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Copyright

India

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LexOrbis Intellectual Property Practice

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1. General Information

1.1 Governing Copyright Statute

The Copyright Act 1957 (the “Act”), supported by the Copyright Rules 2013 (the “Rules”), is the governing law for copyright protection in India. The Act and the Rules are easily accessible at copyright.gov.in or go direct to the Act or the Rules. Apart from the statute, the judicial decisions by the Supreme Court of India and the different state high courts play a significant role in the development of copyright jurisprudence.

1.2 Berne Convention

India is a member of the Berne Convention (1971 text). In addition, India is also a member of the following international conventions on copyright and related rights:

- the Universal Copyright Convention;
- the Convention for the Protection of Producers of Phonograms against Unauthorised Duplication of their Phonograms;
- the Multilateral Convention for the Avoidance of Double Taxation of Copyright Royalties; and
- the Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement.

1.3 Foreign Copyright Holders

The copyright of works of countries mentioned in the International Copyright Order is protected in India, with the same copyright protection as Indian works.

2. Copyrighted Works

2.1 Copyright Protection: Essential Elements

The most significant requirement for copyright protection is “originality”. The word “original” has not been defined in the Act but it is understood to mean a work that “owes its origin to the author”. The work must originate from the skill and labour of the author and must not be a copy of any other work. Another requirement of copyright protection is the fixation of the work in a tangible form.

The “originality” requirement is applicable to literary, dramatic, musical and artistic works but not to cinematographic films and sound recordings, as the last two are made using the former categories of works. Though there is no express stipulation regarding “originality” in respect of cinematographic films and sound recordings, copyright does not subsist in a cinematographic film if a substantial part of that film is an infringement of the copyright of any other work. Likewise, copyright does not subsist in a sound recording made in respect of a literary, dramatic or

musical work if, in making the sound recording, copyright in some other work has been infringed.

2.2 Copyright Protection: Special Notice and Registration of Works

Acquisition of copyright is automatic, and the right comes into existence as soon as the work is created. However, securing a formal registration is advisable for enforcement purposes because the registration certificate acts as prima facie evidence of ownership of copyright. The Register of Copyrights is prima facie evidence of the particulars entered therein.

The Registrar of Copyrights maintains a list of all registered works and this is available for public inspection.

2.3 Categories of Copyrightable Works

In India, copyright can only subsist in original literary, dramatic, musical and artistic works, and through them, cinematographic films and sound recordings. No straitjacket definition is given for literary works and it merely states in the Act that literary work includes computer programs, tables and compilations, including computer databases. The definitions of dramatic work and artistic work are also inclusive in nature. Dramatic work has been defined as including any piece of recitation, choreographic work or entertainment in dumb show (eg, mime), the scenic arrangement or acting form of which is fixed in writing or otherwise. Similarly, artistic work is also defined in inclusive terms and states that it means a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, a work of architecture and any other work of artistic craftsmanship. The word “cinematograph” in cinematographic films has also been defined to include any works produced using a process analogous to cinematography. Musical works include graphical notations of music and sound recordings mean a recording of sounds from which such sound may be produced regardless of the medium on which such recording is made or the method by which such sounds are produced.

The law does not recognise non-categorised works and any work can only be protected if it falls into one of the above categories of work. The work needs to be fixed in a tangible medium of expression as the copyright law protects only expressions and not ideas.

2.4 Copyright Protection: Software

Computer software or programs are treated as literary works and protected under the Copyright Act. For literary work, copyright means the exclusive right:

- to reproduce the work;
- to issue copies of the work to the public;
- to perform the work in public;

- to communicate the work to the public;
- to make a cinematographic film or sound recording in respect of the work;
- to make any translation of the work; or
- to make any adaptation of the work.

In addition to the above rights, the owner of the copyright of a computer program enjoys the right to sell or give it on hire, or offer it for sale or hire, regardless of whether such a copy has been sold or given on hire on a previous occasion. To register computer software, the applicant needs to provide the “source code” and “object code” to the copyright office in addition to other information.

2.5 Copyright Protection: Databases

Databases are protected under copyright law as literary works. However, to obtain copyright protection for tables, compilations and computer databases, the work must exhibit some creativity or originality in the selection or arrangement of its contents. If negligible labour and skill were required to make the selection and compile the items that form the work, then no copyright can subsist in the work.

2.6 Copyright Protection: Industrial Design

Copyright protection for a design may be claimed under the Act if the design qualified to be registered under the Designs Act but was not registered. However, in such cases, protection is limited and expires once the design has been applied to more than 50 articles by an industrial process. The judgment of a division bench of Delhi High Court in *Microfibres Inc v Girdhar & Co* (2009) provides clarity with respect to the conflict between “original artistic work” as defined under the Act and “design” as defined in the Designs Act. It was held that copyright would exist in the original work of art and the author or copyright holder would continue enjoying the longer protection granted under the Act in respect of the original artistic work. The court held that the legislative intent was to grant greater protection to original, purely artistic works (eg, paintings and sculptures) and lesser protection to design activity which is commercial in nature. The protection accorded to a work which is commercial in nature is lesser than, and not to be equated with, the protection granted to a work of pure art.

2.7 Copyright Protection: Distinct Categories

The work needs to fall into one of the following categories to be protected under copyright law:

- original literary, dramatic, musical and artistic works;
- cinematographic films; or
- sound recordings.

Fictional characters – the images of fictional characters can be protected as “artistic work”.

TV formats, etc – TV formats per se are not protected under the copyright law. However, they can be protected as a concept note, provided they are written in a unique and detailed manner. Concept notes can be protected under “literary work”.

Sports events – the video of a sporting event can be protected as a cinematographic film.

Advertising copy and product labels – labels can be protected as artistic work and the writing on advertising material can be protected as literary work.

Museum exhibitions – these can be protected as a work of architecture under the category of artistic work.

Websites – the materials available on a website can be protected as either a literary work or an artistic work, depending on the content.

Recipes – these may not get copyright protection. However, a cookbook having both textual and illustrative elements can be protected.

Perfumes – these cannot be protected under copyright law.

Maps – these can be protected as artistic works.

3. Authorship and Copyright Ownership

3.1 Authorship

The author, who creates the work, is the first owner of copyright in a work. The first owner for each category of work will be as follows:

- the author/creator in respect of a literary or dramatic work;
- the composer in respect of a musical work;
- the artist in respect of an artistic work (“artistic work” includes a painting, sculpture, drawing, engraving, photograph, work of architecture and any other work of artistic craftsmanship);
- the person taking the photograph in respect of a photograph;
- the producer, in relation to a cinematographic film or sound recording; and
- the person who causes the creation of a work in the case of any literary, dramatic, musical or artistic work which is computer-generated.

Where the work is a public speech or address, the person who delivers such work in public shall be the first owner of the copyright therein. However, if such work is made/delivered by a person on behalf of another person, such other person on whose behalf the work is made or delivered will be the first owner.

3.2 Joint Authorship

In India, the Act recognises the concept of a “work of joint authorship”, which means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author(s). The courts in India have not yet fully defined and determined what amounts to an active and close intellectual collaboration, which is essential in the case of claiming joint authorship. In the case of *Angath Arts Private Limited v Century Communications Ltd and Anr* 2008(3) ARBLR 197(Bom), the High Court of Bombay held that the “joint owner of a copyright cannot, without the consent of the other joint owner, grant a licence or interest in the copyright to a third party”. Furthermore, in the case of a work of joint authorship, all the authors (two or more) must individually satisfy the conditions essential for subsistence of copyright in the work. Joint authors enjoy all the rights granted by the Act, including bringing a suit for infringement and being entitled to relief such as an injunction, damages, account of profits, etc. The term of copyright of a work of joint authorship is calculated in relation to the longest-lived author.

3.3 Copyright Protection: Anonymous or Pseudonymous Works

When a work is published anonymously or pseudonymously, and the real name of the author remains undisclosed, copyright subsists for 60 years from the year after the work is published. However, if the author’s real name is disclosed within this period, copyright subsists for 60 years from the year after the author dies.

The Act also recognises orphan works. Where the owner of the copyright in a work cannot be found, any person may apply to the Appellate Board for a licence to publish or communicate such work, or a translation thereof in any language, to the public.

3.4 Collective Works

A collective work is a compilation in which several contributions, constituting separate and independent works in themselves, are assembled into a collective whole. A collective work covers the copyrightable authorship in the selection, co-ordination or arrangement of the work.

3.5 Corporate Authorship

An author needs to be a natural person, which means, a corporation cannot be an author. However, it can be an applicant and owner of the copyright.

There is a difference between the copyright ownership principles pertaining to works created by employees on one hand and independent consultants/freelance workers on the other hand. In the case of employment contracts (contracts of service), the general rule is that the employer shall have copyright in the work created/authored by an employee in the course of employment, unless there happens to be an agreement to the contrary. However, in the case of a work-for-hire contract (contract for services), the copyright in the work generally remains vested with the author/creator of the work, unless the rights are assigned in favour of the commissioner in the form of a written and duly executed document/assignment agreement. However, specifically in the case of a photograph, painting, portrait, engraving or cinematographic film made or created for valuable consideration, the person who has commissioned such work shall be the first owner of the copyright therein (in the absence of any agreement to the contrary).

Parties are free to enter into contracts which determine the ownership of the copyright vested in the work created. In the case of employment contracts, the general principle is that the employer is the owner of the copyright in the case of work created in the course of employment; however, if the employment agreement states otherwise, the agreement takes precedence over the general rule.

In the case of a work made or first published under the direction and control of a public undertaking, such public undertaking shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

4. Scope of Copyright Protection

4.1 Economic Rights of the Copyright Owner

Section 14 of the Act defines the term “copyright” to mean the exclusive right to do or authorise the doing of the following acts in respect of a work or any substantial part thereof.

In the case of a literary, dramatic or musical work (except a computer program):

- reproducing the work in any material form, which includes storing it in any medium by electronic means;
- issuing copies of the work to the public which are not already in circulation;

- performing the work in public or communicating it to the public;
- making any cinematographic film or sound recording in respect of the work; and/or
- making any translation or adaptation of the work, or doing any of the above acts in relation to translation and adaptation.

In the case of a computer program:

- to do any of the acts specified in respect of a literary, dramatic or musical work; and/or
- to sell or give on commercial rental, or offer for sale or for commercial rental, any copy of the computer program; however, such commercial rental does not apply in respect of computer programs where the program itself is not the essential object of the rental.

In the case of an artistic work:

- reproducing the work in any material form including depiction in three dimensions of a two-dimensional work or in two dimensions of a three-dimensional work;
- communicating the work to the public;
- issuing copies of the work which are not already in existence to the public;
- including the work in any cinematographic film; and/or
- making an adaptation of the work, or doing any of the above acts in relation to an adaptation of the work.

In the case of a cinematographic film:

- making a copy of the film including a photograph of any image forming a part thereof, or storing it in any medium by electronic or other means;
- to sell or give on commercial rental, or offer for sale or for such rental, any copy of the film; and/or
- to sell or give on commercial rental, or offer for sale or for such rental, any copy of the film, regardless of whether such copy has been sold or given on hire on previous occasions.

In the case of a sound recording:

- to make any other sound recording embodying it, including storing it in any medium by electronic or other means;
- to sell or give on hire, or offer for sale or hire, any copy of the sound recording; and/or
- to communicate the sound recording to the public.

The duration of copyright depends upon the kind of work. The term of protection for different kinds of work is as follows:

- literary, artistic, musical and dramatic works – life of author plus 60 years from the beginning of the calendar year which follows the year in which the author died;
- sound recording – 60 years from the beginning of the calendar year which follows the year in which the sound recording was published; and
- cinematographic film – 60 years from the beginning of the calendar year which follows the year in which the cinematographic film was published.

4.2 Alienable Rights

Economic rights can be transferred/assigned or licensed.

The owner of the copyright of a work has the right to assign their copyright to any other person. The effect of assignment is that the assignee becomes the new owner of all the rights related to the copyright of the assigned work. The assignment of copyright is valid only if it is in writing and signed by the assignor or their duly authorised agent. The assignment of a copyright in a work should identify the work and specify the kind of rights assigned and the duration and territorial extent of such assignment. Furthermore, it should specify the amount of the royalty/consideration payable, if any, to the author or the author's legal heirs during the continuance of assignment. The assignment will be subject to revision, extension or termination on terms mutually agreed upon by the parties.

A licence is the authorisation granted by the right-owner in respect of the usage of a copyrighted work. The owner of a copyright in any existing work or the prospective owner of a copyright in any future work may grant any interest in the right by licence in writing by the owner or by their duly authorised agent. The formalities required for assignment of copyright also apply to licensing of the copyright.

4.3 Transmissible Rights

If the owner of the copyright dies, the economic rights in the copyright are transferred to their legal heirs as per the applicable succession laws in case of intestate succession, or to the identified individual as per the will of the copyright owner.

4.4 Transfer of Rights

See 4.2 Alienable Rights.

There are no minimum age or competency requirements for registering, exercising or transferring rights under the Act. However, the general principles of competency will apply in the case of any contracts for exercising, licensing or transferring/assigning the copyright. Therefore, neither party should be a minor or of unsound mind. The principles of free consent, lawful consideration and lawful object also apply.

4.5 Copyright Exhaustion Doctrine

There are certain recognised circumstances where subsequent dealings in works cannot be restrained by the copyright owner. More particularly, in the case of literary (not being a computer program), dramatic, artistic or musical works, a copy of the work which has been sold even once, or is otherwise already in circulation, cannot be restrained by the copyright owner from being issued to the public. This concept is also referred to as the “principle of exhaustion”.

As far as parallel importation is concerned, there has been much debate and deliberation as to whether India should follow the doctrine of “national exhaustion” or “international exhaustion”. At the time of writing this chapter, India follows the national exhaustion principle owing to a catena of judgments in this regard.

4.6 Moral Rights of the Copyright Owner

The moral rights of an author are duly recognised and protected under law, whereby an author can claim authorship of a work irrespective of any subsequent assignment of copyright therein. Moreover, these rights serve to protect against any distortion, mutilation, modification or degradation of the work affecting the author’s honour or reputation, even after the expiration of the term of copyright and can thus be exercised also by the author’s legal heirs/representatives. Moral rights, which are independent of the author’s copyright, can be understood as the author’s right to paternity and integrity with respect to the work. These special rights of an author cannot be assigned; however, as to whether the author may waive or relinquish them remains debatable, as the Act does not specifically cover such a scenario. However, in the case of *Sartaj Singh Pannu v Gurbani Media Pvt Ltd and Ors*, 2015, the court observed that if a waiver of moral rights with regard to credit/paternity/authorship is voluntary, the same would not be contrary to public policy and would thus be permissible. As such, waiving a moral right may be permissible on a case-by-case basis, especially if it is not in conflict with public policy.

5. Copyright Management Systems

5.1 Anti-circumvention Right

Section 65A of the Act was introduced in 2012 to effect Article 11 of the WIPO Copyright Treaty.

Section 65A provides that any person who circumvents an effective technological measure applied for the purpose of protecting any of the rights conferred by the Act, with the intention of infringing on such rights, may be punished with up to two years’ imprisonment and shall also be liable to pay a fine.

However, there is nothing to prevent any person from:

- doing anything referred to therein for a purpose not expressly prohibited by the Act, provided that any person facilitating circumvention by another person of a technological measure for such a purpose shall maintain a complete record of such other person including their name, address and all relevant particulars necessary to identify them and the purpose for which they have been facilitated;
- doing anything necessary to conduct encryption research using a lawfully obtained encrypted copy;
- conducting any lawful investigation;
- doing anything necessary for the purpose of testing the security of a computer system or a computer network with the authorisation of its owner or operator;
- doing anything necessary to circumvent technological measures intended for identification or surveillance of a user; or
- taking measures necessary in the interest of national security.

5.2 Legal Remedies for Copyright Management Information

Section 65B of the Act was introduced in 2012 to effect Article 11 of the WIPO Copyright Treaty.

Section 65B provides that any person, who knowingly:

- removes or alters any rights management information without authority; or
- distributes, imports for distribution, broadcasts or communicates to the public, without authority, copies of any work, or performance knowing that electronic rights management information has been removed or altered without authority;

may be punished with up to two years’ imprisonment and shall also be liable to pay a fine.

If the rights management information in any work is tampered with, the owner of copyright in such work may also avail civil remedies against the persons responsible for such acts.

6. Collectives

6.1 Collective Rights Management

The 1994 amendment in the copyright statute extended the operation of legal provisions relating to collective licensing bodies called copyright societies to all rights relating to all domains of works.

Presently, the following three copyright societies are registered in India:

- the Indian Reprographic Rights Organisation (IRRO) for Reprographic (photocopying) works;
- the Indian Singers Rights Association (ISRA) registered for performers' (singers') rights; and
- the Indian Performing Rights Society Limited (IPRS) for literary works associated with musical works.

The re-registration of Phonographic Performance Limited (PPL) for sound recordings is pending.

Furthermore, the following applications for registration as a copyright society are pending:

- the Recorded Music Performance (RMPL) for sound recordings;
- the Cinefil Producers Performance Limited (CINEFIL) for cinematographic films; and
- the Screenwriters Association of India (SRAI) for literary works.

6.2 Collecting Society

A copyright society may:

- issue licences in respect of the rights administered by the society;
- collect fees in pursuance of such licences; and
- distribute such fees among copyright owners, after deducting administrative expenses.

6.3 Synchronisation Rights

To obtain a synchronisation right, the interested party will have to obtain a licence from the right-owners of the musical work as well as the sound recording. The copyright in the musical composition is owned by the composer, while the copyright in the sound recording is owned by the music label/producer.

7. Exceptions to Copyright

7.1 Fair Use Doctrine/Fair Dealing

Section 52 of the Act provides a list of exceptions to copyright. The list is comprehensive and statutory in nature. The complete list of exceptions can be seen at <https://copyright.gov.in/exceptions.aspx>.

7.2 Private Copying

Private or personal use, including research, does not constitute an infringement of copyright and is expressly listed as an exception under Section 52(1)(a)(i) of the Act.

7.3 Reproductions of Cultural Goods/Buildings

The Act provides exceptions with regard to reproductions of cultural goods/buildings and the following is permitted:

- the making or publishing of a painting, drawing, engraving or photograph of a work of architecture or the display of a work of architecture;
- the making or publishing of a painting, drawing, engraving or photograph of a sculpture, or any other work of artistic craftsmanship if such work is permanently situated in a public place or any premises to which the public has access; and
- the inclusion in a cinematograph film of:
 - (a) any artistic work permanently situated in a public place or any premises to which the public has access; or
 - (b) any other artistic work, if such inclusion is only by way of background or is otherwise incidental to the principal matters represented in the film.

7.4 Activities Carried Out by Intermediaries

An exception for intermediaries is given under Section 52(1)(c) of the Act. This section provides that transient or incidental storage of a work or performance for the purpose of providing electronic links, access or integration, where such links, access or integration have not been expressly prohibited by the right-holder, shall not be considered infringement unless the person responsible is aware, or has reasonable grounds to believe, that such storage is of an infringing copy.

It is further given that if the person responsible for the storage of a copy has received a written complaint from the owner of the copyright in the work, complaining that such transient or incidental storage is an infringement, the person responsible for the storage shall refrain from facilitating such access for a period of 21 days or until they receive an order from the competent court instructing them to refrain from facilitating access, or where no such order is received before the expiry of 21 days, the person may continue to facilitate such access.

7.5 Satire and Parody

The fair-use defence in India is provided under Section 52 of the Act which stipulates, inter alia, that fair dealing with any work for the purpose of criticism or review, whether of that work or of any other work, does not constitute infringement of copyright (Section 52(1)(a)(ii)).

It was observed in the Madras High Court in *M/s Blackwood & Sons Ltd v AN Parasuraman* (AIR 1959 Mad 410) that in order to constitute a fair dealing, there must be no intention on the part of the alleged infringer, to compete with the copyright holder of the work and to derive profits from such competition and also, that the motive of the alleged infringer in dealing with the work must not be improper.

In view of this, a satire or parody must satisfy two conditions to avail the fair-dealing defence:

- the work must not intend to compete with the original work; and
- the satire or parody must not make improper use of the original work.

7.6 Copyright: Freedom of Speech/Right of Information

Freedom of speech and expression is one of the fundamental rights of the Indian legal system. It has been suitably captured under the Act under various exceptions to Section 52. Indian courts have discussed this issue in several website blocking orders, which are considered to be one of the most successful, cost-effective and proportionate means to address the issue of rogue websites. The Delhi High Court in *UTV SOFTWARE COMMUNICATION LTD AND 1337X* held that the extent of website blocking should be proportionate and commensurate with the extent and nature of the infringement. A court should pass a website blocking order only if it is satisfied that the same is “necessary” and “proportionate”. The proportionality principle is used to strike a fair balance between the right to intellectual property on the one hand, and the right to trade and freedom of expression on the other.

8. Neighbouring/Entrepreneurial/ Copyright-Related Rights

8.1 Neighbouring Rights

The Act provides for broadcasting reproduction rights in favour of broadcasting organisations and the rights of performers over their performances.

8.2 Transferring/Licensing/Sale of Neighbouring Rights

Neighbouring rights can be transferred/assigned and/or licensed. The requirements are the same as for the assignment or licensing of copyright, as mentioned in **4.2 Alienable Rights**.

8.3 Copyright Exceptions Applicable to Neighbouring Rights

Exceptions to copyright (see **7.1 Fair Use Doctrine/Fair Dealing**) are applicable to neighbouring rights.

9. Copyright Infringement and Litigation

9.1 Types of Copyright Infringement

A copyright is infringed if a person without appropriate permission or a licence does anything that the owner of the copyright has an exclusive right to do.

This includes, when any person permits (for profit) any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless they were not aware and had no reasonable ground to believe that such communication to the public would be an infringement of copyright.

It is also an infringement of copyright if any person:

- makes for sale or for hire, or sells or lets for hire, or by way of trade displays or offers for sale or for hire; or
- distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright; or
- by way of trade exhibits in public; or
- imports into India;

any infringing copies of the work.

9.2 Defences against Copyright Infringement

The following do not constitute infringement:

- any activity that falls under the scope of fair use, or similar provisions such as fair dealing, in any work for private or personal use, including research/criticism or review/reporting of current events or current affairs;
- reproduction of work by a teacher or pupil in the course of instructions;
- reproduction of any work for the purpose of a judicial proceeding or its reporting;
- the reading and recitation in public of reasonable extracts from a published literary or dramatic work;
- storing of work in any medium by electronic means by a non-commercial public library, for preservation if the library already possesses a non-digital copy of the work, etc.

Apart from the above, the following is a non-exhaustive list of defences that can be used while defending a claim of infringement:

- challenging the subsistence of copyright – disputing the originality of the work;
- claiming multiple originality by proving that the defendant had no access to the work created by the plaintiff;

- challenging the right of the plaintiff to sue – preliminary objection on maintenance of the suit;
- having the suit/complaint barred by limitation – preliminary objection on maintenance of the suit;
- claiming no knowledge of the infringement – in case of a civil action, if the defendant proves that at the time of the infringement they were not aware and had no reasonable ground for believing that copyright subsisted in the work, the plaintiff shall not be entitled to any remedy other than an injunction in respect of the infringement, and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the court may, in the circumstances, deem reasonable.

Furthermore, in the case of criminal complaints, if the offence is not committed for commercial gain, the extent of the fine/imprisonment may be reduced.

9.3 Proceedings Available to the Copyright Holder

Rights-holders have access to both civil and criminal remedies under the law to counter copyright infringement. Under civil remedies, the copyright owner can file a suit for infringement and seek both injunction and damages. Under criminal remedies, the rights-holders or the authorised representatives can file an official complaint to the local police authorities informing them of the infringement of their rights, or directly approach the magistrate to file a criminal complaint so that the competent court can direct the police authorities to investigate the matter further.

Additionally, the owner of copyright or their duly authorised agent may give a notice to the customs authorities to suspend the clearance of imported infringing copies of work. In view of the above, criminal remedies can be considered an alternative to civil actions.

9.4 Jurisdiction for Copyright Proceedings

Infringement of copyright proceedings can be instituted before a district court, within the jurisdiction of which, the claimant:

- resides; or
- carries on business; or
- personally works for gain.

In addition, every copyright infringement suit can be instituted in a court within the local limits of the jurisdiction of which:

- the defendant actually and voluntarily resides, or carries on business, or personally works for gain; or
- the cause of action, wholly or in part, arises.

Furthermore, there are no special courts for copyright cases; these are heard by the commercial benches of the courts.

9.5 Necessary Parties to Copyright Infringement Proceedings

Either the copyright holder or an exclusive licensee can sue for copyright infringement. An exclusive licensee can sue for violation of any rights that it holds by virtue of a licence from the original owner of the copyright. Furthermore, only an exclusive licensee or the copyright owner can institute a lawsuit for infringement.

9.6 Third Parties to Copyright Proceedings

In civil proceedings, the third parties can be enjoined from using the infringing material and costs or damages can be awarded. In criminal proceedings, the infringers may be imprisoned and a fine may also be imposed. See also **9.10 Remedies and Sanctions**.

9.7 Urgent Measures

The Indian courts award ex parte ad interim injunctions in cases where there is an urgent need to restrain the act of infringement in question. In cases where temporary injunctions are granted, the trinity of a prima facie case, irreparable injury and balance of convenience needs to be assessed by the courts.

9.8 Role of Experts in Copyright Proceedings

Expert evidence can be given on aspects of foreign law, science, art, identity, handwriting and fingerprints under Section 45 of the Evidence Act 1872. However, Indian courts generally do not demand any expert opinions in copyright infringement cases but if the court wishes it can seek the help of experts.

9.9 Counterfeits and Parallel Imports

The Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, enable IP owners to enforce their rights at Indian borders. A notice can be given to the customs authorities to initiate action against importers of counterfeit goods. The period of protection available under customs is five years from the recordation of rights with the customs authorities or upon expiry of the validity of registration of the IP right, whichever is earlier. After five years have expired, the right-holder is required to furnish a fresh notice.

The Indian Copyright Act does not expressly specify the scope of exhaustion but the Delhi High Court in *John Wiley & Sons v Prahabhat Chander Kumar Jain* (2010) held that the Act can only be taken to mean national exhaustion, thus making parallel imports to India illegal.

9.10 Remedies and Sanctions

The remedies provided against infringement of copyright can be categorised as:

- civil remedies – the copyright owner can seek injunctions, damages, rendition of accounts, delivery and destruction of infringing copies;
- criminal remedies – these include imprisonment, fines, seizure of infringing copies and delivery of infringing copies to the owner; and
- border enforcement – this provides for prohibition of the importation of infringing material.

9.11 Copyright Infringement as Administrative or Criminal Offences

Copyright infringement can constitute an administrative or criminal offence and both administrative and criminal remedies are available to the aggrieved person. Under the administrative step of border enforcement, the copyright owner can seek prohibition of the importation of infringing materials.

Under criminal remedy, the rights-holders or their authorised representatives can file an official complaint with the local police authorities informing them of the infringement of their rights, or they can approach the magistrate directly and file a criminal complaint so that the competent court can direct the police authorities to investigate the matter further.

9.12 Appellate Procedure for Copyright Proceedings

In a case where the first instance judgment is passed by the District Court, an appeal may be instituted in the High Court. Furthermore, in cases where the first instance judgment is passed by a single judge of the High Court, the appeal may be brought before the Division Bench.

In cases of seizure and disposal of infringing copies, an aggrieved person may, within 30 days of the date of the order of the magistrate, file an appeal in the Court of Session.

9.13 Costs of Copyright Litigation

The cost of litigation is recoverable from the defendants, and the Commercial Courts Act specifically provides the mechanism for payment of costs. However, recovery of costs depends upon several factors, such as the merits of the case, quantum of loss, and evidence submitted before the court, etc.

9.14 Alternative Dispute Resolution

There is an alternative dispute resolution system in the form of mediation between the parties before the copyright infringement suit reaches the court. As per Section 12 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts (Amendment) Act, 2018, a commercial suit including a copyright infringement suit, having a value of INR300,000 (approximately USD4,150) or more, which does not contemplate any urgent interim relief, shall not be instituted unless the plaintiff has exhausted the remedy of pre-institution mediation.

LexOrbis Intellectual Property Practice is a premier IP firm and among the fastest-growing IP practices in India, having offices at three strategic locations in Delhi, Mumbai and Bengaluru. With a team of over 90 highly reputed lawyers, engineers and scientists, the firm is a one-stop shop, providing practical solutions and services on all IP and legal issues faced by technology companies, research institutions, universities, broadcasters, content developers and brand owners. Its services include Indian and global IP portfolio development

and management, advisory and documentation services on IP transactions/technology-content transfers, and IP enforcement and dispute resolution in all forums across India. LexOrbis also has wider reach through its global network of trusted partners and associate firms. The team's highly accomplished legal professionals are adept at handling all business needs and addressing complex legal and techno-legal issues, and they employ cutting-edge technology systems to improve their processes and efficiency.

Authors



Manisha Singh is a founder and the managing partner of LexOrbis, who supervises all practice groups at the firm. She started her career when Indian IP laws and practices were undergoing substantial changes, and has played an important role in advising Indian policy and lawmakers

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