



OFFICE FOR HARMONIZATION  
IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

twentyyears  
1994 - 2014



Guide to protection of  
Intellectual Property Rights  
in India

2014  
2014



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## 1. Introduction

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This guide is written to provide basic assistance to intellectual property (IP) rights holders and their advisers, on the IP protection and enforcement system in India.

The guide is intended to provide simple guidelines on how rights holders can protect their IP assets and what do if their rights are infringed.

## 2. Background

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Legislation including the Designs Act, 2000, the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act 1999 has been enacted to increase IP protection.

In 2013 the Department of Industrial Policy and Promotion (DIPP) outlined a draft national intellectual property right (IPR) strategy which discusses the steps that the Government needs to take to promote creation of IP and encourage its utilization.

India is a signatory to:

- The Paris Convention – which means that someone from another signatory state can apply for a patent or trade mark and expect the same rights as a national rights holder

[http://www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html)

- The Patent Cooperation Treaty - which allows someone to get a set of patent applications, in different countries, through a single application

<http://www.wipo.int/pct/en/texts/articles/atoc.htm>



- The Berne Convention – which ensures that parties to the convention, give equal recognition to copyright holders from other convention member states.  
[http://www.wipo.int/treaties/en/ip/berne/trtdocs\\_wo001.html](http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html)
- The Rome Convention – which extends copyright protection to performers, producers of phonograms and broadcasting organizations

Finally, India has been a member of the World Trade Organisation (WTO) since 1995.

<http://www.wto.org/>  
[http://www.wto.org/english/tratop\\_e/trips\\_e/trips\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/trips_e.htm)

However, intellectual rights in India are under pressure, particularly in content-based industries. Counterfeiting and piracy is reported as being high and according to the Federation of Indian Chamber of Commerce and Industry (FICCI), <http://www.ficci.com/> counterfeit and lookalike products of pharmaceuticals, cosmetics, toiletries books, movies music, software and packaged goods result in huge losses and associated dangers for consumers.

In response, India provides an administrative IP protection system, which is largely under the jurisdiction of the Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM). Moreover, there is a growing prosecution regime, involving police, customs authorities and the judicial courts, which are all authorised to take action against the counterfeiting and piracy. Furthermore, IP infringement cases can also be pursued through administrative decisions.

It should also be noted that recently, Indian Courts have passed stringent orders against counterfeiters and have awarded heavy damages.

### 3. India's Legal Framework

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At present, India has no specific legislation to deal with counterfeiting and piracy. Nevertheless, a range of statutory, civil, criminal and administrative laws are in place to support IP rights holders. These include:

- Trademarks Act  
[http://ipindia.nic.in/tmr\\_new/default.htm](http://ipindia.nic.in/tmr_new/default.htm)
- Copyright Act  
<http://copyright.gov.in/Documents/CopyrightRules1957.pdf>
- Patents Act  
[http://ipindia.nic.in/ipr/patent/eVersion\\_ActRules/sections-index.htm](http://ipindia.nic.in/ipr/patent/eVersion_ActRules/sections-index.htm)
- Designs Act  
[http://ipindia.nic.in/ipr/design/design\\_act.PDF](http://ipindia.nic.in/ipr/design/design_act.PDF)
- Geographical Indications Act  
[http://ipindia.nic.in/ipr/gi/gi\\_act.pdf](http://ipindia.nic.in/ipr/gi/gi_act.pdf)
- Customs Act  
[http://www.wipo.int/wipolex/en/text.jsp?file\\_id=201640](http://www.wipo.int/wipolex/en/text.jsp?file_id=201640)
- Drugs and Cosmetics Act  
[http://www.medindia.net/indian\\_health\\_act/drugs\\_and\\_cosmetics\\_act\\_1940/list-of-acts.htm](http://www.medindia.net/indian_health_act/drugs_and_cosmetics_act_1940/list-of-acts.htm)
- Consumer Protection Act  
[http://ncdr.nic.in/1\\_1.html](http://ncdr.nic.in/1_1.html)
- Prevention of Food Adulteration Act  
[http://www.medindia.net/indian\\_health\\_act/the-prevention-of-food-adulteration-act-1954-introduction.htm](http://www.medindia.net/indian_health_act/the-prevention-of-food-adulteration-act-1954-introduction.htm)
- Protection of plant Varieties and Framers Rights Act 2001  
<http://agricoop.nic.in/PPV&FR%20Act,%202001.pdf>



## 4. How to protect your IPR through registration (patent, trade mark, designs, others)

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As explained IP laws in India cover a range of fields including trademarks, patents, geographical indications, protection of plant varieties and farmers' rights, trade secrets, semi-conductor designs and industrial designs. However, certain rights currently available in the EU such as unregistered designs and utility models are not available.

The following link provides basic information regarding the full range of intellectual property rights in India.

<https://www.indianembassy.org/intellectual-property-rights.php>

Almost all of these rights can be protected through registration at the CGPDTM – Intellectual Property India. In this respect, both trademark and patent applications can be filed online and the CGPDTM has a searchable website to assist applicants. However, when making an application for designs in India, unlike trademark and patent applications, these can only be filed manually. It should also be noted that industrial designs can be applied for under the Patent Cooperation Treaty.

In India, copyright comes into existence as soon as a work is created and therefore, acquiring copyright is automatic and does not require any formal registration. However, a facility exists to have works registered in the Register of Copyrights which is kept at the Copyright Office. This 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.

Entries made in the Register of Copyrights serve as prima-facie evidence in the court of law.

<http://copyright.gov.in/>

Potential applicants for IP rights from countries outside India should also take note that unless they have a place of business in India they must file patent, trademark and design applications through an Indian attorney or agent.

The UK IP Office also has a useful guide in place

<http://www.ipo.gov.uk/ipindia.pdf>

The EBTC IPR India Help Desk offers numerous services including information on India's IPR laws, and the implications of recent developments in IPR cases for EU organizations.

## 5. Civil and Administrative procedures for enforcement

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Civil litigation in India is now commonplace and case law is well developed as it is generally accepted as being an easier route to pursue. The system allows the award of compensation and punitive damages for both copyright and trademark infringements. However, they are less likely to be imposed for patents and other cases.

In terms of administrative processes, mediation with infringers is also possible. But this must be instigated before another form of action is commenced. Moreover, this route should be carefully considered. The Indian Civil Procedure Code clearly outlines a formal mediation process, but in many sectors there are a multitude of infringers involved. Therefore, this option can be resource intensive and less successful in stopping infringements in the long term.

## 6. General criminal and civil law that can apply to IPR issues

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Criminal cases are commenced as the result of official complaints by rights holders to enforcement authorities, or magistrates. In general, tougher penalties and fines are more common in criminal cases.

In some parts of India the police also have Economic Offences wings in place that work within local police departments and are well placed to deal with counterfeiting and piracy cases.

[http://mha.nic.in/uniquepage.asp?ld\\_Pk=346](http://mha.nic.in/uniquepage.asp?ld_Pk=346)



In addition, the Income Tax Department draws officers from the Indian Revenue Service officers around the country and is responsible for investigation into various economic crimes and tax evasion. These agents posted in the Directorate of Criminal Investigation.

<http://www.irsofficersonline.gov.in/>

Although the Court of First Instance in India is the District Court, High Courts also have the jurisdiction to adjudicate on matters of first instance. Of the six High Courts in existence, the Delhi High Court deals with the highest number of IP cases in the country. Therefore, it could be regarded as “the IP Specialist Court”.

However, despite recent improvements in the prosecution system, enforcement and court procedures are often perceived as being very slow. This together with a reported lack of transparency and backlogs in cases in criminal courts can often cause frustration and confusion for rights holders.

## 7. Customs Authorities

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Employing the help of Indian Customs Authorities can help to prevent protracted enforcement cases. The Indian Intellectual Property Rights (Imported Goods) Enforcement Rules - 2007 allows rights holders to make applications for customs action, to detain infringing goods and suspect consignments.

Rights holders should take note that customs measures only apply to imports of copyright and trademark infringing goods and ‘infringing goods’ is defined as goods made, reproduced, put into circulation or otherwise used in breach of IP laws within or outside India, without the consent of the rights holder or its duly authorised agent.

Under existing rules, a rights holder can apply to Customs for the suspension of any consignment that infringes its rights. Customs must then notify the rights holder within 30 days to confirm whether the notice has been approved and registered. If registered, the application remains valid for five years or for the duration of the right. During this period, Customs will then suspend any suspect consignment of infringing goods based on the rights holders ‘application

Customs authorities also have ex officio powers to intercept consignments being imported or exported that are suspected of infringing the IPR regulations and, according to their findings, Customs may also destroy offending goods and then bring prosecutions against infringers in the courts.

<http://www.cbec.gov.in/ipr-idx.htm>

## 8. Weak points in IPR enforcement legislation, administration systems etc.

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The European Commission's (DG TRADE)<sup>1</sup> report on bilateral interactions with India reflects that while some improvements have been noted in Indian IPR legislation there some issues, particularly in patent law where restrictive patentability criteria combined with difficulties to enforce granted patents can cause problems. Moreover, the extremely broad criteria being applied for granting compulsory licences for revocations of patents make the effective patent protection in India difficult. This is notable for pharmaceuticals and chemicals but also for other sectors where local innovation is being promoted.

## 9. Basic Advice

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- Protect your rights through registration and by applying to customs.
- Seek advance professional advice from lawyers and investigators on how to protect supply chains and secure evidence
- Ensure colleagues employees and business partners have substantial knowledge about your products and can easily identify counterfeits.
- Put protective measures in place in respect of confidential information and trade secrets
- Engage lawyers and enforcement as quickly as possible and take appropriate action

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<sup>1</sup> [http://trade.ec.europa.eu/doclib/docs/2013/march/tradoc\\_150789.pdf](http://trade.ec.europa.eu/doclib/docs/2013/march/tradoc_150789.pdf)



## 10. Contact information (online and otherwise)

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- EBTC IPR Helpdesk India
  - Copyrights: <http://www.ebtc.eu/index.php/services/request-ipr-support/ipr-resources/94-ipr/ipr-helpdesk/125-learn-about-copyrights>
  - Designs: <http://www.ebtc.eu/index.php/services/request-ipr-support/ipr-resources/94-ipr/ipr-helpdesk/169-learn-about-designs>
  - Patents: <http://www.ebtc.eu/index.php/services/request-ipr-support/ipr-resources/94-ipr/ipr-helpdesk/171-learn-about-patents>
  - Trademarks: <http://www.ebtc.eu/index.php/services/request-ipr-support/ipr-resources/94-ipr/ipr-helpdesk/172-learn-about-trademarks>
- The Protection of Plant Varieties and Farmers' Rights Authority India <http://www.plantauthority.gov.in>
  - General information on the application procedure can be found in this brochure: [http://www.plantauthority.gov.in/pdf/G\\_Brochure\\_English.pdf](http://www.plantauthority.gov.in/pdf/G_Brochure_English.pdf)
- Controller General of Patents, Designs and Trade Marks (CGPDTM), located at Mumbai. Head Office of the Patent office - Kolkata and Branch offices at Chennai, New Delhi and Mumbai.
- The Trade Marks registry Mumbai and Branches in Kolkata, Chennai, Ahmedabad and New Delhi.
- The Design Office at Kolkata in the Patent Office.  
<http://www.ipindia.nic.in/>
- The Offices of the Patent Information System (PIS) and National Institute of Intellectual Property Management (NIIPM) at Nagpur  
<http://www.ipindia.nic.in/niipm/>
- Geographical Indications Registry at Chennai  
<http://ipindia.nic.in/girindia/>

- Central Board of Excise and Customs  
<http://www.cbec.gov.in/ipr-idx.htm>
- Competition Commission of India  
<http://www.nipo.org.in/iplaws7.htm>
- Confederation of Indian Industry (CII)  
<http://www.ciionline.org/>
- Copyright Office  
<http://copyright.gov.in/>
- Indian IPR Foundation (NIPO)  
<http://www.nipo.org.in/>
- Attorneys at Law Local law firms in India can offer you legal advice and services specific to your business. The Chambers and Partners website offers a search facility listing Indian local law firms.  
<http://www.chambersandpartners.com/Asia/Search/Location/110>  
<http://www.chambersandpartners.com/Asia/Search/Location/110>
- The European Union (EU) Chamber of Commerce in India helps and supports contacts between businesses based in EU member states and India:  
<http://www.euindiachambers.com>



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