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Law and Practice

1. Trade Mark and Copyright Law

1.1 Governing Law

In India, trade marks are primarily governed by the Trade Marks Act 1999 and the Trade Marks Rules 2017, forming a comprehensive regulatory regime coupled with common law provisions.

In addition to the statute, official guidelines issued by the Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM), such as the Trade Marks Manual, court precedents and decisions of the Trade Marks Office (TMO) govern several aspects of trade mark law in the country. Further, the decisions of High Courts are binding on lower courts in their respective jurisdictions and form an important source of trade mark law.

There are also ancillary laws which impact trade marks, for example, the Copyright Act 1957, the Companies Act 2013 and, in limited cases, the Designs Act 2000.

Copyright is governed by the Copyright Act 1957 and the associated rules.

As a common law country, common law rights are recognised in India.

1.2 Conventions and Treaties/Rights of Foreign IP Holders

India is a signatory to the Paris Convention on Industrial Property, the WIPO Madrid Agreement Concerning the International Registration of Marks 1891 (the "Madrid Agreement"), the WIPO Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1989 (the "Madrid Protocol") and the Nairobi Treaty.

India further abides by the Nice Agreement on the International Classification of Goods and Services,

and the Vienna Classification, established by the Vienna Agreement.

For copyright, predominantly, India is a member of the Berne Convention of 1886, the Universal Copyright Convention of 1952 and the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement of 1995.

2. Trade Mark Ownership, Protection and Rights

2.1 Types of Trade Marks

A "trade mark", as defined by the Trade Marks Act 1999, is a mark capable of being graphically depicted and capable of differentiating one person's goods or services from those of others, and may include the shape of goods or their packaging, as well as colour combinations. This definition of trade mark is inclusive and evolving.

The following are examples of trade marks that can be registered in India:

- any name (including the applicant's or predecessor in business's personal name or surname, or the person's signature), which is not unusual for trade to use as a mark;
- letters or numerals, or any combination thereof;
- an invented word or any arbitrary dictionary word(s), which are not directly descriptive of the character or quality of the goods or services;
- devices, including fancy devices or symbols;
- slogans, domain names and monograms;
- combinations of colours or even a single colour in combination with a word or device;
- the shape of goods or their packaging;
- marks constituting a three-dimensional sign;
- sound marks when represented in conventional notation or described in words by being graphically represented;
- certification and collective trade marks; and
- service marks or trade dress.

As a first-to-use country, unregistered trade marks with prior usage can be protected under common law in India. The passing off of trade marks is a tort actionable under common law and is mainly used to protect the goodwill associated with a mark.

Statutory Trade Marks

The Indian trade mark statute provides special protection to certain marks: for instance, the Olympic symbol, the Olympic motto and the phrases "Olympic(s)", "Olympian(s)" and "Olympiad(s)" are not to

be registered as trade marks in India without prior permission from the Olympic Committee.

On the basis of international, national and cross-border repute, the TMO also recognises well-known trade marks in India. Such trade marks that are "well known" are given greater protection under the law, which protects them from infringement and passing off in all the classes.

There are certain trade marks governed by charters such as the one developed by the Scotch Whisky Association (SWA) and its members, which protects the SWA trade mark.

Similarly, a mark is prohibited for registration as a trade mark under the following conditions:

- If it comprises any matter that is likely to offend the religious sensibilities of any class or segment of Indian residents.
- If it "comprises or contains scandalous or obscene matter".
- If its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act 1950.
- If it is a word which is the commonly used and accepted name of any single chemical element or compound in respect of chemical substances or preparation. Also, the law prohibits registration of a word which is declared by the World Health Organization and notified by the Registrar of Trade Marks as an international non-proprietary name, or which is deceptively similar to such name.

If an international non-proprietary name is erroneously accepted for registration in respect of pharmaceutical preparations, or if a prohibited or non-registrable trade mark is erroneously accepted for registration, the necessity to revoke/withdraw the acceptance of the application may arise.

Well-Known Trade Marks

Beyond jurisdictional protection of trade marks, Indian courts have taken into consideration factors such as transborder reputation and goodwill in protecting a trade mark that is used or registered in foreign countries, its reputation in foreign jurisdictions, and knowledge and information of the same within the public at large in India due to spill-over of its reputation through travel, the internet, advertisement or any other means.

Indian courts have consistently objected to the unlawful gain or profit from the reputation built by third parties around the world. Further, Indian courts have also objected to passing off of unregistered trade marks, including foreign trade marks.

In addition to declaration of trade marks as well known through courts, the Trade Marks Act 1999 has special provisions which allow for declaration of trade marks on the basis of evaluation of evidence by the TMO.

2.2 Essential Elements of Trade Mark Protection

A mark is prohibited for registration as a trade mark under the following conditions:

- If it comprises any matter that is likely to offend the religious sensibilities of any class or segment of Indian residents.
- If it "comprises or contains scandalous or obscene matter".
- If its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act 1950.
- If it is a word which is the commonly used and accepted name of any single chemical element or compound in respect of chemical substances or preparation. Also, the law prohibits registration of a word which is declared by the World Health Organization and notified by the Registrar of Trade Marks as an international non-proprietary name, or which is deceptively similar to such name.

If an international non-proprietary name is erroneously accepted for registration in respect of pharmaceutical preparations, or if a prohibited or non-registrable trade mark is erroneously accepted for registration, the necessity to revoke/withdraw the acceptance of the application may arise.

Absolute Grounds for Refusal

The TMO can object to or refuse an application on either absolute or relative grounds. Absolute grounds, which disqualify a mark from being registered (according to Section 9 of the Trade Marks Act 1999), include:

- the mark is not distinctive;
- the mark is descriptive of associated goods and services;
- use of the mark has become customary and is bona fide used in established practices;
- the mark is deceptive and will cause confusion;
- use of the mark can offend the religious views of persons in India;
- the mark contains obscene or scandalous elements; and
- the shape of a mark is a result of the nature of the goods themselves or is required for functional use.

In order to overcome TMO objections raised under Section 9(1), the applicant may submit that the mark has acquired a distinctive character by virtue of its prior use. The use of a trade mark must be established by adequate evidence.

Relative Grounds for Refusal

Relative grounds for refusal of registration (according to Section 11 of the Trade Marks Act 1999) include:

- deceptive similarity of the mark in question with the opponent's registered mark;
- similarity of the mark in question with a mark which has prior use; and
- adoption of the mark in bad faith.

Objections raised under Section 11 can be overcome by the applicant by:

- removing the conflicting goods or services by way of amendment;
- obtaining consent from the proprietor of the cited mark(s) under Section 11(4);
- filing evidence to establish honest concurrent use to secure registration under Section 12;
- securing rectification of the register excluding such goods or services of the same description from the specification of the cited mark under Section 57; or
- dividing the application and allowing the objections-free part of the application to proceed further.

2.3 Trade Mark Rights

Section 28 of the Trade Marks Act 1999 states as follows:

"28. Rights conferred by registration

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor."

Section 65A and Section 65B of the Copyright Act 1957 allow for the same, and the sections are replicated below.

"65A. Protection of technological measures

(1) Any person who circumvents an effective technological measure applied for the purpose of protecting any of the rights conferred by this Act, with the intention of infringing such rights, shall be

punishable with imprisonment which may extend to two years and shall also be liable to a fine.

(2) Nothing in sub-section (1) shall prevent any person from –

(a) doing anything referred to therein for a purpose not expressly prohibited by this Act: Provided that any person facilitating circumvention by another person of a technological measure for such a purpose shall maintain a complete record of such other person including his name, address and all relevant particulars necessary to identify him and the purpose for which he has been facilitated; or

(b) doing anything necessary to conduct encryption research using a lawfully obtained encrypted copy; or

(c) conducting any lawful investigation; or

(d) doing anything necessary for the purpose of testing the security of a computer system or a computer network with the authorisation of its owner; or

(e) operator; or

(f) doing anything necessary to circumvent technological measures intended for identification or surveillance of a user; or

(g) taking measures necessary in the interest of national security."

"65B. Protection of Rights Management Information – Any person, who knowingly –

(i) removes or alters any rights management information without authority, or

(ii) distributes, imports for distribution, broadcasts or communicates to the public, without authority, copies of any work, or performance knowing that electronic rights management information has been removed or altered without authority, shall be punishable with imprisonment which may extend to two years and shall also be liable to a fine:

Provided that if the rights management information has been tampered with in any work, the owner of copyright in such work may also avail of civil remedies provided under Chapter XII against the persons indulging in such acts."

2.4 Use in Commerce

A trade mark can be registered on a "proposed to be used" basis. There is no requirement for the mark to have been used in India to make it eligible for registration in India. If, however, use of the trade mark is not commenced for a period of five years, this can be a ground for removal of the trade mark from the Register of Trade Marks.

Having said that, the Honourable Supreme Court of India, in a judgment, stated that "use of a mark in regard to the goods is to be considered as a reference to the usage of the mark upon, or in any physical, or in any other relation whatsoever, and is not necessarily limited to physical use on goods or to the sale of goods bearing the trade mark".

2.5 Notices and Symbols

Predominantly there are three kinds of trade mark symbols:

- the unregistered trade mark, represented by the letters TM;
- the service trade mark, represented by the letters SM, which is typically used by service sector brands; and
- the registered trade mark, represented by the symbol ®.

The TM and SM symbols can be used with a mark by anyone who is claiming rights to that mark, regardless of having an actual trade mark registration in place.

2.6 Related Rights

A trade mark can also be protected by copyright or related rights. In India, the TMO is contacted prior to the registration of a copyrightable artistic work that can also be used as a trade mark for certification that there are no trade marks on record that are similar to the copyrightable artistic work.

The artistic work copyright can be filed for registration only when the TMO confirms and certifies that there are no similar or identical trade marks on record. Likewise, a trade mark cannot be registered if it is in conflict with a copyrighted work.

While India's trade mark and copyright regulations take into account potential conflicts, there is currently no practical mechanism either established by trade mark law or used by trade mark authorities in India to examine copyright records while assessing trade mark applications.

3. Copyright Ownership, Protection and Rights

3.1 Types of Copyrightable Works

Section 13 of the Copyright Act 1957 states as follows:

"Section 13. Works in which copyright subsists.

(1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist

throughout India in the following classes of works, that is to say, –

(a) original literary, dramatic, musical and artistic works;

(b) cinematograph films; and

(c) 1 [sound recording].

(2) Copyright shall not subsist in any work specified in sub-section (1), other than a work to which the provisions of section 40 or section 41 apply, unless –

(i) in the case of a published work, the work is first published in India, or where the work is first published outside India, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of India;

(ii) in the case of an unpublished work other than a 2 [work of architecture], the author is at the date of making of the work a citizen of India or domiciled in India; and

(iii) in the case of a 2 [work of architecture], the work is located in India.

Explanation – In the case of a work of joint authorship, the conditions conferring copyright specified in this sub-section shall be satisfied by all the authors of the work.

(3) Copyright shall not subsist

(a) in any cinematograph film if a substantial part of the film is an infringement of the copyright in any other work;

(b) in any 3 [sound recording] made in respect of a literary, dramatic or musical work, if in making the 3 [sound recording], copyright in such work has been infringed.

(4) The copyright in a cinematograph film or a record shall not affect the separate copyright in any work in respect of which or a substantial part of which, the film, or, as the case may be, the 3 [sound recording] is made.

(5) In the case of a 3 [work of architecture], copyright shall subsist only in the artistic character and design and shall not extend to processes or methods of construction."

3.2 Essential Elements of Copyright Protection

Originality is the most vital qualification for copyright protection in India, and the work must be expressed in a tangible medium.

3.3 Copyright Authorship

Section 17 of the Copyright Act provides information on who can be called as the first owner of copyright.

"17. First owner of copyright

Subject to the provisions of this Act, the author of a work shall be the first owner of the copyright therein:

Provided that –

(a) 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;

(b) subject to the provisions of clause (a), 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;

(c) in the case of a work made in the course of the author's employment under a contract of service or apprenticeship, to which clause (a) or clause (b) does not apply, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(cc) in the case of any address or speech delivered in public, the person who has delivered such address or speech or if such person has delivered such address or speech on behalf of any other person, such other person shall be the first owner of the copyright therein notwithstanding that the person who delivers such address or speech, or, as the case may be, the person on whose behalf such address or speech is delivered, is employed by any other person who arranges such address or speech or on whose behalf or premises such address or speech is delivered;

(d) in the case of a Government work, the Government shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(dd) 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;…"

India also recognises the concept of joint authorship.

3.4 Copyright Rights

Section 14 of the Copyright Act 1957 grants exclusive rights as follows:

"14. Meaning of copyright

For the purposes of this Act, copyright means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely –

(a) in the case of a literary, dramatic or musical work, not being a computer program –

(i) to reproduce the work in any material form including the storing of it in any medium by electronic means;

(ii) to issue copies of the work to the public not being copies already in circulation;

(iii) to perform the work in public, or communicate it to the public;

(iv) to make any cinematograph film or sound recording in respect of the work;

(v) to make any translation of the work;

(vi) to make any adaptation of the work;

(vii) to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);

(b) in the case of a computer program –

(i) to do any of the acts specified in clause (a);

(ii) to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programmer:

Provided that such commercial rental does not apply in respect of computer programs where the program itself is not the essential object of the rental;

(c) in the case of an artistic work –

(i) to reproduce the work in any material form including –

(A) the storing of it in any medium by electronic or other means; or

(B) depiction in three dimensions of a two-dimensional work; or

(C) depiction in two dimensions of a three-dimensional work;

(d) in the case of a cinematograph film –

(i) to make a copy of the film, including –

(A) a photograph of any image forming part thereof; or

(B) storing of it in any medium by electronic or other means;

(ii) to sell or give on commercial rental or offer for sale or for such rental, any copy of the film;

(iii) to communicate the film to the public;

(e) in the case of a sound recording –

(i) to make any other sound recording embodying it including storing of it in any medium by electronic or other means;

(ii) to sell or give on commercial rental or offer for sale or for such rental, any copy of the sound recording;

(iii) to communicate the sound recording to the public.

Explanation – For the purposes of this section, a copy which has been sold once shall be deemed to be a copy already in circulation."

Moral rights are recognised in India and the provisions of Section 21 of the Act regulate that.

3.5 Term of Protection and Termination

Sections 22–29 of the Copyright Act provide the terms for copyright protection.

The term of protection is the lifetime of the author plus 60 years after the death of the author:

- for published literary, dramatic, musical and artistic works; for literary, dramatic, musical and artistic works (other than a photograph) which are published anonymously and pseudonymously; for posthumous works (literary, dramatic, musical works or engravings);

- for cinematographic works;
- for sound recordings;
- in the case of government works;
- in the case of works of public undertakings; and
- in the case of works of international organisations.

3.6 Collective Rights Management Systems

Currently, India has the Indian Reprographic Rights Organisation (IRRO), the Indian Singers and Musicians Rights Association (ISAMRA) and the Indian Performing Rights Society Limited (IPRS), among others. Section 33 of the Copyright Act 1957 recognises collection societies in India. Such societies may issues licences, collect fees for licences and distribute such fees among authors or other stakeholders.

3.7 Copyright Registration

It is not mandatory to seek copyright registration; however, securing a registration is beneficial in enforcement actions as also in controlling counterfeiting. The copyright register is available for inspection with the Copyright Office. Any person claiming to be the author of a work can seek protection. Foreign applicants require a local attorney.

Notices and Symbols

Use of the copyright symbol © can be made; however, it is not mandatory.

3.8 Copyright Application Requirements

The information required for filing a copyright application is as follows:

- name of the applicant;
- address of the applicant;
- nationality of the applicant;
- title of the work;
- language of the work;
- copy of the work;
- name of the creator/inventor/singer/composer of the work;
- address of the creator/inventor/author of the work;
- nationality of the creator/inventor/author of the work;
- NOC of the author/developer;
- POA (draft to be provided);
- whether the work is published;

- if the work is published –
- year of first publication;
- country of first publication;
- name, address and nationality of the publisher;
- if the work is published more than once, then –
- years of subsequent publication;
- countries of subsequent publication;
- names, addresses and nationalities of the publishers; and
- an image of the signature of the authorised signatory.

The government fee for filing a copyright action is as follows:

- artistic work: approx. USD165;
- software: approx. USD8;
- literary work: approx. USD8;
- cinematographic work: approx. USD61; and
- sound recording: approx. USD25.

3.9 Refusal of Registration

At the time of filing, barring a declaration, there is no other mechanism followed by the Copyright Office to assess originality and thereafter issue a refusal. The exception to this is an artistic work, as, prior to filing a copyright application for an artistic work, a clearance is taken from the TMO on similarity of the artwork with third-party trade marks.

3.10 Related Rights

No response is available for this jurisdiction.

4. Trade Mark Registrations and Applications

4.1 Trade Mark Registration

In India, ownership of a trade mark is determined based on the first-to-use principle, and passing-off of any mark can be asserted regardless of registration status. If a mark lacks distinctiveness, it can nevertheless be registered under Section 9 of the Trade Marks Act 1999 if it has acquired distinctiveness and/or a secondary meaning through usage.

4.2 Trade Mark Register

In India, the CGPDTM controls trade mark registrations and registered trade marks. On its website, the Trade Marks Registry offers a free online trade mark search. All trade mark applications submitted to the TMO in India, including all registered, applied, challenged and expired trade marks, are included in the database.

Although it is not required, conducting a trade mark search before applying to register a trade mark is advisable. Accessing the online trade marks database, as well as Registrar of Companies records, domain searches and a basic internet search, can be used to do trade mark searches in India for word marks and device marks.

4.3 Term of Registration

The registration of a trade mark is valid for a period of ten years and renewable every ten years, in accordance with the provisions of the Trade Marks Act 1999 and Trade Marks Rules 2017.

Renewal of Trade Marks After Lapse of Term

Trade mark owners in India can renew their registrations after the term has lapsed. Trade marks are initially registered for ten years, and renewal is required every ten years to maintain the registration.

- If the owner does not renew the trade mark before its expiration, the owner can still apply for renewal during a grace period of six months following the expiration date.
- After the grace period, the trade mark is removed from the Register of Trade Marks, but the owner may apply for its restoration within one year from the expiration date.

4.4 Application Requirements

Any natural person, legal person or other organisation that claims to be the owner of a trade mark can apply for trade mark registration.

The following information and documentation must be submitted in a trade mark registration application:

- applicant's name and address;
- state or country of incorporation;
- a description of the trade mark;
- a representation of the trade mark;
- a list of the relevant goods or services;
- the power of attorney;
- the date of first use – if use is claimed, an affidavit of use and documentary evidence must be filed

electronically;
- a statement of intention to use;
- the official filing fee;
- a priority claim and documents, where priority of an earlier application is claimed; and
- if the applicant is not domiciled in this jurisdiction, a local service address.

An agent filing to register a mark on behalf of the owner requires a simple executed power of attorney. Multi-class trade mark applications are allowed in India.

4.5 Use in Commerce Prior to Registration

A trade mark can be registered on a "proposed to be used" basis. There is no requirement for the mark to have been used in India to make it eligible for registration in India. If, however, use of the trade mark is not commenced for a period of five years, this can be a ground for removal of the trade mark from the Register of Trade Marks.

4.6 Consideration of Prior Rights in Registration

A trade mark can be denied registration under Section 11(1) of the Trade Marks Act 1999 if there is a likelihood of public confusion with an earlier trade mark, including the likelihood of association with the earlier trade mark, and if either of the following relative grounds (based on prior rights) applies:

- the mark is identical to or comparable to an earlier trade mark in the same or a similar goods or services sector; or
- the mark is similar to an earlier trade mark in the same or a similar goods or services sector.

However, one way to overcome such objections on prior similar mark(s) in the register is by obtaining consent from the proprietor(s) of the cited mark(s).

4.7 Revocation, Change, Amendment or Correction of an Application

A correction of any errors in the application or any amendment to the application is permitted by the Trade Marks Act 1999. However, no request for correction/amendment shall be allowed which seeks substantial alteration in the application for registration of a trade mark.

4.8 Dividing a Trade Mark Application

The Trade Marks Act 1999 provides for the filing of a division application by the applicant. Following the division, each divided application is treated as a separate application, with the same filing date. A separate new serial number is allotted to each divided application and they are linked by cross-reference with the initial application.

4.9 Incorrect Information in an Application

The Trade Marks Act 1999 enumerates numerous offences in relation to falsifying or falsely applying a trade mark, making or possessing instruments for falsifying trade marks, applying false trade descriptions and so on. The punishments for these offences vary, but the punishment can be as severe as imprisonment for up to three years, with or without a fine.

It is possible to correct the information in an application, except if it is considered a substantial alteration.

4.10 Refusal of Registration

The TMO can object to or refuse an application on either absolute or relative grounds.

Absolute grounds, which disqualify a mark from being registered (according to Section 9 of the Trade Marks Act 1999), include:

- the mark is not distinctive;
- the mark is descriptive of associated goods and services;
- use of the mark has become customary and is bona fide use in established practices;
- the mark is deceptive and will cause confusion;
- use of the mark can offend the religious views of persons in India;
- the mark contains obscene or scandalous elements; and
- the shape of a mark is a result of the nature of the goods themselves or is required for functional use.

Relative grounds for refusal of registration (according to Section 11 of the Trade Marks Act 1999) include:

- deceptive similarity of the mark in question with the opponent's registered mark;
- similarity of the mark in question with a mark which has prior use; and
- adoption of the mark in bad faith.

In order to overcome TMO objections raised under Section 9(1), the applicant may submit that the mark has acquired a distinctive character by virtue of its prior use. The use of a trade mark must be established by adequate evidence.

Objections raised under Section 11 can be overcome by the applicant by:

- removing the conflicting goods or services by way of amendment;
- obtaining consent from the proprietor of the cited mark(s) under Section 11(4);
- filing evidence to establish honest concurrent use to secure registration under Section 12;

- securing rectification of register excluding such goods or services of the same description from the specification of the cited mark under Section 57; or
- dividing the application and allowing the objections-free part of the application to proceed further.

4.11 The Madrid System

India is a signatory to the WIPO Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1989 (the "Madrid Protocol").

The applicant must be an Indian national, be domiciled in India, or have a real and effective business or commercial establishment in India in order to obtain an international trade mark registration in India.

Furthermore, the applicant must have an application for a national (Indian) trade mark or a trade mark registration with the Indian TMO. The international application will be based on this national trade mark application/registration.

5. Trade Mark Procedure for Inter Partes Proceedings

5.1 Timeframes for Filing an Opposition or Cancellation

An opposition window remains open for a period of four months from the date of advertisement of a trade mark application in the *Trade Marks Journal*. This time period cannot be extended under any circumstance.

If an opponent cannot file its opposition within this period, an extension of time is not allowed under the current Indian trade mark law. The four-month period is strict, and failure to file an opposition within this timeframe results in the forfeiture of the right to oppose.

Once an opposition is filed, the applicant and the opposing party can enter into negotiations to reach an amicable resolution.

This informal "cooling-off period" is not explicitly prescribed under the Trade Marks Act 1999, but parties often mutually agree to request an adjournment of proceedings to facilitate negotiations.

If an amicable resolution is reached, the opponent can withdraw its opposition by filing an appropriate application before the Registrar of Trade Marks.

Under the Trade Marks Act 1999, there are statutory limitations and specific time periods for filing

revocation or cancellation actions:

Revocation or Cancellation of a Trade Mark

A trade mark can be revoked or cancelled on several grounds, such as non-use, lack of distinctiveness, or if it was registered in bad faith.

Time limitations

- *Non-use revocation:* A trade mark can be revoked if it has not been used for a continuous period of five years from the date of registration and three months before the date of the application for cancellation.
- *Bad faith or other grounds:* There is no specific statutory time limit to file for revocation or cancellation on grounds such as bad faith, lack of distinctiveness, or violation of procedural requirements. Such actions can be filed anytime during the validity of the trade mark registration.
- *Well-known marks or prior rights:* Cancellation can be sought at any time if the trade mark violates the rights of a prior well-known or registered mark.

Grounds for Cancellation of Copyright Registration

A copyright registration can be challenged or cancelled if it was obtained through fraud or misrepresentation.

Time limitations: The law does not specify a strict time limit for challenging copyright registration. However, general principles of limitation laws in India may apply, which could restrict challenges to within three years from the date when the fraud or misrepresentation was discovered.

5.2 Legal Grounds for Filing an Opposition or Cancellation

There are no specified grounds of opposition under the statutory law, but an opposition is broadly based on absolute or relative grounds as stated under the Trade Marks Act 1999. Besides this, an opponent could also raise objection with regard to the proprietorship of the trade mark opposed, prohibitions contained in Section 13, absence of consent in writing in Section 14, etc.

5.3 Ability to File an Opposition or Revocation/Cancellation

Filing of Opposition

Any person may give a notice of opposition to the registration of a trade mark, regardless of whether the opponent has any commercial or personal interest in the matter or is a prior registered trade mark owner. The question of bona fides of the opponent does not arise. The prescribed official government fee to file an opposition against any advertised mark is USD40, and attorneys' fees are

USD885.

Revocation/Cancellation Proceeding

Any aggrieved person may make an application before the TMO or the Intellectual Property Division for removal of a registered trade mark or for cancelling the registration of the trade mark and for rectification of the register, as such.

Persons aggrieved are generally persons who are in some way or another substantially interested in having the mark removed from the register, or persons who would be substantially damaged if the mark remained on the register, perhaps as it would affect their own rights in a trade mark or any like reason. Hence, in a revocation/cancellation petition, the person aggrieved needs to file a statement of case establishing the reason behind the petition.

5.4 Opposition or Revocation/Cancellation Procedure

Opposition Procedure

Once a notice of opposition is filed, the procedure is as follows:

- the TMO will serve a copy of the notice of opposition to the applicant;
- following the service of the notice of opposition, the applicant is given two months to file a counterstatement outlining its position in order to overcome the grounds of opposition;
- the applicant's trade mark is deemed abandoned for non-prosecution if it fails to file a counterstatement within two months of receiving the opposition;
- alternatively, after filing of the counterstatement, the opposition will proceed to the evidence stage; and
- upon completion of the evidence stage, a hearing notice date is generated and, after hearing the parties and considering the evidence, the TMO then gives its verdict on whether the trade mark is accepted for registration or refused.

Revocation/cancellation procedure: An application for revocation/cancellation of a registered trade mark can be filed before the TMO or the Intellectual Property Division in the prescribed manner and with the requisite fee.

5.5 Legal Remedies Against the Decision of the Trade Mark Office

If either of the parties is not satisfied with the TMO's decision in opposition proceedings, then the decision can be challenged by filing an appeal before the Intellectual Property Division.

5.6 Amendment in Revocation/Cancellation Proceedings

There is no explicit provision for amendment given in revocation/cancellation proceedings. However, in case of a partial revocation/cancellation petition – as explained in **5.4 Opposition or Revocation/Cancellation** – amendment to limit the specification could be directed.

5.7 Combining Revocation/Cancellation and Infringement

Under Section 124 of the Trade Marks Act 1999, the defendant in an infringement suit can seek a stay of the infringement proceedings. In order to obtain a stay, the defendant must contest the registration of the mark that is the subject of infringement proceedings.

5.8 Measures to Address Fraud

If any trade mark is registered without any sufficient cause (ie, if registration was obtained by fraud or misrepresentation of facts or the mark registered is similar to an already registered trade mark), then cancellation proceedings can be initiated for the impugned mark under Section 57 of the Trade Marks Act 1999.

6. Assignments and Licensing

If any trade mark is registered without any sufficient cause (ie, if registration was obtained by fraud or misrepresentation of facts or the mark registered is similar to an already registered trade mark), then cancellation proceedings can be initiated for the impugned mark under Section 57 of the Trade Marks Act 1999.

6.1 Assignment Requirements and Restrictions

The Trade Marks Act states that if the validity of an assignment is disputed, the TMO has the authority to refuse to register the assignment until the parties' rights are established by a competent court.

The assignment or transmission where multiple exclusive rights would be created in more than one person is restricted, as is the separation of rights on a territorial basis and the creation of rights in various individuals in different parts of India. The TMO, on the other hand, has the authority to allow assignment if it is considered to be in the public interest.

Where there is an assignment without goodwill of business, it will not take effect unless the assignor obtains directions from the TMO and advertises the assignment as per directions. Furthermore, certification trade marks can only be assigned subject to consent of the TMO.

Before recording an assignment that involves the transmission of money outside India, the consent of an authority specified in any law for the transmission of money overseas must be produced.

Partial Assignment

Both trade marks and copyrights in India can be partially assigned, subject to the conditions of clarity, proper documentation, and compliance with statutory requirements.

Both copyright and trade mark rights are transmissible upon the death of the owner.

6.2 Licensing Requirements or Restrictions

In India, licensing can be governed by specific terms under applicable laws, including the Copyright Act 1957, and the Trade Marks Act 1999. Below is an overview of licensing requirements, types and important clauses to consider.

General Licensing Requirements

Trade mark licensing: Registering a licence with the TMO is not mandatory but highly advisable. A registered licence grants the licensee statutory rights of action in case of infringement.

Key clauses in a licence agreement include:

- *Quality control monitoring:* Ensures that the licensor maintains quality standards associated with the intellectual property (IP).
- *Trade mark usage:* Specifies the permitted use of the trade mark or copyrighted material.
- *Grant clause:* Defines the scope and nature of the licence.
- *Indemnity clause:* Protects the licensor from liability arising from misuse by the licensee.
- *Termination clause:* Outlines the conditions under which the licence may be terminated.

Types of Licences

For copyrights (Copyright Act 1957):

- Exclusive licence
- Non-exclusive licence

For trade marks (Trade Marks Act 1999):

- *Exclusive licence:* The licensee has exclusive rights to use the trade mark for the licensed goods or services. The owner cannot use the trade mark or grant licences similar to those of others for the same goods or services.
- *Non-exclusive licence:* Allows the licensor to license the trade mark to multiple licensees while

continuing to use it themselves.

Perpetual Licences

A perpetual licence is defined as one that remains valid indefinitely, provided it is explicitly stated in the agreement.

- *Copyright:* A licence cannot exceed the term of the copyright (lifetime of the author plus 60 years for literary, dramatic, musical or artistic works).
- *Trade marks:* Perpetual licences are allowed, subject to the condition that the trade mark registration is renewed every ten years to remain valid.

Archival Rights

- *Copyrights:* Licences can include archival rights, allowing the licensee to store, reproduce and retrieve the licensed material for specified purposes. These rights must be clearly defined in the agreement.
- *Trade marks:* Although archival rights are less relevant for trade marks, agreements may include provisions for maintaining historical usage records.

Licensing of Applications for IP

IP applications, such as patents, trade marks, copyrights and designs, can be licensed even before registration is granted.

Licensing of applications must comply with applicable laws and may include restrictions or conditions to protect the interests of the applicant and the licensee.

6.3 Registration or Recording of an Assignment or Licence

In India, while assignments and licences are valid even without registration, it is strongly recommended to register them. Registration helps minimise risks such as disputes over priority, unenforceability, or conflicts with later recorded assignments or licences. It ensures legal certainty, provides clarity, and establishes priority over subsequent claims.

7. Initiating Trade Mark and Copyright Lawsuits

7.1 Timeframes for Filing Infringement Lawsuits

The Limitation Act 1963 sets out the statute of limitations for filing infringement actions. In most civil cases, the statute of limitations runs for three years from the date of the first breach of rights. An

infringement proceeding, on the other hand, necessitates the use of a deceptively similar mark by the defendant. Because each instance of usage of such a mark gives rise to a new cause of action, the three-year limit does not apply in such cases (*Timken Company v Timken Services Private Ltd*, 2004 (28) PTC 121 SC).

7.2 Legal Claims for Infringement Lawsuits and Their Standards

Based on the level of infringement, various strategies could be devised on a case-by-case basis, which could include obtaining and executing legal proceedings, serving the opposite party with cease-and-desist notices, and/or initiating pre-litigation mediation proceedings.

The trade mark owner can pursue infringement actions or passing off in the competent court for civil relief such as:

- an interlocutory, temporary or ad interim injunction;
- a permanent or perpetual injunction;
- a Mareva injunction (freezing injunction);
- an Anton Piller order;
- a John Doe order;
- damages or accounts of profits; and
- delivery up and destruction.

Criminal and administrative reliefs are also available under the Trade Marks Act 1999.

Section 29 of the Trade Marks Act 1999 provides an exhaustive list of situations in which a registered mark can be infringed. Similarly, unregistered trade marks are protected as part of India's common law regime. An action for passing off can always be instituted against the misuse of an unregistered trade mark.

Section 27 of the Trade Marks Act 1999 specifically reinforces this common law remedy by stating that the right to invoke a claim for passing off remains undisturbed by the statute.

7.3 Factors in Determining Infringement

Section 29 of the Trade Marks Act 1999 gives a comprehensive list of scenarios in which a trade mark can be violated. One of the essential requirements for infringement is that the infringing mark is used in the course of business by a third party.

Further tests for infringement include the following:

- use of an identical or deceptively similar mark on goods or services that are the same as those covered by the scope of the former trade mark's registration;

- use of an identical or similar mark on goods and services that are identical or similar to the goods or services associated with the registered trade mark, in a way that is likely to confuse the public into thinking that the original mark and the offending mark are associated with one another;
- use of a mark, even in relation to goods or services which are not covered in the scope of the registration, provided that the registered trade mark has a reputation in India – the reputation also must be such that misuse by the third party denigrates the distinctiveness of the mark; and
- use of mark, or a part of the mark, as part of the corporate name or trading name of an entity.

7.4 Prerequisites and Restrictions to Filing a Lawsuit

While there are no mandatory requirements before initiating a lawsuit, issuing a demand letter/cease-and-desist notice to a suspected infringer might assist in stopping the infringement without resorting to litigation, thus accelerating the process.

Before taking action, it is also a good idea to perform necessary investigations.

Section 142 of the Trade Marks Act 1999, on the other hand, protects a person from threats of infringement lawsuits by allowing courts to declare that the claims of infringement and breach of rights are unjustified and groundless.

7.5 Lawsuit Procedure

In India, lawsuits for infringement and passing off, among other claims, can be filed before District Courts and cannot be heard in any court lower than a District Court.

Further, a suit relating to trade mark dispute can also be brought before a High Court having original jurisdiction (ie, the High Courts of Delhi, Mumbai, Chennai and Kolkata).

Legal practitioners (registered under the Central Advocates Act 1961) or registered trade mark agents can represent parties. Parties can also present their cases in person (Section 145, Trade Marks Act 1999).

Costs of Litigating Infringement Actions

Investigation fees, attorneys' fees and expenses, notarisation fees, translation fees and court fees are all examples of usual costs. After a first-instance decision, litigation costs, including attorneys' fees, are recoverable. However, there is no guarantee that a party against whom an injunction is obtained will have to bear the expenses of litigation. The court has complete discretion over whether or not to award expenses.

Foreign trade mark and copyright owners can bring infringement claims in India.

7.6 Declaratory Judgment Proceedings and Other Protections for Potential Defendants

Section 142 of the Trade Marks Act 1999 protects a person from threats of infringement lawsuits by enabling courts to declare that the claims of infringement and breach of rights are unjustified and groundless.

7.7 Small Claims

No response is available for this jurisdiction.

7.8 Effect of Trade Mark and Copyright Office Decisions

The development of trade mark law in India is heavily inspired by judicial pronouncements. High Court decisions (with appellate and writ jurisdiction) bind lower courts in their respective jurisdictions and are an important source of trade mark law. Decisions of the TMO also have a major role to play.

7.9 Counterfeiting and Bootlegging

As with other trade mark policies, the enforcement of trade mark counterfeiting laws serves to safeguard potential consumers. The Customs Act 1962, read with the Intellectual Property Rights (Imported Goods) Enforcement Rules 2007, makes it illegal to import goods that infringe on IP rights. Because counterfeit goods are intrinsically prohibited under the Customs Act, they have the authority to halt the clearance of goods on their own initiative, as well as where there are prima facie evident or reasonable grounds to believe that the import of specific goods may infringe on IP rights.

Trade mark counterfeiting is not defined or addressed in the Trade Marks Act 1999. However, Section 102 of the Act, which deals with "falsifying and falsely applying trade marks", covers such counterfeiting.

In addition to trade mark infringement and passing off activities, a trade mark owner may seek criminal action against trade mark counterfeiting (civil actions). Sections 103 and 104 of the Trade Marks Act 1999 make it illegal to use and sell goods and services under false trade marks. The sentence might range from six months to three years in prison, with a fine.

Further, even a quia timet action can be taken against counterfeits to restrain them in case of an anticipated risk.

8. Litigating Trade Mark and Copyright Claims

8.1 Special Procedural Provisions for Trade Mark or Copyright Proceedings

In a landmark decision, with effect from April 2021, the country abolished the Intellectual Property Appellate Board (IPAB) and transferred jurisdiction of adjudicating appeals to the High Courts. Subsequently, Delhi High Court formed a dedicated Intellectual Property Division to formalise and hear IP matters that had been pending before the IPAB. Delhi High Court created the Intellectual Property Division to deal with matters relating to IP rights, with which the aggrieved parties can file their claims.

8.2 Effect of Registration

A trade mark registration establishes a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration.

8.3 Costs of Litigating Infringement Actions

Investigation fees, attorneys' fees and expenses, notarisation fees, translation fees and court fees are all examples of usual costs. After a first-instance decision, litigation costs, including attorneys' fees, are recoverable. However, there is no guarantee that a party against whom an injunction is obtained will have to bear the expenses of litigation. The court has complete discretion over whether or not to award expenses.

9. Defences and Exceptions to Infringement

9.1 Defences to Trade Mark Infringement

Defences available against infringement claims include the following:

- delay and laches;
- acquiescence;
- honest and good-faith adoption and use;
- differences in goods and services;
- the nature of the product;
- pricing; and
- the absence of confusion or deception.

Acquiescence may be considered a form of delay, although it has a more active element of knowledge of third-party rights coupled with delay.

9.2 Defences to Copyright Infringement (Fair Use/Fair Dealing)

Section 52 of the Copyright Act details the provisions that allow for fair use.

"52. Certain acts not to be infringement of copyright

(1) The following acts shall not constitute an infringement of copyright, namely –

(a) a fair dealing with any work, not being a computer program, for the purpose of –

(i) private or personal use, including research;

(ii) criticism or review, whether of that work or of any other work;

(iii) the reporting of current events and current affairs, including the reporting of a lecture delivered in public;

Explanation – The storing of any work in any electronic medium for the purposes mentioned in this clause, including the incidental storage of any computer program which is not itself an infringing copy for the said purposes, shall not constitute infringement of copyright;

(aa) the making of copies or adaptation of a computer program by the lawful possessor of a copy of such computer program, from such copy –

(i) in order to utilise the computer program for the purpose for which it was supplied; or

(ii) to make back-up copies purely as a temporary protection against loss, destruction or damage in order only to utilise the computer program for the purpose for which it was supplied;

(ab) the doing of any act necessary to obtain information essential for operating interoperability of an independently created computer program with other programmer by a lawful possessor of a computer program provided that such information is not otherwise readily available;

(ac) 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;

(ad) the making of copies or adaptation of the computer program from a personally legally obtained copy for non-commercial personal use;

(b) the transient or incidental storage of a work or performance purely in the technical process of electronic transmission or communication to the public;

(c) transient or incidental storage of a work or performance for the purpose of providing electronic links, access or integration, where such links, access or integration has not been expressly prohibited by the right holder, unless the person responsible is aware or has reasonable grounds for believing that such storage is of an infringing copy:

Provided that if the person responsible for the storage of the copy has received a written complaint from the owner of copyright in the work, complaining that such transient or incidental storage is an infringement, such person responsible for the storage shall refrain from facilitating such access for a period of twenty-one days or till he receives an order from the competent court refraining from facilitation access and in case no such order is received before the expiry of such period of twenty-one days, he may continue to provide the facility of such access;

(d) the reproduction of any work for the purpose of a judicial proceeding or for the purpose of a report of a judicial proceeding;

(e) the reproduction or publication of any work prepared by the Secretariat of a Legislature or, where the legislature consists of two Houses, by the Secretariat of either House of the Legislature, exclusively for the use of the members of that Legislature;

(f) the reproduction of any work in a certified copy made or supplied in accordance with any law for the time being in force;

(g) the reading or recitation in public of reasonable extracts from a published literacy or dramatic work;

(h) the publication in a collection, mainly composed of non-copyright matter, bona fide intended for instruction use, and so described in the title and in any advertisement issued by or on behalf of the publisher, of short passages from published literary or dramatic works, not themselves published for such use in which copyright subsists:

Provided that not more than two such passages from works by the same author are published by the same publisher during any period of five years;

Explanation – In the case of a work of joint authorship, references in this clause to passages from works shall include references to passages from works by any one or more of the authors of those passages or by any one or more of those authors in collaboration with any other person;

(i) the reproduction of any work –

(i) by a teacher or a pupil in the course of instruction; or

(ii) as part of the question to be answered in an examination; or

(iii) in answers to such questions;

(j) the performance, in the course of the activities of an educational institution, of a literary, dramatic or musical work by the staff and students of the institution, or of a cinematograph film or a sound recording if the audience is limited to such staff and students, the parents and guardians of the

students and persons connected with the activities of the institution or the communication to such an audience of a cinematograph film or sound recording;

(k) the causing of a recording to be heard in public by utilising it –

(i) in an enclosed room or hall meant for the common use of residents in any residential premises (not being a hotel or similar commercial establishment) as part of the amenities provided exclusively or mainly for residents therein; or

(ii) as part of the activities of a club or similar organisation which is not established or conducted for profit;

(l) the performance of a literary, dramatic or musical work by an amateur, club or society, if the performance is given to a non-paying audience, or for the benefit of a religious institution;

(m) the reproduction in a newspaper, magazine or other periodical of an article on current economic, political, social or religious topics, unless the author of such article has expressly reserved to himself the right of such reproduction;

(n) the storing of a work in any medium by electronic means by a non-commercial public library, for preservation if the library already possesses a non-digital copy of the work;

(o) the making of not more than three copies of a book (including a pamphlet, sheet of music, map, chart or plan) by or under the direction of the person in charge of a non-commercial public library for the use of the library if such book is not available for sale in India;

(p) the reproduction, for the purpose of research or private study or with a view to publication, of an unpublished literary, dramatic or musical work kept in a library, museum or other institution to which the public has access:

Provided that where the identity of the author of any such work or, in the case of a work of joint authorship, of any of the authors is known to the library, museum or other institution, as the case may be, the provisions of this clause shall apply only if such reproduction is made at a time more than sixty years from the date of the death of the author or, in the case of a work of joint authorship, from the death of the author whose identity is known or, if the identity of more authors than one is known from the death of such of those authors who dies last;

(q) the reproduction or publication of –

(i) any matter which has been published in any Official Gazette except an Act of a Legislature;

(ii) any Act of a Legislature subject to the condition that such Act is reproduced or published together with any commentary thereon or any other original matter;

(iii) the report of any committee, commission, council, board or other like body appointed by the Government if such report has been laid on the Table of the Legislature, unless the reproduction or publication of such report is prohibited by the Government;

(iv) any judgment or order of a court, tribunal or other judicial authority, unless the reproduction or publication of such judgment or order is prohibited by the court, the tribunal or other judicial authority, as the case may be;

(r) the production or publication of a translation in any Indian language of an Act of a Legislature and of any rules or orders made thereunder –

(i) if no translation of such Act or rules or orders in that language has been previously been produced or published by the Government; or

(ii) where a translation of such Act or rules or orders in that language has been produced or published by the Government, if the translation is not available for sale to the public:

Provided that such translation contains a statement at a prominent place to the effect that the translation has not been authorised or accepted as authentic by the Government;

(s) the making or publishing of a painting, drawing, engraving or photograph of a work of architecture or the display of a work of architecture;

(t) the making or publishing of a painting, drawing, engraving or photograph of a sculpture, or other artistic work falling under sub-clause (iii) of clause (c) of section 2, if such work is permanently situate in a public place or any premises to which the public has access;

(u) the inclusion in a cinematograph film of –

(i) any artistic work permanently situate in a public place or any premises to which the public has access; or

(ii) any other artistic work, if such inclusion is only by way of background or is otherwise incidental to the principal matters represented in the film;

(v) the use by the author of an artistic work, where the author of such work is not the owner of the copyright therein, of any mould, cast, sketch, plan, model or study made by him for the purpose of the work:

Provided that he does not thereby repeat or imitate the main design of the work;

(w) the making of a three-dimensional object from a two-dimensional artistic work, such as a technical drawing, for the purposes of industrial application of any purely functional part of a useful

device;

(x) the reconstruction of a building or structure in accordance with the architectural drawings or plans by reference to which the building or structure was originally constructed:

Provided that the original construction was made with the consent or licence of the owner of the copyright in such drawings and plans;

(y) in relation to a literary, dramatic, artistic or musical work recorded or reproduced in any cinematograph film, the exhibition of such film after the expiration of the term of copyright therein:

Provided that the provisions of sub-clause (ii) of clause (a), sub-clause (i) of clause (b) and clauses (d), (f), (g), (m) and (p) shall not apply as respects any act unless that act is accompanied by an acknowledgment –

(i) identifying the work by its title or other description; and

(ii) unless the work is anonymous or the author of the work has previously agreed or required that no acknowledgment of his name should be made, also identifying the author;

(z) the making of an ephemeral recording, by a broadcasting organisation using its own facilities for its own broadcast by a broadcasting organisation of a work which it has the right to broadcast; and the retention of such recording for archival purposes on the ground of its exceptional documentary character;

(za) the performance of a literary, dramatic or musical work or the communication to the public of such work or of a sound recording in the course of any bona fide religious ceremony or an official ceremony held by the Central Government or the State Government or any local authority;

Explanation – For the purpose of this clause, religious ceremony includes a marriage procession and other social festivities associated with a marriage;

(zb) the adaption, reproduction, issue of copies or communication to the public of any work in any accessible format, by –

(i) any person to facilitate persons with disability to access to works including sharing with any person with disability of such accessible format for private or personal use, educational purpose or research; or

(ii) any organisation working for the benefit of the persons with disabilities in case the normal format prevents the enjoyment of such works by such persons:

Provided that the copies of the works in such accessible format are made available to the persons

with disabilities on a non-profit basis but to recover only the cost of production:

Provided further that the organisation shall ensure that the copies of works in such accessible format as used only by persons with disabilities and takes reasonable steps to prevent its entry into ordinary channels of business;

Explanation – For the purposes of this sub-clause, "any organisation" includes and organisation registered under section 12A of the Income-tax Act, 1961 (43 of 1961) and working for the benefit of persons with disability or reorganised under Chapter X of the Persons with Disabilities (Equal Opportunities, Protection or Rights and full Participation) Act, 1995 (1 of 1996) or receiving grants from the government for facilitating access to persons with disabilities or an educational institution or library or archives recognised by the Government;

(zc) the importation of copies of any literary or artistic work, such as labels, company logos or promotional or explanatory material, that is purely incidental to other goods or products being imported lawfully.

(2) The provisions of sub-section (1) shall apply to the doing of any act in relation to the translation of a literary, dramatic or musical work or the adaptation of a literary, dramatic, musical or artistic work as they apply in relation to the work itself."

9.3 Exhaustion

In India, parallel importation is governed by the principle of exhaustion of rights under Section 30(3) of the Trade Marks Act 1999.

Also, India follows the principle of international exhaustion, and the term "market" refers to the international market.

Doctrine of First Sale in India

India follows a variation of the copyright exhaustion doctrine known as the doctrine of first sale. This principle is enshrined in the Copyright Act 1957, with specific provisions and exceptions.

Application to physical copies

- *Control over subsequent sales:* Once a copyrighted work is lawfully sold or transferred, the copyright owner cannot prevent its resale, rental or further transfer. For example, if a book or music CD is sold by or with the authorisation of the copyright owner, the owner cannot later restrict its resale or redistribution.
- *Authorised sale exhausts rights:* If a copy of a copyrighted work is sold with authorisation, the copyright owner's right to control distribution of that specific copy is exhausted.

Treatment of digital content under the doctrine of first sale

The application of the doctrine of first sale to digital content presents unique challenges due to the nature of digital goods and licensing practices.

- *Traditional application:* The doctrine of first sale typically applies to tangible goods, such as physical books, DVDs or records.
- *Digital content limitations:* The Copyright Act 1957 does not extend the first-sale doctrine to digital content in the same way as physical copies. This means that even after a digital copy is sold or licensed, the copyright owner retains the right to control its distribution or resale.

Digital licensing models

- *Licensing over ownership:* Digital content, such as e-books, software, movies and music, is often provided under licensing agreements rather than outright sale. End-user licence agreements (EULAs) and terms of service commonly restrict resale, sharing or distribution of licensed digital content. For example, when purchasing an e-book or digital music, the buyer typically acquires a licence to use the content rather than ownership of the copyrighted material.
- *No exhaustion of rights:* Licensing agreements prevent the application of the first-sale doctrine to digital content. This ensures that copyright holders retain control over the subsequent distribution of digital goods.

Digital content resale limitations

- *No resale of digital goods:* Unlike physical copies, digital goods (eg, software, movies or music) cannot typically be resold due to restrictions imposed by licensing agreements and digital rights management (DRM) technologies.
- *Impact of DRM technologies:* DRM technologies enforce restrictions on the sharing, copying or transfer of digital content, making resale impractical and often illegal under licensing agreements.

- *Physical copies:* The doctrine of first sale applies to physical goods, allowing lawful resale or redistribution of copyrighted works after the first sale.
- *Digital content:* The doctrine of first sale does not extend to digital goods. Licensing agreements and DRM technologies ensure that copyright owners retain control over digital content, restricting resale or redistribution.

Summary

- *Physical copies:* The doctrine of first sale applies to physical goods, allowing lawful resale or redistribution of copyrighted works after the first sale.
- *Digital content:* The doctrine of first sale does not extend to digital goods. Licensing agreements and DRM technologies ensure that copyright owners retain control over digital content, restricting

resale or redistribution.

10. Remedies

10.1 Injunctive Remedies

Civil remedies can be pursued by bringing a complaint in a competent court for infringement or passing off. There are several types of civil remedy available, such as:

- a Mareva injunction (freezing injunction);
- an Anton Piller order;
- a John Doe order;
- a permanent or perpetual injunction;
- damages or accounts of profits; and
- delivery up and destruction.

Preliminary or temporary relief is available and is frequently requested in trade mark infringement lawsuits.

The Code of Civil Procedure (1908) makes it easier to file an application for an injunction prohibiting a defendant from using a mark that infringes on a claimant's rights, for example. A claimant must show:

- a prima facie case;
- irreparable harm and injury to its activities in order to obtain a preliminary or temporary injunction (goodwill, market share, etc) – the injury must be severe enough that monetary compensation from the defendant would not be enough to compensate the victim; and
- the balance of convenience dictates that issuing an injunction is more equitable than refusing to do so.

The following are defences available to those accused of infringement:

- delay and laches;
- acquiescence;
- honest and good-faith adoption and use;
- distinctions in products and services;
- the nature of the product;
- pricing; and
- the absence of confusion or deception.

Acquiescence may be considered a form of delay, although it has a more active element of knowledge of third-party rights coupled with delay.

10.2 Monetary Remedies

Various factors are used to evaluate and provide monetary remedies. In general, damages are granted in trade mark litigation in one of three ways, as detailed below:

- Actual/compensatory damages are based on the actual loss suffered/actual profits gained as a result of the infringement and must be proven by the claimant.
- Punitive damages, as defined under the Act, are issued in the form of fines. Where the court decides that the amount of compensatory damages awarded is not appropriate to the magnitude of the defendant's actions, punitive damages are issued. In such cases, the court awards such damages in addition to compensatory damages that have previously been calculated.
- Token/minor damages are awarded in the event that a dispute is resolved quickly.

10.3 Attorneys' Fees and Costs

Court expenses, length of arguments, duration of trial, use of senior lawyers, and other factors all affect costs. After a first-instance decision, litigation costs, including attorneys' fees, are recoverable. However, there is no guarantee that a party against whom an injunction is obtained will have to bear the expenses of litigation. The court has complete discretion over whether or not to award/impose costs of the proceedings.

Courts sometimes require parties to give an estimate of costs they intend to incur throughout trial and subsequent phases of the case, since costs play such an important role in defining the parties' strategy to litigation. This also makes determining the amount of fees to be paid easier for the court.

10.4 Ex Parte Relief

Even if a defendant has not been given prior notice of the suit or the claimant's grievance, a temporary ex parte injunction can be granted (Section 135(2), Trade Marks Act 1999).

Claimants obtain ex parte injunctions only in exceptional situations and not as a matter of right. The court must be convinced that the claimant's interests will be severely harmed if the request is denied. The behaviour of a claimant, on the other hand, is a key aspect in assessing whether or not an injunction can be granted. Temporary injunctions are likely to be denied if the claimant takes too long to allege a violation of its rights.

10.5 Customs Seizures of Counterfeits or Parallel Imports

In accordance with the TRIPS Agreement, India has established the Intellectual Property Rights (Imported Goods) Enforcement Rules 2007, which authorise customs officers to enforce IP rights over imported goods. Customs officers can enforce IP rights over imported goods under these Rules. The Rules provide a step-by-step process for rights-holders to register their IP with customs officials. This registration imposes an administrative duty on customs to protect the rights-holders against violation of their IP rights.

Rights-holders can also seek remedies aimed at preventing unlawful product imports and exports. The Customs Act 1962 recognises the government's authority to prohibit the import and/or export of products in order to preserve rights protected by the Trade Marks Act 1999.

11. Appeal

11.1 Appellate Procedure

Filing an Appeal

An appeal can be filed by any person aggrieved by the decision or order of the Registrar of Trade Marks, which may include the applicant, owner or any other interested party.

The appeal must be filed within three months from the date on which the aggrieved person received the decision or order of the Registrar.

Grounds for Appeal

Appeals may be filed on various grounds, such as:

- errors of law or procedural violations;
- incorrect application of facts;
- abuse of discretion by the Registrar; or
- insufficient evidence to support the decision or order.

Jurisdiction

The appropriate forum for filing the appeal is the High Court that has jurisdiction.

The High Court has the authority to hear appeals related to trade mark matters, including those concerning the decisions or orders passed by the Registrar.

11.2 Timeframes for Appealing Trial Court Decisions

Appeal from trial court: An appeal can be taken to an appellate court if there are grounds such as errors of law, facts or procedure. The time within which to file an appeal is generally 90 days (or three months for trade mark appeals), but can be extended in some cases.

Time to decide an appeal: The time for an appellate court to decide an appeal varies. In general, it can take anywhere from six months to two years, depending on the complexity of the case and the workload of the court.

12. Additional Considerations

12.1 Emerging Issues

AI and Trade Mark Law in India

In a significant move to modernise the trade mark registration process, the Trade Marks Registry has introduced an artificial intelligence (AI) and machine learning-based trade mark search facility. Launched by the Union Minister of Commerce and Industry, this technology aims to enhance the efficiency and accuracy of trade mark searches.

AI and Copyright Law in India

As AI continues to permeate numerous sectors, India's approach to integrating AI within its trade mark and copyright laws is evolving. While a comprehensive statutory framework specifically addressing AI-generated works is yet to be established, recent developments indicate a proactive stance in adapting existing IP laws to encompass AI-related challenges. In this regard, the Parliamentary Standing Committee ("Committee"), in its Report No. 161 titled "Review of the Intellectual Property Rights Regime in India", recommended review of the Copyright Act 1957 to expand to scope of authorship in AI-generated works.

Emerging legal considerations

Indian courtrooms (in particular, the Delhi High Court and the Bombay High Court) have so far witnessed four major IP cases involving infringement of IP rights through the use of GenAI tools. These are:

1. *Anil Kapoor v Simply Life India*; 2023 SCC OnLine Del 6914

This case was filed by the celebrated actor Mr Anil Kapoor for protection of his personality rights against misuse of his image and likeness in various Deepfake videos as well as by users of AI tools,

such as 'Midjourney', to generate images of the actor. The Delhi High Court by way of its order dated 20 September 2024, restrained such illegal and unauthorised use of AI to produce or imitate Mr Kapoor's persona (image, voice, likeness, etc.). Mr Anil Kapoor also subsequently featured in *Time*'s '100 Most Influential People in AI'.

2. *Jaikishan Kakubhai Saraf (Jackie Shroff) v Peppy Store*, 2024 SCC Online Del 3664

This case involved infringement of eminent actor Mr Jackie Shroff's personality rights by, inter alia, an unlicensed chatbot, which provided responses to users' chats in the actor's iconic and inimitable mannerism and style. The Court observed that such use amounts to a violation of the actor's personality rights and restrained such misuse.

3. *Arijit Singh v Codible Ventures LLP*, 2024 SCC Online Bom 2445

This case, filed before the Bombay High Court, involved infringement of the well-known singer Mr Arijit Singh's personality rights, mainly by the misuse of the singer's voice, vocal style and vocal arrangements by various users of certain AI tools to generate artificial sound recordings of the singer's voice. The Court restrained such infringement of the plaintiff's personality rights and directed immediate deletion/removal of videos featuring infringing content.

4. *ANI Media v Open AI Inc.*, Order dated 19 November 2024 in CS (COMM) No. 1028/2024

This case filed in India follows other suits filed against OpenAI in the US, Canada and Germany alleging infringement of copyrighted works by storage/use of the same by OpenAI as training data for its chatbot ChatGPT. It involves key legal issues including whether such use would qualify as 'fair use' under Indian copyright law. Though OpenAI has taken the defence that content owners are free to 'opt out' from the use of their content as training data, the interesting issue would be whether this would be fair. It is the early unrestricted access to data, including copyrighted data, which has made ChatGPT "intelligent", leading it to build capabilities which would allow for future training even if access to training data is now limited.

While in the first three cases, infringement was evident in the 'output' of the AI tools, this last case highlights infringement by way of the 'input' used by the AI tool, by way of its training data.

12.2 Trade Mark and Copyright Use on the Internet

The Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules 2021 regulate online intermediaries. The Rules stem from the Information Technology Act 2000.

Online intermediaries are granted safe harbour protection under Section 79 of the Act if they comply with specific obligations and due diligence requirements set forth in the Rules. If these Rules are violated, or if the intermediaries choose to act in defiance of a court or government order, they lose

their safe harbour protection and become liable, along with the true source of the infringing content.

The Guidelines mandate that all intermediaries exercise due diligence, which includes due diligence in the event of a trade mark or proprietary rights infringement. Further, where a claim of infringement is brought to an online intermediary's knowledge, the Rules require the intermediary to remove any restricted/infringing content within 36 hours of obtaining actual knowledge of its existence.

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