

The second quarter of this year has seen significant developments in the field of Intellectual Property Rights in India.

While the National IPR Policy was approved by the Government of India to strengthen the future of IPR in India, the Patent (Amendment) Rules, 2016 were re-published and brought in effect in May. The Controller General of Patents, Trademarks and Designs was also in news and received severe criticism for erroneously abandoning approximately 2,50,000 Trademark Applications for lack of prosecution; such abandonments were subsequently stayed by the Hon'ble Delhi High Court and the Controller was ordered not to treat any trademark applications as abandoned without proper notice to the interested parties. In addition to the above, a case before the High Courts of Delhi dealt with the issues of moral rights and discussed the scope of copyright societies. In one of the cases, the Hon'ble High Court of Delhi questioned the role of Indian Performing Right Society Limited (IPRS), a copyright society, in granting licenses on behalf of copyright owners. Another notable case dealt with the issue of online piracy through torrent websites.

The above updates have been discussed here below in detail:

LEGAL DEVELOPMENTS

National IPR Policy, India - May, 2016

In May this year, the Indian government initiated the process to strengthen the future roadmap of intellectual property rights ("IPR") protection in India, by approving the National IPR Policy ("the Policy"). The Policy, being TRIPS and WIPO compliant, aims at setting in place an institutional mechanism for a dynamic, vibrant and balanced IPR system in India. The new Policy also aims to create awareness among all sections of society about the economic, social, and cultural benefits of IPR. The Policy lays down the following seven objectives:

1. IPR Awareness: Outreach and Promotion – the Policy aims at creating public awareness about the economic, social and cultural benefits of IPRs among all sections of society.
2. Generation of IPRs – The Policy supports generation of more IPRs and protection of the same.
3. Legal and Legislative Framework – The Policy is brought into effect in order to have strong and effective IPR laws, which balance the interests of rights owners with larger public interests.
4. Administration and Management – with the new Policy, the government aims at modernizing and strengthening service-oriented IPR administration in India.

5. Commercialization of IPRs – Commercialization through IPR is another major objective of the Policy.
6. Enforcement and Adjudication – The Policy aims to strengthen the enforcement and adjudicatory mechanisms for combating IPR infringements. The government also plans to set up new IPR cells in every government and state government departments to coordinate with DIPP for the Policy implementation.
7. Human Capital Development – the Policy also aims at building an increased number of skilled IPR experts in order to strengthen and expand human resources, institutions and capacities for teaching, training and research in IPR.

In addition to the above, the Policy also addressed the topics of compulsory licensing and 'invention' under Section 3 (d) of the Patents Act. The Policy will allow compulsory licensing with restrictions in case of a public health emergency such as epidemics and it is compliant with the World Trade Organization's guidelines.

Approval and implementation of the same will enable faster actions to foster creativity, innovation and promote entrepreneurship.

Patent (Amendment) Rules, 2016

An amendment to the Patent rules was published for comments from the public in October 2015 and had received severe objections. Taking into consideration the objections and suggestions received from the public, this year, the government amended and notified the Patent (Amendment) Rules, 2016 (herein after "Rules"). The said Rules have come into effect from the 16th May 2016.

With the amended Rules, the Patent Office has made several technical and procedural amendments. For example, the Rules recognise a new entity called 'Startup'. Under the Rules, a 'Startup' is *"an entity, incorporated or registered in India for not more than five years, with an annual turnover not exceeding INR 25 crore in any financial year, and is working towards innovation, development, deployment or commercialization of new products, processes or services driven by technology or intellectual property. However, an entity formed by splitting up or reconstruction does not qualify to be a Startup"*.

Also, the words '*or courier service*' and '*or courier*' have been omitted from the Rules. Instead, it is specified that *'a patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated, including scanned copies of documents that are required to be submitted in original'*.

In addition to the above, the following amendments are noteworthy:

1. The Rules require a Patentee to provide email address along with an address for service, and a Patent Agent is required to furnish a mobile no. registered in India.
2. The Patent Office will henceforth accept authenticated documents by electronic transmission provided that the original document is submitted within a period of 15 days.
3. Online fees paid twice will be refunded at the discretion of the Controller.
4. The Rules also explicitly mention that, where no form is specified for a particular action, Form 30 of the Patent Rules, 2003, may be used.
5. With an aim of making the patenting process in India smoother, the Rules now allow hearings to be held through video conferencing or audio-visual communication devices; documents pertaining to the same are to be submitted within 15 days from the date of hearing. Any requests for adjournment of hearings can be filed three days prior to the set hearing date.

NOTABLE IP CASES

Tata Steel Limited v. Union of India & Anr AND Intellectual Property Attorneys Association v. The Controller General of Patents, Designs and Trade Marks & Anr

The Controller General of Patents, Trademarks and Designs abandoned a large number of Trademark Applications (around 250,000) supposedly in lack of prosecution. After receiving severe criticism for their orders of abandonment without proper reasons, the Controller General had sought representations from trademark applicants whose applications were abandoned erroneously. The action of abandonment passed by the Controller General was questioned in the aforesaid writ petitions. The Hon'ble Delhi High Court has stayed all the orders of abandonment and also ordered the Controller General not to treat any trademark applications as abandoned without proper notice to the parties interested.

The Trade Marks Act, 1999 under section 132 of the Act talks about abandonment. In these cases, it is important to note that the section specifically mentions the need of serving a notice to the concerned parties.

The section explicitly reads as follows - *Where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade marks in force prior to the commencement of this Act, the Registrar may, by notice require the applicant to remedy the default within a time specified and after giving him, if so, desired, an opportunity of being heard, treat the application as abandoned, unless the default is remedied within the time specified in the notice.*

Chitra Jagjit Singh V. The Indian Performing Right Society Limited and Others

In a decision passed by the Hon'ble High Court of Delhi, it was held that the Indian Performing Right Society Limited (IPRS) was incompetent to grant licenses as per Section 33 of the Copyright Act, 1957.

The court, in the above judgement, found that IPRS, by its own admission, failed to renew its registration as a copyright society under the Copyright Act, 1957. Hence, IPRS was restrained from granting any license in respect of the works of the plaintiff and also of Late Shri. Jagjit Singh.

The judgement was drawn pursuant to the case filed by the plaintiff, Mrs. Chitra Jagjit Singh, wife of Late Shri Jagjit Singh, objecting (1) to the issuance of public performance licenses by IPRS in relation to Late Shri Jagjit Singh's copyrighted works and (2) to the organisation of a concert being publicised as "Ek Ehsaas Jagjit Singh Live in Concert" and "Jagjit Singh sings again for charity". Mrs. Chitra Singh claims all copyright and moral rights over her husband's work post the death of her husband.

The event was being organized in Delhi on the occasion of Late Shri Jagjit Singh's 75th birth anniversary for charitable purposes. The advertisement published by the defendant for the event contained a picture of the singer prominently with the above captions. In this regard, the court agreed with the plaintiff that such advertisements mislead the public into believing that the late singer, who is no more alive, was performing live. The court held that this was a case of breach of privacy rights and other intellectual property rights of the late singer. The organizers of the event were restrained from using advertisements containing Late Shri. Jagjit Singh's image or name and the said captions. However, the court allowed the concert to be conducted as tickets were already sold and it was an event for charity.

Udta Punjab's Producer succeeds in receiving a John Doe Order

The Hon'ble High Court of Bombay on the 16th of June, 2016 passed a John Doe order, directing several websites to take down the links (URLs) allowing illegal download of the unreleased Hindi movie, Udta Punjab. In a case filed by Balaji Motion Picture against Bharat Sanchar Nigam and 49 websites and cable operators, the court has also temporarily restrained cable operators from telecasting the film.

In their suit, the Producer had sought injunction and blocking of websites belonging to the 50 cable operators. However, the Court opined that it was unreasonable to block entire websites and limited the relief to the take down of the downloadable copy of the movie Udta Punjab.

Thanks and Regards

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