

We at **OEC Oertli Consulting** provide the strategic and MMP parts in international projects and closely cooperate with Amarjit & Associates as one of the leading law firms in India which works to the highest level of legal practice. **Amarjit & Associates** provides professional services to its clients, a quality that the business community would expect to receive from an efficient law firm with international dimensions. The firm, anticipating the increasing need and trend of multinational and domestic companies for the protection and enforcement of Intellectual Property Rights and the Globalization of economy opening up the avenues for joint venture arrangements, has built up an infrastructure and a think tank to provide complete range of legal services to cater to the varied needs and demands.

The expansion of Intellectual Properties regime to new fields like Geographical Indications, Plant Varieties, Bio technology, Cyber Laws has thrown new challenges not only to the individual clients but also to the States Constitutionally bound to protect the interest of its subjects keeping pace with unification of the World economy and at the same time complying with the international obligations. The firm provides services aiming at the protection and enforcement of all aspects of Intellectual Property Rights. Keeping in view the need to create awareness about the Intellectual Property Rights and to provide necessary guidance and input to the people of this country, the firm has nominated zonal representatives in some zones in the country and additional zonal offices are proposed to be set up in due course.

Amarjit & Associates, due to its most active arrangements with its associate attorneys in various countries all over the world, provides an additional breath of international expertise which is of significant benefit to the corporate clients. The firm is closely associated with OEC Oertli Consulting and provides consultation and legal services with regards to domestic as well as international matters. The firm is incorporated with such an effective structure so as to ensure a continuity of relationship with each and every client, while handling the simplest or most complicated matter.

#### **PROSECUTION SERVICES**

Amarjit & Associates aims at providing the appropriate and accurate advise as to the protection available and required for the industrial growth of individual client and that of the State. The firm also aims at providing maximum protection to its clients and also feels that it is as their duty to

keep the clients informed of the progress of their cases at every stage. Utmost effort to anticipate any bottleneck situation that may arise during the protection, prosecution and maintenance of Intellectual Property Rights is also timely made.

### **TRADEMARK PROTECTION & PROSECUTION**

Trademark is one of the most valuable species of Intellectual Property Assets of any client. Due care is required to be taken while adopting a mark. The level of protection a trade mark can have in future will largely depend upon the nature of the mark. The trade mark, once registered has to be periodically renewed to retain statutory rights to the exclusive use thereof.

The Trade Marks Act, 1999 has come into force with effect from 15<sup>th</sup> September, 2003. The changes which have been brought in the new Trade Mark legislation are:-

- Registration of service marks (which were earlier protected under the common law);
- The distinction between Part A and Part B of the Register abolished;
- The definition of trade mark expanded to include Shape of goods and Combination of Colours;
- Grounds of refusal of application divided into two categories

Absolute

Relative

- Statutory protection to well known trade mark afforded
- To overcome citation consent of the applicant of earlier registered mark/pending application acceptable to the Registrar to waive objections;
- The ambit and scope of infringement considerably expanded. Earlier the infringement was only in respect of the goods for

which the trade mark was registered. However, under the new legislation, even if infringing mark is used in respect of similar goods or services or part of a trade name would constitute infringement;

- The provisions relating to the registered user are made more liberal by recognizing the use made by unregistered user as deemed user of the registered proprietor;
- The offences of counterfeiting and falsification made cognizable attracting stringent punishment;
- Intellectual Property Appellate Board constituted for speedy disposal of appeals and rectification proceedings;
- Validity of registration of a trade mark made ten years;
- Jurisdiction for filing suit for infringement and Passing off vested with the Court where the plaintiff resides or carries on business.
- Registrar's power to grant extension of time in opposition proceedings to file evidence curtailed to a maximum period of one month in addition to statutory period of two months.
- The process of registration streamlined. Application number allotted at the time of filing the application. Examination of application within seven days and in case there is no conflict, the mark may be registered within a period of one year from the date of filing.

### **THE DESIGN ACT 2000**

Industrial Design is one of the categories of Intellectual Property Rights where the design system focuses on the protection of the aesthetic features of an article derived from its visual appearance. Industrial design is getting the attention of enterprises producing fast moving consumer articles. The registration of a design is valid for 10 years from the date of Application

and this period is further extendable. No protection for a design can be claimed unless the registration is granted under The Design Act of 2000.

The new legislation on design has also brought in important changes such as:

- The definition of design expanded to include composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms in addition to the features of shape and configuration, pattern and ornament.
- New provision for restoration of the lapsed design made enabling the proprietor to apply for extension of copyright within one year from the date on which the design ceases to have effect;
- The ground of invalidity of registered design made a ground of defence in suit for infringement;
- The defendant empowered to challenge the registrability of the design, being not new or original, as a defence to infringement proceedings.

### **THE COPYRIGHT ACT 1957**

Registration of copyright is not compulsory for the protection of copyright. However the registration, if obtained, helps effective enforcement. As per the Indian Copyright Act, the application for Registration of a Copyright in Artistic Work which is used or capable of being used as a trade mark can only be filed if accompanied by a 'no objection certificate' issued by the Registrar of Trademarks. An Application for registration of Copyright in respect of other works can be filed at any time after the creation of the work without any obligation to obtain certificate from the Registrar of Trade Marks.

India is a member of Berne Convention. The Indian Copyright Act provides protection to all such works as are made or first published by an author who is a citizen of convention country. Three dimensional reproduction of two dimensional drawings statutorily recognised to be an infringement of copyright;

- Computer Software protected as literary work;
- Limitation of two years prescribed for version recording in respect of musical works;
- Power of the Copyright Board recognised to fix royalty relating to the broadcasting rights.
- Copyright ceased to subsist if the subject matter is registered or is capable of being registered as a design under the Designs Act;
- Ownership of copyright not required to be proved in case of infringement of musical work and /or cinematographic film,
- The provisions concerning assignment copyright made more elaborate requiring identification of the work, royalty payable, description of the right assigned, period of assignment, territorial extent in the deed of assignment. If territorial extent is not defined it shall be presumed to extent within India. If the period of assignment is not specified, it shall be deemed to be five years from the date of assignment.
- Disputes concerning assignment and royalty is to be adjudicated by the Copyright Board.
- If the assignee fails to exercise the right under the deed of assignment within a period of one year, the assignment lapses.
- The Copyright Board is empowered to revoke the assignment of copyright;
- The Copyright Board empowered to grant compulsory licences in respect of the works withheld from public or unpublished Indian works.

## **THE PATENT ACT 1970**

AS AMENDED BY  
THE PATENT (AMENDMENT) ACT, 2005

The Indian Patent Act is now fully TRIPS compliant and affords protection to process as well as product subject matters provided the invention complies with the standard requirements of novelty, utility and industrial applications. As for now only the process patents were registrable. India being a member of World Trade Organization has joined the Paris Convention and committed itself to grant product patents in respect of drugs, chemicals and food substances per se. To meet its international obligations, The Patents Act, 1970 was amended by the Patent (Amendment) Act, 2005.

The salient points of the new legislation are:

### **SALIENT FEATURES**

- No more mailbox applications
- Pharmaceuticals, chemical & food per se patentable
- Unpatentable invention enlarged
- Rights in patents from the date of publication
- Hardly any pre-grant opposition
- Post grant Opposition introduced
- Divisionals may be filed up to grant of patents on parent application
- Less time for filing requests for Examination

## **PATENTABILITY CRITERION**

- “Intention” means a new product or process involving an inventive step and capable of industrial application.
- “inventive step” means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious by a person skilled in the art;
- “new invention” means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification i.e. the subject matter has not fallen in public domain or that it does not form part of the state of the art;

## **INVENTIONS NOT PATENTABLE (SS. 3 & 4)**

- Frivolous or contrary to natural laws
- Contrary to public order or morality (sex apparatus)
- Mere discovery of scientific principle of law or theory
- Mere discovery of new property
- Mere new use for a known property
- Mere admixture as opposed to synergistic compositions
- Mere arrangement or re-arrangement of known devices
- Method of agriculture or horticulture
- Process for the medicinal, surgical, curative, prophylactic, diagnostic or therapeutic treatment of human and animals
- Mere scheme, rule, performing mental act or method of playing game
- A presentation of information

- Topography of integrated circuits
- Traditional knowledge
- Atomic energy related inventions.

### **PROVISIONAL & COMPLETE SPECIFICATIONS**

- Provisional applications may be filed provided complete is filed within 12 months. No extensions possible.
- Previously, three months extension was available.
- Chemical and food products  
Unpatentable till 31.12.2004  
Patentable w.e.f. 01.01.2005

### **PUBLICATIONS**

- 18 months from the priority date
- Early publication possible on payment of extra fees
- Right to claim damages accrue from the date of publication but right to sue is only upon grant of patent.

### **REQUEST FOR EXAMINATION**

- 36 months from the earliest priority date
- Previously 48 months from the date of filing
- Completely thoughtless---calls for major change of systems in the Offices of practioners and applicants
- PCT National phase applications are left with less than 5 months

- No corresponding foreign application would have been examined;
- No remedy if the date is missed.
- Divisional applications S. 16
- Earlier a divisional had to be filed before acceptance of the patent. Now it can be filed before grant of patent.
- Patent Office refuses to depart from old law and practice

### **CONCEPT OF UNITY OF INVENTION**

- Single invention or a group of inventions linked by a common inventive concept
- Patent Office has no idea how to interpret Section 19 (5)
- Multiple independent claims
- Problems as may be faced by an applicant
- Dual lines in several instances for same action causing major inconvenience to practitioners and applicants.
- Filing assignment: *Earlier: 3+3 months Now: 3 + 1 month*
- Filing details of foreign cases: *Earlier: 3+3 months Now: 3 + 1 month*
- Filing priority documents *Earlier: 3+3 months Now: 3 + 1 month*
- Dual time lines in several instances for same action causing major inconvenience to practitioners and applicant.
- Filing Request for Examination Earlier 48 months from filing date : Now: 36 months from priority Date (Loss of 24 months)
- Dual time lines in several instances for same action causing major inconvenience to practitioners and applicants.
- Placing application in a condition for Grant Earlier: 12 months from FER : Now: 6 + 3 months from PER

### **LITIGATION PRACTICE**

Once the Intellectual Property Right is registered or duly protected, Amarjit & Associates provide complete assistance, advice and support to

their clients to safeguard their interest and to assist them in policing their rights.

The firm has vast experience of over 30 years in conducting litigation for the enforcement of Intellectual Property Right Laws, in India and many foreign countries which includes drafting of pleadings, examination and cross-examination of witnesses and arguing before the Supreme Court of India, High Courts and specialized Tribunals.

Amarjit & Associates also provides a vast range of services, including consultation, drafting of pleadings, examination and cross-examination of witnesses, drafting of applications, appeals, etc.

### **COUNSELLING**

Amarjit & Associates provide counsel and advice from the time the intellectual Property is created or acquired by the clients who seek enforcement of their rights. In order to provide counsel it is necessary to have a good understanding of the local markets as well as the legal aspects. The firm is able to provide effective counseling as they understand the region, the local markets, the procedures at Courts, Trademarks Registry, Patent and Design Office and the Copyright office.

The firms provide special counseling services to local companies interested in foreign markets through their wide network of connections. They advice local clients on the protection of Intellectual Property Rights overseas and also counsel the clients as to how to penetrate into foreign markets and have their presence established overseas.

Foreign clients and attorneys are advised on the acquisition, maintenance and enforcement of Intellectual Property Rights in India. Good advice, strategic and tactical, is crucial for making the right decisions. Proper counseling and advice is the key to obtaining, maintaining and enforcing Intellectual Property Rights.

## **SEMINAR AND I.P. UPDATE**

Depending on the needs of overseas clients and associates, Amarjit & Associates provide lectures in India and abroad about the Indian Laws, prosecution and/or litigation practice.

## **THE TEAM**

Amarjit Singh

Amarjit Singh is a Senior Advocate with 30 years of experience in Intellectual Property Laws including Trade Marks, Copyright, Industrial Designs and Patents. He joined the Bar in 1975 and has been the founder partner of Delhi based intellectual property law firm, Anand & Anand for 23 years. He is also the founder of the law firm Amarjit & Associates having offices at New Delhi (India), New York (U.S.A.) & Zurich (Switzerland). Mr. Singh, a product of Campus Law Center, University of Delhi, achieved a distinction of being the youngest lawyer to have conducted I. P. related cases in almost every state in the country within first ten years of his practice and to have conducted some of the prominent cases in foreign countries including United States, U.K., Germany, Israel, Thailand, Singapore, Indonesia, Egypt and Turkey.

He has a vast experience in conducting litigation for the enforcement of IPR Laws, which includes drafting of pleadings, examination and cross-examination of witnesses and arguing before High Courts and specialized Tribunals.

Mr. Singh participated in various WIPO organized programs on Intellectual Property Laws. He is a faculty member of Bureau of Parliamentary Studies, Lok Sabha Secretariat and has been training members of Parliament of developing countries on legislative skills with special reference to intellectual property laws.

He has regularly been briefing Members of Parliament on new IPR legislation for participation in debates in Lok Sabha and Rajya Sabha. He has also been actively associated with the training of Senior Officers of enforcement agencies.

He is also a faculty member of Institute of Intellectual Property Studies, Mumbai- Hyderabad imparting diploma courses on Patents and Copyright- Entertainment Laws.

He was a special invitee to be a member of Swiss Trade Minister's delegation visiting India for promoting Indo-Swiss business relations. He was nominated as a delegate by the Ministry of Human Resource Development to represent India at a WTO Seminar at Beijing.

He is a regular participant of International Seminars; Conferences organized by International Organizations including WIPO, AIPPI & APAA.

Mr. Singh has been the Vice President of the Indian Chapter of AIPPI, APAA & Intellectual Property Lawyers Association (IPLA).

He also appeared as an expert witness before the Parliamentary Select Committees constituted by the Parliament to suggest legislative changes in Intellectual Property Laws consequent to India becoming member of WTO.

Mr. Singh is also the author of various articles on intellectual property laws and is a regular speaker at various Forums & Seminars organized by Attorneys Associations, Business Forums & International Organization.

He has handled various joint negotiations/agreements on behalf of Foreign/Indian Companies including Airline Projects. Major areas of practice include Joint Venture, Foreign Collaboration, Corporate Strategies, Formation of Companies, various Government Registrations/Clearance and Miscellaneous Government Liaisons.

Mr. Singh has recently been elected as Board member of Global Anti-Counterfeiting Group (GAGC) and Secretary of the Asian Patents Attorneys Association (Indian Group) as well as the Secretary General of the Anti Counterfeiting Group of India affiliated to Global Anti-Counterfeiting Group. He is also the Director of Intellectual Property Attorneys Association (IPLPA) and the Founder Vice-President of Intellectual Property Attorneys Association (IPAA).

Mr. Singh has also been nominated as a member of the INTA – CPR Panel of neutrals as well as a penalist on the WIPO Domain names dispute resolution Panel.

### Gurvinder Singh

Gurvinder Singh a science graduate, an eminent lawyer and a patent attorney. He is a senior associate and has an experience of nearly 18 years in handling civil as well as criminal litigations concerning protection and enforcement of Intellectual Property Rights. He has successfully contested various proceeding on behalf of various national as well as multi-national Corporate Clients. He has also vast experience of organizing, planning and causing search and seizure action in close co-ordination with the Police, customs, and other law enforcement agencies.

### Mahipal Ahluwalia

Mahipal Ahluwalia has a vast experience of nearly 30 years for conducting and handling high profile criminal litigations. He is representing highest executive and legislative leaders of the country involved in criminal and/or political prosecutions.

### Jagjit Singh

Jagjit Singh has an experience of nearly 30 years in conducting civil litigations including Corporate, Contract, Arbitration, Transfer of Properties, Specific Relief, Negotiable Instruments, Rent, Matrimonial, Companies Laws, etc.

### Kuldip Madan

Kuldip Madan is an attorney at law and is duly admitted to New York Bar. He is based in New York office and has vast experience of nearly 28 years for attending to taxation, immigration and I.P. Laws.

### Shabnam Gupta

Shabnam Gupta has an experience of more than 13 years as an in house corporate lawyer dealing with drafting of pleadings, agreements, multi-national commercial agreements, and arbitrations.

### Kanwal D.P. Singh

Kanwal D.P. Singh is an associate lawyer attached with the firm since its inception. She is a faculty member of Amity Law School.

### Shivani Kochhar

Shivani Kochhar is a Law graduate from Delhi University with an experience of almost 7 years in handling, filing and prosecution of trade mark and copyright applications. She is an associate lawyer and has assisted the in-house lawyers as well as senior designated lawyers in infringement proceedings. Ms. Shivani Kochhar has also made in-depth study on the Madrid Protocol and Data Exclusivity and is an author of various articles on the subject. She is also a registered Patent Agent and a member executive of the APAA.

### Gurpreet Singh Monga

Gurpreet Singh Monga is an associate lawyer with an experience of more than 3 years in the preparation, filing and prosecution of trade mark applications. He has also been actively involved in IPR infringement cases as an associate and is responsible for maintaining a data of trade mark applications. Gurpreet is also a Master of Science in Information and Technology.

### Brijinder Singh Loomba

Mr. Brijinder Singh Loomba is one of the member of the zonal team of the firm based in Chandigarh. He has four years of practical experience in handling IPR litigation and is Guest Faculty with CDTS in Cyber Crime

Cell under Union Home Ministry. He has conducted seminars with SPIC Microsoft Center under the aegis of UT Administration on Cyber Laws.

### Roop Loomba

Roop Loomba is a science as well as law graduate and has four years of experience in handling IPR related matters at the level of registering authority and also at the level of civil/criminal courts. She has conducted seminars for creating awareness of IPR Laws and has presented papers on E-commerce in Semi Conductor, Cyber Crime. She conducted seminar with I.T. Deptt., Government of Haryana on Cyber Laws. She has prepared and proposed many projects on IPR's, Cyber Laws at the Government level.

### Geeta Gulati

Geeta Gulati is a science as well as law graduate and has four years of experience in handling IPR related matters. She has also been actively involved in holding seminars/interactive sessions with UT Administration, IT Deptt. Of Haryana, Semi-Conductor, Guest Faculty in CTDS and author of many articles.

In addition, the firm has other associate junior lawyers who are assisting the seniors for the effective discharge of their day to day professional obligations.

The firm with experienced, energetic, dedicated and young team of associates and a supporting staff is the fastest growing and meteorically rising firm in the region. The firm due to its immense client base and client loyalty has acquired a wealth of experience that is rare amongst other firms of the region.

# AMARJIT & ASSOCIATES

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