



Innovation, Science and
Economic Development Canada
Canadian Intellectual Property Office

Innovation, Sciences et
Développement économique Canada
Office de la propriété intellectuelle du Canada



DOING BUSINESS ABROAD

Protecting your IP in India



Canada

This publication is also available online
at Canada.ca/intellectualproperty

Contact

Client Service Centre
Canadian Intellectual Property Office
Innovation, Science and
Economic Development Canada
Place du Portage I
Room C229, 2nd floor
50 Victoria Street
Gatineau, QC K1A 0C9

Telephone (toll-free): 1-866-997-1936
TTY: 1-866-442-2476
Fax: 819-953-2476
ic.contact-contact.ic@canada.ca

Permission to reproduce

Except as otherwise specifically noted, the information in this publication may be reproduced, in part or in whole and by any means, without charge or further permission from the Department of Innovation, Science and Economic Development, provided that due diligence is exercised in ensuring the accuracy of the information reproduced; that the Department of Innovation, Science and Economic Development is identified as the source institution; and that the reproduction is not represented as an official version of the information reproduced, or as having been made in affiliation with, or with the endorsement of, the Department of Innovation, Science and Economic Development.

For permission to reproduce the information in this publication for commercial purposes, please fill out the application for Crown copyright clearance at ic.gc.ca/eic/site/icgc.nsf/frm-eng/EABV-9DDLWL

© Her Majesty the Queen in Right of Canada, as represented by the Department of Innovation, Science and Economic Development, 2018

Cat. No. Iu71-4/53-2018E-PDF
ISBN 978-0-660-24773-1





DOING BUSINESS ABROAD

Protecting your IP in India

	Doing business abroad: Protecting your IP in India	5
	Where is IP registered?	7
	Trade marks	
	Patents	
	Designs	
	Copyright	
	IP enforcement	10
	Tips: Important notes	11





DOING BUSINESS ABROAD

Protecting your IP in India

Intellectual property (IP) is a valuable asset that can support your business expansion abroad. A Canadian patent, trademark or industrial design does not secure your rights outside of Canada. You should consider obtaining IP protection in the countries where you are, or plan on, doing business; this includes countries where you sell products over the Internet and countries where you manufacture products.

India is Canada's largest trading partner in South Asia. Given the significance of the Indian market, it is important to know how to recognize, register and enforce your IP rights in India. There are important differences between Canada and India in the protection and registration process for IP.

In India, you can apply for patent, copyright, and trade mark protection. If you wish to enter the Indian market or are already doing business in India, it is recommended that you apply to protect your IP rights in India as soon as practically possible, and that you always do this through Indian attorneys with expertise in IP rights.







Where is IP registered?

Trade marks, copyrights, patents, and designs are granted under the authority of the Office of the Controller General of Patents, Designs & Trade Marks (also known as Intellectual Property India), operating under the Department of Industrial Policy & Promotion.

If you do not have a business entity in India, a lawyer based in India must be used to file an IP application on your behalf. A Canadian or an international IP law firm can provide services directly in India or coordinate work with an Indian associate. As well, the Intellectual Property India website (ipindia.nic.in) provides a list of Indian patent and trade mark agents. Documents for an IP application can be submitted in English or in Hindi.

Note that under its *Biological Diversity Act*, India maintains broad, stringent provisions regarding the application for IP rights “based on any research or information on a biological resource obtained from India” without the prior approval of India’s National Biodiversity Authority. Penalties for violations of these provisions are severe, and include imprisonment. If you think this requirement may apply to your situation, consult an Indian attorney with expertise in IP rights.

Trade marks

- International trade mark applications under the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Madrid Protocol) may be filed designating India.
- A trade mark distinguishes your company’s goods and services from those of others in the marketplace and may be composed of letters, words, numbers, and/or designs. Colour combinations and three-dimensional shapes are also registerable in India if indicated on the application. Sound marks may also be registered if capable of being represented graphically and are found to be distinctive through use.
- The official languages of India are Hindi and English; however, a number of other languages are also spoken. An applicant may consider protecting

translations and transliterations if they are using word elements in their trade mark.

- The registration can take different forms namely word mark, label, logo and device mark.
- Trade mark applications must be filed with the Trade Marks Registry in the regional office in which your business is situated.
- As in Canada, registration may be based on the proposed use of a mark. It is therefore important to apply for registration as early as possible to ensure protection.
- Because of the widespread practice of “cybersquatting”—when third parties register well-known marks in bad faith in order to sell them to the original rights owners—it is advisable for rights owners to register their domain names in India as trade marks as soon as possible.
- A trade mark is registered for 10 years in India and may be renewed indefinitely for periods of 10 years.
- A registration for a trade mark that has not been used in India for five consecutive years may be subject to cancellation.

Patents

- Patent applications can be filed through the Patent Cooperation Treaty (PCT) system or with Intellectual Property India directly. As in Canada, patents in India are granted only for inventions: a new technical solution or improvement to a product or a process. Patent applications require full examination before being granted.
 - To obtain a patent, an invention must be new, non-obvious, and useful.
- Non-residents must file their patent application through a registered patent agent or give an address for service in India.
- A patent is valid for a period of 20 years from the date of filing.
- India, like Canada, has a first-to-file patent system where patents are granted to the first person who files an application for an invention.
- In general, an application for a patent must be filed prior to any public disclosure of the subject matter. However, India’s *Patents Act* provides a 12-month grace period for public disclosure of the subject invention under certain circumstances.
- It is important for businesses to consider that the *Patents Act* has a compulsory license provision whereby any person can file an application to have a compulsory license granted to them. This can be done after the third year anniversary of the grant of the patent. There are three grounds on which these licenses can be requested:
 - The reasonable requirements of the public have not been satisfied.
 - The patented invention is not available to the public at a reasonably affordable price.
 - The patented invention is not exploited or used in the territory of India.
- The PCT, to which Canada and India are parties, makes it possible to secure a filing date simultaneously in a large number of countries that are parties to the PCT by filing a single international application instead of filing several separate applications. PCT applications must enter the national phase in India within 31 months of the original filing. The grant or refusal of a patent in India remains the responsibility of Intellectual Property India.

- India does not participate in the Patent Prosecution Highway, so the program is not available to expedite the examination process.

Designs

- Designs are innovations in the external features of a product such as shape, pattern, and/or colour. Although the Register of Designs is maintained by Intellectual Property India, designs are protected separately under the *Designs Act*. Design protection is under a first-to-file system.
- Registration of a design confers so-called “copyright” for the design, which lasts for 10 years from the date you file it¹. Protection may be extended for a single five-year term.
- With the exception of textiles, designs must be marked as such on the relevant article.

Copyright

- In India, as in Canada, copyright protects original works such as literary, dramatic, musical, and artistic works. Protection is governed by the *Copyright Act* and *Copyright Rules*.
- The registration of copyright is administered by the Copyright Office under the authority of the Registrar of Copyrights.
- As in Canada, the registration of copyright is not required. However, a copyright registration may be used to establish ownership in any dispute or court case.

¹ If the same design is filed earlier in another country, the earlier filing date will be used.





IP enforcement

India offers several ways to enforce your rights against unauthorised use, including customs seizures and civil litigation. The state may also prosecute offenders under its own criminal law. Alternative dispute resolution means can also be considered such as mediation or arbitration. In order to determine the best course of action, you should consult an IP professional.

- All types of IP may be protected by the Indian Central Board of Excise and Customs which acts to prevent the import of allegedly infringing goods into India, as long as the IP has been registered or granted by the appropriate IP office. Registration is for a period of at least one year.
- Civil suits are possible for all types of IP infringement. Relief may include temporary or permanent injunction, damages or accounting of profits, delivery up of goods and/or legal costs.
- India's *Copyright Act* and *Trade Marks Act* provide for penalties including imprisonment for a period of up to 3 years, as well as a fine of up to 200,000 rupees.

Software

If you are outsourcing or developing software in India you should consider upfront how you will protect your IP rights and establish ownership of your IP. In India, software can be protected mainly by two

different types of IP rights: copyrights and patents, though copyright is commonly used. It can also be protected as a trade secret. IP professionals can help you protect your IP rights by drafting non-disclosure agreements and establishing ownership of your IP in the terms and conditions of your procurement contracts, among other things. Obtaining advice may be necessary to protect your IP when outsourcing or developing software in India.





Tips: Important notes

- IP rights are important—take the time to identify your IP to determine what can be registered and/or enforced in India as early as possible by consulting Indian attorneys with expertise in IP rights.
- Remember that the protection of IP rights (such as patents, trade marks or copyrights) registered in Canada does not extend to India.
- Make sure that contracts, including with regard to employment or licensing, appropriately protect your IP interests, and specify who can do what with your IP.
- Align your IP strategy with your business strategy. Identify business goals, protectable IP, regional requirements, potential partners and capacity to expand into your target markets.
- Routinely monitor the marketplace for any unauthorized use of your IP.
- Prior to proceeding with any of the enforcement methods outlined above, consider contacting a qualified IP professional to discuss options including a “cease and desist” letter.

For additional help:

- For information about IP protection in India, visit the website of the Office of the Controller General of Patents, Designs & Trade Marks at ipindia.nic.in.
- For material relating to the export of goods to India, or to contact a trade commissioner, visit the Canadian Trade Commissioner Service website at tradecommissioner.gc.ca/india.
- Visit the Global Affairs Canada website at international.gc.ca, for more information about doing business in India.
- For IP tools, resources and information for businesses, visit Canada.ca/ip-for-business.
- For more information on going global with your IP, visit Canada.ca/export-ip.
- Find more programs and support for Canadian businesses and innovators at innovation.canada.ca.

* The information provided above is meant as an educational resource only and should not be construed as legal advice.



Canada.ca/intellectualproperty

