 'T'.

i) Is the stand of the Controller correct ?

Answer : Yes. Court will uphold the decision of the Controller.

ii) Can there be any other ground of refusal ?

Answer : Yes. Section 9 and 11 – Absolute and Relative grounds of refusal to be enumerated.

iii) What are the remedies available against the refusal ?

Answer : The remedy against the refusal is Consent of the proprietor for honest concurrent use.

Q. 4 : Answer Any Four out of the following : = 48.

a) What is a Patent ? What is the object of the Patent Law ? What are the rights and obligations of a Patentee ?

Answer :

Meaning of Patent : Patent is a monopoly right granted to a person who has i) invented a new and useful article, or ii) made the improvement of an existing article or a new process of making an article.

Object of Patent Law :

- i) Encourage and Develop new technology and Industry.
- ii) Induce an inventor to disclose his discoveries.
- iii) Reward for the expenses of developing inventions.
- iv) Inducement to invest capital.
- v) Period of the patent.
- vi) What is sealing and what is granting ?

Rights of a Patentee :

- i) Right to exploit the Patent.
- ii) Right to assign and licence.
- iii) Right to surrender the Patent.
- iv) Right before sealing.
- v) Right to apply for Patent of Addition.
- vi) Right in case of infringement, etc.

Obligations of a Patentee :

- i) It is the duty of the Patentee to work the Patent.
- ii) Patentee should submit periodical statement to the Controller as to the work of invention on commercial basis in India, etc.

b) What does not amount to an infringement of Copyright ?

Answer :

The protection of copyright given to the owner or the licensee is not absolute. It is subject to certain exceptions and restrictions. Section 52 of the Copyrights Act gives an elaborate list of certain acts not constituting infringement of copyright, viz.

- i) Fair dealing.
- ii) Making of copies/adaptation of computer programmes for specific purposes.
- iii) Reporting of current events.
- iv) Reproduction in connection with judicial proceedings.
- v) Reproduction for legislative purposes.
- vi) Reproduction to make certified copies.
- vii) Publication for use of educational institution.
- viii) Performance of literary works.
- ix) Publication of public lecture.
- x) Production or publication of translation of Acts of legislature or Rules, etc.

c) Explain the process of Registration of Trademarks under the Trademarks Act, 1999.

Answer :

Stages/Process of Registration of Trademark viz.,

- i) Application for registration.
- ii) Acceptance of Application or refusal to accept.
- iii) Advertisement of application.
- iv) Opposition to registration.

[Explanation of all the above points].

d) Who can oppose grant of patent and on what grounds ? What is the procedure for opposing a patent ?

Answer :

Any person interested, may give notice to the Controller, stating his opposition to grant of patent on any of the following grounds :

- i) The applicant or any person claiming through him has wrongfully obtained the invention.
- ii) The invention is published before the date of claim.
- iii) The invention and claim of complete specification is publically known and publically used in India before the priority date of that claim.
- iv) A similar complete specification was already claimed with priority date earlier than that of claim of Applicant.
- v) The invention claimed does not involve obvious clear inventive step.
- vi) The subject matter of complete specification and its claim is not an invention under the Act or it is not patentable under the Act.
- vii) The complete specification does not sufficiently and clearly describe the invention or methods by which it is to be performed.
- viii) Applicant has failed to disclose the Controller the information required under Section 8 or has furnished false information intentionally.

ix) The application was not made within 12 months from the date of the first application for the protection of invention made in convention country in case of convention application.

e) **Discuss the various rights which Copyright protects. Explain the concept of Copyright.**

Answer :

The object of the copyright law is to protect the author of the copyright work from unlawful reproduction or exploitation of his work by others.

The right also extends to prevent others from exercising without authority any other form of right attached to the copyright.

Examples in the case of literary works.–

i) The right of musical, dramatic version,

ii) Cinematographic version.

iii) Translation.

iv) Adaptation.

v) Copyright is a multiple right consisting of a bundle of different rights in the same work. These rights can be assigned or censed, either as a whole or separately.

Works in which copyright subsists [Section 13] :

i) General rights : negative, Multiple, Economic.

ii) Moral rights : Publication, Authorship, Integrity.

iii) Author's special right : Main rights.

iv) Section 2 (d), Section 17 with reference : Donoghue v/s. Allied Newspapers Ltd. (1937) 3 Ch. D 503.

f) **Discuss and compare the salient features of Trademarks, Patents, Designs and Copyright as Intellectual Property.**

Answer :

There are many similarities in the Law relating to different species of Intellectual Property in regard to the Nature of the Property, the Mode of its Acquisition, the Nature of Rights conferred, the Commercial Exploitation of those rights, the Enforcement of these rights and the Remedies available against infringement of those rights.

Patents :

The Patents Act 1970 does not provide for comprehensive definition, a patent licence given to the inventor to make exclusive use of his invention.

The Patent can be correctly defined as exclusive right to use or exercise on an invention granted to a person for limited period in consideration of the disclosure of invention, it is the protection assured by the State to use the invention in monopoly.

In case of patent, the property consists of exclusive right to use the invention patented; to grant licences to owners to exercise that right or to sell that right to third person, the invention may relate to a new product or an improvement of an existing product or a new process of manufacturing new products. The acquisition of this monopoly, the conditions to be satisfied for acquisition, its duration, the licensing of these monopoly rights or their assignments to others, are strictly governed by the Patent Act, 1970, after expiry of the term of the Patent, which is 14 years for all the products except in case of drug and food patents 7 years, thereafter it becomes public property, whereby any one can use the patented invention.

The commercial exploitation of different kinds of Intellectual Property is made in different ways in case of patent, the patentee may himself have the patent or assign his right or licence to industrialist for lump sum payment or on royalty basis.

Industrial Design :

In case of industrial design, the property consists in the exclusive right to apply the design registered under the Designs Act, 1911, and now replaced by the Designs Act, 2000. This right in relation to the class of goods for which it is registered for maximum period of 15 years subject to payment of renewal in fees is prescribed by the rules. This right can also be licenced for use by third parties or assignor to any person on expiry of the term of registration, anybody can use the design.

A registered design can be exploited by assigning or licensing the right to others capable of exploiting it on royalty or lump sum basis.

Trade Marks :

Under Section 2 (zb) of the Trade Marks Act, 1999, the trade mark means, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.

A trade mark is a symbol which is applied or attached to goods offered for sale in the market, so as to distinguishing them from similar goods. The old Act, the Trade and Merchandise Marks Act, the use of the trade mark to prevent others from not only using the mark as registered, but also marks which are deceptively similar or the registered trade marks, as to likely to cause confusion amongst the customers of the goods or services covered by registration.

The Trade Marks Act, 1999 has got many important changes in the law of trade marks. The most important change is in case of unregistered trade marks. The right to protection of good will continue indefinitely, provided the owner of the goods will use the mark lawfully and prevent others from infringing those rights by appropriate actions in the court of law.

Commercial exploitation of a registered trade mark by licencing others to use it on a royalty basis is not permissible, except by registration of licence as a registered user under conditions prescribed by the statute.

Copy Right :

The Copyright Law in India, originally passed in the year 1914, thereafter the Copyright Act, 1957 came into operation, and subsequently, various amendments to this Act in the year 1983, 1984, 1994 and 1999 were made.

The Copyright (Amendment) Act, 1999, has effected certain changes in the law. The definition of copyright is given in Section 14 of the Copyright Act, 1957. The Copyright means, the exclusive right to do or authorize others to do certain acts in relation to –

- i) Literary, dramatic, musical and artistic works;
- ii) Cinematograph film, and
- iii) Sound recordings.

The nature of the acts varies according to subject matters. The copyright subsists in any original work recordings, the nature of the acts varies according to subject matters the copyright subsists in any original works specified in the Act from the moment of its publication during the time of the author, plus 60 years with certain exceptions.

The literary work includes computer programmes, tables and compilation including computer database. The Act deals with the licensing and assignment of the copyrights in any work, the power of authorities an institutions, the 1999 Act provides for know-how and confidential information can be protected only so long as the owner is able to keep them secret and takes action against unlawful use of such information by others by an action for breach of the confidence or the contract.

The Law of Patents, Designs, and Trade Marks, are territorial in their operation, whereas the Law of Copyright deals with copyrights acquired in one country extends to other countries which are the members of the Bene Convention and niversal Copyright Convention. India is the member of both the Conventions. The Copyright can be commercially exploited by assigning or licensing it to another for lump sum payment or on a royalty basis. The scope of assignment and licensing of Copyright is much more wider having regard to the variety of rights conferred on the copyright owner.

[17]

[November, 2011 (30/11/11)]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.

2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) What is “certification trade mark”?

Answer : Certified trade mark is a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services; quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name, as proprietor of the certification trade mark, of that person. [Trade Marks Act – Section 2 (e)].

b) What is meant by “patent”?

Answer : A Patent is a monopoly right granted for a limited period to a person (i.e. patentee) for excluding others from making, using, selling, importing the patented product or process producing that product when a patentee who has: i) invented a new and useful article, or ii) made the improvement of an existing article or iii) a new process of making an article.

c) Define an “inventive step”.

Answer : “Inventive step” means feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled the art”. [Patents Act – Section 2 (1) (ja)].

d) What is the period of assignment of copyright ?

Answer : if the period of assignment is not stated, it shall be deemed to be five years from the date of assignment. [Copyright Act – Section 19 (5)].

e) Who can apply for the registration of geographical indication ?

Answer : Section 2 (e) of the Geographical Indications Act defines “geographical indication”. Geographical indications identifies goods as originating from particular territory such as, Swiss chocolates, Basamati rice, etc. Any citizen of the country/territory can apply for the registration of the same on behalf of the nation/country to which such goods are attributable.

f) Who is a registered user under the Trade Marks Act, 1999 ?

Answer : Under Section 2 (x) of the Trade Marks Act, 1999, “registered user” means, a person who is for the time being registered as such under Section 49 of the Act.

g) What is meant by a priority date under Section 11 of the Patents Act, 1970.

Answer : "priority date" has a meaning assigned to it by Section 11 of the Act. Thus, priority date of claim of a complete specification shall be the date of filing of the relevant specification.

h) State the works in which copyright subsists.

Answer : Copyright subsists only in certain classes of works : a) Original Literary, Dramatic, Musical and Artistic Works. b) Cinematographic films. C) Sound Recordings. [Copyright Act - Section 13 (1)].

i). What are the reliefs available in passing off action ?

Answer : An action of passing off is a Common Law remedy. A plaintiff can ask for injunction and a compensation for the damages caused by the defendant.

j) Which designs cannot be registered ?

Answer : A design which - i) is not new or original; or ii) has been disclosed to the public prior to the priority date of the application for registration; iii) is not significantly distinguishable from known designs; or iv) comprises or contains scandalous or obscene matter, shall not be registered. [Designs Act, 2000 - Section 4].

Q. 2 : Write short notes on Any Four of the following : = 20.

- a) Anton Pillar Order.
- b) Patents of Addition.
- c) Collective Mark.
- d) Copyright Societies.
- e) Patent protection for micro-organisms.
- f) Prohibition of registration of certain geographical indications.

Q. 3 : Attempt Any Two with reasoned answers : = 12.

a) The Government starts the manufacture of a drug by a process which is not the same as the one by which Glaxo, the patentee, manufactures the same drug. The drug manufactured by the Government is distributed in Public Health Centres. Glaxo files a suit against the Government for infringement.

i) What will be the fate of the suit ?

Answer : Glaxo will not succeed in the suit, as the process of manufacture of drug is different, so there be no effect of the suit.

ii) What provisions of the Patent Act will the Court rely upon in passing the order ?

Answer : The Court will rely upon the provision of Section 99 of the Patents Act, 1970 - "Use of inventions for the purposes of Government" - [Section 99].

iii) Will the result be different if the process of manufacture was the same ?

Answer : Yes, in such a case, the result would have been different if the process of manufacture was the same, then it would amount to an infringement of a patent.

b) A proprietor of an unregistered Trade Mark brings a suit for infringement against the proprietor of registered Trade Mark, who is merely exercising his right to use the mark.

i) Is the suit maintainable?

Answer : No, under Section 27 of the Act, no action for infringement of unregistered trade mark is maintainable.

ii) Can the proprietor of a registered trade mark be guilty of infringement when using his own mark?

Answer : No, he cannot be said to be guilty of infringement.

iii) What remedy is available to the proprietor of the unregistered Trade mark?

Answer : The remedy for infringement will be available to him when he gets the Trade Mark registered under the Trade Marks Act, 1999.

c) "X" is the author of a play in which the copyright subsists. The drama club of Ideal High School stage the play in the school gathering. No fee is charged for attending the same. "X" files a suit against the school.

i) Will "X" succeed?

Answer : "X" will not succeed.

ii) What is the defence available to the school?

Answer : The defence available to the School is, as the students can stage a play for the information relating to knowledge of education, and they can quote from the book or play/drama. Therefore, there is no infringement of a copyright. There act is a permitted act.

iii) Which provision of the Copyright Act is applicable to this case?

Answer : The provision of Fair use under Section 52 of the Copyright Act, 1957.

Q. 4 : Answer Any Four of the following : = 48.

- a) Discuss the procedure for the registration of Trade Marks. What are the effects of registration?
- b) Who can file a suit for the infringement of a Trade Mark? What are the defences available to the defendant? What reliefs can the court pass in suit for infringement?
- c) Discuss the grounds for a pre-grant and post-grant opposition to the grant of patent.
- d) What is anticipation? Discuss the various ways in which a patent may be anticipated.

e) When is a copyright infringed? State and discuss the exceptions thereto?

f) Discuss the rights of broadcasting organization and performers.

[18]

[May, 2012 (12/5/12)]

(Revised Course)

With Solutions

N.B.

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) What is a certification trade mark ?

Answer : Certification trade mark means, a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name, as proprietor of the certification trade mark, of that person.

b) Define "invention".

Answer : Invention means, a new product or process involving an inventive step and capable of industrial application.

c) Who is the person interested under the Patents Act, 1970 ?

Answer : Person interested includes a person engaged in, or in promoting, research in the same field as that to which the invention relates.

d) What is a well-known trade mark ?

Answer : Well-known trade mark in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of

trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services. [Section 2 (zg)].

e) Who is a registered proprietor in respect of a geographical indication ?

Answer : A Registered Proprietor in relation to a geographical indication means, any association of persons or producers or any organization for the time being entered in the register as proprietor of the geographical indication.

f) What is a priority date u/s. 11 of the Patents Act, 1970 ?

Answer : There shall be priority date for each claim of a complete specification.

g) What is the distinction between a suit for passing off and a suit for infringement ?

Answer : For an action of passing off, the trade mark need not be registered, however, for an action of infringement, the trade mark is compulsorily required to be registered.

h) What are various types of Intellectual Property Rights ?

Answer : The various types of intellectual property are – i) Copyright; ii) Patents; iii) Trade Marks; iv) Designs; v) Geographical Indications,; etc.

i) What is the period of assignment of copyright ?

Answer : The period of assignment of copyright will be the period agreed upon by the Author and Assignee, or if the period of Assignment is not stated in the Agreement, then it shall be deemed to be 5 years from the date of Assignment.

[The owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign to any person the copyright wholly or partially, and either generally or subject to limitations, and either for the whole term of copyright or any part thereof].

j) What are the qualifications for becoming a patent agent ?

Answer : Patent agent means, a person for the time being registered under the Act as a patent agent. A person who is a citizen of India; completed the age of 21 years; has obtained a degree of science, engineering or technology for any established under law; has passed qualifying exam as prescribed; has for a total period of not less than 10 years functioned either as an examiner or discharged the functions of Controller under Section 73 or both; has paid prescribed fees.

Q. 2 : Write short notes of Any Four of the following : = 20.

- a) Collective Mark.
- b) Copyright Board.
- c) Anton Pillar Order.

d) Patents of Addition.

e) Specification.

f) Geographical Indication.

Q. 3 : Attempt Any Two with reasoned answer : = 12.

a) Doctor & Co. manufactures a product under that trade mark FIXON which is not registered. T. Rex & Co., subsequently, registers the mark FIXON in its name and starts to use it. Doctor & Co. files a suit for infringement of their trade mark.

i) Is the suit maintainable ?

Answer : No, the suit is not maintainable.

ii) Can a registered proprietor of trade mark, be guilty of infringement ?

Answer : Yes, the registered proprietor is guilty of infringement in the eyes of law.

iii) What remedy is available to Doctor & Co. ?

Answer : The remedy is to register Trade Mark according to the Trade Marks Act by which the Doctor & Co. is an official owner and can sue on infringement.

b) "X", who is employed in Newton & Co., in the research and development department. "X", while working in the laboratory of the Company, invents a new machine. Newton & Co. apply for the patent.

i) Is the application maintainable ?

Answer : No, the application is not maintainable.

ii) Can "X" oppose the application ?

Answer : No, X cannot oppose the application.

iii) What would be the defence of Newton & Co. ?

Answer : The defence will be that, Mr. X is employed in their Company in research and development department, and it is a part of employment job.

c) Mr. "P" writes a play, "Hum Hindustani", about national integration. "Q", a film producer takes the basic theme of the play and makes a movie out of it. "P" files a suit for infringement of copyright.

i) Will "P" succeed ?

Answer : Yes, P will succeed.

ii) What is the principle on which the court will rely ?

Answer : The Court will rely on the principle of Original, Literary, Dramatic, and in relation to a literary or dramatic work, the author of the work has copyright.

iii) State the leading case on which this problem is based.

Answer : The leading case is based Chidambar v/s. Renga, AIR 1966 SC 193.

Q. 4 : Answer Any Four of the following : = 48.

- a) What is the procedure for the registration of trademarks and what is the effect of registration ?
- b) Discuss the powers of the Controller in granting compulsory licenses. What are the terms and conditions on which such license may be granted ?
- c) What is a convention application ? What are the special and supplementary provisions relating to convention applications under the Patents Act, 1970 ?
- d) Explain the concept of copyright and state the various rights which are comprised in copyrights.
- e) Discuss the provisions of the Copyright Act, 1957 in relation to copyright societies.
- f) What is meant by the term "Intellectual Property Rights" ? What is the justification for the protection of Intellectual Property Rights ?

[19]

[December, 2012 (10/12/12)]

(Revised Course)

With Solutions

N.B:

- 1) There are no Sections in the Question Paper.
- 2) Answer Question Nos. 2 and 4 with reference to some illustrations wherever required.

Q. 1 : Answer in not more than Two sentences : = 20.

a) Define "dramatic work".

Answer : Dramatic work includes any piece of recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting, form of which is fixed in writing or otherwise, but does not include a cinematograph film.

b) Define "certification mark".

Answer : Certification trade mark means, a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registerable as such under

Chapter IX in respect of those goods or services in the name, as the proprietor of the certification trade mark, of that person.

c) **What is a convention country under the Patents Act, 1970.**

Answer : Convention country means, a country or a country which is member of a group of countries or a union of countries or an –Inter-governmental Organization referred to as a Convention Country in Section 133.

d) **Define “publication” under the Copyrights Act, 1957.**

Answer : Publication work means, making a work available to the public by issue of copies or by communicating the work to the public.

e) **What is meant by Geographical Indication ?**

Answer : Geographical Indication, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods or originating, or manufactured in the territory of a country, or a region, or locality in that territory, where a given quality, reputation or other characteristics of such goods is essentially attributable to its geographical origin, and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned, takes place in such territory, region, or locality, as the case may be.

f) **Define “broadcast” under the Copyrights Act, 1957.**

Answer : Broadcast means, communication to the public – i) by any means of wireless diffusion, whether in any one or more of the forms of signs, sounds or visual images; or ii) by wire, and includes a broadcast.

g) **What is work of joint authorship ?**

Answer : The work of joint authorship is help the author in his work, till completion.

h) **What is a patent addition ?**

Answer : Patent in addition shall be granted for improvement or modification of patented invention. Section 54, 55, 56 of the Patent Act deals with it.

i) **What is meant by adaptation under the Copyrights Act, 1957 ?**

Answer : Adaptation means – i) in relation to a dramatic work, the conversion of the work into a non-dramatic work; ii) in relation to a literary work, an artistic work, the conversion of the work into a dramatic work by way of performance in public or otherwise; iii) in relation to a literary or dramatic work, any abridgement of the work or any version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a

newspaper, magazine or similar periodicals; iv) in relation to a musical work, any arrangement or transcription of the work; and v) in relation to any work, any use of such work involving its re-arrangement or alteration.

j) Who is a registered proprietor under the Geographical Indications Act?

Answer: A Registered Proprietor in relation to a geographical indication means, any association of persons or of producer or any organization for the time being entered in the register as proprietor of the geographical indication.

Q. 2 : Write short notes on Any Four of the following: = 20.

- Piracy of a registered design.
- Transfer of patent.
- Copyright society.
- Performer's right.
- Well known trademark.
- Revocation of patents.

Q. 3 : Answer Any Two with reasoned answers : = 12.

a) BROSAN Pharmaceutical Company claims to have invented a medicine for headache, which gives instant relief in 2 minutes. The tablet 'Xfast' is a combination of their previous two cold tablets without any new invention; But 'Xfast' produces quicker relief.

i) State whether 'Xfast' tablet will be entitled for patent?

Answer : No, 'Xfast' tablet will not be entitled for patent.

ii) What are the main ingredients required to qualify for patent?

Answer : The main ingredients required to qualify for a patent are - 1) by any person claiming to be true and first inventor of the invention; 2) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application; 3) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

b) 'Fun and Frolic Entertainment' announced a film based on life and times of King Akbar. Divine Films Limited filed a suit prohibiting 'Fun and Frolic Entertainment' from proceeding with the shoot of the film, on the ground that, their own serial based on King Akbar was already being shown in a 'X' private channel.

i) Whether Divine Films Limited claims are valid?

Answer : No, the claim of Divine Films Limited are not valid.

ii) Can anyone have a copyright over historical and legendary characters?

Answer : No, one can have a copyright over historical and legendry characters.

c) ABC Pharmaceutical Company wanted to introduce a cough syrup 'CREMONE' in the market, and applied for trademark under the name 'CREMONE'. XYZ Company, which already had a registered Trade Mark 'CREMLON' cough syrup, raised objection on the grounds of trademark being deceptively similar.

i) State whether XYZ Company will succeed ?

Answer : Yes, XYZ Company will succeed.

ii) What is deceptive similarity?

Answer : A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion.

Q. 4 : Answer Any Four out of the following : = 48.

- a) What is meant by intellectual property?, and discuss the various kinds of intellectual properties.
- b) Explain in detail, the term 'Industrial Design'. Enumerate the procedure of Registration of Industrial Design.
- c) Discuss the law relating to infringement of copyrights.
- d) Define invention, and state what are not inventions under the Patents Act, 1970.
- e) What do you mean by the term 'copyright'. What are the rights conferred by virtue of copyright ?
- f) What is infringement of a trademark ? What are the remedies available for infringement ?

[20]

[May, 2013 (02/5/13)]

(Revised Course)

With Solutions

N.B.

- 1) There are no separate Sections in the Question Paper.
- 2) Answer Question Numbers 2 and 4 with reference to some illustrations wherever required.

Q.1: Answer the following in not more than Two sentences : = 20.

a) What is an 'inventive step' ?

Answer : Inventive step means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both. And that makes the invention not obvious to a person skilled in the art.

b) What do you mean by originality of design ?

Answer : Original, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet, are new their application.

c) Define 'publication' under the Copyright Act, 1957.

Answer : Publication means, making a work available to the public by issue of copies or by communicating the work to the public.

d) Who is a registered user ?

Answer : Registered user means, a person who is for the time being registered as such under Section 49 of the Trade marks Act, 1999.

e) What is a patent of addition ?

Answer : Where application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor and the applicant also applies or has applied for a patent for that invention or is the patentee, the Controller may, if the applicant requests, grant the patent for the improvement or modification as a Patent of Addition.

f) Define 'dramatic work'.

Answer : Dramatic Work includes any piece or recitation , choreographic work or entertainment in dumb show, the scenic arrangement or acting, form of which is fixed in writing or otherwise, but does not include a cinematograph film.

g) What is meant by 'Geographical Indication' ?

Answer : Geographical indication, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods originating or manufactured in the territory of a country; or a region or locality in that territory, where given quality, reputation or other characteristics of such goods is essentially attributable to its geographical origin, and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned, takes place in such territory, region or locality, as the case may be.

h) What is meant by 'adaptation' under the Copyright Act ?

Answer : Adaptation means, – i) in relation to a dramatic work, the conversion of the work into a non-dramatic work; ii) in relation to a literary work an artistic work, the conversion of the work into a dramatic work by way of performance in public or otherwise; iii) in relation to a literary or dramatic work, any abridgement of the work or any version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a news paper, magazine or similar periodicals; iv) in relation to a musical work, any arrangement or transcription of the work; and v) in relation to any work, any use of such work involving its rearrangement or alteration.

i) **What is work of joint authorship ?**

Answer : The work of joint authorship is to help the author in his work till completion.

j) **Who is a registered proprietor under the Geographical Indications Act ?**

Answer : A registered proprietor in relation to a geographical indication means any association of persons or of producer or any organization for the time being entered in the register as proprietor of the geographical indication.

Q.2: Write short notes on Any Four of the following : _____ = 20.

- a) Surrender of Patents.
- b) Assignment of Copyright.
- c) Piracy of a registered design.
- d) Functions of trade Mark.
- e) Transfer of Patent.
- f) Well-known Trade Mark.

Q. 3 : Answer Any Two with reasoned answers : _____ = 12.

a) Professor X published a book on the subject of Environmental Law and it was made available for sale. Professor Y bought the book and used the same for delivering lectures and also giving notes from the book. Professor X sued Y for violating his copyright.

i) **Whether Professor Y has violated the copyright and state reasons ?**

Answer : No, Professor Y has not violated the copyright. For study purpose professors or students can quote from the book under Section 52, of the Copyright Act, 1957.

ii) **State whether a professor can have a copyright on his lecture ?**

Answer : No, the lecture is given by Professor Y by purchasing the book and delivering lecture from it, will not have copyright.

b) TYK Company applied for registration of trademark for its newly launched oil product, named 'ALLEPAY KERALA OIL' for healing arthritis, although the oil was manufactured in Vasai, Maharashtra. The Registrar refused to register the said trademark.

i) Whether the Registrar's decision was right ?

Answer : Yes, the Registrar's decision was right.

ii) Whether geographical names be used as trademark ?

Answer : Geographical indication or name is used in trade mark in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods, one of the activities of either the production or of processing or preparation of the goods concerned, takes place in such territory, region or locality, as the case may be.

c) Kingston Pharmaceutical Company claims to have invented a medicine for headache which gives instant relief in minutes. The tablet 'Super Relief' is a combination of their previous two cold tablets without any new invention. But 'Super Relief' produces quicker relief.

i) State whether 'Super Relief' tablet will be entitled for the patent ?

Answer : No, 'Super Relief' tablet will not be entitled for Patent. For the purpose of patent, invention means, a new product or process involving an inventive step and capable of industrial application.

ii) What are the main ingredients required to qualify for the patent ?

Answer : The main ingredients required to qualify for patent are an application by – 1) any person claiming to be true and first inventor of the invention; 2) any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application; 3) the legal representative of any deceased person who immediately before his death was entitled to make such an application.

Q. 4: Answer Any Four out of the following : = 48.

- a) What is meant by 'intellectual property' ? and discuss the various kinds of intellectual properties.
- b) Explain in detail the term 'Industrial Design'. Enumerate the procedure of Registration of Industrial Design.
- c) Discuss the law relating to infringement of copyrights.
- d) Discuss the provisions of the Patents Act with respect to provisional and complete specifications.

- e) What is a trade mark ? Discuss the various grounds of refusal of registration of trade marks.
- f) What is the meaning of the word 'copyright' ? Discuss the works in which copyright subsists.

[21]

[December, 2013 (02/12/13)]

(Revised Course)

With Solutions

N.B.

- 1) There are no separate Sections in the Question Paper.
- 2) Answer Question Numbers 2 and 4 with reference to some illustrations wherever required.

Q. 1: Answer the following in 2-3 sentences each : = 20.

a) Explain "distinctiveness".

Answer : An essential element of device claimed to be a trade mark is that, it identifies the goods of a particular merchant, and distinguish them from the goods of others. A word, symbol, shape or colour serving this purpose is said to be distinctive.

User for one year prior to application is not sufficient to acquire Distinctiveness under Section 9, to qualify for registration the mark should have acquired distinctiveness by long user [Sarda Plywood Industries Ltd. v/s. Deputy Registrar Trade Marks, 2007 (34) PTC 352 (IPAB) i.e. Intellectual Property Appellate Board].

b) Define "inventive step".

Answer : Inventive step means, a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both, and that makes the invention not obvious to a person skilled in the art.

c) Who is performer ?

Answer : Performer includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance.

d) Explain the term "Design".

Answer : Design means, only the feature of shape, configuration, Pattern, ornament or composition of lines or colours applied to any article, whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which is in the finished article appealing to and are judged solely by the eyes; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of the Trade Mark Merchandise Marks Act, 1958 or property mark as defined in Section 479 of the Indian Penal Code, 1860 or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957.

e) Explain "government work".

Answer : Government work means, a work which is made or published by or under the direction or control of - i) the Government or any department of the Government; ii) any Legislature in India; iii) any Court, Tribunal or other Judicial Authority in India.

f) Who is the Registered user under the Trade Marks Act, 1999 ?

Answer : Subject to the provision of the registered user, a person other than the registered proprietor of a trade mark may be registered as a registered user thereof in respect of any or all of the goods or services in respect of which the trade mark is registered.

g) State the works in which copyright subsists.

Answer : The work in which copyright subsists are - a) Original, Literary, Dramatic, Musical and Artistic Work; b) Cinematograph Films; and iii) Sound Recording.

h) Define goods.

Answer : Goods means, anything which is the subject of trade or manufacture.

i) What is a Collective Trade mark ?

Answer : A Collective Trade Mark means, a trade mark distinguishing the goods and services of the members of an association of persons not being a partnership firm, which is the proprietor of the mark, from those of others.

j) What are "Indications" ?

Answer : Indications include any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.

Q.2 : Write short notes on Any Four of the following : =20.

- a) Copyright Societies.
- b) Objectives of Trade mark law.
- c) Right of Performers.
- d) Specifications.
- e) Producer.
- f) Communication to the public.

Q.3 : Situational Problems: Solve Any Two of the following : =12.

a) Actor John wants to apply for registration of his personal name "John" as a Trademark for John Studios.

i) Will John get registration of his name as a Trademark? Explain.

Answer : Yes, the John will get the registration in his name.

ii) Name the Section for making the application and name the Authority.

Answer : Section 18 of the Trade Marks Act, 1999, where the provision of application for registration is provided the name of authority is Registrar of the trade Marks Registry.

b) Mr. X has invented a new method of germination of Brinjal seeds, which grow very fast. Mr. X applies for Registration as patent for his new invented method.

i) Will Mr. X succeed to get registration?

Answer : No, Mr. X will not succeed to get registration as it comes under Section 3 where inventions are not patentable, are described.

ii) Explain the feature of patentable invention.

Answer : An invention of a new product or process involving an inventive step and capable of industrial application is patentable invention.

c) Songs composed by Mr. Y, the composer, are sung by the students of an educational institution during the Annual Day. Mr. X, one of the students' parent complains to Mr. Y, the composer, who desires to file a criminal complaint.

i) Is Mr. Y's complaint maintainable?

Answer : No, Mr. Y's complaint is not maintainable.

ii) State and explain the provision of law.

Answer : Section 52 of the Copyright Act, 1957 is applicable to this case, where it is provided that, certain acts does not amount to an infringement of Copyright.

Q.4 : Answer Any Four of the following : = 48.

- a) Discuss the doctrine of "Deceptive Similarity".
- b) "All inventions are not patentable". – Discuss.

- c) State the effects of Registration of Geographical Indications.
- d) What is passing off? State the modes of passing off.
- e) "Copyright is a bundle of rights". - Explain.
- f) What is Intellectual Property? Explain the types of Intellectual Property.

[22]

[May, 2014 (05/5/14)]

(Revised Course)

With Solutions

N.B.

- 1) All questions are Compulsory.
- 2) Cite Case-law wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in Two sentences each : = 20.

a) What is a Trade-mark ?

Answer : Trade Mark means a mark capable of being represented graphically, and which is capable of distinguishing the goods or services of one person from those of others, and may include shape of goods, their packaging and combination of colours.

Trade Mark is an indication to the purchaser or possible purchaser as to the manufacture of quality of goods.

b) What is meant by Patent of addition ?

Answer : Where application is made for a patent in respect of any improvement in, or modification of an invention described or disclosed in the complete specification filed therefor, and the applicant also applies or has applied for a patent for that invention or is the patentee, the Controller may, if the applicant requests grant of the patent for improvement or modification as a Patent of Addition.

c) Define an inventive step.

Answer : Inventive Step means a feature of an invention that involves technical advance as compared to the existing knowledge, or having economic significance, or both, and that makes the invention not obvious to a person skilled in the art.

d) What is the term of copyright for a 'musical work' ?

Answer : Musical work means a work consisting of music, and includes any graphical notation of such work, but does not include any words or any action intended to be sung, spoken or performed with the music.

- e) Who is a composer ?
Answer : Composer in relation to a musical work, means the person who composes the music regardless of whether he records it in any form of graphical notation.
- f) Explain the term 'Design'.
Answer : Design means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional, or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combine, which in the finished article appealing to the eye and solely judged by the eye.
- g) Explain the term 'work'.
Answer : Work means any of the following works, namely – i) Literary, Dramatic, Musical or Artistic work; ii) Cinematograph film; iii) Sound recording.
- h) Who is the Registered User under the Trade Mark Act, 1999 ?
Answer : Under Section 48 of the Trade marks Act, 1999, a person other than the registered proprietor of a trade mark may be registered as a registered user thereof in any or all of the goods or services in respect of which the trade mark is registered.
- i) State the works in which copyright subsists.
Answer : The work in which copyright subsists are – a) Original literary, Dramatic, Musical and Artistic work; b) Cinematograph Films; and c) Sound recording.
- j) What are 'goods' ?
Answer : Goods means anything which is the subject of trade or manufacture.

Q. 2: Write short notes on Any Four of the following : = 20.

- a) Geographical Indications.
- b) Fair Dealing.
- c) Copyright Societies.
- d) Communication to the Public.
- e) Compulsory Licensing in Patents.
- f) Requirements of Registration of Designs.

Q. 3 : Attempt Any Two of the following situational problems : = 12.

- a) An Acrobat enchants the audience with his performance. Mr. B makes a visual recording of the performance, and without the consent of the Acrobat exhibits the same to his friends on payment of charges.
- i) State the technical term which could define the Acrobat.

Answer : The technical term is ‘performer’ which includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance – [Section 2 (qq)], and he is also an ‘author’ in relation to an artistic work other than a photograph, ‘the artist’ – Section 2.(d) (iii) of the Copyright Act, 1957.

ii) Has Mr. B committed any offence under the Copyright Act, 1957 ? If yes, state the penalty, if any.

Answer : Yes, Mr. B has committed an offence of Infringement of Copyright. He shall be punished with imprisonment for a term which shall not be less than 6 months, but which may extend to 3 years, and with fine which shall not be less than Rs. 50,000/-, but which may extend to Rs. 2 Lakhs.

b) Mr. Jack wants to use the name Ramesh who died recently, as his trade mark and applies for registration of the mark “Ramesh”, to the Registrar of Trade Marks.

i) State the procedure for Mr. Jack as per Section 14 of the Trade Mark Act, 1999.

Answer : Section 14 of the Act provides for use of names and representations of living persons or persons recently dead – Where an application is made for the registration of a trade mark which falsely suggests a connection with any living person, or a person whose death took place within 20 years prior to the date of an application for registration of a trade mark, the registrar may, before he proceeds with the application, require the applicant to furnish him with the consent in writing of such living person, or as the case may be, of the legal representative of the deceased person to the connection appearing on the trade mark, and may refuse to proceed with the application unless the applicant furnishes to the Registrar with such consent.

ii) State and explain the qualities of a good mark.

Answer : 1) It should be easy to pronounce and remember, if the mark is a word; 2) In case of device mark, the device should be capable of being described by single word; 3) It should be short; 4) It must be easy to spell correctly and write legibly; 5) It should not be descriptive, but may be suggestive of the quality of the goods; 6) It should appeal to the eyes, as well as, to the ear; 7) It should satisfy the requirements of Registration.

c) Mr. P invents and discovers a new method of cultivating pulses and desires to apply for a patent for the invention.

i) Will Mr. P succeed to get a patent in the above case ?

Answer : No, Mr. P will not succeed to get a patent as it comes under Section 3 of the Patents Act, 1970 where inventions not patentable are described.

ii) What the qualities of an invention to get a patent ?

Answer : An invention of a new product or process involving an inventive step, and capable of industrial application is patentable invention.

Q. 4 : Answer Any Four of the following : = 48.

- a) Explain the term Intellectual Property and explain its features.
- b) Explain the defences available to the Defendant in the suit for infringement of trade mark.
- c) Discuss Revocation of a Patent.
- d) State the law on Registration of Designs.
- e) What is Passing Off ? Distinguish between an action of infringement of trade mark and Passing Off.
- f) Which are the works in which copyright subsists ?

[23]

[November, 2014 (25/11/14)]

(Revised Course)

With Solutions

N.B.

- 1) All questions are Compulsory.
- 2) Cite Case-law wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in Two sentences each : = 20.

a) Explain the term 'Computer'.

Answer : Computer means any electronic, magnetic, optical or other high speed data processing device or system which performs logical, arithmetic, and memory functions by manipulations of electronic, magnetic or optical impulses, and includes all input, output processing, storage, computer software, or communication facilities which are connected or related to the computer in a computer system or computer network.

b) What is the period of assignment of copyright ?

Answer : The period of assignment of copyright will be the period agreed upon by the Author and Assignee, or if the period of Assignment is not stated in the Agreement, then it shall be deemed to be 5 years from the date of Assignment.

[The owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign to any person the copyright wholly or partially, and either generally or subject to limitations, and either for the whole term of copyright or any part thereof].

c) Who can apply for a registration of a Design ?

Answer : The proprietor of a new or original design can apply for registration of his Design.

d) Define 'Inventive Step'.

Answer : Inventive Step means a feature of an invention that involves technical advance as compared to the existing knowledge, or having economic significance, or both, and that makes the invention not obvious to a person skilled in the art.

e) What is Patent of Addition ?

Answer : Where application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor and the applicant also applies or has applied for a patent for that invention or is the patentee, the Controller may, if the applicant requests, grant the patent for the improvement or modification as a Patent of Addition.

f) Explain the term Indication.

Answer : Indications include any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.

g) Explain the term 'article'.

Answer : Article means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

h) Who is a composer ?

Answer : Composer in relation to a musical work, means the person who composes the music regardless of whether he records it in any form of graphical notation.

i) What is an Indian work ?

Answer : Indian work means a literary, dramatic or musical work - 1) the author of which is a citizen of India; or 2) which is first published in India; or 3) the author of which, in the case of an unpublished work is, at the time of the making of the work, a citizen of India.

j) Explain the term 'goods'.

Answer : "Goods" means, anything which is the subject of trade or manufacture.

Q. 2 : Write short notes on Any Four of the following = 20.

- a) Right Management Information.
- b) Rights and Liabilities of Copyright Societies.
- c) Mareva Injunction.
- d) Specification.
- e) Priority Date.
- f) Qualities of a Good Trade mark.

Q. 3 : Solve Any Two of the following problems : = 20.

- a) Mr X applies for registration of a Design of Rectangle to be applied to goods.
i) Will Mr. X succeed to get the Design of Rectangle registered under the Designs Act, 2000 ?

Answer : No, Mr. X will not succeed, because, there is prohibition of registration of certain designs, which is not new or original or is not significantly distinguishable from known designs.

ii) Explain the provision of law applicable.

Answer : The provision of law applicable in this case is Section 4 of the Designs Act, 2000.

- b) The author Mr. X bequeaths his unpublished poem "The Rays" to his son Y by virtue of a Will.

i) Is the bequeath valid in law ?

Answer : Yes, the bequeath is valid under Section 20 of the Copyright Act, 1957.

ii) Is the son entitled for copyright on the poem "The Rays" ?

Answer : Yes, the son of the author Mr. X is entitled for copyright.

- c) 'A' prepares an admixture of two chemicals, which react and produce a new chemical which is only an aggregation of the properties of the two mixed chemicals. Mr. 'A' desires to apply for a Patent.

i) Will Mr. 'A' succeed to get a Patent ?

Answer : No, Mr. A will not succeed to get Patent.

ii) State and explain the provision of law.

Answer : The provision of law in the Patents Act, 1970 is provided under Section 3 which states that – a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.

Q. 4 : Answer Any Four of the following : = 48.

- a) Explain the nature and scope of Intellectual Property Rights.
- b) Discuss the grounds of refusal of registration of a Trade Mark under the Trade Mark Act, 1999.

- c) Explain Revocation of a Patent.
- d) Explain the effects of Registration of Geographical Indication.
- e) Which are the acts which do not amount to infringement of copyright ?
- f) Discuss the law of Passing Off with relevant case law.

[24]

[May, 2015 (07/5/15)]

(Revised Course)

With Solutions

N.B.

- 1) All questions are Compulsory.
- 2) Cite Case-law wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in Two/Three sentences each : = 20.

a) Explain the term 'patent'.

Answer : Patent means a patent for any invention granted under the Patents Act, 1970.

b) What is a musical work ?

Answer : Musical work means a work consisting of music and includes any graphical notation of such work, but does not include any words or any action intended to be sung, spoken or performed with the music.

c) Who can apply for a registration of a design ?

Answer : Any person claiming to be the proprietor of any new original design not previously published in any country and which is not contrary to public order or morality, may apply for registration of the designs under the Designs Act, 2000.

d) Define 'invention'.

Answer: Invention means a new product or process involving an inventive step and capable of industrial application.

e) What is a 'Patent of Addition' ?

Answer : Where application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefore and the applicant also applies or has applied for a patent for that

invention grant the patent for the improvement or modification as a patent of Addition.

f) Explain the term 'indication'.

Answer : Indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.

g) Explain the term 'article'.

Answer : Article means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

h) Who is a performer ?

Answer : Performer includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance.

i) What is 'reprography' ?

Answer : Reprography means the making of copies of a work, by photocopying or by similar means.

j) Explain the term 'mark'.

Answer : Mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape or goods, packaging or combination of colours or any combination thereof.

Q. 2 : Write short notes on Any Four :

= 20.

a) Commercial rental.

Answer : The Copyright (Amendment) Act, 2012 proposes to replace the word 'hire' with 'commercial rental' in Section 14 (d) (ii) - "to sell or give on commercial rental or offer for sale or for such rental, any copy of the film"; Section 14 (e) (ii) - "to sell or give on commercial rental or offer for sale or for such rental, any copy of the sound recording; and Section 37 (3)(e) - "to sell or give on commercial rental or offer for sell or for such rental, any such sound recording or visual recording referred to in clause (c) and clause (d).

Now, the Amendment proposes to replace 'hire' with 'commercial rental'. The Amendment also inserts the definition for commercial rental. The definition is as follows:

Section 2 (fa) : 'Commercial rental' does not include the rental, lease or lending of a lawfully acquired copy of a computer programme, sound recording, visual recording or cinematograph film done non-profit purpose by a non-profit library or non-profit education institution.

Explanation - For the purposes of this clause a 'non-profit library or non-profit educational institution' means a library or educational institution which receives grants from the Government or exempted from payment of tax under the Income Tax Act, 1961 (43 of 1961).

The definition is more like an exception to copyright infringement. Instead of ascertaining the ambit of Commercial rental it excludes giving on rent, landing or leasing of the work by nonprofit library and nonprofit education institution for nonprofit purpose.

Commercial rental according to definition means giving on rent or lending or leasing of a lawfully acquired copy of the work. It is unlikely that it would encompass more and would not permit such organization from distributing in such ways.

The exclusion of giving copies of Copyright work on rent, landing or lasing by non-profit libraries and education institutions is a step forwards encouraging research and scholarship.

- b) Copyright societies.
- c) Fair dealing.
- d) Provisional specification.
- e) Object of patent law.
- f) Qualities of a good trade mark.

Q. 3 : Solve Any Two of the situational problems : = 12.

- a) Mr. X applies for registration of a design "Hexagon" to be applied to goods.
i) Will Mr. X succeed to get the design "Hexagon" registered under the Designs Act, 2000 ?

Answer : No, Mr. X will not succeed because there is prohibition of Registration of certain designs, which is not new or original or is not significantly distinguishable from known designs.

ii) Explain the provision of law applicable.

Answer : The provision of law applicable here is Section 4 of the Design Act, 2000- Prohibition of registration of certain designs.

b) The author Mr. X relinquishes all his copyright in the poem “The Moon” to the Registrar of Copyrights.

i) Is the relinquishment valid? Explain with provision of law.

Answer : Yes, this relinquishment will be valid under Section 21 of the Copyright Act, 1957.

ii) What will be the effect of the relinquishment on the rights in the work subsisting in favor of any person?

Answer : The effect of the relinquishment on the rights in the works subsisting in favor of any person, the author's right will cease to exist from the date of the notice.

c) Mr. A invents a radioactive substance and applies for a patent for the same.

i) Will Mr. A succeed to get a patent?

Answer : Yes, Mr. A will succeed in getting the patent.

ii) State and explain the provision of law applicable.

Answer : Mr. A is a true and first inventor of the invention [Section 6 of the Patents Act, 1970].

Q. 4 : Answer Any Four of the following : = 48.

- a) Discuss the main forms of Intellectual property rights.
- b) Discuss “marks” which cannot be registered.
- c) Discuss the characteristics which an invention must have to be entitled for a patent.
- d) Explain the prohibition on registration of certain indications as geographical indication.
- e) Copyright is a bundle of rights – Explain.
- f) What is passing off? Discuss with case law.

[25]

[November, 2015 (04/11/15)]

(Revised Course)

With Solutions

N.B.

- 1) All questions are Compulsory.
- 2) Cite Case-law wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in One/Two sentences each : = 20.

a) Explain the term ‘engravings’.

Answer : Engravings include etchings, lithographs, wood-cuts, prints and other similar works, not being photographs.

b) What is the mode of assignment of copyright ?

Answer : The mode of assignment of copyright is - It is in writing, signed by the assignor or by his duly authorized agent.

c) Explain the term design.

Answer : Design means, only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in Section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957 (14 of 1957).

d) Define 'inventive step'.

Answer : Inventive step means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

e) What is a Patent of Addition ?

Answer : Where application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefore and the applicant also applies or has applied for a patent for that invention grant the patent for the improvement or modification as a patent of Addition.

f) Explain the term 'goods'.

Answer : "Goods" means, anything which is the subject of trade or manufacture.

g) Explain 'collective mark'.

Answer :

Answer : A Collective Trade Mark means, a trade mark distinguishing the goods and services of the members of an association of persons not being a partnership firm, which is the proprietor of the mark, from those of others.

h) Who is a composer ?

Answer : Composer in relation to a musical work, means the person who composes the music regardless of whether he records it in any form of graphical notation.

i) What is a Government Work ?

Answer : Government work means, a work which is made or published by or under the direction or control of – i) the Government or any department of the Government; ii) any Legislature in India; iii) any Court, Tribunal or other Judicial Authority in India.

j) Explain the term 'literary work'.

Answer : Literary work includes computer programme, tables and compilation including database.

Q. II : Write short notes on Any Four of the following : = 20.

- a) Communication to the public.
- b) Rights and liabilities of Copyright Societies.
- c) Marve Injunction.
- d) Specification.
- e) Priority Date.
- f) Doctrine of Honest Concurrent Use.

Q. III : Solve Any Two of the following : = 12.

a) Mr. X applies for registration of the term 'Oxygen' as a Trade Mark for his goods.

i) Will Mr. X succeed to get the mark registered as Trade Mark ?

Answer : No, Mr. X will not succeed in getting his mark registered as a trade mark.

ii) Explain the provision of law applicable.

Answer : The trade mark is well known under Section 9. Absolute grounds for refusal of registration proviso (b) – which consists exclusively of marks or indications which may serve in trade or designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

b) Mr. X, a singer sings the song 'Beauty' before an audience in an auditorium. Mr. Y records the said song.

i) Which are the technical terms which could define Mr. X and his song 'Beauty' ?

Answer : The term will be author of musical works.

i) Has Mr. Y committed any offence ? Explain.

Answer: Yes, Mr. Y has committed an offence of infringement of Copyright.

c) On a visit to the Sahara Desert, Mr. X discovers that the Camel of Sahara can travel for nearly a month without water. Mr. X decides to apply for patent for this discovery.

i) Will Mr. X succeed to get Patent?

Answer : No, Mr. X will not succeed to get Patent.

ii) State and explain the provision of law applicable.

Answer : The provision of law in the Patents Act, 1970 is made under Section 3 which stated in proviso (c) and (j). Proviso (c) – the mere discovery of a scientific principle or a formulation of an abstract theory or discovery of any living thing on non-living substances occurring in nature; Proviso (j) – plants and animals in whole or any part thereof other than micro-organism but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.

Q. IV : Answer Any Four of the following (in brief) : = 48.

- a) Explain the nature and types of Intellectual Property Rights.
- b) Discuss the grounds of refusal for registration of a 'Trade Mark' under the Trade Mark Act, 1990.
- c) Explain the limitations on the Rights of a Patentee.
- d) Explain the procedure of registration of Geographical Indications.
- e) Which are the acts which do not amount to Infringement of Copyright?
- f) Discuss the modes of 'Passing Off'.

[26]

[May, 2016 (18/5/16)]

(Revised Course)

With Solutions

N.B.

- 1) All questions are Compulsory.
- 2) Cite Case-law wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in 2-3 sentences each : = 20.

a) What is a 'well known trade mark'?

Answer : Well-known trade mark in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods

or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services. [Section 2 (1) (zg) of the Trade Marks Act, 1999].

b) What is meant by 'patent' ?

Answer : A Patent is a monopoly right granted for a limited period to a person (i.e. patentee) for excluding others from making, using, selling, importing the patented product or process producing that product when a patentee who has i) invented a new and useful article, or ii) made the improvement of an existing article or iii) a new process of making an article.

c) Define 'invention'.

Answer : Invention means, a new product or process involving an inventive step and capable of industrial application.

d) What is the term of 'copyright of a sound-recording' ?

Answer : The author and owner of a sound recording is the producer . "Sound recording means a recording of sounds from which such sounds may be re-produced regardless of the medium on which such recording is made or method by which the sounds are produced" [Section 2 (xx)]. – Examples : Audio cassettes, Compact discs, Records, etc.

e) Explain the term 'performance'.

Answer : Section 2 (q) of the Copyright Act, 1957 defines the term "performance" – "performance, in relation to performer's right, means any visual or acoustic presentation made live by one or more performers".

f) Explain the term 'design'.

Answer : The term design is defined under Section 2 (d) of the Designs Act, 2000 – "Design means only the features of shape; configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye".

g) Explain 'Indian work'.

Answer : "Indian work" means a literary, dramatic or musical work. – (i) the author of which is the citizen of India; or (ii) which is first published in India; or (iii) the

author of which, in the case of an unpublished work is, at the time of the making of the work, a citizen of India" - [Section 2 (1) of the Copyright Act, 1957].

h) Who is 'registered user' under the Trade Mark Act, 1999 ?

Answer : Under Section 2 (1) (x) of the Trade Marks Act, 1999, "registered user" means a person who is for the time being registered as such under Section 49 of the Act.

i) State the works in which copyright subsists.

Answer : Copyright subsists only in certain classes of works : a) Original Literary, Dramatic, Musical and Artistic Works. b) Cinematographic films. C) Sound Recordings. [Copyright Act - Section 13.(1)].

j) Explain the term 'goods' in the Trade Marks Act, 1999.

Answer : Under Section 2 (1) (j) of the Trade Marks Act, 1999, "goods" means anything which is the subject of trade or manufacture.

Q. 2: Write short notes on Any Four of the following : = 20.

- a) Functions of a Trade Mark.
- b) Reasonable requirements of the public.
- c) Good Trade Mark.
- d) Joint Authorship.
- e) Compulsory Licensing in Patents.
- f) Prohibition of Registration of certain Design.

Q. 3 : Solve Any two of the following situational problems : = 12.

a) The famous trade mark TATA is a surname.

i) Which provision of the Trade Mark Act enables the surname to be used as trade mark, despite the express provision that surnames *per se* are unregistrable ?

Answer : According to Section 9 of the Trade marks Act, 1999, one of the absolute ground for registration of the trade mark is that it is devoid of any distinctive character. But under Section 133 of the Act, the preliminary advice may be given by the Registrar as to distinctiveness; And a surname if it has acquired distinctiveness, may be registered as a trade mark. For example, the surname Bajaj, Godrej, Tata, Mahindra are registered as trade marks as they have acquired distinctiveness with respect to the goods with which they are associated before an application for their registration is made.

ii) Name the authority involved in Registration of Marks.

Answer : The authority for the purposes of registration is the Registrar of trade marks.

b) Mr. X, a painter of an advertisement poster claims copyright for the painting on the poster.

i) Will Mr. X succeed to get copyright for the painting ?

Answer : Yes, Mr. X would succeed in getting a copyright for the painting.

ii) Explain the legal provision applicable.

Answer : Under Section 2 (c) the "artistic work" includes a painting, and the copyright subsists for the painting also.

c) An Adivasi in a remote jungle not exposed to civilization invents an arc made of sharpened stone fixed to a stick to kill prey. The Adivasi, when he strayed into a city, is advised to apply for his invention.

i) In the above case, will the Adivasi succeed to get a patent for his invention ?

Answer : No, this Adivasi cannot seek a patent for his invention.

ii) Explain the legal provision applicable.

Answer : Under Section 2 (1) (j) of the Patents Act, 1970, a patent may be granted to an invention of product or process which is "new" and "useful". "Novelty" is the test of "invention" under this Section. The creation of an arc is neither novelty nor invention. According to Section 3 (b) of the Act, it is not an invention.

Q. 4 : Answer Any Four of the following : = 48.

- (i) What is Deceptive Similarity ?
- (ii) Explain the nature and forms of Intellectual Property Rights.
- (iii) What are the rights and duties of a patentee in respect of the patent granted to him ?
- (iv) Define the terms "Broadcast" and "Performer". Discuss the rights of the Broadcasting Organization and of Performers.
- (v) "Copyright is a bundle of rights" – Explain.
- (vi) Explain the grounds of refusal for registration of Trade Marks.

[27]

[November, 2016 (16/11/16)]

(Revised Course)

With Solutions

N.B.

1) All questions are Compulsory.

2) Cite Case-law wherever necessary.

3) Figures to the right indicate full marks.

Q.1: Answer the following in 2-3 sentences each : = 20.

a) What is a "collective mark" ?

Section 2 (1) (g) of the Trade Marks Act, 1999, defines the term "collective mark" as under –

"collective mark" means, 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".

b) What is meant by "patent" ?

Answer : Section 2 (1) (m) of the Amendment Act, 2005 defines Patent. "Patent" means a patent for any invention granted under the Patent Act, 1970. Patent means 'exclusive right' conferred upon the 'patentee' with respect to an 'invention'.

c) Define a "inventive step".

Answer : "Inventive step" means feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled the art". [Patents Act – Section 2 (1) (ja)].

d) What is the term of "copyright of an Artistic Work" ?

Answer : The term "artistic work" is defined under Section 2 (c) of the Copyright Act, 1957. Artistic work means, – (i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality; (ii) a work of architecture; and (iii) any other work of artistic craftsmanship". The copyright of an artistic work subsists during the lifetime of the author of such work and for 60 years following the year of the death of the author.

e) Who is a "performer" ?

Answer : The term is defined under Section 2 (qq) of the Copyright Act, 1957 as – "performer" includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance".

f) Explain the term "design".

Answer : The term design is defined under Section 2 (d) of the Designs Act, 2000 – "Design means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye".

g) Explain "Registered Proprietor".

Answer : "Registered proprietor, in relation to a trade mark, means the person for the time being entered in the register as proprietor of the trade mark" – Section 2 (1) (v) of the Trade marks Act, 1999.

h) Who is 'registered user' under the Trade Mark Act, 1999 ?

Answer : Under Section 2 (1) (x) of the Trade Marks Act, 1999, "registered user" means a person who is for the time being registered as such under Section 49 of the Act.

i) State the works in which copyright subsists.

Answer : Copyright subsists only in certain classes of works : a) Original Literary, Dramatic, Musical and Artistic Works. b) Cinematographic films. C) Sound Recordings. [Copyright Act – Section 13 (1)].

j) Explain the term "Indication".

Answer : "Indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies" – Section (2) (1) (g) of the Geographical Indications of Goods Act, 1999.

Q. 2: Write short notes on Any Four of the following : _____ = 20.

- a) Berne Convention.
- b) Reasonable requirement of the public.
- c) Well Known Trade Mark.
- d) Infringing Copy.
- e) Compulsory Licencing in Patents.
- f) Prohibition of Registration of certain names of chemical elements or international non-proprietary names.

Q. 3: Solve Any two of the following situational problems: _____ = 12.

- a) Three photographers take photographs of the Taj Mahal from different corners.

i) Can the three photographers claim copyright for their respective photographs?

Answer : Yes, the three photographers can claim copyright for their respective photographs.

ii) Explain the legal provision applicable.

Answer : It is the individual labour and skill employed by these three different photographers in taking separate photos of the three different corners of the Taj Mahal. Each of them can be considered to be separately the 'author' of their work. Within the meaning of Section 2 (d) of the Copyright Act, 1957, the person taking the photograph, in relation to a photograph is considered an 'author'.

Under Section 17 of the Act, author is the first owner of the copyright of the work.

b) "Y" applied for registration of the word "Ustickon" in respect of rubber soles for shoes. The Registrar of Trade Marks refused to register the word as Trade Mark.

i) Is the Registrar of Trade Marks justified in rejecting the registration ?

i) Answer : Yes, the Registrar can be justified in rejecting the registration. The Registrar refusing to grant/register trademark is correct. Under Section 9 (d) of the Act, there is the 'absolute' ground for refusal, that is, if the trademark is of such nature as to deceive the public or cause confusion, then the trademark shall not be registered.

ii) Explain the legal provision applicable.

Answer : Yes, under Section 11 of the Act, if the trademark is 'relative' in nature (i.e. 'relative' grounds for refusal. It means - (a) if there is likelihood of confusion caused to the public including the likelihood of association with an earlier trademark by virtue of its identity with the earlier trademark (eg. 'ESCON', 'AFSCON', etc.) though the product of the later (i.e. 'Usticon') is different from the earlier well-known trade mark, (b) if the earlier trademark is well-known trademark in India and the later mark would take unfair advantage of the earlier mark or would be detrimental to the distinctive character or repute of the earlier trademark.

c) Mr. B declares that he has invented a ball which instead of falling to the ground rises up in the air, defying the principle of gravity.

i) Can Mr. B seek a patent for the invention ?

Answer : No, B cannot seek a patent for his invention.

ii) Explain the legal provision applicable.

Answer : Under Section 2 (1) (j) of the Patents Act, 1970, a patent may be granted to an invention of product or process which is "new" and "useful". "Novelty" is the test of "invention" under this Section. The ball filled with a gas will certainly not fall on the ground. There is neither novelty nor invention. Under Section 3 (a) of the

Act, an invention which is frivolous or which claims anything obviously contrary to well established natural laws are not inventions. The natural law is the law of gravity ! Who can defy it by invention without using the substance like a gas, etc ?

Q. 4 : Answer Any Four of the following : = 48.

- (i) Discuss the absolute grounds for refusal of registration of Trade Marks.
- (ii) Explain suit for infringement of Trade Mark. What defences are available for the defendant ?
- (iii) Discuss – “All inventions are not patentable”.
- (iv) Explain the need for protection of Intellectual Property Rights.
- (v) What is Passing Off ? Distinguish between an action of infringement and passing off.
- (vi) Comment on ownership of Copyright.

[28]

[May, 2017]

(Revised Course)

With Solutions

Please check whether you have got the right question paper.

N.B.

- 1) All questions are Compulsory.
- 2) Cite relevant Case-laws wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in Two to Three sentences each : = 20.

a) What is a ‘Collective mark’ ?

Answer : [Nov. 16; Nov. 15; Dec. 13; Nov. 10; Nov. 08; Nov. 07]

b) What is a patent of addition ?

Answer : [Nov. 15; May, 15; May, 14; May, 13; Dec. 12; Nov. 11]

c) Who is a person interested ?

Answer : Apr. 17; May, 12]

d) What is the term of copy right of a Literary Work ?

Answer : [Nov. 08]

e) Explain the term 'package'.

Answer : "package" includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule, cap, lid, stopper and cork. [Section 2 (q) – The Trade Marks Act, 1999] and [Section 2 (i) of "The Geographical Indications of Goods (Registration and Protection) Act, 1999"]

f) Explain the term 'engraving'.

Answer : "engravings" include etching, lithographs, wood-cuts, prints and other similar works, not being photographs. [Section 2 (i) – The Copyright Act, 1957]

g) What is reprography ?

Answer : "reprography" means the making of copies of a work, by photocopying or similar means. [Section 2 (x) – Copyright Act, 1957].

h) Who is the registered proprietor ?

Answer : [Nov. 16; May, 13; Dec. 12; May, 12]

i) Explain the term 'transmission' under the Trade Mark Act, 1999.

Answer : "transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer, not being assignment. [Section 2 (zc) – Trade Marks Act, 1999].

j) What is the meaning of 'patented article' and 'patented process' ?

Answer : "patented article" and "patented process" means respectively an article or process in respect of which a patent is in force. [Section 2 (o) – Patents Act, 1970].

Q. 2 : Write short notes [Any Four] :

= 20.

- a) Certification Trade Mark.
- b) Rights and obligations of a Patentee.
- c) Ghost Marks.
- d) Copyright Societies.
- e) Complete Specification.
- f) Anticipation.

Q. 3 : Solve Any Two situational Problems with reasons :

= 12.

A) A dancer enchants the audience with dance movements. Mr. X makes a visual recording of the dance movements with the permission of the dancer and exhibits the same to his friends on payment of charges.

i) State the technical terms which would define the dancer and the dance movements.

The technical term which would define 'dance' and the 'dance artists' is 'performer' which includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance – [Section 2 (qq)], and he is also an 'author' in relation to an artistic work other than a photograph, 'the artist' – Section 2 (d) (iii) of the Copyright Act, 1957.

ii) Has Mr. X committed any offence under the Copyright Act, 1957, if yes, state the penalty.

Answer : Yes, Mr. X has committed an offence of Infringement of Copyright. He shall be punished with imprisonment for a term which shall not be less than 6 months, but which may extend to 3 years, and with fine which shall not be less than Rs. 50,000/-, but which may extend to Rs. 2 Lakhs.

B) Mr. Ram wants to use the mark "Bata" as his trade mark for his soaps and applies for registration of the mark "Bata" to the Registrar of Trade Mark.

i) Will Mr. Ram succeed to get the mark registered ?

Answer : No, Mr. Ram cannot get the Mark registered as "Bata". Because it is devoid of distinctive character (i.e. Bata is already a famous registered trade mark), and therefore, it is an absolute ground for refusal for registration.

ii) State and explain the Doctrine involved.

Answer : Doctrine of Absolute Prohibition.

C) On a visit to the African Tropical Forests, Mr. Z discovered that the Negeri Tribe hunts with very effective spears. Mr. Z imitates the spear and applies for a patent.

i) Will Mr. Z succeed to get a patent ?

Answer : No, Mr. Z cannot get a patent for the spear.

ii) State and explain the provision of law involved.

Answer : Under Section 2 (1) (j) of the Patents Act, 1970, a patent may be granted to an invention of product or process which is "new" and "useful". "Novelty" is the test of "invention" under this Section. The imitation of the spear is neither novelty nor invention. According to Section 3 (b) of the Act, it is not an invention.

Q. 4 : Answer Any Four of the following :

= 48.

- a) Discuss the classification of intellectual property.
- b) Discuss Revocation of Patents.
- c) "All inventions are not eligible for grant of patents". Explain.
- d) Discuss the grounds of Refusal of Registration under the Trade Marks Act, 1999.
- e) Explain the law of passing off.
- f) Copyright is a bundle of rights – Elaborate.

[29]

[November, 2017 (30/11/17)]

(Revised Course)

With Solutions

Please check whether you have got the right question paper.

N.B.

- 1) All questions are Compulsory.
- 2) Cite relevant Case-laws wherever necessary.
- 3) Figures to the right indicate full marks.

Q. 1: Answer in Two to Three sentences each: = 20.

a) What is a 'trade mark' ?

Answer : [May, 2014]

b) Who is a 'patentee' ?

Answer : "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent. [Section 2 (p) of the Patents Act, 1970].

c) What is an 'inventive step' ?

Answer : [Nov. 16; Nov. 15; Nov. 14; May, 14; Dec. 13; May, 13; Nov. 11; April, 09]

d) What is the term of copyright of a Musical Work ?

Answer : [May, 15, May, 14; April, 07]

e) Who is a performer ?

Answer : [Nov. 16; May, 15; Dec. 13]

f) Explain Government work.

Answer : [Nov. 15; Dec. 13]

g) Explain the term 'package' under the Trade Mark Act, 1999.

Answer : [May, 2017]

h) State the works in which copyright subsists.

Answer : [Nov. 16; May, 16; May, 14; Dec. 13; Nov. 11; Nov. 10; April, 09; May, 2014]

i) Who is the author in relation to sound recording ?

Answer : In case of sound recording the author is the producer.

j) What is an associated trade mark ?

Answer : [Nov. 2009]

Q. 2 : Write short notes [Any Four] : = 20.

- a) Classification of patents.
- b) The Berne Convention.
- c) Collective Marks.
- d) Copyright Board.
- e) Compulsory Licensing Patents.
- f) Functions of a Trade Mark.

Q. 3 : Solve Any Two situational problems with reasons : = 12.

A) Mr. Ravi wants to use the name Nitrogen as his trade mark for clothes and applies for registration of the mark to the Registrar of Trade Marks.

i) Will Mr. Ravi succeed to register the name "Nitrogen" as trade mark for his goods ?

Answer : No, Mr. Ravi will not succeed in getting his Mark registered as a Trade Mark.

ii) State and explain the provisions of law involved.

Answer : The trade mark is well known under Section 9. Absolute grounds for refusal of registration proviso (b) - which consists exclusively of marks or indications which may serve in trade or designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

B) Mr. Vishnu, the farmer discovers a new method of sowing seeds which ensures their quick germination and applies for a patent of the discovery.

i) Will Mr. Vishnu get a patent for the method ?

Answer : Yes, Mr. Vishnu will succeed to get registration.

ii) When can an invention get a patent ?

Answer : An invention of a "new" "useful" product or process involving an "inventive step" and capable of industrial application can get a patent. "Novelty" is the test of invention.

C) A dancer enchants the audience with her dance movements.

i) State the technical term which could define the dancer and her dance movement.

Answer : The technical term which would define 'dance' and the 'dance movements' is 'performer' which includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance - [Section 2 (qq)], and he is also an 'author' in

relation to an artistic work other than a photograph, 'the artist' – Section 2 (d) (iii) of the Copyright Act, 1957.

ii) Explain any two of the Dancer Rights.
Answer : Dancer is a "performer". Being a performer the dancer has a right 1) to make sound recording or visual recording of the performance; 2) to reproduce a sound recording or visual recording of the performance; 3) to broadcast the performance; 4) to communicate the performance to the public, otherwise than the broadcast.

Q. 4 : Answer Any Four of the following [Essay Type] : = 48.

- a) Explain the term property. Analyze intellectual property as a form of property.
- b) Discuss the inventions which are not patentable.
- c) What are the grounds for opposition to grant of a patent ?
- d) What is Passing Off ? Distinguish between Infringement and Passing Off.
- e) Critically analyze Section 52 of the Copyright Act, 1957.
- f) What are the various forms of Trade Marks ? What are the qualities of a good Trade Mark ?

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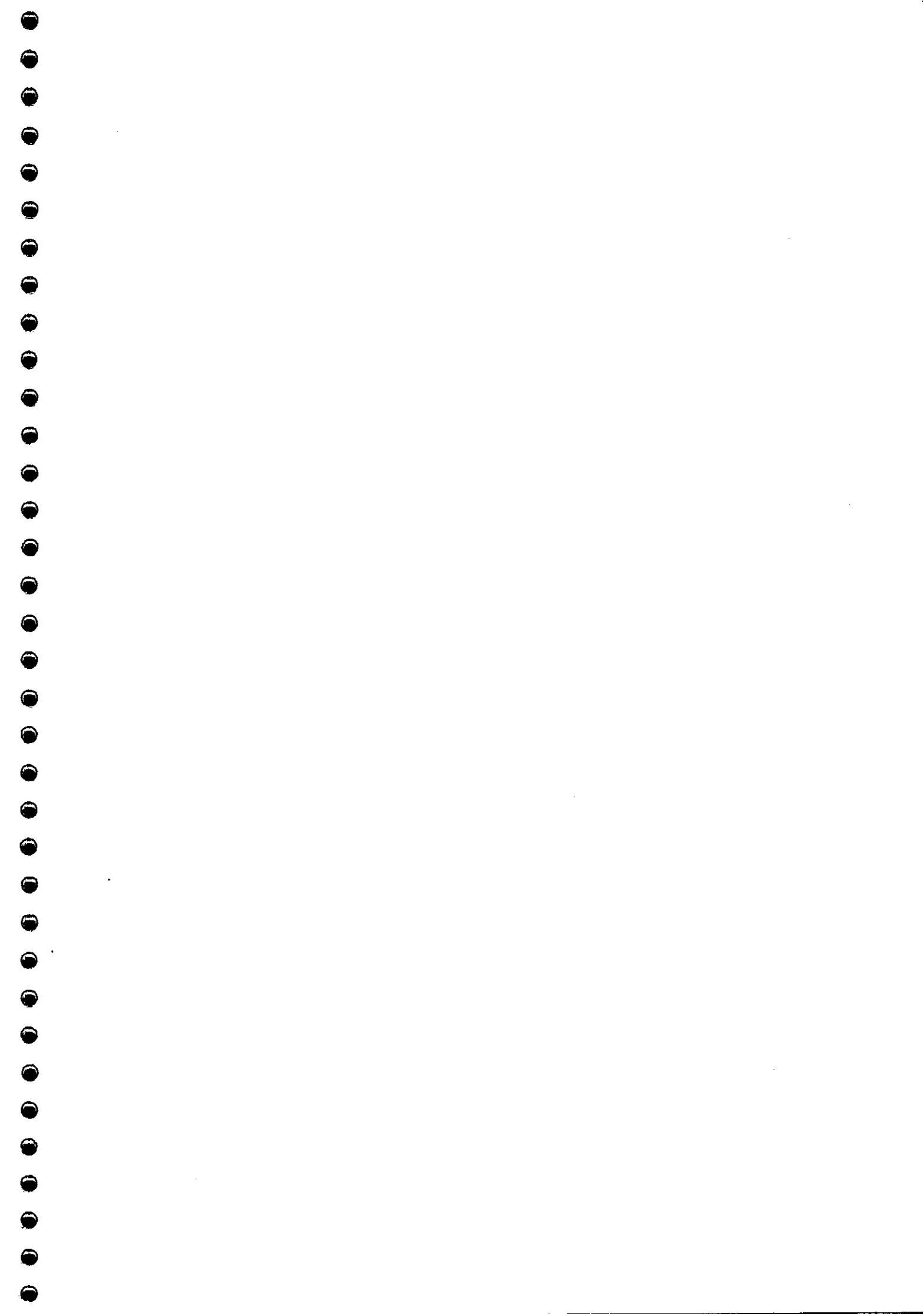
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