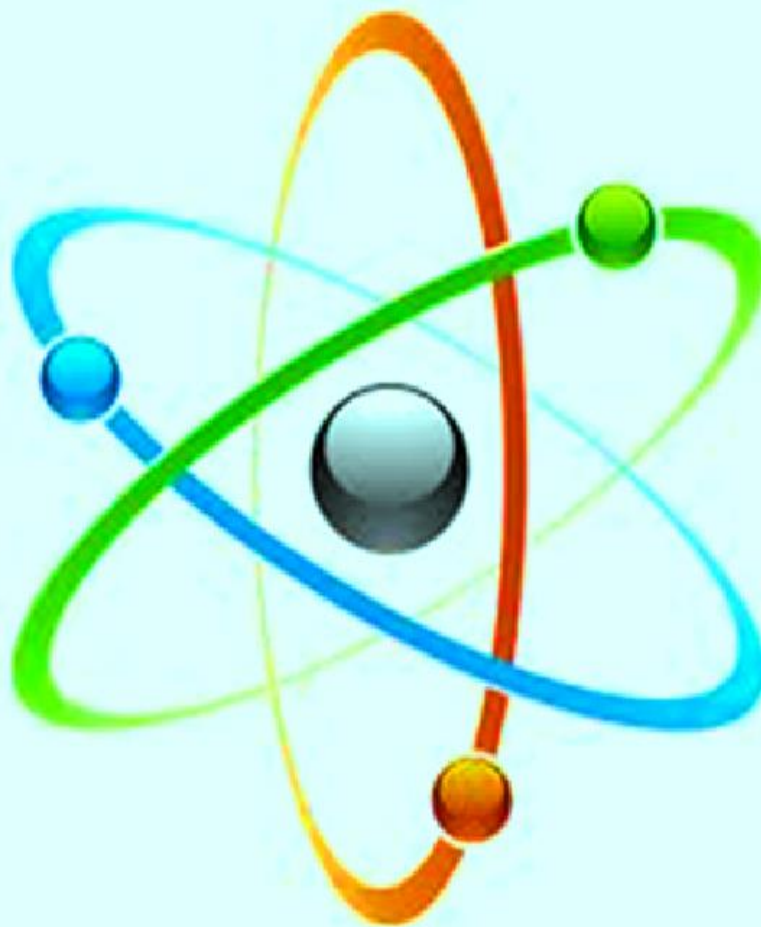


IP EXPRESSIONS

*A biannual publication from the Office of Controller General of
Patents, Designs and Trademarks, India*

Vol. No.1 Issue 2
January, 2015



Patents

Designs

Trademarks

Geographical Indications



**INTELLECTUAL
PROPERTY INDIA**

PATENTS/DESIGNS/TRADEMARKS
GEOGRAPHICAL INDICATIONS

PREFACE

Intellectual property rights are protected primarily to stimulate innovation, design, and creation of new technology, ensure fair competition and to protect consumers, by enabling them to make informed choices between various goods and services. While on the one hand, it provides consumers with new products enabling them to benefit from innovation, on the other, it provides the industry and innovators the incentive and means to finance research and development activities. The intellectual property scenario in India is developing at a very fast pace. The Intellectual Property Regime in India aims to create an IP culture and to enhance knowledge & competencies in tune with the global environment.

The Inaugural edition of “IP Expressions”, a biannual publication of the Intellectual Property Office, was unveiled by Sh. Amitabh Kant, Secretary, Department of Industrial Policy & Promotion on 8th September, 2014. During the period from September 2014 to January 2015, the Government of India has taken the initiative to include IPR in the “Make in India” project and constituted the IPR Think Tank, bringing IP to the centre-stage in India.

Against this backdrop, I am pleased that this edition of the E-Patrika provides an interdisciplinary perspective of various aspects in the IP regime in India. In trademarks, a wide series of topics embracing facets such as ‘Charting the Evolution of Trademark Law in India’, ‘India’s Accession to The Madrid Protocol’ and an article on ‘The Definition, Purpose and Function of Trade Mark Law based on the Principles Emanated from Recent Case Laws’ are included in this edition. An article on “History of Design Registration Law in India (1872-1932)’ charts the journey of Design registration in India.

On the Patents side, a wide range of articles on ‘Intellectual Property and Indian Ecosystem’, ‘Patent and Traditional knowledge for Development of Pharmaceutical Industry’, ‘ICT Patents in India and Business Strategies’, ‘Intellectual Property Policy and Strategy for collaboration between Institutes and Industry’ have also been incorporated.

Although the views expressed in the articles are of the authors, I commend the work done by the authors for expressing their thoughts and sharing their views and the Editorial Board, which has selected articles suitable for achieving the primary purpose of dissemination of knowledge on the different aspects of intellectual property.

(Chaitanya Prasad, IAS)

Controller General of Patents, Designs & Trade Marks

The views expressed in the articles are the personal views of the author and do not reflect the views or the policy of the Office or the Government.

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CHARTING THE EVOLUTION OF TRADEMARK LAW IN INDIA

By

DR. PRITHPAL KAUR

Evolution of the concept of Trademark

The notion of ownership of creation or innovation and its protection is not new to mankind. Originally, marks were placed on objects to identify ownership and to deter would be thieves. By this way the ancient people tried to control low quality goods, and as the maker of the product was identified automatically the infringers were punished. The more a trademark came to be known, the more it inspired confidence in the goods and services to potential clients. When a mark was placed it meant that any other third party other than the manufacturer did not have any right over it, in a large way it helped deter people with vested interest. In the middle ages two basic kinds of marks could be found:-

Merchants Mark

Production Mark

The Merchants Mark indicated ownership whereas the Production mark indicated the Origin. People also started engraving their names in ships and this was probably the first widely recognised method of using trademarks, where in case of ship wreckage, identification would be possible. Other people doing business or in guilds started asserting it as a mark on their goods. This made the manufacturer responsible for the quality of the goods that were being produced and helped them to retain their customers.

Trademark Law in India

In India, prior to 1940, no specific legislation for protection of trademarks had been enacted and common law principles of equity and passing off were followed for protecting them. Major milestones that can be enlisted to be elementary in evolving Trademark Law in India are:

- The Indian Trademark Act, 1940
- The Trademark and Merchandise Act, 1958
- Trademark Act, 1999
- Trademark (Amendment) Act, 2010
- Well-Known Trademarks and Trans-border Reputation
- Protection of Domains names under Trademark Law
- Reliefs against Trademark Infringement and Passing-Off
- Protection of Un-conventional marks
- India's accession to Madrid Protocol
- Digitization of Trademark Registry
- Government's initiative towards IP awareness and protection

Indian Trademarks Act, 1940: The said enactment extended to all parts of India, Pakistan and Bangladesh¹.

Trade and Merchandise Marks Act 1958: In view of augmentation witnessed in trade and commerce, the Government felt the need of robust statutory provisions for safeguarding trademarks and accordingly repealed the 1940 Act and passed the Trademark and Merchandise Act, 1958.

The 1958 consolidated the provisions relating to protection of marks as enunciated under other Statutes like the Indian Penal Code, Code of Criminal Procedure and Sea Customs Act.

Trademarks Act, 1999: Since, inception, the Act of 1958 underwent several amendments to accommodate new practices in trade and commerce. Accordingly the legislature passed the Trademark Act, 1999² which brought about the following fundamental changes in law governing the filing and prosecution of trademark law in India³:

- ✓ Confirmed with the obligations under the TRIPS (Trademark Related Aspects of Intellectual Property Rights)
- ✓ Provides for registration of service marks
- ✓ Enables filing of multi-class trademark application
- ✓ Increasing term for renewal of trademark from 7 years to 10 years
- ✓ Provision of enhanced punishments in case of false trademarks
- ✓ Provision for registration of collective marks i.e. marks owned by associations
- ✓ Constitution of IPAB (Intellectual Property Appellate Board)
- ✓ Expansion of the term “mark” under section 2 to include shape, packaging, combination of colours and any combination thereof

Trademarks (Amendment) Act, 2010: The Legislature incorporated Chapter IV A in the Act, which embodied *Special Provisions Relating to the Protection of Trademarks through International Registration*.

Well-Known Trademarks and Trans-border Reputation: The statutory provisions under the Trademark Act, 1999 accords special protection to well-known marks in the following manner:

- Against registration of any similar marks;
- Against misuse of well-known trademark- as recognized by the Indian Intellectual Property Office.

Prior to formulation of law for protection of well-known trademarks, such marks were safeguarded vide common law principles of passing off and injunction. The Indian Judiciary has played an elementary role in evolving the law and the following cases substantiate the same:

¹ <http://wordict.com/trademarksub.html>

² <http://www.mondaq.com/india/x/127680/Trademark/Trademarks+Law+In+India+Everything+You+Must+Know>

³ http://www.ipindia.nic.in/tmr_new/NEW_ELEMENTS_IN_TRADEMARKS_ACT_1999.htm

Daimler Benz Aktiengesellschaft v Hybo Hindustan⁴: In this case the Court considering the Plaintiff's mark "BENZ" to be well known on account of trans- border reputation and goodwill granted injunction against the defendants who were using the impugned mark for selling their apparel.

Whirlpool Co & Anr v. N R Dongre⁵ : Whirlpool had not registered their trademark in India. However, by virtue of use and advertisements in International magazines and worldwide reputation the Plaintiff successfully prevented the defendant from infringing its trademark in India.

Protection of Domain Names under the Trademark Law: With the increased use of technology and internet, domain names are serving as business identifiers and accordingly registration of domain names has been gradually increasing.

The Indian Judiciary extended trademark protection to domain names in the case of **Satyam Infoway Ltd. Vs Sifynet Solutions Pvt. Ltd.**⁶. In the said case, the Court made the following observation:

"Original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has development from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain name owner provides information/services which are associated with such domain name. Thus domain name may pertain to provision of services within the meaning of Section 2(z)"

Remedies against Trademark Infringement and Passing-Off: In cases of trademark infringement and passing off, the Judiciary apart from granting injunction or ex-parte injunction for immediate relief has passed orders like *Anton Piller Orders*, *Mareva Injunction* and *John-Doe Orders* for according relief to the aggrieved.

Anton Piller Orders- One of the former cases, wherein the Judiciary recognized passing of Anton Piller order was the case of **National Garments vs National Apparels, Ernakulam**⁷. In the said case, the Court observed that **Anton Piller Order** can be granted for inspection of the defendant's premises without prior warning and discovery of his records and further stated that **Anton Piller order** is similar to the ex parte interlocutory in order to take an inventory of the articles etc. passed in an ordinary suit.

Mareva Injunction- It was first recognized by the Judiciary in the case of **Kloninkijke Philips Electronics v. Overseas Business Corporation & Ors. (2001)**. In this case the plaintiff was manufacturing consumer goods under its registered trademark **PHILIPS**. Thereafter, the defendants were trying to export a consignment of televisions bearing the mark **PHILIBS**.

The Court held that there was a similarity of marks which was likely to cause confusion in the minds of the public and accordingly *Mareva Injunction* was granted whereby *a local Commissioner was appointed to inspect the premises of the defendant and empowered to seize the infringing goods*.

⁴ AIR 1994 Del 239

⁵ (1996) PTC 415 (Del)

⁶ AIR 2004 SC 3540

⁷ AIR 1990 Ker 119

John Doe Orders- In the case of **Ardath Tobacco Company Limited v Bhai**⁸, the Indian Court for the first time passed **John Doe Orders** restraining named defendant and unknown infringers. The Court passed the order, pursuant to which search and seizure was conducted.

Protection of Un-conventional Marks: Trademark protection is no more restricted to wordmarks or images but the Judiciary has extended protection to non- traditional marks like shape of mark, sound mark, single colour mark and three- dimensional marks.

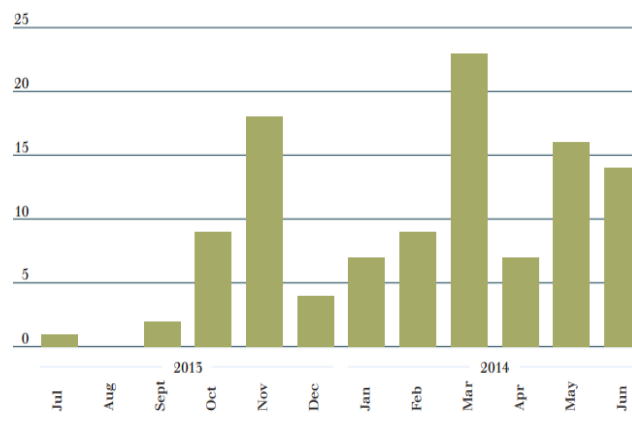
Shape mark- Famous Zippo lighters were successfully registered by the Trademark Registry as a shape mark.

Sound marks- Yahoo’s sound mark Yodel! is the first sound mark registered in India. Moreover, Nokia, Allianz Aktiengesellschaft and ICICI have also successfully secured registration for their sound marks in India.

Single Colour marks- Entities like Victronix AG (#1394234- brown colour label) and Telekom AG (#1462271-magenta colour label) have successfully registered their single colour marks in India.

India’s Accession to Madrid Protocol: India deposited its instrument of accession to the Madrid Protocol for International Registration of Marks at WIPO in April, 2013. The System enables Indian trademark owners to secure international trademark registration in signatory countries by way of filing a single application.

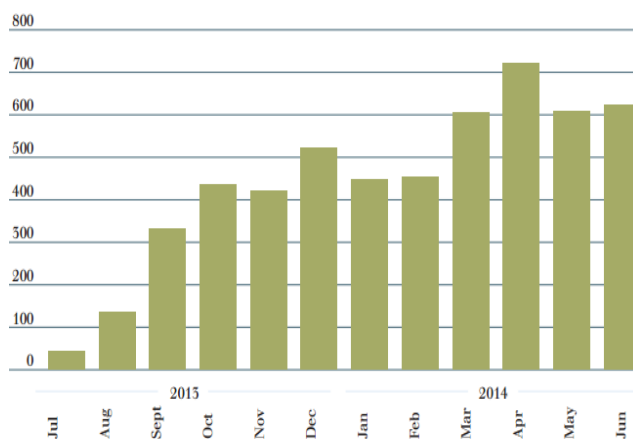
According to WIPO reports, pursuant to accession, 110 international applications have originated from India and in 5,458 international applications have been filed designating India as a signatory country.⁹



INTERNATIONAL APPLICATIONS ORIGINATING FROM INDIA (2013-14)

⁸ CS (OS) 141/2004

⁹ Source: Statistics under Madrid System (WIPO)- <http://www.wipo.int/madrid/en/statistics/>



INTERNATIONAL APPLICATIONS DESIGNATED TO INDIA (2013-14)

Digitization of Trademark Registry and records: The Indian IP Office has been constantly making efforts towards digitization of its records and thereby making the filing and prosecution of trademarks less cumbersome and transparent.

In 2011, the Trademark Registry enabled comprehensive e-filing of trademarks, thereby allowing trademark owners or their agents and attorneys to file trademarks through a simple process. The system also allows users to upload the supporting documents alongwith the application. Moreover, other subsequent TM Forms can also be filed online.

The status and documents of all the trademarks filed and registered can also be viewed at the Registry's website at <http://164.100.176.37/eregister/eregister.aspx> . Moreover, the facility for trademark search is also available, which allows public to conduct free trademark search including wordmark search and device search through Vienna codes.

The digitization of trademark records has to a great extent made the system transparent and has also made the filing and prosecution of trademarks less time consuming and expensive. It has also helped in speedy disposal of trademark forms and procedure.

Recently, the Registry has launched a dynamic trade mark utility enabling the public to see in real time the stock and flow of trade mark applications.

Government's Initiative towards IP Awareness and Protection: The Modi Government has also been initiating several efforts towards innovation and towards strengthening of IP Policy and awareness in India. The Ministry of Commerce and Industry recently constituted Think Tank for drafting National IPR Policy. The first draft has already been submitted to the Centre and reportedly the essential features of the draft include the following¹⁰:

- Balancing national priorities and international obligations;
- Constitution of IP Promotion and Development Council;
- Establishing a dynamic, vibrant and balanced intellectual property system in India;

¹⁰ <http://timesofindia.indiatimes.com/india/Indias-ambitious-National-IPR-Policy-ready-think-tank-submits-report-to-Centre/articleshow/45653552.cms>

- Foster innovation and creativity in a knowledge economy;
- Accelerate economic growth, employment and entrepreneurship;
- Start-ups and manufacturing units for IP awareness, protection and utilization;

The National IPR Policy is a welcome move and it is expected that innovation and creation will foster in future.

Conclusion

Trademark Law in India has come a long way, since its inception in 1940. The Legislature has constantly amended and updated the law to accommodate changes and harmonize with the International law and standards.

Here it would be pertinent to mention the Judiciary's effort in evolving trademark law through its precedents and *obiter dicta*. Time and again the Indian Judiciary has passed such judgements which have served as the law of land and has aided exploration and registration of trademarks that are not merely limited to names and images but extend to registration of even sound and shape marks.

In recent years, trademark recognition and protection has also been extended to visual and aesthetic features of a product, like infringement of packaging and colour combination of products have been prevented by the Judiciary.

The emergence of IT industries and MSME's in India has augmented innovation and protection of IP in India. Companies are exploring different forms of trademarks and consequently law relating to trademark protection is evolving each day.

Moreover, India's recent accession to the Madrid Protocol and Government's initiative to draft India's National IPR Policy indicates the increasing prominence of IP protection in India.

INDIA'S ACCESSION TO THE MADRID PROTOCOL

By

R. A. TIWARI

Assistant Registrar of Trade Marks and G.I., Trade Marks Registry, Mumbai

On 8th April 2013, the Government of India joined the Madrid system for international registration of trademarks, by depositing the instrument of accession to the Madrid Protocol with the Director General of the World Intellectual Property Organisation.

Madrid system provides for single procedure for the registration of trademarks in several territories. Madrid system comprises of two treaties- the *Madrid Agreement Concerning the International Registration of Marks (commonly known as the "Madrid Agreement")* which was concluded in 1891 and entered into force in 1892, and the *Protocol Relating to the Madrid Agreement (commonly known as the "Madrid Protocol")*, which came into operation on 1 April 1996. These treaties are administered the World Intellectual Property Organisation (WIPO) in Geneva, Switzerland.

India joined the Madrid Protocol, since it is more popular in the users of the Madrid System.

Trademark and its value

A trademark is a mark or sign which is adopted to distinguish, in the course of trade, the goods produced or the services rendered by any person from those of others. The word 'Person' here includes an individual or a group of individuals carrying on a business together, as well as a legal person, like a Company, Society, Trust, Government body, or any other statutory organisation. When such a person as an entrepreneur produces a commodity to bring that into the market, he uses all the inventive skills & creativity and takes all efforts to make that product more effective, more useful and more appealing. Similarly when that entrepreneur renders any service and launches that in the market for the prospective customers he takes all efforts to make that service more effective and more useful. In such circumstances, it is quite obvious that such person would wish his products or services to be identified with him and be distinguished from similar products or services of others in the market. The trademark plays this role. The trademark may be word, letter, numeral or any combination thereof, label, brand, ticket, or combination of colours, shape of goods or packaging. Article 15 of the Trade Related Intellectual Property Rights (TRIPS) states that: "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark"¹¹. The Indian Trade Marks Act defines the trademark as "'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..."¹². the Act further defines

¹¹Article 15 of the Trade Related Intellectual Property Rights

¹²Section 2(1)(zb) of the Trade Marks Act, 1999

mark as "'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"¹³. Much of the entrepreneur's wisdom and intellect and creativity available with him are involved in making a product or launching a service in the market. His products or services are identified in the market, by the trademarks adopted by him. As such the trademark of the entrepreneur is a very valuable Intellectual Property Right (IPR) available with him. The Forbes Magazine, for instance, has provided value of 10 trademarks as on 15th June 2011, as follows-

Google

Trademark value: \$44.3 billion

Company market capitalization (number of shares times share price): \$164 billion

Still the most popular search engine, Google, with its mobile operating system Android, has now surpassed Blackberry and Apple's systems in terms of market share.

Microsoft

Trademark value: \$42.8 billion

Market cap: \$204 billion

The number one software company in the world, Microsoft has been diversifying its product lines to include video game consoles, consumer electronics and digital services.

Walmart

Trademark value: \$36.2 billion

Market cap: \$184 billion

The world's largest retailer in the world now has over 2 million employees and nearly 9,000 stores.

IBM

Trademark value: \$36.2 billion

Market cap: \$199 billion

Holds more patents than any other technology company and has been acquiring software manufactures in a variety of fields to diversify its hardware-heavy portfolio.

Vodafone

Trademark value: \$30.7 billion

Market cap: \$138 billion

operates one of the largest mobile telecommunication networks in the world, with over 340 million customers in more than 20 countries.

Bank of America

Trademark value: \$30.6 billion

Market cap: \$109 billion

¹³Section 2(1)(m) of the Trade Marks Act, 1999

Despite its rough ride through the latest financial crisis, Bank of America still has one of the country's most extensive branch networks with some 6,000 locations in the U.S and another 300 offices abroad.

GE

Trademark value: \$30.5 billion

Market cap: \$197 billion

There are few industries this uber-conglomerate doesn't touch—from health care to aerospace to household appliances.

Apple

Trademark value: \$29.5 billion

Market cap: \$307 billion

Even signal-strength problems couldn't derail sales for Apple's iPhone 4.

Wells Fargo

Trademark value: \$28.9 billion

Market cap: \$143 billion

On an acquisition tear to the top of the banking heap.

AT&T

Trademark value: \$28.9 billion

Market cap: \$182 billion

Largest provider of local and long distance telephone services in the U.S., with about 95 million subscribers.

The registration and protection of trademarks

Since the trademark is such a valuable property, it is advisable to register it. Registration is prima facie evidence of proprietorship of trademark. It gives the exclusive right in favour of the registered proprietor to use the trademark in respect of relevant goods or services and to take legal action in case of infringement of registration or any type of unauthorized use or dilution of the trademark. The registered proprietor may assign or license the trademark as any other property. The registered proprietor can enjoy the Goodwill associated with registered trademark forever, if the mark is renewed from time to time.

Ordinarily the trademarks are registered with national trademark registry offices and these are protected within the territory under the jurisdiction of these offices. In India the trademark is registered with the Trade Marks Registry of the office of the Controller General of Patents, Designs and Trade Marks under the Ministry of Commerce and Industry, Government of India. Accordingly the registered trademark can be enforced only within the territory of India.

Need for India's accession to the Madrid System

At present, the trade and business transcend the national boundaries. The whole world has become a global village. The goods & services of Indian entrepreneurs are not only making their presence in international market but they are very much liked there. Value and reputation of Indian trademarks in the international market is increasing day by day. Due to this Indian entrepreneurs go

to register their trademarks in different territories in order to protect them. For registering trademarks in different territories one needs to make applications before each jurisdiction *in different languages, with different fees and by following different regional regulations*. One needs to engage a local attorney for every application.

On the other hand the Indian public has become more quality conscious and the people here look for products bearing original foreign brands.

The India entrepreneurs, if they want to protect their trademark beyond the territory of India, file applications for registration of their trademarks directly and the Indian office is not involved in it. Therefore the data regarding number of applications filed in foreign jurisdictions by Indian applicants is not applicable. However the number of applications filed by foreign applicants for registration of their trademarks in India during 2007-08 to 2013-2014 is as follows-

TREND OF APPLICATIONS FILED FROM 2007-08 to 2013-14¹⁴

Year	Indian Applicants	Foreign Applicants	Total
2007-08	1,17,014	6,500	1,23,514
2008-09	1,19,371	10,801	1,30,172
2009-10	1,34,403	7,540	1,41,943
2010-11	1,67,701	11,616	1,79,317
2011-12	1,69,602	13,986	1,83,588
2012-13	1,79,435	14,780	1,94,216
2013-14	1,84,140	15,865	2,00,005

The Government of India in the year 2007 itself took a decision to accede to the Madrid Protocol of the Madrid system of international registration of trademarks. India joined the Madrid Protocol, since it is more beneficial to the public. Most of the countries which were members of the Madrid Agreement also joined the Madrid Protocol. In fact, there is only one country (i.e. Algeria) which is the member of the Madrid Agreement only.

The Government of India acceded to the Madrid Protocol as 90th member of the Madrid System. After India's accession, Rwanda joined on 17th August 2013 and Tunisia on 16th October 2013. Canada is likely to join. India is the 14th of the G-20 economies to accede to the Madrid Protocol. The African Intellectual Property Organization (OAPI) became the 93rd member of the Madrid System on December 5, 2014, following the deposit with the Director General of WIPO of its instrument of accession to the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force in respect of OAPI, on March 5, 2015. OAPI comprises 17 member States: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo. Zimbabwe became the 94th member of the Madrid System on December 11, 2014, following the deposit with the Director General of WIPO of its instrument of

¹⁴The Annual Report of the Office of the CGPDTM

accession to the Madrid Protocol. The Madrid Protocol will enter into force in respect of Zimbabwe, on March 11, 2015.

Basics of the Madrid System and Madrid Protocol, in general

Any Country which is a party to the Paris Convention for the Protection of Industrial Property may become a party to the Madrid Agreement or the Madrid Protocol or both. In addition, an intergovernmental organization may also become a party to the Protocol (but not the Agreement) where at least one of the Member States of the organization is a party to the Paris Convention and the organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

The Madrid System is a closed door system. Only a person linked with a country or intergovernmental organization which is a member of the Madrid Protocol can make an application for registration and protection of his trademark in the territory within the jurisdiction of that Country or intergovernmental organization.

Any person (including a legal entity)

- who is a *citizen of*, or is *domiciled in*, or has real and effective *industrial or commercial establishment* in a country or intergovernmental organization which is member of the Madrid Protocol, and
- who has got a registration of a trademark or who has filed an application for registration of trademark in that country or intergovernmental organization,

can make application for international registration of trademarks under the Madrid Protocol.

The application for international registration is made by the *same person* for the *same trademark* and *in respect of goods or services* covered in the domestic application or registration.

In fact the Madrid System is a system for providing international protection of the mark under domestic application or registration, by international registration of the mark with the international Bureau of the WIPO.

The applicant, in his application for international registration of the mark designates countries and/or intergovernmental organizations where the mark is sought to be protected.

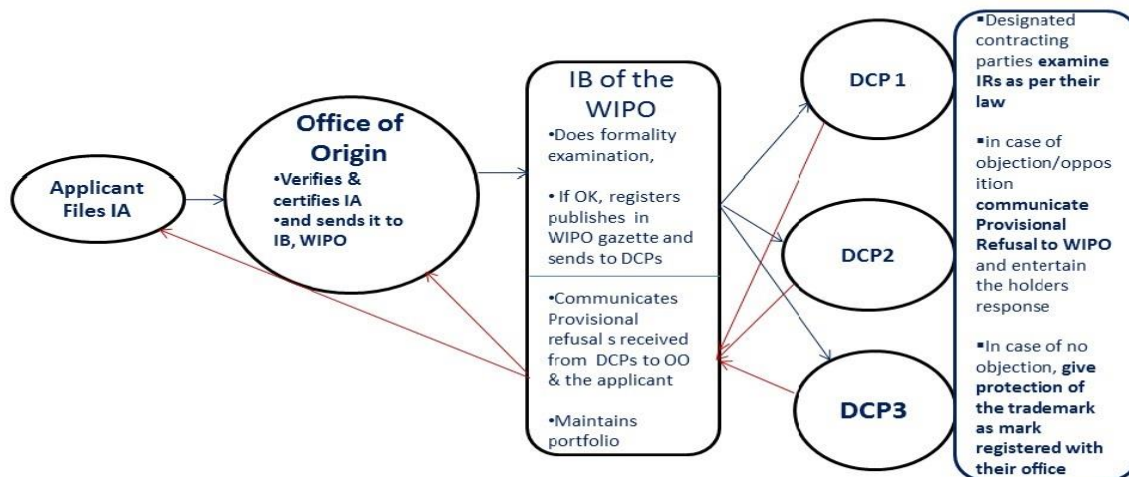
The office of the country or intergovernmental organization to which the applicant is connected by way of his citizenship or domicile or establishment, is called "the Office of Origin". The domestic application or registration on the basis of which application for international registration is filed is called "Basic Application" or "Basic Registration" respectively. The members of the Madrid System involved in the process of application and protection of the trademark are referred to as "Contracting Parties"

An application for international registration must be presented to the International Bureau through the Office of origin. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the *WIPO Gazette of International Marks*.

The International Bureau notifies each Contracting Party in which protection has been requested, whether in the international application or subsequently. From the date of the international registration or subsequent designation, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been deposited directly with the Office of that Contracting Party. Each designated Contracting Party has the right to refuse protection, within the time limits specified in the Agreement or Protocol. Unless such a refusal is notified to the International Bureau within the applicable time limit, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party. The time limit for a Contracting Party to notify a refusal is generally one year. Under the Protocol however, a Contracting Party may declare that this period is to be 18 months (or longer, in the case of a refusal based on an opposition).

The process of international registration and protection of the trademark under the Madrid Protocol may be understood with following diagram-

Procedure for international registration under the Madrid Protocol



The main advantage of the India's accession to the Madrid Protocol is that it allows an Indian entrepreneur who has got the registration of a trademark in India or who has simply made an application for that, to obtain trademark registration and protection in any or all member states by making **one application** in India in English with **one set of fees in Swiss Francs**. Similarly a person from another member state may get protection of his trademark in India by making such application

in the office of his home country and by designating India therein. In such international registrations under the Madrid Protocol there is **one registration number** and **one renewal date**, irrespective of the number of jurisdictions designated. The registration can be further extended geographically. All subsequent changes to the international registration may be recorded with the IB and have effect through one single procedure.

All the relevant information about the Madrid System, including data for International Register on ROMARIN, the WIPO Gazette, various tools like Madrid Goods Service Manager (for proper specification of goods or services), Madrid Real-time Status (for tracking actual status of international applications, are freely available at <http://www.wipo.int/madrid/en>

Steps taken for implementation of the provisions of Madrid Protocol in India

The Trade Marks Act, 1999 and Trade Marks Rules, 2002 govern the law relating to trade marks in India. A major amendment in the Trade Marks Act, 1999 by way of the Trade Marks (Amendment) Act, 2010 was brought to enable accession to the Madrid Protocol. The Trade Marks Rules, 2002 were amended in the year 2013 through the Trademarks (Amendment) Rules 2013 mainly for the purpose of implementation of provisions of the Madrid Protocol in India. Accordingly the provisions of the Madrid Protocol came into force in India since 8th July, 2013.

It was also decided that all functions relating to Madrid Protocol in India should be done only through electronic system. A 'Trade Marks International Applications System' has been developed and put into operation. Under this system, the applications for international registration of trademarks can be filed and payment of fees relating thereto can be made online through the *comprehensive e-filing service of trademarks gateway*.

While acceding to the Madrid Protocol, the Government of India had made various declarations & notifications to the WIPO. Under such declarations & notifications it was desired that *individual fees (in spite of complementary fee) should be paid to India in respect of international registration in which India has been designated and in respect of renewal of such international registrations; all communications relating to international application or registration be made and received in English although 3 languages viz. French, Spanish and English are recognized under Madrid Protocol; recording of licenses in the International Register shall have no effect, in case holder of the international registration wants to license his a mark, this shall be done as per Indian law. One of the major declarations was made under Article 14(5) of the Madrid Protocol under which India could not be designated in international registrations which were affected before 8th July 2013, when the provisions of Madrid Protocol came into force in India.*

Implementation of provisions of the Madrid Protocol by the Trade Marks Registry Office

The Indian office has entered into a Memorandum of Understanding with the International Bureau of the World Intellectual Property Organization (WIPO). Under which all the data are transmitted and received from WIPO electronically through FTP Server. The Trade Marks Registry sends data to WIPO on every Monday and receives data on every Friday. All the functions relating to applications for international registration of trademarks originating from India as well as relating to

international registrations wherein India has been designated are performed through the *Trade Marks International Application System*. In addition to correspondence through the system an alert is sent to the respective applicant or his authorized agent at his registered email.

After the provisions of the Madrid Protocol have come into force in India, since 8th July 2013, the Trade Marks Registry (TMR) office of India has two fold responsibilities-

As an Office of Origin

- The TMR receives International Applications. Application must be filed only through *the comprehensive e-filing services for trademarks* gateway made available at the official website www.ipindia@nic.in, with handling fee of INR 2000/
- The TMR verifies as to eligibility of the applicant and contents of the International Application vis-à-vis basic registration/application
- When the International Application is not proper, the TMR sends a deficiency letter to the applicant through the *Trade Marks International Application System with an alert* at his email. The applicant is required to prepare a reply to the deficiency letter and upload it, with supporting documents, if any, through the gateway.
- When the International Application is proper, the TMR certifies and transmits such applications to the International Bureau of WIPO and send a *copy of certification letter* and *fee notice* to the applicant.
- The fee for international application and the individual fee/Complementary fee for designated countries wherever applicable is to be paid directly to the International Bureau of the WIPO, in Swiss Francs
- The IB of WIPO examines such applications for formalities. In case any irregularity (regarding classification of goods or services, for instance) is found, the IB communicates such irregularities to the TMR as well as to the applicant.
- The TMR sends the irregularities to the applicant through the System or by email. The applicant is required to respond to irregularities and prepare a reply to the irregularity letter, and upload it, with supporting document, if any, through the gateway. The TMR sends response to irregularities to the International Bureau of WIPO
- If the International Application is found to be proper by the IB of the WIPO. It is registered with the IB, published in the WIPO gazette and transmitted to the offices of the designated Contracting Parties.
- For the first five years from the registration date, the international registration is dependent on the mark applied for or registered at the office of origin (the basic mark). If, for some reason, the basic mark is abandoned or cancelled (totally or partially) during this initial period, the international registration is cancelled to the same extent (totally or partially) as a consequence. The TMR as an office of origin is under obligation to inform the IB of any change concerning the scope of protection regarding the basic mark. If the international registration is cancelled, the cancellation is published in the *Gazette*, and the affected designated contracting parties are notified accordingly

As an Office of Designated Contracting Party

- In case of an international registration designating India (IRDI), is notified to India the TMR records the particulars of international applications in TMR data base, by giving a national number to it as *IRDI xxxxxx* equating the *date of international registration of IRDI with the date of application for a national application*,
- The IRDI is examined as a national application as per provisions of the Trade Marks Act & Rules. In case of any objection, the TMR communicates a provisional refusal to WIPO. The WIPO communicates the provisional refusal to the applicant of the international application (the Holder of the international registration). The Holder of the international registration may respond to the provisional refusal and request the TMR office to reconsider it only through an Indian agent.
- The TMR follows the procedures regarding the post examination cases similar to those followed in case of national applications objected at examination stage.
- In case of no objections, the TMR publishes particulars of IRDIs in the Trade Marks Journal. Any person may file notice of opposition to so published IRDI, as any other published national application. The Notice of Opposition should be filed on-line through the comprehensive e-filing gateway available at the website
- On receiving any opposition to the IRDI, the TMR will communicate to the WIPO, a provisional refusal based on the opposition. The WIPO sends copy of the same to the holder. The Holder of the international registration, may contest to provisional refusal and file a Counter Statement, only through an Indian agent. The opposition proceeding shall then be conducted as per usual process.
- In case no opposition is received within the prescribed period and there have been no grounds for refusal, the TMR will notify the *Grant of Protection* of the international registration, to the WIPO. In such a case the trademark under the international registration shall have the same protection as if it has been registered with this office.
- The international registrations of marks under the Madrid System is done and maintained by the International Bureau of WIPO, The registration of a mark at the International Bureau is for a period of 10 years It is then renewable for a further 10 years upon payment of the required fees to the WIPO. Accordingly the renewals of international registrations and amendments or corrections in the international registrations are done by the WIPO. The TMR updates the records of IRDIs as per notification by the WIPO.

Indian Office under the Madrid System

In spite of India's declaration under Article 14(5) under which India could not be designated in international registrations which were affected before 8th July 2013, India has been designated in **12593** international registrations as on 24th December 2014. As on 30th November 2014, the WIPO has registered and notified to Indian Office **8642 international** registrations seeking protection of trademarks in India.

Indian office has received **187** applications for international registration of trademarks under the Madrid Protocol Out of these applications **97** have been registered at the level of the WIPO and have been transmitted to offices of the designated contracting parties who will take final decision

about protection of such marks. International registrations designating India are examined in order of the date of the international registrations and along with the national applications bearing the same date of applications. As on date around **228** IRDIs have been examined.

The *Guidelines for functioning under the Madrid Protocol* are made available on the website.

Queries and problems relating to the functioning of the Madrid Protocol in India may be sent to the **International Registration wing** of the **TMR** at madrid.tmr@nic.in or a telephone call may also be made at- +91 22 24134555 or +91 11 25300290

It is hoped that after India's accession to the Madrid System for international registration of trademarks, the entrepreneurs-Indian as well as Non-Indians, would be able to secure better protection of their trademarks beyond their local boundaries.

DEFINITION, PURPOSE AND FUNCTION OF TRADE MARK LAW:

PRINCIPLES EMANATED FROM RECENT CASE LAW

By

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INTRODUCTION

Law of Trade Marks has emerged dynamically as a subject where most modern developments are harmoniously integrated in the law when it was first enacted in India in the year 1940. However, primary purpose of the Act has remained the same. The primary purpose of trade marks consists in identifying for the final user the origin of the products or services so as to distinguish them, without confusion, from those originating elsewhere, and thereby provide a guarantee that they have been manufactured or provided by a single undertaking, which bears responsibility for their quality.

According to settled case law, trade mark law constitutes an essential element in the system of competition in the modern world. "In that system, each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs enabling the consumer, without any possibility of confusion, to distinguish those goods or services from others which have another origin." (Merz & Krell v Deutsches Patent [2001] E.C.R. I-6959).¹

DISTINCTIVENESS AND SIMILARITY

If the law of trade mark can be summarised in two words by virtue of which a trade mark must be registered or refused, they are Distinctiveness and Similarity, each of which must be considered separately in making the global assessment necessary to decide whether there is a sufficient link between two trade marks to confuse an average person so that the mark can be refused or not so that the mark can be registered. "A lesser degree of similarity to a more strongly distinctive mark may be just as objectionable under Community trade mark law as a greater degree of similarity to a less strongly distinctive mark." (Lloyd L.J. in Whirlpool v Kenwood [2009] EWCA Civ 753).²

There are characteristics that the basic form of application should contain. "The court has consistently held that the graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified. In order to fulfil that function, such a representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (Dyson Ltd v Registrar of Trade Marks [2007] 2 C.M.L.R. 14).³

While refusing a mark it was held: "In the absence of any additional element whether graphic or made up of some distinctive feature, the marks sought lacked any fanciful element and did not present the minimum degree of distinctive character required, given that they are understood by the public merely as indications of the type and quality of the goods and services covered and not as marks fulfilling the function of indicating the commercial origin. This perception of the marks sought

in a descriptive sense is not prevented by the juxtaposition of the terms that make up the said marks, this technique being current and usual in the areas of advertising and marketing.” (CeWe Color v OHIM [2006] E.T.M.R. 34)⁴

The ways for determining distinctiveness has been well defined. “For a finding that there is no distinctive character, it is sufficient that the semantic content of the word mark in question indicates to the consumer a characteristic of the product or service relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive at first glance as such, rather than as an indication of the commercial origin of the product or service in question.” (Norma Lebensmittelfilialbetrieb v OHIM [2004] E.C.R. II-1915).⁵

“The distinctiveness of a trade mark within the meaning means that the mark in question makes it possible to identify the product or the service for which registration is sought as originating from a given undertaking and therefore to distinguish the product or service from those of other undertakings and, therefore, is able to fulfil the essential function of the trade mark.” (Cargo Partner v OHIM [2006] E.T.M.R. 35).⁶

TRADE MARK AS PROPERTY

When trade mark is regarded as “intellectual property”, the expression evokes curiosity in the minds of an average customer who understands property mainly in terms of movable and immovable. On the other hand trade marks is kind of special property which is incorporeal nature that display characteristics such as to be the subject of commerce. The rule that governs trade mark as well as all kinds other properties, the most important is the civil law principle of “autonomy of intention, accompanied by the restrictions necessary to facilitate procedures for registration, which is of particular importance for legal certainty and, above all, for the purpose of relying on trade marks as against third parties.” The Court of Justice calls it “tangential purposes of incorporeal property, in particular that of an indicator of quality, on the basis that it serves to attract customers.” (Elizabeth Florence Emanuel v Continental Shelf 128 Ltd [2006] E.T.M.R. 56).⁷

The right of property is independent of other elements like use and reputation: “Ever since Lord Cottenham in *Millington v Fox* (1838) 3 M & Cr. 388 decided that fraud was not an essential ingredient in order to obtain an injunction to restrain infringement of a trade mark, it was recognised by courts of equity that there was a right of property in a trade mark and that such right did not depend on length of user or reputation in the market. Before the Act of 1875 it had been definitively established that the only essential quality for constituting property in a trade mark (unobjectionable in its itself) was that it should have been used by the proprietor in its business upon or in connection with some vendible article. (General Motors Corp v Yplon SA [1999] E.C.R. I-542).⁸

TRADE MARK AND PATENT

Even some times the media is confused and take into granted that patent, trade mark and GI are all one and some. Although trade mark and patent are entities under same umbrella both are different.

“A trade mark is not necessarily a work of invention. Criterion of originality, novelty or imagination is irrelevant in trade mark law. The criterion to be taken into account is the ability of the shape to distinguish goods on the market from goods of the same kind offered by competitors. The fact that a shape might be protectable under copyright or design law does not render it distinctive for trade mark purposes. Instead, the relevant criterion for registration is whether the shape was able to distinguish the goods from other similar goods on the market.” (Bacardi’s Application [2006] E.T.M.R. 84).⁹

Impact of the mark on the eye of the average customer is important factor of trade mark law. The first impression created in the mind must be free from any kind of confusion “The perception of the average customer for the goods in question does not depend on the dissection of the mark and on an examination of each feature of the mark. It turns on the feature which contributes most to the overall impression created by the whole mark.” (Koninklijke Philips v Remington [2006] EWCA Civ 16).¹⁰

A trade mark if only patented does not enjoy any right conferred by trademark. In the same manner there is no rule in trade mark law that bars anything that has been patented or could have been patented from registration. “Rather the general principle is that the same product or item can be protected by various industrial property rights, provided that the conditions for each of those Rights are fulfilled individually.” (Lego Juris A/S v Mega Brands Inc [2007] E.T.M.R. 11).¹¹

“As regards the comparison between trade mark law and patent law, it should be noted that it is based on the distinction between shapes incorporating the same technical solution and those incorporating other technical solutions.” (Lego Juris v OHIM[2009] E.T.M.R. 15).¹²

There is a necessity, however in some times of both patent and trade mark in respect of a same product. “Registration of an obvious technical feature could result in a situation where exclusive rights are acquired or perpetuated through trade mark law over inventions which are in reality patentable, contrary to the legitimate objective.” (Dyson Ltd v Registrar of Trade Marks [2007] 2 C.M.L.R).¹³

TRADE MARK AND COPYRIGHT

A lot of applicants visit Registries with the recording of their performances who wants to register as a copyright and return in vain. Difficulties can be expected to arise if trade mark law is utilized as a means of enforcing performers' rights in respect of recordings of their performances. “Trade mark law, as already emphasised, is concerned essentially with the trade origin of goods. Protection for the rights of performers as such as properly found elsewhere.”(Linkin Park's Application [2006] E.T.M.R. 74).¹⁴

Trade mark law, never the less, like copyright and design protection, does not protect abstract ideas, but only marks which exhibit distinctive features. The mark's representation had to be taken at face value, and no consumer would be able to distinguish, for example, a car model on the basis of the features shown in the mark's representation unless they see the car itself.

TRADE MARKS AND GI

In a review of GI law it is written: “It is difficult to untangle the cobweb like texture of the field of geographical indications (GIs) and to highlight the main issues which make it unlikely that the realm of GIs becomes a calm land in the years to come. Being treated as a form of intellectual (and within that: industrial) property in many international documents, but often handled as a highly political issue affecting countries' reputation and their local communities, the legal framework of GIs is far from being unequivocal, which often results in misunderstandings in discussions about designations containing geographical elements. Instead of being a genuine intellectual property (IP) item, the provisions concerning geographical indications are rather a policy inspired set of rules which are arching over several fields of law such as competition rules, consumer protection, agriculture-related regulatory tools and, of course, IP, with a special relationship to trade mark law. There is a need to try to set up an inventory of the related instruments, with an outlook on certain selected areas of this colourful conglomerate. (European Intellectual Property Review 2009- “Where is the if the is in why? A rough guide to the maze of geographical indications” by Andras Jokuti).¹⁵

In EIPR 2009 an interesting function of GI has been mentioned: “The most obvious function of GIs is that they are *source indicators*, telling the purchaser of the product where the goods are coming from. Trade marks also have this role, only that they work in a business context instead of a geographical one. Connected to this, there is the added element of *guaranteeing a certain quality*: there must be something that creates the positive connotations to the given geographical name, as the product marked with the GI has to show some characteristics that make it stand out of the category of similar goods. This is already a major difference in comparison with trade marks: GIs include the quality element by definition, while trade marks--if managed well--can only acquire such reputation with time. The above functions both relate to the *consumer protection* and *fair competition* arguments: they represent information to the customer when making choices on the market, and protection should be granted in order to avoid misleading labeling and false source indications, drawing the attention to goods of higher quality.” (EIPR 2009: A rough guide to the maze of geographical indications).¹⁶

TRADE MARK AND BRAND

Brands are big business. They can be worth many millions of pounds. The value of the Coca Cola brand has been said to be worth 60 per cent of the market capitalisation of the Coca Cola Corporation. Defining a brand is not easy. A lawyer would tend to think of goodwill, trade marks and so on. But a brand includes more elements; such as image and reputation; the values that the brand owner tries to inculcate in the buying public. A brand is what customers choose to buy. Many decisions about brands are made by customers emotionally or intuitively rather than rationally. Successful brands create a relationship of trust between the customer and the brand.

Important to all this is the overall idea of the “brand image”. The brand image can be created in a variety of ways: personal experience; word of mouth; how the brand is presented in stories in the media; packaging; point of sale display; retail staff; and, of course, advertising. The value of a brand lies in brand awareness; perceived quality; brand association and brand loyalty. The distinctiveness of a brand is of particular importance where the product offered by competitors in a given field of

activity has few substantive differences. The provision of mobile phone services is one such field. Car insurance is another.

A brand that customers can call to mind easily is called a “salient” brand. Many brands have readily recognisable images which are almost indelibly associated with the brand. Sometimes this is packaging (for example, a Perrier bottle). Sometimes it is an image associated with advertising (such as the Dulux dog). Sometimes it is a combination of elements (for example, the Coca Cola bottle, the distinctive font for the logo and the colour red). (It has been said that the reason that Father Christmas is represented in red, rather than in his original green, is because of the influence of Coca Cola's branding.)

English law does not, however, protect brands as such. It will protect goodwill (via the law of passing off); trade marks (via the law of trade mark infringement); the use of particular words, sounds and images (via the law of copyright); shapes and configurations of articles (via the law of unregistered design right) and so on. But to the extent that a brand is greater than the sum of the parts that English law will protect, it is defenceless against the chillwind of competition. But the essence of a trade mark has always been that it is a badge of origin. It indicates trade source: a connection in the course of trade between the goods and the proprietor of the mark. That is its function” It seems to me that the ECJ is recognising that a trade mark may have functions beyond simply guaranteeing a trade origin. The position occupied by the mark within the relevant product market is a legitimate object of protection. As the ECJ recognised the “image” of a trade mark is something that the proprietor is entitled to protect. The limit of the protection is a different question. However, the analysis of the Court seems to me to point clearly to the conclusion that in some circumstances, even where the goods have been placed on the market with the consent of the proprietor of the mark, he is able to complain about the use of his mark by a third party to advertise those very same goods.” (Lewison J. in *O2 Holdings v Hutchison 3G Ltd*, [2006] EWHC 534)..¹⁷

SHAPE OF GOODS AS TRADE MARK

A recent development happening in the field of trade mark is registration of shapes as a trademark. “The principle ensures that shape marks, like other trade marks, are indicators of the origin or source of the goods in question. They do not enlarge the scope of trade mark protection to cover technical solutions for the goods themselves. Other forms of intellectual property, such as patents, designs and copyright, are available for the protection of particular rights of defined scope and limited duration in specified aspects of the goods themselves. If trade marks were allowed to confer rights in technical solutions for the goods themselves, legitimate competition in the relevant market for the goods would be impaired. A shape mark registered in breach of the functionality principle would enable its proprietor to protect his products from the competition of other traders' goods in a shape, which was necessary to obtain a similar technical result.

Trade marks, unlike most other manifestations of intellectual property, are renewable and potentially of unlimited duration as indicators of the origin of goods. They are not intended, however, to confer on the proprietor of the trade mark a monopoly right in other aspects of the goods themselves. The unregistrability of certain shapes is directed at the potential misuse of shape marks in order to combat competition from rival goods, which incorporate similar technical solutions

and functional characteristics. If such restrictions on registration did not exist, a shape mark could be registered and used to create and conserve a monopoly in technical solutions for the goods in question. Art. 3(1) (e) Community Law which is binding on European Union intends to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.” (Koninklijke Philips Electronics NV v Remington Consumer [2006] EWCA Civ 16).¹⁸

SHAPE AND DISTINCTIVENESS

The quality of a shape to be registered as a trade mark has been defined: “Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character. In this case, the trade marks for which registration is sought consist of the three-dimensional shape of the packaging of the goods in question—a fortiori where the goods, because of their very nature, must be packaged in order to be marketed, so that the packaging chosen imposes its shape on the goods and, for the purposes of examining an application for registration as a mark, must be assimilated to the shape of the product.” (Deutsche SiSi-Werke v OHIM [2006] E.T.M.R. 41).¹⁹

While refusing the shape it was held: “The features characterising the trade mark sought have no technical or ergonomic function, it should be noted that, even if that were proven, it cannot affect the lack of distinctiveness of the trade mark sought. In so far as the relevant public perceives the sign as an indication of the commercial origin of the goods or services, whether or not it serves simultaneously a purpose other than that of indicating commercial origin, for example a technical purpose, is unrelated to its distinctiveness.” (KWS Saat v OHIM (Shade of orange) [2002] E.C.R).²⁰

SMELL TRADE MARKS

A sign consisting of the smell of ripe strawberries was refused under absolute grounds due to insufficient graphical representation. Eden SARL, the applicant represented this sign graphically by a picture of a red strawberry and the words “smell of ripe strawberries”. The Court held:

“Although olfactory recollection is one of the most reliable aspects of the human memory, giving traders a strong incentive for using such signs to identify their goods, the graphical representation requirements cannot be relaxed for olfactory signs so as to achieve the registration of signs which, by their nature, are difficult to represent graphically.

Sieckmann judgement refusing the registration of smell as a trade mark set a new trend defining the qualifications of a graphical presentation: “a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”

The refusal is a result of lack of capability to prove the requirement of a graphical representation: “A combination of the description of the smell and the picture of the strawberry was insufficient to

constitute a graphical representation, since a combination of methods of representation not capable, in themselves, of satisfying the requirement of graphic representation was not able to satisfy those requirements. At least one of the elements in the representation must satisfy all the requirements. Also, the picture did not convey information additional to the description in words. Although it was claimed that the picture illustrated the state of ripeness of the strawberry, since this was already clear from the wording, the picture and wording together did not add up to more than the sum of their parts.” (Eden SARL v Office for Harmonisation in the Internal Market [2006] E.T.M.R. 14).²¹

TOUCH TRADE MARKS

German Supreme Court’s refusal of Touch Mark under absolute grounds set up a standard for all non-conventional marks to fulfill the requirements of the graphic representation of a trade mark by describing in sufficiently precise and definite terms. Referring to basic definition of a trademark that is capable being represented graphically it was held: “Signs which are suitable to distinguish the goods or services of a specific enterprise from those of other enterprises can be eligible for trade mark protection. The principal function of the mark is to guarantee to a consumer or ultimate customer the original identity of the product or service labelled with the mark, in that it enables him to distinguish this product or service from the products or services of other origin. The prerequisite for a sign to function as a distinguishing means is that the object claiming protection as a trade mark can be perceived by a third party, that is to say, has an effect upon the latter's sensory organs only refers to signs which are perceptible in a visual sense. However, signs which, like the acoustic signs or like odours, are perceptible via other sensory organs, are not excluded from trade mark protection. Consequently, a sign which is perceptible via the sense of touch can also basically be a trade mark. It is requisite for the general pre-requirements applying to a trade mark's eligibility for protection, such as, in particular, the independence of the mark, to be fulfilled by the product. In order to fulfil the requirement of an abstract suitability as a distinguishing means, a sign may not be a function-based, compulsory component of the product, but must possess elements which extend beyond its basic form, which can by all means be abstracted from the product mentally, if not physically, and can fulfil the identifying function of the mark. This requirement can basically be fulfilled by touch marks and three-dimensional marks, since elements or properties of a design, whose perception is intended to be obtained as a mark via the sense of touch, can be abstracted from the product in a mental sense.” (Haptic Trade Mark Application [2008] E.T.M.R. 16).²²

SLOGAN AS A TRADE MARK

Advertising slogan with descriptive quotation have been accepted as trade mark in the world of vigorous competitive nature of enterprises: “However, a sign which, like an advertising slogan, fulfils functions other than that of a trade mark in the traditional sense of the term is distinctive for the purposes of Art.7(1)(b) of Regulation 40/94 only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin. .” (Fieldturf v OHIM—LOOKS LIKE GRASS ... FEELS LIKE GRASS ... PLAYS LIKE GRASS [2004] E.C.R. II-1023).²³

An advertising slogan if continuously used is accepted for registration: “According to settled case law, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. A mark which, like an advertising slogan, fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive if it may be perceived immediately as an indication of the commercial origin of the goods or services in question so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the proprietor of the mark from those of a different commercial origin. (Best Buy Concepts v OHIM (BEST BUY) [2003] E.C.R. II-2235).²⁴

THE RIGHT CONFERRED BY TRADE MARK LAW

It should be understood that, in view of the “spirit of trade mark law, the term “absolute” means that the owner is assured of protection independently of the risk of confusion, since in such situations there is a presumption that this is the case, and not that the protection of the owner is assured in respect of all parties and in all circumstances.” (Claude Ruiz-Picasso v OHIM, Daimler Chrysler AG [2006] E.T.M.R. 29).²⁵

“Ownership of a trade mark confers a monopoly on its owner, so that, in principle and as a general rule, he is able to prevent its use by others. Such legal protection is even more justified in the case of a proper name since anybody can be taken advantage of.” (Adam Opel AG v Autec AG [2007] E.T.M.R. 33).²⁶

“The exclusive right was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions and that, therefore, the exercise of that right must be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods.” *ibid.*²⁷

“Trade mark rights are granted in order to guarantee the possibility of control over the quality of goods, not the actual exercise of that control. A trade mark therefore permits the proprietor not only to prevent goods which are not produced by him from appearing to be so (the function of guarantee of origin) but also to prevent the quality of goods produced by him being changed, in a manner unauthorised by him, at the marketing stage after the goods have first been placed on the market on his behalf or with his consent.” (Copad v Christian Dior [2009] Bus LR 1571).²⁸

“The proprietor of a trade mark is entitled to prohibit a third party from using, without the proprietor's consent, a sign identical with that trade mark when that use is in the course of trade, is in relation to goods or services which are identical with, or similar to, those for which that trade mark is registered, and affects, or is liable to affect, the functions of the trade mark. The question whether that function of the trade mark is adversely affected when internet users are shown, on the basis of a keyword identical with a mark, a third party's ad, such as that of a competitor of the proprietor of that mark, depends in particular on the manner in which that ad is presented.

The function of indicating the origin of the mark is adversely affected if the ad does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party. In the case where a third party's ad suggests that there is an economic link between that third party and the proprietor of the trade mark, the conclusion must be that there is an adverse effect on the function of indicating origin." (Sarl v Céline SA (C-17/06) [2007] E.C.R. I-7041).²⁹

RIGHT OF UNREGISTERED TRADE MARK

The unregistered sign must be used in the course of trade in order to give the opponent a right to file an opposition. "Use in the course of trade requires specific use within the context of the trade mark law. Moreover, use in the course of trade must occur before the date of application for the trade mark." (MNG Holding AS' Application [2006] E.T.M.R. 73).³⁰

Freedom to compete or just to trade is an important foundation of modern world and should only be restricted, including by trade mark law, where necessary. "Trade marks need protection to play their vital part in a competitive economy, but it is very questionable whether they need more protection than for that purpose." (Jacob L.J.: L'Oreal SA and Others v Bellure NV and Others [2007] EWCA Civ 968).³¹

"The requirement of genuine use is fulfilled where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. This requirement is not fulfilled where the mark is used fictitiously for the sole purpose of preserving the rights conferred by the mark." (Intel Corporation v Empresa Nacional de Telecomunicaciones SA [2006] E.T.M.R. 69).³²

"A proprietor may not prohibit such use if it cannot affect his own interests as proprietor of the mark, having regard to its functions. The exclusive nature of his right can be justified only within those limits." (Tudapetrol v (CEFIC) [2007] E.T.M.R. 36).³³

LIMITATION OF PROTECTION

According to a basic principle of European trade mark law, the protection enjoyed by a registered trade mark is limited to products or services which are similar or identical to the products or services in respect of which the trade mark is registered. "It is clear from the above provisions that protection in respect of dissimilar goods or services constitutes an exception to one of the fundamental principles of European trade mark law." (Copad SA v Christian Dior Couture SA and others [2009] Bus. L.R. 1571).³⁴

"Trade mark law cannot impose wider limits on use of the trade mark as regards third parties than as regards a licensee, who knows the extent of his rights as limited by the agreement. There is no apparent reason why the rights conferred by a trade mark should be limited in scope in respect of a licensee only, but take full effect in respect of a third person who is not a party to the licence agreement." (Copad SA v Christian Dior Couture SA and others [2009] Bus. L.R. 1571).³⁵

DILUTION OF TRADE MARK LAW

“The brand is pitted against its own weight and popularity. The technique entails using well-known, registered trade marks of large corporations, slightly altered but still recognisable as an adaptation of the original brand. The purpose, the applicant explains, is to lampoon the brands; to make a statement about the company's policies or practices; to probe issues bearing on the broader society; to assert free expression and in so doing to challenge the inordinate use of trade mark laws to silence expressions that are unflattering about brands.” (Miss World Ltd v Channel Four Television Corp [2007] EWHC 982 (Pat) ³⁶

“I do not see that trade mark law need be so oppressive and all powerful. I would hold that a “link” requires more than such a tenuous association between the two marks. If a trade mark for particular goods or services is truly inherently and factually distinctive it will be robust enough to withstand a mere passing bringing to mind when it or a similar mark is used for dissimilar goods or services. The average consumer is a reasonably sensible individual. He is used to lots of trade marks in different fields—some of which may resemble trade marks for other fields.” (JACOB J in Intel Corp v CPM United Kingdom Ltd [2007] EWCA Civ 431)³⁷

“The more the mark is well known, the greater the number of operators who will want to use similar signs. The presence on the market of a large quantity of goods covered by similar signs might adversely affect the trade mark in so far as it could reduce the distinctive character of the mark and jeopardise its essential function, which is to ensure that consumers know where the goods concerned come from.” (Adidas v Marca [2008] Bus. L.R. 1791).³⁸

TRADE MARK LAW AND INTERENT

“Although it thus proves to be the case that advertisers on the internet can, as appropriate, be made liable under rules governing other areas of law, such as the rules on unfair competition, the fact nonetheless remains that the allegedly unlawful use on the internet of signs identical with, or similar to, trade marks lends itself to examination from the perspective of trade mark law. Having regard to the essential function of a trade mark, which in the area of electronic commerce, consists in particular in enabling internet users browsing the ads displayed in response to a search relating to a specific trade mark to distinguish the goods or services of the proprietor of that mark from those which have a different origin, that proprietor must be entitled to prohibit the display of third-party ads which internet users may erroneously perceive as emanating from that proprietor.” (Google v Louis Vuitton [2010] E.T.M.R. 30) ³⁹

“A domain name is not just an address, but also carries other functions apart from the technical one. Referring to the owner of the domain name, a domain name attracts internet users to visit that specific website. Therefore, a domain name's functions are similar to those of a trade mark, because they facilitate differentiation and remembering, they also provide information, show identity or origin and carry an advertising function. This way a domain name also carries proprietary value and in principle it can be an object of intellectual property rights, regardless of the rules.”(Gulf International Lubricants v Gulf Estonia [2008] E.T.M.R. 26).⁴⁰

“In respect of the function of indicating origin, the Court held that the question whether that function is adversely affected when internet users are shown, on the basis of a keyword identical with a mark, a third party’s ad depends in particular on the manner in which that ad is presented. The function of indicating the origin of the mark is adversely affected if the ad does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party in the case where a third party’s ad suggests that there is an economic link between that third party and the proprietor of the trade mark, the conclusion must be that there is an adverse effect on the function of indicating origin. Similarly, in the case where the ad, while not suggesting the existence of an economic link, is vague to such an extent on the origin of the goods or services at issue that normally informed and reasonably attentive internet users are unable to determine, on the basis of the advertising link and the commercial message attached thereto, whether the advertiser is a third party vis-à-vis the proprietor of the trade mark or, on the contrary, economically linked to that proprietor, the conclusion must also be that there is an adverse effect on that function of the trade mark. (Google France [2010] E.T.M.R. 30).⁴¹

TRADE MARK LAW AND PASSING OFF

On balance, bearing in mind the object of a trade mark law, which was probably narrower than that of the law of passing off, the court was inclined to take the stricter approach that the infringing use had to be trade mark use. For the purposes of the appeal, however, whichever approach was adopted would lead to the same result. (City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier [2010] F.S.R. 14).⁴²

“In trade mark law and the law of passing-off, the question of whether there is infringement or passing-off is not dependent solely on the names; whether goods or services are similar or identical or whether there is a common field of activity can be determinative. (MB Inspection Ltd v Hi-Rope Ltd [2010] R.P.C. 18)..⁴³. “Fair trading, ultimately, is what trade mark law is about.” (Judge David Edwards).⁴⁴

“For the interpretation of the notion of genuine use, account must be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, insofar as there is no sound economic reason resulting from an actual function of the mark on the market. However, the purpose of that provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks.” (Goulbourn v OHIM, Redcats (Silk Cocoon [2003] E.C.R. II-789).⁴⁵. “It had to be remembered that the reasonable businessman was not an expert on trade mark law, or jurisdiction.” (Floyd J. Best Buy v Worldwide Sales [2010] F.S.R. 35).⁴⁶

STRICT RULES FOR MEDICINAL AND PHARMACEUTICALS

In a landmark case in India a judgement draws clear lines which cannot be crossed by an examiner of a Registry while examining a trade mark for pharmaceutical trade mark: "The judgment of the Supreme Court in Cadila has to be read in its entirety. The width and ambit of the test laid down by the Supreme Court cannot be restricted by an artificial process of construction which focuses attention only upon the observations contained in the aforesaid extract. In fact, in a subsequent part of the judgment, Supreme Court held thus:

"What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be at par with cases involving nonmedicinal products. A stricter approach should be adopted while applying the test to Judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of nonmedicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effect on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effect on the public health." (Wyeth Holdings Corp v Burnet Pharmaceuticals [2008] F.S.R. 24, quoting Supreme Court judgment in Cadila.)⁴⁷

MULTIPLE FUNCTIONS OF TRADE MARK

There are many functions of a trademarks and even new functions are emerging like communicational and advertising in addition to essential function of indicating the origin of a trade mark as well as quality: "It seems to me to be simplistic reductionism to limit the function of the trade mark to an indication of trade origin ... Experience teaches that, in most cases, the user is unaware of who produces the goods he consumes. The trade mark acquires a life of its own, making a statement ... about quality, reputation and even, in certain cases, a way of seeing life. When I examine the current functioning of the market and the behaviour of the average consumer, I see no reason whatever not to protect those other functions of the trade mark and to safeguard only the function of indicating the trade origin of the goods and services." (Advocate General Colomer Arsenal Football Club Plc v Reed [2003] Ch).⁴⁸

Now a days products, goods and services depend heavily on advertising and promotion. In such a time when a huge funds both public and private are diverted in order to attract customer the advertising function of the trade mark must be highlighted: "The new law on trade marks protects the advertising function of trade marks, as well as their distinctiveness. Trade mark law now protects the interests of entrepreneurs, as well as advertising investment. To this end, the rules concerning establishing infringement through association have been extended beyond the protection of well-known marks in order to cover marks that were simply "known".

The new laws concerning trade marks pursue, to an even greater degree, the purposes of protecting a sign not only for its distinctive nature but rather for its advertising function, of protecting the professional interests of entrepreneurs, of safeguarding the business and advertising investments

made in order to maintain and increase its selling power on the market. In this respect, it is paradigmatic that the rules protecting against infringement due to association have been generalised and extended from the highly recognised trade mark to the simply known trade mark. Therefore, the duty to protect consumers against the risks of being deceived implicit in such an evolved system of rules remains assigned to the different sectors of market law.” (Adidas-Salomon v Gruppo Coin SpA, [2006] E.T.M.R. 39).⁴⁹

A mark which provides only informative function is not registrable: “Law on Trade Marks provides that the signs which perform only informative function are not registrable. This means that a trade mark must have features that will give the subject goods an individual character on the market and will put those goods into ordinary customers' minds.” (F... Sp. z. o. o.'s Application [2007] E.T.M.R. 16).⁵⁰

The ECJ looks at the function of a trade mark not whether the use is trade mark use. “Unchecked use of the mark by a third party, which is not descriptive use, is likely to damage the function of the trade mark right because the registered trade mark can no longer guarantee origin, that being an essential function of a trade mark.” (Aldous L.J. in Arsenal Football Club Plc v Reed (No.2) [2003] R.P.C. 39).⁵¹

“However, it is, I think, now recognised that a trade mark has legitimate functions apart from merely identifying and guaranteeing trade origin. The proprietor of a trade mark has a legitimate interest in protecting the image that the registered mark represents.” (ECJ in Parfums Christian Dior SA v Evora BV [1997] E.C.R. I-1603).⁵²

Asserting quality as an important function of trade mark it has been held “It is a truism that a registered trade mark's primary function is as an indicator of the origin of the goods or services with which it is associated. It is equally a truism that its protection does not cease there. It also acts as a guarantee of such quality as the trade mark owner is willing to associate with the mark. Thus, if the trade mark owner is in the habit of turning out high-quality goods under his or her mark, that becomes part of the commercial value with which the mark is associated because the nature of the goodwill then becomes associated with the mark and becomes a relevant factor in considering what the mark actually protects.

“A sign which was at one time capable of acting as a trade mark may, by reason of the use thereof by third parties as a customary designation of a product, lose the capacity to perform the essential function of a trademark, and in particular that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition ...” (Alcon Inc v OHIM [2003] ECR II-411).⁵³

It must be pointed out that the primary function of a mark is unquestionably that of an “indication of origin”. “The fact remains that a mark also acts as a means of conveying other messages concerning, inter alia, the qualities or particular characteristics of the goods or services which it covers or the images and feelings which it conveys, such as, for example, luxury, lifestyle, exclusivity, adventure, youth. To that effect the mark has an inherent economic value which is independent of and separate

from that of the goods and services for which it is registered. The messages in question which are conveyed inter alia by a mark with a reputation or which are associated with it confer on that mark a significant value which deserves protection, particularly because, in most cases, the reputation of a mark is the result of considerable effort and investment on the part of its proprietor. A mark with a reputation is protected with regard to any application for an identical or similar mark which might adversely affect its image, even if the goods or services covered by the mark applied for are not similar to those for which the earlier mark with a reputation has been registered.” (Sigla v OHIM [2007] E.T.M.R. 79).⁵⁴

A merely decorative mark cannot be registered: “If the average consumer regarded the sign as having a merely decorative purpose, he would not identify the sign with the commercial origin of the goods or services, from which it follows that the sign would not be suitable for performing its principal function and its value as a mark would therefore be called into question. Otherwise, if it were possible to deduce the origin of the goods and services, the contrary situation would arise.” (Adidas-Salomon v Fitnessworld Trading [2004] Ch 120).⁵⁵

Link is a significant function of the trade mark between the ‘maker’ and the ‘made’: “A significant function of a trade mark is to link goods or services to a source of supply, whether the original producer or a commercial intermediary. That is in the interest of both supplier and consumer. The supplier can establish a reputation, which is protected from usurpation by competitors, for products bearing the mark, and can thus promote trade in those products. Likewise, the consumer can make purchasing decisions on the basis of the qualities he perceives as attached to the mark. Since those decisions may be negative, suppliers have an incentive to maintain and improve the quality of the goods or services supplied under the mark. A significant function of a trade mark is to link goods or services to a source of supply, whether the original producer or a commercial intermediary. That is in the interest of both supplier and consumer. The supplier can establish a reputation, which is protected from usurpation by competitors, for products bearing the mark, and can thus promote trade in those products. Likewise, the consumer can make purchasing decisions on the basis of the qualities he perceives as attached to the mark. Since those decisions may be negative, suppliers have an incentive to maintain and improve the quality of the goods or services supplied under the mark. But that is not true in all circumstances. In an apparent paradox, the best known trade marks are particularly vulnerable to the existence of similar marks even in highly dissimilar product areas, where actual confusion is unlikely. Moreover, such marks frequently perform functions which go beyond linking goods or services to a uniform source. They present a powerful image of quality, exclusivity, youth, fun, luxury, adventure, glamour or other reputedly desirable lifestyle attributes, not necessarily associated with specific products but capable of presenting a strong marketing message in itself.” (Advocate General E. Sharpston in (Intel Corp Inc v CPM United Kingdom Ltd, ETMR).⁵⁶

INFRINGEMENT OF TRADE MARK

Infringement is established when basic function of the trade mark is violated: “To constitute infringement the offending use must therefore be such as to affect or be liable to affect the

functions of the trade mark, and in particular its essential function of guaranteeing to consumers the origin of the goods. This will be the case, in particular, where the use complained of is such as to create the impression that there is a material link in the course of trade between the goods and the undertaking from which they originate. The question is whether consumers, including consumers confronted with the goods after they have left the point of sale, are likely to interpret the sign as designating or tending to designate the undertaking from which they originate.” (Kitchen J. in . Julius Sämann v Tetrosyl Ltd [2006] EWHC 529 Ch).⁵⁷

“In order to establish infringement a claimant must therefore prove that the defendant is using the sign in issue in a trade mark sense, that it to say as an indication of origin or so as to create the impression that there is a material link in the course of trade between the goods or services in issue and the trade mark proprietor. Purely descriptive use cannot infringe. If the sign is used in such a way that it both denotes origin and acts as a description — the no man's land identified by Lord Walker — then, it is submitted, such use will also infringe if the use is liable to jeopardise the guarantee of origin which constitutes the essential function of a trade mark.” (Kerly on Trade Marks, 14th ed.).⁵⁸

My immediate reaction is that it is very difficult generally to disentangle commercial value, properly understood, from the goodwill and repute that is associated with the mark. This case must, I think, be viewed as a case in which the point that was made by the alleged infringement was so is connected from the ordinary function as an indication of origin and as an indicator of quality fulfilled by the mark that it was fanciful to say that the mark qua mark was affected in any way. That is a finding of fact, not a proposition of law, and it is plainly a consideration which must be, so far as the guarantee conveyed by the South African Constitution is concerned, assessed as a question of fact in every case.” (Pumfrey J.: Miss World Ltd v Channel Four Television Corp [2007] EWHC 982 (Pat)).⁵⁹

CONCLUSION

Trade mark has been established since its inception as a branch of law as an asset of considerable economic value: “In a relatively superficial analysis, trade mark law is imbued with at least two antithetical approaches when it comes to resolving conflicts which arise between marks. The first approach regards signs as mere intangible assets which must be protected by registration, emphasises their nature as rights in rem and affords precedence to jus civilis aspects, particularly the rules on the right of ownership. The second, by contrast, emphasises the economic perspective, drawing attention to their undeniable links with the regulation of trade, specifically the rules on competition (as legal monopolies), whose principles delimit the powers derived from registered trade marks.

Thus, in the event of a dispute over a sign, the first approach described tends to protect a trade mark proprietor by reason of the primacy of the rights of ownership, while the second generally protects the principle of free trade and the rules of competition.”(European intellectual Property Review,2010.).⁶⁰

Ideally, trade mark law will also develop in such a way that one day the one international law will totally replace national laws; but on a realistic assessment of present conditions, this aim cannot be

achieved immediately or perhaps entirely. It is not therefore realistic to fix a specific time limit within which the owners of national rights must convert these rights into applications for Community rights)

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HISTORY OF DESIGN REGISTRATION LAW IN INDIA (1872-1932)

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The history of design law in India did not commence its journey hand in hand with the act for exclusive privileges to Inventors in the year 1856.¹⁵ Even in the Act of 1856 and 1859, the Design Law failed to get its berth although legal provisions for the protection of design in the United Kingdom had made earlier in 1842(5 & 6 Vict C 100).¹⁶ In order to wipe out these anomalies, the law makers of the time felt the need for protection of design in India. Accordingly, the protection for design was introduced through the Act XIII of "Patterns and Designs Act" passed in 1872, which received the assent of Governor General in Council on the 28th April, 1872.

Mr Henry George Graves, Former Controller of Patents and Designs in India (01.01.1912 – 27.11.1919)¹⁷ in his report on the Patent Office during calendar year 1911 published vide No.1289-P dated Calcutta, the 26th April, 1912 remarked "The *registration of designs, which was also effected under the 1888 Act, has a shorter history as it only dates back to the Patterns and Designs Protection Act of 1872.*"¹⁸

Pattern and Design Act, 1872(Act- XIII of 1872)

This Act merely amended Act XV of 1859 where following features were incorporated:

- i) Include within the meaning of "new manufacture", any new or original pattern and design, or the application of such pattern to any substance or article of manufacture
- (ii) Provide that the term of exclusive privilege in the case of a pattern or *design* should be limited to "three years and no more"; and
- (iii) invest persons, who had acquired in the United Kingdom "exclusive privileges" in respect of patterns or designs with the same privileges and civil remedies appertaining thereto in India also, in respect of same patterns and designs.

Protection of Inventions Act, 1883(Act- XVI of 1883)

This Act introduced a provision in the 1859 Act for the protection of inventions exhibited in the Exhibitions in India. According to it, if within six months from the opening of an exhibition a person being an inventor and exhibitor of any manufacture exhibited at the Exhibition, petitioned to the Governor General in Council under Act XV of 1859 for leave to file a specification the

¹⁵ The History of Patent System in India (1832-1947) –Vol. 1 Issue 1, September, 2014- IP Expression

¹⁶ Report of the Patents Enquiry Committee (1948-50)

¹⁷ Indian Patents Centenary (1856-1956) – SOUVENIR-PATENT OFFICE, CALCUTTA

¹⁸ Report on the Patent Office, No. 1289-P, dated Calcutta, the 26th April, 1912 – Extract from *Gazette of India*, Part-II, dated 25th May, 1912

circumstance that the invention was publicly or made publicly known at any time after the opening of the exhibition would not prevent the invention from being deemed to be a new invention under that Act.

Exhibition- this was defined to mean the International Exhibitions of 1883 and 1884 held at Calcutta and also any exhibition held in India which the Governor General in Council by notification in the Gazette of India declared to be calculated to promote Indian art or industry and to prove beneficial to the mercantile, agricultural or industrial classes of Her Majesty's subjects in India.

The Inventions and Design Act, 1888-(Act-V of 1888)

Design – It means some peculiar shape, configuration or form given to an article, or arrangement of lines or the like used on or with an article, but not the article itself:

Copyright- It means the exclusive right to apply a design to an article.

Proprietor- It means that the author of any new and original design shall be considered the “proprietor” thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case that the person shall be considered the “proprietor” and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to an article, either exclusively of any other person or otherwise, and also every person on whom the property in the design or the right to the application thereof shall devolve, shall be considered the “proprietor” of the design in the respect in which the same may have been so acquired, and to the extent, but not otherwise.

Secretary – Under this Act, Secretary means a secretary to the Government of India appointed by the Governor General in Council to discharge the functions of the secretary under this Act, and includes any Under Secretary, Assistant Secretary or other officer subordinate to the Government of India to the extent which such officer may be authorised by general or special order of the Governor General in Council to discharge any of those functions.

High Court – has the meaning assigned by the Code of Criminal Procedure, 1882¹⁹, in reference to proceedings against European British subjects.²⁰

District Court- has the meaning assigned to that expression by the Code of Civil Procedure.

¹⁹ Act V of 1898 in the revised edition as modified up to 1st April, 1900 (Inventions and Designs Act, 1888 (Act V of 1888), Government of India, Department of Commerce and Industry, Calcutta, Office of the Superintendent of Government Printing, India AND The Patent Office, India – 1907)

²⁰ In the N.W. Frontier Province, the Chief Court of the Punjab is the High Court in respect of proceedings under this Act-see s.6(1) (c) of the N.W. Frontier Province Law and Justice Regulation, 1901 (VII of 1901), Punjab Code, Ed. 1903. (Inventions and Designs Act, 1888 (Act V of 1888), Government of India, Department of Commerce and Industry, Calcutta, Office of the Superintendent of Government Printing, India AND The Patent Office, India – 1907)

Application for order for registration of design – As per provisions of this Act, any person whether a British subject or not claiming to be the proprietor of any new and original design not previously published in British India may apply to the Governor General in Council for an order for the registration of design.

The application must be in writing in the form or to the effect of the fifth schedule and must contain a statement of the nature of the design and be accompanied by as many copies of **drawings, photographs or tracings** thereof not being fewer than four as may be required by the rules for the time being in force.

Samples of the design will be admitted instead of drawings in the case of textile or other substances which can be handled like sheets of paper.²¹

It must be left with or sent by post to the Secretary and the date of the delivery or receipt thereof in the office of the Secretary shall endorsed thereon and recorded in that office.

Registration of Design - Upon the application, the Governor General in Council may after such inquiry as he thinks fit make an order authorising the registration of the design under the Act.

Register of Design- When an order has been made under Section 52 of sub section (1) of the Act, the Secretary shall cause the design to be registered in a book to be kept by him for the purpose and to be called the **register of design**.

The date of registration shall be recorded in that register.

Acquisition of Copyright- When a design is registered, the proprietor thereof shall subject to the other provisions of this Part have the copyright in the design during five years from the date of registration.

Marking Registered Design- Before delivery on sale of any article to which a registered design has been applied, the proprietor of the design shall cause the article to be marked with the word “registered” either in full or in an abbreviated form.

If he fails to cause the article to be so marked, the copyright in the design shall cease unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Exhibition- Same as Act of 1883.

Mutation of Names in Register of Design- Any person in whom the copyright in a design has become vested may apply to the Secretary for the entry of his name in the register of designs as proprietor of the copyright and the Secretary may if he sees fit cause the entry to be made.

Suit for infringement of copyright- The registered proprietor of a design may institute a suit in the District Court for the recovery of any damages arising from the application by any person to any article of the design or of any fraudulent or obvious imitation thereof for the purpose of sale, or from the publication, sale or exposure for sale by any person of any article to which the design, or

²¹ As per Contents 16 of the Memorandum and Directions for the guidance of parties applying for protection of Inventions and Designs.(The Inventions and Designs Act, 1888(Act V of 1888)

any fraudulent or obvious imitation thereof, has been applied, that person knowing or having reason to believe that the proprietor had not given his consent to such application.

Registration of cessation of copyright- When from the expiration of the term of a copyright or from any other cause, the copyright in a design has ceased, the Secretary shall cause an entry with respect to the cessation of the right to be made in the register of designs.

Rectification of register of designs- A High Court may on the application of any person aggrieved by an entry in the register of designs, or by the omission of an entry therefrom, make such order for the rectification of the register as it thinks fit.

Fees- As per Section 62 and the Sixth Schedule of this Act, following fees structure were made:-

Sl. No	Head	Rs	A.	P.
01	For registration of a design under Section 51 of this Act	10	0	0
02	For a mutation of names in the register of designs under Section 56 of this Act	5	0	0
03	For the inspection of any book or other document which is open to inspection under Part-II of this Act	1	0	0
04	For Copies			
	(a) When the number of words copied does not exceed four hundred	1	0	0
	(b) For every hundred words in excess of four hundred	0	4	0
	(c) Of drawings, photographs or tracings	Cost according to agreement		
05	For certifying copies – For every hundred words	0	2	0

Indian Patents & Designs Act, 1911(Act-II of 1911)

As per words of Mr H.G. Graves “The Indian Patents and Designs Act, 1911, II of 1911, which will in future regulate the patenting of inventions and the registration of designs.”²²

Application for registration of Designs- the Controller may, on the application of any persons claiming to be the proprietor of any new or original design not previously published in British India, register the designs under Part- II of this Act.

The application must be made in prescribed form and manner accompanied with prescribed fee and must be left at the Patent Office.

²² Report on the Patent Office, No. 1289-P, dated Calcutta, the 26th April, 1912 – Extract from *Gazette of India*, Part-II, dated 25th May, 1912

Refusal of design application-According to this Act, the Controller may, if he thinks fit, refuse to register any design presented to him for registration; but any person aggrieved by any such refusal may appeal to the Governor General in Council.

Abandon of design application-As per this Act, an application which owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

Date of registration of design- As per provision of this Act, a design when registered shall be registered as of the date of the application for registration.

Registration of design in new classes- Through this Act, first time concept of class has been introduced. Accordingly, the same design may be registered in more than one class and in case of doubt as to the class which a design ought to be registered; the Controller may decide the question.

This Act further stipulates where a design has been registered in one or more classes of goods, the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated –

- (a) on the ground of the design not being a new and original design, by reason only that it was so previously registered; or
- (b) on the ground of the design having been previously published in British India, by reason only that it has been applied to goods of any class in which it was so previously registered.

Certificate for registration of design- The Controller shall grant a certificate of registration to the proprietor of the design when registered.

Copy of design certificate- the Controller may in case of loss of the original certificate or in any other case in which he deems it expedient furnish one or more copies of the certificate.

Register of Design – There shall be kept at the Patent Office a book called the Register of Designs wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs and such other matters as may be prescribed.

Copyright in Registered Designs- When a design is registered, the registered proprietor of the design shall subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of five years.

If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

Requirements before delivery on sale- Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall-

- (a) (if exact representations or specimens were not furnished on the application for registration), furnish to the Controller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Controller may erase his name from the register, and thereupon the copyright in the design shall cease; and
- (b) Cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so, the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

The Act further states where a representation is made to the Governor General in Council by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Governor General in Council may, if he thinks fit, by rule under this Act, dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as he thinks fit.

Effect of disclosure on copyright- The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design and the disclosure of a design in breach of good faith by any person other than the proprietor of the design and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

Inspection of registered Designs- During the existence of copyright in a design or such shorter period not being less than two years from the registration of the design as may be prescribed the design shall not be open to inspection except by the proprietor or a person authorised in writing by him or a person authorised by the Controller or by the Court and furnishing such information as may enable the Controller to identify the design and shall not be open to the inspection of any person except in the presence of the Controller or of an officer acting under him and on payment of the prescribed fee and the person making the inspection shall not be entitled to take any copy of the design or of any part thereof:

Provided that where registration of a design is refused on the ground of identity with a design already registered the applicant for registration shall be entitled to inspect the design so registered.

Open to public for Inspection – After the expiration of the copyright in a design or such shorter period as aforesaid the design shall be open to inspection and copies thereof may be taken by any person on payment of the prescribed fee.

Different periods for different classes of goods- This Act provides different periods for different classes of goods.

Information as to existence of copyright- On the request of any person furnishing such information as may enable the Controller to identify the design and on payment of the prescribed fee the Controller shall inform such person whether the registration still exists in respect of the design and if so in respect of what classes of goods and shall state the date of registration and the name and address of the registered proprietor.

Provisions as to exhibitions- The exhibition at an industrial or international exhibition certified as such by the Governor General in Council or the exhibition elsewhere during the period of the holding of the exhibition without the privity or consent of the proprietor of a design or of any article to which a design is applied or the publication during the holding of any such exhibition of a description of a design shall not prevent the design from being registered or invalidate the registration thereof :

Provided that-

- (a) The exhibitor before exhibiting the design or article or publishing a description of the design gives the Controller the prescribed notice of his intention to do so; and
- (b) And the application for registration is made before or within six months from the date of the opening of the exhibition.

The Governor General in Council may by notification in the Gazette of India apply this section to any exhibition mentioned in the notification in like manner as if it were an industrial or international exhibition certified as such by the Governor General in Council and any such notification may provide that the exhibitor shall be relieved from the condition of giving notice to the Controller of his intention to exhibit and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the notification.

Piracy of registered design- During the existence of copyright in any design shall not be lawful for any person-

- (a) for the purpose of sale to apply or cause to be applied to any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof except with the license or written consent of the registered proprietor or to do anything with a view to enable the design to be so applied; or
- (b) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article

If any person act in contravention of this section, he shall be liable for every contravention-

- (a) to pay to the registered proprietor of the design a sum not exceeding five hundred rupees recoverable as a contract debt, or
- (b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof to pay such damages as may be awarded and to be restrained by injunction accordingly;

Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed one thousand rupees

When the court makes a decree in a suit under sub-section (2) , it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs.

Fees- As per Section 57, Rule 4 and the First Schedule of this Act and Rules, following fees structure were made:-

Sl. No	Head	Rs	A.
01	For registration of a design under Section 43 of this Act in Class 1 to 6	3	0
02	For registration of a design under Section 43 of this Act in Class 7 to 15	0	8
03	For registration of a design under Section 43 of this Act in Class 16	3	0
04	On request to extend copyright under Section 47 of this Act	10	0
05	On request to inspect under Section 50 of this Act	1	0
06	On request for information under Section 51 if this Act		
	(a) when number is given	2	0
	(b) when number is not given	4	0
07	On notice to Controller of intended exhibition of a design under Section 52 of this Act	5	0
08	Request for certificate under Section	2	0
09	Request to cancel or correct under Section 62 sub-section (b) & (c)	3	0
10	Request for entry in register under Section 63 of this Act	5	0
11	Request for entry of address under Section 63 of this Act	1	0
12	Entry of order of Court under Section 64 of this Act	3	0
13	Appeal under Section 43(4) of this Act	30	0

Indian Patents and Designs Rules, 1912

In exercise of the powers conferred by sections 57 and 77(1) of the Indian Patents and Designs Act, 1911 (Act-II of 1911), the Governor General in Council made this rule.

Main features of these rules are as follows:

Classification- For the purpose of the registration of designs and of these Rules, goods shall be classified in the manner specified in the fourth Schedule as given below.

If any doubt arises as to class to which any particular description of goods belongs, it shall be determined by the Controller.

Address for service- An address for service in British India shall be given in all applications and other communications to the Controller of in connection with designs. Unless such an address is given the Controller need not proceed with the examination of an application nor send any notice that may be required by the Act or these Rules.

Application- An application under section 43 of the Act for the registration of a design shall be made **on Form 14** and shall be accompanied by four copies of the design and shall be dated and signed by the applicant or his agent.

The application shall state the class in which the design is to be registered and the article or articles to which the design is to be applied. Where it is desired to register the same design in more than one class, separate application shall be made in each class.

If so required by the Controller, the applicant shall state the purpose for which the article is used and the material or predominating material of which the article is made and shall give a brief statement of the novelty claimed for the design.

Copies and specimens of designs- The four copies of the design which in accordance with rule 28 must accompany the application shall be exactly similar drawings, photographs, tracings or other representations of the design or shall be specimen of the design.

Each representation shall show the complete design and shall be on paper of a size of 13 by 8 inches and on one side only. Drawings or tracing shall be made in black ink.

When the specimens are not in the opinion of the Controller, suitable for record in the Office, they shall be replaced by representations.

If the Controller in any case so requires, he shall be supplied with one or more representations or specimens of the design in addition to those supplied with the application.

Where words, letters, numerals are not of the essence of the design they shall be removed from the representations or specimen.

Conclusion- “Design” a branch of intellectual Property Rights is not so focussed or discussed like “Patent”. However, the contribution of design in industrialisation cannot be minimised in any way. As a result, like the Patent Laws, provisions of design laws has a history which is not as old as Patent, but it is also equally important among the persons concerned in the system.

It is no denying fact that the origin and evolution of design laws in India is a British legacy. However, art and architecture in ancient and medieval India reached in a pinnacle of excellence. Frescos of Ajanta, Elora, Sanchi Stupa, Taj Mahal etc. reflect that technologies existed in ancient and medieval period which combined in its matrix, Civil Engineering, Architecture, Geological Sciences as well fine arts. Unfortunately, such technologies went into oblivion perhaps due to absence any proper protective mechanism for such intellectual properties. However, it is evident that some of the artisans inherited their ancestral technological knowledge which was handed down to them by their predecessors. Also, is true that while Indians believed in the maxim of open knowledge, a section of artisans relied upon unique kind protective mechanisms to shield their skills from unwarranted copying. The nature of such protective mechanism can be unearthed with thorough and extensive research in the field.

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INTELLECTUAL PROPERTY AND INDIAN ECOSYSTEM

By

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Intellectual property is a big jargon in India's corporate world today. It is being globally pronounced that India needs to develop an effective innovative ecosystem. The country is putting whole of its efforts to foster the environment for innovation and strong and steady economy with the vision to escalate productivity, economic growth and development and improve global competitiveness. India, in 2010, has declared years 2010-2020 as India's Innovative Decade. A high profile National Innovation Council has been established to develop innovative culture across the country. India, with its economy in transition, is facing various confrontations to integrate into the increasingly global production networks and to find their own niche in the increasingly global value chains. The most deterrent factor for development of innovation aura is multiple social challenges. Huge population in the country - second largest population in the world, the world's largest number of poor people, literacy rate as low as 70%, inadequate health and poor nutrition levels hinder economic aspirations of the country. In spite of these constraints the determined efforts by the country are fetching positive reforms in India's innovation culture. To be successful, we need to assign high priority to developing our own innovative capabilities, as well as our ability to absorb and adapt technological innovations from abroad, and to move up the value chain over time. Such an ecosystem with thrust and respect for innovation would reward transitional economy in India with creative confidence, facilitate partnership, commercialization of new technology and encourage entrepreneurship in young professionals.

Intellectual property is one of the key elements for growth, development and competitiveness of an economy of a country. Intellectual Property Rights form the major pillar of the trade related economic developments. Intellectual property system gives limited exclusive rights to inventors and thereby increases their chances to recover the often substantial upfront investments they need to make to generate innovations and to bring them to market. Intellectual property right system makes it possible for innovators to sell, license or give away the rights to their innovations to others, who may be better placed to exploit them. In other words, intellectual property rights are a key prerequisite for intellectual assets to emerge in markets. The system also encourages innovators to disclose their knowledge so that future innovators can build on it, thereby helping to accelerate the rate of innovation. Patents find significant position amongst intellectual properties, may be for the reasons: successful patent can generate huge revenue and patents form quest for research and development also contributing to economic development of a country. Patent policies have proved to be extremely important for several countries to develop.

A managing, protecting and enforcing intellectual property right in a country and also across the borders is a big challenge. Policymakers are shouldering the responsibility to ensure that practices and policies targeting improvements in the intellectual property regime are consistent with and integrated into a larger effort to improve the policy, legal and regulatory framework promoting innovation and competitiveness.

Intellectual property can contribute effectively to knowledge-based economic development only if the key stakeholders in the innovation process have the capacity to actually make optimal use of the intellectual property system. Strategic management of intellectual property can be a very important factor in managing the innovation process successfully. However, research organizations and small and medium sized enterprises frequently lack the skills and sometimes also the incentives to manage intellectual property strategically and to maximize its impact on innovation. Policies aimed at improving IP management capabilities at research organizations or small enterprises are unlikely to have a big impact unless the legal protection of IP is sufficiently strong and enforcement of IPRs is effective. Perhaps, these policies are unlikely to enhance economy-wide innovative capacity and competitiveness if potential innovators lack the awareness, skills or resources to access the legal IP system or to manage their IP judiciously. Efforts are underway to address simultaneously weaknesses in the IP regime along the entire spectrum from the management of IP in research organizations, enterprises and financial firms to the legal and institutional system for IP protection, and to IPR enforcement. The goal is to make SMEs and individual entrepreneurs more aware of the potential use of the IP system and the importance of having an in-house IP strategy, including both formal and informal means that responds to their specific and individual needs.

Probable reasons for the under usage of the formal IPR system, even by potentially or actually innovative SMEs, are primarily: first, the high costs of protection and enforcement; and, secondly, the lack of awareness by SMEs on how the IPR system works. Besides patents, innovative SMEs should have basic knowledge of the complete formal IP systems, including copyright, trademarks, industrial designs, geographical indications, utility models, trade secrets, and the relevant aspects of unfair competition legislation, as well as of informal means of protecting their competitive advantage. Smaller businesses are not aware of the benefits and the financial and strategic value of IP, and that in general, innovators and creators are not aware of most or all the categories of IP mentioned, and of the benefits associated with each type of IP protection.

On one hand it is argued that patent rights promote innovation because the patent system allows for returns on the inventive process. On the contrary, concerns have been raised that the patent system increases the costs of innovation and technology transfer because technological inputs will be more expensive when protected by proprietary rights.

The optimal level and impact of patents varies depending on the stage of economic development domestically. Considering transitional state of economy in India, Indian patent regimes should take into account market size and the imitative, adaptive nature of our country R&D. If standards of patent protection are too high, there is a risk that innovation could be adversely affected. Although the role of patent system in encouraging invention and innovation in developing and least-developed countries is arguable, one policy option available to us that could assist further with stimulating invention and innovation is greater use of patent information. Patent information comprises technical, legal, business-relevant and public policy-relevant information which is generally publicly available, free of charge. National and regional patent offices provide a vast repository of technical information that can be accessed free of charge. There is great potential for patent information focusing on a particular technology – known as patent landscapes – to contribute to the development needs of developing countries by identifying essential technologies, know-how, processes and methods that are potentially of use to them. Even though patent information is easily

accessible via the internet, this resource is used to only a small fraction of its potential for stimulating invention and innovation.

India is striving to build infrastructure and R&D capacity by using new ways of learning about new technologies rather than relying on imitation. These new approaches include opportunity to access information available online, the use of open access scientific journals and patent databases. India is implementing policies to provide strong legal protection to patents and for effective enforcement of intellectual property rights. Efforts are needed to increase awareness for potential innovators to equip them with skills or resources to access the legal IP system or to manage their IP judiciously which in turn will enhance economy-wide innovative capacity and competitiveness. Hence, there is a need for directed efforts to address simultaneously weaknesses in the IP regime along the entire spectrum from the management of IP in research organizations, enterprises and financial firms to the legal and institutional system for IP protection, and to IPR enforcement.

India has endeavoured to develop a successful policy in the pharma field. The patent policy pursued by India has made it emerge as a big international player in the generic drug market. However, patenting in pharma sector raises various concerns in a developing nation like India. The impact of pharmaceutical patents on health and access to medicines is one aspect to be considered while balancing the social value of invention and innovation needs against the enclosures created by intellectual property rights. In this context, India, being a developing country is facing humongous challenges on health and poverty front, has formulated its policies for patenting of pharmaceuticals in favour of social obligations of the nation, in line with the stipulations laid down in TRIPS. India's patent policy demonstrates that developing countries need to establish the fine line of balance between protecting intellectual property and public health issues. Since intellectual property rights are conferred by the Government to private parties, it is the prerogative of the Government as to what extent it wants these rights to be in the hands of private players. This has necessitated the implementation of a higher threshold of the judgement of inventive step, one among the three universal criteria to grant a patent, the other two being novelty and industrial applicability. Developing countries are facing increased pressure from developed countries to brace their efforts on the enforcement of intellectual property rights, most of these largely beyond international obligations as set out in the TRIPS Agreement.

India needs to have IPR infrastructure including IPR managers, IPR attorneys and IPR enforcement machinery to handle matters arising out of the grant of patents, to handle international pressure and to be at par with the developed countries. While the primary objective of a stronger system of patent protection and enforcement is to maximize the competitive gains from additional innovation and technology acquisition over time, with particular emphasis on raising innovative activity by domestic entrepreneurs and enterprises, upgrading patent protection alone is an insufficient condition to achieve this. Instead, the patent system needs to be strengthened within a comprehensive and coherent set of policy initiatives that optimize the effectiveness of patents and this can be actualized by further structural reform of enterprises, trade and investment liberalization, promotion of financial and innovation systems to commercialize new technologies, expansion of educational opportunities to build human capital for absorbing and developing technology and specification rules for maintaining effective competition in developing country markets.

PATENT AND TRADITIONAL KNOWLEDGE FOR DEVELOPMENT OF PHARMACEUTICAL INDUSTRY

By

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Abstract :

Traditional knowledge for drug discovery is a unique tool keeping in mind the utilization of bio resource for benefit sharing and generating IPR particularly patent right to face global competitors in post WTO era.

Key words : Patent System, Traditional Knowledge and Benefit Sharing

Introduction

Mankind has used natural resources for maintaining health and curing diseases. The plant and animal kingdoms provide numerous pharmaceutically exploitable compositions or compounds. Many of the presently available synthetic or partially synthetic medicines are directly or indirectly derived from natural resources. Well known examples are anti-inflammatory salicylic acid derivatives; narcotic analgesic opioids; anti-malarial quinines; antibiotics like gentamycins, macrolides, beta-lactams (penicillins), tetracyclins; anticoagulants (eg heparin), antihypertensives (reserpines), anti-migraine ergotamines; anti-neoplastics (vincristine, taxols, bleomycins, mitomycins); antitussive codeines, cardiotonic digitalin derivatives, vasoactive escin to name only a few.

Pharmaceutically exploitable compositions of natural origin are first identified by bioprospecting either by random screening methods or by a targeted approach using traditional knowledge. Potentially useful compositions are then studied by pharmacognosy that is the branch of pharmacology dealing with natural drugs and their constituents. Once a pharmacologically active component is identified, improvements are possible either through purification and standardisation (higher purity, known content) or identification of the pharmacophore (the part of the molecule responsible for the therapeutic action) and chemical modification of the lead compound in order to improve receptor selectivity, the efficacy-safety profile and drug pharmacodynamics.

BACKGROUND:

In the past, knowledge of pharmaceutically useful plants and animals were collected from the local populations and specimens of these species were collected and analysed. As a rule, there was no benefit for the holders and providers of traditional knowledge even if such knowledge did lead to commercial exploitation. Traditional knowledge was considered as heritage of the public domain that could be used freely in the creations and innovations, which in turn, gave rise to intellectual property rights. As a matter of fact, the indigenous population very often could not afford any of the 'modern' medicaments resulting from their contribution of traditional knowledge (TK).

The term 'traditional' does not imply that it is old or untechnical in nature, but tradition-based; it reflects the information that people in a given community have developed over time based on experience and adaptation to a local culture and environment. The term traditional refers also to the way the knowledge is created, preserved and disseminated. It is now recognised that TK is not static or fossilised. Every successive generation creates new knowledge. It is intimately linked to the biodiversity of local biotopes. Traditional communities have conserved but are not necessarily collective. Given the highly diverse and dynamic nature of traditional knowledge, it may not be possible to develop a singular and exclusive definition of the term. The concept of TK is conceived rather broadly, similar to the concept of 'invention'.

With the emergence of new technologies in applied biology, as for example-improved methods of bio prospecting, the possibilities of ex-situ utilisation of indigenous (genetic) resources and associated traditional knowledge are increasing. Traditional knowledge and especially traditional medicine has the potential of being translated into substantial commercial and humanitarian benefits by providing leads for development of useful products and processes in sectors like, botanical medicines industry, pharmaceutical industry, seeds industry for crop development, horticulture, crop protection industry, cosmetics and natural personal care industry and biotechnology industries in fields other than healthcare and agriculture.

Industrial Applicability:

Like in any industry, this utilisation begins with certain raw materials, which are processed through several steps of value-addition in order to produce a final product of potential commercial value. At each of these stages, human innovation and creativity and investments in research and development add value development; add value to the initial resource. However, if access to TK, including traditional medicine, is to be increased substantially, the natural (initial) resources, upon which such products and therapies depend, must be protected in order to prevent eg over-harvesting of wild plant populations and the ecological consequences. The biodiversity of the plant and animal kingdoms must be preserved as a source of potential future benefits for the local population and mankind as a whole, because of the strong interrelation between TK and biodiversity, one aspect of protecting TK lies in the conservation of biological diversity, the sustainable use of its components and fair and equitable sharing of benefits arising out of the utilisation of (genetic) resources, this is the aim of The Biodiversity Act 2002 and Rules 2004.

Benefit Sharing:

It is thus largely acknowledged that a share of benefits must accrue to creators and holders of traditional knowledge because of their initial contribution to the successive stages of value addition leading to the commercial exploitation and humanitarian benefits of the final health care product. The traditional way knowledge is created, preserved and disseminated in particular communities is quite different from the way intellectual property is handled in the EU or the US. The individuals and communities who excel and who have particular skills and knowledge related to traditional knowledge should be attributed rights for their contributions in order to promote and reward excellence and ensure equitable sharing of benefits. The on-going debate regarding

protection of traditional knowledge involves the different aspects of intellectual property rights like trademark, geographical indication, patent, copyright and related rights, trade secrecy agreements, plant variety protection, defensive disclosures including national laws and international.

Patent System:

One of the existing standards of protecting intellectual property is the patent system. The patent system was not established with the particular aim of protecting the rights of holders of traditional knowledge against unauthorised use of such knowledge. However, if correctly applied, it prevents patenting of traditional knowledge. The general aim of the patent system is to promote innovation by granting an exclusive right to the inventor for a certain period of time in exchange for disclosing the invention.

An invention shall be considered to be new if it does not form part of the state of the art. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description by use or in any other way before the date of filing of the Indian patent application. Traditional knowledge published or unpublished, but previously used, forms part of the state of the art. Consequently, traditional knowledge, if available to the public, fails to satisfy the criteria for patent protection (lack of novelty.) When the criterion of novelty is applied strictly, no patent will be granted on traditional knowledge and there will be no interference between the patent system and traditional knowledge holders (no negative effects to holders of TK).

However, the particular problem arising here for the search examiner is that prior art with respect to traditional knowledge is not always easily accessible. Another problem is that the laws of some countries do not consider information disclosed abroad in a non-written form to constitute prior art, which made it impossible in these countries to prevent the grant of patents for inventions known to traditional communities.

One possibility to prevent bio piracy at an early stage of the patent procedure is provided for in the The Patents Act, 1970, Section 25(1)—Observations by third parties:

(1) Following the publication of the Indian patent application, any person may present observations concerning the patentability of the invention in respect of which the application has been filed. Such observations must be filed in writing and must include a statement of the grounds on which they are based. That person shall be a party to the proceedings before the Indian Patent Office.

(2) The observations referred to in paragraph one shall be communicated to the applicant for or proprietor of the patent who may comment on them.

However, third party observation requires a constant survey of published applications, a tedious task. Furthermore, it is the task of the patent office to retrieve relevant prior art in order to guarantee the validity of granted patents and the legal rights and legal security of the public, including traditional knowledge holders. In some cases, traditional knowledge has never been made available to the public, and is therefore, patentable.

Conclusions:

In view of above findings and explanations it is clear that traditional knowledge is a useful tool for development of new formulations of drugs in the present IPR era subject to complying of requirements of The Biodiversity Act 2002 for benefit sharing with TK holders.

ICT patents in India and business strategies

By

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ICT (information and communication technology) field incidentally represents the most liberalized and most investor friendly industry. Extending from televisions, to computers originally and now subsuming such that most functionalities are being enabled/possible towards a single portable consumer electronics device, carrying out diverse functions. Though protected by patents, the ICT sector is going through such a transformative change worldwide that many devices are becoming irrelevant because of the very reason of the existence ICT sector (Moore's law is an observation that, over the history of computing hardware, the number of transistors in a dense integrated circuit doubles approximately every two years). A leading mobile phone maker once claimed to be world's biggest digital camera maker, only to sell out itself in a few years because the traditional mobile phone is being swallowed by the computer's industry, albeit in a miniature format. Personal gaming devices, portable music players, digital cameras , portable video players , navigation devices, chronographs, fitness devices , among others have all become/ are in the process of becoming irrelevant in their individual forms and are being integrated into a single device. It is this tsunami that anyone in the ICT sector should be prepared to face in order to survive. Strangely it is the patents held on these devices ,that came to the rescue as valuable assets when the device makers of ICT sector are selling out. The protection available in Europe / USA could not save the traditional telecom network gear firms underlying the fact that patents are just another business tool .New developments in smart phones aim to develop a free, open hardware platform for creating highly modular smart phones could be a further game changer. These developments envisage users swapping malfunctioning modules or upgrade individual modules as innovations emerge, providing longer lifetime cycles for a handset, and potentially reducing electronic waste. Game changer probably because of the level of "standardization" from user's perspective is so minimal in smart phones.

Case studies on ICT Patents:

A strong patent portfolio in India could not ensure success for a technology (cdma), probably because of rival gsm technology(is FRAND based, and hence less restrictive).
<http://www.forbes.com/2010/07/13/forbes-india-qualcomm-takes-on-india.html>

In spite of owning patents on dual sim mobiles many European telecom firms didn't introduce the dual sim mobiles in India initially (rather it was Indian firms who took the lead), which eventually led to the most European telecom firms exit from India. This brings another issue to discussion , failure to understanding local needs in spite of owning IP. The Indian mobile consumers are mostly pay as you go type (prepaid) unlike the contract type (postpaid) in Europe/USA. The other important factor probably for the demand of dual sim phones was lack of number portability forcing users to seek cost effective solutions.(Primary Sim was used for receiving calls and the secondary to make calls).

If world's leading furniture maker (IKEA) thinks of using material Locally available(coconut wood) in India to remain cost effective ,the same analogy holds good for ICT. Inventions made in India and made for India are certain to work, probably! Perhaps it is not the number of patents filed /granted that matters in India rather the strength / value of patents filed /granted that matter. Further it is not the grants that matter even pending patents are enabling business. A table given below tries to sum up what has been told above .

Patents (granted/ published) & respective Revenues (India) of some ICT firms

Firm	Published Applications in India (since Jan' 2005)	Granted Patents in India (since Jan' 2005)	Revenues* FY 2013 (Rs. Crores)
Apple	307	23	2890
Google	308	81	2076
Samsung	2450	791	11,328
Nokia	2193	342	9780
Blackberry	806	171	273.2

*Source: News Reports based upon Registrar of Companies data

(Disclaimer: The views expressed herein are based on the assimilation of facts, linked with the happenings in ICT sector), and every effort has been made to be objective.

INTELLECTUAL PROPERTY POLICY AND STRATEGY FOR COLLABORATION BETWEEN INSTITUTES AND INDUSTRY

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ABSTRACT:-

In India there is a huge research potential, and no dearth of talented persons in Industries, Institutes but there is very less IP (Intellectual Property) awareness and interactions compare to developed countries. Many faculties, scientists, highly educated persons do not know much about IPR such as patents, hence there is need for awareness of IP in academic & industries and collaboration activities to avoid duplication of research. There is an unprotected ocean of scientific Knowledge and technological information like published patents & granted patents which is open to public for further research & development. However, due to lack of awareness it is not known to them and thus is unutilised hence, there is a need to provide uniform basic IP education particularly with respect to Patents. The information related to IPR if made compulsory into all streams at undergraduate, school level will improve the awareness regarding these rights Industry-Institutions are currently faced with several problems like inadequate funding¹ of educational research, technical knowhow and hence it is necessary that there must be an IP policy and strategy to encourage, support and promote profit based on innovative technologies, business models to define the barriers, to identify the communication gaps, form IP cells and sharing of research and promotional measures to improve Institute-industry interactions. It is suggested that any Industry or Institute who will manufacture in India shall be eligible for expedited examination & grant of IPR like Patents, Trademarks etc. This will enable the inventor to commercialize the product early. Another route is to give compulsory percentage of share of royalty to inventors for his inventions. Income tax, service tax exemptions etc. may also be considered to make these attractive. Keywords:-Intellectual Property, strategy, policy, institutes, university, collaboration, research, basic IP education, duplication of research, royalty, tax

1. BACKGROUND & INTRODUCTION

In Indian institutes and industries, IP (Intellectual Property) awareness is very less compared to developed countries. Various professors, scientists, highly educated persons are not aware about IPR such as patents. Hence there is an urgent need to increase the IP awareness in academic & industries and their collaborative activities. ²IP has never been given much importance in institutes or industries, but after recent development of 1995, India signed international agreement like TRIPS,

PCT etc .after which the international patent filing has increased during the last 10 years. However, the growth of the filings by Indian applicants has not shown the same pace. Thus, to make the Indian applicants more competitive, there is need for Indian Industries-Institutes to find out the ways to create an internal IP policy or an IP cell to protect their IP's and improves the IP awareness culture in organization by interacting with each other. Further the communication gaps in academic & industries for technology sharing / mutual research etc. should be minimized which will avoid the duplication of research work. In India there is a huge research potential, talented person but comparatively the Indian patent filing is very less as compared to China, Japan, USA etc. Hence there is need to find out and reduce the gaps and to identify the problems in Institutes and industries for filing Patents and improve the relationships with Institute-Industry cooperation by way of agreements, joint research, meetings which can reduce the expenses in research and development.

In the Indian educational scenario, management and science colleges at present do not have IP management education and even if it is present very few of them are having as optional elective or chapter. IP education is required for science and management stream since, the students are having different creativity, and hence Basic IP education³ may be provided at school, undergraduate level in a student friendly manner. In some management and engineering college there is IP education, but there is no uniformity in the contents or the teaching methods. Thus, there is an imperative need to formulate a uniform course structure. Further it is highlighted that there is an acute shortage of resources like text books, case studies, resource persons i.e. lecturers and professors on the IPR topic. There is still much work to be done to integrate IP as part of management and science discipline and to increase the IP resources. The officials involved in enforcement also do not have awareness about IP because of which, the potential of infringement is high. Hence there is need to develop IP management capabilities, the formulation of IP policies, strategies for strengthening the institutes-industries, IP offices, awareness amongst enforcement mechanisms like police, custom, banks for obtaining IP loan etc.

Universities as well as institutions are faced with several problems like lack of funding for education and research activities. Generally they do not generate income, because of which there is always a fund crunch, making it difficult to achieve their objectives. The fund crunch also leads to a cut down in quality training, inability to purchase equipment for their research laboratories, infrastructure, computers etc. They also are unable to pay competitive salaries and thereby not able to attract and retain talent and highly qualified people leading to reverse brain-drain problem and low levels of knowledge transfer institutes to Industry. Some universities and institutions have started generating income through consultancy services, research, royalties from licensed Patents for inventions, research contracts, sponsored research and joint ventures etc. by the successful negotiation of contracts which requires skills and technology transfer. There is now a need to create appropriate policies, strategies and programs to facilitate joint research initiatives between public, private and academic sector to help find sustainable solutions which will also help in mitigating the fund crunch and also safeguard their interests when managing collaborative research.

2. IP POLICY & STRATEGY:-

Universities, Institutions and Industry need to define IP policies which should be comprehensive in their coverage and approach. However, depending on the direction of research activities, each institution should decide on the type of intellectual property to be included in its intellectual property policy. The following are the types of intellectual property that may be considered by a university or institution in its development of an intellectual property policy like Patents, Designs, Trademarks, Geographical Indications, and Copyrights etc. Universities and institutions should educate their staff in IP, provide technical/financial support, obtain legal protection for their IP, facilitate the transfer of IP for public use, and develop the required machinery within themselves for the licensing and management of technology, including patent clearance.

IP strategy would vary as per university, Institutes, Industry, government, management etc. The focus of strategy shall be on IP creation. Strategies on IP education, creating laboratory for innovations, early Innovation laboratory, open Innovation laboratory technology licensing, Joint ventures, outsourcing of design etc. can be considered and it depends on finding of IP audit. Strategic decision making is required which includes setting goals, licensing, commercialization's of IP asset, acquisitions and agreements, litigations, due diligence, IP Management office, International IP Trends etc. could be included. IP management strategy for Industry, Institutes which include the following:

a) Form the IP Management Cell

- form cross-functional core team,
- define IP Policy,
- establish IP management committees,
- protect for the IP assets,
- Commercialize or audit or evaluate the IP assets,
- Legal formalities, litigations etc.

b) Formulation of IP Policy

- identify a centralized office like Office of the Dean of Research & Head,
- create IP awareness in all departments,
- define the rights and responsibilities of all involved in innovations,
- solicit feedback regarding the fulfilment of the objectives of the IP policy,
- Institute a review mechanism of the policy for fine-tuning and improvement.

c) Focus on IP assets which are IP creation, protection, evaluation, enforcement etc.

d) Identify, Quantify, Measure & Monitor the IP Assets

3. ANALYSIS OF COLLABORATION BETWEEN INDUSTRY AND INSTITUTES

There are some Institutes which are having IP cells which are collaborating with the various industries like:

An Indo-Foreign Cell (IFC) was set up in the Indian Council of Medical Research in the early 1980s to coordinate collaboration in biomedical research between India and other countries/ international agencies. The International collaborations are sought under bilateral, multilateral and/or regional collaborative framework for facilitating and strengthening interactions among governments, academia, institutions and industries in the research areas of mutual interest⁴.

VNIT, Nagpur⁵ has formed the IIC cell for interaction with industry. The Industry Institute Interaction Cell (IIC) was established in 1989 under the Industry Institute Interaction Scheme of the Ministry of Human Resources Development, Govt. of India. The objectives to evolve educational programmes which are consistent with the requirements of the industry and which can give rise to engineering personnel capable of coping-up with the accelerating pace of the technological development, further to create adequate facilities of updating knowledge of professional engineers and technologists to meet growth and developmental needs of the industry and to coordinate the research and developmental activities.

The Society for Innovation and Development (SID) was founded in the year 1991, in close collaboration with the Indian Institute of Science (IISc) Bangalore⁶. The mission of SID is to enable India's innovations in science and technology by creating effective channel to help and assist industries & business establishments to compete & prosper global competition, turbulent market conditions & fast moving technologies.

IIT Kanpur⁷ has collaborations with different sectors of the industry. Several initiatives are being undertaken to scale up the level of interaction. One such initiative by the Industrial Collaboration Advisory Group (ICAG) is the Industry Connect Series where speakers from the industry are invited to present the areas of interest to explore possibilities of collaboration with researchers in IIT Kanpur. They had formed the cell and connected with industries through projects.

The IIT Madras Research Park⁸ assists companies with a research focus to set up a base in the park and leverage the expertise available at IIT Madras. The Research Park breaks down the traditional, artificial barriers of innovation through its connectivity and collaborative interaction. This helps the industry to create, integrate, and apply advancements in knowledge. The resulting synergy leads to matchless technological innovation and transfer.

The Centre for University - Industry Collaboration, Anna University Chennai⁹ was established in the year 1991 with a primary focus on Interaction between University and Industry, Faculty Empowerment Programmes, Arranging Industrial Training, Industrial Visit and Industrial Project for Students. CUIC has a unique scheme of Industrial Associateship Scheme (IAS) wherein, small, medium, large scale industries, R&D and Educational institutions are enrolled with the main aim to carry out collaborative activities. Presently, there are 150 Members from Industries, Engineering Colleges, Polytechnics and R & D Institutions. Programmes for promoting Industry-Institute interactions, Regional Get-togethers of industries, Government-funding agencies, R&D and Educational institutions, etc., are also organised at regular intervals for cross pollination of industrial / academic ideas.

IIT Delhi, Dept. of Chemical Engineering¹⁰ has collaborations with many local and foreign institutions and the industry. The joint collaborative efforts are directed at improving process design, increasing efficiency and enhancing yield of high value added products. They had prepared the policy to enables IITD to discharge its primary responsibility of fostering, stimulating and encouraging creative activities in the area of science and technology, to protect the legitimate interest of faculty/students/ project staff/ and the society in a rational manner. The policy provides a system for the ownership, control and transfer of the intellectual property created and owned by the Institute. The policy promotes fair use of traditional knowledge while recognizing local traditional knowledge stakeholders and benefit sharing. It shares a global perception of practices related to intellectual property retaining national identity and local constraints, avoiding as far as possible 'conflict' of opposing interests.

4. INITIATIVES TAKEN BY THE GOVERNMENT

- DIPP has drafted national IPR policy to create a systematic campaign for promotion of India's IP strengths by conveying to all stakeholders the value and benefits of IP and creates awareness programs specifically targeting industry and R&D, Create suitable course materials etc¹¹.
- RGNIPM under Office of Controller General of Patents, Designs & Trademarks, and Nagpur has already started Awareness programs, Seminars, Short term Public programs on various IPRs. RGNIPM is providing concessions to students, research scholars¹².
- In recent changes in Patent Act and Rules include the three tiered fees structure i.e. for individuals, companies and small entities with relaxation of patent filing fees for small entities¹³.
- Deduction in respect of royalty on Patent granted under Income tax Act¹⁴.
- Tax benefits for expenses incurred on research are applicable for expenses incurred in India.
- Excise duty exemption is available for products that are based on valid Indian patents¹⁵

5. RECOMMENDATIONS & FINDINGS

- Any Industry or Institute who will manufacture in India can be eligible for expedited examination & grant of IPR like Patents, Trademarks etc. to make commercialize the product early and reap benefits from the IPR¹⁶.
- There is lacking of awareness of IP in academic & industries hence; there is need to create IP awareness culture in academic & industries. Further it is recommended that to form IP interaction cell amongst all the educational institutes and there shall be dedicated technology transfer offices, industry institute interaction cell (III) all over India which can help in marketing the inventions available. Also there is need to educate enforcement bodies like customs, police, banks, judicial officials etc.
- There shall be incentive/motive for Industry-Institutes tie up for joint research work and to form agreement between Institutes, Industry & Government. There are various problems to institutes or industry like proper infrastructure, research facilities, technology sharing or mutual research which can avoid the duplication of research work hence there is need provide adequate funding and fill the communication gap in academic & industries.

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