

Intellectual Property rights (IPR)

1. What are Intellectual Property Rights (IPR)?

IPR is a general term covering patents, copyright, trademark, industrial designs, geographical indications, protection of layout design of integrated circuits and protection of undisclosed information (trade secrets).

2. What are the legislations covering IPRs in India?

Patents: The Patents Act, 1970 and was amended in 1999, 2002 and 2005.

Design: The Design Act 2000

Trade Mark: The Trade Marks Act, 1999

Copyright: The Copyright Act, 1957 as amended in 1983, 1984 and 1992, 1994, 1999 and the Copyright Rules, 1958.

Layout Design of Integrated Circuits: The Semiconductor Integrated Circuit Layout Design Act 2000.

Protection of Undisclosed Information: No exclusive legislation exists but the matter would be generally covered under the Contract Act, 1872.

Geographical Indications: The Geographical Indication of Goods (Registration and Protection) Act 1999.

Plant Varieties: The Protection of New Plant Variety and Farmers Rights Act 2001

3 . Who are responsible for administration of IPRs in the country?

Patents, designs, trademarks and geographical indications are administered by the Controller General of Patents, Designs and Trademarks which is under the control of the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry. Copyright is under the charge of the Ministry of Human Resource Development. The Act on Layout Design of Integrated Circuits will be implemented by the Ministry of Communication and Information Technology.

Patents

4. What is a patent?

A patent is an exclusive right granted by a country to the owner of an invention to make, use, manufacture and market the invention, provided the invention satisfies certain conditions stipulated in the law. Exclusivity of right implies that no one else can make, use, manufacture or market the invention without the consent of the patent holder. This right is available only for a limited period of time. However, the use or exploitation of a patent may be affected by other laws of the country which has awarded the patent. These laws may relate to health, safety, food, security etc. Further, existing patents in an area similar to that covered by the invention may also come in the way.

A patent in the law is a property right and hence, can be gifted, inherited, assigned, sold or licensed. As the right is conferred by the State, it can be revoked by the State under very special circumstances even if the patent has been sold or licensed or manufactured or marketed in the meantime. The patent right is territorial in nature meaning thereby, that a patent granted in India can be enforced in India only. Inventors/their assignees will have to file separate patent applications in countries of their interest, along with necessary fees, for obtaining patents in those countries.

5. What is expected from patentee as an obligation to the state?

A patentee must disclose the invention in a patent document for anyone to practice it after the expiry of the patent or practice it with the consent of the patent holder during the life of the patent.

6. What are the conditions to be satisfied by an invention to be patentable?

An invention must satisfy the following three conditions of:

- (i) Novelty
- (ii) Inventiveness (Non-obviousness)
- (iii) Usefulness

Novelty: An invention will be considered novel if it does not form a part of the global state of the art. Information appearing in magazines, technical journals, books, newspapers etc. constitutes the state of the art. Oral description of the invention in a seminar/conference can also spoil novelty. Novelty is assessed in a global context. An invention will cease to be novel if it has been disclosed in the public through any type of publications anywhere in the world before filing a patent application in respect of the invention. Prior use of the invention before the filing date can also destroy the novelty. Novelty is determined through extensive literature and patent searches. It should be realized that patent search is essential and critical for ascertaining novelty as most of the information reported in patent documents does not get published anywhere else.

Inventiveness (Non-obviousness): A patent application involves an inventive step if the proposed invention is not obvious to a person skilled in the art i.e., skilled in the subject matter of the patent application on the date of filing the application. The prior art should not point towards the invention implying that the practitioner of the subject matter could not have thought about the invention prior to filing of the patent application. Inventiveness cannot be decided on the material contained in unpublished patents. The complexity or the simplicity of an inventive step does not have any bearing on the grant of a patent. In other words a very simple invention can qualify for a patent. If there is an inventive step between the proposed patent and the prior art at that point of time, then an invention has taken place. A mere 'scintilla' of invention is sufficient to found a valid patent.

Usefulness: An invention must possess utility for the grant of patent. No valid patent can be granted for an invention devoid of utility.

7. How is invention defined in the Indian Patent Act which can qualify for grant of a patent?

Invention means a **new** product or process involving an **inventive step** and **capable of Industrial application**.

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

Capable of Industrial application means that the invention is capable of being made or used in an industry

8. What are the types of inventions which are not patentable in India?

An invention may satisfy the condition of novelty, inventiveness and usefulness but it may not qualify for a patent under the following situations:

- (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 scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- (iv) the mere discovery of a new form of a known substance which does not result in 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 purpose 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 regards to efficacy.

- (v) 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;
- (vii) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (ix) a method of agriculture or horticulture;
- (x) any process for 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;
- (xi) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- (xii) a mathematical or business method or a computer program per se or algorithms;
- (xiii) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- (xiv) a mere scheme or rule or method of performing mental act or method of playing game;
- (xv) a presentation of information
- (xvi) topography of integrated circuits
- (xvii) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components
- (xviii) inventions relating to atomic energy

9. When should an application for a patent be filed?

Filing of an application for a patent should be completed at the earliest possible date and should not be delayed. An application filed with provisional specification, disclosing the essence of the nature of the invention helps to register the priority by the applicant. Delay in filing an application may entail some risks like (i) other inventors might forestall the first inventor by applying for a patent for the said invention (ii) there may be either an inadvertent publication of the invention by the inventor himself/herself or by others independently of him/her.

10. Can a published or disclosed invention be patented?

No, publication of an invention in any form by the inventor before filing of a patent application would disqualify the invention to be patentable. Under special circumstances a grace period of 12 months is available in India. A patent application must be filed before the grace period ends. A practical advice is that, inventors should not disclose their inventions before filing the patent application. The invention should be considered for publication after a patent application has been filed. Thus, it can be seen that there is no contradiction between publishing an inventive work and filing of patent application in respect of the invention.

11. What is considered as the date of patent?

The date of patent is the date of filing the application for patent (whether provisional or complete). The term of the patent is counted from this date.

12. What is the term of a patent in the Indian system?

Term of the patent is 20 years from the date of filing for all types of inventions

13. How does one keep a patent in force for the full patent term?

A patent has to be maintained by paying the maintenance fees every year. If the maintenance fees is not paid, the patent will cease to remain in force and the invention becomes open to public. Anyone can then utilize the patent without the danger of infringing the patent.

14. What are the essential documents to be generated and submitted by a potential patentee?

There are two types of patent documents usually known as patent specification, namely

(i) Provisional Specification and (ii) Complete Specification

Provisional Specification

A provisional specification is usually filed to establish priority of the invention in case the disclosed invention is only at a conceptual stage and a delay is expected in submitting full and specific description of the invention. Although, a patent application accompanied with provisional specification does not confer any legal patent rights to the applicants, it is, however, a very important document to establish the earliest ownership of an invention. The provisional specification is a permanent and independent scientific cum legal document and no amendment is allowed in this. No patent is granted on the basis of a provisional specification. It has to be followed by a complete specification for obtaining a patent for the said invention. Complete specification must be submitted within 12 months of filing the provisional specification. This period can be extended by 3 months. It is not necessary to file an application with provisional specification before the complete specification. An application with complete specification can be filed right at the first instance.

Complete Specification

Submission of complete specification is necessary to obtain a patent. The contents of a complete specification would include the following

1. Title of the invention.
2. Field to which the invention belongs.

3. Background of the invention including prior art giving drawbacks of the known inventions & practices.
4. Complete description of the invention along with experimental results.
5. Drawings etc. essential for understanding the invention.
6. Claims, which are statements, related to the invention on which legal proprietorship is being sought. Therefore the claims have to be drafted very carefully.
7. Abstract of the invention
8. If a biological material is mentioned in specification; source and geographical origin of the same is to be disclosed. For new biological material deposition number of the same along with complete address of the International Depositary Authority (IDA) to be included in the specification. [In India Institute of Microbial Technology (IMTech), Chandigarh is recognized as IDA]

15. What are the criteria for naming inventors in an application for patent?

The naming of inventors is normally decided on the basis of the following criteria:

- i. All persons who contribute towards development of patentable features of an invention should be named inventor(s).
- ii. All persons, who have made intellectual contribution in achieving the final results of the research work leading to a patent, should be named inventor(s).
- iii. A person who has not contributed intellectually in the development of an invention is not entitled to be included as an inventor.
- iv. A person who provides ideas needed to produce the 'germs of the invention' need not himself / herself carry out the experiments, constructs the apparatus with his/her own hands or make the drawings himself/herself. The person may take the help or others. Such person who have helped in conducting the experiments, constructing apparatus or making the drawings or models without providing any intellectual inputs are not entitled to be named inventors.

Quite often difficulties are experienced in deciding the names of inventors. To avoid such a situation, it is very essential that all scientists engaged in research should keep factual, clear and accurate recorded of daily work done by them in the form of diary. The pages in the diary should be consecutively numbered and the entries made be signed both by the scientists and the concerned leader.

16 What is the nature of information needed while consulting a patent attorney?

As an inventor one should share the complete invention with a patent attorney in the same manner as a patient confides in a doctor. As a doctor may not be able to write a correct prescription without knowing the details of the disease/problem, a patent attorney may not be able to draft a good specification in the absence of details about the invention. Following points should be kept in mind while discussing with the attorney:

- i. Provide complete details of the invention including failures, if any, on the way to the invention.

- ii. Do not feel bad if attorney asks you questions like where did you get the idea from or did you copy the idea from somewhere or are you keeping other inventors working with you on the inventorship or have you published the invention or disclosed it in a seminar/conference or have you displayed the invention in an exhibition? A patent document is a techno-legal document, hence all precautions are to be taken right from the first step. Provides right answers and you may even show your laboratory note book/log book to the attorney. This will help the attorney / agent to explain the inventive step in a precise manner and draft a good specification and associated claims.
- iii. Explain the central theme of the invention and novelty, inventiveness and utility of the invention.
- iv. Share all the prior art documents in your possession with the attorney.
- v. If you have developed an improved version of your competitor's product/process, admit it and be totally honest. This would help the attorney in drafting precise claims and avoid excessive claims, which might be struck down immediately or at a later date.
- vi. A detailed description of the best way of putting the invention into practical use, results of your tests and trials, etc., including all failures and defects should be given to the attorney.
- vii. Alternative ways of using the invention, and the substitutes or parts of it i.e., will one chemical compound do as well as any other in the process?
- viii. It may be worth drafting the patent widely enough to cover less satisfactory alternatives as well so as to prevent rivals from marketing a less satisfactory competing product which because of its defects might bring the whole genre of product into disrepute or which may be cheap.
- ix. Both after an initial search and during the course of the filing and grant of a patent application, it is important to respond quickly and accurately to queries which the patent attorney may have. Thus the client should keep the patent attorney informed of any new developments in the field of invention carried by the patentee or some one else.

17. What is opposition under the Indian Patents Act 1970?

The Act now provides for pre grant and post grant opposition. **Pre-grant opposition** can be filed after the publication of patent application and before the grant of patent. **Post-grant opposition** can be filed within one year of the grant of the patent. An opposition board will be constituted for each of the opposition notification accepted by the Controller for the post grant opposition proceedings. . Opposition in both cases will be allowed with all the grounds specified in the Act.

18. What are the grounds for opposition?

Pre-grant and post-grant opposition can be filed on following grounds

- i. Claimed invention or its part wrongfully obtained
- ii. Claimed invention is published in patent or any other document before the priority date
- iii. Claimed invention is published in patent after the priority date having earlier priority date
- iv. Claimed invention was publicly known or publicly used before the priority date

- v. Claimed invention is obvious and clearly does not involve any inventive step, having regards to the matter published or used (in India) before the priority date
 - vi. Claimed invention is not the invention within the meanings of the Patent Act or is not patentable under the Patent Act
 - vii. The complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed
 - viii. The applicant has failed to disclosed to the Controller the information regarding foreign applications filed for the same invention by him or has furnished the information which in any material particular was false to his knowledge
 - ix. In case of convention application if the application is not filed before the expiry of 12 months from the date first application for the protection for the invention made in convention country
 - x. The complete specification does not disclose or wrongly mentioned the source and geographical origin of biological material used in the invention
 - xi. Claimed invention was anticipated having regards to the knowledge, oral or otherwise available within any local or indigenous community in India or elsewhere
- but on no other ground

19. What is the cost of filing a patent application in India?

The fee structure have been thoroughly revised; important fees are given below:

No.			Individual	Legal entity
1.	Filing of patent application along with complete/provisional specification	For maximum number of pages 30 and maximum number of claims 10	Rs.1000/-	Rs.4000/-
		For each additional sheet	Rs.100/-	Rs.400/-
		For each additional claim	Rs.200/-	Rs.800/-
2.	Request for examination of patent		Rs.2,500/-	Rs.10,000/-
3.	Sealing Fee	(Removed)	Nil	Nil
4.	Renewal fee (every year)	2 nd year to 6 th year	Rs.500/-	Rs.2,000/-
		7 th year to 10 th year	Rs.1500/-	Rs.6000/-
		11 th year to 15 th year	Rs.3000/-	Rs12,000/-
		16 th year to 20 th year	Rs5000/-	Rs.20000/-

20. What is the distinction between a patented invention and know how?

The law does not require that the information disclosed in the patent specification be sufficient for commercial exploitation of the invention. Thus, a patent usually will not disclose sufficient information for commercialization. Know how on the other hand, covers all information necessary to commercialize the invention e.g. setting up a production plant. Such information would include, for example, details of the production methods, the design drawings etc. It is this know how which is traded while transferring technology. Know how is always kept as a trade secret and not shared with public. Know how is not protected through patents as most of it is non-patentable matter and one does not take patent on the remaining parts to avoid public disclosure. A know how developed around an existing patent and commercialized subsequently may be an infringement of the patent unless the patentee has agreed to commercialization on mutually agreed terms.

21. Is a patent granted in one country enforceable in other countries?

No. There is nothing like a global patent or a world patent. Patent rights are essentially territorial in nature and are protected only in a country (or countries) which, has (have) granted these rights. In other words,-for obtaining patent rights in different countries one has to submit patent applications in all the countries of interest for grant of patents. This would entail payment of official fees and associated expenses, like the attorney fees, essential for obtaining patent rights in each country. However, there are some regional systems where by filing one application one could simultaneously obtain patents in the member countries of a regional system; European Patent Office is an example of a similar system.

22. Does grant of a patent in one country affect its grant or refusal in another country?

Each country is free to grant or refuse a patent on the bases of scrutiny by its patent office. This means that granting a patent in one country of the Union does not force other countries to grant the patent for the same invention. Also, the refusal of the patent in one country does not mean that it will be terminated in all the countries.

23. What is 'mail box' provision?

TRIPS requires that countries, not providing product patents in respect of pharmaceuticals and chemical inventions have to put in a mechanism for accepting product patent applications w.e.f. 1 January 1995. Such applications will now be examined for grant of patents, after the amendments in the national patent law made by the Patent Amendment Act 2005. This mechanism of accepting product patent applications is called the "mail box" mechanism.

24. What was an EMR?

TRIPS requires that member countries of the WTO not having provision in their laws for granting product patents in respect of drugs and agrochemical, must introduce Exclusive Marketing Rights (EMR) for such products, if the following criteria are satisfied:

1. A patent application covering the new drug or agrochemical should have been filed in any of the WTO member countries after 1 January, 1995;
2. A patent on the product should have been obtained in any of the member countries (which provides for product patents in drugs and agrochemical) after 1 January 1995;
3. Marketing approvals for the product should have been obtained in any of the member countries;
4. A patent application covering the product should have been filed after 1 January 1995 in the country where the EMR is sought;
5. The applicant should apply seeking an EMR by making use of the prescribed form and paying requisite fee.

EMR was only a right for exclusive marketing of the product and is quite different from a patent right. It was valid up to a maximum period of 5 years or until the time the product patent laws come into effect from January 1, 2005.

25. Does India have provision for grant of EMR?

Yes. The necessary amendment to: the Patents Act, 1970 came into force on 26 March 1999. The provision was applicable with retrospective effect from 1 January 1995. Now this provision has been removed from the Act through patent amendment Act 2005.

26. What is industrial property?

Industrial property includes:

(a) Patents (b) Utility models (c) Industrial designs (d) Trademarks, service marks and trade names (e) Indication of source or appellations of origin (this is same as the geographical indications adopted in TRIPS);

27. What is the Paris Convention?

The Paris Convention is an international convention for promoting trade among the member countries, devised to facilitate protection of industrial property simultaneously in the member countries without any loss in the priority date. All the member countries provide national treatment to all the applications from the other member countries for protection of industrial property rights. The Convention was first signed in 1883. Since then, the Convention has been revised several times, in 1900 at Brussels, in 1911 at Washington, in 1925 at the Hague, in 1934 at London, in 1958 at Lisbon and in 1967 at Stockholm. The last amendment took place in 1979. India became a member of the Paris Convention on December 7, 1998. *(Readers may note the use of the phrase 'Industrial Property' and not Intellectual Property).*

28. What are the principal features of the Paris Convention?

The principal features of the Paris Convention have been listed below

- National treatment
- Right of priority
- Independence of patents
- Parallel importation
- Protection against false indications and unfair competition

29. What is the meaning of national treatment under the Paris Convention?

This is a very important concept and is essential for successfully achieving the fundamental aim of the Paris Convention. The idea is to provide equal treatment to applications from member countries, in a given member country and not to differentiate between the nationals of your country and nationals of the other countries for the purpose of grant, and protection of industrial property in your country. Imagine that a national of country X applies for grant of a patent in India. According to the Paris Convention, the Indian Patent Office shall apply the same norms and rules, to the applicant from X, as applicable to an Indian applicant, for granting a patent. Similarly the applicant from X shall have the same protection after grant and identical legal remedies against any infringement shall be available to the applicant provided the conditions and formalities imposed upon Indians are complied with. No requirement as to domicile or establishment in the country where protection is claimed, may, be imposed.

30. What do you understand by the right of priority and what is its significance?

The date from which patent right is deemed to start is usually the date of filing of complete specification. To obtain rights in other member countries, the application must be filed on the

same day in other member countries if it is desired to have the rights started from the same day. However, there are practical difficulties in synchronizing the activities. For facilitating simultaneous protection in member countries, the Convention provides that within 12 months of national filing, if patent applications are filed in those member countries, the patents, if granted in member countries, will be effective from the date of national filing. This right is known as the right of priority. In other words you maintain the priority or the same date of filing in all the member countries and no one else in those countries can obtain the patent rights on a similar/identical invention from the same or a later date.

In case the applicant after a second look at the patent application finds that the patent contains more than one invention or on his own accord wishes to divide the application, he can claim the initial date of priority for subsequent patent applications. The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

31. What is implied by importation in relation to working of a patent under the Convention?

Importation is considered as working of patent, provided the patented product is manufactured in a member country and is imported into another member country which has also granted a patent on the same invention to the same applicant. Imagine that a product X has been patented in two member countries A and B. The product X is then manufactured in country A and imported into the country B. This product X shall enjoy the same patent protection in the country B even though it has been manufactured in the country A. This would also be considered as if the patent has been worked in country B.

32. Is there a provision for compulsory license in the Paris Convention?

Yes, each member country shall have the right to provide for the grant of compulsory licenses to prevent the abuses resulting from the exclusive rights conferred by the patent. Compulsory licenses for failure to work or insufficient working of the invention may not be requested before the period of time of non-working or insufficient working has elapsed. This time limit is four years from the date of filing of the patent application or three years from the date of the grant. Such licenses will be a non-exclusive and non-transferable one.

33. Is there any relationship between the Paris Convention and the TRIPS Agreement?

It has been made mandatory for the member countries of the TRIPS Agreement to comply with the Article 1 to 12 and Article 19 of the Paris Convention.

34 What are the other advantages of joining the Paris Convention?

There are a number of international conventions and treaties, which are open only to the members of the Paris Convention. Some of these are:

- Patent Cooperation Treaty (PCT)
- Budapest Treaty (for deposition of microorganisms)UPOV (for protection of new varieties of plants)

- Madrid Agreement (for repression of false or deceptive indications of source on goods)
- Madrid Protocol (concerning registration of marks)
- Hague Agreement (concerning deposits of industrial designs)

35. What is the Budapest Treaty?

This is an international convention governing the registration of deposits of microorganisms, cell lines etc in officially approved culture collections for the purpose of patent applications in any country that is a party to it. Because of the difficulties and on occasion of virtual impossibility of reproducing a microorganism from a description of it in a patent specification, it is essential to deposit a strain in a culture collection centre for testing and examination by others. The Treaty was signed in Budapest in 1973 and later on amended in 1980. India has become a member of this Treaty, with effect from December 17, 2001.

36. Are there any differences in the filing of patent applications in respect of microbiological inventions and other inventions?

An inventor is required to deposit the strain of a microorganism in a recognized depository which assigns a registration number to the deposited microorganism. This number needs to be quoted in the patent application. Obviously a strain of microorganism is required to be deposited before filing a patent application. It may be observed that this mechanism obviates the need of describing a microorganism in the patent application. Further, samples of strains can be obtained from the depository for further working on the patent. There are many international depositories in many countries, which are recognized under the Budapest Treaty.

37. What is the system for protecting microbiological inventions and microorganisms?

The Indian Patent Act has excluded microorganisms from the list of items not patentable. Exclusion of only process patent for product prepared by biochemical, biotechnological and microbiological processes have been removed and now both product and process patent will be allowed. As per another provision of the Act discovery of any living or non-living substance naturally occurring in nature will not be patentable. It means that in the case of microorganisms isolated from nature no patent will be given for the microorganisms per se. Whereas process and product patents will be awarded in case of genetically modified microorganisms. Many countries allow patenting of genetically modified microorganisms but a few also allow patenting of naturally occurring microorganisms if isolated from nature for the first time and if other conditions of patentability are satisfied.

38. What is Patent Cooperation Treaty (PCT)?

The Patent Cooperation Treaty (PCT) is a multilateral treaty entered into force in 1978. Through PCT, an inventor of a member country (Contracting State) of PCT can simultaneously obtain priority for his/her Invention in all/ any of the member countries, without having to file a separate application in the countries of interest, by designating them in the PCT application. India joined the PCT on December 7, 1998.

39. Who coordinates the activities of PCT?

All activities related to PCT are coordinated by the World Intellectual Property Organization (WIPO) situated in Geneva.

40. What is the need for PCT?

In order to protect your invention in other countries, you are required to file an independent patent application in each country of interest; in some cases, within a stipulated time to obtain priority in these countries. This would entail a large investment, within a short time, to meet costs towards filing fees, translation, attorney charges etc. In addition you are making an assumption which, due to the short time available for making the decision on whether to file a patent application in a country or not, may not be well founded.

Inventors of Contracting States of PCT on the other hand can simultaneously obtain priority for their inventions without having to file separate application in the countries of interest; thus saving the initial investments towards filing fees, translation etc. In addition the system provides much longer time for filing patent application in member countries. The time available under Paris Convention for securing priority in other countries is 12 months from the date of initial filing. Under the PCT, the time available could be as much as minimum 20 and maximum 31 months. Further, an inventor is also benefited by the search report prepared under the PCT system to be sure that the claimed invention is novel. The inventor could also opt for preliminary examination before filing in other countries to be doubly sure about the patentability of the invention.

41. How are patent applications under PCT handled?

The patent office or may other office designated by each contracting state becomes a receiving office for receiving patent applications. These applications are referred to International Searching Authorities (ISA) which usually the patent offices, appointed to carry out the patent search on a global basis. In case the receiving office is also an ISA, a separate referral is not required. There is also a provision to get a patent application examined by international preliminary Examining Authorities, which in most cases are ISAs.

42. What is the meaning of delayed processing of an application filed under the PCT system?

A search report on the patent application filed with a receiving office is received by the applicant/inventor 16 months after the priority date which is nothing but the date of submitting the application in the receiving office. The International Bureau of the WIPO publishes the application and the search report 18 months after the priority date. The original application is then sent to the designated offices indicated in the application. Within two months of this i.e. by the 20th month, the applicant will have to formally apply to the patent offices of these countries for grant of patents by paying official fees and completing other formalities stipulated by these offices (some countries). In case translated copies of the application are required, the same has to be furnished by the applicant. In spite of submitting the request for grant of patents in designated countries in the 20th month after the priority date, the priority in these countries is the same as the date of filing the original PCT application.

If applicant/inventor has requested for an examination report, the report is usually received by the applicant /inventor about 28 months after the priority date. Within two months of this, the applicant/inventor will have to formally apply for grant of patents in designated countries. The priority of the application is maintained in the designated countries.

43. What is the benefit of the delayed processing?

(a) By the end of the 20th to 31st month the applicant is in a better position to assess the quality of the invention being protected as a detailed search report or an examination report or both would be available to help making an assessment.

(b) Applicants can re-evaluate their decision about filing applications in all the member countries after a long gap of 20 to 31 months.

(c) If not satisfied, applicants may decide to select or drop a few countries from the list. This decision would also be influenced by the changing market conditions.

(d) Applicants can delay their investment in respect of the national phase or the regional phase applications by 20 to 31 months without sacrificing priority.

44. Which is the appropriate office in India in relation to PCT applications?

A PCT application can be filed in any of the Branch Offices of the Patent Office located at New Delhi, Chennai, Mumbai and Kolkata (Head Office). Any of these Offices shall function as receiving office, designated office and elected office for the purpose of international applications filed under the Treaty.

An international application shall be filed in the Patent Office which would process the application in accordance with these rules and the provision under the PCT.

45. What is the cost of filing a PCT application?

The cost of filing a PCT application by an Indian Applicant is as follows:

1.	Transmittal Fees	Rs.8,000/- for legal entity and Rs.2000/- for individuals
2.	International Filing Fee	US\$1,134
3.	Fee per sheet over 30 sheets	US\$12
4.	Search Fee	US\$ 182 to US\$ 1000 depending on the International Searching Authority (ISA) selected by the applicant

5. All fees payable are reduced by 75% for the applications filed by any individual as an applicant who resides in a PCT contracting state where the per capita national income is below US\$3000.

46 Where do you pay the fees and in which currency?

All types of fees are payable at the receiving office and it is the responsibility of the receiving office to remit the search fees to the concerned office if the receiving office is not the search authority. Similarly, all other charges due to other agencies, would be remitted by the receiving office. The fees are payable in the currency acceptable to the receiving office as an Indian you can pay all the fees in Indian rupees.

47. Is there any system for protecting a new plant variety?

New plant varieties cannot be protected in India at present. However, in many countries such plants can be protected through Breeders Rights, patent and UPOV Convention India was under an obligation to introduce a system for protecting new plant variety. The protection can be through patent or a sui generis system or a combination of these two systems. India opted for sui generis system and enacted The New Plant Variety Protection and Farmers Rights Act. This Act is yet to be enforced.

48 What is UPOV?

UPOV is an abbreviation of Union pour la Protection des Obtentions Vegetales (Union for protection for new varieties of plant). It is an international convention which provides a common basis for the examination of plant varieties in different member States of UPOV for determining whether a plant variety merits protection under UPOV or not.

49 What is the criteria for deciding protection of a plant varieties?

There are 5 main criteria to arrive at a decision whether a plant variety is really new or not. These have remained unchanged between 1978 and 1991 Acts of the Convention. These criteria are:

1. **Distinctness:** The variety shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of filing of the application. The object of this criterion is to ensure that the candidate variety can be identified amongst all other varieties whose existence is known, whether or not they are protected. An application for protection or for the entry of a variety in an official register in any country causes the variety to be recorded as a matter of common knowledge. In other words, the application for the protection should be filed with UPOV before disclosing it to any other agency.

2. **Uniformity:** The variety shall be deemed to be uniform if, subject to the variation that may be accepted from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics. The objective of this criterion is to ensure that the individuals representing the variety which is a candidate of protection, form a group which is identifiable on the basis of the description of its characteristics. In other words, the variation between individuals within a variety must be less than that within a species. In the absence of this condition it would become impossible to identify distinct varieties within species.

The degree of uniformity is determined taking into account the mode of reproduction of the species and all the genetic structure of varieties. The same levels of uniformity cannot be required for a strictly self pollinating species or for a species which is vegetatively propagated. An acceptable level of uniformity would ensure that it can be used for agricultural production. In this regard the difference between the protection, given by UPOV and patent system can be noted.

3. **Stability:** The variety shall be deemed to be stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation at the end of each such cycle. The idea is to ensure that the variety will be identical to the description established at the moment of granting protection after repeated propagation.

Stability, as well as uniformity may be lost if the rights holder fails to maintain the variety true to the description established when the rights were granted.

4. **Novelty:** The variety shall be deemed to be new if, at the date of filing of the application for breeder's right, propagating or harvesting material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder for the purpose of exploitation of the variety. It is also understood that a variety to which people have had free access in the past cannot be protected because then the interest of those who have relied on the free access, will suffer.

As it is some time necessary to see the response of the market to new varieties before deciding whether or not to apply for protection, grace period has been included. The period is one year prior to the date of application in the country where the application is filed and in countries other than that in which the application has been filed and six years in case of trees and vines and four years for all other species.

5. **Appropriate denomination:** The variety shall be designated by a denomination, which will be its generic designation. The premise is that the variety denomination must be its generic designation class for a requirement that 'denomination must enable the variety to be identified'. Users and consumers need to have some method of knowing that a sample is a sample of a particular identified plant variety; because it is often not possible to identify it from its appearance. This is facilitated by requiring that a specific denomination and only that denomination be used to identify a variety in trade.

50. Does India have any law for protecting new plant varieties?

Yes, India has enacted the New Plant Variety and Farmers Rights Protection Act in 2001 which, in addition to meeting the technical features of UPOV, provides rights to farmers to

use the seeds from their own crops for planting the next crop. Further, there are provisions for benefit sharing with farmers and penalty for marketing spurious propagation material.

Copyrights

51. What does copyright cover?

- (i) Literary, dramatic and musical work. Computer programs/software are covered within the definition of literary work.
- (ii) Artistic work.
- (iii) Cinematographic films which include sound track and video films.
- (iv) Record-any disc, tape, perforated roll or other device.

52 What are the rights of a copyright holder (which when violated lead to infringement)?

(a) In the case of **literary, dramatic or musical work**, not being a computer program----

- (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 work to the public not being copies already in circulation;
- (iii) to perform the work in public, or communicate it to the public;
- (iv) to make any cinematography film or sound recording in respect of the work;
- (iv) to make any translation of the work; to make any adaptation of the work;
- (v) to do, in relation to a translation or an adaptation of the Work, any of the acts specified in relation to the work in Sub-clauses (i) to (vi);

(b) in the case of **computer program** -

- (i) to do any acts specified in clauses (a);
- (ii) to sell or give on hire, or offer for sale or hire any copy of
- (iii) the computer program, regardless of whether such copy has been sold or given on hire on earlier occasions;

(c) in the case of an **artistic work** –

- i. to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three 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 cinematography film .
- v. to make any adaptation of the work;
- vi. to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);

(d) in the case of a **cinematography film** -

- i. to make a copy of the film including a photograph of. any image forming 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 occasions;
- iii. to communicate the film to the public;

(e) in the 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.

53. How is computer defined for the purpose of copyright?

Computer includes any electronic or similar device having information processing capabilities.

54. What is the definition of a computer program?

Computer program means a set of instructions expressed in words, codes, schemes or any other form, including a machine readable medium, capable of causing a computer to perform a particular task or achieve a particular result.

55. What is the term of a copyright?

- a. If published within the life time of the author of a literary work the term is for the life time of the author plus 60 years.
- b. For cinematography films, records, photographs, posthumous publications, anonymous' publication, works of government and international agencies the term is 60 years from the beginning of the calendar year following the year in which the work was published.
- c. For broadcasting the term is 25 years from the beginning of the calendar year following the year, in which the broadcast was made.

56 Is it necessary to deposit accompanying documents of the computer program for which copyright is being sought?

Documentation which normally accompanies the program is regarded as separate work and for this reason if the same has to be registered, it must be separately registered and not combined with the computer program in a single application.

57 If an employee in a company develops a program, would this employee own the copyright?

No. In the case of a program made in the course of author's employment under a contract of service or apprenticeship, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright.

58 If an independent third party develops a program for a company, who owns the copyright?

Works created by third parties on commission do not automatically vest the copyright in the commissioning party. If the third party is an independent contractor, it is essential for the commissioning party to obtain the copyright through a written deed of assignment. It is a common misconception that the copyright automatically belongs to the commissioning party. Thus, it is only where the developer is an employee creating the work under a contract of service that the rights belong to the employer.

59. What is the rule for the transfer of copyright?

The owner of the copyright in an existing work or prospective owner of the copyright in a future work may assign to any person the copyright, either wholly or partially in the following manner.

- i. for the entire world or for a specific country or territory; or
- ii. for the full term of copyright or part thereof ; or
- iii. relating to all the rights comprising the copyright or only part of such rights.

60. Is there a possibility of divulging secrets through deposit of source code?

Once the copyright is registered, the work is open to public inspection. For this reason, it is advisable, only to file a small extract of the computer program rather than the full program itself. It is important, however, to know that the part of the computer program which is not being filed would remain the trade secret of the owner and can be subject matter of a protection against any person who wrongfully obtains and utilizes the said program.

61. In order to further ensure that secrets are protected, is deposition of computer program in object code permissible?

Although the recent amendment (1994) in the Copyright Act enlarges the meaning of a computer program, it is still not very clear as to whether it includes both object code and source code. However, keeping in mind the proclaimed object of the amendment, presumably the benefit of the Copyright Act will be available to both. As per experts' opinion, it is easier to determine from source code whether the deposit represents copyrightable material. Deposit of object code may be possible, but registration presumably would be accepted pending on assurance that the code does represent copyrightable material. Procedures for these do not exist at present with the Copyright Office.

62. In some of the programs, the screens could be the most commercially significant aspect. Is it necessary to register the program screen separately from the underlying code?

Generally, all copyrightable expressions embodied in a computer program, including screen displays, are protectable. However, unlike a computer program, which is a literary work, screen displays are artistic work and cannot therefore be registered in the same application as that covering the computer program. A separate application giving graphic representation of all copyrightable elements of the screen display is necessary.

63. What notice needs to be put on computer program copies to seek copyright protection?

When a work is published by authority of the copyright owner, a notice of copyright may be placed on publicly distributed copies. As per the Berne Convention for protection of literary and artistic works, to which India is a signatory, use of copyright notice is optional. It is, however, a good idea to incorporate a copyright notice.

64. What are the major provisions in the amended Copyright Act, 1999 with regards to computer programs?

The major provisions are:

- (i) the doing of any act necessary to obtain information essential for operating interoperability of an independently created computer program with other programs by a lawful possessor of a computer program provided that such information is not otherwise readily available;
- (ii) the observation, study or test of functioning of the computer program in order to determine the ideas and principles which underline any elements of the program while performing such acts necessary for the functions for which the computer program was supplied;
- (iii) the making of copies or adaptation of the computer program from a personally legally obtained copy for non-commercial personal use.

Designs

65. What does the term 'Design' mean according to 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; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device.

66. What are the types of design not registrable under the Act?

A design which

- (a) is not new or original; or
- (b) has been disclosed to the public any where in India or in any other country by publication in tangible form or by use in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or
- (c) is not significantly distinguishable from known designs or combination of known designs; or
- (d) comprise or contains scandalous or obscene matter, shall not be registered.

67. What is meant by an article under the Designs Act, 2000?

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.

68. What is the object of registration of designs?

Object of the Designs Act is to protect new or original designs so created to be applied or applicable to particular article to be manufactured by industrial process or means.

Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. The important purpose of design registration is to see that the artisan, creator, originator of a design having aesthetic look is not deprived of his bonafide reward by others applying it to their goods.

69 What are the essential requirements for the registration of design under the Designs Act, 2000?

1. The design should be new or original, not previously published or used in any country before the date of application for registration. The novelty may reside in the application of a known shape or pattern to new subject matter. However, if the design for which application is made does not involve any real mental activity for conception, then registration may not be considered.
2. The design should relate to features of shape, configuration, pattern or ornamentation applied or applicable to an article. Thus, designs of industrial plans, layouts and installations are not registrable under the Act.
3. The design should be applied or applicable to any article by any industrial process. Normally, designs of artistic nature like painting, sculptures and the like which are not produced in bulk by any industrial process are excluded from registration under the Act.
4. The features of the designs in the finished article should appeal to and are judged solely by the eye. This implies that the design must appear and should be visible on the finished article, for which it is meant. Thus, any design in the inside arrangement of a box, money purse or almirah may not be considered for showing such articles in the open state, as those articles are generally put in the market in the closed state.
5. Any mode or principle of construction or operation or any thing, which is in Substance a mere mechanical device, would not be registrable design. For instance, a key having its novelty only in the shape of its corrugation or bend at the portion intended to engage with levers inside the lock associated with, cannot be registered as a design under the Act. However, when any design suggests any mode or principle of construction or mechanical or other action of a mechanism, a suitable disclaimer in respect there of is required to be inserted on its representation, provided there are other registrable features in the design.
6. The design should not include any trade mark or property mark or artistic works.

70 Can stamps, labels, tokens, cards, be considered an article for the purpose of registration of design?

No. Because once the alleged design i.e., ornamentation is removed only a piece of paper, metal or like material remains and the article referred ceases to exist. Article must have its existence independent of the designs applied to it. So, the design as applied to an article should be integral with the article itself.

71 When does the applicant for registration of design get the registration certificate?

When an application for registration of a design is in order, it is accepted and registered, then a certificate of registration is issued to the applicant. However, a separate request should be made to the Controller for obtaining a certified copy of the certificate for legal proceeding with requisite fee.

72 What is a Register of Designs?

The Register of Designs is a document maintained by the Patent Office, Kolkata as a statutory requirement. It contains the design number, date of filing and reciprocity date (if any), name and address of proprietor and such other matters as would affect the validity of proprietorship of the design and it is open for public inspection on payment of prescribed fee and extract from register may also be obtained on request with the prescribed fee.

73 What is the duration of the registration of a design? Can it be extended?

The total time of a registered design is 15 years. Initially the right is granted for a period of 10 years, which can be extended, by another 5 years by making an application and paying a fee of Rs. 2000/- to the Controller before the expiry of initial 10 years period. The proprietor of design may make application for such extension even as soon as the design is registered.

74 Is it mandatory to make the article by industrial process or means before making an application for registration of design?

No, design means a conception or suggestion or idea of a shape or pattern, which can be applied to an article or intended to be applied by industrial process or means.

75 Why is it important for filing the application for registration of design at the earliest possible?

First to file rule is applicable for registrability of design. If two or more applications relating to an identical or a similar design are filed on different dates, the first application will be considered for registration of design.

76 Can the same applicant make an application for the same design again, if the prior application has been abandoned?

Yes, the same applicant can apply again since no publication of the abandoned application is made by the Patent Office, provided the applicant does not publish the said design in the meanwhile.

77 Are the registered designs open for public inspection?

Yes, registered designs are open for public inspection only after publication in the official gazette on payment of prescribed fee of Rs. 500/- on a request in Form -5.

78 Can the applicant file the application for registration of design himself only or through a professional person?

The application for registration of design can be filed by the applicant himself or through a professional person (i.e patent agent, legal practitioner). However, for the applicants not resident of India, an agent residing in India has to be employed.

79 Can the registration of a design be cancelled?

The registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in Form 8 with a fee of Rs. 1500/- to the Controller of Designs on the following grounds:

1. That the design has been previously registered in India;

2. That it has been published in India or elsewhere prior to the date of registration
3. That the design is not new or original;
4. That design is not registrable;
5. That it is not a design under Clause (d) of Section 2.

80. What is the penalty for the piracy of registered design?

If anyone contravenes the copyright in a design he is liable for every offence to pay a sum not exceeding Rs. 25,000/- to the registered proprietor subject to a maximum of Rs. 50,000/- recoverable as contract debt in respect of any one design.

81. What does Hague Agreement on Industrial Designs signify?

The Hague Agreement Concerning the International Deposit of Industrial Designs first came into existence in 1925. The Agreement aims at providing a mechanism for securing protection of an industrial design in all the member countries by means of an international deposit. The international deposit could be in the form of the industrial product or drawing or photograph or any other graphic representation of the said design. The duration of protection was 15 years from the date of deposit, this term is divided in two periods namely, one period of five years and the other of ten years. This Agreement is now being implemented by the WIPO.

82 What are the changes made to the Hague Agreement?

A Diplomatic Conference was held in June and July 1999 to bring out some amendments in the Hague Agreement. The revised agreement will come into effect after it has been ratified by six of the initial signatory nations to the Agreement. The idea is to provide a way through which a single design application can give rights to protection for that design in member countries. The international design application must designate countries where protection will be sought. The designated countries can refuse to award design rights, if the application does not meet the requirements of national laws. The Agreement does not lay down any particular standards for registrability of the design, leaving this to national laws. Once registered the international registration will have the same effect as a national design registration in those designated countries that have not refused grant for national registration. Other main features of the revised agreement/ treaty are:-

1. International design protection will be available to nationals of a contracting country, domiciled in a contracting country or have industrial or commercial establishment in a contracting state.
2. An international design application may be filed either at the applicant's national office or directly with the International Bureau of WIPO.
3. Two-dimensional designs (textile designs) would be eligible for protection.
4. A formalities examination will be carried out by the International Bureau and then the application will be published if it is found to satisfy the formalities. The publication will be made six months after the registration. This can be deferred to 30 months in some special cases.
5. The International Bureau will, after the registration, send a copy of the application to each of the designated countries. These countries have to inform the Bureau within six months if national requirements are not met. However, countries

that examine design applications for novelty or where opposition system exists, this time is increased to 12 months.

6. Multiple designs may be included in the same application. It is however, required that all products to which such designs relate must be in the same class under the Locarno classification.

It can be seen that there are some similarities with the PCT system for patent applications. India is not yet a member of the Hague Agreement and hence, the above provisions or description may not be of immediate relevance to us. However, there is a strong need to monitor the developments in this area.

83 How is the Trademarks Act 1999 different from the Trade and Merchandising Marks Act 1958?

Enactment of the Trademarks Act 1999 is a big step forward from the Trade and Merchandise Marks Act 1958 and the Trademark Act 1940. The newly enacted Act has some features not present in the 1958 Act and these are:-

1. Registration of service marks, collective marks and certification trademarks.
2. Increasing the period of registration and renewal from 7 years to 10 years.
3. Allowing filing of single application for registration in more than one class.
4. Enhanced punishment for offences related to trademarks.
5. Exhaustive definitions for terms frequently used.
6. Simplified procedure for registration of registered users and enlarged scope of permitted use.
7. Constitution of an Appellate Board for speedy disposal of appeals and rectification applications which at present lie before High Court.

84 How is "Trademark" defined?

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 other and may include shape of goods, their packaging and combination of colours; and

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a 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

(ii) 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.

85 What are "Well-known Trademarks" and "Associated Trademarks"?

Well-known trademark 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.

Associated Trademarks means trademarks deemed to be, or required to be, registered as associated trademarks under this Act.

86 What is the meaning of "Service" in the Trademark Act 1999?

Service means service of any description which is made available potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising.

87 How are the terms "Certification Trademarks" and "Collective Marks" defined in the Act?

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.

Collective Mark means a trademark 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.

88 What is the term of a registered trademark?

The initial registration of a trademark shall be for a period of ten years but may be renewed from time to time for an unlimited period by payment of the renewal fees.

89. What is the Madrid Agreement?

The Madrid Agreement was adopted on April 14, 1891 to facilitate protection of a trademark or service mark in several countries by means of a single international registration. As on July 15, 1999, 54 countries are party to this Agreement mainly belonging to Europe, countries of Africa and four countries in the Far East namely, China, the Democratic People's Republic of Korea, Mongolia and Vietnam. The United Kingdom, the United States of America, most Latin American countries, Japan and India are not signatories to this agreement. The Agreement covers both trademarks and service marks.

90. What are the main features of the Madrid Agreement?

Main features of the Madrid Agreement are as follows :

1. An applicant must be a national of a member country. A person having his domicile or a real and effective industrial or commercial interest in such a country is also eligible. It may be noted that this would be governed by the national laws of the country in question:
2. A mark to be registered in member states should be first registered at the national level in the country of origin of the applicant. The first registration is called 'basic registration'.

3. The country having given the basic registration can only transmit there quest for international filing to the International Bureau of the World Intellectual Property Organization (WI PO) along with the list of the countries in which protection is being sought. There 'is no provision for directly filing a request under the Agreement.
4. It may be iterated that the country of origin has to be a member state. The role of the office of the country of origin is not only to send the application for international registration but also to certify that the mark which is the subject of the international registration, is the same mark which is the subject of the basic registration.
5. For each application fees has to be paid for each designated country and WIPO. The fees paid for the designated countries is called the 'complementary fee'.
6. The International Bureau notifies the international registration to the offices of the designated countries and publishes it in a monthly periodical called 'The WIPO Gazette of International Marks'.
7. If the basic registration is cancelled for some reasons, in the country of origin, during the first five years, the international registration automatically stands cancelled in all the designated countries. This also gives an advantage to a person to oppose the registration of a mark only in the country of origin and that person need not oppose it in all the designated countries. This possibility of challenging an international registration through a national registration is referred to as 'Central Attack' feature of the Agreement.

91. What is the Madrid Protocol?

The Protocol relating to the Madrid Agreement concerning the International Registration of Marks was adopted at Madrid on June 27, 1989. The Protocol, which entered into force on December 1, 1995, retains the basic features of the Madrid Agreement. As on July 15, 1999, 39 countries have acceded to the Protocol. The Protocol was formed to remove some of the features of the Madrid Agreement, which posed some obstacles to accession by several countries. These features are:

1. For an international registration, it is essential to first register a mark at the national level. The time required for obtaining a mark at the national level varies from country to country. Hence some parties do suffer.
2. Within one year, a designated member country has to examine and issue a notice of refusal by giving all the grounds for refusal. The period was considered short.
3. A uniform fee is paid for the designation of a member country. This was found to be inappropriate for countries with high level of national fees.
4. An international registration is linked to the basic registration during the initial five years and the former gets cancelled if latter is cancelled. The fact, that grounds under which a mark is cancelled in the country of origin need not necessarily exist in every other designated country, is overlooked.
5. The only working language of the Madrid Agreement is French.

Innovations introduced by the Madrid Protocol are :

1. An international application need not necessarily be based on a registration made by the Office of Origin but can also be based on an application filed with the Office of Origin. This makes it convenient for countries with full examination system where the national registration takes time. It also makes it possible to claim the right of priority of six months under the Paris Convention.

2. A Contracting Party can receive the fee under the existing Madrid Treaty system through its share in the international

fees collected: for each designation made as in the Madrid Treaty. Alternatively, the member country can choose "Individual fee" system for each designation made, which should be an amount not more than the national fee for a ten-year registration. The "Individual fee" system makes an attractive proposition for countries with high level of national fees.

3. It is possible to transform an international registration into national or regional application in the designated Contracting

Parties, if the basic registration is cancelled for some reasons, as in the case of "Central Attack".

4. An applicant may choose to base an international registration in any of the Contracting States with which he has connection through nationality, domicile or establishment.

Semiconductor Integrated Circuits Layout Design

92. What does Semiconductor Integrated Circuits layout Design Act, 2000 cover?

It provides protection for semiconductor IC layout designs. Layout design includes a layout of transistors and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in a semiconductor IC. Semiconductor IC is a product having transistors and other circuitry elements, which are inseparably formed on a semiconductor material or an insulating material or inside the semiconductor material and designed to perform an electronic circuitry function.

93. What is not registrable as IC layout design?

Layout design

1. Not original;
2. Commercially exploited anywhere in India or in a convention country;
3. Inherently not distinctive;
4. Inherently not capable of being distinguishable from any other registered layout design is not registrable as IC layout design.

Note: Design not exploited commercially for more than 2 years from date of registration of application shall be treated as commercially exploited for the purpose of this Act.

94. What is the term of an IC layout design protection?

The term is 10 years from the date of filing.

95. What constitutes infringement under the Act?

Reproducing, importing, selling, distributing the IC layout design for commercial purposes only constitutes infringement. A person when creates another layout design on the basis of scientific evaluation of a registered layout design shall not be causing any infringement.

Geographical Indications

96. What does the term 'Geographical Indications (GI)' stand for?

The term GI has been defined as "Geographical Indications", 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 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.

97. Who can apply for GI's registration?

Any association of persons or producers or any organization or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering geographical indication in relation to such goods shall apply in writing to the Registrar in such' form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.

98. Which of the geographical indication cannot be registered?

Geographical Indications :

- the use of which would be likely to deceive or cause confusion or contrary to any law.
- which comprises or contains scandalous or obscene matter or any matter likely to hurt religion susceptibility of any class or section of citizens of India.
- which would other wise be disentitled to protection in a court. .which are determined to be generic names or indications of goods and are,
- therefore, not or ceased to be protected in their country of origin or which have fallen into disuse in that Country.
- which, although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the i goods originate in another territory, region or locality, as the case may be.

99 What is the punishment in the Act for falsifying GI?

A sentence of imprisonment for a term between six months to three years and a fine between fifty thousand rupees and two lakh rupees is provided in the Act. The court may reduce the punishment under special circumstances.

100. What is term of GI protection?

The registration of a GI shall be for a period of ten years but may be renewed from time to time for an unlimited period by payment of the renewal fees.