

IPR utilities with “CYBER LAW”

Abstract:

The Intellectual Property Rights [1] protect the original work in fields of art, literature, photography, writing, paintings, even choreography in written format, and audio , or video files. The IPR protects these works both in tangible and intangible form. Patent, Copyright, Trademarks, Trade Secrets, Industrial and Layout Designs, Geographical Indications are intellectual property rights for which legal remedies are available even for online infringements.

Information Technology Act 2000 does not mention a single word about Intellectual Property protection while Infringement of IPR is one of the most challenging area in cyberspace. As well as Copyright and Domain names violations do occur on the internet but Copy Right Act 1957 & Trade Mark Act 1999 are silent on that which specifically deals with the issue. Therefore we have no enforcement machinery to ensure the protection of domain names on net. Time has come where we must enact special legislation for the protection of Intellectual property in cyberspace.[2]

Keywords:

Patent, Copyright, Trademarks, Geographical Indications , Domain names.

Introduction:

The utility of computers and the internet is well understood and in fact embedded in the modern business and commerce as well as in the society in general. The advantages of the use of the computers and internet are immense in the modern business and our society can't function smoothly without computers and information technology. But the use of internet and computers has brought along many unavoidable misuses of computer and the internet.

But the IT Act, 2000 lack somewhere to deal with the issues of Intellectual property. Intellectual property refers to creations of mind i.e. Copyright, Trademark, Patent, Geographical Indications and Integrated Circuits etc. etc. The Author in this paper has highlighted some important issues including online copyright infringement, domains names issues and suggestion thereof.

This Act has three objects, those are

1) To respond and to give effect to the united nations call to all states to give favourable consideration to model law when they enact or revise their laws so as to facilitate harmonization of the laws governing alternatives to paper based methods of communications and storage of information.

2) To provide legal recognition to transactions carried out by means of electronic data interchange and other means of electronic communication, commonly called as ecommerce which involve the use of alternatives to paper based methods of communication and storage of information.

3) To facilitate e-filing of documents with the government agencies so as to promote efficient delivery of government service by means of reliable electronic records.

Legislations Enacted to Protect IPR[4]

In the year 1999, the government passed an important legislation based on international practices to safeguard the intellectual property rights. The same are described below–

1. The Patents (Amendment) Act, 1999, facilitates the establishment of the mailbox system for filing patents. It offers exclusive marketing rights for a time of five years.
2. The Trademarks Bill, 1999.
3. The Copyright (Amendment) Act, 1999.
4. Geographical Indications of Goods (Registration and Protection) Bill, 1999.
5. The Industrial Designs Bill, 1999, replaced the Designs Act, 1911.
6. The Patents (Second Amendment) Bill, 1999, for further amending the Patents Act of 1970 in compliance with the TRIPS.

INTERNATIONAL LAWS FOR PROTECTION OF IP IN CYBER WORLD

The various international conventions treaties and agreements for protection of intellectual property in cyberspace are : “Berne Convention (1886), Madrid Agreement Concerning the International Registration of Trademarks (1891), Hague Agreement Concerning the Registration of International Designs (1925), Rome Convention for Protection of Performers, Producers of Phonograms and Broadcasting Organizations (1961), Patent Cooperation Treaty (1970) Agreement on the Trade-Related Aspects of Intellectual Property Rights (1994), World Intellectual Property Organization Copyright Treaty (1996), World Intellectual Property Organization Performances and Phonograms Treaty (1996), and Uniform Domain Name Dispute Resolution Policy (1999), in consolidation form the international instruments that govern Intellectual Property Rights.”^[11]

Berne Convention (1886) protects the IPRs in Literary and Artistic Works and for the developing countries specialised provisions are provided.

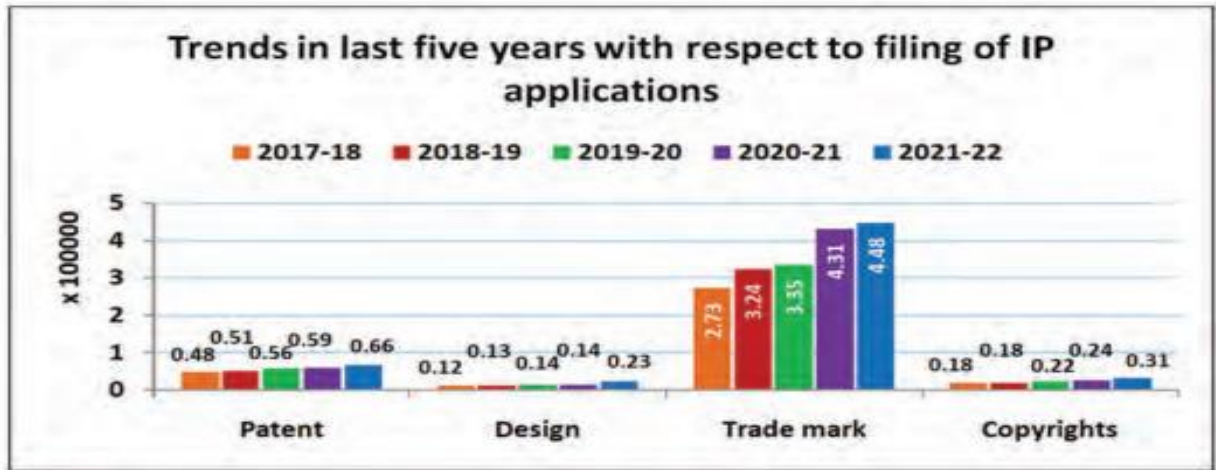
Rome Convention (1961) covers creative works of authors and owners of physical indicators of intellectual property. It permits the implementation at domestic level by member countries where the dispute falls within purview of adjudication by International Court of Justice unless resorted to arbitration.

TRIPS (1994) is a multilateral agreement on intellectual property that has the widest coverage of IPRs like copyrights and related rights.

UDRP (1999) is for the resolution of disputes on registration and use of internet domain names.

Trends in last five years with respect to filing of IP applications:

Application	2017-18	2018-19	2019-20	2020-21	2021-22
Patent	47854	50659	56267	58503	66440
Design	11837	12585	14290	14241	22699
Trade mark	272974	323798	334805	431213	447805
Geographical Indication	38	32	42	58	116
Copyrights	17841	18250	21905	24451	30988
Semiconductor Integrated Layout Designs (SCILD)	02	NIL	Nil	05	01
Total	350546	405324	427309	528471	568049



(i) TABLE[7]

A utility patent relates to the functional character of an invention. A utility patent is the most common type of U.S. patent. In evaluating the desirability of utility patent protection, the initial step is the verification that the invention resides in one of the statutory classes of patentable subject matter identified in 35 U.S.C. § 101, viz., processes, machines, compositions of matter, and articles of manufacture (this category technically refers to unitary or discrete articles having no or relatively few moving parts), and improvements thereof. Thus, inventions which are modifications or improvements of existing products or technology are fully appropriate subject matter for patent protection, provided that they otherwise meet the statutory patentability criteria. The patentability criteria are set out in Title 35 of the United States Code, in Sections 101, 102, and 103. These criteria include requirements of novelty, utility, and unobviousness. Each of these criteria is briefly discussed below. In the first instance, an inventor contacting legal counsel frequently will not have made a definitive assessment of the value of his/her invention. The

inventor should be informed that the patenting effort is a protracted and uncertain procedure involving the filing of a patent application in the U.S. Patent and Trademark Office, either by the inventor himself/herself (pro se), or by the inventor's licensed patent representative. While there is no prohibition against pro se filing and prosecution of an application for patent, the drafting requirements and the criticality of language and terminology involved is such that the inventor generally is well-advised to avoid "homemade" patent applications, and to retain a competent registered Patent Attorney or Patent Agent. A registered Patent Attorney is an individual who has been licensed by the U.S. Patent and Trademark Office to practice in matters before such office, and who is a member in proper standing of a state bar. In order to become credentialed before the Patent and Trademark Office, a technical or science background is required. A registered Patent Agent is an individual who has such technical or science background and who has passed the licensing (registration) examination of the Patent and Trademark Office but who is not an attorney. The inventor/client should be informed that a registered Patent Attorney or registered Patent Agent can assess the invention, can prepare the inventor's patent application, and can file and prosecute same in the Patent and Trademark Office, but only a licensed attorney can handle matters entailing the practice of law outside the scope of such Patent and Trademark Office representation (for example, preparing license contracts, bringing suit for infringement of patent rights, etc.). The next action to be undertaken in determining the propriety of patent action, once it is confirmed that the invention resides in one of the above-discussed statutory classes of potentially patentable subject matter, is making a prior art determination, in the context of the statutory patentability requirements of utility (35 U.S.C. § 101), novelty (35 U.S.C. § 102) and unobviousness (35 U.S.C. § 103). The prior art includes knowledge, information and activity of others which predates the invention in questions, as well as sales, offers for sale, public use, or printed publication of an invention in the United States, more than one year prior to the filing of the inventor's application for patent. Thus, a threshold question to the inventor/client should be whether any of these sales/use/publication activities has taken place, since any such activity will start a "oneyear clock" running. If more than one year has elapsed since the inception of one or more of these activities within the scope of the statute, the patent rights in that invention have irretrievably been lost. The United States Supreme Court in *Pfaff v. Wells Electronics, Inc.* (525 U.S. 55 (1998)) establishes the principle that the 1 year period of the on-sale bar of the Patent Law (35 USC §102) begins to run when a "ready to patent" invention is the subject of a commercial offer for sale of the invention. Concerning the ready for patenting condition, the Supreme Court declared: "That condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." (525 U.S. at 67, emphasis added) The "ready to patent" standard thus has been left open-ended in character, as regards the events that may define it. Special attention therefore is warranted to determine if an "on sale" statutory bar has occurred or is imminent if an invention has been commercially exposed to the market. The patent laws in most foreign countries are even more restrictive, providing no "oneyear clock" grace period. In such countries, absolute novelty is required for patent protection. Thus, if there has been any "divulgarion" to the public of the invention prior to filing for patent protection, then it is not possible to obtain valid patent protection in such countries. If the prospective client seeks counsel in connection with an impending disclosure, use, and/or sale

of his/her invention, the client should be made aware that these activities will result in immediate loss of the foreign patent rights in such "absolute novelty" jurisdictions, if no patent application has been filed beforehand. In this respect, the U.S. is a member of various international patent treaties, principally the International Convention, and the Patent Cooperation Treaty. Under such treaties, once a U.S. patent application is filed, corresponding foreign applications may be initiated within one year after the U.S. filing date, and will "relate back" to the filing date (i.e., have the effective priority filing date) of the U.S. patent application. What this means is that any subsequent product, development or patent activities by others, during the one year period after the U.S. application is filed, will not adversely affect the foreign counterparts filed within such one year period and claiming the priority rights of the U.S. application. This is a significant benefit, where the same or similar invention may be made by others in the interim between the U.S. patent application filing date and the date of foreign patent applications filed within one year thereafter. It should be noted that some countries are not members of any international patent treaties, so that separate individual patent applications would have to be filed in such countries at the outset to protect the invention. In this respect, it is recommended that if the inventor decides to pursue patent protection on the invention, the inventor identify foreign countries which may be important to him/her from a commercial standpoint, as a basis for deciding if foreign patent applications should be filed at the time the U.S. application is filed, in non-treaty countries. For all these reasons, it is highly prudent to counsel the inventor/client to seek the assistance of patent counsel at the earliest possible date. In determining the state of the art against which the invention will be judged by the U.S. Patent and Trademark Office, searches of issued U.S. and foreign patents and non-patent prior art may be conducted through an independent searcher to locate any references that may be pertinent to the invention. Copies of the pertinent "prior art" which is located in the search are provided by the researcher, and may be furnished to the patent attorney or patent agent, as a basis for preparing a detailed written assessment of the strength and scope of patent protection which may be obtainable based on the prior art located. Of course, if the inventor is knowledgeable of the state of the art in the field of the invention, and does not believe any competitive product or technology exists which is similar in character to this invention, or if the inventor desires to file the application in the U.S. Patent and Trademark Office as promptly as possible without assessing the state of the art, then the inventor may wish to proceed directly to preparing and filing a U.S. patent application. The danger in this approach is that an issued patent or other reference may be in existence which prevents patent protection from being obtainable. For this reason, it is generally recommended that an initial patent search be conducted, since the cost of such a search is generally significantly less than the cost of preparing and filing a patent application. The cost of a patent search, analysis, and opinion is typically in the range of \$1000- \$2000, depending on complexity. Alternatively, the inventor may wish to conduct his/her own patent search. Such a search may be conducted on-line at patent search sites such as the U.S. Patent and Trademark Office Web site[6]. A patent search also can be conducted at the Patent Depository in the D. H. Hill Library at N.C. State University[7], Raleigh, where assistance to the public is available for patent searches, free of charge (this may be a very time-consuming process, however). Since the patentability of the invention, and validity of any resulting patent obtained on the invention will be measured not only against the relevant patents but also against the general state of the art in the field of the invention, it is also advisable to do a general on-line search of non-patent sources

of prior art. This may be done using a general Internet search engine, e.g., to locate information on relevant products, methods, etc. that may have bearing on patentability. Assuming that a search is done, and it is concluded that the prospects for patentability justify the filing of a patent application, or it is decided to proceed directly to patent application filing without a search, the cost, including preparation of the patent application and related filing documents, preparation of formal drawings, and the Patent and Trademark Office filing fee, may be on the order of about \$5000-\$6000 for a simple application, \$6000-\$7500 for a patent application of moderate complexity, and \$7500- \$10,000 for an application concerning complex subject matter. Once the patent application is filed in the U.S. Patent and Trademark Office, it is sent to a Patent and Trademark Office Examiner who specializes in the subject matter of the application. The Examiner then performs a patent search (the reason a pre-filing patent search is recommended is to avoid any surprises at this stage) and based on the results of his or her search issues an Office Action. In the Office Action, the Examiner may take exception to the patentability of the invention claims, based on prior art, as well as objecting to other aspects of the specification and drawings of the application. In response to the Office Action, amendments may be filed and/or arguments may be presented in favor of patentability. This is followed by further action from the Patent and Trademark Office, until a final disposition of the application is made. The costs involved in this phase of the proceedings, termed "patent prosecution," depend on the position taken by the Patent Office. The Patent Office may, for example, determine the application to be allowable without any adverse action, in which event, no significant additional service charges would be incurred. On the other hand, the Patent Office may take an adverse position to patentability, which requires a significant argumentation and/or amendment of claims. Generally these prosecution costs do not exceed about \$8000. If the prosecution of the patent application is successfully concluded, a Notice of Allowance is issued by the Patent and Trademark Office and an issue fee is payable to the PTO to issue the patent. The current amount of the issue fee is \$605.00 for individuals and small businesses, and \$1,210.00 for large businesses (those having more than 500 employees). Subsequently, maintenance fees are payable to keep the patent in force for its full term of 20 years from its filing date. These maintenance fees are due at 3-½, 7-½, and 11-½ years after issuance of the patent. The amounts of these fees are currently \$470.00, \$950.00 and \$1,455.00 for individuals and small businesses, and \$940.00, \$1,900.00 and \$2,910.00 for large businesses, respectively. If the maintenance fee is not timely paid (it can be paid up to six months late with payment of a surcharge), the patent expires as a result of such non-payment. As soon as a patent application is filed, the invention covered by the application has "patent pending" status, and the invention can be correspondingly marked and advertised. Although there are no enforceable rights against infringement unless and until the patent actually issues, the marking and promotion of products as "patent pending" does put one's competitors on notice that a patent application has been filed and that a patent may issue and be asserted against them. In this manner, the "patent pending" notice serves as a barrier to entry to those who otherwise might be prone to work to "knock off" the product. Of course, there are individuals and companies who may decide that the capital investment is such that the invention can be "knocked off" successfully during the patent pending period, and the infringing operation will be taken out of business as soon as the patent actually issues. Alternatively, competitors may take the position that any patent issued is invalid, and continue infringement, thereby requiring legal proceedings or the threat of same to effect a resolution.

AGAIN, IT IS TO BE EMPHASIZED THAT THE U.S. PATENT LAW PROVIDES A ONE YEAR PERIOD FOR A PATENT APPLICATION TO BE FILED, AFTER THE APPLICATION IS FIRST SOLD, OFFERED FOR SALE, PUBLICLY USED, OR DISCLOSED IN A "PRINTED PUBLICATION". IF MORE THAN A YEAR PASSES FROM THE FIRST OCCURRENCE OF SUCH EVENTS, THEN U.S. PATENT RIGHTS ARE IRRETRIEVABLY LOST.

Insofar as foreign patent rights may be of interest, no disclosure of an invention should be made prior to filing of a patent application, except under secrecy agreement. As an adjunct to utility patent protection, the patent statute in 35 U.S.C. § 111(b) provides for provisional patent applications, which have a life of 12 months and are not subject to revival after such 12-month period. The filing date in the U.S. Patent and Trademark Office of the provisional patent application may be claimed as the priority date of a subsequently filed U.S. utility patent application, provided that the utility patent application is filed during the 12 months pendency of the provisional patent application. A provisional application thus affords a method of securing an early priority date to an invention which may be the subject of further development or evolution during the 12- month period, so that the description of the invention in the provisional application can be "bulked up" or otherwise more fully delineated, relative to the description initially filed in the provisional patent application. The filing fee for a provisional application is \$75.00 for individuals and small businesses, and \$150.00 for large businesses. The cost of preparation and filing of a provisional application, inclusive of the aforementioned filing fee, will depend on the complexity of the subject matter and extent of the description of the invention, but typically is in the range of \$2500-\$3500. The foregoing pertains to utility patents. Set out below is a cursory discussion of design patents.

Brief facts of the case [5]

The suit was filed by Tata Sons Ltd

(plaintiff no.1) and its subsidiary, Tata Infotech Ltd

(plaintiff no. 2). It was submitted that the mark "TATA" is derived from the surname of its founder Mr. Jamsetji Nusserwanji Tata. It was submitted that "the mark "TATA" has consistently been associated with and exclusively denotes the conglomeration of companies forming the Tata group, which is known for high quality of products manufactured and/or services rendered by it under the trademark/name TATA". It was also submitted that the House of Tata's comprises over 50 companies which use "TATA" as a key and essential part of their corporate name. Further, plaintiff no. 1 is the registered proprietor of the trademarks pertaining to and/or comprising the word "TATA" in relation to various goods falling across various classes of the Fourth Schedule of the Trade Mark Rules, 2002. It was, therefore, contended that plaintiff no. 1 has the exclusive right in the said trademark. The plaintiff no. 2 submitted that it is a pioneer in the field of information technology and has been using the trade name and service mark "TATA INFOTECH" since the year 1997. It was also submitted that the company enjoys high reputation in the market. The plaintiffs contended that they came to know about the registration of the domain name www.tatainfotech.in by the defendant on 21 February 2005 when the said defendant sent an email to the plaintiff no. 2 informing them about the registration he held over the impugned domain name. It was also contended that the defendant in the said email had claimed that he had supposedly received an offer for purchase of this domain name for a "large sum of money"

and that he wanted to inform the plaintiff about this. The plaintiffs contended that “this clearly showed that the defendant no. 1 had registered the impugned domain name only with a view to make illegal gains out of selling this domain name either to the plaintiffs or to any third party who wished to acquire it to use it in an illegitimate and mala fide manner. And that this also showed that the defendant no. 1 was very well aware of the plaintiff’s rights over the trade name and service mark TATA INFOTECH.”

Comparative Trends of IPRs granted/registered (and disposed)

IPR/Year	2017-18	2018-19	2019-20	2020-21	2021-22
Patents	13045 (47695)	15283 (50884)	24936 (55945)	28385 (52755)	30073 (35990)
Designs	10020 (10788)	9483 (11414)	12256 (14701)	9147 (9281)	15262 (15655)
Trade Marks	300913 (555777)	316798 (519185)	294172 (419566)	255976 (294944)	261408 (318878)
Geographical Indications	25	23	22	05	50
Semiconductor Integrated Layout Design	NIL	NIL	NIL	NIL	NIL
Copyrights	19997 (39799)	14625 (25943)	16029 (22516)	16399 (19477)	20673 (20820)

G. Publication and Pre-grant opposition:

During the reporting year, a total of **69613** patent applications were published under section 11A and **481** pre-grant oppositions were filed under section 25(1) of the Patents Act, 1970, which is about 0.69% of the total published applications. The details of the applications published and pre-grant oppositions filed are given below:

(ii)TABLE [8]

Conclusion:

As Intellectual property is one of the valuable assets of any person, it should be protected at any cost since a person puts his skills and labour for creation of Intellectual Property. On the other hand, there is an urgent need for the strict laws in this field, so that these crimes related to IPR could be avoided in future. The new domain name dispute law should be intended to give trademark and service mark owners legal remedies against defendants who obtain domain names “in bad faith” that are identical or confusingly similar to a trademark. It should act as an important weapon for trademark holders in protecting their intellectual property in the online world. In United States, they have special legislation for prevention of cybersquatting i.e. “U.S. Anti-Cybersquatting Consumer Protection Act, 1999” which protects the interest of owners of both registered and unregistered trademarks against use of their marks within domain names and also safeguards living persons against use of their personal name under certain circumstances. So it’s a high time for India to enact such a suitable legislation which will protect the rights of copyright, trademark owners.

- [1] Hereinafter referred to as IPR
- [2] CYBER LAW AND IPR ISSUES: THE INDIAN PERSPECTIVE (Mr. Atul Satwa Jaybhaye*)
- [3] Ibid
- [4] Ibid
- [5] IPR research blog
- [6] (www.uspto.gov/patft/index.html) official site.
- [7] BASICS OF INTELLECTUAL PROPERTY Steven J. Hultquist
- [8] ANNUAL REPORT 2021-2022 (The office of the controller general of patents, designs, trademarks and geographical indications government of india ministry of commerce & industry department for promotion of industry & internal trade.)