

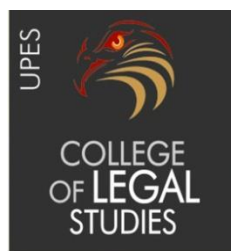
**OVERLAPPING OF INTELLECTUAL PROPERTY RIGHTS: AN
ANALYSIS WITH REFERENCE TO CONFLICT VIS-À-VIS DESIGN,
TRADEMARK, COPYRIGHT AND PATENT**

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Submitted under the guidance of:

Assistant Professor Ms. Eira Mishra

**This dissertation is submitted in partial fulfillment of the degree of B.
Tech. Energy Technology, LL.B. (Hons.) with specialization in IPR**



College of Legal Studies

University of Petroleum and Energy Studies

Dehradun

2017

CERTIFICATE

This is to certify that the research work entitled “**OVERLAPPING OF INTELLECTUAL PROPERTY RIGHTS: AN ANALYSIS WITH REFERENCE TO CONFLICT VIS-À-VIS DESIGN, TRADEMARK, COPYRIGHT AND PATENT**” is the work done by **Krishnam Goyal** under my guidance and supervision for the partial fulfillment of the degree of B. Tech. Energy Technology, LL.B. (Hons.) with specialization in IPR at College of Legal Studies, University of Petroleum and Energy Studies, Dehradun.

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DECLARATION

I declare that the dissertation entitled “**OVERLAPPING OF INTELLECTUAL PROPERTY RIGHTS: AN ANALYSIS WITH REFERENCE TO CONFLICT VIS-À-VIS DESIGN, TRADEMARK, COPYRIGHT AND PATENT**” is the outcome of my own work conducted under the supervision of Assistant Professor Eira Mishra, at College of Legal Studies, University of Petroleum and Energy Studies, Dehradun.

I declare that the dissertation comprises only of my original work and due acknowledgement has been made in the text to all other material used.

Krishnam Goyal,

15/03/2017

TABLE OF CONTENTS

1. Introduction to doctrine of Overlapping: Defining trajectory for protection of moral to economic rights under one umbrella	01-14
1.1 Background of this research	01
1.2 Current Scenario of Overlapping	06
1.3 Importance of IPR: Some benefits that Overlapping can hamper	09
1.4 IPR Bargain: Conceptualizing the two-end benefits of IPR	10
1.5 Overlapping causes theoretical absurdness	12
2. Interface between Patents and Designs	15-25
2.1 Hypothetical: the critical cloth dryer	15
2.2 Analysis of Overlapping of Patents and Design Law in Apple V Samsung Case	18
2.3 Doctrines having application of Overlapping of IPR	19
2.4 International Panaroma of interface:	22
2.5 Anti-Overlap Provisions	23
2.6 Conclusion	24
3. Overlap between Designs And Trademark & Trade Dress	26-37
3.1 Introduction	26
3.2 Overlap of Trade dress, trademark and Designs	28
3.3 Understanding the family of design and trademark & trade dress	30
3.3.1 Product design trade dress	

3.3.2 Product packaging trade dress	
3.4 Alternate route to trademark protection	30
3.5 Elaborating Conflict of Trademark and Design in Indian context	32
3.6 Sidelineing Overlapping conflicts	34
3.7 Co-existence of design and trademark	35
4. Coinciding elements of copyright and design law	38-56
4.1 Introduction	38
4.2 Meaning of <i>Design</i> and <i>Copyright</i>	42
4.2.1 Berne Convention	
4.2.2 Role of the Paris Convention	
4.2.3 Role of TRIPS Agreement	
4.3 Jurisprudential Study of the interface between the Design and the Copyright	53
4.4 Sui Generis Design Law's potency	53
4.4.1 Resolution of the problem: an innovative approach adopted in a landmark case	
5. Overlap of copyright and trademark	57-67
5.1 Visionary Overview	57
5.2 Diverse inception, attribution, and expansion of trademark and copyright law	59

5.3 Mutant Copyright by additional trademark protection dilutes public interest	61
5.4 Analytical review of overlap with the inclusion of new classes of mark in accordance with law in-force in Russian federation	62
5.5 Conclusion	66
6. Difference and Conflicts between Patents and Trade secrets	68-75
6.1: Introduction	68
6.2 Analysis of hypothetical situation	72
6.3 Integration of IP Rights	73
6.4 Conclusion	74
7. Practical aspects of Overlapping vis-à-vis enforcement of overlapping IP rights	76-85
7.1 Introduction	76
7.2 Court's view on establishment of overlapping regime	78
7.3 Suggestion to reduce overlapping problems	82
8. Conclusion & Recommendation	86-90

ABBREVIATION

AIR	All India Reporter
Anr.	Another
CCPA	United States Court of Custom and Patent Appeal
Cir.	Circuit
Corp.	Corporation
Hon'ble	Honorable
IPAB	Intellectual Property Appellate Board
Ors.	Others
PCT	Patent Cooperation Treaty
PTC	Patent and Trademark Cases
PTO	Patent and Trademark Office
RPC	Reports of Patent, Design and Trademark Cases
SCC	Supreme Court Cases
TRIPS	Trade Related Aspects of Intellectual Property Rights
USPTO	United States Patent & Trademark Office
V.	Versus
WTO	World Trade Office
WIPO	World Intellectual Property Office

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Chapter 1: Introduction to doctrine of Overlapping: Defining trajectory for protection of moral to economic rights under one umbrella

1.1 Background of this research

Intellectual property rights refer to admissibility of wide range of intangible assets for their protection by law and order. These legal rights are not very different to the traditional rights and are also governed holistically by basic procedural codes and common law approach, but IPR is considered to be a totally different set of niche having recognition to modern assets and advanced knowledge for a limited period of time. However, this specie of law is widespread worldwide comparatively in a short span among all classes of the society due to the high commercialization, public interest, social interest, nation's integrity & security, economical value, to name a few are heavily duped with this modern law which is a driving force to greater economy of all the leading countries.

Intellectual Property Rights are the rights given by the statutes to an individual or a venture related with the result of their insightfulness, which ensures select control over the abuse of their work temporarily. The question of security here is by and large "a work of the mind" or the human brains. Essentially, Intellectual property includes two fundamental branches, to be specific design and copyright. Copyright is fundamentally concerned with scholarly, melodic and imaginative manifestations, for example, books, music, craftsmanship, movies and projects and exhibitions and articulations of fables and, all the more as of late, another sort of material work media rendering generation is gotten to through a PC program. Industrial property, then again, geographical indications, trademarks, patents, industrial design and epithets of source, utility models, and so forth.

The proprietor of the intellectual property can flourish its economic strength with the use, exploitation and commercialization of the assets. Most importantly by way of licensing, technology transfer agreements, royalty basis, IP strategy and others helps to identify the strength of its IP which can acquire maximum benefits to the owners. These benefits can be in form of monetary advances, cross-licensing, standardization etc to recoup the

investments made to generate the IP. The maximum investments are made for inventions and innovations to acquire the patent rights for the product or process.

Most of the nations across the globe lack basic understanding of special laws and reasoning to enforce IPR laws. On the contrary, the developed and developing nations are trying to leverage IPR to the extent that they vision the transformation of their traditional economy to the knowledge based economy so to acquire high status among the competing nations. The developed nations hereto mean the nations having best understanding of IPR and its associated branches; in this matter, Japan, EU& USA are to be considered the veterans of the IP.

IPR is broadly classified as an outcome of the intellect of the person or a human mind which shall be capable of protection for moral values, economical values or both. To protect this interest, it was distributed among different branches for better margining of liabilities, rights and duties pertaining to one kind of the asset and subsequently for different sets of assets. For instance, a century before, the IPR was majorly streamed into Copyrights, Trademarks, Design and Patents. The named branches of IPR were used to recognize and differentiate amongst the work that would best fall in the given category. However, with the growth in industrialization, human intellect and creativity, education and technology the margin chalked years before for bifurcating the kind of IP, presently stands fainted to noticeable extent. This dilution is termed as ‘overlapping of IPR’ in most of the jurisdictions and are becoming the bug into generous IP system to shield the IP owner under multiple umbrellas of protection to perpetuity, which hinders the growth and development of the public interest. For instance, the best story that makes the concept of overlapping very easy to understand is of the Walt Disney company, owner of the trademark and copyright “Mickey mouse”. In this particular matter, the Walt Disney Company has attempted successfully, until otherwise in future, to enjoy protection until perpetuity of one artistic work under both the trademark and copyright law.

The trademark and copyright protection’s imbrications signifies that in addition to the increased protection available to the owner of the property under the Trademark’s as well as the copyright’s regime, it also reveals retention of several other interests of the general

public, market rivals, subsequent authors and so on preventing it from under the public domain. In any case, where the copyright expires, the public interest lies in the “right to copy”, make cause to make fare use of it, and also create a derived work out of it. In spite of the availability of these rights under the Copyright law, if the same work is protected under the trademark law also, public is denied of them in the event both the protections are available.¹

Not only the creation of replicas of work protected under trademark and copyright face such a difficulty due to the imbrications of the protection characters between them, but also the same difficulty arises when cartoon characters are a part of it. The overlapping of intellectual property protection has emerged in a number of areas, particularly by accretion rather than by design. Historically, patents, copyright and trademark were considered to protect entire different characters possessing assets as a result of it there was no overlap between the different regimes as they were so diverse about the nature of work these streams of law were concerned about. As these problems arose, the Courts and law makers served several doctrines to draw imaginary lines limiting the scope of each IP within their respective realms. Though, the separation was not so clear or well defined between the three streams, it was assumed that any creation or original work would fetch protection under only one of the regimes.

It is noteworthy that some idiosyncrasies in relation to the trade have the potential of being protected under the umbrella stretched by several intellectual property reigns. The same software seeks protection under the following: patent’s ambit for the reason of it being helpful in finding a solution for an ingenious problem, copyright for the “literary work” which is inculcated in the creative content of it, trademark law protects the symbols or the indicia representing the particular goods or the service’s origin, quality etc. It is not too old when the design patents were not accorded recognition among other intellectual property rights and survived without any title or scrutiny. But with the advent in the technology and subsequently such disputes arising out of it such as the one that arose between Apple and Samsung dragged the market’s attention towards the vital

¹ Viva R. Moffat, Mutant Copyrights & Backdoor Patents: The Problem of Overlapping Intellectual Property Protection, Berkeley Technology Law Journal, 2004.

enrichment of the design patents in the family consisting of other Intellectual properties. The design which can be protected under the Law of Trademarks concerning the source indicators of the product or service can also avail protection under the Copyright Law for the manner in which it is expressed and the main point is revealed in the fact that it can be protected as a design patent too due to its overlapping feature.

In India, this issue has been dealt in detail² by the Honorable Delhi High Court and the matter has been settled especially with respect to “section 15, Copyright Act, 1957” by the persistent adjudication in several cases.

The intellectual property owner's of course has a different prerogative; overlap between IP realms is generally not a concern from his point of view. The main function of availing protection over a single piece of work under more than one IPR permits the owner to enforce the second approach in the situation where the first one fails to protect it and also where the first one comes to an end. Taking a vision of it from the IP user's view, it creates a kind of additional layer of protection to the previous asset and makes it difficult for the users and the rivals to find a way to exploit it. That implies that even after the expiration of the term of protection awarded to a design patent, it does not come to the public domain and so cannot be utilized by others for the purpose of excelling in the competition or advancing it without any restrictions put forward legally. With the happening of this, it is very obvious for the intellectual property exploiter to feel that even the completion of the tenure of the design protection would fetch them nothing and would make no difference to them and this will lead to frivolity to the time bound nature of IPRs.

The position of overlapping is at a stage of uncertainty in all the jurisdictions; the US courts are found giving contrary views on the overlapping. Also, the practice of the election doctrine vindicates the view of the Courts whereby the overlapping appears to be a right of the owner, wherever overlapping is possible. Certain commentators, academicians and jurists have claims and arguments in favor of the multiple protections.

²(1) Microfibres Inc.; (2) Mattel Inc and Others; (3) Dart Industries Inc. and Another v (1) Girdhar and Company and Another; (2) JayantAggarwalla and Others; (3) Techno Plast and Others

According to them, the owner of the particular asset shall not be deprived from leveraging the IP to the fullest possible extent as it is his right to incur all possible dues from his IP. Thus by giving additional protection and further time to enjoy the protection will credit to his dynasty of hard work, creativity and intellectual strength. This could have been a notion adopted by the courts to avoid being a settler or the moderator in the disputes arising out of the overlap between the different segments of the intellectual properties that it has been well established by the doctrine allowing overlap of not only the segments but also the rights of the owners and so instituting any limitation on them would not be a good approach. The reason for the inaptness of such an approach is that it diminishes the actual burden of the protection's scope. On the contrary, the courts may ask the intellectual property owner to opt for any of the doctrines or select among the various protections available for his subject matter and relinquish others if availing in some other form. Nonetheless, soliciting the proprietor from licensed innovation to pick between teachings is hard to set up with the current government protected innovation framework, in which Congress considers the presence of overlapping rights. On the other hand, "the obligation to participate in a form of protection, either explicitly or by omission, requires careful consideration of the nature of future uses of income streams, and doctrinal contours, which may be difficult to predict ab initio."³

In the above matter, the courts took the stand of some antithetical considerations which were not at all expected on their part. The notion taken up by the courts like the US Supreme court was that if a subject is capable of being protected under one of the realms, never means that it cannot be protected under any other law and so they no reason for restricting the ownership in a particular intellectual property. Supreme Court of USA along with several other courts has rejected the claims of overlapping and exorbitant benefits of the IP. Therefore, the owner shall make the right choice at the time of elections, if its IPR is capable to attract multiple IP protection and shall not seek additional advantage when the first IP is expired.

³ Laura A. Heymann, *Overlapping Intellectual Property Doctrines: Election of Rights versus Selection of remedies*, College of William and Mary Law School, Faculty Publications, 2013.

1.2 Current Scenario of Overlapping

Current condition of IPR is over blasted with various essences related to the creation of several articles or even inventions which have their applications not restricted to one subject of IPR. With advancement in every IP the market outside the square of predetermined IP has lost its existence due to numerous new emerging concepts which has their roots contained not only in one kind of the IP but has various application. This paper tries to identify all the inherent boundaries that are associates with similar intellectual property that can persuade protection via more than one regime. The best example that describes today's situation is of an artist who prepares an artistic work and claims the copyright for his creativity under the Indian Copyright Act, 1957. With all due intentions, that person copies his art and applies on the articles which entail all the components of the design law, 2000 as a valid design falling under the ambit of Section 2(d) of Design Act 2000. The situation would have been obnoxious if the application was not at all enforceable regarding the Section 15 of the Copyright Act.

In court, the *Bleistein c. Donaldson lithography Co.*⁴ brought a turning point by laying down that it could not be a reason for denying protection to something under the copyright law that it was in a commercial zone and the art associated with it was used for the purpose of trade and commerce and not purely aesthetic. Therefore, the scope of copyright did not return to the question of whether a paternity book was a prior familiarity or came to existence in the esoteric wave of arts, and not the work which is required to be containing minimum creativity and obviously originality, the protection was still subsisting in it when it was used for commercial purposes. The increased category of the acts amounting to copyright infringement sweeping not only the production of identical replica but also the works "substantially similar" to the one protected already under the copyright law has made the tracking of the boundaries between the design patents and copyright a difficult task. Accordingly, while a pundit may write in 1975 that, accepting an old telephone packaging was ensured by patent and copyright design, "upon the expiration of the patent design, the design would be free for

⁴ 188 U.S. 239, 251-52 (1903)

public use", the remaining copyright which would be to secure the proprietor against the servile duplicate of his previous abiding and any critical variety of a comparative case could cause the cancellation of an action for copyright infringement", such assertion is not supported by modern jurisprudence.⁵

Explaining the situation with another example of malicious threat of overlapping that curtails the theory of public interest and public domain, the owner of a copyright work after gaining popularity for his artistic work or photography persuades to acquire the trademark on the same copyrighted work to attain monopoly till perpetuity. The potential harm that is caused by the overlapping of Intellectual Property system is to the destitute public who are left with ineffectual application of any IP after the expiry of first IP as the same asset is hung by another IPR. It is due to the time bound protection given to the article by the copyright law which is not the same as in the trademark law.

When talking about the trademark and patent laws which are very different in their theory and approach to protect totally different set of rights are yet overlapping due to the blend of technology and creativity that have arisen. The US Supreme Court⁶ faced the dispute whereby the Court has rejected the plea of a proprietor to use the right associated with the trademark even after the protection attained under the patent law comes to an end. "right to copy" in the context of the public was also guaranteed in relation of the patent. "patent backdoor" was the term coined for the attempt made to grant additional protection to an item falling under the patent law subject. Following the threat of overlapping, it can become really difficult to bifurcate between the rights concerned with the morality and the other with the economics. Furthermore, the apprehension now is that the gradual increase in overlapping is morphing the IP holders to move towards the economic rights from the moral rights. Copyright's earlier focus was on the recognition of the associated rights vested with the owners or the creators of the piece subject to the protection under the law of copyright sweeping jurisdiction in the civil law than in other jurisdiction of

⁵ Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH., 2014.

⁶ *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001)

common law. The rights vested in them includes the right of anonymous or even pseudonym publication , maintain work's integrity, etc.

The connection between the patent law and copyright law presents a remarkable paradox. This also includes the utility patent law when the invention is not able to make up to the patent regime. The patent and copyright share the similar fundamental principles but are widely distinctive in their applications and details. However, they still overlap in one of the widely recognized element of software applications. Even the legislatures have tried to discriminate the protection of software from entering into the pit of overlapping in Indian legal system, which is similar to the US system. Indian patent act under section 3(k) makes it clear that the software programmes/ computer programmes are not patentable per se, i.e. there should be structural limitations to the patent claims whereby the software codes do not entirely become the subject of claims, and there shall be some application of the computer program by the software codes. Possibly now, the computer codes are subject to literary work under the copyright code and there object code is protected as any other literary work. However, the owner of the software codes receives indefinite number of objections and rejections worldwide for their malicious attempts to get a software code protected under the patent regime. This kind of attempt is largely identified by various patent offices and they are strictly rejecting such claims.

Nevertheless, the dividing line between copyright and patents or utility patents is implicitly in the two categories of protected activity in the US constitution: 'Writings and Discoveries'. Structured by statutes and interpreted by the Courts, the respective fields have extended beyond mere writings and discoveries, and the dividing line has submerged in this development.

For the reason that brands as well as the design patents are aligned in various kinds of purchaser's reactions does not point out that both are not or less probable to be simultaneously or subsequent to make design and copyright patents. In fact, in practice, it is more likely that the affirmation of patent protection simultaneously or design sequentially and protection of branded clothing, the grievance derived from similar

patents and copyright design.⁷ As Sarah Burstein writes, if the design in question is an applied design (it located in other words, essentially in the upper part and is conceptually separable from the underlying product), you can be protected by the copyright and by a design patent. Given the long duration and favorable cost of acquiring copyright protection and the reason that protection is granted to the copyrighted work not after the examination of it and when it is found to be copyrightable but from “ fixation time” would like to prefer to pursue copyright protection rather than the design protection.⁸ On the contrary, since the protection on the grounds of trade dress or “brand protection” can be availed only after the brand attains a position which is well known and so specific in the market, and that too period of one year or more, an owner of intellectual property could be more motivated to seek registration under the design patent even before the design is published or introduced in the market, especially if (as currently specified in the present), the time period for acquisition of patent design the order of months.

1.3 Importance of IPR: Some benefits that Overlapping can hamper

- a. The intellectual property rights are granted to the property owners over their property which is protected and the rights are availed to them so that they can reap as much as they can from the output or which they invested their time, labor and even .
- b. In addition, the protection also ensures and upholds the innovativeness, creativity and inventiveness in relation to the intellectual property rights forcing the owner to disclose their work for the purpose of having non- exclusive rights and such license in the favor of mankind at large.
- c. The protection of such assets lead to the creation of propitious surroundings to resolve the issue of technology transfer with the help of the protection it offers to the patent. In order to attain foreign investments, it serves as a medium in the prevention of the cultural heritage and the folklores

⁷ See, <http://patentlyo.com/patent/2013/01/design-patents-are-still-relatively-quick.html>, last available, 26/02/2017

⁸ Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988

- d. In addition, the trade and commerce are also influenced by the encouragement and protection of the intellectual property rights. In addition, it creates wealth for not only the corporation but also for the individual at large leading to a wealthy nation through the medium of royalty, fees and foreign exchange as its byproducts.
- e. Conclusively, it can be stated that almost all the fields of human endeavor have been overlapped by the intellectual property rights including communications defense, information network by nuclear weapons' development, microcomputers and the Internet. Other areas are, artistic, marine, literary, petrochemical, cinematographic, sound recordings, musical, software, pharmaceuticals and biotechnological inventions, innovations, trade strategies and aviation, , e-filing of the present patent applications, etc.⁹

1.4 IPR Bargain: Conceptualizing the two-end benefits of IPR

Intellectual Property Law is a step towards the balancing of the rights of the originator of the intellectual property and that of the cost of attaining that information acquired from the public domain to reach that asset. The patent rights granted by the Governments are part of the IPR bargain whereby the inventor is incentivized for his work by the grant of patent rights limited for a particular span of time, generally 20 years via TRIPS. In return, the public can readily make use of that patent which has expired its term without paying any royalty, incentives or fees to the patentee. In addition, the public is also made known of the total disclosure of the invention along with the limited set of rights available with the public from the inventor for increasing the production of the invention and for further improvements from the public.

Another aspect of patent bargain is "*right to copy*". This is attained after the completion of the term of the protection awarded to the articles and after which it is accessible to the public. The aftereffects of the "*right to copy*" after the completion of the term of the protection provided beforehand in the elements included in the specifications of the

⁹ Caroline T. Owozeni, Recent Developments and Challenges in the protection of Intellectual Property Rights, WIPO, 2001.

patent and not due to the reason of another patentable invention. For instance, an invention not qualified as the patentable invention due to various criteria of patentability or may be due to some other reasons such as the list of inventions considered not patentable by TRIPS or domestic national laws is accessible by the public to copy and improve for all public. This exchange of return between the patentee and the public is termed as the patent bargain. The enhancement of the public domain is an essential fundamental of the regime of patent and this goal is accomplished by enabling the right to copy the expired patents and the inventions that are finally objected as not patentable at any of the patenting stage.

The agreement on copyright is based on the same logic as the patent bargain, but the benefits are slightly different. In return for a comparatively longer span of protection, the advantages to public on copyright are critical. Additional creativity in the production is taken into consideration when the copyright is granted for the work disclosed in public and is accessible during the monopoly period. The exceptions include rightful use of copyrighted works and in that situation, infringement does not take place even which the independent creation. Just like the patent law, the copyright act also exempts some the works that cannot be protected under the copyright including some expressive and artistic works and the requisites for the protection of a work under the copyright is that it must be original and a tangible medium must have fixed it. This implies that some of the pieces of art will ever remain in public domain without having copyright protection. And once, it comes in public domain, it can be used and copied by anyone. "right to copy" . The "right to copy" is at the center of the balance of copyright, as is the case in the patent system. Moreover, the copyright law showers larger exceptions to the monopoly unlike the patent or trademark law. It has a fair use doctrine¹⁰ that gives certain exceptions by which certain class of society is allowed to copy the protected copyrighted work without causing infringement to the rights of the copyright holder. Also, the term of protection of the copyright is much longer than the duration of the patent, but the bundle of rights and commercialization strength of the patents are more than the copyrighted work.

¹⁰ Section 52 of the India Copyright Act, 1957

It is easy to understand that the trademark law does not have any inherent or implicit expression to provide benefits to the public. It is created to represent the brand, goods or services with a unique kind of representation which may be the sound, smell, or the visual appearance because of which the trademark bargain is not of much consideration in the field of IPR. Nevertheless, the rights related to the trademark's also confers slight economically sound benefits such as the indicator of quality, purity and excellence or the goodwill associated with the trademark. This unique representation helps the public to invest in the genuine brands without any confusion due to same or similar use of marks.

Trademark law is encouraged by very different objectives than the policy of these patents and copyrights. The law relating to the trademark as well as the design took a long span to develop with exploring even different reasons for the protection of that regime but there is vast difference between the purpose of the two as the trademark law is not to encourage the creation of new and better brands rather than to protect consumers against consumer risk. In other words, trademark law prevents third parties from exploiting the trademark in a way leading to the chaos. For instance, with the trademark law aiming to make the consumers what they are buying when they opt for buying a packet of "Nestle Chocolates" and also that they can expect a level of quality from the product that the particular brand has maintained over time in the market. This clearly signifies the object of the law of trademark which is quite different from that of the copyright law and the patent law objectifying for an incentive to be provided to the owner in order to support and encourage the technology and the production.

1.5 Overlapping causes theoretical absurdness

The accessibility of multiple faces of the intellectual property just for a piece of work though fetches advantage to the owner of the IP, but at the same time, it brings some complications for the one who comes under the population going for the unauthorized accesses.

An organization copying the design of another, for example, cannot rely on being on safe ground if it guarantees that it complies with the fair use of copyright law provides it is even protected under the law of patent or any other intellectual property law. In case, the

design is used as indicia or as a logo or mark for the company, it becomes the trademark and such an overlap between the design and the trademark gives rise to more complications for the reason that trademark's existence is restricted to a comparatively lesser contemplations, supported by the doctrine of amendment developed in the US Courts.¹¹

The user liability is also frayed when the different regime has different terms for the use of matter according to the international standards and more than one form of protection will inundate the right holder with additional leftover terms that might arise from the different IP regime. This situation is worst when the copyright is claimed as it has the longest life in comparison to utility patents, designs or patents. For instance, the US design patent law offers protection to the design for 14 long years. As per the design doctrine, after the expiry of the term of prescribed fourteen years, the subject of the patent design protected comes in public domain and is accessible to all.

This presumption is followed in most of the jurisdictions member of TRIPS which may vary in term of protection, India has 15 years of design protection. The complexity arises when the design which is expired has gained secondary meaning in the market and it is widely recognized as the trade dress, the competitors will have to be cautious before using that design anywhere as it might lead to trademark infringement or passing off, if not the design infringement.

Following the examples and situations cited above, it is clear that the overlapping may cause absurdness to the general concepts and fined-precincts of each IP regime which will also discomfort the public, competitors, interested users, royalty-payers, any other interested person for being victimized for such confusions. This type of absurdness is sometimes put into place voluntarily by the right holders to increase the expired protection and make the profits arising from such confusions in the market.

Due to overarching theory thinkers have come up with the ideologies where intellectual property owners Protected innovation rights are the rights gave by the statutes to an

¹¹ William McGeeveran, *The Trademark Fair Use Reform Act*, 2010

individual or a venture related with the result of their insightfulness, which ensures select control over the abuse of their work temporarily. The question of security here is by and large "a work of the psyche" or the human brains. Essentially, licensed innovation includes two fundamental branches, to be specific copyright and modern property. Copyright is fundamentally worried with scholarly, melodic and imaginative manifestations, for example, books, music, craftsmanship, movies and projects and exhibitions and articulations of fables and, all the more as of late, another sort of material work media rendering generation is gotten to through a PC program. Modern property, then again, licenses, trademarks, mechanical designs, land signs and epithets of source, utility models, and so forth must choose between early or related designs, be kept to the requisite prescribed for the stream's protection expiring early. In the case of the overlap of trademark or copyright with the design patent, the protection expires with the completion of the term of protection of the design patent which expires first and has shorter term of protection. Such theories are not completed without complications. First, it is unlikely that an election doctrine is applied by the judicial organization which was a part and the key player in the extension of the intellectual property reign. However, the solution derived above only stated that in the situation of overlapping between different regimes of intellectual property, the protection of that subject lasts as long as the one guaranteeing the shorter span expires but it does not resolve any dispute arising during that term.

Chapter 2: Interface between Patents and Designs

2.1 Hypothetical: the critical cloth dryer¹²

You develop a new cloth dryer. Earlier the cloth dryer were rectangular shaped, but now you have developed a circular cloth dryer. It essentially has a slit through which you can jibe your head, to use it as other means. It is little expensive to weave and produce, and has a least wastage of raw material. Due to so much unique features it became famous globally.

Knowing the IPR laws in details, you seek IP protection vide design law and patent law in the US, UK and India. Both the patents and design protection were extended to the right holder. The example of the patent and the design is given below:

109898 CIRCULAR CLOTH DRYER

Circular cloth dryer are rectangles of red-cotton. Red-cotton is hard-wearing, but exposure to dust can make it fluffy. The size of the cloth dryer is 7 feet long and 4 feet wide, allowing a regular European make to lie unexposed by sand-dust. A daily user of such cloth dryer puts the cloth dryer exposed to the sunlight for spreading the tanning. However, as the positioning of the sun keeps changing with respect to any one position on the earth, it is occasionally necessary to manually bring the cloth dryer in sunlight.

The object of this invention is to give a circular shape to red-cotton fabric that when used as a cloth dryer to sunbath, water bath requires less efforts to dry the cloth against the movement of the sun. Another object of this invention is to use the most appropriate material for this invention.

The circular shaped cloth having red-cotton material and the wide dimensions of the cloth is the preferred embodiment of this invention for any European, American or African average tall heighted person to lie under this towel especially for sunbathing.

Furthermore, the circular shape of the cloth dryer utilized as an absorber, temperature-retainer cloth gives high comfort to the human body,

¹² Franek v Franco, 615 F 3d 855 (7th Cir. 2010)

The best material suitable for above described purpose is di-hexatowelium. This unique kind of a polymer was used in olden times as a rat poison pellet binder, which after R&D is usable for preparing a cloth material especially as a towel material. It also has suitable strength to carry red-cotton without failure.

CLAIMS:

1. A cloth dryer embodiments comprising of :
 - a. a circular shaped cloth;
 - b. the circular shaped cloth made up of a material di-hexatowellium;
 - c. the material colored in red; and
 - d. the cloth dryer has 7feet heights and 4 feet width with 5mm length.
2. The cloth dryer embodiments as claimed in claim 1 wherein said cloth dryer is shaped circular whereby sunbathing may change the body of a user against the change in position of the Sun.
3. The cloth dryer as claimed in claim 2 is embodied to be kept still while changing the position of the Sun.

The design protection applied has a circular shaped embodiment preferably known as the cloth dryer with red color textile having fibers and strands extruding out of the cloth base.

The right holder for his innovative approach and the appealing structure given to the cloth dryer have novelty, industrial applications, originality and non-obviousness successfully received Patent and Design rights in the US and EU. Now, the situation gets complex when the pirate copies the design and start using it industrially for commercial interest.

However, noticing the piracy the right holder files the infringement suit for civil remedies. The defense that could be taken by the infringer is based on the following doctrines:

- a. Doctrine of election,
- b. Doctrine of stretch,
- c. Doctrine of post expiry right to use,
- d. Mismatched defence.

The alleged infringer spurs the following defenses before the Court of Law:

- a. The patent rights given constitutes that the invention has some functionality associated with it. However, the design right cannot be granted on something which is on functional. It is ought to have some functionality and eye appeal. This defense was based on the observations of the court in the *Interlego V Tyco*¹³, the Court augured three ways by which the design rights can be conferred and the court decided that the design should have some functionally and some eye appeal. Therefore, in this particular situation the grant of patent rights confirms that the design rights cannot be given.
- b. Claim 1 is not novel, which is one of the most essential criteria of granting patent. Thereby, the alleged infringer is trying to persuade the Court to invalidate the patent by questioning the novelty.
- c. The next defense is that if the design rights are granted that implies that the product has an eye appeal which is an obvious determination. Therefore, the obviousness of the product is sustained. Also, the alleged infringer cited the prior art whereby the obviousness rejection can be applied.
- d. The infringer also invoked the dual protection doctrine. By this doctrine the right holder is not allowed to have dual protection for one asset. The right holder shall have the duty to elect the most preferred or desired IP, if there are possibilities of multiple protections.

The counter to the last (d) defense is totally dependent on the jurisdiction in which the multiple protections are sought. Various countries allow the multiple protections and some totally restricts the use of double protection. However, the approach to deal with such situations of overlapping, especially of design and patents are described in the later sections of this chapter.

¹³[1988] UKPC 3

2.2 Analysis of Overlapping of Patents and Design Law in Apple V Samsung Case

The significance of modern design can't be exaggerated in the buyer gadgets commercial center today. For instance, in the cell phone industry, numerous buyers acknowledge and esteem a handset that is attractive, and they frequently settle on buying choices in view of an inclination for one UI over another. In any case, can a satisfying handset design or unmistakable symbol format be patented?

In Canada, a patent might be gotten for "any new and helpful craftsmanship, handle (strategy), machine, make or creation of matter", or any new and valuable change in one of these classes, subject to specific conditions.

"Useful" is basic. To be patentable, a creation must have utility. However, in spite of their shrewdness and oddity, numerous modern designs need utility. The shapes or ornamentations that make up an design don't really play out any capacity or add to the utility of the hidden article. In any case, the design obviously can have business esteem without having an utilitarian perspective. For example, the state of a specific brand speaker or home systems administration gadget or remote control may impact obtaining choices because of its recognition or advance.¹⁴

It is not shocking then that administrations have perceived that the significance of ensuring this specific types of protected innovation, which is unique in relation to the sorts of licenses we usually connect with utilitarian developments. For non-useful perspectives, there is a parallel branch of protected innovation known as Industrial Designs. In the United States, these are known as Design Patents (as opposed to Utility Patents).

Modern Designs can be gotten to protect the visual components of shape, arrangement, example or trimming—or any mix of these elements—connected to a completed article made by hand, device or machine. This obviously incorporates the state of a completed

¹⁴Horbale Paul, The difference between Patents and Designs, Bereskin and Parr Intellectual Property Law, 2014

article, for example, a speaker. Besides, Industrial Design enlistments can likewise be gotten for UI elements, for example, symbols on a show.

These may appear to be minor elements for which to look for patented innovation assurance, yet Industrial Design enrollments can be capable instruments. One late representation of this originates from the Apple and Samsung patent fight in the United States. All things considered, four out of seven licenses stated by Apple were in certainty Design Patents. These secured the well known edge-to-edge glass of the iPad and the network style symbol format of Apple's iOS, in addition to other things.

Plainly, even the greatest players are taking Industrial Designs (Design Patents) truly. Any creator of buyer gadgets ought to unequivocally consider doing likewise.

2.3 Doctrines having application of Overlapping of IPR

As a matter of understanding amongst the IP experts and jurists the dispute and interference between the design and patent rights have been settled to most of the points. However, the situation is not very certain when the issue like the apple v Samsung arises with highly complex technologies in questions. Such issues, needs high understanding of law and technology, any frivolity in understanding may lead to grant of multiple rights to the right holders or the companies voluntarily seeks multiple rights for one asset.

Protected innovation specialists are acclimated to numerous existing together licenses or copyrights in a similar work, yet the view from outside the framework is different. Experts enlist the following protests to overlap: ¹⁵

1. (Stretch) "*If material is satisfactorily secured by trademark law, why extend copyright law to secure it more?*"
2. (Election) "*If the same inventive process is secured by both patent and copyright, why sought to the copyright not be relinquished if a patent is willfully procured?*"

¹⁵ V. Moff at, 'Mutant Copyrights and Backdoor Patents: the problem of overlapping Intellectual Property protection', 19 Berkeley Technology law Journal, 2014

3. (Post Expiry right to use) " *If a design right or item patent lapses, why ought to the likelihood indeed, even exist, as it does now, of having extra conceivably unending exchange check protection on the item shape, a privilege much more strong than assurance by patent or design right?*"

4. ('Mismatched Defenses') " *If overlap of rights is allowed for proprietors, why should it not be allowed similarly for clients? On the off chance that a client has a privilege of reasonable managing a copyright logo under copyright law, why would he be able to not guarantee this privilege if sued for trademark encroachment of the logo?*"

5. ('Undermining' or "circumventing") Other rights can go around stringent patent examination, undermine the patent framework, and debilitate exchange with inconsequential imposing business models.

As amongst patents and designs, be that as it may, these worries have quite lessened constrain.

1. "**Stretch**" What is the "best possible" extent of patent or design law? As opposed to characterizing protectable topic too nearly, officials seem to demonstrate a general inclination for permitting patent law to create with industry and innovation. It is in this way no straightforward matter to deny wrongful "extending" without smothering vital advancement — small time's adaptability is another man's extend.

By and by, keeping away from overlap implies making crevices, later stopped with sui generis measures. Each such measure builds the quantity of interfaces amongst rights and henceforth increments, as opposed to decreasing, the potential for overlapping protection. This is especially valid for design rights, themselves frequently observed as a gap fill amongst patent and copyright. 'Utility models' were initially a gap fill amongst patent and designs. Different cases in the design territory are the UK's Unregistered Design Right, the US Vessel Hull Protection Act, and the different Semiconductor Chip Topography security measures.

2. '**Forced election**' /pre-emption Limitation to just a single type of protection, and implemented renunciation of others, can't work without clear choice principles, which

neither Europe nor the US have authorized. Which right is disavowed — the patent or the design? Also, if timing is determinative, in what capacity ought to all the while documented rights be dealt with? In the US, the decision hypothesis of *Korzybski v Underwood*¹⁶ was not followed in connection to different rights or other authentic circumstances. Similarly in the UK, the authorized race (amongst patent and copyright) in *Catnic v Hill and Smith*¹⁷ was settled on different grounds on claim; and does not hold as between different rights. 10 Nor was it broadly took after somewhere else.

The case law was checked on in the Australian case *Roland Corp v Lorenzo and Sons*¹⁸, the fundamental thought has all the earmarks of being that a bit of patented innovation might be denied of assurance in one IP on the ground that it is all the more suitably managed under another IPR.

3. 'Multiple Protection'

European design law explicitly allows parallel protection by design and patent. The point was chosen long back in the UK in *Werner Motors v Gamage*¹⁹, in which, ten days before filing the design, the proprietor filed for a patent.

The patent and the design had significantly indistinguishable drawings. The design had a statement of originality coordinated to 'the example as appeared of an engine cycle drawing'. In the patent, guarantee presented a progression of whole numbers which 'read onto' (ie secured) the drawings, and claim 2 was in the "omnibus" shape: 'An edge for engine cycles built considerably as portrayed with reference to the going with drawings'. It may in this manner have been thought similar in scope and effect to the design.

In other words, the drawings presented in the design sheet was substantially similar to the drawings attached with the patents and what was claimed in claim 2 of the patent pertained to those similar drawings.

4. 'Post-expiry right to use': The concern in "doctrine of election" cases was normally not the presence of twofold protection as such, but rather the baseless expansion of imposing monopolistic model after expiry of patent rights when general society ought to be

¹⁶ (1929) 3 USPQ 242

¹⁷ [1982] RPC 183

¹⁸ 105 ALR 623 (1991) 33 FCR 111

¹⁹ (1904) 21 RPC 621

allowed to utilize an invention. Where the other right is an unending trademark or a wearisome copyright this may have extraordinary monopoly noteworthiness, yet significantly less so for drawings which have a comparative lifetime (plus or minus five years) to patents, and should be recorded in a similar time allotment (as opposed to, say, after expiry of the patent) with a specific end goal to evade self-anticipation by prior art. In the UK, the post-expiry ideal to utilize this doctrine now 'has no place in the advanced statutory design of things' as stated in *Philips v Remington*. Be that as it may, in spite of the fact that it no longer legitimizes the "election" hypothesis examined above, it might give a basic justification to applying different provisions to a similar impact.

The post-expiry doctrine for patents is solid in the US, however not amongst designs and utility patents. In *Kellogg v National Biscuit*, security under the Competition law was declined to Shredded Wheat TM rolls, beforehand ensured by terminated utility and design patents. No unfriendly remark was passed on double protection by utility and design patents. However, twofold protecting, even between design patent and an utility patent, is for the most part not allowed. By and by, the complaint can be overcome by a 'terminal disclaimer' revoking any term expansion of the longer-lasting right over the shorter one.

2.4 International Panaroma of interface:

There are more than two nations with the very same administration in respect of design protection. Not at all like different fields, is the protection permitted to design by all accounts specific to exceptionally contract national substances. There are patent-like administrations, copyright-like laws, and trademark-like administrations.²⁰ Exclusive laws on designs are surprising, and for the most part exist together with some sort of corresponding conventional security, or even with sui generis protection for particular works. The regimes of protection could exist together, overlap or even to be joined, in a scene that mirrors the multifaceted nature of this field. Earlier in India, prior to 1970, the Patent and Design law were placed together under one Act recognized as the Patent and Design Act. This has been followed similarly in various more jurisdictions like the USA,

²⁰(1992) FSR 421

EU and others. Still today the UAE has all the laws namely, Design Law, Patent Law and the Utility Patent law together in one Act.²¹

Amendments to the Japanese Patent and Design Laws got to be law in 1998, following a time of forty years without change, since the order of its Design Law in 1959. Albeit a few observers have found the adjustments insufficient, it is clear that the auras influencing design law are of significant extent. The prerequisites of protection have been improved for instance from a plain novelty with touch of inventiveness, originality, novelty in addition to creativity standard. A partial design is made, permitting design proprietors to sue for encroachment of a piece of protected subject matter. This arrangement could be especially aggravating, on the grounds that it makes the likelihood of a overlap amongst patent and design laws and a real protection of usefulness and functionality by the method of design law.²²

2.4 Anti-Overlap Provisions

Patent law — Exclusion of Registrable Designs

Patents in the precedent-based law world have been limited to "inventions" — which are, notwithstanding, not characterized in it is possible that US or European law. The word indicates both a sort of topic, and a level of thought. The non-existence of a definition in the European Patent Convention (EPC) was deliberate, and the extent of protectable topic is compelled by the 'industrial application' prerequisite, and the 'non-exhaustive list of non-inventions' of EPC Article 52(2). Amid the extended EPC transactions, the UK proposed an avoidance of 'Designs or arrangements in which the novelty resides in appeal to the eye' expressly to dispense with overlap, yet this was rejected. Rather, 'aesthetic appeal' 'accordingly' was barred. This is taken in the UK to exclude overlap with copyright instead of design, as is clear from the wording of the Patents Act 1977.²³

Design law — exclusion of patentable inventions

²¹ See, <http://www.jus.unitn.it/cardozo/review/business/barrera1.html>, last available, 27/02/2017

²² See, http://www.ipww.com/jul98/p09_japan.html, last available, 27/02/2017

²³ U. Suthersanen, *Design Law in Europe*, London: Sweet & Maxwell, 2000

“The now-superseded French design law²⁴ did specifically exclude protection for patentable inventions, if the same object may be considered both as a new design or model and as a patentable invention and if the elements constituting the novelty of the design are inseparable from those of the invention, such an object may be protected only under the [patents] provisions.”

Portugal, Spain, and Belgium did in like manner, as the OAPI law of Francophone Africa still does. Practically speaking, this prohibition was connected with shifting impacts throughout the years. Once in a while, it was just connected where a design met all the substantive criteria for patentability. In prior cases, it was held to nibble just where technical functions could be accomplished by a solitary frame — as it were, for design where the shape combined with the functions — so that a design was substantial where it could be demonstrated that different structures would satisfy similar functions. Afterward, notwithstanding, this 'multiplicity of forms' approach was relinquished in France, and there are a few late situations where it creates the impression that the insignificant overlapping of a patent with comparative drawings was sufficient to invalidate a parallel design. There is in this way no 'bright line' isolating patents from designs in Europe or the US. The positive prerequisites for fanciness or 'eye appeal' (for design), and utility or technical character (for patents), and the particular statutory prohibitions of practical design and stylish developments examined in this section, don't create an 'absence of overlap', or a 'reasonable and unmistakable separation'. Where a given design incorporates both functional and ornamental components, it might meet all requirements for either or both rights.

2.5 Conclusion

It will ideally now be clear that there is no per se bar to coexistence of designs and patents together for one asset, that Claim 2 of your patent is not invalid as absolutely aesthetic, and that the presence of the parallel design represents no danger to the patent. Is the vice versa additionally genuine? The item cloth dryer concerned is utilized to dry, and to lie on. The circular design does not hoard these essential capacities — there is no

²⁴ Law of 14 July 1909, Art L. 511-3, §2

different market in circular towels. It is utilized straightforwardly, so appearance is not unimportant. It is most likely purchased incompletely for stylish reasons, as a poncho, or maybe basically to look striking in the midst of a beachful of rectangles. The allowed patent is no assurance that each component of each claim meets every one of the necessities for patentability. The "technical" preferred standpoint ascribed to the shape in the patent may simply be patent lawyer's puffery or pipedreams.

The patent highlights the way that, while a circle is not by any means the only shape that abstains from standing up and move around with the sun, it is the most prudent as far as material (when contrasted and, say, a major square towel) and is henceforth, in this sense, in fact the "best" design. This favorable position requires the round shape, regardless of the possibility that it is additionally stylishly satisfying. In any case, isn't the material spared (from the cut-off corners) in a futile shape? Also, isn't the round towel harder to make than a starting point? Can't a financial drawback off set a useful preferred standpoint? In spite of the fact that the court in *Franek v Franco* , on which this situation is based, observed the trade dress worried to be utilitarian and therefore invalid, it is not sure that the same financial investigation ought to underlie design law. Ought to the nearness of some specialized preferred standpoint (if encouraging inactivity can truly be said to be a wonder such as this) trump the nearness of eye appeal, simply in light of the fact that a contender might need to offer something similar? Until some court gets around to choosing these round contentions, there is no certain answer.

Chapter 3: Overlap between Designs And Trademark & Trade Dress

3.1 Introduction

As per Lord Templeman in the Coca-Cola case²⁵, the Coca-Cola bottle can't be viewed as a trademark in light of the fact that 'a bottle is a container and not a trademark'. This infers there is a disagreement between being an trademark and being a container: what is a container is not a trademark; and what is a trademark is not a container. It is clear his Lordship was stressed over the likelihood that a perpetual trademark monopoly could be accomplished for an article which would not have secured protection under patent, design or copyright enactment. It is not adequate for the Coca-Cola bottle to be distinctive. The Coca-Cola Co. must prevail in the startling suggestion that a container is a trademark. Assuming this is the case, and then some other bottle or any article of a distinctive shape is equipped for being a trademark.

This raises the ghost of an aggregate and perpetual restrictions having perpetual monopoly in containers and articles accomplished by method for the Act of 1938. Once the compartment or article has gotten to be related with the producer and uniqueness has been built up, with or without the assistance of the restraining infrastructures made by the Patents Act, the Registered Designs Act or the Copyright Act, perpetual trademark imposing monopoly in the container or article can be accomplished. As I would see it the Act of 1938 was not designed to give on the producer of a container or on the maker of an article a statutory syndication on the ground that the producer has according to the public built up an association between the state of the compartment or article and the maker. Any competitor must be allowed to offer any container or article of similar shape gave the container or article is named or bundled in a way which avoids confusion with regards to the source of the merchandise in the compartment or the beginning of the article. The respondent Registrar of trademarks has constantly taken the view that the capacity of trademark enactment is to ensure the mark yet not the article which is marked.

²⁵ [1986] 1 WLR 695

The overlap amongst trademark and industrial design and trademark and copyright protection can be abused to expand the protection accessible for designs and trade dress. For recently created design and trade dress, the initial step ought to be to consider whether assurance is accessible as an industrial design enlistment (remembering that an application for such an enrollment must be recorded inside a time of public disclosure). Securing the industrial design enlistment will give a 10-year protection amid which trademark uniqueness can be procured,²⁶ giving secondary meaning. Once acquired distinctiveness can be appeared, thought might be given to applying to enlist the design as a distinguishing design. Different design and trade dress –, for example, logos on product packaging – might be managed both trademark and copyright protection. The contrasting rights and remedies gave by each of those particular laws can be depended upon to amplify the choices accessible to urge would-be infringers – for instance, copyright may give a more powerful method for halting the importation and sale of grey market products than the trademark administration.

The different national trademark laws normally allow the protection of signs. They don't segregate between good signs and bad signs. There are a few laws, in any case, that avoid a few sorts of sign from protection. For example, a few laws bar three-dimensional signs; others prohibit a few sorts of visual sign, for example colors. Yet, at whatever point the law bears protection to signs, if a class of signs is not particularly prohibited from protection, it is consequently included. So unless there is a particular prohibition in the law, a specific component is secured as a trademark gave that it is a sign. Obviously, the law can present different prerequisites for protection. It can require, for example, that a sign ought not strife with open public policy or ethical quality. It might likewise require that the sign be new or unique; this prerequisite varies from nation to nation.²⁷

GOOGLE CASE STUDY: ²⁸It is conceivable to acquire overlapping from copyrights, trademarks/trade dress and design patents on a similar item. A case of overlapping scope can be looked in the Google, Inc. design patent drawing. Google has secured a copyright

²⁶ See, http://www.bereskinparr.com/files/file/docs/WTR_AugSept2012_JGB.pdf, last available, 28/01/2017

²⁷ Doi, The Trademark Law, Intellectual Property Law of Japan, 1980.

²⁸ See, <http://www.sgrlaw.com/ttl-articles/1539/>, last available, 21/02/2017

on the screen shot (assigned by the © image) and is utilizing at least one components as a trademark (as observed from the ™ image)

See that "GOOGLE" is composed, this implies the word is not a "basic" element of the design. Along these lines, regardless of the possibility that an eventual infringer substitutes its own organization name in a comparable format, it would encroach the design patent and the copyright. Likewise, logos and shapes may serve as a trademark since they distinguish the source of goods, and the creative/design aspects might be secured by copyright or design patent.

Design Patents, copyrights and trademarks/trade dress all require distinctive components to demonstrate unlawful replicating or impersonation. Similarly as a criminal might be accused of numerous wrongdoings for a similar deed, organizations may charge various sorts of infringement for a similar demonstration.

3.2 Overlap of Trade dress, trademark and Designs

Dual trade dress and design protection can exist when the state of the item is fancy and furthermore serves to recognize the origin of the merchandise to consumers. And mark proprietors can keep on protecting their trademark from infringement even after the design patent terminates. Presence of a design patent, "instead of taking away from a claim of trademark, may bolster such a claim" since "it might be hypothetical proof of non-functionality," important to get trade dress protection.

Made to advance in beautifying expressions and to reward creators, design licenses ensure non-functional, decorative elements of "an article of manufacture." Designs for non-obvious novel ornamental designs are granted for a time of fourteen years. With arrangement ahead of time and the installment of extra charges, issuance of a design patent can take as meager as three to six months (the time between runway shows and putting up the item for sale to the public). Furthermore, not at all like trademark enrollment with the USPTO and activities under the Lanham Act, there is no prerequisite to utilize the design in business keeping in mind the end goal to secure a design patent or sue for patent infringement.

Trade dress, then again, "includes the aggregate picture of an item and may incorporate components, for example, size, shape, shading or colors, surface, illustrations, or even specific design techniques." Similar to design patents, trademark law protects only non-functional product design trade dress. In trademark speech, an item highlight is useful "in the event that it is basic to the utilization or motivation behind the article or affects the cost and nature of the article."

While both trade dress and design patents overlap non-functional elements of item designs, there are a few crucial contrasts between the two types of protections. These distinctions can be clarified by taking a gander at the unmistakable objectives of patent law, which gives a selective property appropriate temporarily to an innovator, and law of the trademarks, which are types of law for the consumer protection. As a trademark law is gone for averting consumer confusion, product design trade dress protection can keep going the length of the design is utilized as a part of business and recognizes the origin of merchandise to consumers.

Infringement of the design patent is found when a standard spectator, giving the consideration of a buyer, sees the patents and the accused designs as significantly the same, in light of the prior art.⁶ In an activity for trade dress infringement, then again, the offended party needs to demonstrate that it claims a protectable item design trade dress and that the utilization of similar trade dress by a litigant causes likelihood of consumer confusion. Both design patent and trade dress infringement concentrate on the impressions of the standard buyer—and not the expert—in assessing the likeness (or befuddling similitude) of the particular design. Be that as it may, not at all like the test for infringement of trade dress which concentrates on commercial center substances, for example, procured uniqueness and consumer confusion, the concentration of the design patent infringement activity is similitude to the design features appeared to design patent drawings, and not likeness to patentee's "commercial embodiments" of the design.²⁹

²⁹ Dennis D. Crouch, A Trademark Justification for Design Patent Rights, University of Missouri School Of Law Scholarship Repository, 2013

3.3 Understanding the family of design and trademark & trade dress

3.3.1 Product design trade dress

As a rule, product design is harder to secure under trademark law than product packaging. The Supreme Court in Wal-Mart perceived that customers normally don't see an item's design as recognizing the origin of the item; rather, product design by and large renders the product itself more helpful or more appealing. Product-design trade dress can be "inherently distinctive" as in it is fanciful or arbitrary; notwithstanding, inherent distinctiveness does not entitle product design trade dress to protection under the U.S. Trademark Act, otherwise called the Lanham Act. Simply after product design trade dress is appeared to have gained secondary meaning will it be qualified for such assurance.

The viable impact of this decides is that product trademark dress is not qualified for protection quickly upon first use. Or maybe, legal protection will connect simply after the gathering guaranteeing rights has utilized and advanced the product trade dress for a particular frame of time, to such an extent that buyers have come to connect it with a specific maker or brand; i.e., the goods have acquired the secondary meaning.

3.3.2 Product packaging trade dress

In Wal-Mart the Supreme Court watched that, not at all like product design, the bundling or "dressing" of product regularly is perceived by purchasers as distinguishing the item's source. Hence, *"the very motivation behind appending a specific word to an item, or briefing it in an unmistakable bundling, is frequently to recognize the origin of the product."* Product-packaging trade dress can be secured either: (1) on the off chance that it is inherently distinctive, or (2) on the off chance that it has gained secondary meaning.

3.4 Alternate route to trademark protection

The right holders can plainly depict which parts of its product, assuming any, are guaranteed in its utility patents, and which are the subject of trademark protection. By

staying away from overlap, the right holder can utilize trademark law and patent law in mix to accomplish most extreme protection.

In the case,³⁰ the Supreme Court tended such that a utility patent can have on the declaration of trademark rights in a product design. The Supreme Court held that utility patent that unveils utilitarian points of interest of a claimed design is "solid evidence" that the design is functional and along these lines not qualified for trademark protection. TrafFix additionally recognized, be that as it may, that trademark protection might be accessible for fancy parts of an element found in a patent claim.

For a situation where a manufacturer looks to ensure arbitrary, incidental or fancy parts of elements of design found in patent cases, for example, self-assertive bends in the legs or an elaborate example painted on the springs, an alternate outcome may get. There the producer could maybe demonstrate that those angles don't fill a need inside the terms of the utility patent.

The Seventh Circuit explained on this point, taking note of that "[t]he hood adornment on a Mercedes, or the four connected rings on an Audi's grille, would represent 'an ornamental, coincidental, or arbitrary part of the gadget' that could get by as a trademark regardless of the possibility that they once had been incorporated inside a protected some portion of the auto."

To improve trademark rights, guarantees in a utility patent ought to be painstakingly drafted in order to prohibit any design features that might have intentions to overlap the trademark protection. This practice will clear up that design feature being referred to is not "a functional piece of the invention," yet rather only a "incidental," "arbitrary," or "ornamental" part of the product.⁴¹ The proprietor will remain on considerably more grounded ground affirming trademark rights in design features that do not guarantee in the utility patents.³¹

³⁰TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 29 (2001)

³¹ See, http://www.brinksgilson.com/files/article_landslide_janfeb_2012_handelman.pdf, last available, 3/12/2016

3.5 Elaborating Conflict of Trademark and Design in Indian context

India enforced the Trademarks Act 1999 and the Trademarks Rules 2002 (compelling September 15 2003) to guarantee sufficient protection for domestic and universal brand owners, in consistence with the TRIPs Agreement. In accordance with the Trademarks Act, a trademark incorporates inter alia, the shape of products, their packaging and color design. In this manner the state of a good can serve a source distinguishing capacity and along these lines can be an enforceable trademark. Shape of goods can be both inherently distinctive and one with secondary meaning.

A product, good or container shape may likewise be subject to a design. In 2000, Designs Act 2000 was passed (gotten into drive May 2001) to meet the commitments under the TRIPs Agreement for industrial designs. Under Designs Act, 2000 a design implies components of shape, setup, design, pattern or creation of lines or colors connected to any "article" regardless of whether in a few dimensional structures (or both), by a mechanical procedure or means which advances to the eye. Along these lines a design ought to satisfy the accompanying conditions.

- It ought to be new and original,
- Distinct from the pre-existing design
- Not disclosed in public

The motivation behind design enrollment is to shield the novel designs concocted from being connected to specific articles produced and promoted commercially. The privilege to make an article, allowed to the holder of the design, is an exclusive right bearing a similar design for a constrained time frame. Therefore the distinction under the two Acts is the basic capacity they perform.

The Design Act basically decides the novelty factor in the shape of a design or pattern or ornament connected to an article while shape of goods as trademark, connected to the item under the Trademarks Act, is to recognize a specific trade origin in regarding particular products and additionally benefits.

“The Design Act restricts a third party from making, selling or utilizing a product of the ensured design. To infringe a design, the infringing container and the container shape appeared as the design must look alike to the eye of the standard spectator.” It has no effect what is within the container. Under trademark law, the infringing container must be, for example, to bring about confusion, deception, or mistake among the expending open. This determination will, of need, consider what is really sold inside every container as the container or state of the good infers its sign as a source from what it holds. Furthermore, courts dissecting a trademark infringement activity would likewise take a notice of the buying habits for the shoppers, and the business strategies utilized by every maker.

The state of a product or container can fill in as a source pointer under Trademarks Act and can likewise be a novel design satisfying the criteria of registrability under the Designs Act. Subsequently, dual protection from both design and trademark laws may exist together. The issue of contention in the overlap of protection does not emerge, as the way of "protection" given under the two laws is distinctive.³²

Although the design and trademark acts protects two different set of products or goods as mentioned under their respective regime. However, the concept of secondary meaning which may adapt to any kind of the IP can give rise to trademark protection to such different sets of IPR. For instance, the design of a unique vacuum cleaner is very well known in the market and the owner has a design protection over the fancy and distinct design. The trademark protection would not be given during the term of protection of this design. However, once the design rights are expired, the owner of the design can apply for trademark protection. Also, if the design has acquired the secondary meaning it is available for trademark protection.³³ This is due to the eligibility criteria which are not fixed for trademark protection with regard to the novelty, originality or any other technical means to identify the public disclosure.

³² Nair Manisha, Shape of goods: The Overlap(And Conflict?) in Trademark and Designs, Lex Orbis, 2007

³³ See <http://www.mondaq.com/india/x/46456/Trademark/Shape+Of+Goods+The+Overlap+And+Conflict+In+Trademarks+Designs> , last available, 3/2/2017

The above mentioned example is not true vice-versa. If some trademark having a unique design is disclosed to the public and the owner would in future seeks to acquire the design rights for a design similar to the trademark which is already knows. It is possible and highly vulnerable to receive objections and rejections for its novelty and originality. Also, the public disclosure will make it debar from protection under design act, 2000. Hence, it is very important to know both the laws in depth before applying or seeking multiple protection of design and trademark or trade dress.

3.6 Sidelineing Overlapping conflicts

The exdesignation to avoid the conflict or overlap between the trade dress & trademark and design is formed totally on the excerpts, obiter dicta, ratio decidendi and observations from the cases decided by the various Judiciary of the world having altogether the similar issues of trademark and design overlapping. The owner of a famous mark, trade dress or a design would obviously seek to leverage most of the profits from one mark which has gained popularity amongst the public. It is not to be forgotten that the special laws like the design law, trademark, patents, copyright or any other IPR laws are officiated with purpose to improve the commercialization in the market without letting the consumers and the owners deprived of their rights.

Their Lordships maintained a strategic distance from it in an extremely basic way, by denying any grant of trademark protection. In the event that a thing is a trademark additionally a container, it ought not get assurance as a trademark. After what has been stated, I can't help thinking that this solution isn't right. Everything has more than one capacity: if protection is denied to trademarks which additionally have different capacities, then trademark protection must be denied in all cases. Nothing can get trademark protection if (or since) it additionally has different capabilities. For instance, a red label ought not to be protected on the grounds that notwithstanding being a trademark, it is likewise red and furthermore paper.

Another approach to stay away from the overlap is to perceive the trademark right yet to subject its practice to cautious examination. This approach obviously infers that a qualification can be made between the presence of the right (whose acknowledgment

does not make unsafe impacts) and its exercise (which might be against public interest). This is a well known distinction, sacrosanct by the act of the European Court of Justice.

The qualification is clear, yet its applications are uncertain. Unmistakably, recognition of the presence of a right, combined with an aggregate and lasting forbiddance on its exercise, is commensurate to a refusal of its reality. To perceive a privilege and to control its practice implies in any event to permit some exercise.

Now one ought to solicit how far the exercise of the right can go keeping in mind the end goal to maintain a strategic distance from this overlapping. Having conceded the presence of the right (that is, the right to the trademark), how far would it be advisable for us to extend its boundaries (as it were, what is and what is not considered infringement)?³⁴

“The House of Lords denied the existence of a trade mark right, and I believe this was an error. I think I may add, however, that the problem of the boundaries of the right can be solved in two ways. One is to give a central definition of the right and establish what is its specific subject matter (central definition). The other is to conceive that the right is limited by external factors, which reduce its scope (external limitations). As far as the first approach is concerned, one should define the essential core of the right, and conclude that whenever the proposed exercise is within this core, there is no undesirable overlap. It is a conception similar but not identical to that of the European Court's specific subject matter of an industrial property right. As far as the second approach is concerned, it may be thought that under normal circumstances the exercise of the right is proper, but in exceptional cases, for example when it violates the anti-monopoly or anti-trust laws, it is not.”

3.7 Co-existence of design and trademark

While the overarching perspective is that the trade dress can be protected and is accessible for designs that used to be secured at least once by a design patent after appearing of optional significance, a few courts have scrutinized the privilege of the

³⁴ Mario Franzosi, What is a trademark?- a challenge to the House of Lords, European Intellectual Property Review, 1987

trademark proprietor to assert secondary meaning when such optional importance was set up exclusively because of the exclusive design patent protection. For instance, in *Winning Ways, Inc. v. Holloway Sportswear Inc.*, the court noticed that "[g]ranted trade dress protection to a thing for which a patent has lapsed makes pressure on the grounds that the item may have gotten secondary meaning exactly in light of the fact that the product was protected." *Winning Ways* speaks to the minority perspective, and brand proprietors can by and large be sure that most courts will urge infringement of product design trade dress protected by an expired design patent in as much as this trade dress acquired secondary meaning.

In *re Mogen David Wine Corp.*, where the presence of the design patent was held not to block the applicant from acquiring registration on the Principal Register for the shape of its wine bottle, the court watched that "trademark rights . . . which happen to proceed past the expiry of a design patent don't "extend" the patent monopoly" since patent and trademark rights "exist autonomously of, under various law and for various reasons."³⁵

In *Kohler Co. v. Moen, Inc.*,³⁶ Moen acquired a trademark registration for its LEGEND kitchen fixture and the presence of the handle utilized on the LEGEND and different spigots. Kohler contradicted the registration, contending that giving trademark protection to design impermissibly clashes with the Patent Clause of the U.S. Constitution. In dismissing Kohler's contentions, the court stated:

"The trademark proprietor has an uncertain term of protection, it is valid, yet in an infringement suit should likewise demonstrate optional importance and likelihood of confusion, which the proprietor of the design patent need not do; there is therefore no fundamental irregularity between two methods of protection."

The court noticed that while a design patent concedes a fourteen-year imposing monopoly "by giving the patentee the exclusive right to make and offer the development, a trademark gives the proprietor just the privilege to restrict others from utilizing the check when such utilize is probably going to bring about confusion or to deceive." Unlike

³⁵ *In re Mogen David Wine Corp.*, 140 USPQ 575, 579 (C.C.P.A. 1964)

³⁶ 29 USPQ2d 1241 (7th Cir. 1993)

patents, trademarks are not monopolies since others are permitted to deliver comparable designs insofar as there is no probability of customer confusion.

Ferrari s.p.a. EsecizioFabricheAutomobili E Corse v. Roberts recommends, “ protection can be allowed to the trademark proprietor regardless of the possibility that there is no disarray at the purpose of offer. In Ferrari, the litigant produced fiberglass units that repeated the outside components of Ferrari's Daytona Spyder and Testarossa automobiles. The respondent contended that Daytona Spyder and Testarossa designs couldn't be secured under the Lanham Act since car designs are to be shielded from replicating just as per the design patent statute. Rejecting the respondent's contention, the court expressed that Lanham Act protection is accessible to designs which additionally may have been secured by design licenses inasmuch as the designs have obtained optional meaning. The litigant likewise contended that he didn't disregard the Lanham Act since he educated buyers that his packs were not bona fide Ferraris but rather fundamentally less expensive reproductions and, along these lines, there was no disarray at the purpose of sale. Since Congress designed to ensure the notoriety of the maker and in addition to ensure the buyers and since Ferrari's notoriety could be harmed by the showcasing of imitations, the court permitted recuperation even without purpose of offer confusion.”³⁷

³⁷ See, <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=74f843be-c63a-40cc-8ae0-007bc50fdd99>, last available, 3/2/2017

Chapter 4: Coinciding elements of copyright and design law: Some line of distinction drawn by the Courts

4.1 Introduction

The doctrines in syndicate Intellectual Property Law experience imbrications. Patent law as well as copyright law can protect the software, trademark and copyright law can extend protection to logos, and much more. Similar are the design patents which keep the opportunities open for the overlapping of an industrial design qualified to be protected under the design protection and also in peculiar regime under the copyright protection as well and also fall under the arena of the trade dress.

The most challenging question before the courts in such a case arises when an intellectual property rights possessor claims his rights in more than one doctrine. This scenario has become common these days and the catechism exists as to how the court should respond to the particular situation. The dilemma that arises has twin responses. Some of the knowledge holders say that this is something that has been evolved from the doctrines in a gradual manner and as permitted by such established doctrines, the courts should not delve into the question of overlapping and should allow the owners to claim the rights over the same piece of work under different doctrines and so must enforce them while some say that this overlapping leads to chaos and so it becomes too onerous to actuate the scope and extent of another's rights as different classes of IPRs provide protection to different extent which can be resolved when the IPR holders are made to opt for the specific rights they want to get enforced by the courts at the outset.³⁸

A design right is a patented innovation right that secures the visual design of items that are not absolutely utilitarian. *“A modern design comprises of the production of a shape, setup or organization of example or shading, or mix of example and shading in three-dimensional frame containing stylish esteem. A mechanical design can be an a few dimensional example used to create an item, modern product or workmanship.”* There have been various legislations regarding the particular right in different nations. In

³⁸ Laura A. Heymann, Overlapping Intellectual Property Doctrines: Election of rights versus Selection of remedies

Kenya, As per modern property Act 2001, a mechanical design is characterized as "any synthesis of lines or hues or any three-dimensional frame regardless of whether related with lines or hues, gave that such structure or shape gives an extraordinary appearance to a result of industry or craftsmanship and can fill in as example for a result of industry or workmanship" .

A mechanical design is registrable in the event that it is new. A mechanical design is esteemed to be new on the off chance that it has not been unoverlaped to people in general, anyplace on the designet, by distribution in unmistakable frame or, by utilize or in whatever other route, before the documenting date or, where material, the required date of the application for enrollment. However a divulgence of the modern design is not thought about on the off chance that it happened not sooner than twelve months before the recording date or, where pertinent, the need date of the application and in the event that it was by reason or in result of acts conferred by the candidate or his ancestor in title; or an apparent mishandle submitted by an outsider in connection to the candidate or his forerunner in title. Further, India's Design Act, 2000 was authorized to unite and correct the law identifying with security of design and to conform to the articles 25 and 26 of TRIPS assention. The new demonstration, (prior Patent and Design Act, 1911 was revoked by this demonstration) now characterizes "design" to mean just the elements of shape, arrangement, example, adornment, or piece of lines or hues connected to any article, regardless of whether in a few dimensional, or in both structures, by any modern procedure or means, whether manual or mechanical or concoction, isolated or joined, which in the completed article bid to and are judged exclusively by the eye; yet does exclude any mode or standard of development. In Indonesia the security of the Right to Industrial Design might be conceded for 10 (ten) years starting from the documenting date and there is no recharging or annuity after the given time frame. Modern Designs that are Granted Protection include: The Right to Industrial Design might be allowed for an Industrial Design that is novel/new, An Industrial Design might be considered new if on the recording date, such Industrial Design is not the same as any past revelation, The past revelation as alluded to in point 2 should be one which before :

a. The recording date or

- b. The Priority Date, if the candidate is recorded with need right.
- c. Has been reported or utilized as a part of Indonesia or outside Indonesia.

A modern design might not be considered to have been reported if inside the time of 6 (six) months at the most recent before the documenting date, such mechanical design

- a. Has been shown in a national or universal presentation in Indonesia or abroad that is legitimate or considered to be authentic; or,
- b. Has been utilized as a part of Indonesia by the architect in an analysis for the reasons for training, research or improvement.

“Under the Hague Agreement Concerning the International Deposit of Industrial Designs, a WIPO-managed arrangement, a system for a global enrollment exists. To fit the bill for enrollment, the national laws of most part conditions of WIPO require the design to be novel.[1] A candidate can petition for a solitary global store with WIPO or with the national office in a nation gathering to the bargain. The design will then be ensured in the same number of part nations of the settlement as fancied. Design rights began in the United Kingdom in 1787 with the Designing and Printing of Linen Act and have extended from that point. Canadian law bears ten years of protection to mechanical designs that are enlisted; there is no assurance for unregistered designs. The Industrial Design Act characterizes "design" or "mechanical design" to signify "components of shape, arrangement, example or decoration and any blend of those elements that, in a completed article, claim to and are judged exclusively by the eye." The design should likewise be unique: in 2012, the Patent Appeal Board dismisses a design for a junk can, and gave direction in the matter of what the Act requires: The level of creativity required to enlist a unique design is more prominent than that set around Canadian copyright enactment, however not as much as that required to enlist a patent, the articles being analyzed ought not be inspected one next to the other, but rather isolate so that flawed memory becomes an integral

factor, One is to take a gander at the design all in all, any change must be generous. It must not be trifling or minute.”

Amid the presence of a restrictive right, no individual can *"make, import with the end goal of exchange or business, or offer, lease, or offer or unoverlap available to be purchased or lease, any article in regard of which the design is registered."* The lead additionally applies to packs and generous contrasts are in reference to already distributed designs. Enlisting a mechanical design in Canada might be suitable for an assortment of articles, for example, purchaser items, vehicles, sports gear, bundling, and so forth, having a unique stylish appearance, and may even be utilized to ensure new advances, for example, electronic symbols. Modern designs can likewise serve to supplement different types of protected innovation rights, for example, licenses and exchange marks. The Canadian courts see occasional case concerning mechanical designs — the primary case in very nearly two decades occurred in 2012 amongst Bodum and Trudeau Corporation concerning visual components of twofold divider drinking glasses.

It is feasible for an enrolled design to likewise get protection under Canadian copyright or trademark law:

“ a "valuable article" (ie, one with an utilitarian capacity) will get copyright security where it is replicated in an amount of fifty or less, yet that constraint does not have any significant bearing regarding: a realistic or photographic portrayal that is connected to the substance of an article, an trademark or a portrayal thereof or a name, material that has a woven or sewn example or that is appropriate for piece products or surface overlaps or for making wearing clothing, a portrayal of a genuine or imaginary being, occasion or place that is connected to an article as a component of shape, setup, design or ornament, where an enrolled design has turned out to be freely identifiable with the item, it might be qualified for enlistment as a "recognizing pretense" under trademark law, however such enlistment can't be utilized to constrain the improvement of any craftsmanship or industry. In Europe, enlisted and unregistered group designs are accessible which give a unitary right overlapping the European Community. Assurance for

an enrolled group design is for up to 25 years, subject to the installment of restoration expenses like clockwork. The unregistered group design goes on for a long time after a design is made accessible to people in general and encroachment just happens if the ensured design has been replicated. Enactment given in Britain amid the years 1787 to 1839 secured designs for materials. The Copyright of Design Act go in 1842 permitted other material designs, for example, those for metal and pottery items, to be enlisted with a precious stone check to show the date of registration”.

Notwithstanding the design protection accessible under group designs, UK law gives its own particular national enlisted design right and an unregistered design right. The unregistered right, which exists naturally if the necessities are met, can keep going for up to 15 years. The enlisted design right can be maximum for 25 years subject to the installment of upkeep charges. The geography of semi-conductor circuits are likewise secured by incorporated circuit format design assurance, a type of protection which endures 10 years.

4.2 Meaning of *Design* and *Copyright*

Design Laws have become so trendy these days. For ascertaining the future of the design laws it is crucial to understand the meaning of the Design first. ‘Design’ being a complex term is not easy to define. A broad as well as a technical meaning can be associated with the term. the broad arena sweeps in costume design, product design, stage and graphic design, urban designing and industrial design and so on. The function of it has been well defined by an expert committee in Australia:

“the design spectrum embrace a wide range of activity which has grown with the developments in mechanically- based production technology. Because this transition from the artist craftsmanship of the late 19th century to the industrial designer of today was a slow process, there exists much misunderstanding as to what ‘design’ is and where it fits within the intellectual property system. The difficulty in reaching any understanding of these issues today is that the legal concepts applied in the protection of designs, and

the work of the artist- craftsman has their origins in the middle to late 19th century when the design was seen essentially as the 'artistic' component of a useful product."³⁹

Legally , the term 'Design' may be confined for the purpose of providing protection to its subject matter, but in general meaning, it overlaps a wide range of aspects including their appearance and the functionality. This appearance leads to the conflict between which law can be applied on a particular subject matter to seek protection under that specific category. Copyright encompasses a wider protection over the appearance where the element of artistic work and originality subsists either in 2 or even 3 dimensions while the matter indicating the origin and the functionality of it are administered by the trademark law. It becomes to difficult to locate the design in between. Various national laws lay down different criteria to make the subject fall under the particular category. The differences are usually there in the national laws in the following respect:

- the intensity of the role of aesthetics
- functional deliberation
- As per the extent of role of aesthetics and the functional deliberation, the level of protection provided
- The manner of dealing with the overlap

The most difficult of all is whether the subject matter can be provided cumulative protection or is required to be categorized into one the overlapping domains and protected thereunder. The following conventions help in solving this problem:

- The Berne Convention 1886
- The Paris Convention 1883
- The Agreement on Trade Related Intellectual Property Rights 1994

The legitimate right given for the Copyright is by the law of a nation allowing the author of a unique work select rights for its utilization and dispersion. This is normally just temporarily. The elite rights are not supreme but rather restricted by confinements

³⁹ Report on Inquiry into Intellectual Property Protection for Industrial Designs, Ministry of Industry, Technology and Commerce, 1991.

and special cases to copyright law, including reasonable utilization. An essential limitation on copyright is that copyright guarantees quite recently the main enunciation of considerations, and not the hidden thoughts themselves.

Copyright is a type of protected innovation, pertinent to specific types of imaginative work. A few, yet not all works require "settling" copyrighted works in an unmistakable shape. It is regularly shared among different creators, each of whom holds an arrangement of rights to utilize or permit the work, and who are usually alluded to as rights holders. These rights much of the time incorporate propagation, control over subordinate works, conveyance, open execution, and "good rights, for example, attribution.

Copyrights are seen as provincial rights, which infers that they don't stretch out the domain of a specific region. While various parts of national copyright laws have been regulated through worldwide copyright understandings, copyright laws contrast by nation.

Usually, the length of a copyright crosses the maker's life notwithstanding 50 to 100 years (that is, copyright regularly slips by 50 to 100 years after the maker fails miserably, dependent upon the ward). A couple of countries require certain copyright traditions to working up copyright, yet most see copyright in any completed work, without formal enlistment. All around, copyright is actualized as a common matter, however a couple of districts do have any kind of effect criminal approvals.

Copyright originated with the innovation of the printing press and with more extensive education. As a lawful idea, its roots in Britain were from a response to printers' imposing business models toward the start of the eighteenth century. Charles II of England was worried by the unregulated duplicating of books and passed the Licensing of the Press Act 1662 by Act of Parliament, which built up an enroll of authorized books and required a duplicate to be kept with the Stationers' Company, basically proceeding with the permitting of material that had for some time been in actuality.

Copyright laws permit results of inventive human exercises, for example, scholarly and creative generation, to be specially abused and along these lines boosted. Distinctive social dispositions, social associations, financial models and lawful systems are believed to represent why copyright rose in Europe and not, for instance, in Asia. In the Middle Ages in Europe, there was by and large an absence of any idea of abstract property because of the general relations of generation, the particular association of scholarly creation and the part of culture in the public eye. The last alludes to the inclination of oral social orders, for example, that of Europe in the medieval period, to view learning as the item and articulation of the group, as opposed to consider it to be singular property. Be that as it may, with copyright laws, scholarly generation comes to be viewed as a result of a person, with chaperon rights. The most huge point is that patent and copyright laws bolster the development of the scope of innovative human exercises that can be commodified. This parallels the courses in which free enterprise prompted to the commodification of numerous parts of social life that prior had no money related or monetary esteem per se.

Copyright has developed from a lawful idea controlling replicating rights in the distributing of books and maps to one with a critical impact on about each cutting edge industry, overlapping such things as sound recordings, movies, photos, programming, and building works. The 1886 Berne Convention initially settled acknowledgment of copyrights among sovereign countries, as opposed to simply respectively. Under the Berne Convention, copyrights for inventive works don't need to be stated or announced, as they are consequently in compel at creation: a writer require not "enroll" or "apply for" a copyright in nations holding fast to the Berne Convention. As soon as a work seems to be "settled", that is, composed or recorded on some physical medium, its writer is naturally qualified for all copyrights in the work, and to any subsidiary works unless and until the writer expressly repudiates them, or until the copyright terminates. The Berne Convention additionally brought about outside creators being dealt with identically to local creators, in any nation marked onto the Convention. The UK marked the Berne Convention in 1887 yet did not actualize huge parts of it until 100 years after the fact with the section of the Copyright, Designs and Patents Act of 1988. Exceptionally, for instructive and logical research purposes, the Berne Convention gives the creating nations

issue necessary licenses for the interpretation or proliferation of copyrighted works inside the points of confinement endorsed by the Convention. This was an exceptional arrangement that had been included at the season of 1971 correction of the Convention, in view of the solid requests of the creating countries. It was until 1989 that the Berne Convention was not signed by the United States.

The United States and most Latin American countries rather went into the Buenos Aires Convention in 1910, which required a copyright see on the work, (for instance, all rights spared), and permitted signatory nations to limit the traverse of copyrights to shorter and renewable terms. The Universal Copyright Convention was drafted in 1952 as another less asking for differentiating alternative to the Berne Convention, and affirmed by nations, for instance, the Soviet Union and making nations. The controls of the Berne Convention are combined into the World Trade Organization's TRIPS understanding (1995), thusly giving the Berne Convention reasonably close overall application. In 1961, the United International Bureaux for the Protection of Intellectual Property denoted the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations. In 1996, this affiliation was winning by the building up of the World Intellectual Property Organization, which propelled the 1996 WIPO Performances and Phonograms Treaty and the 2002 WIPO Copyright Treaty, which instituted more prominent limitations on the utilization of innovation to duplicate works in the countries that approved it. The Trans-Pacific Partnership incorporates protected innovation Provisions identifying with copyright.

Copyright laws are institutionalized fairly through these worldwide traditions, for example, the Berne Convention and Universal Copyright Convention. These multilateral arrangements have been sanctioned by about all nations, and worldwide associations, for example, the European Union or World Trade Organization require their part states to agree to them.

4.2.1 Berne Convention

Protection of authorship is the main concern of the Berne Convention for which the work should be an artistic or literary piece falling under the definition laid down under Art2(1) which reads as:

“the expression literary and artistic works shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico- musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematography, works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, designs, sketches and three- dimensional works relative to geography, topography, architecture or science.”

In the above definition the phrase ‘works of applied art’ is of great relevance which was introduced into the definition in 1948 with the Brussels amendment of the convention. The subsequent two conferences held in Rome and Berlin faced the debate of whether ‘works of art applied to industrial purpose’ should have been included in the list. The controversy was regarding the degree of protection of the in the work of artistic nature when applied to the industrial purposes and the extent upto which the products manufactured by the industrial process and having artistic sense can be protected. The problem initiated with the artistic works like paintings, sculptures, drawings when applied to objects of utilitarian nature like cutlery, curtains, lampshades, crockery, etc. The other problem was faced when the objects having functional characteristics such as the machine parts, umbrella design, kitchen tools, etc. were found to be having artistic characteristics in them.

This problem was seen to be resolved by several national laws with France and UK being the first to attempt in relation to the fabric designs before Berne Convention could address the same.⁴⁰

They dwindled the ambit of protection of such materials of artistic insight when they possessed functional characteristics i.e. when they were applied to the articles.

This even led to the birth of the theory of unity of art⁴¹ which was found to be a safer way to escape the cumbersome situation. The theory seemed to be having so much boundless views and extent but was apt for avoiding the confusion and the trouble faced by the industry due to the overlapping of the two domains.

UK had a different and somewhat stringent approach of distinction between the works of artistic nature and that of utilitarian nature. The copyright Act 1911 bluntly denied protection to the artistic works which were applied to the industrial products under the copyright. This is evident from the above instances that the approach of different nations was different in the same respect in the initial years of the Berne Convention. Before the Berlin Revision, this issue was not at all raised in any of the conferences held. The International Office and the German Administration put forward the idea of incorporation of “works of art applied to industry” under the ambit of Article 4(1) taking support of several national rules established in different major countries stating:

*“The artificial boundaries established between pure art and art used in everyday life can no longer be maintained, neither from a doctrinal point of view nor from that of practical necessity.”*⁴²

The French motion even supported the statement by proposing to include the phrase “whatever their merit or purpose” with the previously suggested “works of art applied to industry”. In spite of several support for the above mentioned inclusions, there was a sound resistance also present at the conference. After so many conferences held further

⁴⁰ 1806 French Law, (1964)JPOS 615.

⁴¹ No distinction between the ‘industrial art’ and the ‘pure art’.

⁴²International Office, Berne, 42, 1908.

and the amendments made after discussions, the matter was resolved with the statement of Article 2(5):

“works protected in the country of origin solely as designs and models shall be entitled in another country of the union only to such special protection as is granted in that country to designs and models; however, if no such protection is granted in that country, such works shall be protected as artistic works.” And with this, the Brussel’s revision conference, 1948 tried to set aside the objective of the Berne convention of protecting the models and industrial designs as artistic copyright.

4.2.2 Role of the Paris Convention

The Hague revision conference held in the year 1925 brought the concept of ‘utility’ and the ‘industrial design’ to the Paris convention, though it was originated far before the Berne Convention. The revision of the Article 1(2)⁴³ made it familiar with the notion.

(2) “the protection of industrial property has as its object patents, utility models, industrial designs, trademarks, trade names, indications of sources or appellations of origin, and the repression of unfair competition”

The ‘objects’ including the industrial designs which were to be protected under the Article 1(2) were dependent on the national policies under Article 2(1) and were also given subject of priority under Article 4A(1) and Article 4C(1). Even for the extension of the ambit of protection, Article 11 guaranteed temporary protection keeping in view the exhibition of such articles at officially recognized exhibitions while Article 5D made commerce of the articles not a pre requisite for seeking the right of protection for the goods. Also the ingression of the products resembling the one protected previously leading to the nonworking of it is also exempted from the grounds of relinquishment of industrial designs.⁴⁴ The protective measures mentioned above were moreover based on the supposition that the subject to be protected must have been registered by the proper registration process prescribed nationally than on the motion of it being protected as a

⁴³ Article 1(2), Paris Convention for the protection of Industrial property, march 20, 1883(revised at Brussels on Dec 14, 1990).

⁴⁴Article 5B, Paris convention, 1883.

design firstly before the Lisbon revision conference held in 1958. Finally the revision made all the contrary propositions settled by introducing a specific definition of ‘design’ and also the tenure for the protection of the subject along with the requirement of it being novel. Though there was an agreement of scrutinizing the provisions for the protection of the articles as ‘designs’ in alliance with the UNESCO as well as the Berne Union but it stated nothing as to how it could be availed practically unlike the previous provisions which required it to be registered by filing an application etc. The active participants at the conference were “International study group on the Protection of Works of Applied Art and Design” who addressed the concern regarding the additive protection of a subject matter under the Design as well as the Copyright subsisting in it at the same time. The group explained that there was a dread requirement for the segregation of the different realms of protection which was a bit difficult task according to them. The Tokyo Congress held in 1966 and the WIPO Model Law on Designs circulated in 1970 also revealed the same notions. Thus, there seemed to be a kind of flexibility awarded to the members of both the Paris as well as Berne for the protection of their design under any of the realms and upto the extent they desired. This is clearly evident from the following remark:

“nothing is said about the means of providing such protection, so that countries may comply with that provision not only through special legislation for the protection of designs, but also through the grant of such protection, for example, in their laws on copyright or their provisions against unfair competition. What is necessary, but at the same time sufficient, is that, whenever the competent authorities of a member State define or recognize an object as being an ‘industrial design’, for example in view of its registration as such in the country itself or internationally, protection in some form be given to it.”⁴⁵

Conclusively, it can be said that the Paris Convention although, silent on the protection awarded to the artistic work and applied art by the international conventions and treaties

⁴⁵Bodenhausen’s comment on Article 5quinquies.

on copyright or even the TROPS Agreement and so is consistent with them in the sense that it makes them stay unaffected.⁴⁶

4.2.3 Role of TRIPS Agreement

The TRIPS Agreement is the only substantive obligation of the International standard addressing the problems in respect of the dispute arising out between the protection of an article falling under the Design as well as copyright through Part II of the instrument. It even lays down the specific requisites which were not at all mentioned in the Paris or the Berne Convention. they are mentioned as follows:

Article 25

“Requirements for Protection

1. Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

2. Each member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.”

Article 26

“Protection

1. The owner of a protected industrial design shall have the right to prevent third parties not having the owner’s consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

⁴⁶ Hague Agreement, Geneva Act

2. Members may provide limited exceptions to the protection of industrial design, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

3. The duration of protection available shall amount to at least 10 years.”

The provisions laid down by the TRIPS Agreement were supplemental to those of the provisions laid down by the Berne and the Paris one.

Summarily, the following inferences can be taken from the above statute:

- Article 25 guarantees protection to both the registered as well as the unregistered design unlike the Article 5quinquies of Paris which provided protection to them only post registering nationally and fulfilling all the prescribed formalities.
- As no registration gateway has been mentioned, so it describes no registration form which has to be adopted in order to seek protection under the TRIPS Agreement by a member country.
- The level of originality required for the copyright protection was moreover adopted from the national regulations of countries like UK and Australia which prescribed lower threshold for the purpose by using words “independent created design”. Also, novelty and originality were not additive requirements in the TRIPS.
- There is an option for the member countries to even reject to provide protection to the work if they are found to fit in the definition of ‘functional design’ under Article 25(1).
- The correct way of fulfilling the commitment under Article 25(2) has been described to be the one for the textile designs to be protected under the copyright without any further formalities.

- The Agreement saying “take account of the legitimate interests of third parties” formalized Article 9 (2) of the Berne convention in addition for laying down the exceptions to the exclusive rights mentioned in it.
- Article 7(4) specifies the tenure of the protection of the work but it has been nowhere mentioned if this term starts from the time of developing the design or its publication or application or registration etc.

4.3 Jurisprudential Study of the interface between the Design and the Copyright

For the purpose of bringing scrutinizing the scenario of the overlap between the two domains of the intellectual Property i.e. Copyright and the Design, the protection provided to them can be broad classified under the following three national approaches:

1. No additive protection
2. Partial additive protection
3. Complete additive protection

Within one approach also, the degree of protection varied from one nation to the other.

4.4 Sui Generis Design Law's potency

Due to the TRIPS talking about the validity of even non registered designs, the interest of the people declined in obtaining registration over their work in Australia while the same faced an increment in Europe due to the new Design Laws and also the Community Design. Notwithstanding all the authoritative and strategy exertion that has been exhausted as of late, the troublesome issue of connection amongst copyright and designs laws remains. we now have expound administrative arrangements in various wards, and global consistency appears to be further away that it was even 10 years prior. this is the situation even after TRIPS, however is reasonable under the present global structure gave by that assention and the Paris and Berne Conventions. Proposed thus is a more straightforward and more direct approach that is steady with this structure.

The beginning stage is artistic copyright, and the way that 'work of connected craftsmanship' are incorporated inside the extent of 'scholarly and aesthetic works' in Article 2(1) of the Berne Convention.'work of connected workmanship' is an adaptable idea which is equipped for grasping creative works that are misused in a two-dimensional mold through applications to surfaces and materials, for example, backdrop, garments,

tea towels, floor overlappings and so forth, and in addition works that are abused in three measurements where designs are connected to the shape or design of valuable articles, for example, seats, tables, headlights, water tanks, espresso percolators and so forth. aesthetic copyright will for the most part become an integral factor on account of three dimensional designs in light of some previous two-dimensional imaginative work where items made by that design can be viewed as three-dimensional multiplications of the two-dimensional work.

Also a national approach like that of India can be adopted in that regard where Section 15 of the Copyright Act 1957 gives the special provision for the protection of copyright in design (actually registered or capable of being registered under the Design Act) as follow:

“(1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 1911 (2 of 1911)

*(2) Copyright in any design, which is capable of being registered under the ¹ [***] Designs Act, 1911 (2 of 1911)², 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 license, by any other person.”*

And the definition of such Design has been specified clearly by the Section 2(d) of Design Act 2000 where “*“design” means only the features of shape, design, pattern, ornament or composition of lines or colors applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957);”*

So, the overlapping problem has been well settled in the Indian statutes.

Resolution of the problem: an innovative approach adopted in a landmark case

Subject of overlapping is new and not so established, still one of the leading judgements delivered by the Privy Council attempted to resolve the issue in *Interlego AG v Tyco Industries Inc*⁴⁷, popularly known as Lego brick case. In the case, there was a suit for the infringement of the copyright of the plaintiff i.e. the plaintiff by the defendant. The design was also registered as a design and so was not qualified to seek the copyright protection further. The plaintiff wanted to claim the right over the design under the copyright law having a wider scope of the protection and also to an extended radius as compared to that offered by the trademark due to the reason that there was no provision for cumulative rights. For the sake of establishing this fact, the plaintiff even moved to the court for proving that their bricks were not qualified of being registered under the design act by virtue of Section 10⁴⁸ so that they could be protected under the copyright having wider protection for even longer duration. For ascertaining this, the court applied the test of determining the element of aesthetic appeal and not the functional element which could make it capable of being registered under the design. To ensure their claim, the plaintiff also argued that they made certain improvements in their design as original artistic work which made it a subject matter of copyright rendering it to be an infringement even if make an object out of the design over which copyright subsists. The judgement was not in favor of the plaintiff and held the bricks capable of being registered under the designs and so were not protected under the copyright law. Lord Oliver while stating the judgement said:

“Inevitably a designer who sets out to make a model brick is going to end up by producing a design, in essence brick shaped. [...] There is clearly scope in the instant case for that argument that what gives the Lego brick its individuality and the originality without which it would fail for want of novelty as a registrable design is the presence of

⁴⁷Interlego AG v Tyco Industries Inc[1989]AC 217

⁴⁸ Section 10, Copyright Act 1956

features which serve only the functional purpose of enabling it to interlock effectively with the adjoining bricks above and below”

Further, design drawings were held to be a merger of both literary and artistic works with the matter written on them to be literary work and the pictures on them to be the copyright subject matter. The changes made to the drawings were a little alterations within the radii of the copyright’s ambit. Judge stated:

“Take the simplest case of artistic copyright, a painting or a photograph. It takes great skill, judgement and labour to produce a good copy by painting or to produce an enlarged photograph from a positive print, but no-one would reasonably contend that the copy, painting, or enlargement was an "original" artistic work in which the copier is entitled to claim copyright. Skill, labour or judgement merely in the process of copying cannot confer originality”

On summarizing, he explained that there must be some element of mutation to make the work an original artistic work with the adornment being significantly visible. The alterations made by the Interlego did not make it an original work and so didn’t afford copyright protection. The labour and the efforts employed in the process of its formation were in the copying and not the originality and innovativeness.

Chapter 5: Overlap of copyright and trademark

5.1 Visionary Overview

Although the inception and purpose of the copyright and the trademark law are not identical making difference in their arena by being protector of different subject matters, regulated by different statutes regarding ownership, infringement, tenure, certification, etc. but it is not so unusual that two different intellectual property protection overlap each other in respect of the presentation of the product comprising any material for the promotion of it like its name, stickers, packing material and appearance which can be protected under the copyright law as well as the trademark law. This gives rise to the chaos in the situation where in the same creation, a party has a copyright and the other has the trademark in the same and one of the protections expires. In order to deal with the overlapping issues, it becomes too crucial for one to distinguish between the two different branches of the Intellectual Property.

The advantage of having both the rights together is a most profitable business for any big commercial house. The clients are normally advised by the legal counselors to obtain the copyright and thereafter a trademark on one right which could be anything. This practice, unlike design and copyright, has not received any express legislative bar; however, the judicial system is successful in giving uncertainty to both the thoughts to allow such multiplicity and the otherwise.

It is practically practiced by the lawyers to register one kind of a creative work under both the legislations in the best interest of their clients reducing foreseen consequences of piracy or weakening the case of infringement or remedying their rights with utmost strength. Even the developed countries have a dicey set of verdicts giving rise to uncertainty in this situation. Therefore, the practice of overlapping of rights between the copyright and trademark is rising. Without doubt, both the laws have different subject matter to be protected and have different aspects of functions in the commercial market. It cannot be done that the copyright can give immense profit to the goodwill without having the secondary meaning in terms of the trademark.

By now the readers must have been clear on the fact that the overlapping protection is one side profit making especially in the streams overlapping inter alia like design, copyright and trademark due to the nature of renewal of mark in the trademark law. Similarly, this chapter recognizes to kinds of overlapping of the copyright and trademark: one is co-existence of both rights together at same time and second is post expiry of copyright having trademark rights alive until otherwise the wish of the right holder.⁴⁹

Both kinds of overlapping regime are a matter of concern for the society. The first kind of the overlap does not allow the society to have benefits of the copyright by way of fair use doctrine which is widely accepted and practiced for growing or recognized segment of the society. However, the trademark rights co-existing with the copyright would bar the application of fair use and fair dealing as nothing like “doctrine of fair use” or kind is applicable or available for the society by the trademark rights and this leads to hampering of interest of the society.

Already the copyright exists for post-life period in most of the copyrightable work. Despite this long period, the existence of the trademark rights after the copyrighted work is ought to be in the public domain would deprive away the moral rights of the public. Therefore, such overlapping is a matter of trouble for the society and could result against the public interest.

The overlapping in the western side of the world is common on slogans⁵⁰ and advertising campaigns which has attracted attention of the jurists to rethink on the appropriate rights that should be attributed to slogans or other related work. Earlier and now itself in some of the jurisdictions, the slogans and like are protected and overlaped under the trademark laws, however, the western laws have started recognizing this under the copyright laws. This transformation was not a one day game; it took a lot of discussions, disputes and verdicts on these issues. It is now recognized that eleven word long snippet is affordable

⁴⁹ Irene Calboli, *Overlapping Trademark and Copyright protection: A call for concern and action*, Illinois Law Review Slip Opinions, 2014

⁵⁰ OnurSahin, *Should Copyright Law protect Advertising slogans*, European Intellectual Property Review, 2016

of copyright protection, if it fulfills the requirements of the copyright laws.⁵¹ It has been argued in the court of law that the slogans do not constitute to have copyrightable requirement, especially the length of the slogans. It is well settled now that the slogans can also be a part of the copyrighted work, provided nourished as per the requirements of the copyright.

Viewing the status of overlapping of the trademark and copyright laws in today's time, the courts have accepted the overlapping of these regimes in the commercially known characters which are capable of giving goodwill to the company by its existence.⁵² But the courts and the juridical system is still reluctant in giving full fledged acceptance to the overlapping of these laws.

By this chapter I would try to bring the comprehensive approach blended with the views of the legislature, jurists and the courts to find out the possible and feasible solution against the problem of the overlapping of rights. This approach is based on *ex ante* view to give proper outcome without lacking practicalities of interruption to right holder's right while reducing the evil of overlapping hampering the rights of the society and public interest. Nevertheless, it is difficult to strike a balance between two opposite views but synchronization could be achieved.

5.2 Diverse inception, attribution, and expansion of trademark and copyright law

International conventions like the Berne Convention on the protection of Literary and Artistic Work and the Universal Copyright Convention have attributed the definition and meaning of the copyright work and similar is the case with the international convention on the trademark laws, like the Madrid convention and the Paris convention have a set of meaningful understanding on trademark laws. The *sine qua non* for copyright and trademark are different and the interferential margin has not been blurred yet between these two laws due to enough difference in these laws on the source, subject matter and requirements of protection.

⁵¹ Sweet and Maxwell, A journal concerning the management of technology, copyrights and trade names, European Intellectual Property Review, Vol. 38, issue 3, 2016.

⁵² Disaster Corporation V. Twentieth Century Fox Films Corp.. 539 U.S. 23 (2003)

The Court of the US in 1962⁵³ have agreed to the notion that the trademark and copyright could co-exist and this finding has been carry forward after a few decades which said, “the dual protection under the trademark and copyright law is appropriate for graphical representation and characters”⁵⁴. Moreover, this was the first decision of its kind that mentions over the concept of co-existing of trademark rights with the copyrights or after the expiry of the copyrights due to the secondary meaning that the trademark has acquired in the given time. Hence, the matter fallen in the public domain would still be eligible for trademark protection due to the independent significance that the trademark has acquired for identifying the source of good, origin and quality.

The ambivalent views on the copyright and trademark overlapping have also been in trend over a century. In 1907 case⁵⁵, the Webster dictionary had a publisher who was flatly denied the protection of the trademark on the name of the dictionary because of already existing copyright on the dictionary and this protection on trademark by the publisher was sought after the copyright had expired. This was the verdict of the Federal Court of Massachusetts.

Very recently in 2003 in the case of Dastar Corporation V. twentieth Century Fox Film Corporation, the Court held that “*the creative work is capable of protection under the trademark regime only when the work is able to indicate the origin of production of the tangible goods that are offered for sale. Also, this kind of a protection cannot be offered to anyone with creative idea, or anything that is overlaped under the copyright protection regime. If anything such happens, this would dilute the standard and value of copyright protection*”.

Without any matter of surprise, it should be accepted that the legal practitioners have successfully sought the alternative to copyright protection and also a way to improve the protection at least when subject matter relates to the articles, characters, videos, slogans, etc.. Some of the much known examples of this are: Angry Birds, the lord of the rings, Mickey Mouse, Star Wars, Simpsons and The Hobbit. Therefore due to the successful

⁵³ Designers Nut and Chocolate Co. V. Crown Nut Co.. 305 F.2d 916 (C.C.P.A 1962)

⁵⁴ Frederick Warne and Co. V. Book sales, Inc., 481 F. Supp. 1191, 1196

⁵⁵ Ogilvie V. G. & C. Merriam Co., 482 F. Supp. 1191

stretching of both the laws, the practical aspects have grown further than the theoretical meaning attributed to independent copyright and trademark regime at least in creative work. Yet, it is not absolutely settled to extend copyright and trademark to the extent of overlapping rights hurting the public interest. The live example is the case law Warner Brothers Entertainment v. Global Asylum Inc.⁵⁶ where the movie was released with the title “The Hobbit” and have disputed arisen on the violation of the copyright as the word mark was used by the plaintiffs and any such use would violate their word mark.

5.3 Mutant Copyright by additional trademark protection dilutes public interest

The case of Warner Brothers⁵⁷ and the Daster Corporation have proved that the overlapping if copyright and trademark are *fait accompli* in the trademark practice, especially for the signs, characters and designs used for the identification of source of the products for sale. As it may be, the same courts have also found that such practice of mutant copyright would sweep away the objectives of the general code of intellectual property rights by disturbing the balance of copyright law towards the basic public interest. This overlapping would make it impossible and hurtful for that segment of the society which is overlaped under the identities allowed to copy under the fair use doctrine enshrined in international conventions and domestic laws like section 52 of the India Copyright Act, 1957. The best recent example of the knowledge which could be deprived and barred from general use by overlapping is the character Peter Rabbit. The court have denied the mutant copyright in role of the trademark

The whole and sole purpose of the Copyright system is to seek advances in the creative system of the society and to promote this purpose one should be allowed to copy or allowed access to the creative work already in the public domain. This access should be no doubt with reasonable restriction towards the right of the author whose interest should not be hurt. However, the freedom to access can only lead to advancement in the society and that is the reason to embed provisions of fair use doctrine, substantial similarity, original content, etc. are provided in the regime of the Copyright law by domestic and

⁵⁶ 2102 WL 6951315

⁵⁷ *ibid*

international laws and conventions. Any additional lock to such advancement that too by regime of trademark law which absolutely precludes the society from using the protected mark in anyways and even the Courts have given penalty and strict reasoning on overriding theory of goodwill of the business. Moreover, the overlapping of protection by trademark would harm the societal advancement in the creativity and access to knowledge would be at high risk of monopoly by the owner of overlapping protection.

No wonder that the trademark owners are majorly at an upper edge of the society to the copyright owners in terms of finance, investment, resources and opportunities of expansion. Hence, the dispute of copyright and trademark overlapping has been settled outside the Courts by the poor copyright owners by granting licenses to the trademark owners for their use of copyrighted work. This happens due to realization by the copyright owner that they lack resources to fight the case of copyright infringement against the rich trademark owners as litigation is highly expensive and also, the trademark owner has better and much efficient resources for expansion of that copyright work. Therefore the copyright owners choose either too completely stop using the artistic work on their name and withdrawing the expensive litigation or end up licensing their copyright work to the trademark owner to gain least benefits that is possibly accruable. If overlapping practice is not stopped now with strict guidelines from the Courts and legislating body then it would lead to situation of high absurdity. Especially now when the copyright is relentlessly increasing in the creative work and more work in functional art wherein the trademark industry also has some considerable interest to obtain rights for maximizing incentives. The practice of overlapping between these two popular regimes is more problematic because it would lead to ending up gaps and differences that these two regimes are associated with.

5.4 Analytical review of overlap with the inclusion of new classes of mark in accordance with law in-force in Russian federation

A different approach has been witnessed uplifted by the Article 7(3)(iii)⁵⁸ of the statute referred to in the Russian Federation. It says that for registration of a design similar to

⁵⁸ Article 7(3)(iii), Law of Russian Federation on Trademarks, Service Marks and Appellations of Origin.

that of any scientific work, artistic work, writings from that work, service marks or anything similar thereto, there must be a consent of the owner of the copyright, or the legal representative of the owner at the time of filing the application in case the rights vested thereto are a result witnessed prior to the date of priority claimed for the trademark to be registered to avoid its rejection on this ground.

This eliminates the need for the examination of the work pursuant to Article 7(3)⁵⁹ and the examination is conducted in accordance with only Article 12 of the Trademarks Law. But there is chance for the third party to question the validity of the registration as prescribed in the procedures administered by the Chamber of Patent Disputes⁶⁰. The decisions taken by the authority at the time prior to their acceptance in the court have been minutely examined by various other authorities and the arbitration bodies and have come up with some analytical points as follows:

The decisions taken by the Chamber of Patent Disputes in case of any objection raised by the third parties which includes either the owner of the copyright over the work in question or the one who is vested with the exclusive rights over it are found to be apt.

It has even taken extra pains in establishing the copyright in the work in question for the purpose of resolving the matter in extreme cases while the verification of the existing copyright is a usual practice. Along with this, the disputes regarding the trademark have also been solved by considering the validity of their registration.

The notion adopted by the Chamber is that irrespective of the creativity or non-creativity attached to the copyright which is to be registered as a trademark, if the consent of the copyright owner is not present, it amounts to copyright infringement *prima facie*.

All the legislations and the provisions dealing with the subject of copyright and the trademark are well applied to the circumstances when there is a matter arising of the appeal made by the third parties regarding the registration of the copyright as trademark.

⁵⁹ Examining for ascertaining the absence of overlap of trademark with the copyright

⁶⁰ An authority for the purpose of resolving the disputes arising out of examination

The term “exclusive right” in relation to the copyright owner was interpreted and was found to be including the right of the author of the copyrighted work to reproduce it or to cause it to be reproduced.⁶¹ Further, it was clearly stated in Article 12(1) that in case of the derived work or the reprocessed work from the work in which copyright already subsists, the rights was associated with the owner of the original work. The only condition on the rights conferred on the author of the derived work is that he will have the exclusive rights only over the work which he has created subject to the requisite that he is also ready for accepting others adaptation or derivation out of his work.

By applying the above administrative guidelines in the field of copyright, the courts should perceive as invalid the give of lawful security for trademarks constituting assignments indistinguishable to (or including) copyright topic. This can be well explained with the help of the following instances:

- i. V. Khazovaya and V.N. Khazovoi, in the execution of their expert obligations for the general population organization "Gzhel" and distributed in a list of workmanship protests in 1988. Accordingly, people in general organization "Gzhel" relegated to the general population restricted organization "Gzhel" the restrictive copyright to utilize the design of "PtitsaGzhel", in agreement with the assention of November 29, 1991. As the rights proprietor of the elite restrictive copyright in a work of compelling artwork, the general population restricted organization "Gzhel" considered that its rights had been encroached when the trademark was enlisted in 1993, in someone else's name. As a non-literal component, delineations of flying creatures were utilized as an enrolled trademark, replicating straightforwardly as an identical representation a part of the above show-stoppers, without the assent of the copyright proprietor. A court perceived as unlawful the give of legitimate assurance for the trademark.
- ii. A comparable approach was likewise embraced in connection to settling a debate which emerged thus of the enrollment of the trademark "WINNIE". The subject of dialog by the court was the subject of the creation of B. Zakhoder of the name of the character "Winnie" in the work "Winnie the Pooh and the others", which got to be distinctly

⁶¹ Article 16(2), Russian Federation on Copyright and other related rights, July 9, 1993

acclaimed to Russian pursuers on account of the interpretation done by Mr. Zakhoder of the work by the creator A.A. Milne "Winnie the Pooh and the House at Pooh Corner". Firstly, the court expressed that "Winnie" was brought into the Russian vocabulary by Mr. Zakhoder, after the production of his book "Winnie the Pooh and the others", and the artistic interpretation is a result of imaginative action and can't be completely indistinguishable to the first. In this association, the court inferred that in all actuality Mr. Zakhoder had the copyright in the character (Winnie the Pooh, Pooh) as a component of the inferred work which he had made. The enrollment in someone else's name of a trademark including or speaking to, specifically, the verbal component "Winnie" without the consent of the creator's successor – G. Zakhoder – is unlawful.

- iii. Practically speaking, Russian courts have analyzed such cases concerning the encroachment of the copyright of remote people. In 1994, the Russian Federation agreed to the Berne Convention on the Protection of Literary and Artistic Works, 1971 adaptation, and the Universal Copyright Convention, in 1971 rendition. As per Article II(1) of the Universal Convention, "Distributed works of nationals of any Contracting State and works initially distributed in that State should appreciate in each other Contracting State an indistinguishable security from that other State accords to works of its nationals initially distributed in its own particular domain, and additionally the protection uniquely conceded by this Convention".

On the premise of the above standard, a debate emerging between the German firm "Carl Bechem GmbH" and the rights proprietor of the trademark with the verbal component "HESSOL"– the Russian open restricted organization "Prognoz- Holding Advertising Information Center" - was settled.

In considering a choice, the court took the narrative proof – an affirmation by Mr. Ronald Neumeister, a German native, as per which the delineation of a lion replicated in the debated trademark was delivered by his inventive exertion. In this association, the proprietor of the restrictive copyright in the given work, therefore of shared work relations, is the creator's manager – the publicizing organization Neumeister GmbH, which in this way exchanged the restrictive copyright in the named work, as per the creator's assertion, to a third individual – the firm "HESSOL HessischeÖlwerke A.

Fischer und Sohn". As per the court's choice, the enlistment of a trademark replicating the name of a character from a work of writing is perceived as invalid. As respects non-conventional sorts of imprints, in the designing of this material cases of the examination by courts, of debate identifying with the overlap of copyright and the rights in non-customary trademarks, have not been recognized.

5.5 Conclusion

The identification of distinction between copyright and trademark protection is a complex process in the present time, this is because of expansion of these fields relating to legal rights. The copyright protection has developed and prevailing in the brand name or character merchandising. In UK the courts have aspired to develop a course that reduces the holding of any double layer of guarding by determining the main duties of law. US have adopted similar methods but equable by increasing surveillance of trademark requirement that will infringe the works that are no longer guarded by copyright.

Trademark law, stresses on explaining about existence of goods used in trade, is attached by the necessity to manifest a possibility of confusion or tarnish to one of the important duties of trademark by an alleged offender before retribution is granted. The continued development of subject-matter probably falling within the scope of a trademark is modulated to some extent by the necessity to exhibit that the mark relied on has been used by the owner in a way to illustrate source. Only if Consumers can be shown to rely on a mark an origin modifier and not simply as a form of display (in US terms, 'secondary meaning' can be proved) will the stain be protected.

In instances having substitute claims for copyright and trademark violation the UK courts have shown that the effective crossover among the two IP sectors is restricted and where it subsists it is on the entire, taken to be interrelated giving a substitute diverse from the modes of protection rather than a disturbing or hostile right. The advent of interface matters in US is same (with the debarment offered to 3-D articles overlapped under the copyright law which has implicitly been removed with from English law , except in context to works of decorated craftsmanship), despite again with a probable desire for copyright public sector issues in special situations.

Moreover, the expansion of rights from the copyright to the trademark protection specifically in the creative work would lead to injustice to the societal bargain. After knowing the facts and figures, it seems not reluctant to me to say that the additional trademark protection is against the objectives of the intellectual property rights system. Furthermore, the principles, objectives and basis of copyright law are on fairness, creative advancement and societal benefits which would sink due to unwarranted expansion of rights in this competitive world. The overlapping regime is highly profitable to maximize the profits, incentives and monopoly on the creative works for the copyright world giving excess rights to the copyright industry and it is available at the most convenient choice.

It is clearly dug that the overlapping rights shall be stopped at its inception or should have high control on its application. There has to be a bright line marking difference between the trademark law and copyright law and wherever the lining is not possible, the overlapping should subject to high scrutiny, judicial control and legislative intent both at ex-ante and ex-post. As we are moving towards the period where the copyright expiry would be at high and as a result the trademarks will be claimed on those expired copyright. It is essential for the judicial system, legislature and the international policy makers to initiate discussions on this mutant copyright by trademark registration to have protection for the society against the vigorous trademark owners who would seek trademark rights post-expiry of the copyright.⁶²

The clear presentation by the ECJ in the Lego case mentioned to above and those of the US courts in Dastar and the Betty Boop cases, that trademark rights may not be opined upon to make a “Species” of deviation copyright that will destroy the public domain emphasizing the strength placed under both European and US law on policy application. In the US the function of copyright as a stimulant to authors to devise new works for the welfare of the public taking precedence over the role that trademarks play once copyright has perished.

⁶² Supra note 49

Chapter 6: Difference and Conflicts between Patents and Trade secrets

6.1: Introduction

The intellectual property is a totally different set of special laws, as also stated in previous chapters with appropriate examples. However, the expansion of intellectual property rights to overlap the most complex area where technology and law blends are patents and trade secrets. It is not always the trade secrets which could read in conjunction with the patents; the trade secret is nothing but an exclusive business strategy that keeps the competitors and rivals anonymous about the rise in business and product quality. It is always addressed as the most confidential information which is to be kept confidential, there has to be precautions taken by the holder of such information preventing it from leakage and it must inundate commercial benefits to the business. The trade secrets are not widely protected under codified laws in some of the jurisdictions and contrary are true for those jurisdictions that support trade secrets remedy under codified special law; for instance, USA has a trade secret law, The Uniform Trade Secret Act, 1979. India has no special legislation to identify the rights emerging from the trade secret law, any encroachments occurred with respect to trade secret are dealt with law of torts in conjunction with other penal, procedural and special laws.

The expression "intellectual property" invokes aims of patents issued to spectacular inventors, well known trademarks and copyrights overlapping awesome centerpieces, writing, and music. In any case, patented innovation is not restricted exclusively to these three all around sets of IPR; certain topic can likewise be ensured as a "trade secret." Indeed, features have included competitive innovations depicting Volkswagen A.G's. installment to General Motors of \$100 million for charged burglary of prized formulas, Campbell Soup's claim against Heinz taking after deserting of a top Campbell official to Heinz, and Eastman Kodak Co's. competitive advantage suit blaming a previous representative turned-specialist for the robbery of "a formula book of the organization's mystery recipes for film fabricating."

Speaking about the inherent characteristics of both the regimes, the patent law confers the right-holders with exclusive right to use the technology or patented product to a limited

term of whereas there is no limited term of using the knowledge in trade secrets. Also, the patent allows disclosure of the invention or the innovation to the public without withholding the knowledge to produce the patented invention restricted to the labs/workshops/ or places of the inventor. It cannot be interpreted that public disclosure would give legal rights to the public to take overdue advantage of the patent disclosure until the expiry of patent rights. Slightly contrary to the patent regime, the trade secrets are not subject to exclusive rights granted by the Congress or any nation. The measures to keep it a secret has to be solely by the owner of the trade secrets. If disclosed by any means, the trade secrets are ought not to be protected by the legal medium. Even the law does not bar anyone in a legalized manner to perform reverse engineering on the product manufacture using the trade secret. Hence, reverse engineering is allowed to disentangle the secret information behind the trade secret, this information can be a molecular formula, composition of substances, program algorithm, etc.

The exact definition of trade secret is yet not codified in India. Nevertheless, the meaning can be carved out for layman understanding from the Uniforms Trade Secret Act which defines it as, “*Information, including a formula, pattern, compilation, program, device, method, technique, or process, that:*

(i) Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and

(ii) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.”⁶³

These clearing proclamations don't characterize the topic of a trade secret as much as build up an utilitarian definition that gifts competitive innovation protection to the individuals who energetically police access to what's more, keep up the mystery of the competitive innovation. This practical definition overlaps for all intents and purposes any material that (1) is proper subject matter, (2) is kept up as a secret, (3) is not for the most

⁶³ Uniform Trade Secrets Act § 1, 14 U.L.A. 537 -38 (2005).

part known to the industry or open (4) is either marketed or of some value, and (5) has a specific level of distinction or solidness

When the information which was protected as the trade secret is leaked, the Court being the forum of justice has to reach to some favorable decision for the person with no wrong-doing. However, the court has to have a multiple views before titling against the disclosure of trade secret because trade secret is not protected by any special law but by only the general laws with certain exceptions. To protect the trade secret it is important to produce before the Court that the information which is stolen is of commercial value and that value is to be determined as literally giving advancement to the industry or offers a competitive advantage.⁶⁴Contemplating the status of protection of trade secrets in practical sense, the Court offered protection only to the information which has an additional advantage over the competitors and in the industry that information has to be nourished by investing significant time, money and knowledge. No matter what the information is, but it has to be produced with sufficient investment by the holder of the trade secret. Another important addition to the above is that the information shouldn't be available generally, even to the employees of the company. Such information has to be made secured by various measures and not allowed to be known to every common person or person having no interest. Also, the confidentiality is maintain to make it difficult for the third party to obtain the trade secret without going out of track or something done in unlawful manner.

While arguing before the court of law, it is important for the trade secret holder to produce such evidences and facts that makes it fact-sensitive for the deciding authority, than arguing on the laws. As it is implied, the measure cited above can only be proved on the basis of facts of the case and the evidences to collaborate with the facts of the case.

The situation of overlap may arise in a conflict between the trade secret and patent. However, the choice to be made in between the trade secret and patents is easier when the subject matter in question is non-patentable invention under the patent act. Hence for this

⁶⁴ See, <https://www.quora.com/Whatisthedifferencebetweenapatentandatradesecret>, last available, 3/02/2017

situation only medium to protect the invention is trade secret. But the problem is more in the following situations:

- a. The subject matter is clearly patentable;
- b. The subject matter is of dubious patentability; and
- c. Other forms of protection may be sought.

Now conflict and concern arises amongst the above enlisted situations whereby the owner of the information can seek either the trade secret or the patent rights and it is more complex when the owner seeks multiple protections trying to obtain the patent rights and the trade secret both for one invention/innovation. This view is not against the public policy or moral rights so far that the bifurcation between the trade secrets and the patents are possible; in other words the necessary ⁶⁵information which is required to be disclosed by way of patenting is clearly been made available to the public without hiding under the umbrella of trade secret. As anything happening contrary to above, i.e. the information given for patenting is limited and not sufficient to properly or wholly describe the invention, and this limited information is provided to maintain a trade secret associated with the patenting invention. In such cases the overlap is most likely to arise and bring uncertainty to the special IP regimes. ⁶⁶

The viable meaning that could be given to trade secrets blend with the patents is understood from the given example, i.e. an inventor will try to patent his development. However, for most of the jurisdictions the patents take numerous months if not a long time for a creation to be prepared for protecting. In the event that another person brings the innovation into the public domain before a patent application is filed, the first creator's ensuing patent application will be rejected for absence of novelty. There will be no legitimate design of action against the other party, unless the first creator can

⁶⁵Dean W. Russell, Russell A. Korn, and Christopher M. Durkee, Choosing between trade secret and patent protection, Intellectual property desk reference- Kilpatrick Stockton LLP, 2012

⁶⁶ See, <http://www.ipdigit.eu/2013/10/secretvypatentshowtochoose/>, last available, 03/03/2017

demonstrate the last had admittance to his innovation and replicated it. In this way, in the time before a patent application is filed, the applicant will require its secrecy.⁶⁷

6.2 Analysis of hypothetical situation

The hypothetical situation is given below which best describes the overlapping of patent and trade secrets.

A group of reputed engineers from the world collected together with one objective to produce a car and other commuting vehicles which runs by fuel water. This invention would be a breakthrough in the field of science, communication and automobiles and hence to protect it from being exploited by unlawful means they have tried to keep it a trade secret until patented. The invention is novel, non-obvious and has industrial application, i.e. the invention fulfills all the eligibility criteria of the patenting. For successful experiments and projects, the engineers approached the automobile company for investment and in-return of the investment the owner of the automobile company asked for the confidentiality of the invention.

Now the company owner, being the rightful owner of the technology, has the following options:

1. To keep the trade secret and commercialize the invention;
2. To disclose the technology and obtain patent rights for a limited term; and
3. To disclose limited knowledge of the technology and keep rest of the knowledge as trade secret. Hence, this might hamper the requirement of the patent whereby it is mandatory to disclose the best way of performing the inventions.

The (3) point is converging point of both the concepts of trade secret and patents and it is most likely to confer both the monopolistic rights to the owner by patenting and

⁶⁷See, <http://www.smeadvisor.com/operations/trademarkpatentcopyrightortradesecreteoverlappingiprights/>, last available, 01/02/2016

maintaining the trade secret. Thus, enjoying both the rights simultaneously is the overlapping of patents and trade secrets.⁶⁸

Another situation describing the condition of overlap between the patent and trade secret is elaborated ahead. A drug may be patentable for its unique molecular formulation, but a later development shows that the company has a trade secret as well with reference to the above patented molecule. The slow release formulation of that drug may be kept as a trade secret by the owners. Also, the goodwill of the company is hitched with the trademark it possess and even the shape of the pills, packaging, etc may be protected by design rights or the trade dress, depending on the facts of the case.⁶⁹

6.3 Integration of IP Rights

Since the substance of the patent framework is public disclosure by the inventor of the invention, it is some of the time proposed that keeping creations secret isn't right. This is a genuine misinterpretation. The decision in *Dunlop Holdings v. Slam Golf* clarified that people in general take advantages and benefits from trade secrets. Trade secrets insider facts by and large don't stifle financial movement, since employees, suppliers, licensees, and others are offered access to the necessary information. Moreover, given the high occurrence of worker versatility and coincidental or think spillage, many trade secrets disseminate inside a couple of years. Conceivable reverse engineering and examination of items are extra ways that trade secrets may disperse or get to be traded off. As such, trade secrets are confidential just in a constrained legitimate sense.

Writing and literature on IP systems, IP valuation, and other IP points quite often address patents and patent portfolios. This concentrate on patents, in any case, neglects the way that legitimate assurance of advancements of any sort, particularly in innovative fields, requires the utilization of more than one IP classification. This overlap guarantees double or different assurances.

⁶⁸ Mark Radcliffe & Lawrence Rosen, *Patents, Copyright and Trade Secrets-What is the difference?*, CIO News, 2003.

⁶⁹ See, <http://www.bakernet.com/BakerNet/Practice/Intellectual+Property/default.htm>, last available, 12/12/2016

Today, we have a single conceptual theory of IP rights and remedies, a solitary field of law with subsets, and a huge overlap between IP fields. A few IP rights are accessible for a similar IP or for various parts of a similar IP. Not exploiting the overlap misses openings, it amounts to a malpractice.

Particularly for innovative items like high-technology goods and services, trademarks and copyrights can supplement patents, trade secrets, and mask works ("blueprints" utilized as a part of the R&D and creation of semiconductor chips). One IP class, regularly patents, might be the "focal point of gravity" in specific occurrences. Other IP rights classes are then supplemental however similarly significant. The supplemental types of IP may capacity to: overlap extra topic fortify selectiveness invoke additional remedies in suit give a reinforcement if an essential IP right gets to be distinctly invalid, subsequently giving cooperative energy and ideal lawful protection.⁷⁰

Some examples of multiple protections available on technologies are:

- a. Computer system having data processing units:
 - i. Patentable hardware and software;
 - ii. Copyrightable software
 - iii. Trade secret of production and algorithm process
 - iv. Semiconductor chips protectable under industrial design
 - v. Trademark registration

6.4 Conclusion

It is been noted unlike the other chapters of this literature, the overlap of trade secret and patents are not in legal arena too much. Other chapters where the overlap was clearly identified are the copyright v designs, trademarks v designs, etc and these are the major bluff areas in the context of overlapping of IPR. Even the courts of the USA, UK and India have not experienced too many overlapping cases between the trade secret and patents. Moreover, the overlap of trade secret and patents do not appear to be barred by law as one is protected by special worldwide known patent law and other has stumbling

⁷⁰ See, <http://www.iphandbook.org/handbook/ch11/p05/>, last available, 17/02/2017

existence as codified law. Also, not many writers, academics and jurists have successfully drawn any line margining the overlapping of both of these regimes. The issue of overlapping of patents and trade secret is one of the rarest occurring issues which is not even faced much by the Courts. On the contrary, it is generally a strategy of the inventor by which he prefers the technology or other inventions/creativity to maintain a trade secret and afterwards disclose the knowledge as patent disclosure.

The most that the overlapping regime causes is the maintenance of secrecy of the primary information which ought to have been given by the inventor for patenting but he chooses to keep it as a trade secret. Hence, the best way of describing and performing the invention is not generally revealed by the inventor and is maintained as the trade secret for commercial interests.

Although the situations have arisen in the past when the jurists have questioned as to whether the rampant use of the secrecy provisions would erode the basic foundation and goals of the patent law of public disclosure. As the patent law makes it mandatory to mention the best way to perform the invention in the complete specification of the patent draft, such trade secrets can harm the objectives of the patent law. However, these questions have been rendered mooted in view of the preservation of the commercial ethics. The business strategy is more likely to be affected if every disclosure is made, but the necessary disclosure to fulfill the patentability conditions is mandatory.⁷¹

Additionally, in the period before the innovator settles on the choice to patent, courts tend to see the two administrations as supplementing each other, a view offer impact to by an eagerness to perceive that most pre-patenting application of confidentiality ought not risk patenting. In the light of this part, it is hard to perceive how any standards of patent pre-emption could be made workable. Without a doubt, global intellectual property commitments now could be said to oblige states to perceive parallel ways for confidentiality and licenses.

⁷¹Neil Wilkof&ShamnadBasheer, *Overlapping Intellectual Property Rights*, Oxford University Press, 2012.

Chapter 7: Practical aspects of Overlapping vis-à-vis enforcement of overlapping IP rights

7.1 Introduction

The overlapping of IPR is not left in modern time only about the accidental incidents happening without the knowledge of the IPR holder and due to the really occurring weak boundaries of IP rights that make the various rights implied to overlap. Against the above notion, the IP overlap is now a concept to have maximum profits and rights for the maximum time in favor of the right holder due to its once known IP in the public. As understood well by previous chapters, the different IP rights have grown so widely that they have started coinciding each other in scope and this is a consequence of technology revolution and advancement in the field of science and technology happening consistently rampantly at constant rate in different markets.

To say, mobile phone technology has shown a tremendous advancement in technology, the transformation is just in 8-10 years of time having taken the world to a totally different sphere of research and development. It is true that IPR is an exotic subject which blends the technical knowledge for its best utilization. The Courts are also faced with too many difficult situations where for the enforcement of IP rights the identification of IP rights valid at that point of time and most appropriate for suitable operations became important. Undisputedly emergence of multiple IP rights from a single IP is beneficial for the right owner who is enjoying the input worth of one IP against the multiple benefits imputing from that one IP. However, it is totally against the society having public interest on that IP and the liabilities associated with that IP at the earliest end of the IP. All this is subject of crucial scrutiny because of the different terms of each IP giving short and big life tenure to the IP as per its identification, for example, the design copied from one place and used as an artistic work can be defended to be used as a fair use however, the design copied and used as design would violate the copyright on the design law as it is difficult to prove the fair use under the design law. Similarly, the situation would be complex if the same design is further used as a trademark. Hence, all such complexities might shake the pillars of the IPR law but the Courts have reached to

better conclusions in sight of the modern approach to deal with modern techno-legal issues.

An corporate body that duplicates another's design, for example, cannot be sure that it is on safe ground on the off chance that it guarantees that it fulfills copyright law's reasonable utilize resistance if the article is likewise ensured by design patent law, which contains no reasonable utilize barrier. In the event that the design additionally works as an organization trademark, promote inconveniences are increased given that reasonable use have application under the Lanham Act exists just in a predetermined number of restricted (and challenged) statutory arrangements, supplemented by dubious First Amendment-related tenets that have created in the Courts.⁷²

The diverse terms for every law additionally raise worries about utilization of the topic once the protections of a specific law lapse. For example, the term of the design patent in the United States is as of now fourteen years. Once that term lapses, design patent principle presumes that anybody is allowed to make the design that was the topic of the design patent. On the off chance that that design is too ensured in terms of professional career dress, be that as it may, and the design is still being used by the element asserting trademark rights in it, the utilization of the design by a contender may be charged to be trademark violation.

It is consequently that a few jurists have recommended that patented innovation proprietors be required to choose among laws at the beginning or, relatedly, to be held to the necessities of the law whose assurances lapse first. On account of a design patent, where either copyright law or trademark law would likewise apply, those rights would lapse in the meantime as the close of the design patent rights, as the design patent conveys the most limited term. This proposition introduces a few intricacies. Initial, a doctrine of election is probably not going to be actualized by the same legal framework that took an interest in the development of patented innovation laws examined previously. Moreover, a decide that held that patented innovation protections in overlap circumstances keep going just the length of the most limited term experiences a

⁷² William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267 (2010).

comparable absence of establishing in the doctrine and does nothing to take care of the overlap issue amid that term.

Additionally, it is far-fetched that supporters of such a proposition would require an organization that deserted business utilization of a novel design to surrender its design patent rights since it could no longer state trademark rights.

Keeping in mind the end goal to clarify why remedies centered approach is the favored arrangement, I start with a review of legal responses to overlapping patented innovation laws. As the following Sub parts will appear, Courts take changed perspectives on the fittingness of the overlap, contingent upon whether the issue is the presence of the privilege in the primary case or the attestation of the privilege in a later encroachment suit .

7.2 Court's view on establishment of overlapping regime

Not surprisingly, earlier in the Courts of the USA and UK the dispute occurred on the common points of overlapping which are the mostly overlapping elements, design and copyright, copyright and trademark, and trademark and design. At such point of time, the Courts were not specialized enough to understand the concepts and they weighed their decisions either allowing the right holder to choose one right out of the multiple right, this is called as preferred right or the early registration scheme. Mostly, the rights and issues that were dispute is due to the following:

- a. The right holder knowingly attempts to register another right when one right is already existing; or
- b. Questioning the already registered right as not accurately registered, and hence invalid.

In other words, prior decision held that the proprietor of subject matter that could qualify either for a design patent or for copyright protection must choose one law at the season of registration. In each of these cases, the overlap address emerged either as the consequence of an endeavor to enlist rights when one arrangement of rights had as of

now been enrolled or as the aftereffect of an endeavor to challenge the securing of rights as shameful given the subject matter.

In case of *In Louis De Jonge and Co. v. Breuker and Kessler Co*⁷³, a 1910 circuit Court case, the litigant endeavored to shield against copyright infringement of the offended party's work of art of holly, mistletoe, and spruce organized in a square by belligerence that the depiction was made and proposed for use on wrapping paper thus ought to have been constrained to protection under design patent law. The Court dismisses this contention, taking note of that, post-Bleistein, the design met all requirements for copyright assurance thus "couldn't be unquestionably allocated for the present reason either to the fine or to the valuable expressions, until the creator or the proprietor chose under which statute he would ensure his property." But, the Court forewarned, "it couldn't enter both," since "the strategy for technique, the term of security, and the punishments for infringement, are different to the point that the creator or proprietor of a depiction that is qualified for both classes must choose to which locale of scholarly exertion the work is to be relegated, and he should submit to the choice." The topic of election, in any case, was not straightforwardly displayed for the situation (thus the Court's remarks were dicta), as the case included just "whether an artwork having masterful legitimacy, however appropriate additionally for use as a design, may at the proprietor's election be ensured either by copyright or by patent."

In 1927 case it was held correspondingly, as it certified the Patent Office's refusal of a design patent enlistment for the state of a ticket in light of the candidate's current trademark registration of a similar design, with content, as a mark for its goods. "The design is not qualified for twofold enlistment, once as a name design, and again as a design for a hosiery ticket," held the Court.

Such a course would come about for all viable purposes in an augmentation of the design imposing business model. The candidate was qualified for apply for a patent for the design as a hosiery name, or he may finish the name, and enroll the design, so finished, as

⁷³ 182 F. 150, 151 (C.C.E.D. Pa. 191

a name. He couldn't do both. He chose to seek after the last course, and has acquired the security accordingly guaranteed to him, and he is bound by that decision.

By the mid-twentieth century, in any case, the perspective of the Courts on simultaneous rights changed. In *Mazer v. Stein*⁷⁴, a 1954 Supreme Court conclusion, the offended party had secured a copyright in statuettes that it proposed to mass deliver as light bases. The respondents, who had replicated the statuettes without approval for their own particular lights, shielded against a copyright encroachment suit, as the litigant did in *De Jonge*, by affirming that the offended party's "distribution as a light and registration as a statue to pick up a restraining infrastructure in make" constituted an abuse of copyright law and that the offended party ought to rather be constrained to a design patent. The Court, having held that the statuettes were copyrightable, declined to evaluate whether the statuettes could likewise be ensured by a design patent. Be that as it may, regardless of the possibility that they could, the Court held, this did not render the offended party's utilization of copyright law ill-conceived: "the patentability of the statuettes, fitted as lights or unfitted, does not bar copyright as masterpieces. Neither the Copyright Statute nor some other says that in light of the fact that a thing is patentable it may not be copyrighted. We ought not all that hold." The Court additionally held that this rule connected whether the copyright registration occurred before or after the work was typified in the valuable article; such enlistment did not, the Court affirmed, constitute copyright abuse.

Since the *Mazer* Court did not need to choose whether the statuettes were additionally secured by design patent, it didn't achieve the topic of overlapping laws. Resulting cases in the lower Courts, in any case, dismisses the contention that a protected innovation proprietor, having benefited itself of one law, ought to be banned from securing rights under another law.

In *re Yardley*⁷⁵, a 1974 case from the Court of Customs and Patent Claims, the Court at the end of the day tended to the doctrinal overlap address, this time as to design patent

⁷⁴347 U.S. 201, 202 (1954).

⁷⁵ 493 F.2d 1389 (C.C.P.A. 1974)

and copyright. The candidate looked for a design patent for the elaborate design for a watch confront (including a cartoon of Spiro Agnew in which the arms and hands filled in as the hands of the watch). The inspector dismisses the claim both on conspicuousness grounds and on estoppel grounds, given three existing copyright enlistments for a similar design, and that dismissal was confirmed by the Patent Office Board of Appeals. On request, the Court held that the current copyright enrollments ought not to themselves be a bar to acquiring design patent protection. To begin with, the Court noted, Congress more likely than not proposed there to be an overlap between statutory topic in copyright and statutory topic in design patent on the grounds that the statutory arrangements as to qualified topic facially conceded to such overlap. Second, the Court closed, requiring race between the two precepts would in this manner be "in direct clash with the reasonable purpose of Congress showed in the two statutory arrangements," since Congress did not demonstrate a need to choose between the two tenets in instances of overlapping qualification.

Such cases drove the Seventh Circuit as it would like to think in *Kohler Co. v Moen, Inc.*⁷⁶, to presume that Courts had by and large held that "*an item's extraordinary qualities can be ensured at the same time, or progressively, by more than one of the statutory means for security of patent innovation.*" The case included cases to both trademark rights and design patent rights over spigot and fixture handle designs. Kohler, the litigant, fought that trademark rights in item setups were impermissible in light of the fact that patent innovation rights in mechanical design ought to be the sole space of design patents; to accord trademark rights in arrangements, Kohler contended, would impermissibly amplify the patent term. The Seventh Circuit dismisses that contention, noticing that since "trademark security is needy just on open response to the trademark in the commercial center as opposed to exclusively on the likeness of the designs," the two laws were theoretically and lawfully particular. Put generally, "a design patent gives the patentee a for all intents and purposes total imposing business model in the design, while a trademark permits focused employments of an ensured design inasmuch as such uses don't make purchaser perplexity." The Court held that Kohler was "allowed to duplicate

⁷⁶ 12 F.3d 632, 638 (7th Cir. 1993)

Moen's design insofar as it guarantees that people in general is not in this way cheated or befuddled into trusting that its duplicate is a Moen fixture." Notably, as it was responding just to the contention that obtaining of overlapping rights were not permissible, the Court was not have to achieve the subject of authorization—at the end of the day, regardless of whether the minor replicating of Moen's spigot would be adequate reason for inferring that the general population would be "confounded into trusting that [Kohler's] duplicate is a Moen fixture."

The Courts have settled the dispute of the overlapping of the design, copyright and trademark with one view approach. The approach is such that once the design right has been expired after its term, and if it has gained the secondary meaning in the eyes of the consumer, it is eligible for trademark protection as well. However, as originality and novelty is the paramount requirements of the design law, the vice-versa is barred. Any brand or logo used as a trademark once revealed cannot be claimed to have a copyright on the design due to the originality and novelty requirement already been hampered by such use.⁷⁷ The notion between the design and the copyright has to be decided at the outset of its use. It cannot be given rights once it is elected. In Indian copyright act, 1957 the section 15 of the act provides for the publication of 50 copies of the copyright work for design, anything surplus to the provided number would amount to nullification of the copyright and the design right over that design. Hence, the use of the copyright, design and trademark is made available for multiplication rights as well but with due care and caution that are provided above. It is essential that the eligibility criteria of each IP shall be pre-conceived before preferring for selective IP.

7.3 Suggestion to reduce overlapping problems

Analyzing the judgment *J.H. Desnick, M.D. v. American Broadcasting Companies, Inc. Desnick*⁷⁸, the US Federal Court provided following solutions to the problem of overlapping after deep observations on the issue of overlapping one rights by others. In this particular case included an ophthalmic facility and two of its specialists who brought

⁷⁷Brite Strike Technologies Inc V Brite Strike Technologies Sa, [2016] I.L.Pr. 37

⁷⁸ 44 F.3d 1345 (7th Cir. 1995)

suit against a broadcasting company and others over a overlap report that asserted that the center performed pointless waterfall surgery on its patients. The offended parties brought suit principally for maligning, in view of the substance of the communicate, and for trespass, in light of the fact that the offended parties could never have allowed authorization to the overlap journalists (who were acting like patients) had their actual thought processes been known. After holding that the lower Court disgracefully expelled the slander assert, the Seventh Circuit held that, by difference, the trespass case was appropriately rejected. The mischief professedly endured by the offended parties—a reputational hurt in view of the allegations in the communication—was a maligning sort hurt. That damage may have been encouraged by the section onto the offended party's property, however the offended parties were not genuinely whining around harm to the sacredness of their territory proprietorship. (We can expect that the offended parties would not have whined if the transmission had been great, despite the fact that such a communication would have come about because of the same unapproved entrance onto the offended parties' property.) Put generally, in the Seventh Circuit's words, "[t]here was no intrusion in the present instance of any of the particular interests that the tort of trespass looks to secure." The upshot of these cases, then, is not a conclusion that the offended party has no passionate pain, obstruction with business relations, or trespass rights to state at all; somewhat, it is an assurance that the way of the damage declared in the current cases did not adjust to those interests.

This case law recommends that one answer for the overlap issue in patent innovation law, including overlaps including design patents, is not to require the rights holder to choose one type of protection at the start yet rather to urge Courts to be mindful to end-keeps running by adjusting solutions for the way of the mischief caused. How then May Courts approach figuring out if the offended party is taking part in an end-run? The cases offer a few recommendations. To start with, Courts may endeavor to divine the way of the damage that the offended party tries to cure, to some extent by considering the course of direct or case history. Ina case like the Omega case, in which the Court's thought of Omega's course of lead drove it to the conclusion that Omega had brought an impermissible trademark encroachment suit wearing copyright encroachment dress.

Second, Courts may take a gander at the connection between the privilege attested and the cure looked for. For instance, if the offended party is bringing suit for encroachment of trademark where a design patent exists or has terminated, a Court ought to evaluate the suitability of restricted injunctive help, for example, a disclaimer or mark, before considering more extensive, patent-like cures, for example, a directive against circulation.

For instance, consider the question in *Kohler Co. v. Moen, Inc.*,⁷⁹ specified prior. Kohler and Moen are rivals in the field of fixtures and spigot handles. Moen effectively got trade dress enrollment for the state of some of its spigots, in view of what the Court described as "considerable confirmation" that buyers perceived the fixtures as Moen fixtures because of their particular shape alone, with no extra markings. Kohler tested the enlistment on the grounds, *bury alia*, that an item shape ought not have the capacity to be enrolled as trade dress under the Lanham Act in light of the fact that the conceivably boundless term of trade dress protection would specifically struggle with the constrained term granted to setups under law of design patent, which was, in Kohler's view, the correct defensive administration for this situation. The Seventh Circuit dismisses this contention, holding that trademark law and design patent law were coordinated toward various closures and required diverse proof with a specific end goal to exploit the rights gave. As needs be, the Court finished up, "Kohler is allowed to duplicate Moen's design inasmuch as it protects that the general population is not along these lines deluded or befuddled into trusting that its duplicate is a Moen faucet." Assume that Moen had acquired a design patent for the decorative parts of its spigot; accept advance that the patent had terminated, and that Kohler then needed to duplicate the design. One sober minded protest to the Court's announcement should be that Moen likely contend that the unimportant replicating of the design is probably going to confound customers into trusting that the Kohler fixture is a Moen spigot, given the uniqueness that the Moen fixture procured amid the design patent tenure. Additionally, the contention would proceed with, the way that the Kohler spigot would be sold in bundling unmistakably showing the wellspring of the fixture would not be adequate to cure any post-deal disarray emerging once the fixtures were introduced. (For sure, the post-deal perplexity

⁷⁹ *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 633 (7th Cir. 1993)

principle muddles things significantly, and Courts would be all around encouraged to reevaluate its extension, if not its viability.) Here, in this way, is the place it would be officeholder on Courts to align cures especially deliberately. Kohler might be free, upon the termination of the design patent, to duplicate the some time ago patent design, and any demand by Moen for a directive to stop offers of the design ought to be denied.

Be that as it may, Kellogg and comparable cases propose that Kohler has a positive commitment to find a way to limit disarray. In the event that a probability of perplexity is appeared, Kohler require not, after TrafFix, change or hide the design somehow, yet maybe it may be coordinated to add a little checking straightforwardly to the fixture that shows that the spigot is a Kohler fixture and not a Moen spigot. This is by all accounts a proper approach to adjust Kohler's entitlement to contend in the market for alluring fixture designs with the buyer's enthusiasm for having precise data with regards to the producer of such designs.

Undoubtedly, there are managerial costs required in this approach. It is speedier and less costly to require patent innovation proprietors to choose just a single type of protection at the front end. Yet, executing such a proposition would require a noteworthy redesign and high investment of patent innovation law in any jurisdiction. Being more mindful to the association among rights, damages, and cures is what that the Courts are all around prepared and—as the cases in the previous section recommends—even slanted to do. It advises us that arbitration is, at its center, about giving fitting solutions for lawfully cognizable mischief. So as to achieve that objective viably, Courts ought not to view themselves as to be restricted by the marks offended parties apply to their cases. Or maybe, Courts ought to consider the basic way of the mischief affirmed at exactly that point would they be able to recognize the cure best intended to improve that damage.

Chapter 8: Conclusion

This research aimed to identify major elements of branches of IPRs which are usually found either restricting or enhancing the scope of IP protection due to its overlapping features. Another aspect to this research supplements the identification of the issues and branches of IPRs which are potentially carrying overlapping issues but yet not disputed before the Court of law and could be expected to adverse this field in near future. Plus to this, a research on exhaustive study of cases and situations where IP overlapping is recognized by a Court of Law at developed and developing nations and analyzing the reasoning relied by the Courts for solving the dispute by limiting the scope of respected IPs is to be researched to identify the prospective jurisprudential tools to solving such difficult issues in future.

The problem of overlapping of Intellectual Property Rights as portrayed throughout the research is negatively centered favoring only the inventor or the owner of the intellectual property and against the societal bargain. This is also true if someone analyses the core objectives of the intellectual property system which is said to have given equal sharing or bestowing something back to the society for use without any monopoly. This is the reason that none of the intellectual property stream is blessed with perpetuity, every IP law has an end may be later, sooner or on renewal basis. Every IP if sought for registration has to go through the scrutiny system adopted by various laws. The major segment of the IPR which is analyzed to be a part of overlapping evil is among the copyright, trademark and design laws. it would not be correct to say that the patents are away from overlapping but practically the patent law has much more well defined boundaries and well nourished system than other related IP streams. The reason for least chances of overlapping of the patent law is due to the highly nourished International conventions defining the standards, mandates and objectives of the law and even the domestic law has been drafted with changes accordingly with time and advancement in the society. Not only this, the patent law has a set of inventions strictly barred from invention as per the subject matter which cannot be the part of patenting in anyways and what could be the part of patenting has very high demands of eligibility and examination before the successful grant. Moreover, the grant is always at stake to be revoked, if gaps

or defaults are found in the granted patent. Hence, the inventors do not generally try more than the patenting the invention because of the chances of the patent getting revoked due to failure which would end up losing the patent.

It is well analyzed throughout the research that there is lot of complexities in the area of overlapping of design, trademark, trade dress and the copyright due to which even the law-makers and the interpreters of the law have been inconsistent at one stand. The case laws prove that the Courts of the UK, US and India have not totally favored the overlapping provision and instances but have given uncertainty to these emerging disputes. The copyright and trademark are at highly risky stake due to rampant trends coming up in the industry of creativity whereby the characters, slogans, and other artistic and creative work would be in dispute for copyright and trademark protection and its overlapping. The industrialists would try at best to acquire both the creative rights and the commercial right over one work so to enjoy all kinds of monopoly and filling up all gaps and holes which would not allow any kind of public interest to flow out from their monopolistic strength. Notwithstanding this commonly attempted practice, the Courts and the legislatures shall very soon come up with a bright line between both the IP regimes, especially for copyright and trademark that distributes the interest of the creator, author, public and the industrialist and thus there shall no deprivation of rights and privileges from the end of the society.

The research is mapped to build a differentiating line among the rights granted by each branch of IPR. Every element included and excluded which is subject of the exclusive protection of each branch is to be read comprehensively and in comparison with other subjects of Intellectual Property.

The judicial pronouncements were subjected to thorough examination with respect to the current trends, background intentions of the legislations and expected enforcement of rights, which will make the status of various streams of IPR apparent for future references.

The entanglement of various IPR in each other due to common terminology, common application of expressions/inventions/articles/products in more than one IP, open scope of

various IPRs to name a few, is determined by researching on each IP separately with an analytical and comparative mindset against the scope of IP which egresses out of its defined framework.

The current situation on overlapping of patent and designs do not have explicit prohibition on co-existence of both together provided, the eligibility requirements of both the IPRs are duly filled. It is important while dealing with the design rights and trademark rights to have an adequate strategy if looking upon for overlapping defense of the brand or the design mark. The design once used could be allowed trademark protection if the design mark is capable to have a secondary meaning but the vice versa may not be true as the condition is still uncertain and there is no bright line between both the laws. The identification of distinction between copyright and trademark protection is a complex process; this is because of expansion of these fields relating to legal rights. The copyright protection has developed and prevailing in the brand name or character merchandising. In UK the courts have aspired to develop a course that reduces the holding of any double layer of guarding by determining the main duties of law. US have adopted similar methods but equable by increasing surveillance of trademark requirement that will infringe the works that are no longer guarded by copyright.

It is clearly dug that the overlapping rights shall be stopped at its inception or should have high control on its application. There has to be a bright line marking difference between the trademark law and copyright law and wherever the lining is not possible, the overlapping should subject to high scrutiny, judicial control and legislative intent both at ex-ante and ex-post. As we are moving towards the period where the copyright expiry would be at high and as a result the trademarks will be claimed on those expired copyright. It is essential for the judicial system, legislature and the international policy makers to initiate discussions on this mutant copyright by trademark registration to have protection for the society against the vigorous trademark owners who would seek trademark rights post-expiry of the copyright.

The overlapping of the trade secret and patents is not too much in the Courts and also the overlap of trade secret and patents do not appear to be barred by law as one is protected

by special worldwide known patent law and other has stumbling existence as codified law. Also, not many writers, academics and jurists have successfully drawn any line margining the overlapping of both of these regimes. The issue of overlapping of patents and trade secret is one of the rarest occurring issues which is not even faced much by the Courts. On the contrary, it is generally a strategy of the inventor by which he prefers the technology or other inventions/creativity to maintain a trade secret and afterwards disclose the knowledge as patent disclosure. Additionally, in the period before the innovator settles on the choice to patent, courts tend to see the two administrations as supplementing each other, a view offer impact to by an eagerness to perceive that most pre-patenting application of confidentiality ought not risk patenting. In the light of this part, it is hard to perceive how any standards of patent pre-emption could be made workable. Without a doubt, global intellectual property commitments now could be said to oblige states to perceive parallel ways for confidentiality and licenses.

Recommendation

The research is initiated on a basis that every law embodied in the legislation by the Parliament is with an identified set of objectives for governing the rights and liabilities erupting out of the subject matter of the law. However due to paucity of time and resources the project could not dig out the current situation on overlapping in the other developed and developing nations. The picture would have been avidly clear after analyzing the IPR regimes and overlapping situation along with the tools enforced to deal with such situations in the other developed and developing nations, e.g. China, Japan, Australia to name a few. I would recommend through my research to have interference of judiciary, experts, academicians, think-tanks and the legislature in drafting and amending some of the parts of Indian statutes which dilutes the line between the IPR laws and further give way to overlapping.

Similar shall be the case with all the IP laws enacted and amended several times to bring clarity in the legislature view capable of dealing with modern issues. Whether it's copyright law, trademark law, patent law or design law, all these laws protect rights

which are not to be skinned over other IP law but are subject to single means of law enforcement.

All that is required and expected from the society and the judiciary is to form a legal and tangible boundary preventing each IP within its ambit and not bringing interdisciplinary ways of extending legal enforcement of rights to an IP owner when he has already exhausted the rightly ~~preferred~~ granted source of protection under IP Laws.

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