

INTELLECTUAL PROPERTY PRACTICE GROUP

*Taking definitive steps to
protect your IDEAS*

PATENTS

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DESIGNS

ABOUT US

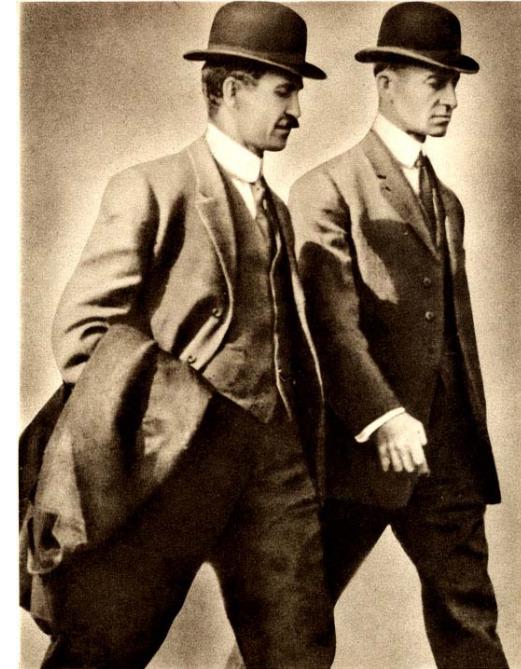
King Stubb & Kasiva has been a key player in the Indian intellectual property arena since the last decade. With the globalization of the economy and the change in the global scenario, Indian Intellectual Property Rights (IPR) legislations have witnessed a revolutionary change. India as a country is moving towards effective harmonization of its IPR laws with other competitive countries. King Stubb & Kasiva has been a very active participant in this change and has created a practice that is unmatched in terms of client satisfaction, professionalism, quick turn around, customization, quality and cost.

We are leading creative and result oriented IPR practice in India. Our IP Group is constantly rated in the top tier for its innovative and result oriented solutions. The core strength of our firm is its understanding of the cultural diversity in India and the challenges that it brings along with it to the IP holders with respect to protecting and enforcing their rights. Over the years, the IP Group of our firm

comprising of Patent and Trade Mark Attorneys, Agents, IP Investigators, Enforcement specialists and Consultants by virtue of an excellent working relationship with the Indian Patent and Trademark Office, Examiners and other IP practitioners has been able to synthesis its footage both in the National as well as the International market.

We provide comprehensive IP related services ranging from prosecution, litigation to consultation services in the areas of patents, trademarks, copyrights, designs, geographical indications, unfair trade practices, trade secrets, licensing and assignment. The vision behind the portfolio of IPR services provided by our IP Group has always been client centric. At our firm, we visualize commercially viable solutions for our clients. Our long-standing clients include many of the world's foremost IP owners. Our clients appreciate and benefit from our ability to provide real world solutions to the legal problems.

We are determined to foster long-term relationships with our clients and provide them with cost efficient business success. In this era of competition, innovation and cutting edge technology, We envisions maintaining the quality of its services for our clients as quality cannot be compromised.



“Orville Wright took the Flyer for a 12-second, sustained flight on December 17, 1903. This was the first successful, powered, piloted flight in history. Their deep conviction and enormous courage, amidst great skepticism, inspires us to greater heights.”

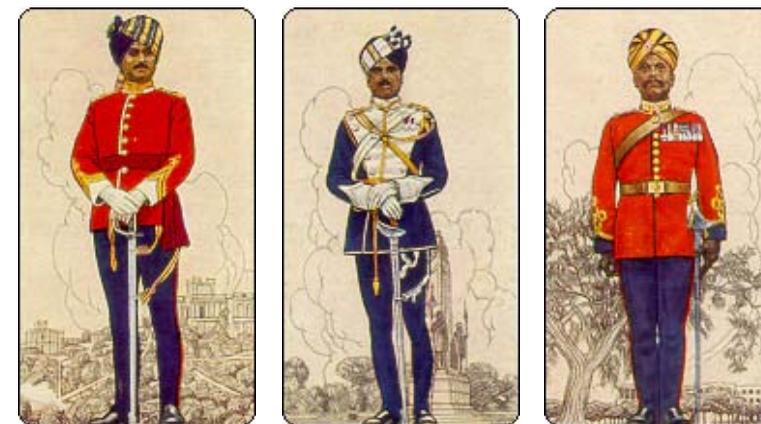
TRADEMARK PRACTICE IN INDIA

Any person claiming to be using a trademark to identify their goods and services and distinguishing them from those of the other players of similar goods or services in the same market are entitled to obtain registration by filing a request in the prescribed manner and paying the requisite fee.

The Trademark Act, 1999 ("TM Act") is the governing law for trade marks in India. India is a member of the Paris Convention for the Protection of Industrial Property ("Paris Convention") thereby allowing applicants to claim priority of up to 6 months as per the convention. India follows the International Classification for identifying goods and services as recognized under the Nice Agreement which consist of 42 classes. All trade mark prosecutions are conducted at the office of Registrar of Trade Marks ("Registrar"). India has decentralized the prosecution process and the marks are now prosecuted by Registrars at five cities namely, New Delhi, Mumbai, Ahmedabad, Chennai and Kolkata. The Registrars in these cities have jurisdictions over certain states.

Application

Indian trade mark law provides for trade mark applications to be filed either in one class or in multiple classes. Once an application for registration of a trade mark is filed with the Registrar, an application number and date of filing is issued. Subsequently, the mark is examined as to its registrability. Upon examination, if there is any objection raised with respect to registration of the trademark, in light of a registered or pending registration or provisions of Indian trade mark law, an examination report ("Office Action") is sent to the applicant. Once the Office Action is issued, the applicant or his representative, within one-month from the date of receipt of the Office Action, has to reply in writing to the Office Action. In case the response to the Office Action is rejected, the applicant can file a request for the review of the said order of the Registrar. If the application is again rejected, the applicant can file an appeal before the Intellectual Property Appellate Board ("Appellate Board"). Writ jurisdiction can be raised against the decision of the Appellate Board. On the other hand, upon examination if no objection is raised then Registrar may accept the application to proceed for publication in the Trademarks Journal.



In the 16th century English traders made their appearance on the Indian coast. These traders used a trademark or "Nishan" for the purpose of trade and the same was borne by the company troops on their flags. Captain James's "Military Costumes of India" includes a flag with the merchant's trademark. In the earliest phase of the Company's rule in India, the troops were organised in three presidential armies, those of Bengal, Madras and Bombay. The scheme of colours carried by these armies followed the British pattern. be applied to goods or services for which it is registered.

Opposition:

Once the mark is published in the Trademark Journal, any person may within 3 months from the date of publication file a notice of opposition to the registration of the trademark. However, in certain cases, an extension of 1 month over and above the 3 months is allowed to the opposing party.

Registration and Validity:

In absence of any opposition, a certificate of registration is issued to the applicant. In case of an opposition, the Registrar after hearing both sides decides as to its registrability. Review to the decision of the Registrar may be filed by either party within one month from the date of such decision. Within 3 months from the date of Registrar's decision an appeal may be made to the Appellate Board.

The validity for a trademark is for a period of 10 years from the date of filing of the application and is subject to renewal for a further period of 10 years. For trademarks that are registered before September 15, 2003, remain valid according to the old law (7 years) and would be renewed for 10 years.

In case of applications filed before this date and registered on or after this date, the validity period is 10 years.

Renewal:

In order to maintain the mark in the register, it is imperative that it should be renewed within the prescribed time limit. An application for renewal of the mark should be made within 6 months before expiration or the mark may be renewed by paying surcharge within 6 months after the expiry date. In case the mark is removed from the register an application for restoration and renewal can be filed within one year from the date of the expiration of the registered trademark. A fresh application for registration of the mark is to be filed if no action is taken within the said one year period. However, the rights of the proprietor are protected for a period of one year after the date of said removal against third party's claim to registration.



From earliest times, humans have used marks to designate ownership, sometimes as property owner or sometimes as manufacturer. It is considered probable that primitive humans used marks to indicate the ownership of livestock. Later marks were used to indicate the maker of goods and their obligation to the quality of their work. This use of marks was at its height in the Roman Empire.

Assignment:

Assignment of trademarks is recognized under the Indian law. An assignment of the trademark can be recorded either at the time when the mark is pending registration or when it has been registered. In case of a registered mark, an assignment can be enforced only once it has been entered in the register.

Assignment can be made in respect of either all goods or services in respect of which the trademark is registered, or of some of those goods or services. If the assignment of the trademark is without transfer of goodwill of business, it has to be registered with the Trademarks Registry within 6 months from signing of the assignment deed; otherwise, the assignment shall not take effect.

Cancellation:

A plea for cancellation of a mark is allowed after registration of the mark. The said plea for cancellation of the trademark on the grounds that the trademark is invalid is to be prosecuted before the Appellate Board.

A registration is vulnerable to cancellation on submission of an application by any aggrieved person, if the trademark has not actually been used during the 5 years immediately preceding the application for cancellation, or that the trademark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him, and in fact there has been no bona fide use of the trademark in relation to those goods or services up to a date 3 months before the date of the application for cancellation.

Infringement:

The owner of a trade mark has both civil as well as criminal remedies, that are available to him, against the infringer. However, no criminal remedy is available, if the trade mark is not registered in India.



The Lion capital of Ashoka is a sculpture of four "Indian lions" standing back to back. It was originally placed atop the Aśoka pillar at Sarnath, now in the state of Uttar Pradesh, India. The pillar, sometimes called the Aśoka Column is still in its original location, but the Lion Capital is now in the Sarnath Museum. This Lion Capital of Ashoka from Sarnath has been adopted as the National Emblem of India and the wheel "Ashoka Chakra" from its base was placed onto the center of the National Flag of India..

PATENT LAW PRACTICE

The current law for patents in India is the Patents Act, 1970 and Patents Rules, 1972, which came into force on April 20, 1972. This Act was amended from time to time to comply with various commitments under the Agreement on TRIPS. India is also signatory to both the Paris Convention as well as the Patent Cooperation Treaty ("PCT").

Under the Paris Convention, an application should be filed in India within 12 months from the date of the basic application filed in the home country of the applicant.

Under the PCT, an international application can enter the Indian national phase within 31 months from the earliest priority date.

Once an application along with the "basic requirements" is submitted to the appropriate Patent Offices, the office that receives the application will accord an Indian National Phase Application Number.

Following are the basic requirements for entry into National Phase in India: (i) Application setting out the title of the invention and names; address of the inventors; (ii) complete specification with claims, drawings and abstract; (iii) prescribed fee; (iv) translation of international application if the application is not filed in English; and (v) international application or translation thereof.

Once the national processing has started, the following documents may be furnished; (i) Instruments or assignment or transfer where the applicant is not the inventor; (ii) declarations of inventorship by the applicant; (iii) statement regarding corresponding applications in other countries; (iv) power of attorney to agent; (v) verification of translation; (vi) copy of priority document (if not already filed with International Bureau); (vii) International search report (if received); and (viii) International preliminary examination report.

"ON February 28, 1856, the Government of India promulgated legislation to grant what was then termed as "exclusive privileges for the encouragement of inventions of new manufactures".



On March 3, 1856, a civil engineer, George Alfred DePenning of 7, Grant's Lane, Calcutta petitioned the Government of India for grant of exclusive privileges for his invention — "An Efficient Punkah Pulling Machine". On September 2 DePenning, submitted the Specifications for his invention along with drawings to illustrate its working. These were accepted and the invention was granted the first ever Intellectual Property protection in India"

At the time of national phase entry, it is possible to make amendments to the International Application, but such amendments cannot go beyond the disclosure in the original Application. No extraneous or new matter may be added.

Publication:

An applicant can request for early publication. However, generally all applications are to be published after 18 months of the priority date or filing date of the application, whichever is earlier. In case of national phase applications under the PCT, as 18 months from the priority date is generally over, they are published immediately after filing.

Examination:

A request for examination has to be filed within 48 months from the date of priority. Patent applications are examined in the order of filing request for examination with respect to compliance with the formalities and patentability requirements. Novelty is one of such requirements. Novelty is not limited only to India. A novelty examination includes any patents already granted in the home country,

any specifications already in records and any other materials that the Examiner may take into consideration.

The applicant is bound to remove all the objections within a maximum period of 12 months from the date of the First Examination Report (“FER”). There is no provision that provides for any extension of time to respond to the FER. Once an application has been accepted, patent is granted and it is published in the Official Journal of the Patent Office.

Opposition:

There are provisions for both pre-grant and post-grant opposition. Once an application is advertised in the Gazette of India, any interested person may oppose it within a period of 4 months from the date of advertisement by filing a notice of opposition. In case of pre-grant opposition, after publication but before grant, any person can file a representation to the Controller of Patents (“Controller”) an opposition on the ground of patentability including novelty, inventive step and industrial applicability or non-disclosure or wrongful mentioning of source and geographical origin or biological material used in the invention in complete specification, and anticipation of invention by the knowledge, oral or otherwise.



Sushruta was a surgeon and teacher of Ayurveda who flourished in the Indian city of Kashi by the 6th century BC. The medical treatise Sushruta Samhita—compiled in Vedic Sanskrit—is attributed to him. The Sushruta Samhita contains multiple detailed references to diseases and medical procedures

Post grant opposition is elaborate. Any interested party may within one year from the date of publication of the grant of the patent file a Notice of Opposition. In addition to the pre-grant grounds there are some other grounds that form part of post-grant grounds in India. Post-grant opposition may be on grounds of prior use in India, insufficient explanation of the invention or the methods of manufacture, application in India after the prescribed period for claiming priority, etc. The Controller after materials being furnished by both the parties decides the matter.

Sealing, Grant and Validity:

When the period for Opposition has expired or where the Opposition is decided in favor of the Applicant, the Patent will be granted and sealed upon payment of prescribed fee. The Patent sealed will be entered in the Register of Patents. The patent is valid for 20 years from the date of filing the application. In case of national phase applications under the PCT, international application date is treated as the date of the application.

Though convention applications get priority under the Paris Convention, for such applications, the 20 year period commences from the date of application in India.

Revocation of Patents:

Apart from Opposition, the Patent may be attacked during its lifetime by initiating revocation proceedings. The reason for this provision is that the public must be given an opportunity to challenge the validity of a patent if it does not fulfill the conditions laid down under the Act and the Rules.

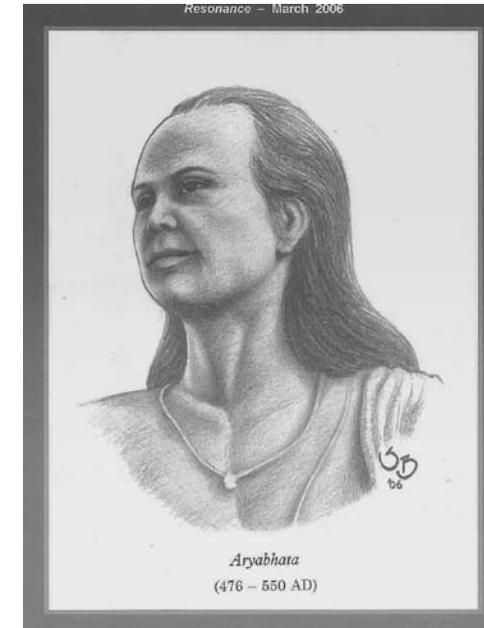
Assignment/Licensing:

The patent once issued remains valid subject to the payment of the prescribed annuity (annual fees). The Patent law in India recognizes that the right to a patent may be assigned, licensed or transferred through succession. The assignment of patent application or issued patents must always be made in writing.

Working of patents is an official requirement in India. The patent will be subject to compulsory licensing under the provisions of the law in case the owner or the licensee(s) of a patented invention fails to satisfy the stipulated working requirements of the country within 3 years as of the date of grant.

Infringement:

In a suit for infringement, a court may grant an injunction and damages or an account of profits. The rights conferred by a patent on the registered patentee expire on the lapse of the protection period as prescribed by the law, lawful assignment or the patent rights, final court decision to this effect or non payment of the annuity fees.



Aryabhata is the author of several treatises on mathematics and astronomy, some of which are lost. His major work, Aryabhatiya, a compendium of mathematics and astronomy, was extensively referred to in the Indian mathematical literature, and has survived to modern times. The number place-value system, first seen in the 3rd century Bakhshali Manuscript was clearly in place in his work.

COPYRIGHT PRACTICE IN INDIA

Indian Copyright law, which is TRIPS compliant, is one of the best in the world. Copyright Act of 1957 (“Copyright Act”) provides for copyright protection in India and is amended from time to time. India is a signatory to the Universal Copyright Convention (U.C.C.) & Berne Copyright Conventions. By virtue of India ratifying the Conventions, “foreign works” first published in a country which is member of U.C.C or the Berne Convention is accorded validity in India.

Registration and Validity

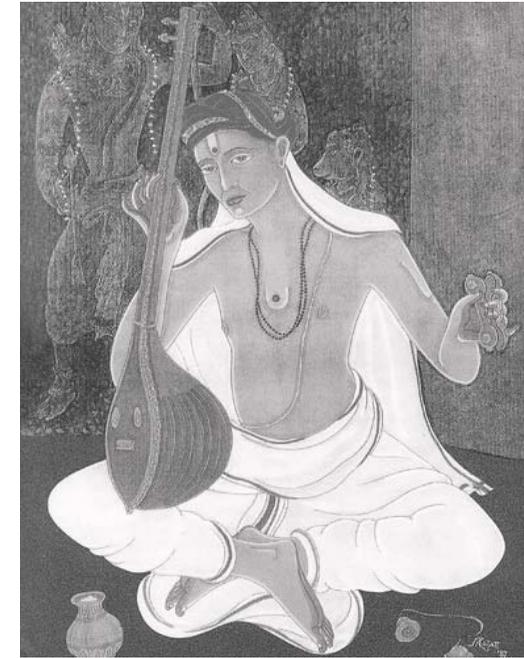
Under Indian copyright law, registration is not a pre-requisite either for acquiring copyright or for enforcing it in an infringement action, provided the subject matter is in some permanent form. However, the benefits granted to such foreign works cannot exceed the protection available under Copyright Act, and the term cannot exceed that fixed in the country of origin of the work.

To obtain copyright registration under the Copyright Act, an application is required to be made to the Copyright Registry (“Registry”) in the prescribed form. Four copies of the work need to be submitted to the Registry. An application for the registration of an artistic work is required to be accompanied by a certificate from the Registrar to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered or applied for registration under the TM Act in the name of another person.

The copyright protection under Indian law extends to the life of the author plus sixty years. The exception to the set term of sixty years is the performer’s and broadcaster’s rights which are fifty and twenty five years respectively, calculated from the calendar year in which the performance or broadcast, as the case may be, took place.

Infringement:

Infringement of copyright is both a civil and criminal offence. A copyright owner can seek remedies from the court.



Tyagaraja was a composer of Carnatic music, who along with his contemporaries Muttusvami Dikshitar and Syama Sastri forms the Trinity of Carnatic music composers. He was a prolific artist and highly influential in the development of the South Indian classical music tradition. Tyagaraja composed hundreds of devotional songs, most of them in praise of the Hindu god Rama. His compositions are very popular even today. Five of his compositions called the 'five gems' (Pancharatna Krithis), are often sung in programs in honour of Tyagaraja.

DESIGN PRACTICE IN INDIA

Designs in India are protected by the Indian Designs Act, 2000 (“Design Act”) and the Indian Designs Rules, 2001 (“Design Rules”).

Registration:

An application for registration of a design may be made by any person claiming to be proprietor for any new or original design not published earlier anywhere in the world. A brief statement of novelty is included in the application. The application is accompanied by four sets of clear representations of the design.

Indian law recognizes the first-to-file rule for registration of design i.e., if two or more applications relating to an identical or a similar design are filed on different dates only first application will be considered for registration of designs. As per the Paris Convention, an applicant can claim priority of up to 6 months in India.

The classification of the goods has been mentioned in the third Schedule of

Design Rules. The classification is based on Locarno Agreement.

It is mandatory as per the Design Rules that only one class number is mentioned in one particular application. This classification has to be made on the basis of Articles on which the design is applied.

Once a design application is filed, the examiner reviews the application for novelty and other legal requirements. A certificate of registration is issued in respect of a design application accepted by the Controller of Design (“COD”) and published in the Official Gazette.

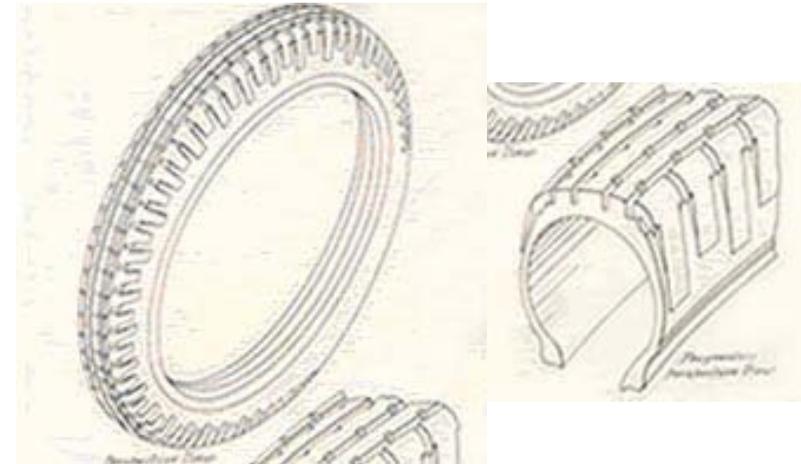
Copyright protection in a Design:

When the design is registered, the registered proprietor shall have a copyright in the design for an initial period of 10 years starting from the date of registration subject to an extension for a period of a second period of 5 years. A registered design, a copyright of which has expired cannot be re-registered.

Cancellation of a Design:

Once registration for the design is granted any person interested may present a petition to the COD for cancellation of the registration of the design on the grounds that:

Amongst the most prolific of the early applicants for registration of a design was "The Dunlop Rubber Co. Ltd. Fort Dunlop, Erdingham, Birmingham " - who filed 45 of the first 100 designs registered



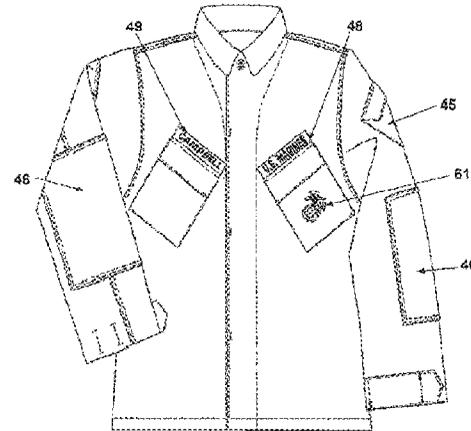
According to the pneumatic tyre lore in 1845 one R W Thompson filed a patent specification describing the application of a hollow inflatable tube to the periphery of a road wheel. The idea was abandoned as it didn't rouse interest! 43 years later J B Dunlop a vet in Belfast reinvented the pneumatic tyre.

(i) the design has been previously registered in India; or (ii) it has been published in India or any other country prior to the date of registration; or (iii) the design is not new or original; (iv) the design is not registrable under the Design Act and (v) the design is not a design as defined under the Designs Act.

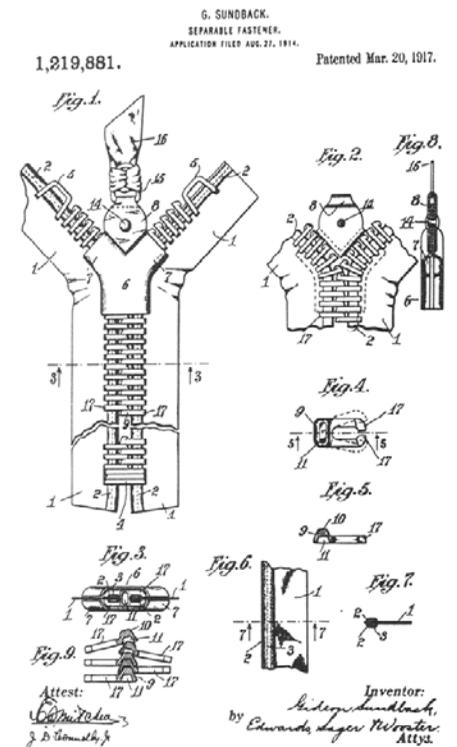
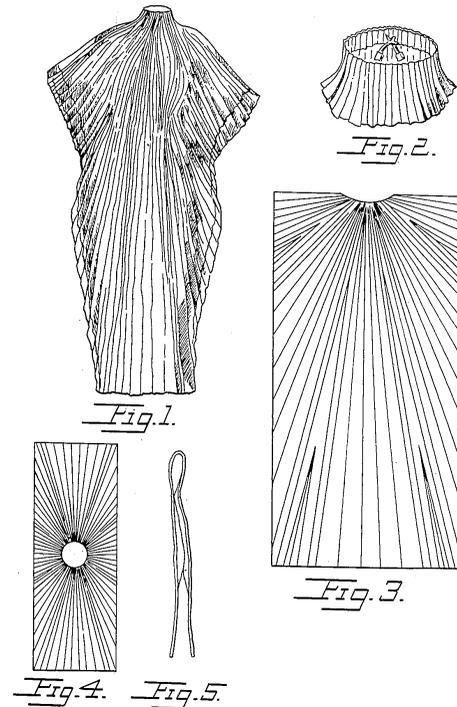
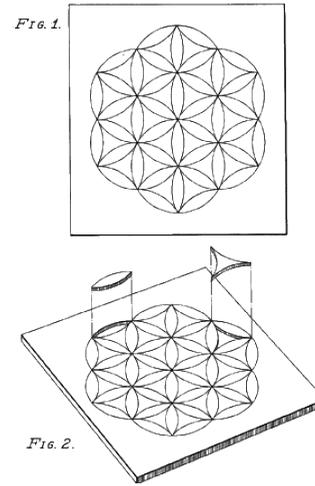
An appeal against the order of the COD will lie to the High Court within three months from the date of the order passed by the COD.

Infringement of Copyright in a Design:

Piracy of a registered design is a civil offence and the proprietor can claim damages in addition to seeking injunction. The registered proprietor of the design may bring an action for infringement of the design in the jurisdiction of the High Court where the infringement has taken place.



1938,009
JIG SAW PUZZLE
 Robert G. Mate, 3024 Davidson Ave.,
 San Bernardino, Calif.
 Filed June 23, 1958, Ser. No. 61,470
 Term of patent 14 years
 (Cl. D34-5)



The object of the Design law is to encourage and protect those who produce new and original designs, also to increase industrial development and competitive process. In England, the first legal protection came in 1787 for textile designs. In India in 1872 the Patents and Designs Protection Act became operative which was amended in 1888 followed by 1911 and now in 2000

TRADE MARK SERVICES

- ✓ Prosecution
- ✓ Enforcement
- ✓ Litigation
- ✓ Counseling
- ✓ Due Diligence
- ✓ Export and Import Controls
- ✓ Licensing
- ✓ Opinions
- ✓ Unfair Competition
- ✓ Transactions
- ✓ Internet and Domain Name Disputes
- ✓ Portfolio Management
- ✓ International
- ✓ Audit

PATENT SERVICES

- ✓ Prosecution
- ✓ Enforcement
- ✓ Litigation
- ✓ Transactions
- ✓ Drafting
- ✓ Opinions
- ✓ Due Diligence
- ✓ Counseling
- ✓ International
- ✓ Audit
- ✓ Licensing

COPYRIGHT SERVICES

- ✓ Prosecution
- ✓ Litigation
- ✓ Licensing
- ✓ Counseling
- ✓ Software Protection
- ✓ Transactions
- ✓ Audit
- ✓ Fair Use
- ✓ Broadcasting
- ✓ Content

DESIGN SERVICES

- ✓ Prosecution
- ✓ Litigation
- ✓ Counseling
- ✓ Transactions

CONTEMPORARY IP PRACTICE

- ✓ Trade secrets
- ✓ Customs registration
- ✓ Entertainment Advertisement
- ✓ IP in financial transactions
- ✓ Watch services
- ✓ IP in Corporate law

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