Intellectual Property Strategies for India

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Intellectual property strategies are long-term plans for successfully using your intellectual property and their protection, enforcement and commercialization to grow and strengthen your business.

Strategies are dynamic. They are partly planned and partly unplanned. Sometimes they are open and sometimes confidential. For instance, take trademarks. Some are regional, some national and yet others, international. Strategies for each differ and have to be carefully understood and applied with the help of experienced experts.

This article will attempt to list some strategies for trademarks and patents – for their protection, enforcement and dispute resolution. This is of course not an exhaustive list nor is it applicable to all factual situations but those that seem to be working well in the Indian context.

General Strategies

1. To protect your intellectual property, engage a well-reputed IP lawyer or a firm after doing a thorough conflict check.
2. Make a list of all your intellectual property, be it trademarks, patents, designs or copyrights, and understand how well they are protected.
3. Identify any trade secrets before they are stolen, as experience shows that most companies start to define their confidential know-how after it has been purloined.
4. Other than civil and criminal litigation, try alternate dispute resolution, such as arbitration and mediation. Pre-litigation mediation has been highly successful before the Delhi High Court Arbitration and Mediation Centre, particularly on cases involving confidential information or relationships.
5. Avoid cease and desist notices, which appear quite cost-attractive but can backfire. Defendants can file actions for groundless threats or declaration of non-infringement in an undesirable jurisdiction, changing the future cause of litigation. They are also forewarned, so an Anton Piller order would fail. They may file caveats to avoid *ex parte* injunctions or even cook-up documents.
6. During the pandemic, virtual courts became very popular. They save travel time; clients can

attend and you can appear in most cities or courts from your home.

7. Evidence can be led in virtual hearings, and this is particularly useful even in normal times with the witnesses cannot travel to the courthouse.
8. Evidence recordal has become quite liberal, as it can be done over weekends, without the formal court file and even in business centres of comfortable hotels. However, virtual court has focused on the need for lawyers to coordinate better as they do not have the benefit of communicating with each other during court hearings.
9. When embarking on a lawsuit or campaign, get a power of attorney in favour of a local representative who may even be an external lawyer, investigator or a trusted person to save filing time, or else papers may have to move from one country to another. Scanned documents and digital signatures are now permitted, but at some stage originals are still required.
10. It is critical to coordinate litigation if multiple jurisdictions, i.e. countries, are involved, so admissions made in one country do not go against you in another.
11. Check the prosecution histories of trademarks and patents. Often statements made before another fora in another context come to bite you later.
12. If the defendant's goods are to be seized through an Anton Piller order, then it is useful to get a pre-raid check done.
13. At a raid if there is any resistance, do not fight, but simply get everything recorded by the local commissioner. A contempt petition in court will put huge pressure on the defendants, possibly forcing a good settlement sum out of them.
14. Always explore John Doe orders so as to cover parties discovered during the raid.
15. When going to court, disclose everything relevant. Suppression is a big reason for judges vacating orders.
16. Avoid delaying the institution of a lawsuit and never write emails that seem to condone, pardon or encourage the defendant's infringing behaviour. Acquiescence can defeat even a permanent injunction.
17. If a case settles early, you can get your full court fees refunded.
18. As a defendant, file caveats so you receive advance notice of a lawsuit and can avoid an *ex parte* order.

Trademarks

19. While selecting a trademark, do keep in mind that the descending order of distinctive words is invented, arbitrary, suggestive, descriptive and, lastly, generic. Concentrate on the first three, which will provide the strongest legal protection.
20. Always search in relevant classes and include cognate and allied goods and services. Thereafter, determine conflicts and adopt the best strategy to overcome those, i.e., by seeking consent, co-existence, buy-out, etc.
21. Your searches should cover (1) the trademark office; (2) the Registrar of Companies; (3) the

internet; and (4) a physical market investigation.

22. Protect your trademark in key markets. Trademarks are territorial, so countries that follow the first-to-file principle should be considered in priority. Also consider national filing versus filing through the Madrid Protocol. Cover goods keeping future expansion in mind.
23. Some good practices that owners have found useful are:

- To promote the trademark so that the general public and consumers are aware of the same.
- Marks should be distinguished from their surrounding text; and
- Avoiding lower case and using them as nouns or verbs.

For Enforcement

24. For collecting evidence of use and reputation, download documents from the internet which can be admitted in evidence along with an affidavit under Section 65B of the Evidence Act.

25. Check if the trademark is declared well-known in India or elsewhere. This helps in proving international renown. Look up old magazines for advertisements and get coloured glossy pictures to make the record look attractive for a judge. It increases the credibility of the mark.

26. Record your trademark under the IP Customs Rules and get your domain name registered. Be active in enforcing your trademark.

Patents

Strategies for the expeditious grant of patents

1. To expedite and accelerate the grant of patents, major changes have been introduced in the patent system in India. Apart from the government's concerted efforts in this regard, a patent applicant can expedite the process by resorting to the following strategies:

Pre-filing strategy

1. File proof of right and/or assignment along with priority documents.
2. File verified English translations of documents, especially in the case of a PCT specification.
3. File details of corresponding patent applications.

Post-filing Strategy

4. File a request for early examination under Section 11(a)(2) as early as possible, in order to be in the front of the queue for examination as patent applications are examined *in seriatim*.
5. Amend claims prior to filing a request for examination while keeping in mind the fact that the claims have to pass muster of Sections 3 and 4 of the Patents Act.
6. Amend claims to be in consonance with claims as granted in other jurisdictions such as Europe and the United States, while adhering to Sections 57 and 59 of the Patents Act.
7. Under Rule 24 (c), the applicant can request for expeditious examination if it fulfils any of the following criteria:

- Applicant has elected India as an International Searching Authority (ISA) or as an International Preliminary Examining Authority (IPEA) in a corresponding PCT Application; or,
- Applicant is a start-up as defined under Rule 2 (fb) of the Patent Rules, 2003; or,
- Applicant is a small entity as defined in Rule 2 (fa) of the Patent Rules, 2003; or,
- Where all applicants are natural persons and at least one of the applicants is female; or,
- Applicant is a government undertaking in accordance with Section 2(1)(h) of the Patent Act, 1970; or,
- Applicant is eligible to avail a Patent Prosecution Highway facility in India.

8. As regards divisional applications, one should keep in mind, the three thumb rules:

- Claims of the divisional and parent should relate to same inventive concept.
- The claims of both the parent and divisional should be separate.
- One should file the divisional as soon as the response to the First Examination Report is filed.

9. In addition to the above, for litigation relating to patents:

- It is most useful to tell the inventor's story through evidence of the inventor – the challenges faced, the choices made and the surprising results obtained.
- A quick *quia timet* action helps where the launch of an infringing product is shortly expected.
- A due diligence should include checking for Section 8 compliance; Form-27 working statements; recordal of assignments; renewals; etc. Always obtain a certified copy of the complete specification for granted claims may differ from applied claims.
- Scientific advisors are not a successful experience in India. It is best for parties to have their own experts.
- The patent can be amended even during an infringement action and this is a very useful provision particularly when the defendants produce some unknown prior art attacking the plaintiff's validity.
- Use PowerPoint presentations, animations and infographics to illustrate the invention or at least some basic concepts from the relevant field of technology.
- In SEP patent cases, Confidentiality Clubs were quite commonly used till recently when a decision

in *InterDigital v.. Xiaomi* declined limiting access to the defendant's external lawyers and experts. The decision is under appeal but in the meantime, parties will try to rely on redacted copies of documents or adopt alternative approaches to prove FRAND rates.

RELATED INDUSTRIES

BRAND STRATEGY

RELATED PRACTICES

PATENTS