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Overlapping of IPR Rights: An Analysis

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An intellectual property right is a form of a legal right that safeguards for a set amount of time an individual's creative or literary works, inventions or discoveries, or symbols or designs. Because of the constant development going on all around us, it was essential to safeguard the intellectual property rights of those who owned it because without doing so, innovation and creativity would not be encouraged, and without such development, it would be impossible to expect the market to expand across a narrow border. To gain exclusivity over the production and sale of the same, India needed to defend its intellectual property rights not just on the domestic market but also on the global one. By demonstrating its dedication to the WTO under the Trade-Related Intellectual Property Rights Agreement (TRIPS)¹, the Indian government made significant strides. This ensured that India's position on intellectual property laws is recognized on a global scale. With the increase in the IP regime, the world is also witnessing an overlap among these laws. To understand the effect of the overlap of IP Laws, one also needs to understand how and in what aspects the laws are getting overlapped while claiming protection under these laws. In light of the above facts, this article tries to explain in detail the types of Intellectual Property Laws and the protection granted under them. This paper also tries to analyze the overlap among these laws with the help of case laws and interpretation of statutory provisions.

Keywords: *intellectual property, overlap, wto, trips, law.*

¹ Trade-Related Intellectual Property Rights Agreement 1869

INTRODUCTION

Human Talent includes a wide range of things such as creativity, innovation, and special skills. Intellectual Property means something created from a human brain. This is one of the most invaluable assets when compared with other assets. In recent years, it has emerged as one of the trending aspects of law from social media to health care to nearly all areas of literature, arts and technology. Our life revolves around Intellectual Property every time and everywhere. No matter what we do and where we go, human brain creations are always there. With the growing economies worldwide, we need to let out our hidden intellectual capital to work alongside each other. Effective Intellectual Property drives the world's economy. It plays an important role in wealth creation, providing a platform for businesses to innovate.

IP asset provides commercial benefits to businesses. IP Protection has become a 'must' requirement due to the simplicity involved in creating a close imitation of a logo, a template, a drawing or a poem. Therefore, we require strong IP laws which can add substantial value to our economy. IP Protection offers various advantages in terms of security, competitive advantage, customer loyalty, Income generation and raising capital. It can help to boost our economy. The main objective here is to protect the interests of an innovator without affecting the rights of the general public.

We have different kinds of Intellectual Property Laws such as The Trade Marks Act 1999², The Patents Act 1970³, The Copyright Act 1957⁴, The Designs Act 2000⁵, the Geographical Indications of Goods (Registration and Protection) Act 1999⁶, Protection of Plant Varieties and Farmers' Rights Act, 2001⁷, Semiconductor Integrated Circuits Layout Design Act 2000⁸, Biological Diversity Act 2002⁹ etc. However, one of the major issues while acquiring protection is

² Trade Marks Act 1999

³ Patents Act 1970

⁴ Copyright Act 1957

⁵ Designs Act 2000

⁶ Geographical Indications of Goods (Registration and Protection) Act 1999

⁷ Protection of Plant Varieties and Farmers' Rights Act 2001

⁸ Semiconductor Integrated Circuits Layout Design Act 2000

⁹ Biological Diversity Act 2002

‘overlapping’. The issue comes into existence when an innovator tries to seek protection under more than one law. The different kinds of IP laws and the area they aim to protect under Intellectual Property are as follows-

DIFFERENT TYPES OF IP LAWS

The Trade Marks Act, 1999¹⁰

A Trade Mark is a symbol, a logo, a label, a phrase, a design or a combination used by goods or services to differentiate it from other similar goods or services. The following are the essentials required to register a trademark¹¹. -

- The chosen mark should be able to be represented graphically.
- It should be possible to distinguish one business's products or services from those of other businesses.
- To show a relationship in the course of commerce between the products or services and some person who has the right to use the mark with or without that person's identity, it must be used, or proposed to be used, about those goods or services.¹²

The Patents Act, of 1970¹³: An invention is a product or a technique that, in general, offers a new way of doing something or presents a new technical solution to a problem. A patent is an exclusive right awarded for an invention. Technical details concerning the innovation must be made public in a patent application to obtain one¹⁴. Moreover, it should also not fall under Sections 3¹⁵ and 4¹⁶ of the Act which talks about non-patentable inventions. The following are the essentials required for patentability -

¹⁰ Trade Marks Act 1999

¹¹ ‘Trademarks’ (WIPO) <<https://www.wipo.int/trademarks/en/index.html>> accessed 04 March 2023

¹² ‘Frequently Asked Questions (FAQs)’ (IP India) <<https://ipindia.gov.in/faq-tm.htm>> accessed 05 March 2023

¹³ Patents Act 1970

¹⁴ ‘Patents’ (WIPO) <<https://www.wipo.int/patents/en/index.html>> accessed 05 March 2023

¹⁵ Patents Act 1970, s 3

¹⁶ Patents Act 1970, s 4

- It should be novel/new.
- There should be some innovation, not something very obvious.
- It should be capable of Industrial Application.
- It should not fall under Sections 3 and 4 of the Act¹⁷.

The Copyright Act of 1957¹⁸: Copyrights refer to the right given to the creators of dramatic, literary, musical, and artistic films and the work of sound recordings. Rights of reproduction, communication and translation of work are also included under this right. The Copyright protects the expressions and not the ideas. It is an automatic right that is generated with the generation of work. Titles, names, short words, short phrases and factual information do not get protection under this Act. To get a Copyright, the work should be original¹⁹.

The Designs Act 2000²⁰: The term "design" refers only to those elements of shape, configuration, pattern, ornament, composition of lines, colour, or combination thereof applied to any article, whether two-dimensional, three-dimensional, or in both forms, by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, and which in the finished article appeal to and are judged solely by the eye but does not include any Trademark or any artistic work as per Copyright Act²¹. Requirements for registration of Design –

- The design should be novel, however, a known shape or pattern can be applied to the new subject matter.
- It should be related to features of shape, configuration, pattern or ornamentation applied to an article.
- The design should be through some Industrial process. Paintings, sculptures etc which are not the outcome of the Industrial process cannot be registered.

¹⁷ Frequently Asked Questions (FAQs) (n 12)

¹⁸ Copyright Act 1957

¹⁹ 'Trademark, Patent, or Copyright' (*uspto*) <<https://www.uspto.gov/trademarks/basics/trademark-patent-copyright>> accessed 05 March 2023

²⁰ Designs Act 2000

²¹ 'Frequently Asked Question (FAQs) | Designs | Intellectual Property India' (*IP India*) <<https://ipindia.gov.in/faq-designs.htm>> accessed 05 March 2023

- The design should be visible in the finished article²².

Geographical Indications of Goods (Registration and Protection) Act 1999²³: Every region has something of its own. A particular product's reputation is built and maintained by combining man and nature and passing it over to generations. Over the years, a link between goods and the region is developed resulting in the growth of Geographical Indications. Requirements to consider a product as GI is –

- It should be an indication.
- It should be originating from a geographical territory.
- It helps in identifying agricultural, natural or manufactured goods.

OVERLAPPING OF IP LAWS

Intellectual Property laws provide various rights and hence sometimes, overlap between two types of laws or protection might happen and such overlap becomes unavoidable. The issue of overlap arises when protection is sought under two laws. We need to maintain a harmonious construction between the two and therefore we need to understand the overlap contextually and in detail. These laws are not constant, they keep changing with technological advances and business models. We often find ourselves in a confusing position for many products, for example, we still don't know the exact place of Computer Software in IP Fraternity. Therefore, we live in a world with flawed and imperfect solutions which takes us back to the debate of overlapping rights. Let us discuss the overlap between two laws one by one -

i. Patents and Copyrights

The Patents Act simplifies the Patent - Copyright issue regarding the overlap as it forbids copyrightable objects from patent protection. It says that "*literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television*

²² 'Designs Registration in India' (*IP India*) <<https://ipindia.gov.in/writereaddata/images/pdf/design-registration.pdf>> accessed 05 March 2023

²³ Geographical Indications of Goods (Registration and Protection) Act 1999

productions;” are not inventions within the meaning of this Act.²⁴ Copyright Act does not specifically mention the patentable subject matter, however, the idea-expression dichotomy as laid down in **R.G. Anand v M/S Deluxe Films & Ors**²⁵ ensures that all forms of expression are not subject to Copyright Protection. This concept says that Copyright law protects the creative way in which an idea is expressed and not the idea itself. There should be enough distinction between the idea and the expression as sometimes there is a very thin line between the two. To distinguish an idea from an expression, the case also laid down a seven-point test. Now the situation may also happen where it becomes very difficult to differentiate between an idea and its expression, that’s where the Doctrine of Merger applies. It means that the idea has very few forms of expression and protecting expression would mean protecting the idea itself. This doctrine has also been greatly dealt with in the case of **Mattel Inc. v Jayant Agarwalla**²⁶ (The famous ‘Scrabble’ game case).

Moreover, Section 52 (1)(w) of the Act says that “*the making of a three-dimensional object from a two-dimensional artistic work, such as a technical drawing, for industrial application of any purely functional part of a useful device*²⁷” does not amount to copyright infringement. This situation has been evident in **Catnic Components Ltd. v Hill & Smith Ltd**²⁸ where the plaintiff sued for the patent infringement of steel lintels. Here lintel was made from the Catnic Patent drawings and it was held that no breach of copyright has been made.

ii. Patents and Trademarks

Section 9 (3) of the Trademarks Act says that “*A mark shall not be registered as a trademark if it consists exclusively of –*

(a) the shape of goods which results from the nature of the goods themselves; or

(b) the shape of goods which is necessary to obtain a technical result; or

²⁴ Patents Act 1970, s 3

²⁵ *R.G. Anand v M/S Deluxe Films & Ors* (1978) AIR 1613

²⁶ *Mattel Inc. v Jayant Agarwalla* (2008) (153) DLT 548

²⁷ Copyright Act 1957, s 52(1)(w)

²⁸ *Catnic Components Ltd. v Hill & Smith Ltd* [1982] RPC 183

(c) *the shape which gives substantial value to the goods.*"²⁹

It says that trademark rights cannot be provided to a completely 'functional' element. Moreover, globally also, many medicines such as Rituxan, and Avastin are still going on through their tradenames even after their patents have expired.³⁰ One of the AI robots named Dabus makes inventions in the USA³¹. One of his inventions is a drinking container whereas the other is for help in rescue operations. Dabus can get trademark protection and the uniqueness of its AI can get patent protection. However, this AI knows whatever is inputted into it, if the same knowledge is given to another robot, it will perform the same. It becomes difficult to place it into one regime of Intellectual Property Law³².

iii. Copyrights and Trademarks

Copyright and Trademarks Act do not specifically restrain each other's subject matter from protection, however, Trade Marks Act under Section 11 says that no mark which has been got copyright protection earlier will be registered³³. Similarly, the Copyright Act also says that every object for protection should have a no-objection certificate certifying that there is no conflicting trademark registration.³⁴ However, there are various copyrighted works which are not registered and Indian law do not mandate upon registration. This brings out a loophole in the provision and unregistered copyright holders are at a disadvantage here.

Moreover, in the **Rovio Entertainment Ltd. v Royal Plush Toys**³⁵ case, Rovio Entertainment Ltd who owned the copyright of 'Angry Birds' video game filed a suit against Royal Plush Toys Inc where toys identical to the birds from "Angry Birds" were produced. Commonwealth Toy and Novelty Co, Inc produced toys after getting the licence agreement from the game makers. The

²⁹ Trade Marks Act 1999, s 9(3)

³⁰ Madhumitha Dharmapuri Selvakumar, 'Overlap of Trademarks with Other Intellectual Property Rights: The Strategies of Global Brands' (2022) 13 Beijing Law Review 429

³¹ Dharmapuri Selvakumar Madhumitha, 'A Robot in IP-The Issues and Need for Legislation' (2020) 25 Journal of Intellectual Property Rights <<http://op.niscpr.res.in/index.php/JIPR/article/viewFile/36713/465481112>> accessed 05 March 2023

³² *Ibid*

³³ Trade Marks Act 1999, s 11

³⁴ Copyright Act 1957, s 45

³⁵ *Rovio Entertainment Ltd. v Royal Plush Toys* [2012] 907 F. Supp. 2d 1086

plaintiff claimed that the consumers will get confused as to the product. The plaintiffs have the copyright over the image, the concept and the characters that are used in the movie 'Angry Birds'. The court rejected the copyright claim however when Rovio argued on trademark and the distinctiveness of the product, the court held that it might create confusion in the minds of consumers and so violates the Trademark Act.³⁶

iv. Copyright and Design

This aspect of overlap has been at the attention of the courts for a very long time now. Section 15 of the Copyright Act³⁷ says that "*Copyright shall not subsist under this Act in any design which is registered under the Designs Act.*" Moreover, clause 2 (2) "*Copyright in any design, which is capable of being registered under the Designs Act, 2000 but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his licence, by any other person*³⁸." This makes the right holder lose protection on both things. In the famous Scrabble game case³⁹, when Mattel, owner of the game, claimed copyright over the board as an 'artistic work', the court held that as the game has been produced more than 50 times and the game has not been registered under the Designs Act, it will lose its protection under the Copyright Act.

The Bombay High Court in **Pranda Jewellery Pvt Ltd v Aarya 24 kt**⁴⁰, ruled on the plaintiff's claim of copyright infringement, finding that under the name "Prima Art," the plaintiff had designed, advertised, and sold gold sheet products with images of gods and other religious symbols. The defendant was charged with producing identical gold sheet items with gods and other religious symbols. The defendants additionally argued that rather than being registered under the Copyright Act, artistic works were eligible for registration under the Designs Act after being used on a product more than 50 times through a particular industrial process. According

³⁶ "'Angry Birds' Toy Counterfeiter Slapped with Copyright and Trademark Injunction' (Mandour Law, 2020) <<https://www.mandourlaw.com/blog/angry-birds-toy-counterfeiter-slapped-with-copyright-and-trademark-injunction>> accessed 05 March 2023

³⁷ Copyright Act 1957, s 15(1)

³⁸ Copyright Act 1957, s 15(2)

³⁹ Mattel *ibid* (n 11)

⁴⁰ *Pranda Jewellery Pvt Ltd v Aarya 24 kt* AIR (2015) Bom 157

to the Honourable Court, an "artistic work" that meets the criteria to be considered an artistic work and is reproduced in any way is eligible for the necessary protection under the Copyright Act of 1957⁴¹. However, it would only be protected for a shorter length of time if it were to be applied in an industrial process or another comparable manner to design a product other than the artistic work itself in two- or three-dimensional form. The Designs Act of 2000's Section 11 makes the same provision.⁴²

We also found out that the case of **Jagdamba Impex v Tristar Products**⁴³, A copyright case involving 2D industrial drawings that were illegally used to make 3D comb-making equipment was settled by the Delhi High Court. Jagdamba began making combs with similar machinery that was later found to be based on Tristar's industrial plans. On appeal, however, the court pointed out that because the Combs' industrial designs had no independent existence, they did not meet the criteria for artistic works under the Copyright system. Tristar had been successful in putting a stop to Jagdamba's copyright violations. After the drawings were used in a specific industrial process to produce more than 50 combs, Tristar's right to copyright protection under Section 15(2) was ended. Additionally, because the drawings were not registered as designs, Jagdamba cannot be sued. Once Tristar submitted a Special Leave Petition to the Honourable Supreme Court, the Delhi High Court's decision regarding the termination of copyright protection was also overturned, and the trial court was asked to look into the matter. The trial court's ruling is still pending.

In **Microfibres Inc. v Girdhar And Co**⁴⁴, a US-based company sued an Indian trader for the infringement of copyright for a fabric. Here, the court held that as the fabric has been produced more than 50 times and not registered as 'Design', it cannot avail of 'Copyright' protection. Moreover, why get a design registered under Designs Act, when one gets automatic copyright with the generation of the 'artistic work.' Also, if the concern is that design that is industrially

⁴¹ 'Copyrights Producing Jewellery Articles Using Designs Article Different from Artistic Work' (*Lakshmikumaran & Sridharan Attorneys*, 28 April 2015) <<https://lakshmisri.com/newsroom/news-briefings/copyrights-producing-jewellery-articles-using-designs-article-different-from-artistic-work/>> accessed 05 March 2023

⁴² Designs Act 2000, s 11

⁴³ *Jagdamba Impex v Tristar Products* (2014) (59) PTC 149 (Del)

⁴⁴ *Microfibres Inc. v Girdhar And Co* (2006) (32) PTC 157 (Del)

produced needs to be protected for a standard of 15 years while Copyright gives protection of the lifetime of the creator plus 60 years, then it can be amended and brought down to 15 years.

Though, it was laid down in **Microbes Inc. v Girdhar**⁴⁵ And Co that works created for industrial application cannot be termed as 'artistic works' under the Copyright Act. But this adds to the confusion as we cannot be sure about the intent of the artist whether it is for industrial application or not. In the Upholstery case, it was held by the Judge that " *The conscious intention of the craftsman will be the primary test of whether his product is artistic or not*".⁴⁶ Thus, it still requires the attention of the judicial courts.

v. Design and Trademark/Passing Off

Section 2 of the Designs Act gives protection to any shape, work, or package designs that are used for commercial purposes. If the design used is only for the visual appearance then it gives a technical effect, however, if the design represents a product or it can be said that if a product is recognized through its design, then it has to be registered under Trademark Act. Even if a design gives substantial value to the product, it cannot fall under the Trademark regime as laid down in the case of **Carlsberg Breweries v Som Distilleries and Breweries**⁴⁷. The concept of passing off is a common law tort that has been used in place of the Trademark Act for a long time now. It refers to the situation when a person sells his goods as the goods of another which damages the goodwill or reputation attached to the trademark.

This overlap brings us to the simultaneous analysis of a few cases. In **Tobu Enterprises v Meghna Enterprises**⁴⁸, the court rejected the plaintiff's plea to claim protection under two IP Laws. Here the plaintiff claimed violation of its shape under the Design Act as well as under the common tort of passing off. Moreover, it was also laid down that Designs Act does not exclusively provides for a savings clause the way the Trademarks Act do. The right of the passing off is subject to the statute in regards to which it is in dispute. Contrary to this, the court

⁴⁵ *Microbes Inc. v Girdhar* (2006) DLT 238

⁴⁶ *Hensher v Restawhile Uphosltery* [1974] 2 All ER 420, 439-40

⁴⁷ *Carlsberg Breweries v Som Distilleries and Breweries* (2018) SCC OnLine Del 12912

⁴⁸ *Tobu Enterprises v Meghna Enterprises* (1983) PTC 359

in the case of **SmithKline Beecham v Hindustan Lever**⁴⁹ held that there is nothing wrong in obtaining protection under two IP Laws. Here the plaintiffs not only claimed protection for S-shaped toothbrushes under Designs Act but also under the common law tort of passing off.

Again, the court in the case of **Micolube India Limited v Rakesh Kumar Trading As Saurabh**⁵⁰ took a similar view as of the Tobu Enterprise case. Here, the plaintiffs who sold petroleum products sued for infringement of their registered design under the Design Act and also under the common law of passing off. The judge relied on the same view regarding Section 27 of the Trade Marks Act.⁵¹

vi. Trademarks and Geographical Indication

*“A geographical indication (GI) is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. To function as a GI, a sign must identify a product as originating in a given place.”*⁵²

Geographical Indication is similar to a trademark however its registration under the Trademarks Act is not possible due to Section 9(1)(b)⁵³ which forbids marks solely of geographical origin from registration. A trademark is given to a single product whereas GI is given to a large community. GI's focus mainly relies on the source, origin and quality of the goods. Art 22⁵⁴ and Sec 25⁵⁵ of the TRIPS agreement and Geographical Indications (Registration and Protection) Act respectively say that a trademark consisting of GI will be cancelled if it creates uncertainty in the minds of consumers regarding the origin of goods.

In the case of the **Tea Board of India v ITC Ltd**⁵⁶, the plaintiffs sued the defendants for their GI infringement claiming that they have fraudulently used the word 'DARJEELING LOUNGE' for

⁴⁹ *SmithKline Beecham v Hindustan Lever* (2000) PTC 83 (Del)

⁵⁰ *Micolube India Limited v Rakesh Kumar Trading As Saurabh* (2013) 99 DLT 740

⁵¹ Trade Marks Act, s 27

⁵² 'Geographical Indications' (WIPO) <https://www.wipo.int/geo_indications/en/index.html> accessed 28 February 2023

⁵³ Trademarks Act 1957, s 9(1)(b)

⁵⁴ Trade-Related Aspects of Intellectual Property Rights Agreement 1995, art 22

⁵⁵ Geographical Indications (Registration and Protection) Act 1999, s 25

⁵⁶ *Tea Board of India v ITC Ltd* CS No 250/2010

their business premises. The court held that there is no infringement of their GI right as 'DARGELLING LOUNGE' is not used in tea. Moreover, GI Act is confined to goods only this name was used for food and refreshments by the defendants which was a service. Again, in the case of **Imperial Tobacco Company of India Ltd v Registrar of Trademarks**⁵⁷, a trademark for the product tobacco having the name 'Simla' was not granted as it can create confusion as to the origin of the product in the minds of consumers.⁵⁸

CONCLUSION

To enlarge the pool of creative and innovative knowledge for societal advancement, intellectual property law is based on the principle that encouraging innovative and creative activities by granting restricted property rights for the fruits of such activities. The fine balance struck under each body of intellectual property law is undermined by overly overlapping protection. Expanding the subject matter covered by patent, copyright, or trademark protection should only take place if it doesn't conflict with the careful compromises made under each of the other bodies of intellectual property law. It is possible to avoid unintentional overprotection of intellectual property that would distort the balance in favour of creators' and innovators' rights at the expense of the general public by keeping in mind the delicate balance between protection and public interest.

⁵⁷ *Imperial Tobacco Company of India Ltd v Registrar of Trademarks* AIR (1977) Cal 413

⁵⁸ *Ibid*