

Public Funded Intellectual Property: Protection of Copyright and Trademark

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Introduction

- IP from public funded projects
- Copyright protection of Government works
- Problems of including all public funded works in the Bill
- Trademark from public funded projects ?
- Challenges of encouraging innovation in India

IP under the Bill

- Section 2(c) of the Bill - “intellectual property” means any right to intangible property, including, trade mark, patent, design, and plant variety as defined under the Copyright Act, 1957, the Patents Act, 1970, the Designs Act, 2000, the Semiconductor Integrated Circuits Layout-Design Act, 2000, and the Protection of Plant Varieties and Farmers’ Rights Act, 2001”

Public funded IP

- Section 2(g) of the Bill - “public funded intellectual property” means intellectual property which is the outcome of research and development for which the Government has provided grant under section 3”
- Whether Public funded IP confined to outcome of R&D from science and technology?

Public funded IP

- Public funding is available for all areas of research
 - Science and social science research
- Works protected under Copyright is one of the major out come of public funded research
 - Literary works
 - Research publications in all fields
 - Publications of results of science and technology disclosing new inventions

Government Work under Copyright Act

- Whether public funded works Government works as per Copyright Act?
- Section 17 - Author is the first owner of Copyright
- Section 2 (k) "Government work" means a work which is made or published by or under the direction or control of-
 - (i) the Government or any department of the Government; -----

Government Work under Copyright Act

- Section 17(d) - in the case of a Government work, Government shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein
 - Whether the public funded work “done under the direction or control” of the Government?

Government Work under Copyright Act

- Agarwala Publishing Co., v. BHS Education, AIR 1967 All 91
 - “The phrase ‘under the direction or control’ of the Board obviously suggest something more than a mere initial impetus of this kind and implies that the whole process of preparation must be directed by the Board”
 - Need to have a relationship of master and servant
 - Whether there exist a freedom to use their own skill and discretion
 - Held that it is not a Government Work

Government Work under Copyright Act

- Rupender Kashyap v. Jiwan Publishing House, MANU/DE/0749/1996
 - Held the question paper prepared for CBSE Government work
 - Based on the terms and conditions of the CBSE held that the question paper setter is under the direction and control of CBSE
 - Not necessary that there must be a relationship

Copyright of works created during employment

- Section 17 (c) in the case of a work made in the course of the author s employment under a contract of service or apprenticeship, to which clause (a) or clause (b) does not apply, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein”
- Whether public funded works, “works made during employment”?

Ownership of Public funded Copyright Work

- Based on the nature of the terms and conditions of the funding
 - Can be a Government work owned by the Government
 - Can be a work of Institution owned by the institution
 - Owned by the creator of the work
- Whether the Bill intend to cover all forms of works?

Protection of Public Funded Works under the Bill

- Section 5 of the Bill envisages the ownership of public funded IP on the recipient or Government
- Section 6 prevent disclosure before protection
 - publication of scientific works on which there is an invention, design or new plant variety where registration is mandatory
- Section 7 obligates taking IP protection
 - Not applicable to copyright since protection is automatic

Protection of Public Funded Works under the Bill

- Section 9 obligate the creator to disclose the IP to the institution
 - Need prior permission before publication
- Whether these provisions applicable to all public funded works?
 - Limited to those works that may result in patent, design, plant varieties etc., that needs registration for protection.

Protection of Public Funded Works under the Bill

- The main thrust of the Bill is regarding IP that require mandatory registration for protection
- Gives an impression that works that has no relation with IP that require registration is not covered in the Bill
- There is lack of clarity because of the broad definition of IP and public funded IP in the Bill

Implications of covering works

- If all works are included it restricts the freedom of the researcher to publish the works
 - Restricts the main objectives of public funding
 - May conflict with section 17 of the Copyright Act on ownership of copyright and freedom of the creator to publish the work
 - Need for clarity as to the nature of works covered under this section

Public Funded Trademark

- Is there any possibility of a trademark being created out of the research funding?
- There is no need for registration of a trademark for protection in India or other countries
- Does the Bill envisage the coverage of trademark?
- Need to remove trademark from the definition

Challenges

- Presumptions of the Bill
 - All or substantial public funded research projects result in creation of IP – inventions?
 - Institutions create IP but lack of legal obligation results in not protecting IP?
 - Obligating IP protection will increase innovation?
 - Mandatory sharing of benefit will act as an incentive to innovate ?
 - There is lack of institutional mechanism to protected IP

Challenges

- Obligations under the Bill only if IP is created
- If no IP is created then the institution and creator has no responsibility in the utilization of the public fund
 - There is no obligation to create IP under the Bill
 - Only moral responsibility and no legal obligation
- Need to insist for obligation to create IP from public funded research projects

Challenges

- Need to look at the nature of the research for which funding is given
 - Does the proposed project ensure some form of IP creation?
 - Is there a mandate that the funding agency should insist that the research proposal envisage IP creation?
 - Do we have a mechanism under the Government Funding system to monitor this?
 - Explanation from the institutions the reasons for not creating IP

Challenges

- Need to ensure quality of the IP protected
 - The obligation is to ensure IP protection
 - Mandate that all the IP protected is put into commercialization
 - No control on the quality of the IP protected
 - Check to prevent “perishing by patenting”
 - Should not result in generating employment for IP lawyers at the expense of government funds
 - Prevent misuse of funds (social waste) for IP protection and maintenance

Challenges

- Need to create more specific obligation to explain why there is no commercialization?
- Obligation not to maintain the IP if there is no commercialization even after expiration of the half of the term of protection

Challenges

- The main objective of the legislation should be to create legal obligation to generate socially relevant and useful IP necessary for the socio-economic development of the large section of the Indian society rather than mere protection of IP