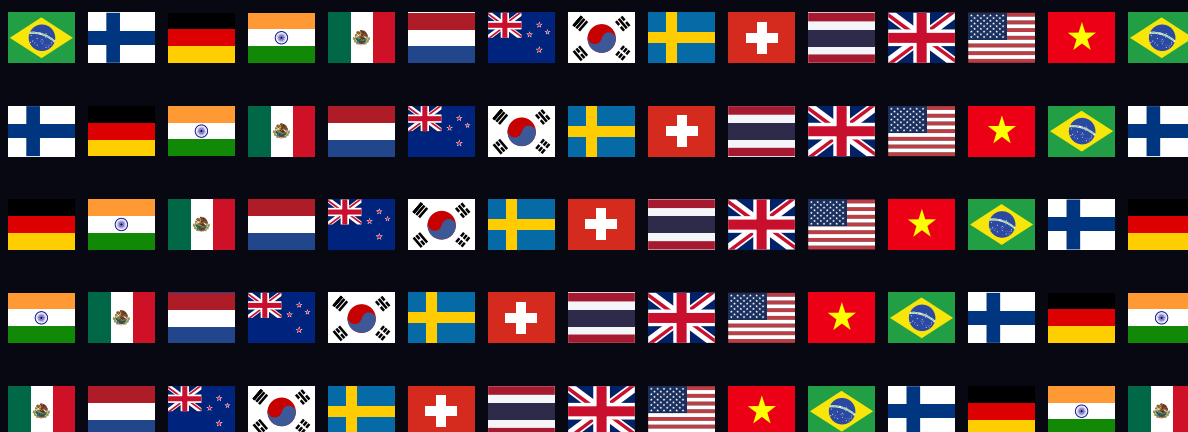


LICENSING

India



Licensing

Consulting editors

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Quick reference guide enabling side-by-side comparison of local insights, including into kinds of licences; law affecting international licensing; intellectual property issues; software licensing; royalties and other payments, currency conversion and taxes; competition law issues; indemnification, disclaimers of liability, damages and limitation of damages; termination of licensing agreements; bankruptcy; governing law and dispute resolution; and recent trends.

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India



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OVERVIEW

Restrictions

Are there any restrictions on the establishment of a business entity by a foreign licensor or a joint venture involving a foreign licensor and are there any restrictions against a foreign licensor entering into a licence agreement without establishing a subsidiary or branch office? Whether or not any such restrictions exist, is there any filing or regulatory review process required before a foreign licensor can establish a business entity or joint venture in your jurisdiction?

Foreign businesses can establish a wholly owned subsidiary or joint venture and can create a private limited company or limited liability company in India. Establishing a limited company by a foreign company or non-resident is governed by the foreign direct investment (FDI) policy regulated by the Department for Promotion of Industry and Internal Trade (DPIIT), under India's Ministry of Commerce and Industry. FDI policy allows foreign businesses to establish business in India through the automatic route or the government route based on the nature of the business. Under the automatic route, the foreign business can establish a wholly owned subsidiary and does not require approval from the Government of India. Whereas certain business sectors like banking and satellite operations can be established under the government route and need approval from the Government of India.

Another option foreign companies have is to create a branch office, liaison office or project office without registering a limited company. For such business entities, the scope of activities is limited to projects or certain functions. Foreign licensors can enter into licensing agreements without establishing a subsidiary or branch office. However, repatriation of money by way of royalties based on licensing agreements comes under the purview of the Security Exchange Board of India. The Foreign Exchange Management Act (FEMA) rules under the Reserve Bank of India (RBI) provide guidelines on the regulation and reporting requirements on foreign remittances.

Law stated - 20 January 2023

KINDS OF LICENCES

Forms of licence arrangement

Identify the different forms of licence arrangements that exist in your jurisdiction.

There are several types of licence agreements depending on the nature of the business and the type of transactions being conducted. These include:

- patent licence agreements;
- trademark licence agreements;
- copyright licence agreements;
- industrial design licence agreements;
- technology transfer licence agreements;
- technology collaboration licence agreements;
- franchise agreements; and
- software licence agreements.

Based on the terms, agreements can be:

- exclusive/non-exclusive licence agreements;

- compulsory agreements;
- cross-licence agreements or cross-agreements; or
- sub-licence/sub-licence agreements.

Law stated - 20 January 2023

LAW AFFECTING INTERNATIONAL LICENSING

Creation of international licensing relationship

Does legislation directly govern the creation, or otherwise regulate the terms, of an international licensing relationship? Describe any such requirements.

There is no specific statute regulating the terms of an international licensing relationship. However, the regulation of international licensing agreements may fall under the ambit of one or more of the following:

- the Indian Contract Act 1872;
- the Competition Act 2002;
- the Trade Marks Act 1999;
- the Copyright Act 1957;
- the Patents Act 1970;
- the Designs Act 2000;
- the Geographical Indications of Goods (Registration and Protection) Act 1999;
- the Semiconductor Integrated Circuits Layout Design Act 2000;
- the Foreign Exchange Management Act 1999 (FEMA);
- the Income Tax Act 1961;
- the Indian Easements Act 1882;
- the Competition Act 2002;
- the Arbitration and Conciliation Act 1996;
- the Specific Relief Act 1963; and
- the Information Technology Act 2000.

Law stated - 20 January 2023

Pre-contractual disclosure

What pre-contractual disclosure must a licensor make to prospective licensees?

There is no specific statutory requirement of pre-contractual disclosure. However, licensors may have a duty to disclose certain information to the parties and the prospective licensee if the information is material to the licensee's decision to enter into the terms and conditions of the licence agreement. Material information is information that would be considered important to a reasonable person in deciding whether to enter into an agreement or not.

In some cases, failure to disclose material information may give the licensee the right to void the contract or seek damages. Whether or not a particular piece of information is material will depend on the circumstances of each case. It is good practice for licensors to disclose any relevant information they are aware of that may be material to the prospective licensee's decision to enter into the agreement. By disclosing such material information, one may avert disputes or legal issues that may arise later.

Law stated - 20 January 2023

Registration

Are there any requirements to register a grant of international licensing rights with authorities in your jurisdiction?

Section 69 of the Patents Act 1970 describes provisions related to documenting the licence agreement with the Patent Office. In the judgment of *Sergi Transformer Explosion Prevention Technologies Pvt Ltd v Kumar Pratap Anil and Ors*, the court ruled that according to section 69(5) of the Patents Act 1970, the validity of a licence or assignment agreement can only be recognised as evidence after the document has been registered with the Controller.

In India, it is not mandatory to record trademark licence agreements with the Trademark Registry. However, it is good practice to record the licence agreement with the Trademark Registry. This can help to establish the terms of the licence and provide evidence of the licensee's rights in the event of a dispute.

It is not necessary to register a grant of international copyright licensing rights with any authorities. However, it is good practice to record the licence agreement as it can serve as prima facie evidence of validity in enforcement proceedings.

Section 30 of the Designs Act 2000 describes the provisions whereby a licensee can make an application to the Controller to register the title within six months of signing the licence agreement.

Law stated - 20 January 2023

INTELLECTUAL PROPERTY ISSUES

Paris Convention

Is your jurisdiction party to the Paris Convention for the Protection of Industrial Property? The Patent Cooperation Treaty (PCT)? The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)?

India is party to the PCT and joined on 7 September 1998. The TRIPs was signed and dated on 1 January 1995.

Law stated - 20 January 2023

Contesting validity

Can the licensee be contractually prohibited from contesting the validity of a foreign licensor's intellectual property rights or registrations in your jurisdiction?

It is possible for the licensee to be contractually prohibited from contesting the validity of a foreign licensor's IP rights or registrations in India subject to the terms of the licence agreement.

Under Indian law, parties to a contract are generally free to enter into agreements that bind them to certain terms and conditions. This includes provisions that limit or restrict the parties' rights or obligations. However, certain provisions may be considered unenforceable if they are against public policy or the law.

For example, a provision that prohibits the licensee from challenging the validity of the licensor's IP rights or registrations may be considered unenforceable if it is deemed to be against the public interest or the principles of fair competition. Similarly, a provision that seeks to waive or limit the licensee's rights under Indian law may also be considered unenforceable.

Law stated - 20 January 2023

Invalidity or expiry

What is the effect of the invalidity or expiry of registration of an intellectual property right on a related licence agreement in your jurisdiction? If the licence remains in effect, can royalties continue to be levied? If the licence does not remain in effect, can the licensee freely compete?

In India, the invalidity or expiry of the registration of an IP right (patent, design, and copyright) may affect a related licence agreement. If the registration of an IP right is found to be invalid, it may affect the licensor's ability to enforce the licence agreement against the licensee. In such a case, the licensee may be able to rely on the invalidity of the registration as a defence against any claims of breach of the licence agreement by the licensor.

If the registration of an IP right expires, it may also affect the licensor's ability to enforce the licence agreement against the licensee. In such a case, the licensee may be able to argue that the licensor no longer has the right to enforce the licence agreement as the underlying IP right is no longer valid.

However, the invalidity or expiry of the registration of an IP right does not necessarily mean that the licence agreement is automatically terminated. The parties to the licence agreement may choose to continue their relationship even if the underlying IP right is no longer valid. However, the terms of the licence agreement may need to be modified or renegotiated in light of the change in circumstances.

Trademark rights are also protected under common laws; therefore invalidity or expiry of a trademark does not have any effect on the licence agreement.

Law stated - 20 January 2023

Unregistered rights

Can unregistered trademarks, or other intellectual property rights that are not registered, be licensed in your jurisdiction?

Unregistered trademarks can be licensed. A licence agreement pertaining to a pending trademark in India cannot be recorded with the Trademarks Office. However, since a patent is required to be compulsorily registered or filed for protection on priority in order to gain protection, the patent licence should be in writing and registered (section 68 of the Patents Act 1970). However, inventions that are not patented can be protected as trade secrets without registration.

Similarly, copyright law requires the licence to be in writing (section 30 of the Copyright Act 1957) although it is not mandatory to register a copyright with the Copyright Office.

Law stated - 20 January 2023

Security interests

Are there particular requirements in your jurisdiction to take a security interest in intellectual property?

Security interest over IP is covered under the following laws:

- the Companies Act 2013;
- the Securitisation and Reconstruction of Financial Assets and Enforcement of Security Interest Act 2002 (the SARFAESI Act);
- the Patents Act 1970;

- the Designs Act 2000;
- the Trade Marks Act 1999; and
- the Copyright Act 1957.

There should be a registered right to grant a security interest in the IP, and the same should be properly documented at the IP office. In *Canara Bank v NG Subbaraya Setty*, the Supreme Court held that assignment of a trademark, 'EENADU', as a security for an outstanding loan, is contrary to section 45 of the Trade Marks Act of 1999 and sections 6, 8 and 46(4) of the Banking Regulation Act 1949. The Court stated that any unregistered assignment cannot be presented as evidence in a court of law.

Law stated - 20 January 2023

Proceedings against third parties

Can a foreign owner or licensor of intellectual property institute proceedings against a third party for infringement in your jurisdiction without joining the licensee from your jurisdiction as a party to the proceedings? Can an intellectual property licensee in your jurisdiction institute proceedings against an infringer of the licensed intellectual property without the consent of the owner or licensor? Can the licensee be contractually prohibited from doing so?

A foreign owner or licensor of IP can institute proceedings against a third party for infringement in India without joining the licensee as a party to the proceedings.

In general, a licensee of IP in India does not have the right to institute proceedings against an infringer of the licensed IP without the consent of the owner or licensor. This is because the owner or licensor is typically the party that holds the legal rights to the IP, and it is their prerogative to enforce those rights. However, as per section 109 of the Patents Act 1970, the holder of an exclusive licence can institute proceedings against an infringer of the licensed IP.

Section 52 of the Trade Marks Act 1999 states that a registered user, subject to the agreement, can institute proceedings against an infringer without the consent of the owner. However, in case of passing-off, the licensee of an unregistered trademark cannot institute proceedings against an infringer without the consent of the owner.

There may be other circumstances in which a licensee may have the right to institute proceedings against an infringer without the consent of the owner or licensor. For example, if the licence agreement specifically grants the licensee the right to enforce the IP rights and to institute proceedings against infringers, then the licensee may have the authority to do so. In addition, if the licensee is adversely affected by the alleged infringement and the owner or licensor is not taking action to address the issue, the licensee may be able to seek a court order requiring the owner or licensor to take action, or allowing the licensee to do so on their behalf.

Law stated - 20 January 2023

Sub-licensing

Can a trademark or service mark licensee in your jurisdiction sub-license use of the mark to a third party? If so, does the right to sub-license exist statutorily or must it be granted contractually? If it exists statutorily, can the licensee validly waive its right to sub-license?

Yes, a trademark or service mark licensee in India can sub-license the use of the mark to a third party, provided the sub-licence is in writing and is properly authorised by the licensor. To sub-license the mark, the licensee must obtain the

written consent of the licensor.

Here, the sub-licence is granted contractually, which means that it is provided for in the original licence agreement between the licensor and the licensee. In this case, the licensee would only have the right to sub-licence the mark if the original licence agreement allows it and if the sub-licence is properly authorised. The licensee may be able to waive its right to sub-licence the mark if the original licence agreement allows it and if the waiver is made in accordance with the terms of the agreement.

Law stated - 20 January 2023

Jointly owned intellectual property

If intellectual property in your jurisdiction is jointly owned, is each co-owner free to deal with that intellectual property as it wishes without the consent of the other co-owners? Are co-owners of intellectual property rights able to change this position in a contract?

If the IP is jointly owned, the co-owners have equal rights in the IP, but any transaction related to the IP, for example, licensing or assignment, cannot be done without the consent of the other co-owner.

Co-owners of IP rights can change their position in a contract. For example, co-owners can enter into an agreement specifying their respective rights and responsibilities with respect to the IP. This can include specifying how any profits from the IP will be shared, as well as any other terms and conditions related to the use and licensing of the IP.

Law stated - 20 January 2023

First to file

Is your jurisdiction a 'first to file' or 'first to invent' jurisdiction? Can a foreign licensor license the use of an invention subject to a patent application but in respect of which the patent has not been issued in your jurisdiction?

The Indian patent system follows 'first to file'. A foreign licensor can license the use of an invention subject to a patent application even if the patent is not yet granted in India.

Law stated - 20 January 2023

Scope of patent protection

Can the following be protected by patents in your jurisdiction: software; business processes or methods; living organisms?

Under the Patents Act 1970, the patent is granted to the invention. Section 2(1)j defines 'invention' as 'a new product or process involving an inventive step and capable of industrial application'.

Additionally, section 3 of the Patents Act defines the not-patentable inventions.

As per section 3(k), a mathematical or business method or a computer program per se or algorithms are not inventions and hence not patentable. To obtain a patent for the invention related to the program or software, it must not be merely an algorithm but a technical invention as well. In *Ferid Allani v Union of India & Ors*, the Delhi High Court reaffirmed that computer-related inventions that demonstrate a 'technical effect' or 'technical contribution' are eligible for patent protection, even if they are based on a computer program.

Further, section 3(j) of the Patents Act says that 'plants and animals in whole or any part thereof other than micro organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals' are not inventions within the meaning of the act.

Law stated - 20 January 2023

Trade secrets and know-how

Is there specific legislation in your jurisdiction that governs trade secrets or know-how? If so, is there a legal definition of trade secrets or know-how? In either case, how are trade secrets and know-how treated by the courts?

There is no specific statute to protect trade secrets or know-how in India. However, these can be protected under common law based on the terms and conditions of the agreement and relevant statutes, for example, the Indian Contract Act 1872, the Indian Penal Code 1860, the Copyright Act 1957 and the Indian Evidence Act 1872.

Law stated - 20 January 2023

Does the law allow a licensor to restrict disclosure or use of trade secrets and know-how by the licensee or third parties in your jurisdiction, both during and after the term of the licence agreement? Is there any distinction to be made with respect to improvements to which the licensee may have contributed?

Yes, the law allows a licensor to restrict disclosure or use of trade secrets and know-how by the licensee or third parties in India. The confidentiality clause in the agreement prohibits the licensee and third parties from disclosing the information both during and after the term of the licence agreement.

Licensee rights relating to improvement or modification are subject to the terms of the agreement.

Law stated - 20 January 2023

Copyright

What constitutes copyright in your jurisdiction and how can it be protected?

The Copyright Act 1957 protects original literary, dramatic, musical, and artistic works and cinematograph films and sound recordings. Copyright protects the expressions, not the ideas, and the Copyright Act 1957 provides the provisions for copyright registration.

In India, copyright protection is automatic, meaning that you do not need to register your work formally to be protected by copyright law. Copyright protection automatically applies to a work as soon as it is created. However, obtaining a copyright registration can provide several benefits, including serving as prima facie evidence of ownership and the validity of the copyright in legal proceedings. Additionally, registering your copyright may make it easier to enforce your rights if your work is infringed upon.

Law stated - 20 January 2023

SOFTWARE LICENSING

Perpetual software licences

Does the law in your jurisdiction recognise the validity of 'perpetual' software licences? If not, or if it is not advisable for other reasons, are there other means of addressing concerns relating to 'perpetual' licences?

A perpetual software licence is a type of software licence that allows the user to use the software indefinitely, provided the terms of the licence agreement are met. In India, perpetual software licences are recognised and are a popular choice for businesses and organisations looking to use software on a long-term basis, the legal requirement being to capture the terms in writing and agreed between the parties.

Law stated - 20 January 2023

Legal requirements

Are there any legal requirements to be complied with prior to granting software licences, including import or export restrictions?

One legal requirement for granting a software licence is to have the terms of the licence captured in writing and agreed between the parties. There are also tax implications for import and export of software.

Law stated - 20 January 2023

Restrictions on users

Are there legal restrictions in your jurisdiction with respect to the restrictions a licensor can put on users of its software in a licence agreement?

There are no legal restrictions that a licensor can put on users of its software, and the licensor can determine what terms to include in a licence agreement. It is possible for a licensor to include a contractual restriction prohibiting its licensees from carrying out any form of reverse engineering or decompiling of a software program, or from making backup copies. However, the licensor must consider other facets of contractual law including user data privacy, limitation of liability and third-party insurance coverage, as applicable.

Law stated - 20 January 2023

ROYALTIES AND OTHER PAYMENTS, CURRENCY CONVERSION AND TAXES

Relevant legislation

Is there any legislation that governs the nature, amount or manner or frequency of payments of royalties or other fees or costs (including interest on late payments) in an international licensing relationship, or require regulatory approval of the royalty rate or other fees or costs (including interest on late payments) payable by a licensee in your jurisdiction?

Though there is no specific legislation on payments of royalties, there are regulations on the repatriation amount one can take back on account of royalties. Payment of royalties to an overseas licensor for use of IP or other technical services is governed by the Foreign Exchange Regulations under the Foreign Exchange Management Act (FEMA). Repatriation of royalty payments is capped at 5 per cent on domestic sales and 8 per cent on exports, and the total

repatriation amount must be under US\$2 million.

Law stated - 20 January 2023

Restrictions

Are there any restrictions on transfer and remittance of currency in your jurisdiction? Are there any associated regulatory reporting requirements?

The FEMA rules provide guidelines on the regulation and reporting requirements on foreign remittances. Foreign remittances under royalty are capped at 5 per cent on domestic sales and 8 per cent on exports, and the total repatriation amount must be under US\$2 million.

Law stated - 20 January 2023

Taxation of foreign licensor

In what circumstances may a foreign licensor be taxed on its income in your jurisdiction?

Licensees are obliged to withhold tax on royalty payments to a foreign licensor. A licensee is required to withhold tax of 10 per cent on the payments made. Under the Finance Act 2020, if repatriation is in the form of dividends to a non-resident Indian shareholder, tax is required to be deducted at 20 per cent (plus applicable surcharge and cess) on the income generated in India, subject to tax treaty benefits. If there is a double taxation treaty agreement between India and the country where remittance is made, then the tax is deducted wherever a lower rate is applicable.

Another aspect to consider is the indirect taxation on import and export of software. When it comes to importing software to India, any software downloaded from a website or through an electronic medium, or royalty payment received via transfer of IP rights related to software, is deemed to be supply of service under the Goods and Services Tax (GST) Act and attracts 18 per cent GST. If the software is imported in the form of DVD, CD, or pen drive, then it is categorised as goods and an Integrated Goods and Services Tax (IGST) rate of 18 per cent is applicable.

Law stated - 20 January 2023

COMPETITION LAW ISSUES

Restrictions on trade

Are practices that potentially restrict trade prohibited or otherwise regulated in your jurisdiction?

The Competition Act 2002, later amended in 2007 and 2009, outlines various tenets of anticompetitive practices including dominant position, predatory pricing, and anticompetitive agreements. All anticompetitive practices are regulated by the Competition Commission of India.

Law stated - 20 January 2023

Legal restrictions

Are there any legal restrictions in respect of the following provisions in licence agreements: duration, exclusivity, internet sales prohibitions, non-competition restrictions and grant-back provisions?

There are no legal restrictions in respect of duration and exclusivity of licence agreements provided they comply with the tenets of the Competition Act 2002. Regarding grant-back provisions in licence agreements, the Competition Commission of India may act upon restriction conditions requiring the licensee to grant back to the licensor any know-how or IP rights acquired and not to grant licences to anyone else. Further, section 140 of the Patents Act 1970 outlines avoidance of restrictive conditions. Section 140, (iii) (d) reads:

'It shall not be lawful to insert in a licence to work any process protected by a patent, a condition the effect of which may provide exclusive grant back, prevention to challenges to validity of Patent & Coercive package licensing, and any such condition shall be void.'

Law stated - 20 January 2023

IP-related court rulings

Have courts in your jurisdiction held that certain uses (or abuses) of intellectual property rights have been anticompetitive?

There are a few cases where IP rights have been challenged because they were anticompetitive in nature. One such case is Bayer v Natco , wherein compulsory licensing was issued to manufacture an affordable generic version of an expensive patented drug. In Biocon v Roche , the Competition Commission of India probed the alleged abuse of dominance to delay the introduction of a generic product into the Indian market.

Law stated - 20 January 2023

INDEMNIFICATION, DISCLAIMERS OF LIABILITY, DAMAGES AND LIMITATION OF DAMAGES

Indemnification provisions

Are indemnification provisions commonly used in your jurisdiction and, if so, are they generally enforceable? Is insurance coverage for the protection of a foreign licensor available in support of an indemnification provision?

Sections 124 and 125 of the Indian Contract Act 1872 define the principles of indemnification. It is possible to enforce indemnification clauses in India. There are a couple of internationally recognised insurers in India that provide insurance coverage for indemnity clauses in contract and licensing agreements.

Law stated - 20 January 2023

Waivers and limitations

Can the parties contractually agree to waive or limit certain types of damages? Are disclaimers and limitations of liability generally enforceable? What are the exceptions, if any?

Parties entering a contract can agree limitations of liability clauses to waive or limit damages, subject to section 73 of the Indian Contract Act 1872. The stated damages can be enforced under section 74 of the act. However, there have been exceptions in the extent of damages awarded, as in Simplex Infrastructure v Siemens Limited wherein it was found that the limitation of liability clause was limited in scope, and an amount outside the scope of the clause that included encashment by way of a bank guarantee was allowed.

Law stated - 20 January 2023

TERMINATION

Right to terminate

Does the law impose conditions on, or otherwise limit, the right to terminate or not to renew an international licensing relationship; or require the payment of an indemnity or other form of compensation upon termination or non-renewal? More specifically, have courts in your jurisdiction extended to licensing relationships the application of commercial agency laws that contain such rights or remedies or provide such indemnities?

The terms of termination should be clearly stated in the termination clause. The law does not impose any conditions on the payment of an indemnity or other form of compensation upon termination or non-renewal unless explicitly stated in the licensing agreement.

Law stated - 20 January 2023

Impact of termination

What is the impact of the termination or expiration of a licence agreement on any sub-licence granted by the licensee, in the absence of any contractual provision addressing this issue? Would a contractual provision addressing this issue be enforceable, in either case?

Enforceability is a challenge post-termination and especially in the absence of any contractual provisions. In *Percept D'Mark (India) Pvt Ltd v Zaheer Khan & Anr*, the court stated:

'Under Section 27 of the Contract Act (a) a restrictive covenant extending beyond the term of the contract is void and not enforceable, (b) The doctrine of restraint of trade does not apply during the continuance of the contract for employment and it applied only when the contract comes to an end.'

However, *Ozone Spa Pvt Ltd v Pure Fitness & Ors* sets precedence where non-compete restrictions were enforced between a buyer and seller beyond the period of the contract. It was observed that if the restrictions are reasonable and apply within specified local limits where the goodwill of the business is prevalent, the contractual provisions are enforceable beyond the termination of the contract.

Law stated - 20 January 2023

BANKRUPTCY

Impact of licensee bankruptcy

What is the impact of the bankruptcy of the licensee on the legal relationship with its licensor; and any sub-licence that the licensee may have granted? Can the licensor structure its international licence agreement to terminate it prior to the bankruptcy and remove the licensee's rights?

Although the licensor can terminate the legal relationship if the licensee goes bankrupt by including relevant bankruptcy clauses in the agreement, recently the Supreme Court of India stayed the termination of a contract as the

contract was key to the insolvency process. In *Gujarat Urja Vikas Nigam Limited v Mr Amit Gupta & Ors* Civil Appeal No. 9241 of 2019, the Supreme Court held that National Company Law Tribunal (NCLT)/National Company Law Appellate Tribunal (NCLAT) correctly stayed the termination of a power purchase agreement (PPA), as the PPA was central and allowing the termination of the PPA would certainly result in the death of the entity filing for bankruptcy.

Law stated - 20 January 2023

Impact of licensor bankruptcy

What is the impact of the bankruptcy of the licensor on the legal relationship with its licensee; and any sub-licence the licensee has granted? Are there any steps a licensee can take to protect its interest if the licensor becomes bankrupt?

The courts can prevent termination of the contract if the bankrupt licensor is able to show that the licence is central to the continuity of the business. However, if the licensee can show that the reputation of the licensee is at stake due to the engagement with the bankrupt licensor, the licensee may seek express provisions to terminate the licence.

Law stated - 20 January 2023

GOVERNING LAW AND DISPUTE RESOLUTION

Restrictions on governing law

Are there any restrictions on an international licensing arrangement being governed by the laws of another jurisdiction chosen by the parties?

There are no restrictions on the jurisdiction chosen in an international licensing agreement. The parties may choose a specific country as a neutral venue for arbitration based on mutual agreement.

Law stated - 20 January 2023

Contractual agreement to arbitration

Can the parties contractually agree to arbitration of their disputes instead of resorting to the courts of your jurisdiction? If so, must the arbitration proceedings be conducted in your jurisdiction or can they be held in another?

Arbitration proceedings can be conducted in any jurisdiction. Usually, Singapore is perceived as a neutral venue for arbitration due to its good infrastructure, low corruption, and proximity to India.

Law stated - 20 January 2023

Enforceability

Would a court judgment or arbitral award from another jurisdiction be enforceable in your jurisdiction? Is your jurisdiction party to the United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards?

A court judgment or arbitral award from another jurisdiction can be enforced in India, since India is party to the United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards. Judgments or arbitral awards

from another jurisdiction can also be contested in the Indian courts.

Law stated - 20 January 2023

Injunctive relief

Is injunctive relief available in your jurisdiction? May it be waived contractually? If so, what conditions must be met for a contractual waiver to be enforceable? May the parties waive their entitlement to claim specific categories of damages in an arbitration clause?

Yes, injunctive relief is available in India and can be waived contractually. Waiver of contractual rights is based on section 63 of the Indian Contract Act, which provides relinquishment of rights between the parties.

Law stated - 20 January 2023

UPDATES & TRENDS

Key developments of the past year

Please identify any recent developments in laws or regulations, or any landmark cases, that have (or are expected to have) a notable impact on licensing agreements in your jurisdiction (including any significant proposals for new legislation or regulations, even if not yet adopted). Explain briefly how licensing agreements might be affected.

In 2022, an Intellectual Property Division (IPD) was set up at the Delhi High Court, which is the leading venue for resolution of IP disputes in India. On 24 February 2022, the Delhi High Court Intellectual Property Rights Division Rules 2022 (the IPD Rules) and the High Court of Delhi Rules Governing Patent Suits 2022 were notified. With these new rules, one can expect resolution of IP disputes more efficiently and in a timely manner.

Law stated - 20 January 2023

Jurisdictions

	Brazil	Bhering Advogados
	Finland	ADVOCARE Law Office
	Germany	Bardehle Pagenberg
	India	LexOrbis
	Mexico	Uhthoff, Gómez Vega & Uhthoff SC
	Netherlands	Parker Advocaten
	New Zealand	Stewart Germann Law Office
	South Korea	Lee International IP & Law
	Sweden	Cirio Advokatbyrå AB
	Switzerland	Schellenberg Wittmer
	Thailand	Tilleke & Gibbins
	United Kingdom	Burness Paul LLP
	USA	Greenblum & Bernstein plc
	Vietnam	Tilleke & Gibbins