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# INTELLECTUAL PROPERTY LAWS IN INDIA

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Bangalore

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# Introduction

## Intellectual Property (“IP”) in India | An Overview

- **Types of IP recognized in India | Governing law**
  - Trade marks | The Trade Marks Act 1999;
  - Patents | The Patents Act 1970;
  - Copyright | The Copyright Act 1957;
  - Designs | The Design Act 2000;
  - Geographical Indication | The Geographical Indication of Goods (Registration and Protection) Act 1999;
  - Know How / Confidential Information | Common law;
  - Plant Varieties | The Plant Variety and Farmers Right Protection Act 2001; and
  - Semiconductor Chip Layout | The Semiconductor Integrated Circuit Layout Design Act, 2000.





# Need for registration of IP in India

## Statutory Protection

- Claim for Infringement
- Certain IP – statutory protection is mandatory for enforcement like Patents, Designs

## Cross Border Transactions

- Joint Ventures.
- Technology Collaborations.
- Technology Licenses.
- Trademark Licenses.





# Patents

## Act and Definition

- Governed by The Indian Patents Act 1970 (the "**Patents Act**").
- 'Patent' defined as "*the patent for any invention granted under this Act*".

## Scope of Protection

- Product & Process Patents
- Patent protection is given to all inventions that meet the criteria of:
  - Novelty;
  - Inventive step /non-obviousness; and
  - Industrial applicability.

## Exceptions

- Those specifically excluded by Section 3 of Patents Act; and
- Inventions relating to atomic energy.





## What are not inventions – Section 3

- Contrary to public order or morality;
- Mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance 3(d);
- Mere admixture;
- Plants or animals in whole or part;
- Business method or computer programme per se; or
- Traditional knowledge.





## Section 3 (d) - Examples

### Novartis

- Glivec - beta crystalline form;
- Whether efficacy would mean therapeutic efficacy.
- Pending SC judgement.

### Alfa Wassermann S P A, Italy

- Patent office, in late December 2012, granted patent for the polymorph of a known substance.
- Patent Application was for 'Polymorphic forms of Rifamixin, process for their production and use thereof in medicinal preparations'.
- Alfa could prove efficacy: same therapeutic value with 100 times less toxicity of the new polymorph of this invention





# Patent Prosecution

## Patent Application

- Type of applications:
  - Under the Patents Act;
  - International application under Patent Co-operation Treaty system; or
  - Convention application
- Place of filing: Place of business/domicile/residence of applicant/agent or place from where invention originated

## Publication, Examination, Compliance to Objections





# Patent Prosecution (Contd.)

## Patent Oppositions

### Pre Grant

- Upon publication of the patent application and till the date of grant of patent.
- It may be filed by any person.

### Post Grant

- Within one year from the date of publication of grant of a patent.
- It can be filed only by a person interested.

### Term

- Term: 20 years, subject to renewal.

### Annual Statement of Working

- Of every year by 31 March of the following year

### Section 39

- Indian Residents not to apply for patents outside India without prior permission from the Controller







# IP PRACTICE IN INDIA

- Awareness to protect IP has increased
- Changing Perspective:
  - Mere innovation
  - Protection
  - Enforcement
- Intellectual Property Appellate Board (IPAB) - Technical Tribunal constituted
- Judiciary getting equipped to Intellectual Property laws
- Customs withholding infringing goods
- IP Litigations have increased multifold





# IP Litigation in India

- Courts have become vigilant in protecting the exclusive rights
- Typically, there are 3 (three) stages of litigation
  - Ad-interim - Injunctions are being granted against the infringer within days from the filing of the suit
  - Interim
  - Final hearing of the suit
- Ex-parte reliefs are also not uncommon
- Punitive damages in certain cases also awarded
- John Doe Orders being granted by various Courts in India





# IP Infringement | Remedies

## Civil Suit

- In case of an infringement, relief may be sought in the form of:
  - Injunction;
  - Damages or accounts of profits; and
  - Order for seizing, delivery, forfeiting or destroying the infringing goods / materials.

## Criminal Complaint

- A criminal complaint may be filed only in the case of infringement of a Trademark, Copyright or a Geographical Indication.





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