

# CTR ENCYCLOPAEDIA ON INDIAN TAX LAWS

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## **[A] N.V. PHILIPS GLOEILAMPENFABRIEKEN EINDHOVEN vs. COMMISSIONER OF INCOME TAX**

HIGH COURT OF CALCUTTA

Dipak Kumar Sen & Shyamal Kumar Sen, JJ.

IT Ref. No. 129 of 1983

Decided on 6th May, 1987

TC39R.1282; TC 68R.272

SOURCE : (1987) 65 CTR (CAL) 103 : (1988) 172 ITR 521 (CAL) : (1987) 34 TAXMAN 274

Legislation referred to

Section 9(1)(vi),

Case pertains to

Asst. Year 1973-74, 1974-75

Decision in favour of

Revenue

**Income deemed to accrue to arise in India—Royalty vis-a-vis technical service—Assessee non- resident company entered into an agreement with an Indian Company, under which assessee agreed to furnish to Indian company technical information relating to manufacture, use, etc. of a product—Information could be used solely by Indian company and could not be disclosed to third parties—In consideration thereof, assessee was to receive 5 per cent of net selling price of product—Amounts received by assessee from Indian company for asst. yrs. 1973-74 and 1974-75 treated as royalty and taxed @ 80 per cent instead of treating the same as technical services fees, which was taxable only @ 10 per cent— Justified—Dictionary meaning of royalty connotes payments periodic or at one time for user by one person of certain exclusive rights belonging to other persons—Such exclusive rights need not be patent rights or rights protected by any law—A person having specialised knowledge can claim exclusive right to the same as long as he chooses not to make such specialised knowledge public—Such a person can exploit and utilise such knowledge in the same way as a person holding a patent or having copyright of a publication to allow a limited user of such specialised knowledge to others in confidence against payments—Payments for user of such specialised knowledge can be treated as royalty or in the nature of royalty**

Held

From the dictionary meaning of the term 'royalty', it appears that the said term connotes payments periodic or at a time for user by one person of certain exclusive rights belonging to another person. The examples of such exclusive rights are rights in the nature of a patent, mineral rights or right in

respect of publications. It is possible that a person who invests may not take out a patent for his invention but unless some there inventor independently and by his own efforts come to duplicate the invention the original invention remains exclusive to the investor and it is conceivable that such an inventor might exploit his invention permitting some other person to have the user thereof against payment. Similarly, it is possible for a person carrying out operations of manufacture and production of a particular product to acquire specialised knowledge in respect of such manufacture and production which is not generally available. A person having such specialised knowledge can claim exclusive right to the same as long as he chooses not to make such specialised knowledge public. It is also conceivable that such a person can exploit and utilise such specialised knowledge in the same way as a person holding a patent or owning a mineral right or having the copyright of a publication to allow a limited user of such specialised knowledge to others in confidence against payment. There is no reason why payment for the user of such specialised knowledge, though not protected by a patent, should not be treated as royalty or in the nature of royalty.—Handley Page vs. Butterworth 19 Tax Cases 322 **relied on**.

(Para 7)

The nomenclature used by the parties in respect of a particular service would not be decisive of the matter but such nomenclature has to be construed on the basis of commercial principles. In the present case the assessee was entitled to receive from the Indian company 5 per cent of the net selling price of the manufacturing product as a consideration for supply of both technical assistance and information. It is significant that a distinction had been made in the agreement between technical assistance and information. Technical assistance may be rendered also by supply of information although such information by way of technical assistance would be information of general nature. But supply of exclusive and specialised information on the basis of which production and manufacture is possible, goes beyond the concept of assistance and falls into the category of a right of user of an exclusive property right. The information agreed to be supplied by the assessee in respect of working methods and manufacturing processes of the product under cl. 2(ii)(iii) are, therefore, exclusive information and knowledge available to the assessee and not generally disseminated and payment in respect thereof would bear the character of royalty. Assessment made as such was, therefore, justified.

(Para 8)

### Conclusion

Specialised technical information supplied by non- resident company to Indian company for user of such specialised knowledge can be treated as royalty or in nature of royalty as against technical services fee.

**Words & phrases—"Royalty"—Connotes payments, periodic or at a time, for user by one person of certain exclusive rights belonging to another person**

### Held

Term "royalty", connotes payments periodic or at a time for user by one person of certain exclusive rights belonging to another person—Examples of such exclusive rights are rights in the nature of a patent, mineral rights or right in respect of publications. Payment for the user of such specialised knowledge, though not protected by a patent, should be treated as royalty or in the nature of royalty.

### Conclusion

Term "royalty" connotes payments, periodic or at a time, for user by one person of certain

exclusive rights belonging to another person.

**DIPAK KUMAR SEN, J.:**

N.V. Philips Gloeilampenfabrieken Eindhoven, Holland, the assessee, is a non-resident company incorporated in the Netherlands. On 8th July, 1964, the assessee entered into an agreement with one Crookes Interfran Ltd., an Indian company, under which the assessee agreed to furnish to the Indian company technical information relating to vitamin D and its manufacture, use and sale, inter alia, on the following terms and conditions:

(a) The assessee would render to the Indian company all assistance and furnish information from time to time in respect of the working methods, manufacturing processes and methods of application relating to vitamin D.

(b) The assessee would provide the Indian company with the following data, assistance and information:

(i) Drawings with detailed instructions and directions for a plant to be set up in the territory specified in the agreement of a capacity of 1,000 kg. per annum producing vitamin D.

(ii) Data regarding working methods and manufacturing processes (including indications, instructions, specifications, standards and formulae), methods of analysis and quality control and other particulars to enable the Indian company to start and carry on the manufacture of vitamin D.

(iii) Medical and other information relating to the pharmacological and pharmaceutical properties of vitamin D.

(iv) The training of one or more technicians of the Indian company in the factory of the assessee in the Netherlands for setting up the plant as aforesaid and/or the placing at the disposal of the Indian company of a technical expert for the erection and initial working of the plant as also the training of an agreed number of qualified staff of the Indian company in the factory of the assessee in the Netherlands.

(v) Assistance to the Indian company in the initial costing of production and advice on problems in respect of establishment, installation, running and administration of the said plant.

(vi) Analysing in the laboratory of the assessee in the Netherlands samples produced by the Indian company free of charge of each batch of Vitamin D manufactured by the Indian company.

(c) Any information disclosed by the assessee to the Indian company under the agreement would be solely for the use of the Indian company, would be considered as having been disclosed in confidence and would not become the property of the Indian company until such time and to the extent that such information would become public by application and user.

(d) The Indian company would take all reasonable care to keep such information confidential and not disclose the same to third parties except as may be necessary in the actual and normal course of use thereof. The Indian company would obtain corresponding undertakings of secrecy from its employees in suitable form.

(e) The Indian company would undertake during the continuance of the agreement and thereafter not to copy the equipment, tools and instruments supplied by the assessee to the Indian company nor to cause or permit the same to be copied and not to prepare or permit the drawings thereof.

(f) The Indian company would pay to the assessee in consideration of the technical assistance and

information supplied 5 per cent of the net selling price of vitamin D manufactured and sold by the Indian company subject to Indian income-tax.

(g) The agreement would take effect from the start of the manufacture of vitamin D by the Indian company and would remain in force for ten consecutive years and would continue thereafter for a period of one year, unless terminated by either party giving to the other six months' previous notice in writings before the end of the original or the extended period.

2. In the asst. yr. 1973-74, the corresponding accounting year ending on 31st Dec., 1972, the assessee received a sum of Rs. 31,080 from Dupher Interfran Ltd., the successor-in-interest of Crooks Interfran Ltd., under the said agreement dt. 8th July, 1964. In its assessment to income-tax in the said assessment year, the assessee contended before the ITO that the said amounts had been received from the Indian company as and by way of technical assistance fees. The ITO in the first instance accepted the contention of the assessee and held that only 10 per cent of the receipts of the assessee from Dupher Interfran Ltd. would be treated as taxable income of the assessee as the same were technical assistance fees. The CIT subsequently set aside the said assessment under s. 263 of the IT Act, 1961 ("the Act"), as he was of the opinion that the payments received by the assessee from the Indian company were more in the nature of royalty than technical assistance fees. The assessee preferred an appeal before the Tribunal against the order of the CIT under s. 263. The appeal was unsuccessful.

The ITO, in the reassessment after construing the agreement in the background of Explanation II to cl. (vi) of sub-s. (1) of s. 9, held that it was obvious that technical assistance, know-how and information furnished by the assessee to the Indian company were nothing else but royalty. He made a distinction between technical assistance fee and technical service fee. He held that technical assistance fee was paid for passing on technical information and services rendered in connection therewith whereas technical service fee was paid for rendering actual technical services. He held that the assessee had received the payments from the Indian company in consideration of passing on of certain technical know-how and information and even if certain services have been rendered in connection therewith, the entire receipt would be taxed as royalty. The ITO noted that in the tax deduction certificates issued by the Indian company to the assessee, the said payments had been described as royalty. It was not in dispute that if the said amounts are treated as technical services fees, only 10 per cent of the amount paid would be taxable in the hands of the assessee, whereas if the said amounts were treated as royalty, 80 per cent of the same would be taxable in the hands of the assessee.

The ITO in making the assessment relied upon the order passed by the CIT under s. 263, where it was noted that the agreement was for a period of ten years and that the Indian company would not require technical assistance after the formative stage. The payment under the said agreement would continue during the entire term of the agreement. It was also noted that the payment was to be made on the basis of a fixed percentage of the turnover of the Indian company. This indicated that the payment was in the nature of royalty.

In the asst. yr. 1974-75, the payment received by the assessee from the Indian company, being Rs. 26,475, was also treated as payment received by the assessee on account of royalty by the ITO and taxed as such.

The assessee preferred an appeal from the said order of assessment before the CIT(A), who set aside the order of the ITO with a direction to make the assessment in terms of the directions contained in the order passed under s. 263 in respect of the asst. yr. 1973-74.

In the subsequent assessment made on remand, the ITO, following the assessment of the assessee for the earlier asst. yr. 1973-74, held that the payment received by the assessee from the Indian company was a payment in the nature of royalty and taxable as such.

Being aggrieved, the assessee preferred appeals from the said two orders of assessment before the CIT(A).

In construing the agreement between the assessee and the Indian company, the CIT(A) noted that in the agreement there was no separate provision for payment on account of any patent licence to be granted by the assessee. He held that payments were received for the entire services by the assessee which included supply of data, assistance and information and supply of technique for manufacture of products of the assessee in India on a fixed percentage of the net selling price of the manufactured products. He held that this payment had an element of royalty as also an element of fees. He came to the conclusion that 50 per cent of the payments received by the assessee from Dupher Interfran Ltd. was in the nature of fees for technical assistance and information and should be taxed as such and the balance 50 per cent should be treated as royalty and taxed in the hands of the assessee accordingly.

Being aggrieved, both the Revenue and the assessee preferred appeals from the order of the CIT (A) before the Tribunal.

Before the Tribunal, it was contended on behalf of the assessee that at the material time, the word "royalty" had not been defined in the Act, and, therefore, the general meaning of the said word had to be obtained from dictionaries. The assessee cited the Random House Dictionary and the Webster's New World Dictionary, where the word "royalty" was defined, inter alia, as (a) payment by lessee to the owner of the land for privilege of working mine; (b) the amount paid to a patentee for the use of his patent; (c) payment made to author for books, etc., sold.

It was contended that the payments by the Indian company to the assessee did not fall in any of the aforesaid categories as the assessee had not given any patent rights or copyrights or any trade name or the right to use the trade name of the products of the assessee. No licence had been granted to the Indian company by the assessee for manufacture of any item patented by the assessee. The definition of the word "royalty" in Explanation II to cl. (vi) of sub-s. (1) of s. 9 was incorporated w.e.f. 1st June, 1976. In the asst. yrs. 1973-74 and 1974-75, the artificial meaning given to the word "royalty" could not be ascribed.

It was contended on behalf of the Revenue before the Tribunal that Explanation II to s. 9(1)(vi) merely stated the position at law, as it always stood and, therefore, the same should be accepted in determining the nature of the payment made by the Indian company to the assessee in the assessment years involved.

The Tribunal held that cls. (v), (vi) and (vii) of s. 9(1) incorporated by the Finance Act, 1976, w.e.f. 1st June, 1976, were new pieces of legislation, prospective in operation and the same could not be taken into account for resolving the controversy involved. The Tribunal construed the meaning of the word "royalty" from dictionaries cited on behalf of the assessee and held that royalty was compensation or a portion of the proceeds paid to the owners of a right for the use of it. Payments made against patents or oil or mineral rights were illustrations of such payments. It was held that in the instant case, payments had been made by the Indian company to the assessee for use of rights in the nature of patent.

The Tribunal considered the definition of the word "patent" in the Patents Act, 1970, and the Indian Patents and Designs Act, 1911, and also the provisions therein for the grant and user of patents and held that a patent was a right recognised by law for exclusive use of an invention by the inventor who had obtained patent therefor or by his nominees or licensees against payment in lump or a periodic payment related to the turnover or in any other manner as agreed upon. Such payment would be a payment of royalty.

The Tribunal held further that an inventor could utilise his invention without obtaining a patent and it was not legally necessary for the inventor to obtain a patent. The inventor could exploit the

invention being information or knowledge of the secret process without getting it patented by sharing it with others against payment who would keep such information or knowledge secret and such payments would be payments for royalty.

The Tribunal held that in the instant case, it was open to the assessee to obtain patents in respect of the manufacturing processes of its products. The assessee agreed to impart to the Indian company the knowledge and information of the process of manufacturing itself for which the Indian company was required to make payment of a fixed percentage of the turnover and to keep the information received as secret. The Tribunal held that the payment made by the Indian company to the assessee on account of the aforesaid would be royalty.

The Tribunal held further that some of the information to be imparted by the assessee under the agreement, viz., providing data, assistance and information with regard to drawings and detailed instructions and directions of a plant to be set up in India by the Indian company as also general information with regard to the properties of the products to be manufactured would amount to rendering of a technical service and the payment received in respect of the same would not be a royalty.

The Tribunal held that the CIT(A) was justified in estimating a part of the payment as royalty and the balance as fees for technical services. In the facts, the Tribunal declined to interfere with the estimate made by the CIT(A).

**3.** On an application of the assessee under s. 256(1) of the Act, the Tribunal has referred the following question as a question of law arising out of its order for the opinion of this Court:

"Whether, on the facts and in the circumstances of the case and on a proper interpretation of the agreement dt. 8th July, 1964, between N. V. Philips Gloeilampenfabrieken and Crookes Interfran Ltd. (now known as Dupher Interfran Ltd.), the Tribunal was right in holding that so much of the payment made under cl. 5 of the said agreement as was referable to the provision of such data, assistance and information as have been referred to in cls. 2(ii) and 2(iii) thereof was to be regarded as "royalty" and not as technical service fees for the purpose of the income-tax assessment of N. V. Philips Gloeilampenfabrieken for the asst. yrs. 1973-74 and 1974-75?"

**4.** At the hearing before us, the learned advocate for the assessee contended that at the material time the word "royalty" had not been defined in the Act and, as such, the said word had to be construed from the commercial point of view. He submitted that any nomenclature given by the parties in the agreement would not be conclusive or decisive. He drew our attention to the following for the meaning and definition of the word "royalty":

(a) Jowitt's Dictionary of English Law, 1977 Edition: "Royalty, a payment reserved by the grantor of a patent, lease of a mine or similar right, and payable proportionately to the use made of the right of the grantee. It is usually a payment of money, but may be payment in kind, that is, of part of the produce of the exercise of the right."

(b) Encyclopaedia Britannica, 1972 Edition, Volume 19, page 676: In this treatise, "royalty has been described as the payment made to the owners of certain types of rights by those who are permitted by the owners to exercise the rights. The rights concerned are literary, musical and artistic copyright, rights in inventions and designs, and rights in mineral deposits including oil and natural gas. As to inventions, a royalty may be said to be compensation paid under a licence granted by the owner of a patent (the licensor) to another person (the licensee) who wishes to make use of the invention, the subject of the patent. The patent remains the property of the licensor. A licence may be exclusive, in which case the patent owner precludes himself from granting licences to third parties, or non-exclusive, in which case the patent owner may grant licences to as many persons as he wishes."

(c) Wharton's Law Lexicon : In this book, "royalty" has been defined as a payment to a patentee by agreement on every article made according to the patent; or to an author by a publisher on every copy of the book sold; or to the owner of minerals for the right of working the same on every tonne or other weight raised.

(d) Law Lexicon by Ramanatha Aiyer : In this book, "royalty has been defined to mean—(a) percentages or dues payable to landowners for mining rights; (b) sums paid for the use of a patent; (c) percentages paid to an author by a publisher on the sales of a book."

The learned advocate for the assessee drew our attention to the relevant provisions of the Patents Act, 1970. Under s. 48 of the Patents Act, a patent granted would confer upon the patentee the exclusive right to make, use, exercise, sell or distribute the invention in India by himself or by his agents or licensees. Under the said section, a patent can be granted for a method or process of manufacturing of any article. Under s. 5 of the Patents Act, a patent can be granted not for products prepared or produced by chemical processes but for the methods or processes of manufacture.

Relying on the aforesaid, the learned advocate for the assessee contended that in the instant case under the agreement between the assessee and the Indian company, the assessee had made available to the Indian company technical information and know-how. Such information and know-how as contemplated in the agreement do not stand on the same footing as protected rights under a registered patent. It was contended that there was no property right on such technical information and know-how until such special knowledge and skill exclusive to the person concerned could form the subject-matter of a patent. In such a case, the special knowledge and skill would come to constitute property in the hands of the person who had acquired or obtained such special knowledge or skill. Otherwise, mere imparting know-how for reward cannot be held to be conferring of any property right as such as in the case of a teacher who imparts his knowledge or skill to his pupils. Technical knowledge and advice cannot be treated as capital assets.

Learned advocate for the assessee next contended that the Tribunal itself had held that some of the information to be imparted by the assessee to the Indian company under the agreement would be of the nature of technical assistance and payment received therefor would be in the nature of fees for such assistance. In that view, there was no reason why other technical information and knowledge to be made available by the assessee to the Indian company should be treated differently and payment made therefor should be held to be royalty. The learned advocate for the assessee contended last that the fact that payment was being made to the assessee by the Indian company of a fixed percentage of the net selling price of the products manufactured and sold by the Indian company would not make any difference to the quality and character of payment. The measure or method of payment cannot determine the nature of the transaction involved.

**5.** Learned advocate for the Revenue contended, on the other hand, that on a proper construction of the agreement between the assessee and the Indian company, it would appear clear that the assessee had at its disposal information regarding working methods and manufacturing processes of its various products which was being made available by the assessee to the Indian company. It would appear from cl. 4 of the agreement that the information disclosed by the assessee to the Indian company under the agreement was meant solely for the use of the Indian company. The said clause further recorded that such information was being disclosed by the assessee in confidence to the Indian company and would not become the property of the Indian company till such information would become public. The Indian company was obliged to obtain similar undertakings of secrecy in respect of the information imparted by the assessee from its employees to the extent the latter would come to know of the same.

Learned advocate for the Revenue contended that it was apparent that such information made available to the assessee regarding methods and manufacturing processes were exclusive to the assessee and not available to the public in general. The assessee treated such information as its

own property and made it clear that such information to the extent made available to the Indian company would not become the property of the latter. The same was not meant to be disclosed to a third party.

It was contended that, under the agreement, the Indian company was permitted to utilise such information to be imparted by the assessee for the period of the agreement and the Indian company would pay for the use thereof at an agreed rate. If such information was not meant to become the property of the Indian company, the same necessarily remained the property of the assessee of which the Indian company had limited use for the specified period against periodical payment. It was contended on the aforesaid facts that part of the payment made by the Indian company to the assessee referable to user of such exclusive information would have the character of royalty though the assessee did not have a registered patent in respect of such methods and manufacturing processes.

6. In support of the respective contentions of the parties, a number of decisions were cited at the bar which are considered hereafter:

(a) Mills vs. Jones (1929) 14 Tax Cases 769 (HL). In this case, the taxpayer had made certain improvements on a hand grenade and had obtained a number of patents in respect of such improvements. During the great war, the British Government used the said invention and a large number of hand grenades were manufactured. After the end of the war, a Royal Commission was set up to deal with the question, inter alia, of payment to be made to inventors whose patent had been utilised by the Government during the war. The taxpayer received substantial payment from the Government in respect of the user, past, present and future for his patented improvements. The amount received by the taxpayer in the award was brought to tax. It was contended by the taxpayer that as the payment was being made, inter alia, for the right to use the invention in the future, a part of the said amount was capital receipt in his hands and could not be taxed. The matter was finally disposed of in the House of Lords. The facts found by the General Commissioners that large stocks of grenades were still in existence after manufacture and that the amount of the award attributable to future use was negligible were accepted and it was held that the taxpayer had been correctly charged to income-tax.

This decision was cited for the following observations made in Handley Page vs. Butterworth (1935) 19 Tax Cases 328 by Romer L.J. in the Court of Appeal which were relied on by the Revenue.

"A patentee has, of course, a monopoly, and that monopoly, which is a right of preventing other people utilising his invention, is a capital asset in his hands. He may exploit that capital asset in either or both of the following ways: he can himself exercise his invention for profit, or he can grant licences to others to do so on payment of royalty. The profit he derives by exercising the invention himself or the profit he derives from the royalty are profits and gains within the meaning of Schedule D, notwithstanding the fact that every year his capital asset is diminishing in value.....The owner of a secret process, such as was possessed by Mr. Handley Page, stands in a very analogous position; he has not a monopoly at law, but he has a monopoly in fact—a monopoly in fact arising from the possession by him of the secret knowledge of the process that he is carrying on. That secret knowledge is as much his capital asset as is the patent monopoly the capital asset of the patentee, and, like the patent, he can use that capital asset in either or both of the following ways: he can himself carry on the secret process or he may—it is very seldom done owing to the obvious danger involved—grant a licence to a third person to carry on the secret process, securing himself against his secret process being divulged by that third party to others. In both these cases, the profits he derives from carrying on the secret process himself and the royalty he might derive from the licensee would be annual profits or gains, within the meaning of Schedule D."

(b) Musker vs. English Electric Co. Ltd. (1964) 41 Tax Cases 556 (HL) : In this case, the taxpayer, a manufacturer of engineering products, acquired specialised information and technique in



engineering processes which it kept with itself. At the request of the British Admiralty, the taxpayer entered into an agreement with the former whereby it agreed to design and develop a marine turbine and to license the manufacture of turbines to other companies in the United Kingdom, Australia and Canada.

Later, the taxpayer at the request of the Ministry of Supply of the British Government entered into agreements with the Government of Australia and an American Corporation under which the taxpayer granted licences to the latter to manufacture a bomber plane which the taxpayer had designed and developed. Under all the aforesaid agreements, the taxpayer agreed to impart manufacturing technique to the licensees in consideration of which the taxpayer received a specified lump sum payment. On these facts, it was held by the House of Lords that the payments received by the taxpayer were trading and not capital receipts. The following observations in the judgment of Viscount Radcliffe were relied on by the assessee :

"There is no property right in 'know-how' that can be transferred, even in the limited sense that there is a legally protected property interest in a secret process. Special knowledge or skill can indeed ripen into a form of property in the fields of commerce and industry, as in copyright, trademarks and designs and patents, and where such property is parted with for money, what is received can be, but will not necessarily be, a receipt on capital account. But imparting 'know-how' for reward is not like this, any more than a teacher sells his knowledge or skill to his pupil.....The other point is that 'know-how', though very naturally looked upon as part of the capital equipment of a trade, is a fixed asset only by analogy and, as it were, by metaphor. The nature of receipts from it depends essentially, I think, upon the transaction out of which they arise and the context in which they are received."

(c) P. H. Divecha vs. CIT (1963) 48 ITR 222 (SC) : TC38R.787 : This decision of the Supreme Court was cited for the proposition laid down as follows :

"It may also be stated as a general rule that the fact that the amount involved was large or that it was periodic in character have no decisive bearing upon the matter. A payment may even be described as 'pay', 'remuneration', etc., but that does not determine its quality, though the name by which it has been called may be relevant in determining its true nature, because this gives an indication of how the person who paid the money and the person who received it viewed it in the first instance. The periodicity of the payment does not make the payment a recurring income because periodicity may be the result of convenience and not necessarily the result of the establishment of a source expected to be productive over a certain period. These general principles have been settled firmly by this Court in a large number of cases...."

(d) CIT vs. Cilag Ltd. (1968) 70 ITR 760 (Bom) : In this case, a foreign company entered into an agreement with its 60 per cent Indian subsidiary under which the Indian company was appointed the sole importer, distributor, processors and manufacturers of the products of the foreign company in India. The agreement further provided that the foreign company would provide the Indian subsidiary the know-how for manufacture of the active substances required for the conditioning of the products of the foreign company and also of the products in consideration of payment of 5 per cent of the actual cost to be computed on an agreed basis by way of compensation fee or royalty. On these facts, it was held by a Division Bench of the Bombay High Court that the royalties received by the assessee were income from business. The observation of Romer L.J. in the case of Handley Page vs. Butterworth (Inspector of Taxes) (supra) noted earlier, was quoted in the judgment of Desai, J.

(e) CIT vs. Hindusthan General Electrical Corpn. Ltd. (1971) 81 ITR 243 (Cal) : TC10R.402 : In this case, one of the questions which arose before a Division Bench of this Court was whether know-how made available and utilised for a long period by the person to whom it was made available would constitute a permanent benefit and the consideration received for such know-how would be a capital or a revenue receipt. Following the decision of the House of Lords in the case of Musker

(1964) 41 Tax Cases 556 (HL), it was held that by obtaining know-how, no capital asset would be acquired. The Division Bench observed as follows :

"Royalties, usually, are periodical payments for continuous enjoyment of certain benefits under a contract. In every case, payment of royalty is not a capital expenditure. In our case, the various types of payments that the assessee has to make seem to be closely related to the assessee's manufacturing processes of 'Simplex' products. In other words, these payments are intimately linked up with the manufacturing activities of the assessee and not with the capital value of the assets that the assessee would acquire. They cannot, strictly speaking, be said to be the purchase price of these assets. It is true that the assessee's foreign principals would be imparting their 'know-how' to the assessee for a reward; but that is nothing more than a teacher selling his knowledge or skill to his pupil. The assessee's foreign principals were merely supplying technical information to enable the assessee to carry on business in terms of the agreement."

(f) CIT vs. Gilbert & Barker Mfg. Co. (1978) 111 ITR 529 (Bom) : TC17R.1233 : In this case, it was held by a Division Bench of the Bombay High Court on facts that it was possible to make available know-how by one person to another on the basis of a licence and the same would be a method of carrying on a business by the person who has the know-how. The Court quoted with approval the observation of Romer L.J. in the case of Handley Page (1935) 19 Tax Cases 328(CA) which has been noted earlier.

(g) CIT vs. Ahmedabad Mfg. & Calico Printing Co. (1983) 139 ITR 806 (Guj) : TC5R.429 : In this case, the assessee, an Indian company, entered into an agreement with an English company under which the foreign company granted to the assessee sole and exclusive right and licence to manufacture, sell, distribute and exploit the products of the English company with improvements and modifications in India and the use of any Indian patent owned by the English company in respect of the said products. The English company also agreed to make available to the assessee or its authorised agents know-how within the knowledge of the English company for use by the assessee for manufacture of the products of the English company in India. The English company also agreed to make available to the assessee benefits or results of future research and development by the English company relating to its products and to furnish to the Indian company at the execution of the agreement secret or patent formulations used by the English company for the manufacture of its products. The assessee undertook to maintain secrecy of the formulation, methods and processing of products of the English company and all improvements or modifications thereof and further agreed not to disclose or give any other person in India the benefits of such research, invention or patents relating to the said know-how. Under the agreement, the assessee was required to pay 1 per cent of the net sale proceeds of the products manufactured by the assessee in India to the English company. Such payment was described as research contribution. No further fee or remuneration was payable by the assessee to the English company. The assessee contended that what it had paid to the English company under the head 'Research contribution' were, in fact, payments of royalty and liable to deduction of tax at source at a lower rate. The Revenue contended to the contrary. On these facts, it was held by a Division Bench of the Gujarat High Court that the agreement between the assessee and the English company was only for a period of 10 years and provided for exploitation of secret formulation, patent and various other rights of the English company by the assessee in India exclusively. The payment was a payment of royalty. The High Court considered the meaning of the expression 'royalty' as appearing in various dictionaries as also in foreign law on international commercial agreements.

(h) CIT vs. Dunlop Rubber Co. Ltd. (1983) 142 ITR 493 (Cal) : TC38R.1081 : In this case, the assessee was a non-resident English company and had a network of subsidiaries and associate companies all over the world. The assessee maintained technical research establishments in the United Kingdom from which latest information, processes and invention relating to goods manufactured by the assessee were communicated to its subsidiaries and associate companies. Under an agreement entered into by and between the assessee and its Indian subsidiary, the latter agreed to pay to the assessee a proportionate part of the cost and expenses including salaries and

research and development expenditure incurred by the assessee for acquisition, discovery and development of information, processes and invention. The Government of India permitted the Indian subsidiary to pay to the assessee research contribution to be paid on the volume of sales by the Indian company subject to a ceiling. The question arose whether the amounts paid by the Indian subsidiary to the assessee were payments of or in the nature of royalty or the same were merely reimbursement of expenses. It was held by a Division Bench of this Court on the facts as found that payment was made by the Indian subsidiary to the assessee for sharing of expenses of research. It was noted that the agreement did not provide as to ultimately what would happen to the information furnished by the assessee to the Indian subsidiary and it was observed that if the agreement provided that the information would belong either to the assessee or to the subsidiary on payment, then it could have been contended that the payments were either royalty or hiring charges for such information and as such taxable income.

(i) CIT vs. Stanton & Stavely (Overseas) Ltd. (1984) 146 ITR 405 (Cal) : In this case, the assessee, a non-resident company incorporated in the United Kingdom, entered into an agreement with the Indian Iron & Steel Co. Ltd. under which the assessee authorised the Indian company to use during the continuance of the agreement the information to be communicated to the Indian company for manufacture of the products of the assessee in a specified territory. The agreement further provided that the assessee would act as consultants of the Indian company on the manufacture of products of the assessee and would advise the Indian company on problems of technical nature and impart to the Indian company particulars of all improvements in the manufacturing technique of such product which would result from research carried out by the assessee during the continuance of the agreement. The assessee also agreed to provide to the Indian company during the continuance of the agreement a licence and authority to use its patents in respect of products manufactured by it. In consideration of the aforesaid, the Indian company agreed to pay to the assessee commission at a specified rate to be calculated on the net selling price of the products of the assessee manufactured and sold by the Indian company during the continuance of the agreement. The question which arose was whether the amounts paid by the Indian company to the assessee by way of commission were in the nature of royalty and fees within the meaning of r. 1(ix) and r. 1(x) of the First Schedule to the Companies (Profits) Surtax Act, 1964, and were required to be excluded from the total income of the assessee in computing its chargeable profits. A Division Bench of this Court affirmed the finding of the Tribunal on these facts and held that the amounts described as commission in the agreement between the assessee and the Indian company were in the nature of royalties and fees and were entitled to the exemption provided by the said rules of the said Act. This Court considered the dictionary meaning of the terms "royalty" and "fee". It was observed that the "nomenclature" used by the parties which were not defined in the statute were required to be construed on the basis of commercial principles and concepts as understood generally by people in trade or commerce. The nomenclature given by the parties would not be conclusive or decisive of the matter.

(j) Citizen Watch Co. Ltd. vs. IAC (1984) 148 ITR 774 (Kar) : TC30R.242 : This judgment is that of a learned judge of the Karnataka High Court delivered in a writ petition. In this case, the assessee, a non-resident company incorporated in Japan, entered into a collaboration agreement with the Government of India under which the assessee agreed to supply technical know-how to the Government for establishment of a modern watch factory in India. The Government set up a company known as Hindustan Machine Tools Ltd. wholly owned by the Government and transferred its rights, obligations and responsibilities under the agreement with the assessee to the Indian company. The agreement provided for payment of various amounts to the assessee for services and the technical know-how to be provided by the assessee to the Government or the Indian company. The said payments were respectively for supply of drawings and other information, a fee for technical and other assistance as agreed to as also a royalty at a specified rate to be calculated on the price of the watches to be manufactured by the Indian company. It was held by the learned judge that the amounts paid to the assessee by the Indian company on account of documentation and technical assistance fees were separate and were not payments of royalty or in the nature of royalty within the meaning of the double taxation agreement entered into by and between the

Government of India and Japan. The Court considered the meaning of the term "royalty" from the English and legal dictionaries and held that royalty is a payment made for the use of patent, etc., but did not include a fee payable for supply of documents and information.

7. In the instant case, in the agreement dt. 8th July, 1964, the assessee agreed, inter alia, to furnish information to the Indian company from time to time in respect of the following :

- (a) working methods,
- (b) manufacturing processes including indications, instructions, specifications, standards and formulae.
- (c) methods of analysis, and
- (d) quality control.

The agreement provided that any information disclosed by the assessee to the Indian company would be solely for the use of the Indian company. The same would be considered as having been disclosed in confidence and would not become the property of the Indian company till such information would otherwise become public by application and user.

The agreement further provided that the Indian company would take all reasonable care to keep such information supplied by the assessee as confidential and would not disclose the same to any third party.

It appears to us from the aforesaid provisions of the agreement that the assessee considered the information to be supplied to the Indian company by the assessee under the said agreement as exclusive and not generally available. The fact that the agreement required the Indian company not to treat the information furnished by the assessee as its own property indicates further that the assessee intended and treated the information to be supplied by it as its own property. Under the agreement, the assessee would be entitled to utilise and use such information for the period of the agreement.

From the dictionary meaning of the term "royalty", it appears that the said term connotes payments periodic or at a time for user by one person of certain exclusive rights belonging to another person. The examples of such exclusive rights are rights in the nature of a patent, mineral rights or rights in respect of publications. It appears to us that the person who grants the user of the exclusive right might have the sanction of law which guarantees the exclusiveness. Such sanction may be obtained by taking out a patent in respect of an invention. In other cases, such exclusive right would arise from the ownership of mineral rights and protected by the laws relating to property. In respect of books and publications, the exclusive right of the author is protected and sanctioned by the laws of copyright.

It is possible that a person who invents may not take out a patent for his invention but unless some other inventor independently and by his own efforts comes to duplicate the invention, the original invention remains exclusive to the inventor and it is conceivable that such an inventor might exploit his invention permitting some other person to have the user thereof against payment. Similarly, it is possible for a person carrying out operations of manufacture and production of a particular produce to acquire specialised knowledge in respect of such manufacture and production which is not generally available. A person having such specialised knowledge can claim exclusive right to the same as long as he chooses not to make such specialised knowledge public. It is also conceivable that such a person can exploit and utilise such specialised knowledge in the same way as a person holding a patent or owning a mineral right or having the copyright of a publication to allow a limited user of such specialised knowledge to others in confidence against

payment.

There is no reason why payment for the user of such specialised knowledge, though not protected by a patent, should not be treated as royalty or in the nature of royalty.

The analogy of a teacher imparting his knowledge to his students upon payment which has been cited on behalf of the assessee cannot apply on all fours to the facts before us. A teacher may have specialised knowledge but such knowledge is not exclusive. Such knowledge might be obtained from any other teacher who professes to teach the same subject. It is the exclusiveness of the specialised knowledge which can be utilised for the purpose of business which, in our view, would determine the issue. We agree respectfully with the observations of Romer L.J. in Handley Page's case (supra) which have been quoted with approval by our High Courts.

**8.** From the decisions cited before us, it appears that the nomenclature used by the parties in respect of a particular service would not be decisive of the matter, but such nomenclature has to be construed on the basis of commercial principles. In the case before us, the assessee was entitled to receive from the Indian company five per cent of the net selling price of the manufacturing product as a consideration for supply of both technical assistance and information. It is significant that a distinction had been made in the agreement between technical assistance and information. Technical assistance may be rendered also by supply of information although, in our view, such information by way of technical assistance would be information of general nature. But supply of exclusive and specialised information on the basis of which production and manufacture is possible, in our view, goes beyond the concept of assistance and falls into the category of a right of user of an exclusive property right.

**9.** For the reasons as aforesaid, we accept the conclusion of the Tribunal and hold that the information agreed to be supplied by the assessee in respect of working methods and manufacturing processes of the product under cl. 2(ii)/(iii) are exclusive information and knowledge available to the assessee and not generally disseminated and payment in respect thereof would bear the character of royalty.

**10.** For the reasons as aforesaid, we answer the question referred in the affirmative and in favour of the Revenue. The reference is disposed of accordingly without any order as to costs.

**SHYAMAL KUMAR SEN, J.:**

While agreeing with my learned brother, I wish to add the following:

**2.** The facts that the company would keep all information received from the assessee solely for the purpose of its use in its factory and would treat the same as having been disclosed in confidence and that it shall not become the property of the company until such time as and to the extent that such information or any part thereof becomes public. As a result, the user or disclosure really shows that the assessee treated the said processes and information as its own exclusive property and did not part with the same except on the above restriction. The analogy of a teacher in parting with his knowledge to the pupil cannot have any application because the teacher does not impose such restriction. It has been expressly provided in that agreement that the company agreed that it would take all reasonable care to keep such information confidential and not to disclose the same to any third parties and it only shows that this is in the nature of an exclusive right or property of the non-resident assessee and permission was granted only to utilise the same for its own specific use in a particular manner by the Indian company. It was further provided that the Indian company would not copy the equipment, tools and instruments or any part thereof supplied by the assessee to the company nor would cause or permit the same to be copied.

**3.** Although no licence has been granted by the owner of a patent in this case, this is analogous to

the position of a patent-owner granting a licence because this is really a permission granted to use the secret process exclusively in a particular manner and it is meant only for the Indian company and not to be disclosed to any third parties. Therefore, it is clear that the non-resident assessee itself treated the method of manufacturing process carried on by it as its exclusive secret process over which it had exclusive domain and wanted the same to be kept a secret and not meant for the public and granted the company right to utilise the same only in the aforesaid restricted manner. This secret knowledge in this case is as much its capital asset as is a patent, a monopoly and a capital asset of the patentee as observed by Romer L.J. in the case of Handley page (1935) 19 Tax Cases 328. This secret process which the non-resident assessee-company is parting with in this case is analogous to the parting of a monopoly right of the patentee and, therefore, the remuneration received by the assessee for the same should be treated as royalty and for the reasons as aforesaid, the answer to the question referred should be in the affirmative and in favour of the Revenue.

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