

INTELLECTUAL PROPERTY LAW IN INDIA

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Online Training Programme On

Intellectual Property Disputes: Jurisdiction, Interim Injunctions and Pre-Institution Mediation under Section 12A

Judicial Academy, Jharkhand

By Haridutt Mishra, Advocate & Mediator, Founder of Track Second, Partner at AARYAVARTT

Trade Marks · Patents · Copyright · Designs · GI · Trade Secrets

What is Intellectual Property?

Definition · Characteristics · Novelty Requirement · Why Protection Matters

Definition

Intellectual Property refers to creations of the human mind — inventions, literary works, symbols, names, images, and designs — to which exclusive legal rights may attach.

TRIPS Agreement, Art. 1 · WIPO Convention, Art. 2(viii)

Novelty Requirement

IP protection requires that the creation be **NEW** — not already in the public domain. Novelty prevents monopolisation of existing knowledge. Different rights define novelty differently.

Patent: Not known · **TM:** Distinctive · **Design:** Not published

Core Characteristics of Intellectual Property

Intangible: Cannot be touched, but can be owned, licensed, and assigned.

Territorial: Rights are jurisdiction-specific; protection in India does not extend abroad automatically.

Time-Limited: Patent (20 yrs), Copyright (60 yrs p.m.a.), Design (15 yrs). Trademarks can be renewed indefinitely.

Exclusive: Rights exclude others from use **without licence or consent**.

Note: NOVELTY is the foundation of IP validity. In patent disputes, a court must first determine whether the claimed invention was already in the public domain before examining infringement.

Understanding Intellectual Property

Why promote and protect intellectual property?

Reward Innovation

Grant limited exclusive rights to creators and innovators to incentivize effort

One Product, Many Rights

Patent + Trademark + Copyright + Design + Trade Secret can coexist simultaneously

Balance Public Interest

the progress and well-being of humanity rests on its capacity for new creations in the areas of technology and culture.

Legal Protection

the legal protection of these new creations encourages the expenditure of additional resources, which leads to further innovation.

Types of Intellectual Property in India

Trade Marks

Trade Marks Act 1999

Badge of origin
Commercial identity

Patents

Patents Act 1970

Inventions
Novelty + Inventive step

Copyright

Copyright Act 1957

Expression of ideas
Auto on creation

Designs

Designs Act 2000

Appearance
Aesthetic features

GI

GI Act 1999

Geographic reputation
Collective right

Trade Secrets

Contract/Equity

Confidential info
No registration needed

Trademark

S.2(1)(zb)- Trademark:

- Capable of being represented Graphically
- Capable of distinguishing the goods or services of one person from those of other

S.2(1)(m)- Mark:

Traditional marks — word, name, signature, letters, numerals

Visual elements — device, label, brand, heading, ticket

Non-traditional marks — shape of goods, packaging, combination of colours

Combinations — any mix of the above elements

WIPO

Trademarks may be one or a combination of words, letters, and numerals.

They may consist of drawings, symbols, three dimensional signs such as the shape and packaging of goods, audible signs such as music or vocal sounds, fragrances, or colors used as distinguishing features.

Types of the Trademarks

Word Mark: Text/letters/words

TATA, AMUL, SAMSUNG

Device mark/Composite mark:



Section 15 & 17:

Section 15 allows registration of trademark **parts** if each is separately distinctive.

Section 17 grants protection to the **mark as a whole**, not individual elements.

Patent

S.2(1)(m) - Patent:

A patent is an exclusive right granted by a Government for an **Invention** - that is **New**, involves an **Inventive Step** and is capable of **Industrial Application**.

New or Novel– include some new characteristic which is not known to public before the date of filing.

Inventive Step- which could not be obviously deduced by a person with average knowledge of the technical field.

Utility – Invention useful to industry or public at large

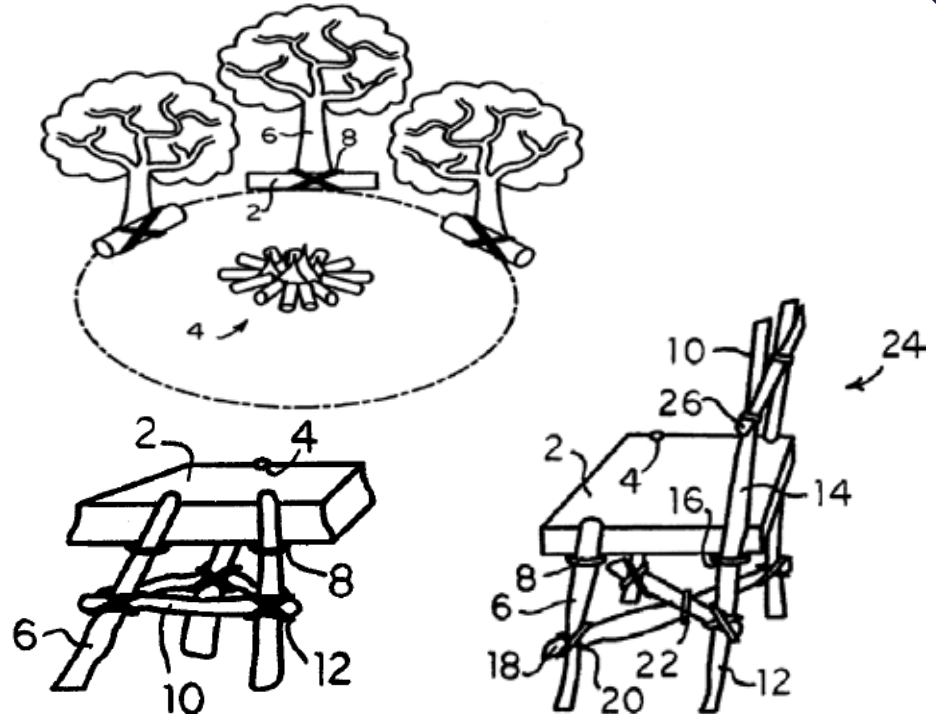


Fig. 1

Fig. 2

Copyright

S.14: Copyright

exclusive right to do or authorise specific acts in relation to a work

—such as reproducing, publishing, performing, communicating, translating, adapting, or commercially renting it

—depending on the category of the work.

Category of the work: R.69

- a) Literary Work
- b) Musical Work
- c) Artistic Work
- d) Cinematograph Films
- e) Sound Recordings
- f) Computer Programmes

Copyright does **NOT** protect **ideas** or mere facts.

Copyright protects the way in which ideas are expressed.



An **idea** (such as a dog playing with a ball) can be expressed in many different ways.

Design

S.2(1)(d): Design

Only the features of

Shape, Configuration, pattern, ornament or composition of lines or colour

Applied to any article

2D or 3D or both forms

By any industrial process of means

Which in finish article

Appeal to and are judged solely by the eye.

Section 4 of the Designs Act:

- a) Is new or original
- b) Has not been shared with the public anywhere
- c) Is not clearly different from a known design
- d) Is not a mix of known designs
- e) Does not include offensive material



What is Infringement?

Infringement is the unauthorised exercise of an exclusive right vested in an IP owner, without licence or legal justification, causing actionable harm.

S. 29: Infringement

Only Registered trademark

Owner Exclusive right to use the mark

S.29(1) Identical mark, identical goods

S.29(2)(a) Identical mark, similar goods

S.29(2)(b) Similar mark, identical goods

S.29(2)(c) Similar mark, similar goods

S.29(4) Well-known mark - Dilution /unfair advantage

Tests: Confusion, Similarity,
unfair advantage

Ex: Liv.52 Vs. Liv-82



Patent

Section 48 Patents Act 1970

Only Registered Patent

Making, using, selling,

importing patented product/process

without licence during patent term.

What is Infringement?

Infringement is the unauthorised exercise of an exclusive right vested in an IP owner, without licence or legal justification, causing actionable harm.

Design- S.22

Only Registered Design

Any fraudulent or obvious imitation of a registered design applied to the same class of articles amounts to **piracy of design**.

Making, importing, selling, or publishing such infringing articles **without consent** of the registered proprietor is prohibited.

The registered proprietor is entitled to **statutory remedies**, including monetary recovery or injunction, against the infringer.

Copyright- S.51

Copyright is infringed when someone, without permission, does any act that only the copyright owner is legally entitled to do.

Selling, distributing, importing, or possessing infringing copies for commercial purposes also amounts to infringement.

Permitting a place to be used for unauthorised public communication or performance of a copyrighted work constitutes infringement if done knowingly.

Test: Substantial reproduction of protected expression

Passing Off vs. Infringement — Trademark

📌 **CRITICAL:** Passing Off exists **ONLY** in Trade Mark law. It does **NOT** apply to Patents or Copyright or Design.

Infringement (Statutory)

Requires registered right. Protects the mark as registered. Defendant need not cause actual confusion. Strict liability — no need to prove intent.

Applies to: TM · Patent · Copyright · Design · GI

Passing Off (Common Law)

No registration needed. Protects goodwill in name/trade dress. Must prove: Goodwill + Misrepresentation + Damage. Intent not required but relevant.

ONLY applies to: Trade Mark / Trade Identity

Illustrative Examples

Passing Off (TM only): “Bikanervala” vs “Bikaner Vala” — even without registration, established goodwill in name is protected from a trader misrepresenting his goods as those of the plaintiff. [Reckitt & Colman v. Borden, 1990]

TM Infringement: Use of “BENZ” on perfume — well-known mark infringed even on dissimilar goods [S.29(4)].

No Passing Off in Patents: Making a patented drug without licence is patent infringement (S.48). There is no “passing off” in patent law — patents protect technology, not commercial identity.

No Passing Off in Copyright: Copying a book is copyright infringement (S.51). Copyright does not protect commercial reputation — passing off is inapplicable.

When & Where to File for Infringement

Limitation Period • Forum Selection • Special IP Courts • Commercial Courts Act

WHEN to File

Limitation Act 1963, Art. 113:

3 years from date of infringement (or knowledge thereof).

Continuing Infringement:

Fresh cause of action accrues each day; limitation runs from last act.

Interim Relief:

File immediately on discovery — delay defeats urgency and undermines balance of convenience.

Criminal Complaint:

TM (S.103) and Copyright (S.63): No specific limitation; general Cr.P.C. period applies.

WHERE to File

Commercial Courts Act 2015:

Commercial Dispute: S.2(1)(c) (xvii)

- a) Related to Registered and Unregistered
- b) Trademarks; Copyright; Patent; Design; domain name; Geographical Indication and semiconductor integrated circuits

S.3(3): The State Government shall, with the concurrence of the Chief Justice of the High Court, appoint one or more persons having experience in dealing with commercial disputes to be the Judge or Judges, of a Commercial Court, from amongst the cadre of Higher Judicial Service in the State.

Jurisdiction in IP Disputes

IP Right	Section	Jurisdiction	Court
Trademark	S.134	where Plaintiff reside or carry on business	District Court having jurisdiction, or Commercial Court if value exceeds ₹3 lakh+.
Passing off	S.20 CPC	Where defendant resides or carries on business Where infringement occurred - cause of action — wholly or in part	District Court having jurisdiction, or Commercial Court if value exceeds ₹3 lakh+.
Patent	S.104	Section 20 CPC governs.	District Court having jurisdiction, or Commercial Court if value exceeds ₹3 lakh+.
Copyright	S.62	where Plaintiff reside or carry on business	District Court having jurisdiction, or Commercial Court if value exceeds ₹3 lakh+.
Design	S.20 CPC S.22 Design	Where defendant resides or carries on business Where infringement occurred - cause of action — wholly or in part	2nd proviso, S.22(2) — no court below District Judge
Domain Dispute	S.134 Trademark S.20CPC	Domain disputes are treated as trademark disputes (passing off).	District Court having jurisdiction, or Commercial Court if value exceeds ₹3 lakh+.

Section 12A & Mediation in IP Disputes

S.12A Commercial Courts Act: Pre-institution mediation is generally mandatory — except where the plaintiff seeks urgent interim relief (Patil Automation v. Rakheja Engineers)

S.12A EXEMPT — Urgent Relief Justified

- Counterfeit goods flooding the market
- Trademark infringement causing immediate confusion
- Patent launch disputes (pharma)
- Imminent film or broadcast piracy
- Trade secret on verge of disclosure
- Domain name causing ongoing damage

S.12A APPLIES — Mediation Suitable

- Technology / copyright licensing disputes
- Royalty payment disagreements
- Franchise or trademark coexistence
- No urgent injunction required
- Ongoing commercial relationship
- Software or IP licensing terms

A judicial determination creates winners and losers. A mediated settlement may create value for both parties.

Judge's Checklist — Infringement Suit

Three Threshold Checks Before Proceeding on Merits

1. Section 12A, CCA

Pre-Institution Mediation

Is “urgent interim relief” genuinely sought, or pleaded only to bypass mediation?

If no urgency, has plaintiff exhausted Section 12A mediation before filing?

Non-compliance renders the suit non-maintainable — verify mediation certificate on record.

2. Order XXXIX CPC

Interim Injunction Test

Prima facie case — is a registered/valid right shown and is it being violated?

Balance of convenience — who suffers greater hardship if relief is granted/refused?

Irreparable injury — would damages alone be an adequate remedy?

Ex-parte order? Record reasons in writing (R.3 proviso).

3. Jurisdiction

Territorial — Sec 134 / Sec 62 / CPC as applicable

Pecuniary — does the suit valuation fall within this court's limits?

Forum — is this matter reserved for a Commercial Court / IPD of the High Court?

Section 21 — was any jurisdiction objection raised at the earliest opportunity?

Interim Relief — The Triple Test

I Prima Facie Case

The plaintiff must demonstrate that they have a bona fide case that has a reasonable probability of success at trial.

The plaintiff usually shows ownership of a valid, registered IP right and clear evidence of an ongoing or imminent infringement by the defendant.

II Balance of Convenience

Court compares relative hardship to both sides.

Would grant or refusal cause more harm?

who has been in the market longer.

III Irreparable Injury

Plaintiff must show that refusal of injunction will cause harm that money cannot compensate even if they ultimately win.

Loss of goodwill or reputation
Trademark dilution or loss of distinctiveness
Market erosion or loss of exclusivity

Anton Piller Order

Where evidence may be destroyed — court authorises inspection & seizure before destruction occurs.
Requires strong prima facie case + real risk of destruction.



O39R3-Ex-Parte Injunction

Plaintiff proves that waiting to issue notice would cause a delay that completely defeats the purpose of the injunction.

- court must record its reasons in writing
- applicant must immediately serve all suit documents to the opposite party

John Doe Order

Where infringers are unidentified — court issues orders against unknown persons. Common in film piracy, broadcast rights, online copyright infringement.

THANK YOU!