

LL.B. V Term

PAPER – LB – 5034 - INTELLECTUAL PROPERTY LAWS

INTRODUCTION

1. **Introduction**
- 1.1 Nature of Intellectual Property
- 1.2 Types of Intellectual property under WTO-TRIPS - Trade Marks, Copyright, Patents, Designs, Geographical Indications, Integrated Circuits, Confidential information;
- 1.3 International Institutional mechanism including various conventions and WIPO
- 1.4 Brief discussion on Geographical Indications Act, 1999

PART A- TRADEMARKS

Legislation – Trade Marks Act, 1999 w.e.f. 15 Sept 2003 replacing Trade and Merchandise Marks Act, 1958

1. **Introduction**
- 1.1 Meaning, Functions, Trade marks for goods or services
- 1.2 Registration not mandatory, unregistered trademarks also protected
- 1.3 Definitions of :
Mark S.2(1)(m); trade mark S.2(1)(zb); Service S.2(1)(z); goods S.2(1)(j); package S.2(1)(q); well known trade mark S.2(1)(zg)
- 1.4 Classification of goods and services
- 1.5 Use of trade mark on good/services– S.2(2)(b) & (c), 29(6),
- 1.5.1 Use in Advertisements –declared as use and ground for protection even without goods/services (*N. R. Dongre v. Whirlpool*, (1996) 5 SCC 714)

(Some Cases are decided on the basis of previous Acts –study with provisions of the new Act - the meanings assigned to words and expressions – apply to new provisions in Act)

2. **Registration of trade mark for goods/services -**
Procedure (S.18 -23), Grounds of Refusal (S.9 & 11), Prior/Vested Rights (s 34 -36), Rectification of register (S.57)
- 2.1 **Absolute Grounds of Refusal of Registration - S.9(1)**
- 2.1.1 Distinctive character - Capable/not capable of distinguishing - clause (a)
- 2.1.2 8 types of Descriptive, laudatory - marks or indications or words – clause (b)

2.1.3	Customary or bonafide practices of trade- – clause (c) Proviso to S.9(1) - Acquired Distinctive character –	
1.	<i>M/s Hindustan Development Corporation Ltd v. The Deputy Registrar of Trade Marks</i> , AIR 1955 Cal 319	1
2.	<i>The Imperial Tobacco Co. of India v. The Registrar of Trade Marks</i> , AIR 1977 Cal 413	7
3.	<i>Geep FlashLight Industries v. Registrar of Trade Marks</i> , AIR 1972 Del 179 (<i>Examples of Habitat Centre (June 2008), coffee time, ‘sugarfree’ etc.</i>)	16
2.2.	S. 9(2) -- ‘Mark of the nature as to deceive public or cause confusion’ – Wide power – no mention of goods /services	
4.	<i>Sunder Parmanand Lalwani v. Caltex (India) Ltd</i> , AIR 1969 Bom 24	20
5.	<i>Sony Kabushuki Kaisha v. Samrao Masker</i> , AIR 1985 Bom 327 (Note the difference in expression Deceptive Similarity – and new wxpression)	
3.	Relative Grounds of Refusal – S. 11	
3.1	Later trade mark similar with Earlier Trade Marks –S.11(1) Identity or similarity of Marks resulting -- in likelihood of confusion or -- Association with earlier Mark (Dilution) and Identitiy or similarity of goods/services Overlap with s 9(2) -	
6.	<i>K. R. Krishna Chettiar v. Sri Ambal & Co</i> , AIR 1970 SC 146	37
3.2	Earlier Trade mark – if a Well Known Trade Mark - S.11(2) Prohibition of registration even for different goods/ services	
3.2.1	Factors for determination - 11(6) to 11(9) & definition in 2(zg)	
3.2.2	Effect of Trade marks registered or used in good faith – S.11(11)	
7.	<i>Carrefour v. Subburaman</i> , 2007(35) PTC 225 (Also on passing off –)	40
3.3	Refusal of registration on grounds of passing off or under law of copyright – S.11(3)	
3.4	Combined effect of Ss. 9(2), 11(1), 11(2) and, 11(3)	
3.5	Prior/ Vested Rights	
3.5.1	Honest and Concurrent user – S.12	
3.5.2	Prior user of mark – S. 34	

3.5.3	Other rights – S. 35	
3.5.4	Acquiescence – S. 33	
4.	Infringement & Passing off Action of Trade mark	
4.1	Enlargement of Infringement protection – S. 29,	
4.2	for same, similar or different goods/services	
4.3	Difference between passing off and infringement	
	Passing off Injunction against registered trade marks	
8.	<i>Parley Products v. J P & Co</i> , AIR 1972 SC 1359	55
9.	<i>Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd</i> , 2001 PTC 541 (SC)	59
	<i>Carrefour v. V. Subburaman</i> , 2007(35) PTC 225 (Also on passing off –)	
4.4	Passing off for similar goods/ different goods/ based on transborder reputation	
10.	<i>Parley Products v. J P & Co</i> , AIR 1972 SC 1359	
11.	<i>Bata India Ltd. v. Pyare Lal & Co.</i> , AIR 1985 All 242	
12.	<i>Milmet Oftho Industries v. Allergen Inc</i> , (2004) 12 SCC 624	73
13.	<i>Bharti Cellular Ltd and Anr v. Jai Distillers P. Ltd.</i> , 2006 (33) PTC 220 (Bom.)	76
5.	Contemporary Areas	
5.1	Protection of Trade Dress & colour combinations	
14.	<i>N Ranga Rao v. Anil Garg</i> , 2006 (32) PTC 15 (Del)	89
5.2	Tarnishment of Trade marks/Comparative Advertising/Disparagement	
	See Also S 29 (8)	
15.	<i>Pepsi Co Inc v. Hindustan Coca Cola Ltd</i> , 2003 (27) PTC 305 (Del) (DB)	109
16.	<i>Dabur India Ltd. v. Colgate Palmolive</i> , 2004 (29) PTC 401 (Del)	121
5.3	Protecting Domain Names as Trade Marks	
17.	<i>Satyam Infoway Ltd v. Sifynet Solutions Pvt. Ltd</i> , AIR 2004 SC 3540	130

PART B – COPYRIGHT

Legislation : The Copyright Act, 1957

Labour, skill and Effort – Doctrine of sweat of the brow; Term of Copyright
 Work S 2 (y), S 16, S 13 copyright only in classes of work, S 22 to 29.

1.	Subject Matter of Copyright	
1.1	Classes of Works in which copyright subsists – S.13, Copyright only in expression No copyright in Ideas,	
1.2	Definitions of various works: Artistic work 2(c), dramatic work 2(h), Literary work 2(o), musical work 2(p), computer programmes 2(ffc), cinematograph films 2(f), sound recordings 2(xx)	
18.	<i>R.G. Anand</i> AIR 1978 SC 16	139
1.4	Meaning of ‘Original’ & – a prefix to s 13(1)(a)	
19.	<i>London University Press v. Tutorial Press</i> , (1916) 2 Ch. D 601	151
1.5	Literary work ;	
20.	Excerpts from <i>London University Press v. Tutorial Press</i> , (1916) 2 Ch. D 601	
21.	<i>Zee Entertainment Enterprises Ltd. v. Gajendra Singh</i> , 2008 (36) PTC 53(Bom)	155
	<i>Illustrative cases</i>	
	<i>Eastern Book Company v. D.B. Modhak</i> , 2008 (36) PTC 1 (SC) ; <i>Barbara Taylor Bradford v. Sahara Media Entertainment Ltd</i> , 2004 (28) PTC 474 (Cal); <i>Anil Gupta v. Kunal Dasgupta</i> , 2002 (25) PTC 1 (Del) ; <i>Zee Telefilms Ltd. v. Sundial Communications</i> , 2003 (27) PTC 457 (Bom) (DB)	
2.	Meaning of Copyright – S.14 – Bundle of Rights	
2.1	Enumeration of rights in s 14 – reproduction , issue of copies, communication to public, translation, adaptation,	
2.2	Other important rights in, Computer programmes, cinematograph film, sound recordings; rental rights	
2.3	Abridgement of the work s 14(a)(vi), 2(a) adaptation, meaning of abridgement, Copyright in abridged work	
22.	<i>Macmillan v. K J Cooper</i> , AIR 1924 PC 75	159
2.4	Author’s Special (Moral) Rights – S.57	
23.	<i>AmarNath Sehgal v. Union of India</i> , (2005) 30 PTC 253	
2.5	Right to Assign and License – S. 18-19A, 30 to 32	
2.6	Rights of Broadcasting Organizations and Rights of Performers –S.37– 38 Exceptions s 39	
3.	Ownership of copyright	
3.1	The first owner – S.17	

- 3.2 Who is an author – S. 2(d) and s 2 (g) (s), S.2(uu), authorship of computer generated works, 2(d) (vi), Proviso (c) to s 17; employment; Joint authorship – tests for:
24. *Gee Pee Films Pvt. Ltd. v. Pratik Chowdhury*, 2002(24) PTC 392 168 (Cal)
25. *Daljit Titus v. Alfred A. Adebare*, 2006 (32) PTC 609 (Del)

4. Infringement and Exceptions

4.1 Infringement – S. 51, Relationship with s 14,

26. *R G Anand v. Deluxe Films*, AIR 1978 SC 1613

4.2 Exceptions to Infringement – S.52 Rights of Public

In all 30 exceptions in s 52, Some of the important exceptions are - Fair Dealing, News and current events, Teaching and Research, and others incl Communication to the public of sound recording in religious ceremonies – S.52 (1) (a) & (b), S.52 (1) (h), S.52(1)(za)

PART C – DESIGNS

Legislation – The Designs Act, 2000

- 1.1 What is design, S.2(d) new and original, appeal to eye,
- 1.2 Copyright in Design (duration)– S.11
- 1.3 Registration of design for articles – Ss.3-9
- 1.4 Rights in registered design
- 1.4.1 Cancellation of Design- S.19
- 1.5 Piracy or Infringement of copyright in Design – S.22
27. *Bharat Glass Tube Limited v. Gopal Glass Works Limited*, S C. Case 174 No: Appeal (civil) 3185 of 2008 [Arising out of S.L.P.(C) No.16321 of 2006], decided on 1/5/2008
(<http://www.judis.nic.in/supremecourt/qrydisp.aspx?filename=31381>)

PART D – PATENTS

Legislation – The Patents Act, 1970

- 1.1 Object of Patent System – Encouraging Inventions and working of Inventions in country concerned. After TRIPS Imports suffice as working.
- 1.2 Patentable Inventions – S.2(1)(j), S.2(1)(ja)
28. *Canadian General Electric Co. Ltd. v. Fada Radio Ltd.*, AIR 1930 PC 1 191
- 1.3 Non Patentable Inventions – S.3 in particular clause (d)
- 1.4 Procedure for filing Patent Application with emphasis on specifications & claims, application for examination, rights of patentees
- 1.5 Anticipation – Prior public knowledge, prior public use

- 1.6 Grounds of Opposition & Revocation – S.25 – Pre-grant, post –grant
- 1.7 Canadian GEC Ltd v Fada Radio AIR 1930 1
29. *F. Hoffmann-La Roche Ltd v. Cipla Limited*, Delhi HC Case No. - 195
I.A 642/2008 In CS (OS) 89/2008, Justice Ravinder Bhatt of Delhi
HC decided on 19.03.2008 (<http://delhihighcourt.nic.in/>)

Prescribed Legislations

- (a) Trade Marks Act, 1999
- (b) Copyright Act, 1957
- (c) Design Act, 2000
- (d) Patents Act, 1970

Recommended Books:

1. Ashwani Kr. Bansal, *Law of Trade Marks in India* (2nd ed., 2006)
2. Ashwani Kr. Bansal, *Materials on Copyright* (2004)
3. V.K. Ahuja, *Law Relating to Intellectual Property Rights* (2007)
4. V.K. Ahuja, *Law of Copyright and Neighbouring Rights: National and International Perspectives* (2007)
5. Alka Chawla, *Copyright and Related Rights: National and International Perspectives* (2007)
6. P. Narayanan, *Copyright and Industrial Designs* (2007)
7. P. Narayanan, *Law of Trade Marks and Passing off* (6th ed., 2004)
8. P. Narayanan, *Patent Law* (4th ed., 2006)
9. *Copinger and Skone James on Copyright* by Gillian Davies, Kevin Garnett, and Gwilym Harbottle, (15th ed., 2005)
10. David Kitchin, David Llewelyn, James Mellor, Richard Meade, Thomas Moody, *Kerly's Law of Trade Marks and Trade Names* (14th Edition 2005)
11. W.R.Cornish, and David Llewelyn, *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights* (5th ed., 2004)

LL.B. V Term Examinations, December, 2007

Note: Attempt five questions including Question No. 1 which is compulsory.
All questions carry equal marks.

1. Attempt briefly any *four* of the following:
 - (a) Meaning of Trade Mark;
 - (b) Protection of well known Trade Marks under the Trade Marks Act, 1999;
 - (c) Moral right of an author under the Copyright Act, 1957;
 - (d) Patentable inventions;
 - (e) Abridgement within the meaning of Copyright Act, 1957.
2. A Trade Mark possesses distinctive character for registration. The Distinctive character can be either inherent or acquired. What is the meaning of inherent or acquired distinctiveness? Explain with relevant provisions of the Trade Marks Act, 1999 and case law.
3. TK Pharma applied for registration of Trade Mark 'Menthaplus' for pharmaceutical and medicinal preparations for human use. It was opposed by the proprietor of Trade Mark 'Methacol' used as veterinary medicine. TK Pharma contended that both medicines have separate uses and both are schedule "L" drugs which can be sold only to the hospitals with the result that there could not even be a remote chance of confusion and deception. Decide in view of the observation of the Supreme Court in Cadila Health Care Ltd. vs. Cadila Pharmaceutical Ltd 2001 PTC 300 (S.C.) regarding the strict standard for deceptive similarity in medicinal products.
4. The appellant registered several domain names using the word 'Nify' (an invented and coined word) with ICANN and the WIPO for its software business. The respondent started interest marketing under the domain name 'Niffy'. The appellant filed a suit of passing off and temporary injunction against the respondent on the ground that he was the prior users. Decide with relevant case law. Whether domain names are subject to the legal norms applicable to trade marks?
5. "In considering whether a mark has reference to the character or quality of goods, the mark must be looked at, not in its grammatical significance, but as it would respect itself to the public at large."

In the light of the above statement, discuss the law relating to the registration of descriptive words as trade marks.
6. A newspaper 'News of India' wanted to publish a series of articles entitled 'Sachin Tendulkar's Centuries Enthralling Stories.' For that purpose they employed Mr. Sarabhai – a free lance journalist who has considerable knowledge and experience of cricket. Mr. Sarabhai got into communication with Tendulkar who told Mr. Sarabhai the various adventures. Mr. Sarabhai made notes of conversation and took manuscript to Tendulkar, who suggested alternations, if necessary. But these alternations were not always adopted in the articles. Later on Mr. Sarabhai wanted to publish these whole list of articles into a book form 'Sachin Tendulkar's experience with Cricket' Tendulkar through his advocates field an injunction suit to restrain the publication claiming himself as author and owner of

the work. Whether he will succeed. Decide the case observing *Donoghue vs. Allied Newspaper Ltd.* (1937) 3 Ch. D. 503.

Whether the reasoning in *Donoghue's* case is correct? Describe the observation of Justice B.N. Kirpal in *Najma Heptulla Vs. M/s Orient Longman Ltd.* A.I.R. 1989 Del: 63. in regard to *Donoghue's* case.

7. What is the object of Patent system? What is the procedure for a grant of Patent in India? Define provisional specification and its relevance.
8. (i) Discuss the law to determine ownership in the context of Section 17 and Section 2(d) of the Copyright Act.
(ii) Dr. Sarita is a professor of intellectual property law in Delhi University. In her career span of 30 years she has published various articles on IP Law prepared a manuscript of text "IP Law and Practice" and also set about 50 examination papers. She contacts a publisher to publish all her articles in a book form, to publish her text book and also examination papers. In book form to help the students.

The University asks the publisher to pay royalty to the University in all the three publications as it owns the copyright. Whether University is right in its claim. Decide with relevant case law and principles concerning employer/employee relationship in matter of ownership of copy right.

LL.B. V Term (Supplementary) Examinations, May-June, 2008

Note: Attempt five questions including Question No. 1 which is compulsory.
All questions carry equal marks.

1. Attempt briefly any *four* of the following:
 - (a) Meaning of 'Trade Mark' under the Trade Marks Act, 1999.
 - (b) Mode of assignment of copyright under the Copyright Act, 1957.
 - (c) Meaning of copyright in the case of computer programme under the Copyright Act, 1957.
 - (d) "Inventive step" under Sec. 2(1)(ja) of the Patents Act, 1970.
 - (e) Do the following amount to 'Use' of a trade mark within the meaning of the Trade Marks Act, 1999?
 - (i) Advertisements (Solus) of a Trade Mark.
 - (ii) Free distribution of goods.
2. "A decision upon registrability of a trade mark involves balancing an inherent tendency to unregistrability as the one hand against evidence showing distinctiveness in fact on the other."

In the light of the above statement, discuss the law relating to registrability of trade marks on the ground of distinctiveness under the provisions of the Trade Marks Act, 1999.

3. X & Co. is manufacturing and marketing cricket bats under a registered trade mark 'Limit' and the picture of a lion with a small tail. After 2 years, Y & Co. approaches the

Registrar for registration of a word 'Sumit' with the picture of a lion having long tail and is also roaring for cricket balls.

X & Co. opposes the registration on the ground that the proposed mark of Y & Co. is deceptively similar to their registered trade mark. Decide with the help of case law.

4. The concept and principle on which passing off action is grounded is that a man is not to sell his own goods under the pretence that they are the goods of another man, that is not the gist of an action for infringement. In view of this, discuss the distinction between 'passing-off' and an 'infringement action.'
5. "There can be no copyright in an idea or ideas. A person who gives expression to the idea whether by means of a book, a picture or a play is the owner of the copyright in the work."

Discuss in the light of the above statement the proper subject matter of the copyright under the Copyright Act, 1957. Will your answer be different if the idea has been crystalized into a 'concept' for a live-show on Television?

6. (a) Mr. X, a professor of Shimla University sets a question paper for Trade Marks Laws for some university, for which he is paid as per that university rules. Discuss whether question papers are proper subject matter of copyright under the Copyright Act, 1957 and who is the owner of Copyright, if any, in this case?
(b) Discuss Author's special right under Sec. 57 of the Copyright Act, 1957.
7. Discuss the inventions where only methods or processes of manufacture were patentable prior to the Patents (Amendment) Act, 2005, under the Patents Act, 1970. Also mention the non-patentable inventions under the Act.
8. What is a "well-known" trade mark under S. 2(1)(2g) of the Trade Marks Act, 1999? Discuss the relevant factors for determining a mark to be a 'well-known trade mark' under the Act.

LL.B. V Term

Intellectual Property Laws

Cases Selected and Edited by

Ashwani Kr. Bansal

V.K. Ahuja

Raman Mittal

O. P. Sharma

Poonam Dass

L. Pushpa Kumar

Sunanda Bharti

FACULTY OF LAW

UNIVERSITY OF DELHI, DELHI-110 007

July, 2008