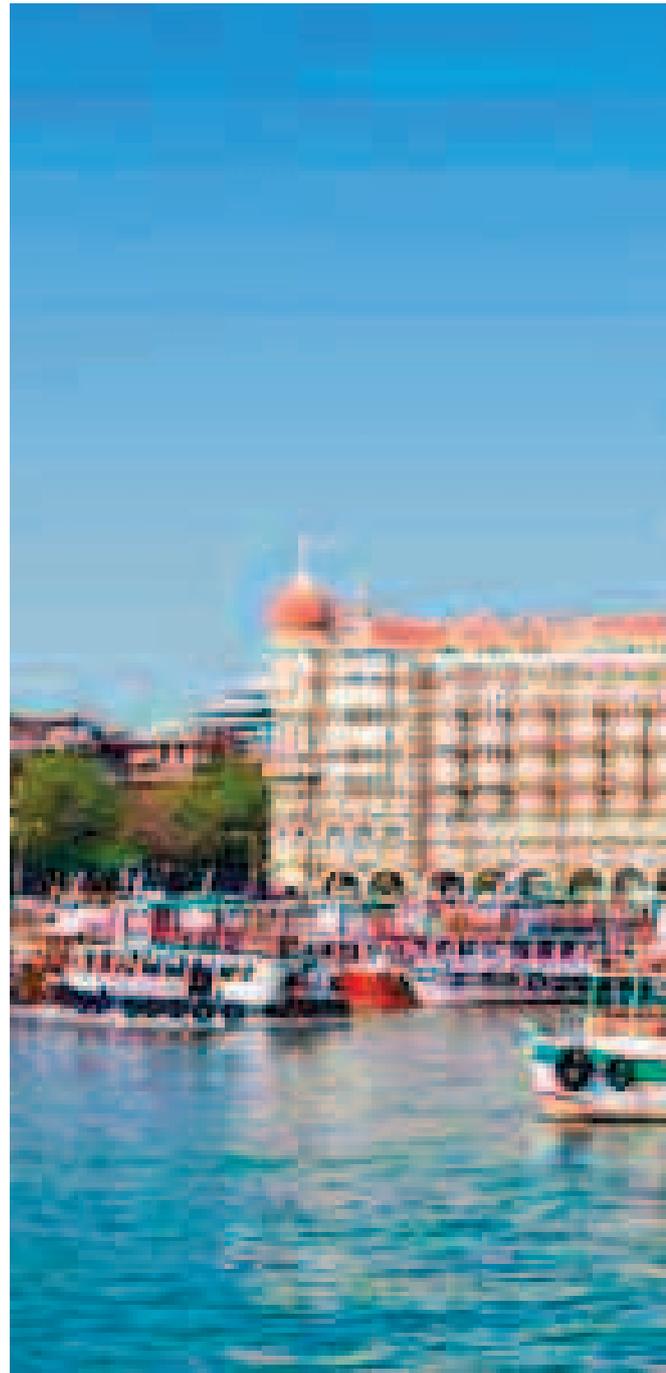


INDIA

Government gears up for IP revamp

Rupin Chopra and Ritika Mogha of SS Rana & Co set out how India has ramped up its approach to IP enforcement, and suggest areas for further improvement



With the new government led by Narendra Modi, India has seen increasing IP awareness, growth and reforms aimed at strengthening the IP rights regime. Since its inception, the Government has been consistently trying to revamp IP policies in India. Even the Indian IP Office has been upgrading IP records and making efforts to bring about transparency in its procedures. This article will discuss: (i) Government initiatives and the national IP rights (IPR) policy; (ii) IP rights trends in the past year; (iii) recent developments in IP administration and management; and, (iv) recent case law.

Government initiatives

Last year, the Indian Government entered into several reform policies to strengthen the IP regime in India. One of its initial steps was the constitution of the IPR think tank for drafting the national IPR policy and advising the Government on such policy matters.

The draft national IPR policy as published by the DIPP (Department of Industrial Policy and Promotion) in December 2014 outlines its objectives in seven areas: IP awareness and promotion; creation of IP; legal and legislative framework; IP administration and management; commercialisation of IP; enforcement and adjudication; and, human capital development.

INDIA



The draft also highlights the steps taken towards integrating IP with Government initiatives like Make in India and Digital India. Under the Make in India initiative, the Government is attempting to transform India into a world-class manufacturing hub, with the intention of fostering innovation and creativity by generating, protecting and utilising IP assets. The Digital India initiative involves components like smart cities, e-governance, e-literacy, e-commerce, strengthening and expansion of digital infrastructure and transforming India into an electronic system, design and manufacturing hub.

At present, the policy has received input from various stakeholders, organisations and countries

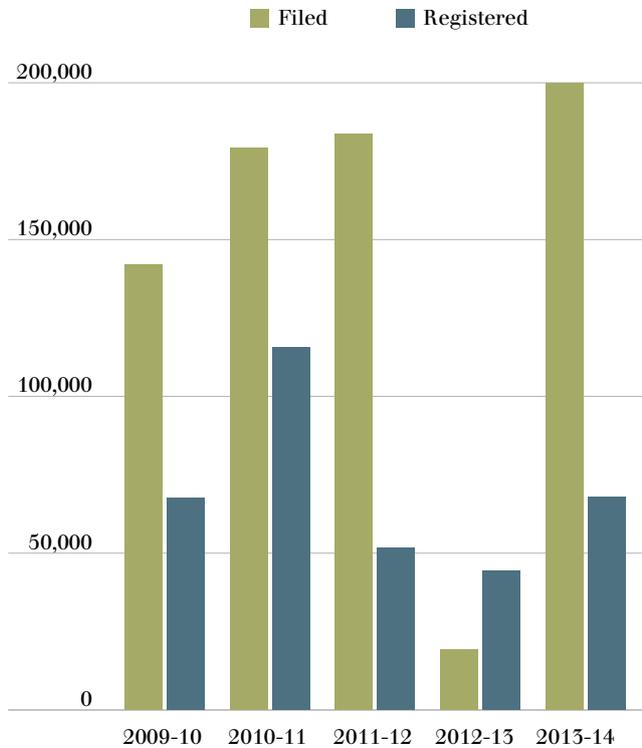
and its final version is being drafted for approval by the cabinet.

Recent IPR trends

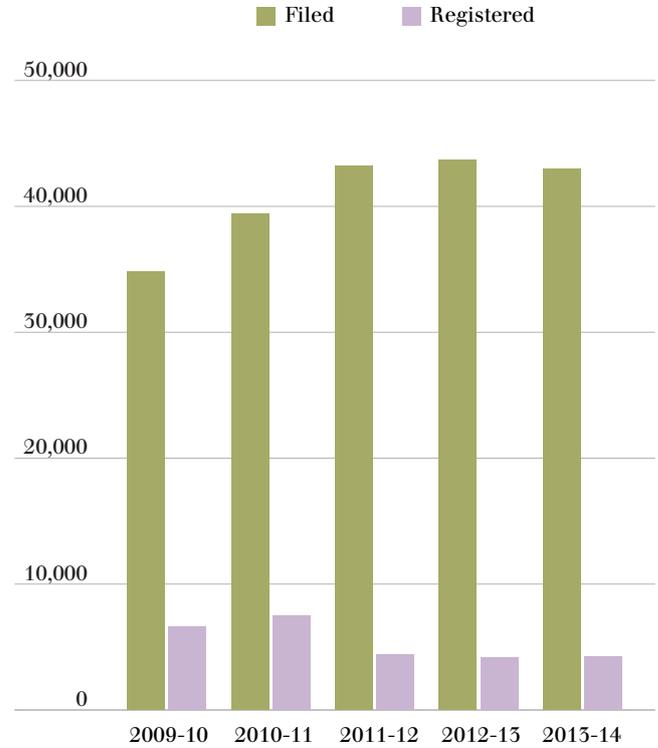
In June 2015, the Indian IP Office released its Annual Report (2013-2014). The Report demonstrates the progress in the filing and disposal of IP applications in India during the reporting year. The Report showed several trends.

In trade mark filing, the Report indicated an increase of 2.98% as compared to the previous year's filings (see figure 1).

In patent filing, the Report witnessed a marginal decrease of 1.65% in filing as compared to the previous year (see figure 2).

Figure 1: Trade mark

Source: Annual Report (2013-2014)

Figure 2: Patent

Source: Annual Report (2013-2014)

In design filing, the Report witnessed an increase of 2.35% as compared to the previous year (see figure 3).

IP management and administration

Over recent years, the Indian IP Office has been striving towards the digitisation of the Office and bringing about transparency in the maintenance of IP records.

In September 2014, the CGPDTM (Controller General of Patents Designs and Trademarks) released a new version of the electronic patent register in IPAIRS. The new version comprises an additional tab, namely 'patent e-register', which accepts six-digit patent numbers and displays additional details of a patent such as legal status, due dates, information on the working of patents, and parent or divisional applications.

In January 2015, the CGPDTM launched the design application search utility which enables searches using several parameters such as application number, date of filing, applicant's name, state and country, name of article, IDC class, priority date, journal number and publication date.

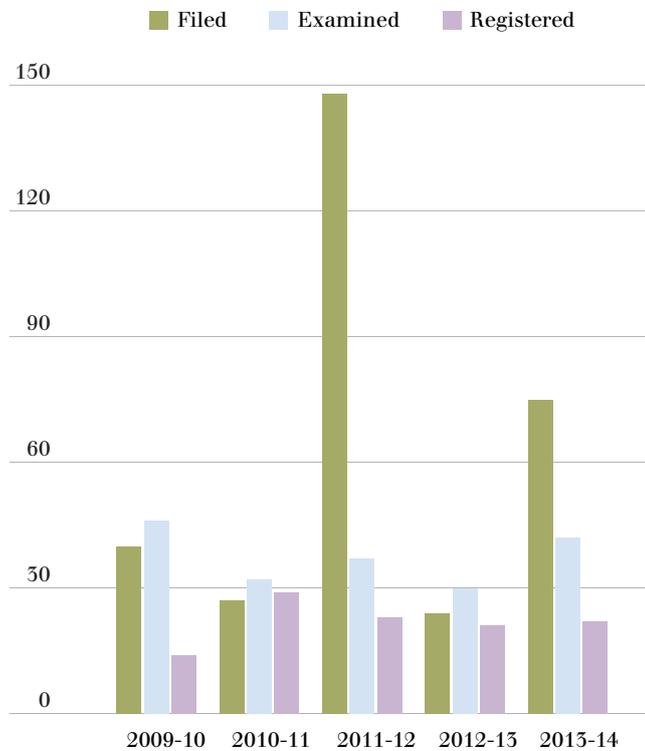
Earlier searches could only be conducted through application number only.

In order to promote the online filing of copyright applications, the Copyright Office stopped the physical filing of applications in August 2014. In March 2015, the CGPDTM launched electronic filing for new design registration applications. From March 2015, GI applications can be submitted online at the portal www.ipindia.gov.in or www.ipindia.nic.in.

The CGPDTM has published a draft manual of trade mark practice and procedure. The manual has been published with the objective of bringing about uniformity in practice and prosecution of trade mark applications in India. The manual brings together the provisions of the Trademark Act and corresponding Trademark Rules along with the office practice followed in the examination and prosecution of trade mark applications.

In March 2015, Shri Rajiv Aggarwal, joint secretary of the Department of Industrial Policy and Promotion took charge as the new Controller General of the Indian IP Office.

Figure 3: Geographical indications



Source: Annual Report (2013-2014)

Recent case laws

In *Indian Performing Rights Society v Sanjay Dalia* 2015 the Supreme Court of India rendered an authoritative judgment while defining the parameters of jurisdiction in trade mark and copyright cases in India. The Court essentially delved into the issue of harassment witnessed by the defendants at the hands of the plaintiffs while instituting a suit based on territorial jurisdiction, and emphasised that the plaintiff cannot drag the defendant to far flung areas to harass them.

The general rule with respect to the institution of a suit as enumerated under section 20 of the Code of Civil Procedure (CPC) provides that a suit can be instituted in a court within whose territorial jurisdiction the defendant resides or carries on business or personally works for gain or where the cause of action arose.

However, an exception to this rule has been provided under section 154 of the Trade Marks Act 1999 and section 62 of the Copyright Act 1957. The law as entailed under the statutory provisions provides that the:

District court having jurisdiction shall, notwithstanding anything contained in the CPC or any

other law for the time being in force, include a district court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or proceeding (ie the plaintiff) actually and voluntarily resides or carries on business or personally works for gain.

In the present case, the defendants raised the objection with regard to the territorial jurisdiction of the court at Delhi. The defendant alleged that the plaintiffs had their principle office at Mumbai and the cause of action also arose in Mumbai. However, the suits for infringement were filed in the High Court of Delhi where the plaintiff's companies have their branch office.

The court observed that the intention of the legislature was that the plaintiff should not go to far flung places from where he carries on business or works for gain in order to deprive the defendant of a remedy and harass them by dragging them to a distant place.

The court further observed that if such an interpretation were permitted, then the abuse of the impugned provision could be misused, as corporations and big conglomerates may have several subordinate offices throughout the country.

In *People Interactive Pvt Ltd v Gaurav Jerry*, the court recognised the importance of meta-tags and how their misuse can lead to unfair competition, and it granted relief to the plaintiff.

The plaintiff was the registered proprietor of the marks shaadi.com and shadi.com and carried on an online business providing matrimonial services. The defendant, who had a similar business, was providing a service under the domain name ShaadiHiSahadi.com. Aggrieved by the use of a deceptively similar domain name, the plaintiff approached the Bombay High Court to restrain the defendant from using the name ShaadiHiSahadi.com.

In this case, the Court explained the term meta-tags and referred to them as:

Special lines of code embedded in the web pages. Meta-tags are a special type of tag. They do not affect page display. Instead they provide additional information: the author of web page, the frequency of updating, a general description of the contents, keywords, copyright notices and so on.

In *Sukesh Bahl v Koniklijke Philips Electronics*, the Delhi High Court ruled that non-compliance with section 8 of the Indian Patent Act 1970 may not automatically revoke the Patent. Under section 8, an applicant is required to file a statement providing the details of any patent application being prosecuted by the applicant in a foreign country. Non-compliance of the said provision is also a ground for the revocation of a patent under section 64(1)(m) of the Act.



Rupin Chopra

Rupin Chopra is an IP attorney at SS Rana & Co. He is proficient in all aspects of IP law, including trade marks, copyrights and designs in India and SAARC (South Asian Association for Regional Cooperation) countries.

Rupin is actively involved in sensitising local industries on IP rights in India. He is associated with several organisations, including the Federation of Indian Chambers of Commerce and Industry, the Associated Chambers of Commerce and Industry of India and the National Institute for Entrepreneurship and Small Business Development. He is a frequent speaker in seminars and workshops conducted by these organisations, and is a member of several international law associations and forums including INTA and ECTA.



Ritika Mogha

Ritika Mogha is an IP attorney at SS Rana & Co. She obtained her LLM in business law from the National Law School of India University, Bangalore. She is proficient in all aspects of trade marks and copyright including the prosecution of trade mark applications before the Indian Trade Marks Office, searches, drafting assignments, copyright applications and providing opinions related to queries on trade marks and IP litigation.

Ritika revises and updates the books *Mogha's Law of Pleading in India* and *Mogha's Indian Conveyancer*, two of India's leading books for drafting and pleading, with the latest decisions of the court. She has a flair for writing and regularly submits articles for the firm's newsletter and for various legal journals. Ritika also captains the firm's women's basketball team.

According to section 64(1)(m) a patent 'may' be revoked if the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has provided information which in any particular was false to their knowledge.

The Court in the case held that though it is mandatory to comply with the said requirement, the fact that the word may is used in section 64 itself reflects that the intention of the legislature was to confer a discretionary power upon the authority or court while exercising the power of revocation. Therefore, the violation of section 8 may attract the revocation of a patent, although this is not automatic.

In *Make My Trip v Make My Tours* the court recognised that the defendant's trade mark logos were virtually identical in design and colour to the plaintiff's well known mark.



Holding that defendant's use of similar marks would cause irreparable harm and injury to the plaintiff, the court granted an injunction.

Building on India's good start

The range of India's initiatives and adoption of best practice in IP processing indicate a ray of hope for the country's IP regime. During the past few years, the Indian IP Office has also undergone major changes in terms of upgrading its IP legislation, infrastructure facilities, human resources, processing of IP applications, computerisation, databases, quality services to stakeholders, transparency and free access of IP data through dynamic tools and utilities.

In spite of such endeavours, however, there are still a few areas where IP rights enforcement and protection challenges remain, such as the non-existence of specific legislation dealing with trade secret protection, and utility patents. Counterfeiting is yet another grey area which is sabotaging the IP rights of genuine owners. Further, the lengthy judicial process involved in the enforcement of IP rights hinders IP owners' ability to enforce their rights.

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