

e-Course PGS 503 : Intellectual Property and Its Management in Agriculture

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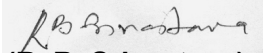
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Preface

After the TRIPS Agreement, the worldwide focus of scientists and planners has shifted on the development of time appropriate technologies, protection of inventions/technologies and real time technology transfer through licensing for industrial and agricultural growth leading to overall economic development. The public perception and expectations from agriculture are also changing fast with the increase in awareness for health, environment and employment generation. Therefore agriculture is also turning to become knowledge based industry. Consequently, the dimension of agricultural research is bound to change to generate new competitive technologies. Obviously such inventions will need protection to safeguard them from unauthorized use.

The significance of protection of Intellectual Property has been realized for wealth and value creation in a knowledge-based economy. The agricultural scientists are comparatively little aware of IPR issues because their primary mandate has always been the free delivery of technology to users particularly farmers. Under the changing scenario of global trade, where national governments are entering into bilateral agreements for tackling IPR issues to promote trade, agricultural scientists must also look for managing their intellectual properties. Thus there is an urgent need to develop understanding about Intellectual Property and associated rights which are wide and diverse.

The present document is purely a collection, compilation and summarization of salient information on TRIPS Agreement and Indian legal frame in relation to various facets of IPR and its management which is scattered over various official documents as well as websites of WTO; Protection of Plant Varieties and Farmers Rights Authority's; Technology Information, Forecasting and Assessment Council's; Policy papers released by National Academy of Agricultural Sciences; Patent Office of India; Geographical Indications Registry; National Research Development Corporation; Indian Council of Agricultural Research; Handbook on Copyright-Ministry of Human Resource Management; National Biodiversity Authority etc. Efforts have been made to bring all summary information on IPR and linked issues at one place to generate awareness among the stake-holders. The information contained in the document would certainly sensitize and help to all those faculty, students and other stakeholders who do not have easy access to internet.


(R. B. Srivastava)

1. INTRODUCTION

Historically agriculture has been seen as a source of food, rural employment and raw material supply base for industrial sector. Tremendous progress in agriculture during last over three decades generated a great confidence in Indian public in relation for our agricultural potential and our farmers' ability to adapt and adopt new technologies. The importance of the agricultural sector in India is critical to realize further economic growth and poverty alleviation. Looking on the global agricultural trade and consumption scenario, it appears that Indian agriculture is facing tough competition and is now at the crossroads. Our national capability in frontier areas of science and technology has to be strengthened and enhanced to harvest the uncommon opportunities available in domestic and global markets. Achieving this transition usually depends on achieving productivity increases and growth in agricultural in general and agric-based industries in particular. Now it is realized that having large stocks of grains is not sufficient to compete, but we must also ensure quality and varieties of products and capability to deliver in time to national and international markets. In developed countries this was achieved through remodeling the mandate of research institutions to generate efficient and time appropriate technologies in the agricultural sector which are regarded as having been instrumental in the industrial revolution.

In fact, the recognition of agriculture as a rule-bound enterprise of investment and profit making became obvious with its inclusion in the intergovernmental negotiations for the General Agreement on Tariffs and Trade (GATT) for the first time in the Uruguay Round (1986-1994). This round led to the establishment of the World Trade Organization (WTO) in January 1995. Now, the WTO has at least half a dozen intergovernmental agreements that directly affect agriculture. These are, Agreements on Agriculture (AoA), Applications of Sanitary and Phyto-sanitary Measures (SPS), Technical Barriers to Trade (TBT), Anti Dumping, Subsidies and Countervailing Measures, Safeguards, and Trade Related Aspects of Intellectual Property Rights (TRIPS).

All this has led to a fierce competition at global level for the development of new research products for domestic consumption, trans-national needs and trade and industry. The institutions, scientists, communities, farmers and individuals need to secure their intellectual creations using various tools of Intellectual Property Rights (IPR) like patents, trademarks, copyrights, geographical indications, design registrations, protection of undisclosed information and protection of plant varieties. Recognition to Intellectual Property provides an effective means of protecting and rewarding innovators which acts as a catalyst in technological and economic development. Following establishment of the international institutional mechanisms, such as, the Convention on Biological Diversity (CBD) and the WTO, and further, signing of International Treaty on Plant Genetic Resources for Food and Agriculture (ITPGRFA), the growing importance and the global scope of IPR in agriculture are well realized and

recognized.

Of late the IPR have been recognized as asset and means of rewarding and harvesting the fruit of agricultural research and development. An understanding of the implications and the application agreement on TRIPS, has become more important than ever before at every stage of planning, research, upscaling and commercialization of agricultural technologies.

Initiatives

Patents build fortress around inventions, trade marks establish and identify brands, copyrights provide protection to accompanying literature and Designs registrations cover novelties in shapes, forms and ornamentation which visually impact consumers. Similarly Protection of Plant Varieties and Farmers' Rights (PPV and FR) Act 2001 will provide protection to the plant varieties. These tools of IPR are key components of strategy formulations. Several legislative and institutional adjustments are being made for Intellectual Property (IP) protection in the country to gear up and face the challenges of globalization. These include enactment of new legislations on Protection of Plant Varieties and Farmers' Rights Act, 2001 and Geographical Indications of Goods (Registration and Protection) Act, 1999, Biological Diversity Act, 2003 and amendments in Patents Act, 1970 and Seeds Act, 1966. The need to provide for protection in the areas specific to farm animal sector is also being realized.

Having intellectual property laws is not enough. They have to be enforced. The TRIPS agreement says that governments have to ensure that IPRS can be enforced under their laws, and that the penalties for infringement are tough enough to deter further violations. The procedures must be fair and equitable, and not unnecessarily complicated or costly. Keeping this in view, and for the implementation of IPR management in agriculture, Indian Council of Agricultural Research (ICAR) has already issued guidelines, which can be followed as such or adjusted as per state and institutional needs. It will have significant impact on the course of agricultural R&D in the country. CCS Haryana Agricultural University has adopted the ICAR Guidelines and formulated its institutional "IPR Policy and Regulations" which have been implemented. This policy envisages incentives to the inventors by way of royalty & recognition, provision of licensing of technology and encouragement for inter-institutional and public-private sector linkages. However, it is important to understand how to reap benefits from an organized IPR system. We have to be aware of basics of TRIPS and IPR and take care of capacity building on IP management.

This publication is a compilation of information scattered over various official documents and websites. It will provide a summary insight about TRIPS and each of the different forms of intellectual property rights, so that awareness among students, faculty and other stakeholders is developed. In turn, it will

help in implementation of IPR Policy in CCS Haryana Agricultural University.

2. TRIPS AGREEMENT

The WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), negotiated in the 1986-94 Uruguay Round, introduced intellectual property protection rules into the multilateral trading system for the first time. Before the WTO's Uruguay Round, intellectual property laws were a matter for domestic policy. But the introduction of the TRIPS Agreement made it mandatory for all WTO members to provide for internationally acceptable and enforceable patent protection for new inventions in all areas of technology. In turn, this may bring fundamental changes in the way of traditional agricultural approach which is practiced in developing countries. IPR linked path way may facilitate the growth of agri-business and industries.

The TRIPS agreement is the most comprehensive international agreement on intellectual property to date. In 2001, developing countries concerned that developed countries were insisting on an overly-narrow reading of TRIPS, initiated a round of talks that resulted in the Doha Declaration: a WTO statement that clarifies the scope of TRIPS; stating for example that TRIPS can and should be interpreted in light of the goal "to promote access to technology for all. The TRIPS Agreement is covered in an elaborate WTO document - comprising 73 articles in 7 parts, namely, (I) General provisions and basic principles, (II) Standards concerning availability, scope, and use of IPRS (III) Enforcement of IPR, (IV) Acquisition and maintenance of IPR and related *interpartes* procedures, (V) Dispute prevention and settlement, (VI) Transitional arrangements, and (VII) Institutional arrangements.

The Agreement on Trade Related Aspects of Intellectual Property Rights (**TRIPS**) is an international agreement administered by the World Trade Organization (WTO) that sets down minimum standards for many forms of intellectual property (IP) regulation. Specifically, TRIPS contains requirements that nations' laws must meet for: copyright rights, including the rights of performers, producers of sound recordings and broadcasting organizations; geographical indications, including appellations of origin; industrial designs; integrated circuit layout-designs; patents; monopolies for the developers of new plant varieties; trademarks; trade dress; and undisclosed or confidential information.

Role of TRIPS Agreement: After the Uruguay round, the GATT became the basis for the establishment of the World Trade Organization. Because ratification of TRIPS is a compulsory requirement of World Trade Organization membership, any country seeking to obtain easy access to the numerous international markets opened by the World Trade Organization must enact the strict intellectual property laws mandated by TRIPS. For this reason, TRIPS is the most important multilateral instrument for the globalization of intellectual property laws.

The WTO's TRIPS Agreement is an attempt to narrow the gaps in the way these rights are protected

around the world, and to bring them under common international rules. It establishes minimum levels of protection that each government has to give to the intellectual property of fellow WTO members. In doing so, it strikes a balance between the long term benefits and possible short term costs to society. Society benefits in the long term when intellectual property protection encourages creation and invention, especially when the period of protection expires and the creations and inventions enter the public domain.

TRIPS also specifies enforcement procedures, remedies, and dispute resolution procedures. The agreement covers four broad issues:

- How basic principles of the trading system and other international intellectual property agreements should be applied
- How to give adequate protection to intellectual property rights?
- How countries should enforce those rights adequately in their own territories?
- How to settle disputes on intellectual property between members of the WTO special transitional arrangements during the period when the new system is being introduced?

Major Provisions of TRIPS

- TRIPS Article 27.3(b) requires countries to grant patent protection to micro-organisms, non biological and microbiological processes. WTO members must also protect plant varieties either through patents or through an effective *sui generis* system or a combination of both. Most developing countries have opted for the *sui generis* protection of plant varieties taking into account their agricultural development and farming practices.
- Copyright terms must extend to 50 years after the death of the author, although films and photographs are only required to have fixed 50 and 25 year terms, respectively.
- Copyright must be granted automatically, and not based upon any "formality", such as registration or systems of renewal.
- Computer programs must be regarded as "literary works" under copyright law and receive the same terms of protection.
- National exception to copy right (such as fair use in the United States) must be tightly constrained.

- Patents must be granted in all "fields of technology," although exceptions for certain public interests are allowed (Art. 27.2 and 27.3) and must be enforceable for at least 20 years (Art 33). Exceptions to patent law must be limited almost as strictly as those to copyright law.
- In each state, intellectual property laws may not offer any benefits to local citizens which are not available to citizens of other TRIPS signatories by the principles of national treatment ((treating one's own nationals and foreigners equally with certain limited exceptions, Art.3 and 5). TRIPS also has a most favoured nation clause (equal treatment for nationals of all trading partners in the WTO).
- The TRIPS Agreement has an additional important principle: intellectual property protection should contribute to technical innovation and the transfer of technology. Both producers and users should benefit, and economic and social welfare should be enhanced.

Frequently Asked Questions:

Q. Does the TRIPS Agreement apply to all WTO members?

All the WTO agreements (except for a couple of "plurilateral" agreements) apply to all WTO members. The members each accepted all the agreements as a single package with a single signature — making it, in the jargon, a "single undertaking".

The TRIPS Agreement is part of that package. Therefore it applies to all WTO members. (More on the single undertaking)

But the agreement allows countries different periods of time to delay applying its provisions. These delays define the transition from before the agreement came into force (before 1 January 1995) until it is applied in member countries. The main transition periods were:

- Developed countries were granted a transition period of one year following the entry into force of the WTO Agreement, i.e. until 1 January 1996.
- Developing countries were allowed a further period of four years (i.e. to 1 January 2000) to apply the provisions of the agreement other than Articles 3, 4 and 5 which deal with general principles such as non-discrimination.
- Transition economies, i.e. members in the process of transformation from centrally-planned into market economies, could also benefit from the same delay (also until 1 January 2000) if they met certain additional conditions.

- Least-developed countries were granted a longer transition period of a total of eleven years (until 1 January 2006), with the possibility of an extension. For pharmaceutical patents, this has been extended to 1 January 2016, under a decision taken by ministers at the Fourth Ministerial Conference in November 2001.

Q. What is the place of the TRIPS Agreement in the multilateral trading system?

One of the fundamental characteristics of the TRIPS Agreement is that it makes protection of intellectual property rights an integral part of the multilateral trading system, as embodied in the WTO.

The TRIPS Agreement is often described as one of the three “pillars” of the WTO, the other two being trade in goods (the traditional domain of the GATT) and trade in services.

The TRIPS Agreement is part of the “single undertaking” resulting from the Uruguay Round negotiations. That implies that the TRIPS Agreement applies to all WTO members. It also means that the provisions of the agreement are subject to the integrated WTO dispute settlement mechanism which is contained in the Dispute Settlement Understanding (the “Understanding on Rules and Procedures Governing the Settlement of Disputes”).

Q. What is the relationship between the TRIPS Agreement and the pre-existing international conventions that it refers to?

The TRIPS Agreement says WTO member countries must comply with the substantive obligations of the main conventions of WIPO — the **Paris Convention** on industrial property, and the **Berne Convention** on copyright (in their most recent versions).

With the exception of the provisions of the Berne Convention on moral rights, all the substantive provisions of these conventions are incorporated by reference. They therefore become obligations for WTO member countries under the TRIPS Agreement — they have to apply these main provisions, and apply them to the individuals and companies of all other WTO members.

The TRIPS Agreement also introduces additional obligations in areas which were not addressed in these conventions, or were thought not to be sufficiently addressed in them.

The TRIPS Agreement is therefore sometimes described as a “Berne and Paris-plus” Agreement.

The text of the TRIPS Agreement also makes use of the provisions of some other international agreements on intellectual property rights:

- WTO members are required to protect integrated circuit layout designs in accordance with the provisions of the **Treaty on Intellectual Property in Respect of Integrated Circuits (IPIC Treaty)** together with certain additional obligations.
- The TRIPS Agreement refers to a number of provisions of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention), without entailing a general requirement to comply with the substantive provisions of that Convention.

Article 2 of the TRIPS Agreement specifies that nothing in Parts I to IV of the agreement shall derogate from existing obligations that members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in respect of integrated circuits.

Q. What is WIPO?

The World Intellectual Property Organization (WIPO) was established by a convention of 14 July 1967, which entered into force in 1970. It has been a specialized agency of the United Nations since 1974, and administers a number of international unions or treaties in the area of intellectual property, such as the Paris and Berne Conventions.

WIPO's objectives are to promote intellectual property protection throughout the world through cooperation among states and, where appropriate, in collaboration with any other international organization. WIPO also aims to ensure administrative cooperation among the intellectual property unions created by the Paris and Berne Conventions and sub-treaties concluded by the members of the Paris Union.

The administration of the unions created under the various conventions is centralized through WIPO's secretariat, the "International Bureau". The International Bureau also maintains international registration services in the field of patents, trademarks, industrial designs and appellations of origin. WIPO also undertakes development cooperation for developing countries through advice, training and furnishing of documents.

An agreement on cooperation between WIPO and the WTO came into force on 1 January 1996. The agreement provides cooperation in three main areas:

- notification of, access to and translation of national laws and regulations
- implementation of procedures for the protection of national emblems, and

- technical cooperation.

WIPO is located at 34 chemin des Colombettes, Geneva
mailing address: P.O. Box 18, CH-1211 Geneva 20
telephone: (41 22) 338 9111
fax: (41 22) 733 5428
website: www.wipo.int.

Q. Does the TRIPS Agreement require all members' rules on protection of intellectual property to be identical?

No, the TRIPS Agreement requires members to comply with certain minimum standards for the protection of intellectual property rights covered in it. But Members may choose to implement laws which give more extensive protection than is required in the agreement, so long as the additional protection does not contravene the provisions of the agreement. This is why the TRIPS Agreement is sometimes described as a "minimum standards" agreement. In addition, the agreement gives members the freedom to determine the appropriate method of implementing the provisions of the agreement within their own legal system and practice. The agreement thus takes into account the diversity of members' legal frameworks (for instance between common law and civil law traditions).

Q. Does the agreement allow compulsory licensing of patents?

Article 31 allows compulsory licensing and government use of a patent without the authorization of its owner. But this can only be done under a number of conditions aimed at protecting the legitimate interests of the right holder. For example: (unless there is an emergency) the person or company applying for a license must have first attempted, unsuccessfully, to obtain a voluntary license from the right holder on reasonable commercial terms, and adequate remuneration must be paid to the right holder.

The authorization granted under compulsory licensing must also meet certain requirements. In particular, it cannot be exclusive, and it must as a general rule be granted predominantly to supply the domestic market.

Q. Does the agreement require members to provide patent protection to plant varieties?

Article 27.3(b) allows members to exclude some types of plant and animal inventions from patenting in their countries. More specifically, it allows them to exclude from patentability "plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other

than non-biological and microbiological processes”.

However, the agreement says members must provide for the protection of plant varieties, either by patents or by an effective *sui generis* system (i.e. a system created specially for this purpose) or by any combination of the two.

Q. What is the role of the TRIPS Council?

The TRIPS Council comprises all WTO members. It is responsible for monitoring the operation of the agreement, and, in particular, how members comply with their obligations under it.

- Monitoring: Members will review each others' laws.
- Consultations: On any TRIPS issue
- Technical cooperation: A work programme
- Reviews and negotiations on specific subjects
- Review of TRIPS agreement

The TRIPS Agreement calls for further work in specified areas, including:

- i. the negotiation of a multilateral system of notification and registration for geographical indications for wines (Article 23.4);
- ii. the review of the application of provisions on protecting geographical indications (Article 24.2);
- iii. the review, after four years, of the option to exclude from patentability certain plant and animal inventions (Article 27.3(b));
- iv. and the examination of the applicability to TRIPS of non-violation complaints under the dispute settlement process (Article 64).

The TRIPS Council will hold a general review of the agreement after five years; but it is also empowered to review it at any time in the light of any relevant new developments which might warrant modification and amendment (Article 71).

Q. What is UPOV?

The International Union for the Protection of New Varieties of Plants (UPOV) is an intergovernmental

organization with headquarters in Geneva (Switzerland). UPOV was established by the International Convention for the Protection of New Varieties of Plants. The Convention was adopted in Paris in 1961 and it was revised in 1972, 1978 and 1991. The objective of the Convention is to provide and promote an effective system of plant variety protection, with the aim of encouraging the development of new varieties of plants, for the benefit of society.

“Scientific and technological advances hold great promise, but the full benefits of scientific breakthroughs will not be realized without the dissemination and adoption of new technologies.”

3. INTELLECTUAL PROPERTY RIGHTS

Definition: Intellectual property right (IPR) is a lawful right of an individual granted by government for a specified period on the ownership of the property created through his intellect. It is for effective use of knowledge for economic growth.

Objectives of Granting IPR

- i. To enhance the performance levels of institutions.
- ii. To give recognition and financial benefits to the efforts for the creativity
- iii. To create competition among the researchers and institutions for quality of research
- iv. To have return on investment in research
- v. To fasten the technology transfer through licensing and other means
- vi. Society benefits in the long term because intellectual property protection encourages creation and invention, which become available to society at the earliest. When the period of protection expires and the creations and inventions enter the public domain, the public can realize benefits at low cost.

Competition in the domestic and global markets, among other factors, is increasingly being driven by innovation, quality and cost in today's world. Institutions and individuals have to attain innovative capabilities of their product, which need protection, to ensure that innovations are rewarded, reach to public in shortest time and benefits are not taken away by others.

Emerging Importance of IPR

In developed countries the IPR portfolio has now become an effective platform for benchmarking of intellectual assets and enhancing innovative capabilities of institutions, business entrepreneurs and researchers. This is being used extensively in today's world for acquisitions, strategic alliances, licensing arrangements and venture capital funding in industries. Infact, industries have now realized that the patented technologies have potential for their industrial growth as they are time appropriate and can be marketed easily. So they look for such technologies. It is important to appreciate the salient features of IPR and integrate them in institutional working so that one can not only create new and useful inventions that go into products and processes but also generate appropriate IPR and enforce them. India has already started working on bilateral trade agreements keeping in view the IPR issues.

The latest one is with Switzerland which will help in the development of continued institutional cooperation for regular technical exchanges between institutions in the two countries to promote trade. Capacity building on IPR issues has become important as the whole trade is shifting fast keeping IPR as tool of promotion of trade and collaboration.

"It is important that all stakeholders learn about the power of their intellectual property and come out with protection initiatives and negotiating agreements for things such as joint ventures and licenses". India continues to build its economic strength, a key aspect of which is promoting and protecting IPR."

Frequently Asked Questions

Q. What is Intellectual Property?

Intellectual Property is the product of mind- It is a class of property emanating primarily from human intellect. Such inventions, publication and other scholarly works are intellectual properties. These properties can be protected through copyrights, trademarks, patents, plant variety protection/plant breeders rights, geographical indicators, layouts, designs, and undisclosed information's provisions. Of late, protection of Plant Varieties and Farmers' Rights Act 2001 has been implemented to protect the plant varieties.

Q. What are the legislations covering IPRs in India?

- **Patents:** The Patents Act, 1970 and was amended in 1999 and 2002. The amended Act after the amendments made in 2002 came in to force on May 20, 2003.
- **Design:** A new Design Act 2000 has been enacted superseding the earlier Designs Act 1911.
- **Trade Mark:** A new Trademarks Act, 1999 has been enacted superseding the earlier Trade and Merchandise Marks Act, 1958. The Act came in force from September 15, 2003
- **Copyright:** The Copyright Act, 1957 as amended in 1983, 1984 and 1992, 1994,1999 and the Copyright Rules, 1958.
- **Layout Design of Integrated Circuits:** The Semiconductor Integrated Circuit Layout Design Act 2000. (Enforcement pending)
- **Protection of Undisclosed Information:** No exclusive legislation exists but the matter would be generally covered under the Contract Act, 1872.

- **Geographical Indications:** The Geographical Indication of Goods (Registration and Protection) Act 1999.
- **Protection of Plant Varieties and Farmers' Rights Act 2001:** *Sui generis* system of plant varieties protection.
- **National Biological Diversity Act 2003:** It shall provide legal protection to our bio-diversity.

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

Patents, designs, trademarks and geographical indications are administered by the Controller General of Patents, Designs and Trademarks which is under the control of the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry. Copyright is under the charge of the Ministry of Human Resource Development. The Act on Layout Design of Integrated Circuits is implemented by the Ministry of Communication and Information Technology. For Protection of Plant Varieties and Farmers Rights, an Authority called PPV &FR Authority is in place. Similarly National Biodiversity Authority has been established.

Q. What's the difference among different types of protection?

Copyrights, patents, trademarks, etc apply to different types of creations or inventions. They are also treated differently. Patents, industrial designs, integrated circuit designs, geographical indications and trademarks have to be registered in order to receive protection. The registration includes a description of what is being protected — the invention, design, brand name, logo, etc — and this description is public information. Copyright and trade secrets are protected automatically according to specified conditions. They do not essentially have to be registered, and therefore there is no need to disclose, for example, how copyrighted computer software is constructed. Other conditions may also differ, for example the length of time that each type of protection remains in force.

Trade liberalization... brings about competition for quality of research, faster transfers of technology, capital investment, and knowledge sharing across borders.

4. COPYRIGHT

Definition: Copyright is a right given by the law to creators of literary, dramatic, musical, performances and artistic works and producers of cinematograph films and sound recordings.

In fact, it is a bundle of rights including, *inter alia*, rights of reproduction, communication to the public, adaptation and translation of the work. There could be slight variations in the composition of the rights depending on the work.

Use of the "©" symbol

Anyone who claims copyrights in a work can use copyright notice to alert the public of the claim. It is not necessary to have a registration to use the designations though it is highly advisable to incorporate a copyright notice like the symbol, letter "c" in a circle or the word "Copyright" followed by name of copyright owner and year of first publication. For example, © HAU. Intellectual Property Rights: Policy and Regulations, 2007.

TRIPS Agreement : This agreement on copyright ensures that:

- Computer programs will be protected as literary works under the Berne Convention and outlines how databases should be protected. Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.
- It also expands international copyright rules to cover rental rights. Authors of computer programs and producers of sound recordings must have the right to prohibit the commercial rental of their works to the public. A similar exclusive right applies to films where commercial rental has led to widespread copying, affecting copyright-owners' potential earnings from their films.
- The agreement says performers must also have the right to prevent unauthorized recording, reproduction and broadcast of live performances (bootlegging) for no less than 50 years. Producers of sound recordings must have the right to prevent the unauthorized reproduction of recordings for a period of 50 years.

Copyrights in India

- Prior to the Act of 1957, the Law of Copyrights in India was governed by the Copyright Act of 1914. This Act was essentially the extension of the British Copyright Act, 1911 to India . Even the Copyright Act, 1957 borrowed extensively from the new Copyright Act of

the United Kingdom of 1956.

- The Indian Copyright Act today is compliant with most international conventions and treaties in the field of copyrights. India is a member of the Berne Convention of 1886 (as modified at Paris in 1971), the Universal Copyright Convention of 1951 and the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement of 1995. Though India is not a member of the Rome Convention of 1961, the Copyright Act, 1957 is fully compliant with the Rome Convention provisions.
- Two new treaties, collectively termed as Internet Treaties, were negotiated in 1996 under the auspices of the **World Intellectual Property Organization (WIPO)**. These treaties are called the '**WIPO Copyrights Treaty (WCT)**' and the '**WIPO Performances and Phonograms Treaty (WPPT)**'. These treaties were negotiated essentially to provide for protection of the rights of copyright holders, performers and producers of phonograms in the Internet and digital era. India is not a member of these treaties as yet.

The Section 9 of the Copyright Act requires for establishment of an office to be called the Copyright Office for the purpose of the Act. The Copyright Office is to be under the immediate control of a Registrar of Copyrights to be appointed by the Central Government, who would act under the superintendence and directions of the Central Government.

- Section 11 of the Copyright Act requires the Central Government to constitute a Copyright Board headed by a Chairman with not less than two and not more than 14 other members. Registrar of Copyrights is to be Secretary of the Copyright Board. Section 12 of the Copyright Act also lays down the powers of the Copyright Board and deems it to be a civil court for the purposes of Sections 345 and 346 of the Code of Criminal Procedure, 1973 and also that all the proceedings of the Board would be deemed to be judicial proceedings within the meaning of Sections 193 and 228 of the Indian Penal Code.

Frequently Asked Questions

Q. Whose rights are protected by copyright?

Copyright protects the rights of authors, i.e., creators of intellectual property in the form of literary, musical, dramatic and artistic works and cinematograph films and sound recordings.

Q. Who is the first owner of copyright in a work?

Ordinarily the author is the first owner of copyright in a work.

Q. Who is an author?

- In the case of a literary or dramatic work the author, i.e., the person who creates the work.
- In the case of a musical work, the composer.
- In the case of a cinematograph film, the producer.
- In the case of a sound recording, the producer.
- In the case of a photograph, the photographer.
- In the case of a computer generated work, the person who causes the work to be created.

Q. Who have rights in a musical sound recording?

There are many right holders in a musical sound recording. For example, the lyricist who wrote the lyrics, the composer who set the music, the singer who sang the song, the musician (s) who performed the background music, and the person or company who produced the sound recording.

Q. Is it necessary to obtain any license or permission to use a musical sound recording for public performance?

A sound recording generally comprises various rights. It is necessary to obtain the licenses from each and every right owner in the sound recording. This would, *inter alia*, include the producer of the sound recording, the lyricist who wrote the lyrics, and the musician who composed the music.

Q. Who is the owner of copyright in a government work?

In the case of a government work, government shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

Q. Who is the owner of copyright in the work of a public undertaking?

In the case of a work made or first published by or under the direction or control of any public

undertaking, such public undertaking shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

Q. Who is the owner of copyright in works by journalists during the course of their employment?

In the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or similar periodical, the said proprietor shall, in the absence of any agreement to the contrary, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical, or to the reproduction of the work for the purpose of its being so published, but in all other respects the author shall be the first owner of the copyright in the work.

Q. Who is the owner of a work produced during the course of the author's employment?

In the case of a work made in the course of the author's employment under a contract of service or apprenticeship, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

Q. Who is the owner of the copyright in the case of a work produced for valuable consideration at the instance of another person?

In the case of a photograph taken, or a painting or portrait drawn, or an engraving or a cinematograph film made, for valuable consideration at the instance of any person, such person shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

Q. Is copyright assignable?

Yes. The owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign to any person the copyright either wholly or partially and either generally or subject to limitations and either for the whole term of the copyright or any part thereof.

Q. Is it necessary to register a work to claim copyright?

No. Acquisition of copyright is automatic and it does not require any formality. However, certificate of registration of copyright and the entries made therein serve as *prima facie* evidence in a court of law with reference to dispute relating to ownership of copyright.

Q. What is the procedure for registration of a work under the Copyright Act, 1957?

Copyright comes into existence as soon as a work is created and no formality is required to be completed for acquiring copyright. However, facilities exist for having the work registered in the Register of Copyrights maintained in the Copyright Office of the Department of Education. The entries made in the Register of Copyrights serve as *prima-facie* evidence in the court of law. The Copyright Office has been set up to provide registration facilities to all types of works and is headed by a Registrar of Copyrights and is located at B.2/W.3, C.R. Barracks, Kasturba Gandhi Marg, New Delhi-110 003,

Q. What are the guidelines regarding registration of a work under the Copyright Act?

Chapter VI of the Copyright Rules, 1956, as amended, sets out the procedure for the registration of a work. Copies of the Act and Rules can be obtained from the Manager of Publications, Publication Branch, Civil Lines, Delhi or his authorized dealers on payment. The procedure for registration is as follows:

- a. Application for registration is to be made on Form IV (Including Statement of Particulars and Statement of Further Particulars) as prescribed in the first schedule to the Rules ;
- b. Separate applications should be made for registration of each work;
- c. Each application should be accompanied by the requisite fee prescribed in the second schedule to the Rules ; and
- d. The applications should be signed by the applicant or the advocate in whose favour a Vakalatnama or Power of Attorney has been executed. The Power of Attorney signed by the party and accepted by the advocate should also be enclosed.
- e. Each and every column of the Statement of Particulars and Statement of Further Particulars should be replied specifically.
- f. Both published and unpublished works can be registered. Copyright in works published before 21st January, 1958, i.e., before the Copyright Act, 1957 came in force, can also be registered, provided the works still enjoy copyright.
- g. Three copies of published work may be sent along with the application.

If the work to be registered is unpublished, a copy of the manuscript has to be sent along with the

application for affixing the stamp of the Copyright Office in proof of the work having been registered. In case two copies of the manuscript are sent, one copy of the same duly stamped will be returned, while the other will be retained, as far as possible, in the Copyright Office for record and will be kept confidential. It would also be open to the applicant to send only extracts from the unpublished work instead of the whole manuscript and ask for the return of the extracts after being stamped with the seal of the Copyright Office.

When a work has been registered as unpublished and subsequently it is published, the applicant may apply for changes in particulars entered in the Register of Copyright in Form V with prescribed fee.

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

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

Q. What does copyright cover?

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

Q. Why should copyright be protected?

Copyright ensures certain minimum safeguards of the rights of authors over their creations, thereby protecting and rewarding creativity. Creativity being the keystone of progress, no civilized society can afford to ignore the basic requirement of encouraging the same. Economic and social development of a society is dependent on creativity. The protection provided by copyright to the efforts of writers, artists, designers, dramatists, musicians, architects and producers of sound recordings, cinematograph films and computer software, creates an atmosphere conducive to creativity, which induces them to create

more and motivates others to create.

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

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

Q. What is the definition of a computer program?

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

Q. What is the term of a copyright?

- a. If published within the life time of the author of a literary work the term is for the life time of the author plus 60 years.
- b. For cinematography films, records, photographs, posthumous publications, anonymous' publication, works of government and international agencies the term is 60 years from the beginning of the calendar year following the year in which the work was published.
- c. For broadcasting the term is 25 years from the beginning of the calendar year following the year, in which the broadcast was made.
- d. In the case of anonymous or pseudonymous works, the copyright is for 60 years from the end of the year in which the work is made available to the public with the consent of the owner of the copyright or from the end of the year in which it is reasonable to presume that the author died, which ever term is shorter.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Address of Indian Copyright Office

Ministry of Human Resource Development,
Government of India
B-2/W-3, Curzon Road Barracks,
Kasturba Gandhi Marg,
New Delhi - 110001

5. PATENT

Definition: A Patent is an exclusive right granted by the government to the owner of the invention for a limited period to make, use, manufacture and market the invention, provided the invention satisfy the following criteria:

- **Novelty:** not known as prior art
- **Non- obviousness:** Must involve inventiveness
- **Usefulness:** Invention must have industrial application

TRIPS Agreement : The TRIPS agreement says that granting protection through patent should have following provisions:

- Patent protection must be available for inventions for at least 20 years.
- Patent protection must be available for both products and processes, in almost all fields of technology.
- Governments can refuse to issue a patent for an invention if its commercial exploitation is prohibited for reasons of public order or morality.
- Governments can also exclude diagnostic, therapeutic and surgical methods, plants and animals (other than microorganisms), and biological processes for the production of plants or animals (other than microbiological processes).
- Plant varieties, however, must be protectable by patents or by a special system (such as the breeder's rights provided in the conventions of UPOV).
- The agreement describes the minimum rights that a patent owner must enjoy.
- TRIPS Agreement also allows certain exceptions. A patent owner could abuse his rights, for example by failing to supply the product on the market. To deal with that possibility, the agreement says governments can issue "compulsory licenses", allowing a competitor to produce the product or use the process under license. But this can only be done under certain conditions aimed at safeguarding the legitimate interests of the patent-holder.
- If a patent is issued for a production process, then the rights must extend to the product directly obtained from the process. Under certain conditions alleged infringers may be ordered by a

court to prove that they have not used the patented process.

- Member countries agreed that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. They underscored countries' ability to use the flexibilities that are built into the TRIPS Agreement. And they agreed to extend exemptions on pharmaceutical patent protection for least-developed countries until 2016. On one remaining question, they assigned further work to the TRIPS Council — to sort out how to provide extra flexibility, so that countries unable to produce pharmaceuticals domestically can import patented drugs made under compulsory licensing.
- A patent shall confer on its owner the following exclusive rights:
 - (a) where the subject matter of a patent is a product, to prevent third parties not having the owner's consent from the acts of: making, using, offering for sale, selling, or importing for these purposes that product;
 - (b) where the subject matter of a patent is a process, to prevent third parties not having the owner's consent from the act of using the process, and from the acts of: using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.
 - (c) Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.
- Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.
- Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application.
- Where the law of a Member allows for other use of the subject matter of a patent without the authorization of the right holder, including use by the government or third parties authorized by the government, the following provisions shall be respected:

- authorization of such use shall be considered on its individual merits;
- such use may only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. This requirement may be waived by a Member in the case of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use. In situations of national emergency or other circumstances of extreme urgency, the right holder shall, nevertheless, be notified as soon as reasonably practicable. In the case of public non-commercial use, where the government or contractor, without making a patent search, knows or has demonstrable grounds to know that a valid patent is or will be used by or for the government, the right holder shall be informed promptly;
- the scope and duration of such use shall be limited to the purpose for which it was authorized, and in the case of semi-conductor technology shall only be for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive;
- such use shall be non-exclusive

Patenting in India

The basic philosophy of the Act is that patents are granted to encourage inventions and utilize them at a commercial scale without undue delay. The said philosophy is being implemented through compulsory licensing. It may, however, be noted that products vital for our economy such as agriculture & horticulture products, atomic energy inventions and all living things are not patentable. Thus, the Patents Act 1970 was expected to provide a reasonable balance between adequate and effective protection of patents on the one hand and the technology development, public interest and specific needs of the country on the other hand.

- India was put under the contractual obligation to amend its patents act in compliance with the provisions of TRIPS. India had to meet the first set of requirements on 1-1-1995. This was to give a pipeline protection till the country starts giving product Patent. It came to force on 26th March 1999 retrospective from 1-1-1995. It lays down the provisions for filing of application for product patent in the field of drugs or medicines with effect from 01.01.1995 and grant of Exclusive Marketing rights on those products.

- India amended its Patents Act again in 2002 to meet with the second set of obligations (Term of Patent etc.), which had to be effected from 1-1-2000. This amendment, which provides for 20 years term for the patent, Reversal of burden of proof etc. came into force on 20th May, 2003. The Third Amendment of the Patents Act 1970, by way of the Patents (Amendment) Ordinance 2004 came into force on 1st January, 2005 incorporating the provisions for granting product patent in all fields of Technology including chemicals, food, drugs & agrochemicals and this Ordinance is replaced by the Patents (Amendment) Act 2005 which is in force now having effect from 1-1-2005.
- The Government brought into force Patents Rules, 1972 w.e.f. 20.4.1972. These Rules were amended on 2.6.99 and replaced by the Patents Rules 2003 w.e.f. 20.5.2003 and further it is amended by the Patents (Amendment) Rules 2005, which is in force now; this includes provisions relating to time-lines with a view to introducing flexibility and reducing processing time gradually for patent applications, and simplifying and rationalizing procedure for grant of the patent.

Frequently Asked Questions

Q. What is a patent?

A patent is an exclusive right granted by a country to the owner of an invention to make, use, manufacture and market the invention, provided the invention satisfies certain conditions stipulated in the law. Exclusivity of right implies that no one else can make, use, manufacture or market the invention without the consent of the patent holder. This right is available only for a limited period of time. However, the use or exploitation of a patent may be affected by other laws of the country which has awarded the patent.

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

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

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

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

An invention must satisfy the following three conditions of :

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

- **Novelty** : An invention will be considered novel if it does not form a part of the global state of the art. Information appearing in magazines, technical journals, books, newspapers etc. constitute the state of the art. Oral description of the invention in a seminar/conference can also spoil novelty. Novelty is assessed in a global context. An invention will cease to be novel if it has been disclosed in the public through any type of publications anywhere in the world before filing a patent application in respect of the invention. Prior use of the invention in the country of interest before the filing date can also destroy the novelty. Novelty is determined through extensive literature and patent searches. It should be realized that patent search is essential and critical for ascertaining novelty as most of the information reported in patent documents does not get published any where else.
- **Inventiveness (Non-obviousness)**: A patent application involves an inventive step if the proposed invention is not obvious to a person skilled in the art i.e., skilled in the subject matter of the patent application. The prior art should not point towards the invention implying that the practitioner of the subject matter could not have thought about the invention prior to filing of the patent application. Inventiveness cannot be decided on the material contained in unpublished patents. The complexity or the simplicity of an inventive step does not have any bearing on the grant of a patent. In other words a very simple invention can qualify for a patent, if there is an inventive step between the proposed patent and the prior art at that point of time, then an invention has taken place.
- **Usefulness**: An invention must possess utility for the grant of patent No valid patent can be granted for an invention devoid of utility.

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

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

- **Inventive step means** a feature that makes the invention not obvious to a person skilled in the art.
- **Capable of Industrial application** means that the invention is capable of being made or used

in an industry. However, inventions claiming substance intended for use, or capable of being used, as food or as medicine or drug or relating to substances prepared or produced by chemical processes (including alloys, optical glass, semiconductors and inter-metallic compounds) are not patentable. Only process claims are allowed in such cases. Meaning of chemical process would also include the biochemical, biotechnological and microbiological process.

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

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

- an invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human , animal or plant life or health or to the environment;
- the mere discovery of scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;
- a substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- a method of agriculture or horticulture;
- any process for medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- plants and animals in whole or any part thereof other than microorganisms but including

seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;

- mathematical or business method or a computer program per se algorithms
- a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- a mere scheme or rule or method of performing mental act or method of playing game;
- a presentation of information
- topography of integrated circuits
- an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components
- inventions relating to atomic energy

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

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

Q. Can a published or disclosed invention be patented?

No, publication of an invention in any form by the inventor before filing of a patent application would disqualify the invention to be patentable. Hence, inventors should not disclose their inventions before filing the patent application. The invention should be considered for publication after a patent application has been filed. Thus, it can be seen that there is no contradiction between publishing an inventive work and filing of patent application in respect of the invention.

Q. What is considered as the date of patent?

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

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

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

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

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

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

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

(i) Provisional Specification and (ii) Complete Specification

Provisional Specification

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

Complete Specification

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

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

3. Background of the invention including prior art giving drawbacks of the known inventions & practices.
4. Complete description of the invention along with experimental results.
5. Drawings etc. essential for understanding the invention.
6. Claims, which are statements, related to the invention on which legal proprietorship is being sought. Therefore the claims have to be drafted very carefully.

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

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

- i. All persons who contribute towards development of patentable features of an invention should be named inventor(s).
- ii. All persons, who have made intellectual contribution in achieving the final results of the research work leading to a patent, should be named inventor(s).
- iii. A person who has not contributed intellectually in the development of an invention is not entitled to be included as an inventor.
- iv. A person who provides ideas needed to produce the 'germs of the invention' need not himself / herself carry out the experiments, constructs the apparatus with his/her own hands or make the drawings himself/herself. The person may take the help of others. Such person who have helped in conducting the experiments, constructing apparatus or making the drawings or models without providing any intellectual inputs are not entitled to be named inventors. Quite often difficulties are experienced in deciding the names of inventors. To avoid such a situation, it is very essential that all scientists engaged in research should keep factual, clear and accurate recorded of daily work done by them in the form of diary. The pages in the diary should be consecutively numbered and the entries made be signed both by the scientists and the concerned leader.

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

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

absence of details about the invention. Following points should be kept in mind while discussing with the attorney:

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

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

After the Patent Office has examined an application and found it in order for grant of a patent, it

publishes the title of the invention, name of the inventor(s) and the applicant(s), abstract of the invention, drawings and claims in the Gazette of India, Part III Section 2, for interested parties to oppose the grant of the patent. An application for opposition may be filed at the concerned Patent Office branch within four months of the date of the issue of the concerned gazette. An extension of one month is possible; a request for extension has to be made within the first four months. Typed or photocopies of the specification together with photocopies of the drawings, if any, can be obtained from the Patent Office, Calcutta or the concerned branch office on payment of the prescribed fees. One would like to oppose if the idea of the accepted application infringes upon one's invention/existing patent, if the coverage of the proposed patent is very wide which may be detrimental to one's research or if the idea is not novel and so on.

Q. What are patentability searches?

Patentability search is a search for invention in hope of not finding the same invention. For this various data bases (Paid or Unpaid) are to be scanned. The patentability search is an universal concept since inventions can not be boundary constraint. But it is to be noted that the patent laws are territorial.

Computer databases search is quick and relatively inexpensively. Database searches are most useful in searching sophisticated inventions, which can be described by precise, well-known terms of art. They are much less useful in searching mechanical gadget type inventions.

No search will "guarantee" the patentability of any invention. The object is to make a reasonable assessment of the prospects for obtaining worthwhile patent protection. Search results are also useful in preparing a patent application.

Q. What is the distinction between patented inventions and know-how?

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

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

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

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

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

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

The Indian Patent Act has no specific provision for patenting of microorganisms and microbiological processes. However, as a matter of practice microorganisms per se are not patentable in India. (However, a recent decision of the Kolkata High Court has held that microbiological processes are patentable in India). In order to meet the obligation under TRIPS. India is required to introduce a patenting of microorganisms. Draft laws in this regards have been formulated. It may, however, be noted that many countries allow both process and product patents in regard to microbiological inventions and microorganism per se. all such countries allow patenting of genetically modified microorganisms but a few also allow patenting of naturally occurring microorganisms if isolated from nature for the first time and if other conditions of patentability are satisfied.

Q. What is patent cooperation treaty (PCT)?

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

Q. Who coordinates the activities of PCT ?

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

Q. What is the need for PCT ?

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

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

Q. How are patent applications under PCT handled?

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

Q. What is the meaning of delayed processing of the application by the national phase or the regional phase?

A search report on the patent application filed with a receiving office is received by the applicant/inventor 16 months after the priority date which is nothing but the date of submitting the

application in the receiving office. The International Bureau of the WIPO publishes the application and the search report 18 months after the priority date. The original application is then sent to the designated offices indicated in the application. Within two months of this i.e. by the 20th month, the applicant will have to formally apply to the patent offices of these countries for grant of patents by paying official fees and completing other formalities stipulated by these offices (some countries). In case translated copies of the application are required, the same has to be furnished by the applicant. In spite of submitting the request for grant of patents in designated countries in the 20th month after the priority date, the priority in these countries is the same as the date of filing the original PCT application.

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

Q. Which is the appropriate office in India in relation to international applications?

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

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

Q. Will an international application designating India be treated as an application for grant of patent under the 1970 Act?

Yes, an international application designating India shall be treated as an application for patent under the Act.

Q. Where do you pay the fees and in which currency?

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

Office Address	Contact Persons
<p>The Patent Office, Intellectual Property Office Building, CP-2 Sector V, Salt Lake City, Kolkata-700091, Phone : 23671945, 1946, 1987, FAX-033-2367-1988, Email:- kolkata-patent@nic.in</p>	<p>i) Shri N.R. Seth Deputy Controller of Patents & Designs</p> <p>ii) Dr. Amitava Chakraborty Assistant Controller of Patents & Designs</p>
<p>The Patent Office, Intellectual Property Office Building, Plot No. 32, Sector 14, Dwarka, New Delhi-110075, Phone : 011-28081923-25, FAX:011-28081920-40, Email: delhi-patent@nic.in</p>	<p>i) Shri P.K. Patni Deputy Controller of Patents & Designs</p> <p>ii) Shri B.P. Singh Assistant Controller of Patents & Designs</p>
<p>The Patent Office, Intellectual Property Office Building, G.S.T. Road, Guindy, Chennai-600032, Phone: 044-22322824-25, FAX: 044-22322878, Email: chennai-patent@nic.in</p>	<p>i) Shri K.M. Viswanathan Assistant Controller of Patents & Designs</p> <p>ii) Shri V. Rengasamy Assistant Controller of Patents & Designs</p>
<p>Patent Office Boudhik Sampada Bhawan, S.M.Road, Near Antop Hill Post Office, Antop Hill, Mumbai - 400 037. Phone : 24137701, 24141026, 24150381, 24148165, 24171457 FAX : 24130387 EMAIL: mumbai-patent@nic.in</p>	<p>i) Shri M.A. Haafeez Assistant Controller of Patents & Designs</p> <p>ii) Shri Rakesh Kumar Assistant Controller of Patents & Designs</p>

6. GEOGRAPHICAL INDICATIONS

Definition: Geographical indications (GI) are indications that identify a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographic origin.

Geographical indications serve the same functions as trademarks, because like trademarks they are:

1. source-identifiers,
2. guarantees of quality, and
3. valuable business interests.

History speaks of Christopher Columbus charting out a new route to India, lured by the wealth of its spices, while English breeders imported Arabian horses to sire Derby winners. China silk, Dhaka muslin, Venetian glass all have reputations carefully built up and meticulously maintained by the masters of that region, combining the best of Nature and Man. In recent times, GIs have emerged as one of the important features of the IPR regime of India. After the Geographical Indications Act came into force on September 15, 2003, many famous products of India such as Darjeeling tea, Panchampalli and Chanderi silk, have been notified as GIs. A Geographical Indication (GI) is an indication which identifies agricultural, natural or manufactured goods originating from a definite geographical territory, as having a special quality or reputation or other characteristics.

Examples of geographical indications from the United States include: "*FLORIDA*" for oranges; "*IDAHO*" for potatoes; "*VIDALIA*" for onions; and "*WASHINGTON STATE*" for apples. Geographical indications are valuable to producers for the same reason that trademarks are valuable. Well-known examples from Europe include "Champagne", "Scotch", "Tequila", and "Roquefort" cheese. Wine and spirits makers are particularly concerned about the use of place-names to identify products, and the TRIPS Agreement contains special provisions for these products. But the issue is also important for other types of goods.

TRIPS Agreement on Geographical Indications

Using the place name when the product was made elsewhere or when it does not have the usual characteristics can mislead consumers, and it can lead to unfair competition. The TRIPS Agreement says countries have to prevent this misuse of place names.

For wines and spirits, the agreement provides higher levels of protection, i.e. even where there is no danger of the public being misled.

Some exceptions are allowed, for example if the name is already protected as a trademark or if it has become a generic term. For example, “cheddar” now refers to a particular type of cheese not necessarily made in Cheddar, in the UK. But any country wanting to make an exception for these reasons must be willing to negotiate with the country which wants to protect the geographical indication in question. The agreement provides for :

1. Protection of Geographical Indications

- Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.
- In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:
 - (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;
 - (b) any use which constitutes an act of unfair competition within the meaning of Article 10*b* of the Paris Convention (1967).
- A Member shall, *ex officio* if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.

1. Additional Protection for Geographical Indications for Wines and Spirits

- Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.
- The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical

indication identifying spirits shall be refused or invalidated, *ex officio* if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

- In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.
- In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

3. International Negotiations; Exceptions

- Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23. The provisions of paragraphs 4 through 8 below shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.
- The Council for TRIPS shall keep under review the application of the provisions of this Section; the first such review shall take place within two years of the entry into force of the WTO Agreement. Any matter affecting the compliance with the obligations under these provisions may be drawn to the attention of the Council, which, at the request of a Member, shall consult with any Member or Members in respect of such matter in respect of which it has not been possible to find a satisfactory solution through bilateral or plurilateral consultations between the Members concerned. The Council shall take such action as may be agreed to facilitate the operation and further the objectives of this Section.
- In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.
- Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection

with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date.

- Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:
 - before the date of application of these provisions in that Member as defined in Part VI; or
 - before the geographical indication is protected in its country of origin;
- measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.
- Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.
- A Member may provide that any request made under this Section in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Member or after the date of registration of the trademark in that Member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that Member, provided that the geographical indication is not used or registered in bad faith.
- The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.
- There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

Protection of Geographical Indications in India

WTO Members and their nationals are increasingly recognizing that geographical indications are valuable as marketing tools in the global economy. Furthermore, intellectual property owners are finding that protecting IP is no longer just a domestic endeavor.

The TRIPS Agreement is the, first multilateral agreement dealing with GIs. India being a party to the TRIPS Agreement is required to protect GIs: necessitating the enactment of the Geographical Indications of Goods (Registration and Protection) Act, 1999. In December 1999, the Parliament had passed the Geographical Indications of Goods (Registration and Protection) Act, 1999. This Act seeks to provide for the registration and better protection of geographical indications relating to goods in India. The Act would be administered by the Controller General of Patents, Designs and Trade Marks- who is the Registrar of Geographical Indications. The Geographical Indications Registry is located at Chennai.

The main benefits of registration under the Act are legal protection to GIs in India, preventing unauthorized use of a registered GI by others, boosting exports of Indian GIs, promoting economic prosperity of producers and legal protection in other WTO member countries.

While GIs are accorded protection within a country, it is difficult to get similar protection in other countries. This could be achieved through bilateral agreements. So, if India and the EU decide to include GIs in the trade and investment agreement that they are currently negotiating, they would be according protection to their GIs in each other's markets

Frequently Asked Questions

Q. What does the term 'Geographical Indications stand for?

The term GI has been defined as "Geographical Indications", in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristics of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.

Q. Who can apply for Geographical Indications' registration?

Any association of persons or producers or any organization or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who

are desirous of registering geographical indication in relation to such goods shall apply in writing to the Registrar in such' form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.

Q. Which of the geographical indication cannot be registered?

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

Q. What is the punishment in the Act for falsifying GI?

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

Q. What is term of GI protection?

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

Q. What is a Geographical Indication?

- It is an indication
- It originates from a definite geographical territory.
- It is used to identify agricultural, natural or manufactured goods
- The manufactured goods should be produced or processed or prepared in that territory.
- It should have a special quality or reputation or other characteristics

Q. Examples of possible Indian Geographical Indications.

- Basmati Rice, Darjeeling Tea, Kanchipuram Silk Saree, Alphonso Mango, Nagpur Orange, Kolhapuri Chappa, Bikaneri Bhujia, Agra Petha

Q. What is the benefit of registration of geographical indications?

- It confers legal protection to Geographical Indications in India
- Prevents unauthorized use of a Registered Geographical Indication by others
- It provides legal protection to Indian Geographical Indications which in turn boost exports.
- It promotes economic prosperity of producers of goods produced in a geographical territory.

Q. Who can apply for the registration of a geographical indication?

- Any association of persons, producers, organization or authority established by or under the law can apply:
- The applicant must represent the interest of the producers
- The application should be in writing in the prescribed form
- The application should be addressed to the Registrar of Geographical Indications alongwith prescribed fee.

Q. Who is a registered proprietor of a geographical indication?

- Any association of persons, producers, organization or authority established by or under the law can be a registered proprietor.
- Their names should be entered in the Register of Geographical Indication as registered proprietor for the Geographical Indication applied for.

Q. Who is an authorized user?

- A producer of goods can apply for registration as an authorized user
- It must be in respect of a registered geographical indication
- He should apply in writing in the prescribed form alongwith prescribed fee

Q. Who is a producer in relation to a Geographical Indication?

The persons dealing with three categories of goods are covered under the term Producer:

- Agricultural Goods includes the production, processing, trading or dealing
- Natural Goods includes exploiting, trading or dealing
- Handicrafts or Industrial goods include making, manufacturing, trading or dealing.

Q. Is a registration of a geographical indication compulsory and how does it help the applicant?

- Registration is not compulsory
- Registration affords better legal protection to facilitate an action for infringement
- The registered proprietor and authorized users can initiate infringement actions
- The authorized users can exercise the exclusive right to use the geographical indication.

Q. Who can use the registered geographical indication?

An authorized user has the exclusive rights to the use of geographical indication in relation to goods in respect of which it is registered.

Q. How long the registration of Geographical Indication is valid?

The registration of a geographical indication is valid for a period of 10 years.

Q. Can a Geographical Indication be renewed?

It can be renewed from time to time for further period of 10 years each.

Q. What is the effect if a Geographical Indication if it is not renewed?

If a registered geographical indication is not renewed it is liable to be removed from the register.

Q. When is a registered Geographical Indication said to be infringed?

- When an unauthorized 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.

- When the use of geographical indication result in an unfair competition including passing off in respect of registered geographical indication.
- 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.

Q. Who can initiate an infringement action?

The registered proprietor or authorized users of a registered geographical indication can initiate an infringement action.

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

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

Q. Can a registered geographical indication or a registered authorized user be removed from the register?

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

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

- 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.
- Whereas a geographical indication is an indication used to identify goods having special characteristics originating from a definite geographical territory.

Office Address	Contact Persons
Geographical Indications Registry, Intellectual Property Office Building,G.S.T. Road, Guindy, Chennai 600032, Phone : 044-22321992-93, 22321996, Fax : 044-22321991	Shri. V. Natrajan Assistant Registrar of Geographical Indications

7. DESIGNS AND LAYOUTS

Definition: Industrial designs refer to creative activity which result in the ornamental or formal appearance of a product and design right refers to a novel or original design that is accorded to the proprietor of a validly registered design. Industrial designs are an element of intellectual property.

TRIPS Agreement

Under the TRIPS Agreement, industrial designs must be protected for at least 10 years. Owners of protected designs must be able to prevent the manufacture, sale or importation of articles bearing or embodying a design which is a copy of the protected design.

This agreement adds a number of provisions:

- Protection must be available for at least 10 years.
- Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.
- Each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.
- The owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.
- Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

Design Protection in India

Under the TRIPS Agreement, minimum standards of protection of industrial designs have been provided for. As a developing country, India has already amended its national legislation to provide for these minimal standards. The essential purpose of design law is to promote and protect the design element of industrial production. It is also intended to promote innovative activity in the field of industries. The existing legislation on industrial designs in India is contained in the New Designs Act, 2000 and this Act will serve its purpose well in the rapid changes in technology and international developments. India has also achieved a mature status in the field of industrial designs and in view of globalization of the economy, the present legislation is aligned with the changed technical and commercial scenario and made to conform to international trends in design administration. This replacement Act is also aimed to enact a more detailed classification of design to conform to the international system and to take care of the proliferation of design related activities in various fields.

Frequently Asked Questions

Q. What does the term 'Design' mean according to the Designs Act, 2000?

"Design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device.

Q. What are the designs not registrable under the Act?

A design which:

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

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

Article means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

Q. What is the object of registration of designs?

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

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

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

design suggests any mode or principle of construction or mechanical or other action of a mechanism, a suitable disclaimer in respect there of is required to be inserted on its representation, provided there are other registrable features in the design.

6. The design should not include any trade mark or property mark or artistic works.

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

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

Q. When does the applicant for registration of design get the registration certificate?

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

Q. What is a Register of Designs?

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

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

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

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

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

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

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

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

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

Q. Are the registered designs open for public inspection?

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

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

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

Q. Can the registration of a design be cancelled?

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

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

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

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

Q. What does Hague Agreement on Industrial Designs signify?

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

Q. What are the changes made to the Hague Agreement?

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

1. International design protection will be available to nationals of a contracting country, domiciled in a contracting country or have industrial or commercial establishment in a contracting state.
2. An international design application may be filed either at the applicant's national office or directly with the International Bureau of WIPO.
3. Two-dimensional designs (textile designs) would be eligible for protection.
4. A formalities examination will be carried out by the International Bureau and then the application will be published if it is found to satisfy the formalities. The publication will be made six months

after the registration. This can be deferred to 30 months in some special cases.

5. The International Bureau will, after the registration, send a copy of the application to each of the designated countries. These countries have to inform the Bureau within six months if national requirements are not met. However, countries that examine design applications for novelty or where opposition system exists, this time is increased to 12 months.
6. Multiple designs may be included in the same application. It is however, required that all products to which such designs relate must be in the same class under the Locarno classification.

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

Office Address	Contact Persons
<p>The Patent Office(Designs Wing), Intellectual Property Office,CP-2 Sector V, Salt Lake City, Kolkata-700091 Phone No. 033-23671945-46, 23671987 FAX-033-23671988, Email:- kolkata-patent@nic.in</p> <p>Note : Application for Design can also be received by any of the Patent Office located at New Delhi, Chennai & Mumbai.</p>	<p>i) Shri M.S. Venkataraman Deputy Controller of Patents & Designs</p> <p>ii) Shri G.P. Roy Assistant Controller of Patents & Designs</p>

8. TRADEMARK

Definition: A trade mark (popularly known as brand name) in layman's 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. In summary-

- 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.

The legal requirements to register a trade mark under the Indian 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.

TRIPS Agreement

The agreement defines what types of signs must be eligible for protection as trademarks, and what the minimum rights conferred on their owners must be. It says that service marks must be protected in the same way as trademarks used for goods.

- 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. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

- Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.
- Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.
- The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.
- Initial registration and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.
- Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

Trademark Protection in India

The Trade Marks Registry was established in India in 1940 and presently it administers the Trade Marks Act, 1999 and the rules thereunder. It acts as a resource and information centre and is a facilitator in matters relating to trade marks in the country.

The objective of the Trade Marks Act, 1999 and Rules, 2002 is to register trade marks applied for in the country and to provide for better protection of trade mark for goods and services and also to prevent fraudulent use of the mark. The main function of the Registry is to register trade marks which qualifies for registration under the Act and Rules.

Frequently Asked questions:

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

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

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

Q. How is "Trademark" defined?

Trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of other and may include shape of goods, their packaging and combination of colours; and

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

Q. What are "Well-known Trademarks" and "Associated Trademarks"?

Well-known trademark in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services. Associated Trademarks means trademarks deemed to be, or required to be, registered as associated trademarks under this Act.

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

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

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

Certification trade mark means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name as proprietor of the certification trade mark, of that person.

Collective Mark means a trademark distinguishing the goods or services of members of an association of persons (not being a partnership within the meaning of the Indian Partnership Act, 1932) which is the proprietor of the mark from those of others.

Q. What is the term of a registered trademark?

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

Q. What is the Madrid Agreement?

The Madrid Agreement was adopted on April 14, 1891 to facilitate protection of a trademark or service mark in several countries by means of a single international registration. As on July 15, 1999, 54 countries are party to this Agreement mainly belonging to Europe, countries of Africa and four countries

in the Far East namely, China, the Democratic People's Republic of Korea, Mongolia and Vietnam. The United Kingdom, the United States of America, most Latin American countries, Japan and India are not signatories to this agreement. The Agreement covers both trademarks and service marks.

Q. How to select a trade mark?

- 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.

Q. What is the function of a trade mark?

Under modern business condition a trade mark performs four functions

Q. Who can apply for a trade mark and how?

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.

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

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.

Q. What are different types of trade marks available for adoption?

- 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.

Q. What purpose the trade mark system serves?

- 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.

Q. Who benefits from a trade mark?

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 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.

Q. What are the benefits of registering a trade mark?

The registration of a trade mark confers upon the owner the exclusive right to the use of the registered trade mark and indicates 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.

Q. What are the sources of trade mark laws?

- (1) The National Statue, 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 academician and professional experts.

Q. What does the Register of trade mark contain ?

The register of trade mark currently maintained in electronic form contains interalia 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.

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

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.

Q. 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.

Office Address	Contact Persons
Office of the Trade Marks Registry, Bhoudhik Sampada Bhavan, Near Antop Hill Head Post Office, S.M. Road, Antop Hill, Mumbai-400037, Email : tmrmmum@bom5.vsnl.net.in	Shri V. Ravi Joint Registrar of Trade Marks
Trade Marks Registry, Intellectual Property Office Building, CP-2 Sector V, Salt Lake City, Kolkata 700091, Phone : 033-23675975, 23672848, 23677307, Fax : 033-23677311, Email : tmrcalbr@cal2.vsnl.net.in	Shri M.H. Mahendra Joint Registrar of Trade Marks
Trade Marks Registry, Intellectual Property Office Building IP Building, G.S.T. Road, Guindy, Chennai 600032, Tele-Fax : 044-22322441 (Direct No. 044-22322360), Tele : 044-22322442 Email : tmrchennai@nic.in	Sri M.C. Gupta, Dy. Registrar Trademerk
Trade Marks Registry, National Chambers, 15/27, 1 st floor, Ashram Road, Ahmedabad 380009, Phone: 079-26580567, 26587193, Fax :079-26586763, Email : tmrahm@ad1.vsnl.net	Shri Dharam Singh Assistant Registrar of Trade Marks

9. UNDISCLOSED INFORMATION AND TRADE SECRETS

Definition: Unlike other forms of intellectual property, trade secrets are essentially internal instruments, the responsibility for their protection remaining with the owner of the secrets. They are not disclosed to any one including the Government and are kept confidential.

The most quoted trade secret and the one which has established the credibility that trade secrecy can be ensured is the case of the Coca-Cola formula, which is kept locked in a bank vault in Atlanta, can be opened only by a resolution of the company's board and is known to only two employees at the same time. The public has no access to the names of those employees and they are not allowed to fly on the same air plane. It is obvious that such extreme systems and standards for protection of trade secrets are neither necessary nor practised by many other corporations.

As the maximum number of trade secrets appropriation takes place through current or past employees, corporates, as a rule, enforce a Non-disclosure Agreement on every employee at the time of joining, so that, breach of contract can be used as the legal instrument for prosecution in case of violation. Some MNCs prevent through a contract, former employees from working for a competitor for a limited period.

TRIPS Agreement

1. In the course of ensuring effective protection against unfair competition as provided in Article 10 of the Paris Convention (1967), Members shall protect undisclosed information in accordance with this agreement.

2. Natural and legal persons shall have the possibility of preventing information lawfully within their control from being disclosed to, acquired by, or used by others without their consent in a manner contrary to honest commercial practices so long as such information:

(a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;

(b) has commercial value because it is secret; and

(c) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.

3. Members, when requiring, as a condition of approving the marketing of pharmaceutical or of agricultural chemical products which utilize new chemical entities, the submission of undisclosed test or

other data, the origination of which involves a considerable effort, shall protect such data against unfair commercial use. In addition, Members shall protect such data against disclosure, except where necessary to protect the public, or unless steps are taken to ensure that the data are protected against unfair commercial use.

Trade secrets protection in India

Under Article 39 of TRIPS, members are obliged to ensure protection of undisclosed information through systems developed through appropriate legislations.

Trade secrets and other types of “undisclosed information” which have commercial value are be protected against breach of confidence and other acts contrary to honest commercial practices. But reasonable steps have to be taken to keep the information secret. Test data submitted to governments in order to obtain marketing approval for new pharmaceutical or agricultural chemicals must also be protected against unfair commercial use. Documentation of this knowledge in India is being done to bring it under legal protection.

Apart from the need for prevention of illegal use of trade secrets, India has yet another relatively unique situation, where a large repository of knowledge and practices are locked up with our traditional vaidyas, hakims, artists and artisans, which remain as trade secrets and have current or potential commercial value. Their protection is vital for the survival of these systems and practices. India has initiated protection of Undisclosed Information/Trade Secrets?

To protect the vast repository of Undisclosed Information and knowledge kept as trade secrets by their practitioners, India has taken pro-active initiatives as provided for under Art. 10 bis of the Paris Convention and Article 39(2) and 39(3) of TRIPS. These steps along with provisions under Breach of Contract or **Non-disclosure Agreement**, would go a long way in developing a culture in the industrial circles to respect trade secrets and undisclosed information as proprietary assets of their owners.

10. PROTECTION OF PLANT VARIETIES AND FARMERS' RIGHTS

The Protection of Plant Varieties have been in focus worldwide after the implementation of WTO rules and regulations. In article 27.3 (B) of the section on TRIPS under GATT 1994 there is provision under TRIPS that member nations are required to grant patents on microorganisms, non/biological and microbiological processes as well as effective IPR protection for plant varieties. TRIPS provide a choice for protecting plant varieties. Members may choose from patents or a *sui generis* system (particular to the nation) or a combination of the two. India has adopted *sui-generis* system and brought "Protection of Plant Varieties and Farmers' Rights Act 2001" and Rules 2003. The PPV&FRA 2001 enacted by India is undoubtedly the trend setter as it is the only one that covers both plant breeders' and farmers' rights. Hailed as progressive, pro/developing country legislation, this law provides for well-defined Breeder's Rights as well as strong and proactive Farmers Rights.

Main aim of the PPV & FR Act

- To encourage scientists, farmers, communities for the development of new plant varieties having quality and production potential
- Registration of varieties for legal protection
- Characterization and documentation of registered varieties
- Ensuring the availability of quality seeds of registered varieties under this Act
- Establishing Gene Funds for rewards and compensation

Protectable Plant Varieties

If the variety confirms the criteria of Novelty, Distinctiveness, Uniformity, and Stability, they can be protected. Any person claiming to be the breeder of variety can apply for protection. The criteria for distinctiveness, uniformity and stability have their usual meanings. However, there are some unique features that the denomination must satisfy to qualify as a registrable variety, and it cannot be registered if the denomination given to such variety:

- is not capable of identifying such variety;
- consists solely of figures;
- is liable to mislead or to cause confusion concerning the characteristics, value, identity of such variety, or the identity of the breeder of such variety;

- is not different from every denomination that designates a variety of the same botanical species or of a closely related species registered under the Act;
- is likely to deceive the public or cause confusion in the public regarding the identity of such variety;
- is likely to hurt the religious sentiments, respectively, of any class or section of the citizens of India;
- is prohibited for use as a name or emblem for any of the purposes mentioned in Section 3 of the Emblems and Names (Protection of improper use) Act, 1950 (52 of 1950); or
- is comprised solely or partly of a geographical name.

The registration form and the annexure can be filed either by the plant breeder or by the company or farmer (s) or through their agent. These varieties can be:

- **Extant Varieties:** Varieties notified under section 5 of the seed Act 1966 and also the varieties in public domain are called extant varieties.
- **Farmers' Varieties/ Community Varieties:** These varieties are traditionally cultivated and evolved by the farmers in their fields. The wild relatives, land races which the farmer possesses also fall in this category.
- **Essentially Derived Varieties:** These varieties are predominantly derived from initial variety that retains the characters of initial variety and clearly distinguishable from such initial variety at least for one trait.

RIGHTS UNDER THIS ACT

➤ Farmers' Rights

The Act recognises the farmer not just as a cultivator but also as a conservator of the agricultural gene pool and a breeder who has bred several successful varieties. There are provisions for such farmers' varieties to be registered with the help of NGOs or institutions so that they are protected against being scavenged by formal sector breeders. The main provisions are:

- Farmer who bred variety are equated with plant breeder for registration, royalty sharing, recognition and rewards

- Will be entitled to save, reuse, exchange, share the seed of all varieties
- Farmers or group of farmers will not be liable to pay any fee in any proceeding before the authority
- Farmer will not be entitled to sell registered variety through labeling and packaging
- Farmer may claim compensation from the breeder if the variety fail to give projected performance. However, it will be decided by the PPV & FR Authority keeping in view the whole circumstances.

➤ **Breeders'/ Researchers' Rights**

- The Act provides exclusive right to breeder or his successor, agent or licensee to produce, market, sell, distribute, import and export of seed of his registered variety.
- Use of others' protected variety for research and developing new variety, but for the repeated use for commercial exploitation the authorization of breeder will be required.
- Breeder will be entitled to get royalty

➤ **Rights of Communities**

- Compensation will have to be paid by the breeder if village or local community contribution in the development of the variety.
- PPV &FR Authority will decide compensation from the gene funds.

KEY INSTRUMENTS FOR IMPLEMENTATION OF THIS NEW ACT:

1. Establishment of the Protection of Plant Varieties and Farmers' Rights Authority consisting of a Chairperson and 15 members appointed by the Central Government. The Authority's Head Office is at NAS Complex, DPS Road, New Delhi. More information can be seen on web site plantauthority.com

2. Setting up of a Plant Varieties Protection Appellate Tribunal to deal with any appeal on order or decision of the authority or Registrar relating to registration of the variety, registration of an agent or a licensee of a variety, claim for benefit sharing, revocation of compulsory license or modification of compulsory license, or payment of compensation under the Act or its rules.

3. Establishment of the Plants Variety Registry. For the purposes of the Act, a Register called the

National Register of Plant Varieties has been established in the Registry, which contained entries of all the names of the registered plant varieties with names and addresses of their respective breeders in respect of the registered variety, the particulars of the denomination of each registered variety, its seed or other propagating material along with specification of their salient features.

Period of Registration: The registration certificate is valid for 9 years in the case of trees and vines and 6 years in the case of other crops and may be reviewed and renewed for the remaining period on payment of the prescribed fees, subject to the total period of protection not exceeding: (i) 18 years from the date of registration of the variety in the case of trees and vines; (ii) 15 years from the date of notification of the variety by the Central Government under Section 5 of the Seeds Act 1996 in the case of extant varieties; or (iii) 15 years from the date of registration of the variety in other cases.

Benefit Sharing: The Act has a unique provision for 'benefit sharing' for Indian organizations (firms, governmental or non-governmental) and group(s) of persons who are Indian citizens who would be allowed to stake claim to the benefits accruing from a registered variety.

Frequently Asked Questions on PPV&FR Legislation

Q. Why protection of plant varieties has become an important issue?

The breeding activities and exploitation of new varieties are the decisive factors for improving rural income and their overall economic development. Since the process of plant breeding is long and expensive, it is important to provide an effective system of plant variety protection with an aim to encourage the development of new varieties of plants for the benefit of society.

Q. What are Farmers' rights?

1. Farmer who has bred or developed a new variety shall be entitled for registration and other protection under PPV&FR Act, 2001 in the same manner as a breeder of a variety.
2. Farmer who is engaged in the conservation of genetic resources of land races and wild relatives of economic plants and their improvement through selection and preservation shall be entitled in the prescribed manner for recognition and reward from the Gene Fund provided that material so selected and preserved has been used as donors of genes in varieties registered under this act.
3. Farmer shall be entitled to save, use, sow, re-sow, exchange and share or sell his farm produce including seed of a variety protected under this act in the same manner as he was entitled before the coming into force of this act provided that the farmer shall not be entitled to sell branded seed of a variety protected under this act.

Q. What is the duration of protection of a registered plant variety?

The duration of protection of registered varieties is different for different crops which are as below:

1. For trees and vines – 9 years extendable to 18 years.
2. For other crops – 6 years extendable to 15 years.
3. For extant varieties – 6 years extendable to 15 years

from the date of notification of that variety by the Central Government under section 5 of the Seeds Act, 1966. Extension will be given after review

Q. Can a new and distinct plant found growing in nature be protected?

As such those plant variety present in wilderness cannot be registered, under PPV&FR Authority. However, any traditionally cultivated plant variety which has undergone the process of domestication / improvement through human interventions can be registered and protected subjected to fulfillment of the eligible criteria.

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

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

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

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

varieties within species.

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

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

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

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

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

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

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

Yes, India has enacted the New Plant Variety and Farmers Rights Protection Act in 2001 which, in

addition to meeting the technical features of UPOV, provides rights to farmers to use the seeds from their own crops for planting the next crop. Further, there are provisions for benefit sharing with farmers and penalty for marketing spurious propagation material.

Q. What are the prerequisites for filing an application form for registration of plant variety?

For registration of a plant variety the following prerequisites has to be completed:

- Denomination assigned to such variety.
- Accompanied by an affidavit that variety does not contain any gene or gene sequences involving terminator technology.
- Complete passport data of parental lines with its geographical location in India and all such information relating to the contribution if any, of any farmer (s), village, community, institution or organization etc in breeding, evolving or developing the variety.
- Characteristics of variety with description for Novelty, Distinctiveness, Uniformity and Stability.
- A declaration that the genetic material used for breeding of such variety has been lawfully acquired.
- A breeder or other person making application for registration shall disclose the use of genetic material conserved by any tribal or rural families for improvement of such variety.

Q. What comprises a plant variety protection Application Form?

The application for registration of a variety is to be made in the form prescribed by the PPV & FR Authority.

- Form I - for registration of new variety, extant variety and farmer's variety and
- Form II - for essentially derived varieties (EDVs) and transgenic varieties.
- Technical Questionnaire attached with Form I and Form II – for detailed information of the concerned variety.

These filled application forms must be accompanied by the fee prescribed by the Authority.

Q. Who can apply for the registration of a plant variety?

Application for registration of a variety can be made by any person claiming to be the breeder of the variety;

- any successor of the breeder of the variety;
- any person being the assignee or the breeder of the variety in respect of the right to make such application;
- any farmer or group of farmers or community of farmers claiming to be breeder of the variety;
- any person authorized to make application on behalf of farmers and
- any University or publicly funded agricultural institution claiming to be breeder of the variety.

Q. Which is the office for the registration of plant varieties?

Registration of plant varieties can be made in the office of Registrar, PPV&FRA, New Delhi. The address of the Office is: Registrar, Protection of Plant Varieties and Farmers' Rights Authority, Govt. of India, Ministry of Agriculture, NASC Complex, DPS Marg, Opposite Todapur, New Delhi – 110 012. Also any information regarding the protection, application, fee structure, etc. can be obtained from this office. Completed forms in triplicate, with fee/charges should be submitted to the Registrar with enclosures, TQ, affidavits in his New Delhi Office or can be sent by Registered Post. In the first instance do not send DUS test fee or seed.

Q. Can an application for registration of plant varieties be made through an agent?

Yes, a breeder or a farmer can apply for registration either in person or through his agent.

Q. Is it necessary to submit the seed / propagating material before registration?

Yes, the breeder shall be required to deposit the seed or propagating material including parental line seeds of registered variety to the Authority. An applicant has to submit a fixed amount of seed sample (breeder seed) with prescribed germination percentage, physical purity and phyto-sanitary standards. The applicant shall also submit along with the seed / propagating the seed quality test report.

Q. What is done with the seeds received by the Authority?

The seed samples received by the Authority will be properly tested for its purity and germination. A part

of the seed sample will be sent to the test centre for conduct of DUS tests and a part of it will be kept by the Authority in the National Gene Bank to maintain the seed samples of the registered varieties for their entire period of protection.

Q. Can any person get the seed samples of the registered variety or a variety undergoing the process of DUS tests?

No, any person seeking for the seed sample of a protected variety or a variety undergoing the DUS test procedure has to get permission from the Authority or the breeder of the variety.

Q. Can a person apply for registration of a variety, which is already in the market?

Any variety which is already in the market, but not for more than a year, can be applied for registration as a new variety. Other older variety can be registered as Extant Variety.

Q. What is the cost of registering a plant variety?

The fee structure as defined by the PPV&FR Authority is as below:

A. Form Charges

1. Application Form Charges: Rs 200/-

B. DUS test fee*

1. Rice, Wheat, Maize, Sorghum, Pearl millet, Rs 20,000/-

Pigeon pea, Mungbean, Urdbean, Chickpea,

Fieldpea, Lentil, Rajmash

C. Annual Fee

The Authority shall notify the amount separately in the official Gazette (in the PVJ of India).

II. Other charges:

A. Registration Charges

1 For **Extant Variety** of Common Knowledge Rs 2,000/-

where no DUS test is needed.

2. Registration Certificate charges ; Rs 5,000/-

B. DUS testsite visit charges/person/visit Rs 500/-

(To be retained at DUS test site after issue of receipt)

Q. What are the exemptions provided under the PPV & FR Act, 2001?

1. Farmers' Exemption: Farmer shall be entitled to produce, save, use, sow, resow, exchange, share or sell his farm produce including seed of a variety protected under this Act.

2. Researcher's Exemption: (i) the use of registered variety for conducting experiment.

(ii) the use of variety as an initial source of variety for the purpose of creating other varieties.

Q. What are the acts of infringement of the rights provided to the registered breeder under the Act?

Following acts may be a case of infringement under the PPV&FR Act:

1. If a person who is not a breeder of a variety registered under this act or a registered agent or a registered licensee of that variety, sells, exports, imports or produces such variety without the permission of its breeder or within the scope of a registered license or registered agency without their permission of the registered license or registered agent.

2. If a person uses, sells, exports, imports or produces any other variety giving such variety, the denomination identical with or deceptively similar to the denomination of a variety already registered under this act in such a way that it causes confusion in the mind of general people in identifying the registered variety.

Q. Is there any punishment if any person falsely represents a variety as a registered variety?

If any person falsely represents a variety as a registered variety then he shall be punishable with imprisonment for a term not less than six months which can be extended up to three years or with a fine not less than one lakh which may be enhanced to five lakhs, or both.

Q. How to get information about General and Specific Guidelines for DUS Testing?

The General and Specific Guidelines for DUS Testing of 12 notified crop species are available in Plant Variety Journal of India, Volume-1, No. 1 dated 20th February, 2007. The cost of each issue of the

Journal is Rs. 100/- or Rs.1200/- per year payable on DD to the Registrar, PPV&FR Authority. This information is also available on the official website of PPV&FR Authority.

Q. From which date the PPV&FR Authority starts receiving applications for Registration of Plant Varieties?

The PPV&FR Authority has started receiving applications for Registration of Varieties of 12 notified crop species from 21st May, 2007.

Q To whom applications of 12 notified crop species are to be submitted?

The Application for registration of varieties can be submitted to Registrar PPV & FR Authority NASC Complex, DPS Marg, New Delhi - 110012.

Q. What are the guidelines for submission of applications for Registration of Plant Varieties?

The guidelines for submission of applications for Registration of Plant Varieties are as under:

- Every application in triplicate must be in writing and signed by the applicant or their representative. Application should be submitted in hard copy along with all essential requirements by hand till further notice.
- Applications will be received only on Monday to Thursday from 10:00 Hours to 15:00 hours. No application will be accepted on Friday, Saturday and Sunday and Public Holidays.
- Every application must have the name of the applicant, their address and nationally as well as the address of service of their agent (if Applicable).
- A person can file upto a maximum of three applications per day.
- Until otherwise notified in the plant Variety Journal of India, each application should be accompanied with an application charge of Rs. 200/- each by demand draft drawn in favour of the "The Registrar, Plant Variety Registrar, New Delhi".
- The Application will be received on "first come first serve" basis.
- No applications will be received after business hours.
- On successful submission of application, the application will receive an acknowledgement slip.
- After submission of application, it will be processed according to the provisions of the Rule 29(2)

of the PPV&FR Rules, 2003.

- After depositing the stipulated fees for conducting DUS tests, the office of the Registrar shall issue receipt and number which shall be used for all future references including the checking of the status of application on line.

Address: Registrar PPV & FR Authority

**Protection of Plant Varieties and Farmers Rights Authority, Government of India, N.A.S.C.
Complex, DPS Marg, New Delhi 110012 , Ph. No. 011- 25848127, 20911443, 25840777**

FAX: 011-25840478

E-mail: registrar@ plantauthority.in

11. BIOLOGICAL DIVERSITY ACT, 2002

The Convention on Biological Diversity (CBD) was negotiated and signed by nations at the UNCED Earth Summit at Rio de Janeiro in Brazil in June 1992. The Convention came into force on December 29, 1993. India became a Party to the Convention in 1994. At present, there are 175 Parties to this Convention. India is one of the 12-mega biodiversity countries of the world. With only 2.4% of the land area, India already accounts for 7-8% of the recorded species of the world. Over 46,000 species of plants and 81,000 species of animals have been recorded in the country so far by the Botanical Survey of India, and the Zoological Survey of India, respectively. India is an acknowledged centre of crop diversity, and harbours many wild relatives and breeds of domesticated animals. The CBD offers opportunities to India to realize benefits from its rich biological resources and associated traditional knowledge.

Aim of Convention on Biological Diversity (CBD)

The CBD stipulates that the parties, even though having sovereign rights over their biological resources, would facilitate access to the genetic resources by other parties subject to national legislation and on mutually agreed terms. The CBD also provides for equitable sharing of benefits arising from the utilisation of traditional knowledge and practices, with holders of such knowledge. This has made it necessary for a legislation to be put in place, which lays down the framework for providing access, for determining the terms of such access and for ensuring the equitable sharing of benefits.

Frequently Asked Questions

Q. What is International Treaty on Plant Genetic Resources for Food and Agriculture?

Building on the principles embodied in the Convention on Biological Diversity (CBD), the new International Treaty on Plant Genetic Resources for Food and Agriculture (ITPGRFA) seeks to establish principles for facilitating access to plant genetic resources and establishing fair and equitable mechanisms of benefit sharing. International Treaty on Plant Genetic Resources for Food and Agriculture (ITPGRFA) was finally agreed in 2001. The ITPGRFA has the specific objective of facilitating access to plant genetic resources held by contracting parties, and those in international collections, for the common good, recognizing that these are an indispensable raw material for crop genetic improvement, and that many countries depend on genetic resources which have originated elsewhere. This represents an implementation of the CBD principles taking account of the specific characteristics of plant genetic resources. Most varieties now in existence, in particular those derived from public breeding programmes, contain genetic material from many sources, often derived from genetic material in gene banks, which themselves may have diverse origins. The ITPGRFA also

recognizes the contribution of farmers in conserving, improving and making available these resources, and that this contribution is the basis of Farmers' Rights. It does not limit in any form whatsoever rights that farmers may enjoy under national law to save, use, exchange and sell farm-saved seed. It also sets out the right to participate in decision making about, and to derive fair and equitable benefits from, the use of these resources.

Q. What does the Biodiversity Act - 2002 primarily address?

The Biodiversity Act - 2002 of India primarily addresses access to genetic resources and associated knowledge by foreign individuals, institutions or companies, to ensure equitable sharing of benefits arising out of the use of these resources and knowledge to the country and the people.

Q. What are the structures of Biodiversity Act – 2002

A three tiered structure at the national, state and local level is to be established. National Biodiversity Authority (NBA): All matters relating to requests for access by foreign individuals, institutions or companies, and all matters relating to transfer of results of research to any foreigner will be dealt with by the National Biodiversity Authority. State Biodiversity Boards (SBB): All matters relating to access by Indians for commercial purposes will be under the purview of the State Biodiversity Boards (SBB). The Indian industry will be required to provide prior intimation to the concerned SBB about the use of biological resource. The State Board will have the power to restrict any such activity, which violates the objectives of conservation, sustainable use and equitable sharing of benefits. Biodiversity Management Committees (BMCs): Institutions of local self government will be required to set up Biodiversity Management Committees in their respective areas for conservation, sustainable use, documentation of biodiversity and chronicling of knowledge relating to biodiversity.

Q. Will this legislation affect research in biological resources?

There is no requirement under the legislation for seeking permission of the National Biodiversity Authority for carrying out research, if it is carried out in India by Indians, as well as under collaborative research projects that have been drawn within the overall policy guidelines formulated by the Central Government. The only situations that would require permission of the NBA are: (i) when the results of any research which has made use of the country's biodiversity is sought to be commercialised, (ii) when the results of research are shared with a foreigner or foreign institution, and (iii) when a foreign institution/individual wants access to the country's biodiversity for undertaking research

Q. Will this legislation impact collaborative research projects?

This legislation will not prohibit collaborative research projects. Section 5 exempts collaborative research projects from sections 3 and 4, provided these conform to the policy guidelines issued by the Central Government. The Indian researchers neither require prior approval nor need to give prior intimation to SBB for obtaining biological resource for conducting research in India.

Q. How will the proposed legislation check biopiracy?

To check bio piracy, the proposed legislation provides that access to biological resources and associated knowledge is subject to terms and conditions, which secure equitable sharing of benefits. Further, it would be required to obtain the approval of the National Biodiversity Authority before seeking any IPR based on biological material and associated knowledge obtained from India.

The instances which have very prominently come to light in the recent past of the patents being secured in USA on brinjal, bitter-gourd, jamun, turmeric and neem pertain to patents being granted on use of biological material which is already known in India and therefore there is nothing new/innovative in the grant of patent. This does not in any way prevent the use of these biological materials within the country in whatever manner they are being used. These instances highlighted the need for the documentation of the knowledge of Indian system of medicine, to prevent such cases by proving that such use is already in vogue and therefore does not qualify for grant of patent.

Q. Does the legislation provide for any exemptions?

The legislation provides exemption to local people and community of the area for free access to use biological resources within India, growers and cultivators of biodiversity and to Vaidis and Hakims to use biological resources, collaborative research through government sponsored or government approved institutions subject to overall policy guidelines and approval of the Central Government

Q. Why value added products have been excluded from the definition of biological resources?

The intention of the bill is not to cover value added products of biological resources. Though the biological resources by definition do not include value added products, an explicit exemption has been mentioned to allay the fears of Indian industry so that export of value added products is not hampered. Value added product implies products containing portions/extracts of plants and animals in unrecognizable and physically inseparable form. For example: Chyawanprash, Isabghol, Pudina Hara, Turmeric creams etc,

Q. Does the legislation provide for protection of traditional knowledge?

Considering these complex nuances, an enabling provision for protection of traditional knowledge has been made under this legislation. The modalities for protecting indigenous knowledge are still emerging and evolving and therefore the measures for doing so have been left open and flexible under this provision. It provides for inter alia registration of knowledge, and for developing *sui generis* system for protecting traditional knowledge

Q. Who are the benefit claimers?

The benefit claimers are conservers of biological resources, creators and holders of knowledge and information relating to the uses of biological resources.

Q. Is there any overlap between Biodiversity Bill and Plant Varieties Protection Act?

There is no overlap between Biodiversity Bill and Plant Varieties Protection (PVP) Act. The scope and objectives of these two legislations are different. The PVP legislation accords intellectual property rights to a person for developing a new plant variety. On the other hand, the biodiversity legislation is primarily aimed at regulating access to biological resources and associated knowledge so as to ensure equitable sharing of benefits arising from their use. In order to harmonize both the legislations, an exemption has been provided under Section 6(3) of the Biodiversity Bill for applicants seeking protection under the PVP Act.

Q. How does the Bill address the concern relating to threatened species?

Section 38 provides for notifying threatened species and prohibits or regulates their collection. It also provides for taking appropriate steps to rehabilitate and preserve those species, thereby ensuring their conservation and management.

Contact Address:

The Secretary
NATIONAL BIODIVERSITY AUTHORITY
475, 9th South Cross Street,
Kapaleeswar Nagar,
Neelankarai,
Chennai - 600041.
Tele/Fax : 91-44-24491390
Email :- nba_india@vsnl.net

12. LICENSING OF TECHNOLOGY

Protection of technology must follow its commercialization so that benefits of invention reach to the public and the return on investment is realized. Licensing of technology has been recognized a faster tool for technology transfer in advanced countries. It has following features:

- Normally, non-exclusive licenses can be executed for technologies such so that these can lead to their wider adoption and thereby maximize research benefits to farmers and other end users. For non-exclusive licenses there shall be flexibility in fixing the license fee.
- When a technology is licensed through an open tendering/bidding process it will normally be given to one licensee. But depending upon the licensee' s manufacturing capacity and size of business, other interested parties from outside the territory of his business/interest may also be considered if the technology has to be rapidly and widely disseminated. Alternately, a sub-licensing clause should be incorporated, which may require the licensee to share a part of the license fee and/or royalty from any sub-licenses that he may enter into with that technology.
- Exclusive license may also be issued when (i) an IPR enabled university technology is to be commercialized in countries abroad, and (ii) the technology is to be disseminated in difficult areas offering low incentives. As exclusive licenses are preferential, commensurate license fee and/or royalty will be negotiated and settled on mutually agreed terms with the licensee.
- The duration for which institution will issue licenses will also be negotiated with the licensee and settled on mutually agreed terms.
- Licensing for commercialization of Plant Varieties should be based on state and national priorities and issues of food and nutritional security. The university may decide to place a plant variety solely in the public domain or else it may be licensed for commercial use on exclusive or non-exclusive basis. However, registration and protection of all protectable varieties will be ensured under the PPV&FR Act before placing them in public or commercial domain.
- Public interest license can be issued to those technologies which directly relates to farmers.
- The inventors of technology shall have sharing of benefits as per institutional policy.

13. IMPORTANT DATABASES FOR PATENT SEARCH

- WIPO (World Intellectual Property Office),
- Indian Patent Office Database,
- CIPO (Canadian Information Patent Office)
- Espacenet.com (European Net Work of Data Use),
- uspto.gov (United State Patent and Trademark Office Database)
- EKASWA A&B Databases for Indian patents

Besides these databases, there are large numbers of service providers for this purpose.

14. CURRENT DEVELOPMENTS IN THE INTELLECTUAL PROPERTY IN INDIA

(a) Establishment of NIIPM

The Government has already approved the proposal for establishment of a National Institute for Intellectual Property Management (NIIPM) at Nagpur. The Institute will perform training, education and research in this field.

(b) Modernization of the IP Offices

To provide additional employees, establish a higher level of computer network to support on-line processing, strengthen the data base and novelty search facilities, to make the people aware of generation activities, and to provide an access to international treaties/conventions easily the government is planning to modernize the IP offices. This proposal will be taken up in the 11th five year plan.

(c) Madrid Protocol on Trademarks

Madrid Protocol, administered by WIPO, is an uncomplicated, facilitative and lucrative system for the registration of International Trademarks. If India becomes a member of this then the Indian companies will have an advantage of registering their trademarks in all the countries which are the members of this protocol by filing a single application. The amendment of the Trade Marks Act is in progress so that our

country can be a member of this protocol.

(d) International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA)

ISA and IPEA's provide search reports on uniqueness and examination reports on patentability of various inventions. In India a scheme is under consideration to get recognition for the Indian Patent Office as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Co-operation Treaty.

(d) Mashelkar Committee

The Indian government has established a group of technical experts to examine the following patent law issues:

(a) Whether it would be compatible to the TRIPS agreement to limit the grant of patent for pharmaceutical substances only to a new chemical entity or to a new medical entity.

(b) Whether it would be compatible to the TRIPS agreement to exclude micro-organisms from patenting.

The bottom-line is that India is one of the most responsible members of the WTO. Besides creating waves in the global software industry India has framed stringent laws for the protection of IPR in the country. Bill Gates, the chief executive officer of Microsoft Corporation, has rated India as one of the strongest pedestals for software development. It is evident from this statement that if a person like Bill Gates who is so much aware of the IPR issues can designate India as one of the upcoming destinations for the software development then the foreign companies should not worry about the protection of their intellectual property rights while investing in India.

(e) ICAR Guidelines for IP Management and Technology Transfer/Commercialization

These guidelines may be adopted as appropriate by SAUs and ICAR institutes for IP Management and Technology Transfer/Commercialization. This would help agricultural institutions in endeavour of IP management.

15. SUGGESTED READINGS

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- Policy and Regulations
 - ICAR, 2006. ICAR Guidelines for Intellectual Property Management and Technology Transfer/Commercialization. Indian Council of Agricultural Research, New Delhi.
 - CCSHAU, 2007. Intellectual Property Rights: Policy and Regulations. CCS Haryana Agricultural University, Hisar
- The Indian Acts:
 - Patents Act, 1970 and amendments 1999 and 2002.
 - Design Act, 2000.
 - Trademarks Act, 1999
 - The Copyright Act, 1957 and amendments in 1983, 1984 and 1992, 1994, 1999 and the

Copyright Rules, 1958.

- Layout Design Act, 2000.
- Protection of Undisclosed Information: No exclusive legislation exists but the matter would be generally covered under the Contract Act, 1872.
- The Geographical Indication of Goods (Registration and Protection) Act, 1999.
- Protection of Plant Varieties and Farmers' Rights Act 2001, and Rules 2003.
- National Biological Diversity Act, 2003

