

## **PATENTS**

***Disclaimer:-The answers given below to the probable questions are for the purpose of guiding public which can not be quoted in any legal proceedings and will have no legal purpose. The users are advised to refer the provisions of the Patents Act 1970 as amended and the Patents Rules 2003 as amended including the latest fee schedules.***

### **1. What is a Patent?**

A *Patent* is a statutory right for an invention granted for a limited period of time to the patentee by the Government, in exchange of full disclosure of his invention for excluding others, from making, using, selling, importing the patented product or process for producing that product for those purposes without his consent.

### **2. Does Indian Patent give protection worldwide?**

Patent protection is territorial right and therefore it is effective only within the territory of India. However, filing an application in India enables the applicant to file a corresponding application for same invention in convention countries, within or before expiry of twelve months from the filing date in India. Therefore, separate patents should be obtained in each country where the applicant requires protection of his invention in those countries. There is no patent valid worldwide.

### **3. Is it possible to file international application under Patent Cooperation Treaty (PCT) in India?**

It is possible to file an international application known as PCT application in India in the Patent Offices located at Kolkata, Chennai, Mumbai and Delhi. All these offices act as Receiving Office (RO) for International application. The addresses of these offices are available on the website of CGPDTM i.e. [www.ipindia.nic.in](http://www.ipindia.nic.in).

### **4. What can be patented?**

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

### **5. Who can apply for a patent?**

A patent application can be filed either by true and first inventor or his assignee, either alone or jointly with any other person. However, legal representative of any deceased person can also make an application for patent.

### **6. How can I apply for a patent?**

A patent application can be filed with Indian Patent Office either with complete specification or with provisional specification along with fee as prescribed in schedule I. In case the application is filed with provisional specification, then one has to file

complete specification within 12 months from the date of filing of the application. There is no extension of time to file complete specification after expiry of said period.

### **7. Is there provision for filing patent application electronically by online system?**

From 20<sup>th</sup> July, 2007 the Indian Patent Office has put in place an online filing system for patent application. More information for filing online application is available on the website of Patent Office i.e. [www.ipindia.nic.in](http://www.ipindia.nic.in). This facility is also available for filing trademarks application.

### **8. What are the criteria of patentability?**

An invention to become patentable subject matter must meet the following criteria -

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

### **9. Should application for patent be filed before or after, publication of the details of the invention?**

The application for patent should be filed before the publication of the invention and till then it should not be disclosed or published. Disclosure of invention by publication before filing of the patent application may be detrimental to novelty of the invention as it may no longer be considered novel due to such publication. However, under certain conditions, there is grace period of 12 months for filing application even after publication.

### **10. Can any invention be patented after publication or display in the public exhibition?**

Generally, a patent application for the invention which has been either published or publicly displayed cannot be filed. However the Patents Act provides a grace period of 12 months for filing of patent application from the date of its publication in a journal or its public display in a exhibition organised by the Government or disclosure before any learned society or published by applicant. The details conditions are provided under Chapter VI of the Act (Section 29-34).

### **11. How a Patent Specification is prepared?**

A patent specification can be prepared by the applicant himself or his registered and authorized agent. The patent specification generally comprises of the title of the invention indicating its technical field, prior art, draw backs in the prior art, the solution provided by the inventor to obviate the drawbacks of the prior art, a concise but sufficient description of the invention and its usefulness, drawings (if Any) and details of best method of its working. The complete specification must contain at least one claim or statement of claims defining the scope of the invention for which protection is sought for.

### **12. What is a provisional specification?**

Indian Patent Law follows first to file system. Provisional specification describes the nature of the invention to have the priority date of filing of the application in which the inventive idea has been disclosed. It must be followed by a complete specification describing the details of the invention along with a statement of claims within 12 months after filing of the provisional application. If the complete specification is not filed within the prescribed period, the application is treated as deemed to have been abandoned

### **13. Is it necessary to file a provisional application?**

Generally, an application filed with provisional specification is known as provisional application which is useful in establishing a priority date for your invention. Moreover, filing of a provisional application is useful as it gives sufficient time to the applicant to assess and evaluate the market potential of his invention before filing complete specification. However, it is not necessary to file an application with provisional specification and one can file application directly with complete specification.

### **14. Does the Patent Office Keep information of the invention Secret?**

Yes. All the patent applications are kept secret upto 18 months from the date of filing or priority date whichever is earlier and thereafter they are published in the Official Journal of the Patent Office which is published every week and also available on the IPO website. After its publication, public can inspect the documents and also may take the photocopy thereof on payment of the fee as prescribed.

### **15. When an application for patent is published?**

Every application for patent is published after 18 months from the date of its filing or priority date whichever is earlier. However, following applications are not published.

- A) Application in which secrecy direction is imposed
- B) Application which has been abandoned u/s 9(1) and
- C) Application which has been withdrawn 3 months prior to 18 months

### **16. Is there any provision in the law for early publication?**

Yes, the applicant can make a request for early publication in Form 9 along with the prescribed fee. After receiving such request the Patent Office publishes such application within a period of one month provided the invention contained thereon does not relate to atomic energy or defence purpose.

### **17. Is patent application once filed is examined automatically?**

The patent application is not examined automatically after its filing. The examination is done only after receipt of the request of examination either from the applicant or from third party.

### **18. When the request for examination can be filed?**

The request for examination can be filed within a period of 48 months from the date of priority or date of filing of the application whichever is earlier. For more details kindly refer to rule 24B of the Patents Rules 2003 as amended upto 2006.

**19. Is there any provision for early examination?**

There is no provision for filing a request for early examination. The applications are examined in the order in which requests for examination are filed. However, an express request for examination before expiry of 31 months can be made in respect of the applications filed under Patent Cooperation Treaty known as National Phase applications by payment of the prescribed fee.

**20. What happens to a patent application once it is examined?**

After examination, the Patent office issues an examination report to the applicant which is generally known as First Examination Report (FER). Thereafter the applicant is required to comply with the requirements within a period of twelve months from the date of FER. In case, the application is found to be in order for grant, the patent is granted, provided there is no pre-grant opposition is filed or pending. A letter patent is issued to the applicant. However, in case a pre-grant opposition is pending, the further action is taken after disposition of the pre-grant opposition.

**21. What happens when applicant is not able to meet the requirement within the prescribed time?**

If the applicant is not able to comply with or meet the requirement within 12 months, or does not submit the documents which were sent to him for compliance within the said period, the application is deemed to have been abandoned.

**22. Is there provision for extension beyond time limit of 12 months?**

There is no provision for extension of time beyond the period of 12 months.

**23. Does applicant get an opportunity of being heard before his application is refused?**

If applicant has not complied with the requirements within the prescribed time, and no request for hearing has been made by the applicant, the controller may not provide the opportunity of being heard. However the Controller shall provide an opportunity of being heard to the applicant before refusing his application if a request for such hearing has been made by the applicant at least 10 days in advance before expiry of the statutory period.

**24. What are the various stages involved in the grant of patent?**

After filing the application for the grant of patent, a request for examination is required to be made by the applicant or by third party and thereafter it is taken up for examination by the Patent office. Usually, the First Examination Report is issued and the applicant is given an opportunity to correct the deficiencies in order to meet the objections raised in the said report. The applicant must comply with the requirements within the prescribed time otherwise his application would be treated as deemed to have been abandoned. When all the requirements are met, the patent is granted and notified in the Patent office Journal. However before the grant of patent and after the publication of application, any person can make a representation for pre-grant opposition.

**25. What is time limit for filing the representation for pre-grant opposition?**

A representation for pre-grant opposition can be filed within six months from the date of publication of the application u/s 11A or before the grant of patent. The grounds on which the representation can be filed are provided u/s 25(1) of the Patents Act 1970.

**26. Is there any fee for filing such representation for pre-grant opposition?**

There is no fee for filing representation for pre-grant opposition? This can be filed by any person.

**27. What are the grounds for filing representation for pre-grant opposition?**

The grounds for filing post-grant opposition are contained in section 25(1) of the Patents Act 1970.

**28. Is it possible to file pre-grant opposition even though there is no request for examination filed?**

Yes, it is possible to file representation for pre-grant opposition even though there is no request for examination has been filed. However, the representation will be considered only when a request for examination is received within the prescribed period.

**29. What is the time limit for filing post-grant opposition in the patent office?**

The time for filing post-grant opposition is 12 months from the date of publication of the grant of patent in the official journal of the patent office.

**30. Is there any fee for filing post-grant opposition?**

The post grant opposition has to be filed in the prescribed form 7 along with prescribed fees of Rs.1500 for natural person and Rs.6000 for person other than natural person. The post grant opposition has to be filed by the person interested and not by any other person.

**31. What are the grounds for filing the post grant opposition?**

The grounds for filing post-grant opposition are contained in section 25(2) of the Patents Act 1970.

**32. Is it necessary to go to the Indian Patent Office to transact any business relating to patent application?**

No, normally all the communications with the office are done through written correspondence. However, interviews relating to patent application can be had with examiners with prior appointment on any working day during prosecution stage.

**33. Where the information relating to patent application is notified?**

The information relating to the patent application is published in the Patent office Journal issued on every Friday. This is also available in electronic form on the website of the Patent Office

**34. What are the contents of the Patent office Journal?**

The Patent office Journal contains information relating to patent applications which are published u/s 11A, post grant publication, restoration of patent, notifications , indexes,

list of non-working patents and notices Issued by the Patent Office relating to Patents, etc..

### **35. Can one subscribe a copy of the Patent office Journal?**

The Patent office Journal can be subscribed by making payment of Rs 400/- in cash or by DD/cheque in favour of **the Controller of Patents**. This is also available in CD form. However, the journal can be downloaded from the website free of charge.

### **36. Where could one find a copy of the Patent office Journal without purchasing the publication?**

The Patent office Journal is freely available on patent office site i.e. [www.ipindia.nic.in](http://www.ipindia.nic.in). This is also available in the technical libraries maintained by the Patent Offices. The library facilities are available to the public free of charge from Monday to Friday on working days except holidays.

### **37. Can one use the words "Patent Pending" or "Patent Applied For"?**

These words are normally used by the patent applicant to their products after filing his application for patent so that the public is made aware that a patent application has been filed in respect of that invention. Use of these words where no application has been made is prohibited under the Patent law. However, use of such words by the patent applicant does not prohibit the third party to plead as innocent unless the patent number is indicated.

### **38. How useful is the marking of a product with "patent pending" or "patent applied for" before the grant?**

Marking of a product with the words "patent pending" or "Patent applied for" after filing of the application for patent serve as a notice to the public that an application for patent is pending with the Patent Office but there is no legal significance of these words. The infringement action can be initiated only after the patent is granted.

### **39. Does patent office help in finding users for patent?**

The Patent Office has no role in the commercialization of patent. However, the information relating to patent is published in the Patent Office journal and also published on the Patent Office website which is accessible to the public worldwide. This certainly helps the applicant to attract potential user or licensee. The patent office also compiles a list of patents which are not commercially worked in India.

### **40. How can one find out that an invention is already patented?**

The person concerned can perform a preliminary search on Patent Office website in the Indian patent data base of granted patent or Patent Office journal published every week or by making search in the documents kept in the Patent Office Search and Reference Room, which contains Indian patents arranged according to international patent classification system as well in serial number. It is open to the general public from

Monday to Friday, except Gazetted holidays. The public can also conduct search free of charge on the website of Patent Office. The person concerned can also make a request for such information under section 153 of the Act

#### **41. What is the term of patent?**

Term of every patent in India is 20 years from the date of filing of patent application, irrespective of whether it is filed with provisional or complete specification. However, in case of applications filed under PCT the term of 20 years begins from International filing date.

#### **42. Is there any difference in the amount of fees to be paid by an individual or a legal entity for filing a patent application?**

Yes, the application filing fees for an individual person(natural person) is Rs.1, 000/- and for a legal entity other than individual is Rs.4, 000/- upto 10 claims and 30 pages. However, in case, the number of pages exceed beyond 30, then natural person has to pay Rs.100/- each extra page and person other than natural person has to pay Rs.400/- per page. Similarly if the number of claims exceed beyond 10, then natural person has to pay Rs.200/- for each additional claim and person other than natural person has to pay Rs.800/- for each additional claim.

#### **43. What are obligations of the patentee after the grant of patent?**

After the grant of patent, every patentee has to maintain the patent by paying renewal fee every year as prescribed in the schedule I. For first two years, there is no renewal fee. The renewal fee is payable from 3<sup>rd</sup> year onwards. In case the renewal fee is not paid the patent will be ceased.

#### **44. Can the patentee pay renewal fee at a time or has to pay every year?**

The patentee has choice to pay the renewal fees every year or he can pay in lump sum as well.

#### **45. When a patent can be restored after its cessation ?**

A request for restoration of patent can be filed within 18 months from the date of cessation of patent along with the prescribed fee. After receipt of the request the matter is notified in the official journal for further processing of the request.

#### **46. What is meant by patent agent and what are the eligibility criteria of becoming a patent agent?**

A Patent agent is a registered person with Indian Patent Office whose name is entered in the patent agent register after being declared qualified the patent agent examination conducted by the patent office and who is entitled—

(a) to practice before the Controller; and

(b) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceeding before the Controller under this Act.

Eligibility conditions **for registration as patent agents are below.-**

A person shall be qualified to have his name entered in the register of patent agents if he fulfills the following conditions, namely—

(a) he is a citizen of India;

(b) he has completed the age of 21 years;

(c) he has obtained a degree in science, engineering or technology from any university established under law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf,

and, in addition,—

(i) has passed the qualifying examination prescribed for the purpose; or

(ii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity.

#### **47. Is it necessary to engage a registered patent agent for filing an application for patent?**

No, it is not necessary under the patent law to engage a registered patent agent for filing an application for patent. The applicant is free to file an application by himself or through the patent agent. However, an applicant who is not a resident of India is required to file either through the registered patent agent or must give an address for service in India

#### **48. Does the Patent Office help to select a patent attorney or agent to make patent search or to prepare and prosecute patent application?**

No, Patent Office does not make any recommendations regarding selection of a patent agent. However, the applicant is free to appoint any patent agent from a list of patent agents maintained by the office. This list can also be viewed at Patent Office website.

#### **49. Does the patent office ascertain fees charged by the patent agents for their services?**

No. This is a matter between the applicant and the patent agent. The Patent Office has no role in ascertaining or assisting the fee charged by a patent agent.

**50. Is it mandatory to obtain prior permission from the Patent Office to file application for patent outside India or abroad!**

Generally speaking, it is not necessary to obtain prior permission from the Patent Office to file patent application abroad under following circumstances.

- (a) Applicant is not Indian resident and invention is originated abroad about.
- (b) If the applicant is Indian resident, a patent application has been filed in India and six weeks period is over from that date.
- (c) The invention does not belong to Atomic Energy or defence purpose.

In other circumstances, the prior permission is required. For further details kindly refer to section 39 of the Patents Act, 1970.

**51. Under what circumstances, it is necessary to obtain a prior permission from the Patent Office?**

The person is required to take prior permission from the Patent Office under following circumstances.

- (a) The applicant is Indian resident and invention is originated in India,
- (b) Applicant does not wish to file patent application in India prior to filing abroad.
- (c) If the applicant is Indian resident, a patent application has been filed in India and six weeks period is not yet over from that date
- (d) The invention relates to atomic energy or defence purpose.

**52. Is it essential to deposit biological material in the international depository authority!**

If the invention uses a biological material which is new, it is essential to deposit the same in the International Depository Authority (IDA) prior to the filing of the application in India in order to supplement the description. The description in the specification should contain the name and address of the International Depository Authority and, date and number of deposition of Biological material. If such biological material is already known, in such case it is not essential to deposit the same. For more details log on to [www.ipindia.nic.in](http://www.ipindia.nic.in)

### **53. Is there any International Depository Authority in India!**

Yes, there is an International Depository Authority in India located at Chandigarh which is known as Institute of Microbial Technology (IMTECH). The more details about this depository authority can be had on its website <http://imtech.res.in/> .

## **DESIGNS**

### **FREQUENTLY ASKED QUESTIONS & ANSWERS**

#### **Q.1 What is meant by Intellectual Property ?**

Ans. Intellectual Property is the Property, which has been created by exercise of Intellectual Faculty. It is the result of persons Intellectual Activities. Thus Intellectual Property refers to creation of mind such as inventions, designs for industrial articles, literary, artistic work, symbols which are ultimately used in commerce. Intellectual Property rights allow the creators or owners to have the benefits from their works when these are exploited commercially. These rights are statutory rights governed in accordance with the provisions of corresponding legislations. Intellectual Property rights reward creativity & human endeavor which fuel the progress of humankind. The intellectual property is classified into seven categories i.e . (1) Patent (2) Industrial Design (3) Trade Marks (4) Copyright (5) Geographical Indications (6) Lay out designs of integrated circuits (7) Protection of undisclosed information/Trade Secret according to TRIPs agreements.

#### **Q.2. What is meant by 'Design' under the Designs Act, 2000 ?**

Ans. 'Design' means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle or construction or any thing which is in substance a mere mechanical device, and does not include any trade mark, as define in clause (v) of sub-section of Section 2 of the Trade and Merchandise Marks Act, 1958, property mark or artistic works as defined under Section 2(c) of the Copyright Act, 1957.

#### **Q. 3. What is meant by an article under the Designs Act, 2000 ?**

Ans. Under the Designs Act, 2000 the "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately;

#### **Q.4. What is the object of registration of Designs?**

Ans. Object of the Designs Act to protect new or original designs so created to be applied or applicable to particular article to be manufactured by Industrial Process or means. Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. The important purpose of design Registration is to see that the artisan, creator, originator of a design having aesthetic look is not deprived of his bonafide reward by others applying it to their goods.

**Q.5. What are the essential requirements for the registration of 'design' under the Designs Act, 2000?**

Ans. (1) The design should be new or original, not previously published or used in any country before the date of application for registration. The novelty may reside in the application of a known shape or pattern to new subject matter. Practical example:

The known shape of "Kutub Minar" when applied to a cigarette holder the same is registrable. However, if the design for which application is made does not involve any real mental activity for conception, then registration may not be considered.

(2) The design should relate to features of shape, configuration, pattern or ornamentation applied or applicable to an article. Thus, designs of industrial plans, layouts and installations are not registrable under the Act. (3) The design should be applied or applicable to any article by any industrial process. Normally, designs of artistic nature like painting, sculptures and the like which are not produced in bulk by any industrial process are excluded from registration under the Act. (4) The features of the design in the finished article should appeal to and are judged solely by the eye. This implies that the design must appear and should be visible on the finished article, for which it is meant. Thus, any design in the inside arrangement of a box, money purse or almirah may not be considered for showing such articles in the open state, as those articles are generally put in the market in the closed state. (5) Any mode or principle of construction or operation or any thing which is in substance a mere mechanical device, would not be registrable design. For instance a key having its novelty only in the shape of its corrugation or bend at the portion intended to engage with levers inside the lock associated with, cannot be registered as a design under the Act. However, when any design suggests any mode or principle of construction or mechanical or other action of a mechanism, a suitable disclaimer in respect there of is required to be inserted on its representation, provided there are other registrable features in the design. (6) The design should not include any Trade Mark or property mark or artistic works as define under the Copyright Act, 1957.

**Q.6. Can stamps, labels, tokens, cards, be considered an article for the purpose of registration of Design?**

Ans: No. Because once the alleged Design i.e., ornamentation is removed only a piece of paper, metal or like material remains and the article referred ceases to exist. Article must have its existence independent of the Designs applied to it. [Design with respect to label was held not registrable, by an Order on civil original case No. 9-D of 1963, Punjab, High Court]. So, the Design as applied to an article should be integral with the article itself.

**Q.7. When does the Applicant for Registration of Design get the registration certificate?**

Ans: When an application for registration of a Design is in order, it is accepted and registered and then a certificate of registration is issued to the applicant.

However, a separate request should be made to the Controller for obtaining a certified copy of the certificate for legal proceeding with requisite fee.

**Q.8. What is a Register of Designs?**

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

**Q.9. What is the effect of registration of design?**

Ans. The registration of a design confers upon the registered proprietor 'Copyright' in the design for the period of registration. 'Copyright' means the exclusive right to apply a design to the article belonging to the class in which it is registered.

**Q.10. What is the duration of the registration of a design? Can it be extended?**

Ans. The duration of the registration of a design is initially ten years from the date of registration, but in cases where claim to priority has been allowed the duration is ten years from the priority date.

This initial period of registration may be extended by further period of 5 years on an application made in Form-3 accompanied by a fee of Rs. 2,000/- to the Controller before the expiry of the said initial period of Copyright.

The proprietor of a design may make application for such extension even as soon as the design is registered.

**Q.11. What is the date of registration?**

Ans. The date of registration except in case of priority is the actual date of filing of the application. In case of registration of design with priority, the date of registration is the date of making an application in the reciprocal country.

**Q.12. Is it possible to re-register a design in respect of which Copyright has expired?**

Ans. No. A registered design, the copyright of which has expired cannot be re-registered.

**Q.13. How one can ascertain whether registration subsists in respect of any design?**

Ans. For ascertaining whether registration subsists in respect of a design, a request should be made to the Patent Office, Kolkata. If the serial number of the registered design is known, the request should be made on Form 6, otherwise on Form 7, together with fee of Rs. 500/- or Rs. 1,000/- respectively. Each such request should be confined to information in respect of a single design.

**Q.14. What is piracy of a Design?**

Ans: Piracy of a design means the application of a design or its imitation to any article belonging to class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor. Publishing such articles or exposing terms for sale with knowledge of the unauthorized application of the design to them also involves piracy of the design.

**Q.15. What is the penalty for the piracy of a registered Design?**

Ans: If anyone contravenes the copyright in a design he is liable for every offence to pay a sum not exceeding Rs. 25,000/- to the registered proprietor subject to a maximum of Rs. 50,000/- recoverable as contract debt in respect of any one design. The registered proprietor may bring a suit for the recovery of the damages for any such contravention and for injunction against repetition of the same. Total sum recoverable shall not exceed Rs. 50,000/- as contract debt as stated in Section 22(2)(a). The suit for infringement, recovery of damage etc should not be filed in any court below the court of District Judge.

**Q.16. Is marking of an article compulsory in the cases of article to which a registered design has been applied?**

Ans: Yes, it would be always advantageous to the registered proprietors to mark the article so as to indicate the number of the registered design except in the case of Textile designs. Otherwise, the registered proprietor would not be entitled to claim damages from any infringer unless the registered proprietor establishes that the registered proprietor took all proper steps to ensure the marking of the article, or unless the registered proprietor show that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

**Q. 17. Can the Registration of a Design be cancelled ?**

Ans.: The registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in form 8 with a fee of Rs. 1,500/- to the Controller of Designs on the following grounds:

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

**Q. 18. Is it mandatory to make the article by industrial process or means before making an application for registration of design ?**

Ans.: No, design means a conception or suggestion or idea of a shape or pattern which can be applied to an article or intended to be applied by industrial process or means. Example- a new shape which can be applied to a pen thus capable of producing a new appearance of a pen on the visual appearance. It is not mandatory to produce the pen first and then make an application.

**Q. 19. Why is it important for filing the application for registration of design at the earliest possible ?**

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

**Q. 20. Can the same applicant make an application for the same design again, if the prior application has been abandoned ?**

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

**Q. 21. How to get information on registration of design ?**

Ans.: After registration of designs the most relevant view(s) of the article alongwith other bibliographic data will be available in the official gazette, which is being published on every Saturday. However, such provision cannot be implemented at this stage due to insufficient infrastructure.

**Q. 22. Whether it is possible to transfer the right of ownership ?**

Ans.: Yes, it is possible to transfer the right through assignment, agreement, transmission with terms and condition in writing or by operation of law. However, certain restrictive conditions not being the subject matter of protection relating to registration of design should not be included in the terms and condition of the contract/agreement etc. An application in form-10, with a fee of Rs. 500/- in respect of one design and Rs. 200/- for each additional design, for registration of the transfer documents is required to be made by the beneficiary to the Controller within six months from the date of execution of the instruments or within further period not exceeding six months in aggregate. An original/notarized copy of the instrument to be registered is required to be enclosed with the application.

**Q. 23. What is meant by priority claim ?**

Ans. India is one of the countries party to the Paris Convention so the provisions for the right of priority are applicable. On the basis of a regular first application filed in one of the contracting state, the applicant may within the six months apply for protection in other contracting states, latter application will be regarded as if it had been filed on the same day as the first application.

**Q. 24. How it is possible to restore the lapse design due to non-payment of extension fee within prescribed time ?**

Ans.: a registration of design will cease to be effective on non-payment of extension fee for further term of five years if the same is not paid before the expiry of original period of 10 years. However, new provision has been incorporated in the Act so that lapsed designs may be restored provided the following conditions are satisfied:

1. Application for restoration in Form-4 with fee of Rs. 1,000/- is filed within one year from the date of lapsed stating the ground for such non-payment of extension fee with sufficient reasons.

2. If the application for restoration is allowed the proprietor is required to pay the extension fee of Rs. 2,000/- and an additional fee of Rs. 1,000/- and finally the lapsed registration is restored.

**Q. 25. Can the name, address of proprietor or address for service be altered in the register of design ?**

Ans.: Name of the registered proprietor, address or address for service can be altered in the register of designs provided this alteration is not made by way of change of ownership through conveyance i.e. deed of assignment, transmission, licence agreement or by any operation of law, for which reference may be made to the answer against Q. 21. Application in form-22 with a fee of Rs. 200/- should be filed to the Controller of Designs with all necessary documents in support of the application as required.

**Q. 26. Are the registered designs open for public inspection ?**

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

**Q. 27. Can the application for registration of design be filed by the applicant himself**

**only or through a professional person ?**

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

**Q. 28. How does a registration of design stop other people from exploiting ?**

Ans.: Once a design is registered, it gives the legal right to bring an action against those persons (natural/legal entity) who infringe the design right, in the Court not lower than District Court in order to stop such exploitation and to claim any damage to which the registered proprietor is legally entitled. However, it may please be noted that if the design is not registered under the Designs Act, 2000 there will be no legal right to take any action against the infringer under the provisions of the Designs Act, 2000.

The Patent Office does not become involved with any issue relating to enforcement of right accrued by registration, similarly The Patent Office does not involve itself with any issue relating to exploitation or commercialization of the registered design.

**Q. 29. What are the important criteria for determining a "set of article" ?**

Ans.: If a group of articles meets the following requirements then that group of articles may be regarded as a set of articles under the Designs Act, 2000:

- a. Ordinarily on sale or intended to be used together.
- b. All having common design even though articles are different (same class).
- c. Same general character.

Generally, an article having the same design and sold in different sizes is not considered as a set of articles. Practical example: "Tea set", "Pen set", "Knife set" etc.

**Q.30. What is an artistic work which are not subject matter of registration ?**

Ans.: An artistic work as defined under Section 2(c) of the Copyright Act, 1957 is not a subject matter for registration which reads as follows:

"Artistic works" means: -

- i. A painting, a sculpture, a drawing (including a diagram, map, chart or plan) on engraving or a photograph, whether or not such work possesses artistic quality.
- ii. An work of architecture and
- iii. Any other work of artistic craftsmanship.

**Q. 31. What is meant by classification of goods mentioned in the Third Schedule ?**

Ans.: In the third Schedule of Design Rules, 2001 the classification of goods has been mentioned. The classification is based on Locarno Agreement. Only one class number is to be mentioned in one particular application. It is mandatory under the Rules. This classification has been made on the basis of Articles on which the design is applied.

Practical Example: If the design is applied to a toothbrush it will be classified under class 04-02. Similarly if the design is applied to a calculator, it will be classified in class 18-01. Subsequent application by the same proprietor for registration of same or similar design applied to any article of the same class is possible, but period of registration will be valid only upto period of previous registration of same design.

**Q. 32. What is meant by Property mark as per the Indian Penal Code (Sec. 479) ?**

Ans.: A mark used for denoting that movable property belongs to a particular person is called a property mark. It means that marking any movable property or goods, or any case, package or receptacle containing goods; or using any case, package or receptacle, with any mark thereon.

Practical example: The mark used by the Indian Railway on their goods may be termed as a Property Mark for the purpose of easy identification of the owner.

# **TRADE MARK**

## **FREQUENTLY ASKED QUESTIONS**

### **1. What is a trade mark?**

**Ans.** A trade mark (popularly known as brand name) in laymans language is a visual symbol which may be a word signature, name, device, label, numerals or combination of colours used by one undertaking on goods or services or other articles of commerce to distinguish it from other similar goods or services originating from a different undertaking.

The legal requirements to register a trade mark under the Act are:

- ❖ The selected mark should be capable of being represented graphically (that is in the paper form).
- ❖ It should be capable of distinguishing the goods or services of one undertaking from those of others.
- ❖ It should be used or proposed to be used mark in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and some person have the right to use the mark with or without identity of that person.

### **2. How to select a trade mark?**

**Ans.**

- If it is a word it should be easy to speak, spell and remember.
- The best trade marks are invented words or coined words.
- Please avoid selection of a geographical name. No one can have monopoly right on it.
- Avoid adopting laudatory word or words that describe the quality of goods (such as best, perfect, super etc)
- It is advisable to conduct a market survey to ascertain if same/similar mark is used in market.

### **3. What is the function of a trade mark?**

**Ans.**

Under modern business condition a trade mark performs four functions

- It identifies the goods / or services and its origin.
- It guarantees its unchanged quality
- It advertises the goods/services
- It creates an image for the goods/ services.

### **4. Who can apply for a trade mark and how ?**

**Ans.**

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may apply in writing in prescribed manner for registration. The application should contain the trade mark, the goods/services, name and address of applicant and agent (if any) with power of attorney , period of use of the mark and signature. The application should be in English or Hindi. It should be filed at th appropriate office.

### **5. How to apply for a trade mark in respect of particular goods or services?**

**Ans.**

It is provided under the Trade Marks Act,1999 that goods and services are classified according to the International Classification of goods and services. Currently schedule IV of the Act provides a summary of list of such goods and services falling in different classes which is merely indicative. The Registrar is the final authority in the determination of the class in which particular goods or services fall. The Schedule IV of the Act is annexed at the end of this questionnaire on trade marks. For detailed description of other goods and services please refer to the International Classification

published by WIPO or contact the local office for assistance.

## **6. What are different types of trade marks available for adoption?**

**Ans.**

- Any name (including personal or surname of the applicant or predecessor in business or the signature of the person), which is not unusual for trade to adopt as a mark.
- An invented word or any arbitrary dictionary word or words, not being directly descriptive of the character or quality of the goods/service.
- Letters or numerals or any combination thereof.
- The right to proprietorship of a trade mark may be acquired by either registration under the Act or by use in relation to particular goods or service.
- Devices, including fancy devices or symbols
- Monograms
- Combination of colors or even a single color in combination with a word or device
- Shape of goods or their packaging
- Marks constituting a 3- dimensional sign.
- Sound marks when represented in conventional notation or described in words by being graphically represented.

## **7. What purpose the trade mark system serves ?**

**Ans.**

- It identifies the actual physical origin of goods and services. The brand itself is the seal of authenticity.
- It guarantees the identity of the origin of goods and services.
- It stimulates further purchase.
- It serves as a badge of loyalty and affiliation.
- It may enable consumer to make a life style or fashion statement.

## **8. Who benefits from a trade mark?**

**Ans.**

**The Regd. Proprietor:** The Regd. Proprietor of a trade mark can stop other traders from unlawfully using his trade mark, sue for damages and secure destruction of infringing goods and or labels.

**The Government:** The Trade Marks Registry is expected to earn a revenue of nearly Rs.40 crores during the current year and which is perpetually on the rise.

**The Legal professionals:** The Trade Marks Registration system is driven by professionals and legal and para legal advisors (Agents) who act for the clients in the processing of the trade marks application.

The **Purchaser** and ultimately **Consumers** of trade marks goods and services.

## **9. What are the benefits of registering a trade mark?**

**Ans.** The registration of a trade mark confers upon the owner the exclusive right to the use of the registered trade mark and indicate so by using the symbol (R) in relation to the goods or services in respect of which the mark is registered and seek the relief of infringement in appropriate courts in the country. The exclusive right is however subject to any conditions entered on the register such as limitation of area of use etc. Also, where two or more persons have registered identical or nearly similar mark due to special circumstances such exclusive right does not operate against each other.

**10. What are the formalities and government fees for major trade mark transaction ?**

**Ans:**

- ✓ For filing new applications there are prescribed forms depending on the nature of application such as Form TM-1, TM-2, TM-3, TM-8, TM-51 etc.

**Fees: Rs.2,500/-**

- ✓ To file a Notice of Opposition to oppose an application published in the Trade Marks Journal **(Form TM-5). Fees:Rs.2,500/-**
- ✓ For Renewal of a Regd.trade mark **(Form TM-12 ). Fees: Rs.5,000/-**
- ✓ Surcharge for belated renewal **(Form - 10).Fees:Rs.3,000/-**
- ✓ Restoration of removed mark **(Form TM-13) Fees:5,000/-**
- ✓ Application for rectification of a registered trade mark **(Form TM-26) Fees:Rs.3,000/-**
- ✓ Legal Certificate **(Form TM-46)**  
(Providing details of entries in the Register)  
**Fees:Rs.500/-**
- ✓ Official search request **(Form TM-54). Fees:Rs.500/-**
- ✓ Preliminary advise of the Registrar as to the registrability of a mark**(Form TM-55).Fees: Rs.500/-.**
- ✓ Copyright search request and issuance of certificate **(Form TM-60) Fees: Rs,5,000/-.**

**11. What are the sources of trade mark laws?**

**Ans: (1)** The national statute i.e., the Trade Marks Act,1999 and rules thereunder .

(2) International multilateral convention.

(3) National bilateral treaty.

(4) Regional treaty.

(5) Decision of the courts.

(6) Office practice and rulings

(7) Decision of Intellectual Property Appellate Board.

(8) Text books written by academicians and professional experts.

**12. What does the Register of trade mark contain ?**

**Ans:** The register of trade mark currently maintained in electronic form contains inter alia the trade mark the class and goods/ services in respect of which it is registered including particulars affecting the scope of registration of rights conferred; the address of the proprietors; particulars of trade or other description of the proprietor; the convention application date (if applicable); where a trade mark has been registered with the consent of proprietor of an earlier mark or earlier rights, that fact.

**13. Can any correction be made in the application or register?**

**Ans:** Yes. But the basic principle is that the trade mark applied for should not be substantially altered affecting its identity. Subject to this changes are permissible according to rules detailed in the subordinate legislation.

**14. Can a registered trade mark be removed from the register?**

**Yes.** It can be removed on application to the Registrar on prescribed form on the ground that the mark is wrongly remaining on the register. The Registrar also can suo moto issue Notice for removal of a registered trade mark.

## **GEOGRAPHICAL INDICATION REGISTRY**

### **Frequently Asked Questions**

1. What is a Geographical Indication?
  - Ø It is an indication
  - Ø It originates from a definite geographical territory.
  - Ø It is used to identify agricultural, natural or manufactured goods
  - Ø The manufactured goods should be produced or processed or prepared in that territory.
  - Ø It should have a special quality or reputation or other characteristics
2. Examples of possible Indian Geographical Indications. Basmati Rice Darjeeling Tea
  - Ø Kanchipuram Silk Saree
  - Ø Alphanso Mango
  - Ø Nagpur Orange
  - Ø Kolhapuri Chappal
  - Ø Bikaneri Bhujia
  - Ø Agra Petha
3. What is the benefit of registration of geographical indications?
  - Ø It confers legal protection to Geographical Indications in India
  - Ø Prevents unauthorised use of a Registered Geographical Indication by others
  - Ø It provides legal protection to Indian Geographical Indications which in turn boost exports.
  - Ø It promotes economic prosperity of producers of goods produced in a geographical territory.
4. Who can apply for the registration of a geographical indication?
  - Ø Any association of persons, producers, organisation or authority established by or under the law can apply:
  - Ø The applicant must represent the interest of the producers
  - Ø The application should be in writing in the prescribed form
  - Ø The application should be addressed to the Registrar of Geographical

Indications alongwith prescribed fee.

5. Who is a registered proprietor of a geographical indication?
  - Ø Any association of persons, producers,organisation or authority established by or under the law can be a registered proprietor.
  - Ø Their name should be entered in the Register of Geographical Indication as registered proprietor for the Geographical Indication applied for.
6. Who is an authorised user?
  - Ø A producer of goods can apply for registration as an authorised user
  - Ø It must be in respect of a registered geographical indication
  - Ø He should apply in writing in the prescribed form alongwith prescribed fee
7. Who is a producer in relation to a Geographical Indication?
  - Ø The persons dealing with three categories of goods are covered under the term Producer:
    - Ø Agricultural Goods includes the production, processing, trading or dealing
    - Ø Natural Goods includes exploiting, trading or dealing
    - Ø Handicrafts or Industrial goods includes making, manufacturing, trading or dealing.
  - Ø Is a registration of a geographical indication compulsory and how does it help the applicant?
8. Registration is not compulsory
  - Ø Registration affords better legal protection to facilitate an action for infringement
  - Ø The registered proprietor and authorised users can initiate infringement actions
  - Ø The authorised users can exercise the exclusive right to use the geographical indication.
9. Who can use the registered geographical indication?
  - Ø An authorised user has the exclusive rights to the use of geographical indication in relation to goods in respect of which it is registered.
10. How long the registration of Geographical Indication is valid?
  - Ø The registration of a geographical indication is valid for a period of 10 years
11. Can a Geographical Indication be renewed?
  - Ø It can be renewed from time to time for further period of 10 years each.
12. What is the effect if a Geographical Indication if it is not renewed?
  - Ø If a registered geographical indication is not renewed it is liable to be removed from the register.
13. When is a registered Geographical Indication said to be infringed?
  - Ø When an unauthorised user uses a geographical indication that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which mislead the public as to the geographical origin of such goods.

- Ø When the use of geographical indication result in an unfair competition including passing off in respect of registered geographical indication.
- Ø When the use of another geographical indication results in false representation to the public that goods originate in a territory in respect of which a registered geographical indication relates.

14. Who can initiate an infringement action?

- Ø The registered proprietor or authorised users of a registered geographical indication can initiate an infringement action.

15. Can a registered geographical indication be assigned, transmitted, etc?

- Ø No. A geographical indication is a public property belonging to the producers of the concerned goods.
- Ø It shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or such other agreement
- Ø However, when an authorised user dies, his right devolves on his successor in title.

16. Can a registered geographical indication or a registered authorised user be removed from the register?

- Ø Yes. The Appellate Board or the Registrar of Geographical Indications has the power to remove the geographical indication or an authorised user from the register. Further, on application by an aggrieved person action can be taken.

17. How a geographical indication is different from a trade mark?

- Ø A trade mark is a sign which is used in the course of trade and it distinguishes goods or services of one enterprise from those of other enterprises.
- Ø Whereas a geographical indication is an indication used to identify goods having special characteristics originating from a definite geographical territory.