

INDIA IP SME HELPDESK

FACTSHEET

1. IP framework for SMEs in India: BACKGROUND

- A. Intellectual Property Rights for SMEs: Why is this RELEVANT to you?
- B. Indian IP framework in comparison to INTERNATIONAL STANDARDS

2. IP Rights in India: THE BASICS

- A. Overview of the “Indian Intellectual Property Office”
- B. Copyright
- C. Patents
- D. Industrial Design
- E. Trade marks
- F. Geographical Indications (GIs)
- G. Trade Secrets

3. ENFORCEMENT of rights

- A. Civil Litigation
- B. Criminal litigation
- C. Using CUSTOMS to block counterfeits

4. RELATED LINKS and additional information

INDIA IP COUNTRY FACTSHEET



1. IP framework for SMEs in India: BACKGROUND

A. Intellectual Property Rights for SMEs: Why is this RELEVANT to you?

Intellectual Property (IP) can be a valuable business asset for SMEs. IP rights do not only legally protect inventions by the SMEs from potential infringers, but thereby also foster their market positioning, increase their competitiveness and improve their overall financial viability. EU businesses consider IPR infringement particularly counterfeiting and piracy as one of the most prominent risk when internationalising to India. Infringement of IP rights can lead to loss of business, jobs, reputation and competitiveness on the market which can have substantial impact on the EU SMEs.

IP rights are territorial in nature: this means that they are only protected and enforceable in the territories in which they have been registered. Therefore, EU SMEs wishing to ensure that their intellectual property is protected in India must take the relevant steps to protect them in this country.

EU SMEs must be aware that if IP rights protect their own intangible assets, they also protect those of their competitors. While this may seem self-evident, being informed about intellectual property, and associated tools is necessary to avoid infringing on a third party's IP rights. One such tool are the IP databases, in which all registered IP rights such as patents, design rights or trade marks are listed. Furthermore, these databases are useful to track the evolution of technology in a specific sector: these freely available databases are a free source of information regarding new technologies being adopted and protected by competitors.

Although India is signatory to many international agreements concerning IPR protection, there are still differences, between European and Indian IP laws in regards the specific protection, registration or enforcement of IP rights. It is therefore highly recommended to design the IP strategy accordingly. This factsheet aims to present the main elements which must be borne in mind when developing an IP strategy in India.

B. Indian IP framework in comparison to INTERNATIONAL STANDARDS

India's accession to most of the international treaties on IP protection ensures that its substantive law is to a great extent harmonised with international standards. This includes the Agreement on Trade-Related Aspects of Intellectual Property Rights (commonly known as the TRIPS agreement), an instrument which has set a minimum level of IP protection applied by all members to the World Trade Organisation (WTO).

Furthermore, India participates in international agreements for cooperation on the protection of trade marks and patents. India has ratified both the Madrid Protocol on the international registration of trade marks, and the Patent Cooperation Treaty. Not only have these two treaties helped bring Indian substantive law closer to international standards on trade mark and patent protection, they also facilitate to a great extent the protection of these IP rights in the Indian territory for EU SMEs.



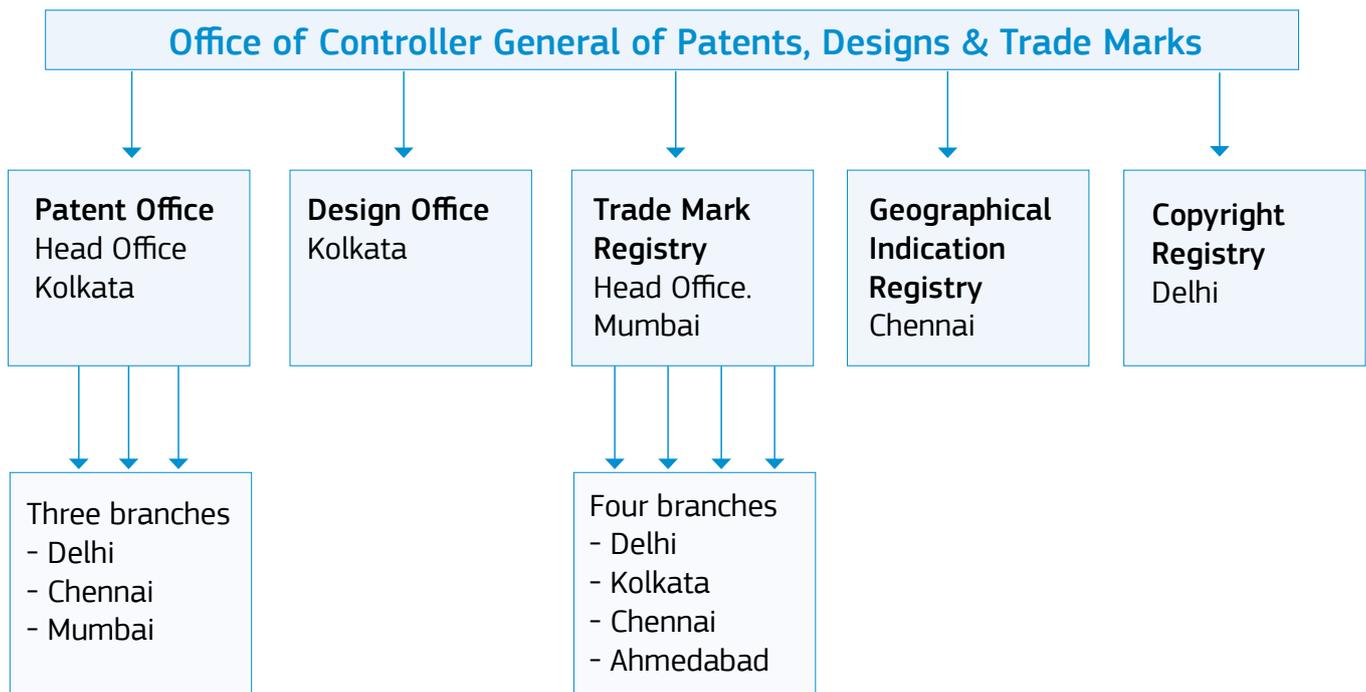
2. IP Rights in India: THE BASICS

A. Overview of the "Indian Intellectual Property Office"

The Office of Controller General of Patents, Designs, and Trade Marks (CGPDTM), India's IP Office, is the government agency administering the issuance and management of all IP rights in India. It is located in Mumbai and oversees the work of all its branches specifically dedicated to a specific IP right, which are located across different cities in India.

How do I know in which office should I file my application?

In the case of patent and trade mark registrations, these can be filed in any of the local branches, depending on the jurisdiction of the applicant's residence or place of business, or that of his legal representative.



Do I need a representative to deal with the India IP Office?

Foreign applicants who do not reside or have place of business in India are required to hire an Indian legal representative to file an IP application, or for any other dealings with any one of the branches of the CGPTDM. In this case, a power of attorney has to be submitted as part of the application.

What is the CGPDTM's working languages?

The CGPDTM has two working languages: English and Hindi. Any application must be filed in one of these two languages.

TIPS AND WATCH-OUTS

SMEs and the CGPTDM

Indian law recognises three categories of IPR applicants: individuals, start-ups and small entities, and large entities.

Start-ups and small entities can benefit not only from reduced official fees, but these applicants can also avail the option of accelerated application procedures, reducing the time necessary to obtain their IPR registrations. The applicants who declare themselves as start-ups or small entities are required to provide evidence that they meet the related criteria in regard to size, turnover, period of incorporation or registration, which is also applicable for foreign applicants.

Small Entities are businesses with an annual investment in machinery/equipment which does not exceed 100,000,000 INR (approximately 1,140,000 EUR) and an annual turnover which does not exceed 5,00,000,000 INR (approximately 5,700,000 EUR).

Start-ups are entities which have been in existence for less than 10 years, and have a turnover which does not exceeded 1,000,000,000 INR (approximately 11,402,120 EUR).

Throughout this document and for the sake of simplification, persons, start-ups and small entities will be from now on referred as "SMEs".

B. Copyright

WHAT is copyright?

Copyright is a right granted to creators of original works. literary, dramatic, musical and artistic works and producers of cinematograph films, and sound recordings. It also includes rights of reproduction, adaptation and translation of the work. It is important to note that copyright only protects a specific 'work', i.e. the tangible expression of an idea, but not the idea expressed itself.

It includes both the "Moral Rights" of an author over his work which consist in the author's inalienable and untransferable right to claim authorship of the work and prohibit modification, to his/ her work damaging to his/her reputation, and the "Economic rights". These are the exclusive rights to commercially exploit the work for economic gain and include reproduction, distribution and adaptation rights. These latter rights can be owned by the creator of the work, or may be transferred to third parties.

Copyright in India WHAT do you need to know?

The basic requirement for copyright protection over a work is that it must be 'original'. This does not imply that the work must be imaginative, but that it must be the fruit of the work and skill of its creator, as opposed to a copy of a pre-existing work.

Copyright protects original literary, dramatic, musical and artistic works, as well as cinematographic films and sound recordings. Original databases also enjoy copyright protection. As is the case in Europe, software is protected in India through copyright as literary works.

The creator of the work is presumed as the copyright owner, though there are exceptions.

TIPS AND WATCH-OUTS

Works created in the course of employment and service contracts

In India, copyright over works created by employees in the normal course of their employment is by default owned by the employer, unless the employment contract states otherwise. The same will apply to works created in the context of a service contract, where copyright is presumed to be owned by the client.



HOW LONG does legal protection last?

The duration of the copyright protection varies according to the nature of works. In the case of musical, artistic and literary works, copyright subsists for the lifetime of the author plus 60 years after his/her death. Films, photographs, and software are protected for 60 years from the year of their public disclosure. The rights over broadcasts last for 25 years from the year of broadcast and performers rights last for 50 years from the year the performance was made.

HOW do I register?

Although copyright registration is not mandatory in India, it is advisable to register copyright as a registration certificate is considered as 'proof of ownership'. Furthermore, it is necessary to initiate legal actions against potential infringers.

Application

The copyright application can be filed either in person, by mail or online with the [Copyright Register](#). The application consists in a copy of the work and with the application form(s), supporting documents, and fees. After submission, a 30 days period starts during which third party may file objections to the Copyright Register. In case of any objection, a hearing is held in which both parties can present their arguments. If the objection by the third party is rejected, the application proceeds for examination.

In case no objection is filed by a third party, the copyright examiner reviews the application and issues examination report. If the examiner finds the application satisfactory, the copyright is registered and a certificate of registration is issued. In case of objection by the examiner, the applicant will be given the opportunity to respond to the examination report and, if required, called for a hearing to address any further discrepancies. After the hearing, the application either proceeds for registration of copyright or the application is rejected.

In case of no objections from the third party, the Copyright can be registered within 3 to 4 months from the date of filing the application.

How much does it COST?

Registration application fees vary depending on the type of work. There are separate fees for changes, amendments, cancellations, additional certificates, etc. The official fees for application for registration of works are as of May 2021 are as follows:

- 6 EUR per work for literary, artistic, musical and dramatic works.
- 57 EUR per work for cinematographic films.
- 23 EUR per work for sound recordings.

There are no periodic fees for maintaining a copyright registration.

C. Patents

What is a patent?

A patent is an intellectual property right granted over an invention which gives its owner the exclusive right to use, produce, sell or import said invention in the country concerned. It therefore excludes others from commercially exploiting said product or process without the patent owner's consent.

The Indian patent system does not include provision to protect Utility Models.

TIPS AND WATCH-OUTS

Provisional applications

Under Indian law you can file a provisional application which partially discloses an invention still under experimental stage. A complete disclosure of the invention commonly referred to as a complete patent specification has to be filed at the Patent Office within 12 months of filing a provisional patent application in India. If the complete patent specification is not filed in time, the application will be considered as abandoned.



Which are criteria to obtain patent protection?

The basic patentability criteria are the same in India as they are in Europe:

- a) **Novelty:** The invention disclosed in the patent application must be new and must not be disclosed in public domain by either publishing, exhibiting, or by any other marketing activity. Note that India provides a “grace period” of 12 months prior to the first patent application during which disclosure of the invention will not be taken into account.
- b) **Inventive step:** The patented product or process must be substantially different from already publicly known information and must not be an obvious development of pre-existing knowledge to a specialist in the particular technology domain.
- c) **Industrial application:** The invention must be produced or utilised in any kind of industry.
- d) **Subject matter:** Indian law contains provision which does not allow patenting certain types of invention. Examples include inventions considered against public safety, methods of agriculture or second medical use. In the case of some subject matter, additional documents must be filed as part of the application. For example, for an invention based on a biological resource obtained from India, an authorisation from the National Biodiversity Authority (NBA) must be submitted to the Patent Office as part of the patent application

Which inventions are eligible for patent protection in India?

In India, as in Europe, patents may protect products (e.g. new chemicals, metallic alloys, mechanical devices, electronic components, etc.) as well as processes (e.g. manufacturing processes of chemicals, polishing processes, etc.).

Furthermore, in both India and Europe, certain categories of otherwise patentable inventions are specifically excluded, including inventions the commercialisation of which would represent a risk to public order or safety, algorithms, scientific theories, computer software as such, or methods for medical treatment.

Beyond these commonalities, however, certain invention categories, that are patentable in Europe, are NOT patentable in India, such as:

- Secondary uses of known products (including secondary medical use of medicines);
- New forms (e.g. salts or isomers) of known products, unless they result in enhanced efficacy (and more specifically, for medicines, therapeutic efficacy);
- Methods of agriculture or horticulture;
- Inventions which can be considered traditional knowledge;
- Inventions relating to atomic energy.

Novelty and disclosure of the invention

Any public disclosure of information regarding your invention before application for a patent, will become public knowledge and hence considered as a “prior art”. However, Indian law states that a grace period of 12 months is provided for a patent application from the date of:

- public display in an exhibition organised by the government and notified to IPO; or
- disclosure in a paper read by the inventor before a learned society or published with their consent.
- if you work the invention in public for a purpose of a trial which was necessary due to a nature of the invention, for example sewage/water treatment plant.

Furthermore, international agreements on patents enable a patent applicant to “claim priority” when filing a patent application in India for inventions for which patent applications have already been filed in other countries up to 12 months earlier. Claiming priority means that when applications have been filed for the same invention in different countries, the date on which the first application was filed is established as the priority date, and all disclosures after this date will be ignored in the examination of an invention’s novelty.



How LONG does legal protection last?

Patents are valid for 20 years, counting from the date of filing of the patent application.

HOW do I register?

There are two ways to file a patent application in India:

a) National filing – Indian Patent Office

A patent application can be filed with the Indian Patent Office either in hard copy or through online filing system by submitting either complete or provisional specification along with requested forms and fees. The full patent application procedure, from filing to grant, can take between 4 to 6 years and the status of the application can be monitored via system [inPASS](#) implemented by the Patent Office.

Based on the address of your domicile, place of business or your legal representative, the application for a patent will be filed in the concerned office in India.



b) International filing – Patent Cooperation Treaty (PCT)

The Patent Cooperation Treaty (PCT) is a mechanism administered by the World Intellectual Property Organisation (WIPO) enabling a patent applicant to file a single patent application with the same effect as national applications filed in each of the PCT-participating countries he or she elects. Effectively, this "International application" acts as a bundle of applications which, if successfully examined at a national or regional level at the end of the 'international phase' (that lasts for 30 months), will result in patents being granted in each of the selected countries. For more information regarding the PCT, we invite you to consult the "[Patent Cooperation Treaty Guide](#)" developed by the International IP SME Helpdesks.

After filing a patent application under the Patent Cooperation Treaty (PCT) route you can select India as one of the designated states. The application must enter the Indian national phase within 31 months from the priority date of the earliest application.

TIPS AND WATCH-OUTS:

Informing the IPO about patent filings outside of India

Patent applicants in India must furnish details of corresponding patent applications with regard to same or substantially same invention filed outside of India as well as search and examination reports of the corresponding applications. This obligation is valid up to grant or refusal to grant a patent. Non-compliance with this provision can have dire consequences as it is a valid ground for invalidation under pre-grant and post-grant opposition and revocation of a patent.

How much does it COST?

The overall cost of obtaining a patent in India includes the official fees which are paid to the IPO and professional fees that are paid to a patent attorney or a patent agent.

Official filing fees:

For SMEs, the patent application fee is **18 EUR**, and in the case of larger entities the fee is **92 EUR**.

The following additional fees apply:

- Per priority claimed: **18 EUR** for SMEs, **92 EUR** for larger entities.
- Per page of the application if it exceeds 30 pages: **2 EUR** for SMEs, **9 EUR** for larger entities
- Per claim, past the first 10 claims: **4 EUR** for SMEs, **18 EUR** for larger entities.

Note that the fees described here only include official fees for filing a patent application, while other fees apply for changes, amendments, request for examination, request for publication, etc. Patent agents will charge additional service fees, which might substantially raise the full cost of the patent protection. The costs expressed in EUR are subject to change due to variations in the exchange rate with the local currency and only serve for guidance.

Annuity Fees:

Once the patent is granted, the patent holder must pay annuity fees from the third year onwards. If the patent is granted more than three years after the date of filing of the application, the accumulated fees for each corresponding year must be paid within three months from the date of grant of the patent. The following table aims to provide a guide to the amounts required for annuity payments for patents in India:

	SMEs	Large entities / all other entities
Year 2 to 5	9 EUR	46 EUR
Year 6 to 9	28 EUR	139 EUR
Year 10 to 14	55 EUR	277 EUR
Year 15 to 20	92 EUR	462 EUR

TIPS AND WATCH-OUTS:

Annual statement of working (SOW)

In addition to paying the annuities, every patent holder (and every licensee, whether exclusive or otherwise) is required to submit every year a statement indicating whether and to what extent the invention disclosed in the patent has been commercially exploited. Failing to supply required information or providing false information might be considered as a punishable offence.

For an invention which is not used in India, not made available to the public for a reasonable price or not satisfying public requirements, a third party can request the IP Office to grant it a compulsory license for this invention.

D. Industrial Design

What is an industrial design?

An industrial design right is a protection conferred to a shape, configuration, surface pattern, colour, or line (or a combination of these), which can be applied to a two-dimensional or a three-dimensional article to produce or increase aesthetics.

Which are the criteria to obtain Industrial design protection?

To obtain the protection under Indian law, a design must fulfil following criteria:

- The design should be new or original, and not being known from any previous publications in any country before the date of application and it is not contrary to public order and morality.
- It must be the application of a shape, configuration or pattern to an article by an industrial process. It cannot protect mechanical devices as such or the mode of construction of the object.
- The feature of design must be obvious and visible on the finished article and be capable of being solely judged by the eye.
- The design should not include any trade mark or property mark or artistic works.

Novelty and disclosure

Although the novelty requirement is an absolute requirement for a design registration, Indian law provides a grace period of 6 months from the date of the disclosure of the design if it was used or disclosed during an exhibition recognised by the government, and the applicant had given previous notice to the Indian Design Office on a prescribed form.

Furthermore, international agreements on IP Rights enable a design applicant to "claim priority" when filing a design application in India for a design for which an application has already been filed in other countries up to 6 months earlier.

HOW LONG does the legal protection last?

The duration of the protection of industrial design is for a period of 10 years from date of filing the design application. The design registration can be renewed once for an additional period of 5 years.

HOW do I register?

A design application can be filed with the Indian Design Office either in hard copy or through an online filing system. After submission, the examiner reviews the application and issues an Examination Report. The applicant or his agent then has to respond to the Examination Report within 6 months after its issuance. If all objections raised by the Examiner are resolved, the application will proceed to registration. Alternatively, the Examiner will appoint a hearing to discuss the objection(s) and consequently the application is either registered or rejected by the Design Office.

The design registration procedure takes between 6 to 12 months from the date of filing.

Based on the address of your domicile, place of business or your legal representative, you can file application for industrial design in hard copy or by post in the concerned Patent Office for your jurisdiction in India or directly with the Design Office in Kolkata. Applications filed online will be directly processed by the Design Office in Kolkata.

TIPS AND WATCH-OUTS: Design Class

India' uses the "Locarno Classification" hereby harmonising the Indian Classification System with international norms. Applicants should therefore use this Classification to classify their designs in their application. One application may cover more than one class.

How much does it COST?

The overall cost to register Industrial design in India comprising the official fees which and professional fees that are paid to a patent attorney or a patent agent.

For SMEs, the design application fee is **11 EUR**, and in the case of larger entities the fee is **46 EUR**.

The renewal fees are **23 EUR** for SMEs and **92 EUR** for larger entities. The fees only include official fees for filing a design application, separate fees for changes, cancellation, amendments might be applicable. Patent agents / patent attorneys will charge additional service fees, which might raise the full cost of the design protection. The costs expressed in EUR are subject to change due to variations in the exchange rate with the local currency and only serve for guidance.



TIPS AND WATCH-OUTS:**Industrial designs and copyright**

As per the Indian law, copyright protection is granted from the moment of creation of the artistic work, which includes object which can also be protected via copyright. However, once the industrial design has been registered, the copyright protection for such work ceases to exist as the dual protection is not allowed.

Moreover, if the work could be registered as Industrial Design (but has not been so), the copyright protection will come to an end whenever any article to which the work is applied, has been reproduced by an industrial process more than 50 times.

E. Trade marks**What are Trade marks and what do they protect?**

A trade mark is a sign which is represented graphically and capable of distinguishing the goods or services of one person from those of others. The trade mark can consist of words, numbers, logos, shape of goods, packaging and combination of colours, or the combinations of all such elements.

In India, there are different types of trade marks:

- **Individual trade mark:** used to distinguish goods and services of one undertaking from those of others.
- **Collective trade mark:** used by an association to distinguish goods and services provided by its members from goods and services provided by other parties. The association ensures compliance with certain quality and accuracy of goods and services which are provided by its members who use the collective mark. The owner of the collective trade mark can even be a public entity or a cooperative.
- **Certification marks:** a mark applied to goods and services which represents certain qualities, characteristics or standards certified by the trade mark holder, which the goods or services must comply with. For example, the Bureau of Indian Standards (BIS) hallmark certifies the purity of gold jewellery.

Which non-traditional trade marks are protected in India?

Non-traditional trade marks such as colour and sound, are also protected in India provided that they are represented graphically in the application form. In the case of sounds, the graphical representation requirement is met by the use of a musical staff showing the musical notes and the rhythm of the sound being applied for.

WHAT do you need to know?

In order to be eligible for registration, a trade mark must not fall within one of the following grounds under which an application will be refused. These are similar to those which apply in Europe and are the following.

Absolute grounds for refusal:

- **Lack of distinctiveness:** marks which are not capable of distinguishing the goods/ services of one company from those of another, which consist exclusively of elements which serve to describe the product/service in question, or its qualities.
- **Illegal signs:** marks which are identical or similar to a name or flag of a State, certain names (such as Mahatma Gandhi), contrary to public order, morality or hurting religious sentiments of Indian citizens, or signs which deceive or pose confusion to public and are deceptive as to the origin, nature and quality of goods or services.
- **Functional signs:** marks which consist in the shape of the goods where said shape results from the nature of the good in themselves, is necessary to the utility of the product, or adds substantial value to the product.

Relative grounds for refusal:

- **Similarity to an earlier sign:** it must not be similar or identical to a well-known trade mark or an earlier trade mark for same or similar goods or services

TIPS AND WATCH-OUTS:**Acquired distinctiveness**

A trade mark which was initially refused on base of absolute grounds can be registered if it is continuously used and hence gains distinctive character.





TRADE MARK

HOW LONG does legal protection last?

Trade mark rights are valid for 10 years and can be renewed indefinitely.

HOW do I register?

A trade mark can be registered through the 'national' or 'international' route and can only be effectively protected once it has been registered in India. India uses the [Nice Classification](#) for the description of goods and services for which a trade mark is registered. Note that India accepts "multi-class" application, i.e. an application covering goods and services from several classes of the Nice Classification.

a) National filing – Trade Marks Registry at Indian Patent Office

A trade mark registration can be filed with the Indian Patent Office through online filing system or in person. The examination of the application takes between 12 to 18 months and the status of the application can be monitored via the website of the [Trade Mark Registry](#) at Indian Patent Office.

b) International filing – Madrid System

The Madrid Protocol is an international system to obtain trade mark protection for a number of countries which are signatory to the Madrid Protocol, using a single application. The member states of the EU and India are parties to the Madrid Protocol. Before you can file an international application, you need to have already registered, or have filed an application, at the trade mark office of your home country. Then the international application can be filed with the trade mark office in your home country which will be forwarded to WIPO for formal examination. After approval, WIPO notifies trade mark offices in all countries in which the applicant wishes to obtain protection. If, within 18 months from the notification no objections are made, the trade mark will be registered.

TIPS AND WATCH-OUTS: Trade mark searches

Before filing a trade mark registration, it is always highly recommended to perform a prior search to ensure that your proposed mark is not similar or identical to a pre-existing trade mark in any of the territories in which you want to file an application. These searches can be done through the database of the [Trade Marks Register](#) or using the [TMview tool developed by EUIPO](#). This so-called prior art search is necessary to save time and money and avoid conflicts before you launch products or services in new markets.

How much does it COST?

The cost for the trade mark registration **52 EUR** for SMEs and, and **116 EUR** for larger entities for the other applicants per class of goods and services. Renewal fees amount to 101 EUR per each class and each mark for all applicants.

The fees only include official fee for filing registration of a trade mark. Trade mark agent will charge additional service fees, which might raise the full cost of the protection. The costs expressed in EUR are subject to change due to variations in the exchange rate with the local currency and only serve for guidance.

For the schedule of fees for International Registrations, please see: <http://www.wipo.int/madrid/en/fees/>

CANCELLATION of the Trade mark for non-use

Cancellation of a trade mark is a process in which any party can seek to remove a registered trade mark from the register if trade mark was registered by the owner without any intention of use and/or if the trade mark has not been used for a continuous period of five years from the date of registration of the mark. Trade mark holders in India should therefore make sure that they use their registered trade mark within 5 years following registration, and keep records/evidence of such use to avoid any problems in the future.

TIPS AND WATCH-OUTS: Unregistered trade marks in India

Indian law follows the "first-to-use" principle. Hence, the right of a first user of a trade mark in relation to same or similar goods or services, is superior even though the subsequent user is the registered holder of the trade mark.

Indian law provides remedy for misuse of an unregistered trade mark by the common law doctrine of passing off. However, the owner of the unregistered trade mark has to prove that mark holds satisfactory reputation in the market. It is always advisable to register your trade mark in order to ensure exclusive rights and protect against infringement.



F. Geographical Indications (GIs)

What are GIs?

A geographical indication (GI) is a name which is used on products that come from a specific geographical region and which reflects certain qualities or characteristics or a reputation associated with that region. GI protection is granted to agricultural, natural and manufactured goods and goods of handicraft originating from a specific, geographical region.

WHAT do I need to know?

In order to obtain a registration under Indian law, a GI must meet all requirements defined by the Indian law. In order to do so, a GI application must contain the following:

- Proof of GI registration in the applicant's home country.
- In the case of EU GIs, the technical file pertaining to the registration filed with the European Commission for PDO/PGI, in which the method of production of the product is explained.
- If there is no technical file available, a document describing stages in method of production.
- Proof of historical origin of your GI.
- A certified copy of a map indicating the specific geographical region.
- Documents concerning quality control, packaging, labeling.
- List of producers claiming the GI tag and processes of checking how the producers comply with maintenance of the prescribed quality and standards.
- Instances of successful enforcement of the GI including details of any successful domain name cases (if applicable).
- Export figures of the product to India as well as expenditure incurred for promotion of the product in India (if applicable).

HOW LONG does legal protection last?

GI registration is valid for period of 10 years and can be repeatedly renewed every 10 years by filing an application for renewal along with paying renewal fees.

HOW do I register?

A GI registration must be filed with the [Geographical Indications Registry](#). After submission at the GI Registry, the Examiner reviews

the application and notifies the applicant in case of any deficiencies in their application. The applicant then has one month to provide any missing documents to the GI Registry, or any extended period granted in the discretion of the Registrar of GIs. Thereafter, the application is examined, and the examiner issues an Examination Report. The applicant must to objections raised by the Examiner within two months, if any. In many cases, the Registrar appoints a hearing. After the hearing, subject to meeting all criteria and the applicant satisfactorily responding to the objections raised, the Registrar will advertise the application inviting any oppositions from the public for a period of 4 months. In case no opposition is filed within this timeframe, it will be registered. If there is a failure to attend to the requirements and objections raised, the application will be abandoned by the Registry.

If all requirements are met, the registration of a Geographical Indication takes between 10 to 12 months from the date of filing. The status of the application can be monitored via the website of the [GI Registry](#).

WHO can register?

An application for GI can be filed by an association representing the producers of the relevant goods.

How much does it COST?

The official fee to be paid for the GI Application registration is approximately **57 EUR**.

The fees only include the official fee for filing registration of a GI. The legal representative will charge additional service fees, which might increase the total cost of the protection. The costs expressed in EUR are subject to change due to variations in the exchange rate with the local currency and only serve for guidance.

TIPS AND WATCH-OUTS: European GIs in India

If there is prior use of a European GI in India and if the same can be proved through documentary evidence such as invoices, export figures, publicity and promotional documents etc., a European GI can be enforced in India.

If such use cannot be proved, a GI must be registered with the Geographical Indications Registry in India for successful enforcement.



G. Trade Secrets

What are Trade Secrets?

In India, a trade secret is any confidential information which has actual or potential commercial value. For any undisclosed information to be considered as a trade secret it must fulfil the following criteria:

- it must be known only to a limited group of people;
- the information must have commercial value as secret;
- it must be actively safeguarded by the owner which might include use of confidentiality agreements with for the employees or business partners.

Trade secrets may include recipes or formulas, proposals, know-how, programmes, drawings, databases comprising confidential customer information, cost and price information, suppliers and contractors, contract terms, marketing strategy and plans, etc.

Trade Secrets in India: What you need to know

There is no specific law related to a trade secret protection in Indian law. Nevertheless, India is a signatory to the [Trade Related Aspects of Intellectual Property Rights \(TRIPs\) Agreement](#). In order to ensure compliance with requirements for protection of trade secrets as outlined in the TRIPs Agreement, trade secrets and confidential information are protected under various laws in India, for instance The Indian Penal Code, The Competition Act, The Contract Act, The Copyright Act etc, to name but a few depending on the nature of the information to be protected as trade secret.

The protection of a trade secret might enjoy infinite term as long as it is kept secret, and hence businesses are required to implement various measures to ensure that their confidential information is protected. Such measures could include use of confidentiality agreements for the employees or business partners, keeping the confidential data restricted or password protected, or physically restricted access to the information.

There is not a single legislation dealing with the trade secret protection in India, thus the best practice which can be adopted for trade secret protection is to implement a robust contractual arrangement through which confidentiality is assured. For instance, employment contracts having non-disclosure and/or confidentiality clauses should be an essential requirement in any HR policy, especially if the business is working with sensitive information. Such legal obligation should prevent current employees from disclosing

the employer's confidential information to a third-party during employment, and should prevent information/data theft after he/she leaves the company and joins another company which might be a competitor. Similarly, any contract with third parties – be it consultants, licensees, clients etc. – should include a non-disclosure and non-compete clause.

Even in the absence of a written agreement between the parties, Indian courts have held that as long as the party which received the information, was aware it was confidential information, that information could be considered as a trade secret. However, even in case of oral agreements, the onus of proof is on the owner of the information to prove that he has taken necessary step to protect the information.

In cases of misuse of the trade secret, you can obtain an injunction to prevent the disclosure of the trade secret and to have all confidential information returned. Moreover, depending on the extent of misuse you might also claim compensation for any damage suffered due to unauthorized disclosure of trade secrets by the misuser. However, the results of litigation in regard to trade secrets in India, depend on the facts and circumstances of the case as various remedies are available in different laws. Indian courts are generally more open to granting injunctions as opposed to granting damages.

HOW LONG does legal protection last?

The right over a trade secret only exists until the secrecy of the information is maintained. It can therefore last indefinitely.

TIPS AND WATCH-OUTS:

Trade Secrets best practice

Identify and list all assets such as recipes or formulas, proposals, know-how, programmes, drawings, databases comprising confidential customer information which could be considered as trade secrets.

It is advisable that you implement a trade secret policy in your organisation to avoid any misuse of confidential information which might result in loss of the trade secret.

Implement preventive steps in your organisation to ensure protection of trade secrets.

Make your employees aware of the importance of confidential information.

Enter into non-disclosure agreements with third parties before sharing confidential information and/ or starting negotiations.



3. ENFORCEMENT of rights

Indian legislation established commercial courts at the district level and commercial divisions within High Courts, to align and expedite commercial lawsuits which would also include disputes of IP rights. The very same legislation specified timelines for different stages of a suit to prevent delays and ensure fast disposals of the lawsuits.

Despite that, litigation of IP rights in India is very diverse due to the large number of courts, varying degree of IPR-related experience of the judges and varying practices within the courts.

Enforcement of IP rights in India is available under both civil and criminal law. The civil remedy is available for all IP rights whereas the criminal remedy is available for all IP rights except for patents and designs. The civil law also provides a mechanism for alternative dispute resolution such as arbitration, conciliation, judicial settlement and mediation. These tools have been very effective in settling all forms of IP disputes including those relating to patents, Standard Essential Patents (SEP), trade mark or copyrights.

A. Civil Litigation

The usual remedies you can seek through civil litigation are injunction, damages and seizures of infringing goods by the appointed commissioner. The civil lawsuit filed at a commercial court generally takes 2 to 3 years from the initiation of proceeding till receiving the judgement depending on the complexity case.

Evidence to initiate IP suits is dependent on the infringed IP right as evidence varies from purchasing the infringing product, advertisement, publication, mapping of patent claims with the infringing product, to name but a few.

Claimants can apply for remedies such as an interim and permanent injunction, rendition of accounts, accounts of profits or accounts of damages, preservation of assets and seizures of infringing goods. The punitive damages are granted in addition to real damages.

There are various orders which the courts issue depending on the particularities of the case for instance the 'Anton Pilar Order' is used for immediate search and seize of evidence if the case is prima facie strong. The 'John Doe Order' is used against unidentified defendants to prohibit them from possibly infringing any IPR rights or the Norwich Pharmacal Order which forces a third party to disclose documents or information to an applicant.

B. Criminal litigation

In India, no criminal remedy is available for infringement of patents and industrial designs. The usual remedies sought are search and seizure of infringing products by police and destruction of infringing goods. Criminal action is available in respect of trademarks, copyright and designs and may result in penalties and imprisonment for the infringer.

It should be noted that specific laws concerning patents, industrial designs, copyright and GIs outline different means/penalties etc. for civil or criminal actions and hence litigation in India is very case-specific and the guidance of experienced litigators is required.

C. Using CUSTOMS to block counterfeits

What are Customs?

The Central Board of Indirect Taxes and Customs (CBIC) is the government agency which has authority to suspend the clearance of imported goods which are suspected to be infringing a your IPR



in India. Furthermore, Customs can also impose penalty on a party which facilitates the import of infringing goods, and order for the destruction of detained infringing goods.

Customs in India: What you need to know regarding process at the Indian Customs Authority

IPR holders in India can register their IPRs with Customs, so that upon the importation of suspected infringing goods, the Customs authorities notify them as well as the importer/consignee stating the reasons for suspension and directing them to join the proceedings within the prescribed period.

IPR holders are required to furnish at the port of suspension a bond along with Bank Guarantee in favour of the Customs Authority within 3 days from the notice of suspension. The Bond has to be for 110% of the declared value of the imported goods and the Bank Guarantee for 25% of the said Bond value. Failing to do so means that the Customs authorities shall have no obligation to keep the goods suspended and the customs can release the suspended goods to the importer.

There exists an option to opt for an on-line centralized bond scheme in place of any consignment specific Bond. This relieves IPR holders from having to furnish consignment specific Bonds at each and every port where the goods have been suspended,

Thereafter the IPR holder or his representative is required to examine the suspended goods to assess their authenticity the port where the goods have been suspended. If the goods are found genuine, the

Customs Authority will release the goods to the importer and return to you the Consignment Specific Bond or Centralised Bond, and Bank Guarantee.

If the goods are found to be counterfeit the Customs Authority will issue a notice to the importer and all other necessary parties who have facilitated the said importation of the goods and keep the Consignment Specific Bond and Bank Guarantee.

The Custom Authority will call a hearing with both parties to make their submissions, if it is established that the suspended goods have are indeed infringing, the Customs Authority shall pass an order for absolute confiscation and also imposing penalty on the imported and other necessary parties.

The goods shall then be destroyed or disposed of, under official supervision. The costs of destruction, demurrage and detention charges incurred till the time of destruction or disposal, are borne by the IPR holder.

At the end of the proceedings, the Bond and Bank Guarantee are returned to back to the IPR holder.

WHAT can be registered?

Trade marks, copyright, industrial designs and geographical indications can be registered with the Custom Authority. Patents are no longer eligible for custom recording in India due to issues in determination of the infringement. If you want to record multiple IP rights, separate application forms must be filled for each IP right.



How to register?

You can register your IPR (trade mark, copyright, design, etc.) by submitting an application in the prescribed form electronically. Along with the application, the following documents must be submitted:

- Proof of existence and ownership of a valid IPR (registration certificate of trade mark, etc.);
- Power of Attorney in favour of authorised representative (valid for at least 5 years);
- General Bond to protect the competent authorities/importer/owner of the imported goods against any liabilities and to bear the costs for destruction of goods, demurrage etc. Further, by way of the General Bond, the Right Holder undertakes to furnish consignment specific bond along with Security at the time of interdiction of goods and to join the proceedings as per the Rules.
- Indemnity Bond indemnifying the Customs authorities against all liabilities and expenses on account of suspension of the release of allegedly infringing goods.
- Statement of Grounds and Grounds of Exclusivity.
- Digital photographs/images of the genuine products.
- Digital images of counterfeit goods (if available).
- IEC code of the authorised importers and of IP Holder
- Differentiating features of genuine and infringing goods (not mandatory but recommended).

After the application is filed, a Unique Temporary Registration Number (UTRN) will be generated. Customs will notify the applicant whether the application has been accepted or rejected, within 30 days from the date submission of the application along with complete documents.

In case the application is accepted for registration, a Unique Permanent Registration Number (UPRN) will be issued by the Customs upon registration of the application, which will be valid for a maximum of five years. Once the UPRN is allotted and formally recorded, this information is simultaneously made available at all Customs ports in India.

Who can register?

The application may be submitted directly by the IPR holder or their legal representative.

TIPS AND WATCH-OUTS:

Customs in India

Only IP Rights which are recorded with the Customs, can be enforced.

Customs Authority is not under an obligation to suspend a consignment of goods if your IP rights are not recorded with Customs Authority. In such cases, a consignment may be suspended by the Customs depending upon facts and circumstances of the case.



4. RELATED LINKS and additional information

World Intellectual Property Organization (WIPO)
<http://www.wipo.int/portal/en/index.html>

Office of the Controller General of Patents, Designs & Trade Marks (India IP Office)
<https://ipindia.gov.in/>

Patent Office
<https://ipindia.gov.in/patents.htm>

Design Office
<https://ipindia.gov.in/designs.htm>

Trade mark Registry
<https://ipindia.gov.in/trade-marks.htm>

GI Registry
<https://ipindia.gov.in/gi.htm>

Copyright Office
<https://copyright.gov.in/>

Central Board of Indirect Taxes & Customs
<https://www.cbic.gov.in>





INDIA IP COUNTRY FACTSHEET

Download Guide



The **India IP SME Helpdesk** offers **multilingual services** providing free and first-line legal advice on IP related subjects, as well as training, webinars and publications, especially designed for EU SMEs.



HELPLINE First-line advisory service on IP protection and enforcement for EU SMEs working or planning to operate in India.



TRAINING Targeted trainings and webinars on IPR protection and enforcement for EU SMEs (including sector- specific approaches).



IP CONTENT State-of-the-art publications (factsheets, learning modules, videos, IP glossary, info graphics, case studies and newsletters) on the protection and enforcement of IPR in India – specifically addressing IP matters from the SME business needs point of view.



AWARENESS RAISING EVENTS Participation in events attended by EU SMEs to increase the awareness of IP and of the visibility of the services provided by the Helpdesk.



IP ANALYSIS Analysis of IP challenges faced by EU SMEs in the target markets.



IP DIAGNOSTIC TOOLKIT Toolkit for self-evaluation of the IP-status of the user in terms of IP knowledge and management.



IP COST TOOL Online tool that allows the user to pre evaluate the costs related to IP management in India.

If you have any queries on how to protect your Intellectual Property in India contact our Helpdesk service:

india@iprhelpdesk.eu
+34 96 590 70 70
Working Hours: Monday - Friday 9:00 - 17:00 (CEST)

If you want more information on additional free services offered by the Helpdesk contact the coordination team:

india@iprhelpdesk.eu
University of Alicante, Campus San Vicente del Raspeig,
Edificio Torre de Control, 03690 Alicante, Spain
+34 96 590 70 70

Follow us on Social Media and stay tuned on new releases of factsheets and other IP content:

Follow us on Social Media:
   @IndiaIPHelpdesk



ec.europa.eu/ip-helpdesk

©European Union, 2021

Reuse is authorised provided the source is acknowledged.

The Reuse policy of the European Commission documents is regulated by Decision 2011/833/EU (OJL 330, 14.12.2011, p.39).

The India IP SME Helpdesk is a free service for the SMEs which provides practical, objective and factual information about Intellectual Property Rights in India. The services are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. The content and opinions expressed are those of the authors and do not necessarily represent the views of the European Commission and/or the Executive Agency for Small and Medium-sized Enterprises or any other body of the European Union.

Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice. Neither the European Commission nor the Agency may be held responsible for the use which may be made of the information contained herein.

Luxembourg: Publications Office of the European Union, 2021.

Print ISBN 978-92-9460-806-2 doi: 10.2826/859983 EA-01-21-140-EN-C
PDF ISBN 978-92-9460-805-5 doi: 10.2826/986218 EA-01-21-140-EN-N



Publications Office
of the European Union