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E-JAIRIPA



**Hon'ble Justice
Mrs. Mridula Mishra
Vice Chancellor, CNLU**

It is a matter of immense pleasure and pride that the CIRF in IPHD of Chanakya National Law University is going to release the Vol. III issue 02 (July-December 2022) of E-JAIRIPA (E- Journal of Academic Innovation and Research in Intellectual Property Assets) on 6th of May 2023. It is also a subject of great pleasure that the journal is being released on the first anniversary of the Centre for Innovation Research and Facilitation in Intellectual Property for Humanity and Development (CIRF in IPHD).

The pandemic 2020 has been a period of unrest in all walks of life, especially in academics too. Thanks to Information Technology that supplemented the class room teaching and sitting in the Physical library to online teaching and access to Online learning material, books, journals, magazine, newsletters etc. The significance of

Online publication has been understood and the universities have been converting their hard copy into soft copy for the worldwide access and benefits. This e- journal (E-JAIRIPA) is an effort by CIRF to contribute to the academic world in the domain of Intellectual Property Research. Intellectual Property is a creation of human mind. The Patents Law deals with the invention and innovation. It is a tool for Industrial Development furthering industrialization, employment, and economic development. Patents Law has become the backbone of the Economy of any country. The Pharmaceutical Patents helps in health care along with continuous research for human development. Patents is granted to the inventors and protects the invention from infringement by any person. It is a guaranteed safeguard to the invention and economic gain. The patentee avails this right for twenty years (As per TRIPS), thereafter it enters into public domain, which is open to use by anyone without payment of royalty or permission. The trademarks are an essential Intellectual property for business propagation and safety to consumers. The information technology, semi-conductor integrated circuits lay out design (chips) are essential tools used in our daily life. The Community intellectual property (GI, Biodiversity, Biotechnology, Plant Variety, and farmer's rights) are the part and parcel of intellectual Assets. This online journal will encourage the researchers, academicians, students to do fundamental research and this journal will disseminate the ideas and understanding world- wide.

HON'BLE JUSTICE (RETD.) MRS MRIDULA MISHRA

VICE CHANCELLOR, CNLU

REGISTRAR'S MESSAGE

E-JAIRIPA



**Shri MP
Srivastava
Dist. Judge (Retd)
&
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The Journal is a forum for the scrutiny, examination and discussion of academic research. It is an examination as to what is happening in academics. The journals carry scholarly research papers which are peer reviewed before publication. This is the examination by the unknown experts in that discipline. Hence the knowledge of authors are examined, analyzed, debated and disseminated. This helps in learning and further improves the knowledge of the trainer. It results in the refined understanding of the students and academicians.

The journal E-JAIRIPA has been published and released keeping its importance in academics. This will surely encourage the students, authors, teachers in the field PR to write on certain issues and try to find solution. Since the papers has to be peer reviewed, it will be a guide line as to how to write scholarly papers. Most importantly, when the journal is online (E-Journal), it has easy access to all the people on this globe. Hence merits and demerits of articles cannot be concealed. In the paperless world, the e-journal is a need.

I appreciate the efforts of the CIRF team in bringing first issue of E-JAIRIPA to the public for learning and examining the quality of the writings. The reader's corner will be a feedback for the improvement in its quality. Since this is a first issue, the team will learn its strength and weakness which shall be certainly reflected in improvement with successive volumes and issues. Wishing the CIRF team all the Best for all success of the Journal.

SHRI M.P. SRIVASTAVA

DIST. JUDGE (RETD.) & REGISTRAR, CNLU

PREFACE



Prof. Dr. Subhash

Chandra Roy,

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E-JAIRIPA (E-Journal of Academic Innovation and Research in Intellectual Property Assets) is a Peer Reviewed E-Journal of the Centre for Innovation Research and Facilitation in Intellectual Property for Humanity and Development (CIRF –in-IPHD) of Chanakya National Law University the JAIRIPA is a half yearly journal of Academic Innovation and Research on the issues related to copyright, Patents, Trade Marks, Geographical Indications, Plant Varieties and Farmer’s Rights, Bio Diversity, Layout design and integrated circuits, Industrial Design, Traditional Knowledge, on current Academic issues. It is a half-yearly e- Journal, Vol. III, Issue 02 (July-Dec, 2022). This E-Journal shall have open access to all the concern world-wide for Common Good. The ISSN will be obtained later as per Rule.

Research is the backbone of academics. The journals are the conveyances on which the research papers are carried on from the authors to the readers, the reaction of reader’s to authors’ vice-versa. The journals expedite the process of thesis –antithesis and synthesis. The research scholars’ survey the problems in the area of their disciplines and think over the gap. Hence the contribution made by the author-researcher helps to the teaching community, research scholars and policymakers. It helps the book authors, either it be student edition or reference. It is the journal that keeps the teachers updated and well informed. The class teaching is monotonous without current and relevant issues as it correlates the academics with real world. The Journals are Supplementary and complementary to academics, a bridge between society and academicians for the benefit of students and researchers. This cycle goes on with observation, scrutiny, comments, analysis, updating the existing knowledge and filling the gap. The regular readers of the journals are well informed, advanced and confident. They learn the style of writing and way of expression. The journal carries variety of opinion, ideas, information that help in the correction of concept and revealing the truth. This is the reason that research writing and publication is essential component for the Academic positions. The paper writing is a proof that the person has academic bent of mind. It is a proof that one is growing. This E-Journal has been launched and released for the benefit of all the stake holders without making any discrimination on the basis of caste, creed, race, color, class, gender and political boundary, etc. This journal has open access to all concern. This issue of JAIRIPA carries twenty research papers contributed by researchers from different parts of India. All the papers have been peer reviewed, and similarities checked. The editors and reviewers have tried their best to allow the best possible papers before the readers. The comments, criticism, and advice of the readers are most welcome for further improvement. Hence this half-yearly E-Journal (JAIRIPA) is hereby submitted with all humility before the readers.

PROF DR. SUBHASH C. ROY

CHIEF EDITOR: E-JAIRIPA

DIRECTOR: CIRF in IPHD (CNLU)

E-JAIRIPA

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Objectivity of Doctrine of Originality: Are Tweets Copyrightable

Ms. Baishali Jain and Prof. Dr. S.C. Roy¹

ABSTRACT

The competing claims of copyright owners and copyright users are one of the major components of the balance drawn by copyright law. The question of originality, the threshold standard of qualification for copyright protection, is at the core of copyright. Twitter is part of the new wave of internet communication. It is unique because messages sent via Twitter are limited to 140 characters. Many of these messages are about mundane details of daily life, but some are creative, even literary, and may qualify for copyright protection. The problem, then, is necessarily whether a Tweet can qualify for copyright protection. Thus with the aim to resolve the grey area as to whether Tweets fulfill the originality standard, the project will discuss the Doctrine of originality: Its backdrop and the evolving journey with emphasis to the Internet era. Further, the new challenge imposed upon the originality is- Is there any standard fixed for testing the originality or it differs from case to case. The standard to test the originality will be discussed in the light of Twitter, as to whether the Tweets fall under the originality criteria or is attacked by the de minimus rule. Twitter tweet is one such issue which has raised the objectivity of originality. The originality bottom line has been drawn way back; today it needs to be refined in terms of technological change. This article first recounts the origin and development of the originality standard by exploring through various jurisdictions. It then analyzes the character of tweets through the legal lens of subject matter of copyright. Finally, the article attempts to evaluate whether tweets fall under the category of copyrightability.

Keywords: Copyright, Originality, Unauthorized user, Infringement, Tweet.

INTRODUCTION

Intellectual property law can be considered as the most rapidly evolving body of law in existence today and excluding the law of patents, the law of copyrights can be considered the fastest evolving branch of it. While 60 years ago it was advocating towards the protection of literary, dramatic, musical and artistic works (authorial works), today it has expanded its reach towards films, broadcasts, published editions, computer programmers and etc. It will continue to evolve as long as human beings continue to create and should evolve for the sake of creativity itself. However, it can be observed that the most important requirement of copyright protection,

¹ Assistant Professor, Lovely Professional University, Punjab & Dean, Research & Development, Chanakya National Law University, Patna. (resp.)

the one which many commentators like to refer to as the sine qua non of copyright protection haven't done so. The requirement of originality is inseparable from copyright protection, which the world agrees but they cannot agree on the threshold on which it should be judged.

Protection of Intellectual property plays a very crucial role in shaping the human society due to increasing awareness/ knowledge about their rights tangible and intangible. The law of copyrights is one of the oldest component of intellectual property law and grants umbrella protection to “expressions of ideas” (Idea-Expression dichotomy), created by authors. It encompasses a vast economic and cultural field extending to arts, education, information, entertainment, broadcasting and the media.² Unlike with regard to other intellectual property law rights such as patents and trademarks, under copyright law, protection arises automatically upon the creation of the work (in jurisdictions with an unregistered copyright regime).³

The underlying rationale of obtaining the property right of copyright is to protect the author's investment in the production of the work against unfair competition and especially against a competitor's free ride and his parasitical undercutting of the author's expenses by unauthorized copying.⁴ Breyer expands on this notion and gives four justifications defending the monopoly granted through copyright; namely

- a. A natural right to property in one's work, allowing authors to control the use of, and treatment given to their work;
- b. To reward for investment in creation and publication;
- c. To stimulate creativity which is socially, as well as personally beneficial;
- d. To disseminate ideas in the public interest.⁵

Different jurisdictions have different criteria requirements to be fulfilled for the work to fall under the subject matter of copyright. But there stands one requirement which is common in all jurisdictions that is the requirement of “originality”. Many commentators refer to it as the sine qua non of Copyright.⁶ However, the requirement is common to all jurisdictions, but the threshold of the requirement (originality) is not similar. Different approaches have been laid

² Catherine Colston, *Modern Intellectual Property Law* (3rd ed. Cavendish Pub, New York, 2010)

³ Bently Lionel, *Brad Intellectual Property Law*, 4th ed. Oxford Univ. Press, United Kingdom, 2014)

⁴ Rahmatian Andreas, *Originality In UK Copyright Law: The Old Skill And Labour Doctrine Under Pressure* IRIPCL (2013)

⁵ Stephen Breyer, *The Uneasy Case For Copyright: A Study of Copyright In Books, Photographs And Computer Programs* 84 *Harvard Law Review* 281 (1970)

⁶ *Kamar Int. Inc vs. Russ Berrie & Co.*, 657 F. 2d 1059, 1061 (9th Cir. 1981)

down by various courts. However, it needs to be declared that the requirement applies generally to literary, dramatic, musical and artistic works (works of authorship).

With the advancement of technology, we welcomed the wave of Social Networking Sites (SNS) connected with the Internet. A social networking site is a web-based service where a user can create a profile and build a personal network that connects him or she to other users.⁷ Six Degrees.com was the first SNS followed by My Space, Facebook, Twitter, and LinkedIn and so on. No doubt these SNS connected the global world but at that the same time posed threat upon the exclusive rights of the content holder because of its inherent feature i.e. “sharing on click” The growth of the internet and social networking sites has given rise to new legal precedent.⁸

DOCTRINE OF ORIGINALITY: Sine Qua Non of a Copyright

Originality as a requisite for copyright protection has been statutorily acknowledged in all of the jurisdictions. Creative works were only awarded protection. Section 1(1)(a) of the Copyright, Designs and Patents Act 1988 of the United Kingdom, states that “Copyright is a property right which subsists in, original literary, dramatic or musical works”⁹, Section 14 (1) of the Copyright Act 1994 of New Zealand states that Copyright is a property right that exists in original works Of literary, dramatic, musical, or artistic works; sound recordings, films, communication works and typographical arrangements”¹⁰, Section 102(a) of the Copyright Act of 1976 of the United States provides that “Copyright protection subsists, in accordance with this title, in original works of authorship”.¹¹ Therefore, legislations have statutorily imposed the requirement of originality for a protectable work.

In the case of University of London v University Tutorial Press (1916)¹² Peterson J stated;

“The word ‘original’ does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Act is not concerned with the originality of ideas, but with the original expression of thought ... But the Act does not require that the

⁷ Danah M. Boyd & Nicole B. Ellison, Social Network Sites. Definition, History, and Scholarship, 13 J. COMPUTER-MEDIATED COMM. 1 (Oct. 2007), <http://jcmc.indiana.edu/vol13/issue/boyd.ellison.html> (defining social network sites as web-based services that allow individuals to “(1) construct a public or semi-public profile within a bound system, (2) articulate a list of other users with whom they share a connection, and (3) View and traverse their list of connections and those made by others within the system”).

⁸ Cooper Seth, My States: Balancing Liberty and Safety in Social NetwOrking INSIDE ALEC, (2008).

⁹ Copyright designs an patents act 9 (Sec. 1(1)(a)) (UK)

¹⁰ Government, New Zealand “Copyright act 1994 (sec. 14)

¹¹ Copyright act 1976 SEC. 102(a)

¹² University of London vs. University Tutorial press (1916)2 Ch 601

expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author.”

Originality test is one such test which has been imposed way back in 1839 in Gray vs. Russell case.¹³ In this case Justice Story held:

“There is no foundation in law for the argument, that because the same sources of information are open to all persons, and by the exercise of their own industry and talents and skill, they could, from all these sources, have produced a similar work, one party may at second hand, without any exercise of industry, talents, or skill, borrow from another all the materials, which have been accumulated and combined together by him. Take the case of a map of a county, or of a state, or an empire; it is plain, that in proportion to the accuracy of every such map, must be its similarity to, or even its identity with, every other. Now, suppose a person has bestowed his time and skill and attention, and made a large series of topographical surveys in order to perfect such a map, and has thereby produced one far excelling every existing map of the same sort. It is clear, that notwithstanding this production, he cannot surpass the right of any other person to use the same means by similar surveys and labors to accomplish the same end. But it is just as clear, that he has no right, without any such surveys and labors, to sit down and copy the whole of the map already produced by the skill and labors of the first party”.

QUANTUM OF ORIGINALITY IN COPYRIGHT

An exploration into the justifications for originality illustrates that the purpose originality serves in copyright depends on the eyes from which the observer wishes to see it. From a natural rights perspective, originality, at least in theory, ought to protect the personality of the authors as expressed in their works.¹⁴ As a result works that do not reflect the author’s personality (e.g. Works of labour or investment, objective features of works) will not warrant protection.¹⁵ However if seen from a reward perspective, where a certain effort has been made in creating a work, the creator may be said to deserve some protection which seems to be a justification which encompasses individuals who exercise labour to gain protection as well.¹⁶

Looking at the purpose of originality from a utilitarian perspective, originality can be customary to sit at a higher level to protect works for the incentives provided by copyright.¹⁷ This view will protect works of investment but may not protect trivial or insubstantial works.

¹³ 10 F. Cas. 1035 (G.C.D. Mass. 1839) N0. 5728

¹⁴ Bently, Lionel and Sherman, Brad Intellectual Property Law (4th ed. Oxford univ. press UK, (2014)

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ J. Wiley, Copyright at The School of Patent (1991) 58 U Chi L. Rev 119.

The common understanding of originality is that the work should originate from the author. In other words, the work need not be original in the sense that it must involve any original or inventive thought. In other words, there is no necessity that the work is “novel” as expected in patents. What copyright protects is the expression of an idea and all that is expected is that expression is not copied from another work.¹⁸

As already mentioned that the jurisdiction have their discretion in setting the benchmark while testing the originality. Some jurisdictions grant copyright when the work meet the minimal level of originality, while others crave for the higher level of originality i.e. not just independently created but also involve some amount of creativity.

The United Kingdom and New Zealand (Skill, labour and judgment test)

Both in the UK and New Zealand, for the protection of literary, dramatic, musical and artistic works (authorial works) they must satisfy the originality threshold. Considering United Kingdom, however, originality was not required under the very first Copyrights statute, The Statute of Ann 1701 and was first seen in the Sculpture Copyright Act of 1814.¹⁹

In the United Kingdom, the threshold of originality for many years was considered as spending a level of skill labour and judgment. In *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd*, where it considered the originality of football betting coupons, Lord Reid stated that the skill, labour and judgment criteria is what is used in the United Kingdom to determine originality.²⁰ The same standard is followed in New Zealand as well. In the case of *University of Waikato v Benchmarking Services Limited* (2004).²¹ The New Zealand Court of Appeal held that the determining fact of originality is whether sufficient time, skill, labour or judgment have been expended in producing the work.²²

In the case the court reiterated its own decision in *Wham-OMFG Co. v Linclon Industries Ltd* (1984) where they said;

“The originality that is required by the Act relates to the manner in which the claimant to the copyright has expressed thought or ideas. The Act does not require that the

¹⁸ Hariani, Krishna and Hariani, Anirudh “ANALYZING ‘ORIGINALITY’ IN COPYRIGHT LAW: TRANSCENDING JURISDICTIONAL DISPARITY” (2011) 51.

¹⁹ Liu, Dr Deming “Of Originality: Originality in English copyright law: past and present” [2014] European Intellectual Property Review.

²⁰ *Ladbroke v William Hill*, All ER 465, 469 (1964).

²¹ *University Of Waikato v benchmarking Services Limited* 8 NZBLC 101, 561 (CA)(2004)

²² Finch, Ian (ed) *James and wells intellectual prOperty law in New Zealand* (Thomson Reuters, New Zealand, 2007).

work be novel in form but that it should originate from the author and not be copied from another work."²³

However, in the case of *CCH Canadian Ltd v Law Society of Upper Canada* (2004) the Supreme Court of Canada attempted to define the three elements.

"For a work to be 'original' within the meaning of the Copyrights Act, it must be more than a mere copy of another work. At the same time it need not be creative, in the sense of being novel or unique. What is required to attract copyright protection in the expression of an idea is an exercise of skill and judgement. By skill, I mean the use of one's knowledge, developed aptitude or practical ability in producing the work. By judgement I mean the use of one's capacity to discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work. The exercise of skill and judgement required to produce the work must not be so trivial that it could be characterised as a purely mechanical exercise. For example, any skill and judgement that might be involved in simply changing the font of a work to produce 'another' work would be too trivial to merit copyright protection as an original work"

The United States (minimum degree of creativity test)

Before the case of *Feist v Rural Telephone Service Company*, the United States Courts held that originality had two distinct elements; namely; "independent creation" and "a subjective element".²⁴ The first element was very straight forward. It meant that for a work to be original, in the sense, an author must create it independently of other pre-existing works. However according to Russ Versteeg, the courts couldn't determine specifically, what the second element is.

In *Feist v Rural Telephone Service Company*, the United States Supreme Court held that "Feist had not infringed Rural's Copyright because the latter's alphabetized white page directory lacked originality necessary to be copyrightable."²⁵ For a work to be original under the meaning of the Copyrights Act, it must be (1) Independently created and (2) must exhibit a modicum of creativity".²⁶ In making the judgment, the court in *Feist* rejected the "sweat of the brow" doctrine.

²³ *Wham-OMFG CO v Linclon Industries Ltd*, 1 NZLR 641 (CA) (1984).

²⁴ Yu, Peter K *Intellectual property and information wealth: Issues and practices in the digital age* (Greenwood Publishing Group, New Delhi, 2006).

²⁵ *Feist Publications, Inc, v Rural Telephone Service Co*, 499 US 340 (1991)

²⁶ *Id.*

In the Feist case, the Court concluded that the ‘subjective element’ present in the originality is a “modicum of creativity”.

US commentators agree that having a low standard of creativity is best for the development of copyright law and it will be better if US courts omit the word “creativity” completely when deciding on eligibility of protection under copyright. Russ states that when the Copyrights Office proposed “creativity” to be included as a factor for copyright protection, they did not recommend a definition. The Chairman of the American Patent Law Association stated that that it is a retrogressive step to try to introduce the element of creativeness in addition to originality as a test. The term “Originality” has a judicial history. By adding the term “creative” (will create confusion) similar to adding the same in patent law.

INDIA (The middle path)

In India, copyright can subsist only in “Original” literary, dramatic, musical and artistic works. The Act does not define “Original” or “Originality” and what these concepts entail has been the subject-matter of judicial interpretations in India and various other jurisdictions.²⁷

The Copyright Act 1957 does not ask for originality of ideas, but in expression of thought. However the degree of originality required in a work is of more than trivial or minimal level.²⁸ The word “Original” does not mean that the work must be the expression of original or inventive thought. The Originality which is required relates to the expression of the thought but the Act does not require that the expression must be in an original or novel form, but that the work not be copied from another work that should originate from the author.

As early as 1924 while interpreting Sec 2 of the Imperial Copyright Act 1914, in the Privy Council case of Macmillan Company v. J.K. Cooper²⁹ Lord Atkinson held that labour, skill and capital expended must be sufficient to impart to the product, some quality which differentiates the product from raw material.³⁰ In Rupendra Kashyap v Jivan Publishing House, the court held that the word ‘original’ in Sec 13 of the Copyright Act 1957 did not imply any originality of ideas but merely meant that the work in question should not be copied from other work and should originate from the author being the product of his labour and skill.³¹ Thus the

²⁷ The COPYRIGHT ACT, 1957 Sec. 13

²⁸ Eastm Book Co. vs. Navin J. Desai (2002)25 PTC 641 (D.B)

²⁹ Macmillan Co. vs. J.K. Cooper, AIR 1924 P.C. 75

³⁰ Quoted in Nag Book House vs. State Of WB, AIR 1982 Cal245, at 249

³¹ Rupendra Kashyap vs. Jivan Pub. House, AIR 1996 PTC 439, Del

term ‘Original’ in reference to a work means that the work has independently been created by the author and has not been copied from someone else’s works.

The Supreme Court of India reviewed the concept of originality in detail in *Eastern Book Company and Others v D B Modak and Another*.³² Prior to this case the Indian courts, implicitly, followed the English approach to originality. The appellants in this case were the publishers of Supreme Court Cases (SCC), a series of law reports which contains all the Supreme Court’s judgments. The appellants alleged that the respondents, who had created software packages that contained Supreme Court judgments, had copied the contents of their publication verbatim.

The Supreme Court interestingly diverted from its standard practice of following the English sweat of the brow doctrine and adopted the view that “Novelty or invention or innovative idea is not the requirement for protection of copyright but it does require minimal degree of creativity.” Applying the “creativity” standard, the court held that mere copy-editing of the judgment would not merit copyright protection as this involves labour and nothing else. However, since some creativity is involved in the production of headnotes, footnotes, editorial notes, etc., these would qualify for copyright protection and the respondents were not allowed to copy them.

The Supreme Court appears to have adopted a middle path and relied on the judgment in *CCH Canadian Ltd v Law Society of Upper Canada*, where the Supreme Court of Canada took the view that the sweat of the brow approach was a rather low standard to establish originality as it shifted the balance of copyright protection mainly in favour of the owner as against public interest, and the modicum of creativity standard was too high as “creativity” implied that the creation must be “novel” or “non-obvious” and these concepts are mostly synonymous with patents and not copyright.³³

The Supreme Court clearly sought to establish a balance between the right of authors to exploit their work and reap benefits and at the same time ensure the right of the public to freely access copyrighted works. By departing from the sweat of the brow doctrine, the courts discarded both the low threshold and the higher threshold in favour of a middle-of-the-road approach. This

³² *Supra* note 30.

³³ *CCH Canadian Ltd vs. Law Society of Upper Canada* (2004) 1 SCR 339

would mean that each case would be scrutinized on its individual merits to establish originality as per the current approach.

TWITTER Vis a Vis COPYRIGHT: Challenging the originality threshold

Every time a new technology comes along that aids communication, copyright inevitably becomes an issue with it, at least to some degree.³⁴ From piano rolls to radios to televisions to the Web, every great technology has shifted the copyright landscape and has had its course altered, at least in some way, by those protections. Twitter is no different in that regard, whether it is just a fad or the beginnings of something larger, twitter as a technology raises copyright questions that are not easy to answer.

Twitter is a web-based real-time, short-messaging service that allows users to exchange information with other users via short notes or "Tweets."³⁵ They must be under 140 characters in length and generally answer one question: "What are you doing?"³⁶ Twitter users' answers vary, as some users' Tweets are akin to stream of consciousness, while others Tweet facts, share stories, or just keep tabs on each other.³⁷

Tweets are messages which fall under literary content of copyright, hence attracting the copyright law. Tweets pose a unique challenge to the application of copyright law. Under Twitter's copyright policy, twitter users own their Tweets, and therefore, users, not Twitter, would have the right to sue for copyright infringement.³⁸ Each Tweet, however, must satisfy the elements of copyright-ability: a Tweet must be original, it must qualify as a work of authorship as contemplated by the Act, and it must be fixed in a tangible medium of expression.³⁹ In the era of internet, where the inherent feature of every social media is to share, and on the other hand the objective of Copyright law is to check the unauthorized communication to the public of the work, there arises an issue as to "Are Tweets Copyright protected?"

The copyright law is applicable on those works only which fall under the subject matter of the copyright act. Now the debatable question which arises is first test whether the literary content of twitter reaches the "Originality" threshold set down by different jurisdictions.

³⁴ Jonathan Bailey, Copyright And Twitter The Blog Herald (2008)
<https://www.blogherald.com/features/copyright-and-twitter/>

³⁵ About twitter, <http://twitter.com/about>

³⁶ *Id.*

³⁷ *Id.*

³⁸ Twitter terms of service, TWITTER, <http://twitter.com/tos>

³⁹ 17 U.S.C. Sec. 102(a)

There has been mixed views regarding “tweets” meeting the originality threshold. Those who claim tweets are non-copyrightable, support their view on the following points:

1. Since a tweet, exclusive of embedded media, can be only 140 characters, its size is an impediment. Short phrases, titles, etc., are usually not protected under copyright law because most of them fail to reach the level of originality required for copyright protection. They are generally seen as lacking in originality and creativity.
2. Another factor that may work against tweets getting copyright protection is that the content of most tweets cannot be protected under copyright law, for instance, “Had some yummy pasta” is neither original nor creative and is therefore not copyrightable.
3. The concept of *scènes à faire* also serves as an impediment. According to this, certain works cannot be given copyright protection since the elements used to describe a scene are necessary and that scene cannot be described but through those elements. It is likely that if a group of people witness an incident and then tweet about it, they will more or less come up with the same description.

On the other hand, those who are in support of protection to tweet claim that granting such protection might be difficult but not impossible. Though there is a limit to the post but nowhere is it concluded that originality is tested solely on the size of the content. If the author can give creativity even in a small content why should protection not be granted? The question raised here is – “Are tweets copyrightable?” Rather it should be – “Is this tweet copyrightable?” The protection is not being sought for all the posts on the twitter, instead only for those which display some sort of creativity. It is said that the tweet is attacked by the “de minimis rule”.⁴⁰ The supporters lay down the solution laying that all the tweet messages of a user should be taken as a whole and not individually so as to bring them out from the purview of insufficient content. The other contention laid by the supporters is that if Haiku⁴¹ can be protected then why not Twitter? Or it can be said that, represent the tweet in the form of a Haiku to grant protection.

There have been instances where the twitter according to their terms of service has deleted the posts on the ground that they are infringing copyright. Some are as followed:

- a. There was one prestigious publishing company who decided to withdraw the book entitled “Les Perles des tweets et du net” which was a compilation of “tweets”. The compilation was done without the authorization from the author, moreover with no

⁴⁰ Legal maxim “De minimis non curat lex” meaning law doesn’t govern trifles.

⁴¹ Japanese poem of 17 syllables followed as 5/7/7 format.

acknowledgment of the author's name. The company to avoid any potential judgment against themselves, they decided to withdraw the book from the market.⁴²

- b. Olga Lexell, a freelance writer based in Los Angeles, found one of her tweeted jokes to have been posted by others without due credit being given to her. She argued that writing jokes is her bread and butter. Twitter deleted the infringing tweets after she filed a takedown request.⁴³
- c. On the Indian front, Vasuki Sunkavalli, Miss India Universe 2011, was accused of copying tweets belonging to writer and journalist Sadanand Dhume. Though the matter was settled amicably, the question of copyrightability of tweets was once again brought to the fore.⁴⁴

Tweets that qualify as independently created must also contain a modicum of creativity.⁴⁵ Although the threshold requirement of creativity is very low,⁴⁶ not all Tweets will meet standard. The work must possess some creative spark, 'no matter how crude, humble or obvious' it might be."⁴⁷ Rabid poet's Tweet "Moon Writings"⁴⁸ contains a unique expression of words that form a poem, which satisfies the creative element.⁴⁹ On the Other hand, adamisacson's Tweet "Hi. I'm in a staff meeting. . ." does not meet this standard. This Tweet consists of shared public expressions which are too trivial to satisfy the creativity standard.⁵⁰ Mager's Tweet, "wine chocolate scotch," falls in the grey area. Its list of assorted words could be compared to

⁴² Anna Guix, Social media and copyright: who owns the content? Legal today (2014) <http://www.legaltoday.com/gestion-del-despacho/nuevas-tecnologias/articulos/social-media-and-copyright-who-owns-the-content>

⁴³ Manisha Singh and Raashi Jain, Tweet twitter tweeted: Can copyright protect tweets? India Business Law Journal (2015)

⁴⁴ *Id.*

⁴⁵ See *Feist Publication Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); *In re Trade-Mark Cases*, 100 U.S. 82, 94(1879)

⁴⁶ *Feist*, 499 U.S. at 361; see *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903). It was suggested by Justice Oliver Wendell Holmes that very nearly any creative effort will suffice since, & the [work] is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright"

⁴⁷ *Feist*, 499 U.S. at 345 (quoting *NIMMER & NIMMER*, supra note 62, § 1.08 [C][1]).

⁴⁸ Posting of Rabid Poet to TWITTER (Sept. 21, 2009, 9:53 AM), <https://twitter.com/RabidPoet>

⁴⁹ *Becker v. Loews, Inc.*, 133 F.2d 889, 891 (7th Cir. 1943) ("A poem consists of words, expressing conceptions of words or lines of thoughts; but copyright in the poem gives no monopoly in the separate words, or in the Ideas, conception, or facts expressed or described by the words. A copyright extends only to the arrangement of the words")

⁵⁰ See *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705, 710 (7th Cir. 1972) (noting words and phrases are not copyrightable); see also *John Muller & CO. v. N.Y. Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986) (finding that a soccer teams logo consisting of "four lines that form arrows and the word & arrows" lacked the level of creativity needed for copyrightability).

the alphabetized telephone white pages in *Feist Publications, Inc. v. Rural Telephone Service Co.* which the Court found lacked the creative spark.⁵¹

Alternatively, if the words were looked at as a whole, the modicum of creativity requirement could be met in the arrangement of the words.⁵² Additionally, this Tweet meets the low originality threshold discussed in *Alfred Bell & CO. v. Catalda Fine Arts, Inc.*, where the court decided the defendants would have been fine if they had made their own handmade versions of a work, but could not simply copy plaintiffs work.⁵³ Clearly, there is no definitive answer as to whether all Tweets meet the level of originality required. Nevertheless, it is possible for some Tweets to qualify as original.

Moreover, if the protection is granted to the tweets they will not only protect the unauthorized re-tweet but would also put a check on the commercial activity in the form of “Framed tweet”. It is an unethical activity undertaken by the infringer whereby they frame the tweets of renowned and public figures and then sell it off with the aim to earn profit.⁵⁴ Eventually, looking at the whole discussion, it is clear that due to absence of any settled definition of originality and creativity, there is always a room for the issues like the above to arise. The courts have tested the originality subjected to the facts of the case.

CONCLUSION

Copyright is a minimal protection; it prevents against no more than actual copying. As a minimal protection, the originality standards required for copyright protection should be minimal as well. That objective is best served by a standard of copyright originality that recognizes the narrowness and the nearly universal nature of copyright protection for written material under the 1976 Act.

The choices are limited and essentially require an election between objective and subjective standards. The objective standard identifies those portions of the work that have originated with the author and, while according copyright protection to the work, carefully limits copyright

⁵¹ *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351-52, 363-64 (1991) (holding that alphabetized telephone white pages lacked the creative spark required by the Copyright Act and the Constitution, and, therefore, were not entitled to copyright protection despite the hard work that went into compiling the facts contained in the directory).

⁵² 17 U.S.C. § 101 (2006) (defining a copyrightable compilation as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship”). The right thus secured by the copyright Act is not a right to the use of certain words, because they are the common property of the human race, nor is it the right to ideas alone, since in the absence of means of communicating them they are of value to no one but the author. But the right is to that arrangement of words which the author has selected to express his ideas.

⁵³ 23 *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 104-05 (2d Cir. 1951)

⁵⁴ TWITTERLOGICAL: The misunderstanding of Ownership <http://canyoucopyrightatweet.com/>

protection to the additions made by the creator. Where there is a slavish copying, as with a purely mechanical reproduction, the copyist has added nothing; the work does not originate with him and he is entitled accordingly to no protection

A subjective standard, as applied by the Second Circuit, is not only statutorily and constitutionally unwarranted, it is effectively unmanageable. It complicates what should be a simple standard of review. The judiciary is not qualified, as Justice Holmes so aptly noted, to make judgments about a work's literary or artistic merit. For the court to impose its own subjective judgment not only on the reproduction but on the underlying work as well is to twice violate that basic premise. As originality standards move from being erratic as a consequence of subject matter assessments to being unpredictable because of judicial assessments of the creator's skill, the consistency of standards required by a national copyright statute will necessarily diminish.

Realising it's a high time, the space at which the technology is developing and on the other hand the related laws (copyright) which is not so in par with the change need to be more dynamic than it is today. Twitter tweet is one such issue which has raised the objectivity of originality. The originality bottom line has been drawn way back, today it needs to be refined in terms of technological change.



The Saga on Traditional Knowledge under IPR: Protection, Promotion and Strategies

Saloni Neema & Pallavi Singh⁵⁵

ABSTRACT

Throughout many millennia, Traditional Knowledge of the Indigenous and local populations' has proven extremely valuable. It has been passed from generation to generation based on decades of experience and adaptations to the local lifestyle and culture. It has a broad domain like food, genes, clothes, biodiversity, etc. It has kept involved as per community interaction with their cultural environment. Despite its existence for a long time, it is on the verge of being marginalized. This article analyses the risks, the inadequacies of the international legal framework, and the failing attempts by national governments to re-establish their role in the world. It identifies the need for the preservation and promotion of Traditional Knowledge. It discussed the Traditional Knowledge protection under the different legal statutes and threw light upon the few landmark cases like Turmeric, basmati rice and neem cases. The paper aims to analyse the prominent existing national and international legal protection of TK (Traditional Knowledge) and provide suggestions for sustainable resource management.

Keywords: Traditional Knowledge, Indigenous, TKDL, Biodiversity

INTRODUCTION

An African proverb says, "When an old person of knowledge dies, then a whole Library disappears".

According to this famous quote, traditional knowledge has ancient origins in every culture throughout the world. This knowledge was also beneficial to their long-term growth and livelihood. To put it in layman's terms, Traditional Knowledge (TK) is a knowledge base accumulated over a significant period in a particular region or community, in which the people are well adapted to the local environment and culture, and they do not strive to maximize their income but instead take action to prevent their risks. And by this, it should be emphasized that

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traditional knowledge is a collective piece of information over which only society may claim a right, not a specific individual. Traditional knowledge pertains to indigenous and local group's knowledge, inventions, and customs from worldwide. Traditional knowledge is passed down orally from generation to generation, based on decades of experience and adaptations to the local lifestyle and culture. Stories, music, folklore, proverbs, cultural values, beliefs, rituals, community rules, the local language, and agricultural techniques, including the development of plant species and domesticated animals, are examples of collectively owned knowledge. It is sometimes called an oral tradition since it has been practiced, sung, danced, painted, carved, recited, and performed for centuries. Traditional knowledge is practical, especially in agriculture, fishing, health, horticulture, forestry, and general environmental management. Traditional knowledge protection and promotion culminate numerous ideals such as human rights, environment protection, sustainable development, intellectual property rights, and benefit-sharing mechanisms.⁵⁶ The first and most significant stage in determining the nature of intellectual property protection for traditional knowledge is to define which aspect of intellectual property traditional knowledge pertains to. The three categories of intellectual property that can protect traditional knowledge are copyright law⁵⁷, patent law, and trade secrets.

SIGNIFICANCE AND CHARACTERISTICS OF TRADITIONAL KNOWLEDGE

Traditional Knowledge doesn't have one domain to define it due to its diverse nature. The feature that characterizes Traditional Knowledge is its evolving nature. Traditional Knowledge evolves with the collective or individual creator's responses to an interaction with their cultural environment. In addition to that, it is held by members of a distinct culture and or/sometimes acquired "by means of inquiry peculiar to that culture, and concerning the culture itself or the local environment in which it exists."⁵⁸

Traditional Knowledge represents a collective culture, not an individual one. This bestows it with a unique feature of common control instead of single-controlled entity. And users of common property are subject to rules and restrictions embedded in cultural or religious

⁵⁶ Meera Nayak, The Misappropriation of Traditional Knowledge, DENVER JOURNAL OF INTERNATIONAL LAW & POLICY (April.30, 2019), <http://djilp.org/the-misappropriation-of-traditional-knowledge/>.

⁵⁷ Vatsala Singh, IPR Vis- A- Vis Traditional Knowledge, KHURANA & KHURANA ADVOCATES AND IP ATTORNEYS (Oct. 5, 2018), <https://www.khuranaandkhurana.com/2018/10/05/ipr-vis-a-v-is-traditional-knowledge/>.

⁵⁸ UNEP/CBD/COP/3/Inf.33, Annex ii

customs. Resultantly, they perceive themselves as a possessor of their habitat instead of resource owners. Hence, community members have only community rights.

A very important feature of Traditional Knowledge is that it is 'Traditional' only to the extent that its creation and use are part of the cultural traditions of communities.⁵⁹ "Traditional", therefore does not necessarily mean that the knowledge is ancient.⁶⁰ "Traditional" knowledge is being created every day, it is evolving as a response of individuals and communities to the challenges posed to their social environment.⁶¹

The value of traditional knowledge is becoming more widely recognized. Traditional knowledge is vital not just to individuals who rely on it in their daily lives, but also to industry and agriculture in the modern world. Traditional knowledge concerning land and species conservation, management, and biological resource rejuvenation is based on indigenous people's daily lives and practices, as well as their deep understanding of their ecosystems developed over thousands of years. It has the potential to play a critical role in achieving sustainable development and addressing the world's most pressing issues, such as climate change, land management, and land conservation, as well as strengthening scientific, technological, and medical research, as evidenced by pharmaceuticals, among other things.

Furthermore, traditional knowledge has the potential to provide viable paths for achieving food security not only for indigenous peoples but for people all over the world. Many indigenous land and environmental management strategies have been shown to improve and promote biodiversity at the local level, as well as contribute to the maintenance of healthy ecosystems.

Promotion of traditional knowledge by a country also encourages the feeling of national cohesion and identity. Moreover, complying with international agreements like the TRIPS Agreement and Convention on Biodiversity (CBD) help to establish the high standard of intellectual property protection.

PRESERVATION, PROTECTION AND PROMOTION OF THE TRADITIONAL KNOWLEDGE

As Traditional Knowledge is considered to be a publicly owned property, this makes it more prone to unauthorized use and exploitation. Hence, protection is needed to safeguard the

⁵⁹ Dr. G.B. Reddy's, Intellectual Property Rights and the Law 399 (9th ed. 2012).

⁶⁰ *Id.*

⁶¹ *Id.*

interest of rightful owners. When it comes to developing countries, it is of key importance for them to protect, preserve and promote the traditional knowledge. As their rich endowment of traditional knowledge and biodiversity plays a crucial role in their healthcare, food security, culture, religion, identity, environment, sustainable development and trade.⁶²

Due to the absence of Sui generis legislation to safeguard the Traditional Knowledge, it is exploited without the benefits being shared with the original TK holders. Traditional Knowledge in such cases is used without the consent of the owners and used by the third parties in unauthorized manner for the commercial purpose, thereby depriving the rightful owners of the profit. Therefore, effective measures are required to preserve, promote and protect Traditional Knowledge.

Estimation is that out of over 6,000 currently spoken languages representing the cultures, 90% may face extinction in the next 100 years. Traditional Knowledge can be preserved through recording, documentation, digitization of traditional knowledge, registries or databases. Protecting Traditional Knowledge not only allows the rightful owners to get the benefit derived, but it also helps to keep the knowledge alive for future generations so that the cultural knowledge could be preserved.

Presently, traditional knowledge can be protected in two ways namely;

1. Positive Protection and;

2. Negative Protection.

Positive Protection

“Positive protection is the granting of rights that empower communities to promote their traditional knowledge, control its uses and benefit from its commercial exploitation.”⁶³ It aims to establish legal protections for traditional knowledge. This is accomplished by either exploiting existing laws or enacting new sui generis laws through legislative processes.

Defensive Protection

This mechanism protects against third-party acquisition of unlawful intellectual property rights

⁶² V.K. Gupta, Protecting India's Traditional Knowledge, WIPO MAGAZINE, June 2011 at p.5.

⁶³ Traditional Knowledge and Intellectual Property – Background Brief, (April 4 2022, 7:03pm), https://www.wipo.int/pressroom/en/briefs/tk_ip.html.

over traditional knowledge. The Indian Patent Act 1970 provides for the defensive protection to the Traditional Knowledge. This protection can be claimed when it is made mandatory for the applicant to disclose the source of origin of genetic resources and associated traditional Knowledge.

Unlike other types of intellectual property rights, India does not have a comprehensive act or law to safeguard traditional knowledge, but other IP acts do, such as the Patents Act of 1970, Sections 25 and 64, which enumerates traditional knowledge as one of the grounds for revocation of a patent application. The Copyright Act of 1957 makes no reference of protecting traditional cultural, literary, or artistic works, or folklore, but Section 31A provides for safeguarding of unpublished Indian work, However, Copyright protection is only for a limited period of time, and it also necessitates that certain criterion be met, so traditional knowledge protection under this IP is restricted.

TRADITIONAL KNOWLEDGE UNDER PATENTS

It's been indicated that the Indian Patent Office is issuing patent protection on the use of Indian traditional knowledge (TK), particularly relating to the Ayurveda, Unani, and Siddha systems of medicine, as well as patents on inventions involving biological resources acquired from India, without continuing to follow the law's obligation even though other foreign patent offices have denied or objected to the award of such patents based on prior art evidence retrieved from the Traditional Knowledge Digital Library.

The preservation of traditional knowledge and biodiversity is adequately provided under the Indian law. Traditional knowledge is in the public domain by definition, so any patent filing relating to TK does not meet the criteria as an invention under Section 2 (1) (j) of the Patents Act, 1970⁶⁴, which defines "invention"; as a new product or process involving an inventive step and capable of industrial application. Furthermore, a substance created by a simple mixing resulting merely in the amalgamation of the qualities of the components thereof, or a technique for making such substances, is not an innovation and hence not patentable, according to Section 3(e) of the Patents Act. Under Section 3 (p) of the Indian Patents Act,⁶⁵ "an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known qualities of traditionally known component or components"; is not an invention and hence not patentable

⁶⁴ The Patents Act, 1970, § 2 (1) (j).

⁶⁵ *Id.* § 3 (p).

within the meaning of the Act.

As previously indicated, the Patents Act protects traditional knowledge with defensive protection. An innovation which, in effect, is traditional knowledge or which is an aggregation or duplication of known qualities of historically known component or components; is not an invention, according to Section 3(p) of the Indian Patents Act, 1970.⁶⁶ It's also a reason to file a pre-grant or post-grant opposition under sections 25(1)(k)⁶⁷ and 25(2)(k).⁶⁸ Section 25(1)(k) states that any person may oppose a patent application after it has been published but before it has been granted on the grounds that the invention, in so far as it is claimed in any claim of the complete specification, is anticipated based on knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere. Section 25(2)(k) allows any person who is interested to submit a post-grant objection after the patent has been granted but before one year has passed since the patent has been published. This is also a reason for termination of a patent under Section 64(1) (q) of the Patent Act, 1970.⁶⁹ Aside from the aforementioned, if the applicant has incorporated biological material in the innovation that is not accessible to the general public, the applicant will be required to declare the sources and geographical origin of the biological material in the patent specification. Pre-grant and post-grant opposition, as well as patent revocation, can be brought because of non-disclosure or erroneous reference of biological material in the specification.

Defensive protection can also be obtained by gathering traditional knowledge from all accessible sources, compiling it into a database, and making it accessible to patent offices for the purpose of performing patent searches. Many applications based on traditional knowledge will be rejected merely on the basis of examination. Many traditional knowledge sources are unwritten and passed down orally. Identifying the people who have such information and their documentation is a difficult undertaking.

Biopiracy, as the term implies, is the piracy of diverse biosphere elements such as microorganisms, plants, and animals. According to research conducted by the Council of Scientific and Industrial Research (CSIR) in 2000⁷⁰, seven medicinal herbs from India

⁶⁶ *Id.*

⁶⁷ *Id.* § 25 (1) (k).

⁶⁸ The Patents Act, 1970, § 25 (2) (k).

⁶⁹ *Id.* § 64(1) (q).

⁷⁰ Chandra Prakash Kata, Pitamber Prasad Dhyani, Bikram Singh Sajwan, Developing the medicinal plants sector in northern India: challenges and opportunities, NATIONAL LIBRARY OF MEDICINE (Aug.8, 2006), <https://www.ncbi.nlm.nih.gov/pmc/articles/PMC1562365/>.

accounted for 80 percent of all medical patents filed in the United States and the United Kingdom. In 2003, the US and UK filed roughly 15000 patents on medicinal plants of Indian origin, and by 2005⁷¹, the number of patents had risen to 35000⁷², demonstrating developed nations ‘interest in developing countries’ knowledge and skills. Furthermore, the patent examiner who comes for examination is from a developed country rather than a developing country, giving the former carte blanche to take and utilize traditional medical expertise. The instances of neem, turmeric, and basmati rice must be studied in order to have a better understanding of how biopiracy occurs.

THE TURMERIC CASE

Turmeric is a tropical herb extensively used in India as a cosmetic and colouring ingredient in almost all cuisines. Turmeric powder has a vivid yellow colour and a somewhat bitter flavour when uncooked. In 1995, a US Patent was granted to the Medical Centre of the University of Mississippi to use Turmeric wound-healing properties.

A patent was awarded for the “use of turmeric in wound healing”; and claimed a technique to cure wounds in a patient by administering an “effective amount” of turmeric while the USPTO and EPO dealt with the Neem dispute. The inventors of the claimed patent on turmeric were Suman K. Das and Hari Har P. Cohly, who eventually assigned the patent to the University of Mississippi. A re-examination application was filed against the issued patent, citing roughly two dozen references, and it was granted quickly.⁷³ The inventor’s defence was inadequate in the face of current interpretations of traditional Ayurveda texts, extracts from the Compendium of Indian Medicinal Plants, nineteenth-century historical materials from Hamdard University’s collection and the patent was revoked in August 1997.

India’s claim: From 1995 to 2006, Dr. R. A. Mashelkar, the Director of the Council of Scientific and Industrial Research (CSIR), contested the patent awarded to the Medical Centre of Mississippi University and fought very hard to restore India’s ancient Turmeric understanding. Scientists from India make the following arguments: The assertion was backed up by documented proof, which included an old newspaper dated 1953 printed and published by the Indian Medical Association and other material such as ageing and ancient Sanskrit

⁷¹ Subramani Parasuraman, Gan Siaw Thing, Sokkalingam Arumugam Dhanaraj, Polyherbal Formulation: Concept of Ayurveda, NATIONAL LIBRARY OF MEDICINE, <https://www.ncbi.nlm.nih.gov/pmc/articles/PMC4127824/>.

⁷² Ramesh Menon, Traditional knowledge receives a boost, INDIA TOGETHER, <https://indiattogether.org/tkd-1-economy>.

⁷³ Vatsala Singh, IPR Vis- A- Vis Traditional Knowledge, KHURANA & KHURANA ADVOCATES AND IP ATTORNEYS (Oct. 5, 2018), <https://www.khuranaandkhurana.com/2018/10/05/ipr-vis-a-vis-traditional-knowledge/>.

literature. In April of 1998, the court ruled in favour of the CSIR, based on the claim that Turmeric has been used by Indians since ancient times, as evidenced by extensive documented evidence.

THE BASMATI CASE

Another example that caused a great deal of difficulty was a patent given by the USPTO to Rice Tec, an American firm, for “Basmati rice lines and grains”. Basmati rice is a fragrant rice type that has been farmed in India and Pakistan for centuries. Aside from patent law⁷⁴, the issuance of this patent resulted in a slew of other IP concerns, such as trademarks and geographical indications.

Rice Tec had been granted a patent for the invention of hybrid rice lines that supplemented desirable grain traits of Basmati rice with desirable plant traits; this was due to the inferior quality of Basmati rice grown in the United States compared to the high-quality Basmati rice grown in northern India and Pakistan and would aid in the production of a better Basmati rice crop in the western hemisphere, particularly in the United States. A re-examination request was submitted, along with testimonies from two scientists and many articles on Basmati rice and Indian rice research—one of which convinced the USPTO that Rice Tec’s essential claims were non-obvious. Rice Tec decided not to appeal the USPTO’s judgement and reduced its twenty claims to three.

THE NEEM CASE

Neem is a tropical evergreen plant native to India and other Southeast Asian countries. Because of its medicinal capabilities, Neem is regarded in India as “the village pharmacy”. It has been utilized in medicine since the beginning of time, primarily in Ayurveda, and may be dated over 4000 years. The Sanskrit term “Arista” means “imperishable” or “perfect”; and refers to the Neem tree. The leaves of the Neem tree, as well as the tree itself, are used in medicine. It is used to treat inflammatory, pyretic, antiseptic, antifungal, and antiviral symptoms. Theft of genetically diverse resources and materials, especially plant varieties, is known as bio-piracy in exchange for a patent.

Even though the owner is the legitimate owner of the property, once material is patented, the owner may be able to prevent it from being repossessed by anybody else. As a result, by

⁷⁴ Saipriya Balasubramanian, India: Traditional Knowledge And Patent Issues: An Overview Of Turmeric, Basmati, Neem Cases, MONDAQ (April.18, 2017), <https://www.mondaq.com/india/patent/586384/traditional-knowledge-and-patent-issues-an-overview-of-turmeric-basmati-neem-cases>.

patenting indigenous people's local customs, companies may be able to ban locals from using their indigenous practices, posing a threat to native economic growth.

Problem raised in Neem Patent:

In the year 1971⁷⁵, a timber importer from the United States purchased neem seeds to establish neem trees in his Wisconsin headquarters. He also carried out performance and safety experiments on the pesticide capabilities of Neem and received approval from the United States Environmental Protection Agency, EPA. After three years, he transferred the patent to W R Grace and Co., a global organization. By 1985, numerous US and Japanese corporations attempted to locate and formulate emulsions for toothpaste manufacture using Neem. In 1992, the company W R Grace and Co claimed ownership of the insecticide emulsion made from Neem seeds.

Dispute:

According to India's assertion, Neem is an indigenous plant still used as a type of traditional knowledge in the country. It was also claimed that granting a patent to Neem would hurt impoverished farmers and, as a consequence, the Indian economy. In India, a group of individuals and numerous non-governmental organizations launched the Neem campaign to mobilise global support and defend traditional knowledge systems as well as Indian traditional goods from biopiracy. The Neem Case was the first legal challenge against biopiracy patents in the United States and Europe.

Judgement:

The European Patent Office (EPO) acknowledged the arguments of Indian scientists on July 30, 1997, resulting in the rejection of W R Grace and co.'s patent by the US patent office. The consumption of Neem and its derivatives in India for even more than 4000 years has been the only justification acknowledged in its entirety.

TRADITIONAL KNOWLEDGE DIGITAL LIBRARY (TKDL)

The then-Central Government's Planning Commission established a "Task Force on Conservation and Sustainable Use of Medicinal Plants" in June 1999. One of its goals was to discover ways to make it easier to safeguard "patent rights and intellectual property rights of

⁷⁵ *Supra* note 74.

medicinal plants". One of the Task Force's recommendations was to establish a library to ensure the collection of traditional knowledge on a single platform that is digitally accessible and useful in demonstrating to the world that traditional medicinal knowledge associated with India is prior art and that patent applications based on such expertise will not meet the criteria for novelty. As a result, a database of India's traditional knowledge was created.

The Traditional Knowledge Digital Library (TKDL) is a database of approximately 2, 50,000 formulas used in Ayurveda, Siddha, Unani, and Yoga schools of traditional Indian medicine.⁷⁶ TKDL is a pioneering Indian attempt to avoid misuse of the country's traditional medical knowledge at international patent offices, on which the healthcare requirements of over 70% of India's population and the subsistence of millions around the world depend.⁷⁷ India's approach toward defensive protection in constructing the digital library to combat biopiracy and misappropriation of traditional knowledge has been noticed worldwide. However, simply acknowledging the problem is insufficient; it is necessary to implement an equitable benefit-sharing mechanism.

According to the TKDL advisory committee, about 2000 erroneous patents about Indian systems of medicine are awarded every year at the international level because of India's traditional system of medical knowledge, which exists in local languages such as Sanskrit, Hindi, Arabic, Urdu, Tamil, and others, is neither obtainable nor understandable to patent examiners at international patent offices.

PROTECTION OF TK UNDER INDIAN COPYRIGHT LAW

The Indian Copyright Act safeguards the author of a work, but there is no single author for awarding protections to the author of traditional knowledge. In the case of traditional knowledge, the work is a collection of information passed down through generations, making authorship challenging and impossible.

Although Section 31A (2),⁷⁸ of the Indian Copyright Act safeguards unpublished Indian works, it does not expand its branches to protect indigenous people's traditional knowledge or folklore expression directly. However, safeguarding traditional knowledge has its own set of issues. The following are the most significant drawbacks:

⁷⁶ Traditional knowledge digital library (TKDL), Council of Scientific and industrial research, accessed at <https://www.csir.res.in/documents/tkdl>.

⁷⁷ Ramesh Menon, Traditional knowledge receives a boost, INDIA TOGETHER, <https://indiatogether.org/tkdl-economy>.

⁷⁸ The Indian Copyright Act, 1957, § 31A 2.

- The Indian Copyright Act protects works registered under it for a finite period of just 60 years. On the other hand, traditional knowledge should be protected indefinitely rather than for a specified period.

- Only a tangible form of work may be registered under the Indian Copyright Law to protect copyright. On the other hand, traditional knowledge is never a set form of work but rather a verbal form of information passed down through generations. However, the stories are only available in written form in some instances.

- Traditional knowledge cannot be registered under Indian Copyright law and is quickly rejected because it does not meet the Indian Copyright Act's fundamental standards.

PROTECTION OF TK UNDER THE INDIAN TRADE SECRETS ACT

Traditional knowledge can be preserved under the Trade Secrets Act without an expensive procedure like the one required under the Patent Act⁷⁹. Traditional knowledge is a bit of a mystery among members of a specific group, and they are constantly careful of passing it down from generation to generation. As a result, traditional knowledge can be protected under the Indian Trade Secrets Act. Even though Indian traditional knowledge is quite extensive and is employed in various disciplines such as agriculture and medicine, Indian intellectual property laws fail to safeguard traditional knowledge adequately. However, there are alternative options, such as special legislation to protect traditional knowledge and benefit-sharing schemes.

PROTECTION OF PLANTS VARIETIES AND FARMERS' RIGHTS ACT 2001⁸⁰

The Protection of Plant Varieties and Farmers' Rights Act 2001, which aims to preserve farmer's traditional rights, such as the ability to keep, use, distribute, or sell farm produce of a variety protected under the Act, is another crucial piece of law relating to TK in farming. This Act also allows the equal distribution of benefits flowing from the use of plant resources that may accrue via a breeder from the agricultural community will be disposed disposal and planting material of a variety. The Act allows any farmer, group of farmers, or community to apply for the registration of "extant variety" and "farmer's variety" if they claim to be the breeder of the variety. "Extant variety" refers to a variety that is (a) notified under Section 5 of the Seeds Act, 1966⁸¹ (b) a farmer's variety (c) a variety about which there is common

⁷⁹ DR. G.B. REDDY'S, INTELLECTUAL PROPERTY RIGHTS AND THE LAW, Gogia Law Agency.

⁸⁰ Protection of Plants Varieties and Farmers Act, 2001.

⁸¹ The Seeds Act, 1966, §5.

awareness; or (d) any other variety that is in the public domain and is available in India. Farmer's variety has been characterized as a variety (a) that has been historically farmed and evolved by farmers in their fields; or (b) is a wild relative or land race of a variety about which the farmers have common knowledge. However, such a variation must meet the parameters of uniqueness, conformity and stability. In the case of existing varieties, such as farmer's varieties, the criteria of novelty that applies to the registration of other kinds has been reduced.

Farmers will also be eligible for compensation from the Gene Fund as a result of the Act. A farmer who is involved in the conservation of genetic resources of land races and wild relatives of economic plants, as well as their enhancement via selection and preservation, is eligible for recognition and award from the Gene Fund, according to Section 39(iii).⁸²

INTERNATIONAL LEGAL REGIME ON THE PROTECTION OF TRADITIONAL KNOWLEDGE

The need of preserving indigenous and local communities' information, originality, and customs is increasingly becoming more widely recognized around the world. The first attempt to protect traditional knowledge under the IP regime was a joint initiative by WIPO and the United Nations Educational, Scientific and Cultural Organization (UNESCO) in 1978, which led to the further fortification of folklore expressions against unlawful exploitations and other detrimental conducts in 1982. The protection of traditional information has grown in importance since the ratification of the Convention on Biological Diversity (CBD) in 1992. There are some international instruments which contain certain provisions for the protection of Traditional Knowledge and Traditional Cultural Expressions. However, there's no binding international instrument as such which deals exclusively with the protection of traditional knowledge.

Berne Convention for the protection of literary and Artistic works, 1886

For the protection of 'Literary and Artistic work', Berne Convention for the protection of literary and artistic works was adopted in 1886. Words like 'literary' and 'artistic' are defined comprehensively but inclusively in the convention. After the Stockholm revision (1967) and Paris revision (1971), article 15(4) of the convention covered the work of 'Folklore'. But, it is noteworthy that the word 'folklore' has not been used anywhere in the convention.

Article 15(4) (a): -

⁸² *Supra* note, §39 (iii).

(a) *In the case of unpublished works where the identity of the author is unknown, but where there is every ground to presume that he is a national of a country of the Union, it shall be a matter for legislation in that country to designate the competent authority who shall represent the author and shall be entitled to protect and enforce his rights in the countries of the Union.*

(b) *Countries of the Union which make such designation under the terms of this provision shall notify the Director General by means of a written declaration giving full information concerning the authority thus designated. The Director General shall at once communicate this declaration to all other countries of the Union.*

It can be clearly established from the above article that the three foremost things required for the enforcement of the provisions of this article is that (i) there should be unpublished work (ii) the author is unknown (iii) and there is every reason to believe that the author is a national of a given country. In this case, with the fulfilment of above conditions, any country can enforce the right of its work in other countries. This particular provision is more prone to exploitation by the way of claiming the anonymous work by the authority and enforcing it against the other nations.

ILO Convention on Indigenous and Tribal Peoples, 1989

This convention obligated member states to confer rights on the indigenous and tribal people.

Few articles which talk about the tribal people rights: -

➤ **Article 13(1):** It obligates the member states to respect the special importance for the cultures and spiritual values of the peoples concerned of their relationship with their lands or territories.

➤ **Article 23:** It lays down that handicrafts, rural and community-based industries, and subsistence economy and traditional activities of the peoples concerned, such as hunting, fishing, trapping and gathering, are to be recognized as important factors in the maintenance of their cultures and in their economic self-reliance and development.

United Nation Declaration on the Rights of Indigenous People, 2007

This declaration was adopted in 2007 recognizing inter alia “respect for indigenous knowledge, cultures and traditional practices contributes to sustainable and equitable development and proper management of the environment.” The declaration recognizes the rights of the tribal

people to protect and promote their traditions and cultures in order to manifest their past, present and future. States have an obligation to provide redress cultural property taken without their free or prior consent or in violation of their laws, culture or tradition.

- **Article 13:** This article recognizes the rights of tribal people to revitalize, use, develop and transmit to future generations their tradition, history and culture etc.
- **Article 32:** It states that indigenous people have right to maintain, control, protect and develop their cultural heritage, traditional knowledge and traditional cultural expressions, as well as the, manifestations of their sciences, technologies and cultures, including human and genetic resources, seeds, medicines, knowledge of the properties of flora and fauna etc.

Access to benefit sharing of TK and Convention of Biological Diversity and Nagoya Protocol

UN Convention on Biological Diversity, 1992, is the first multilateral treaty which recognizes the role of traditional knowledge. It also recognizes the practices of local and indigenous communities for sustainable development and biodiversity conservation.

Nagoya Protocol was adopted on 29 October 2010 in order to fulfil the objective of fair and equitable sharing of benefits arising from the utilization of genetic resources.

Some of the things which have been mentioned in the protocol are- interrelationship between genetic resources and traditional knowledge for the conservation of biodiversity and the sustainable use of its components and for the sustainable livelihood of these communities.⁸³

The protocol provides great transparency to the user as well as the providers of the genetic resources. Not only this, the protocol gives access to traditional knowledge to the local and tribal people when it is related to the genetic resources. These provisions are made for the benefit of tribal and local people so as to strengthen their traditional knowledge.

➤ **Article 5** of the protocol speaks about the sharing of the benefits derived from the utilization of genetic resources and the profit gained after the application and commercialization of the sources by the parties.⁸⁴ It is ensured that the parties take the required administrative and legislative measures so that benefits arising from the genetic sources be shared in a fair and equitable manner to the local and tribal communities.⁸⁵

⁸³ Preamble, Nagoya Protocol 2010.

⁸⁴ Article 5, Nagoya Protocol

⁸⁵ *Id.*

➤ **Article 6:** This article speaks about the access to the genetic resources for utilization after the prior consent.⁸⁶

➤ **Article 7:** This article required the parties to take prior and informed consent from parties and involved them into it before utilizing the resources.

Thus, the Nagoya Protocol encourages the conservation of Biodiversity, thereby balancing the interrelationship between the local communities and the genetic resource.

RECOMMENDATIONS

Traditional knowledge is a significant asset that should be maintained since it is the foundation of indigenous and local population's livelihoods. Traditional knowledge also helps the Indian economy since much of the tested traditional knowledge utilized to make novel products have economic worth. Agriculturalists preserve and protect biodiversity and implement sustainable farming methods using traditional knowledge.

1. The documentation of traditional knowledge reduces the risk of bio-piracy since it protects native traditional knowledge from third-party exploitation and misappropriation of our goods. As a result, the Traditional Knowledge Digital Library (TKDL) must be updated regularly, and a headquarters should be maintained by a team from either the central / or state governments.

2. All intellectual property laws in India may be amended to safeguard that any information that is a part or outcome of TK is not protected through patents, designs, or trademarks.

3. Commercialize specific forms of traditional knowledge and distribute the rewards of commercializing traditional knowledge equally.

4. Promote ecological protection and management utilization.

5. Prevent traditional knowledge from being misused.

CONCLUSION

Traditional knowledge is frequently a significant aspect of a person's cultural identity, and it

⁸⁶ Article 6, Nagoya Protocol

has played a vital role in the vast majority of people's everyday lives. Millions of people in impoverished countries rely on TK for their food security and health. It is also critical to preserve the rich culture and legacy in the form of folklore and designs, among other things. A sui generis legislation is widely suggested as a mechanism to effectively conserve traditional knowledge however policies and ideas like the National IP Policy, Digital India, and Start-up India would save the rapidly disintegrating traditional knowledge system until a law is established. To safeguard the survival of species and mankind, it would not be erroneous to suggest that the current generation will be required to assist in the preservation of the valuable information of a passing generation.



Approaches to Intellectual Property: A Pluralistic Account

*Abhay Raj Mishra & Rishabh Shukla*⁸⁷

ABSTRACT

The nature of Property Rights is such that it secures several individual interests ranging from securing housing to providing pet companionship. The idea of Property developed with time and with time the nature of such rights changed. It was realised that there were interests that were required to be protected that went beyond the intangible things. The 'Intellectual Property' refers to a loose cluster of legal doctrines that regulate the uses of different sorts of ideas and insignia. The philosophers studied such interests and gave their opinion and developed them. The idea of such a property which would protect the interest in intangible things (like written ideas), was expanded by great philosophers like Immanuel Kant, J.S Mill, Hegel, Marx, etc. The nature of the Intellectual is such that it cannot be justified by one approach. It is pluralistic in nature. The aim of the paper is to analyse the different Jurisprudential approaches to the Intellectual Property. The authors aim to establish the relevance of the different approaches in the present times.

Keywords: Jurisprudence, Intellectual Property, Property Rights, Justice.

I. INTRODUCTION

The role of Intellectual Property is de die in diem in our economy and society. The origin of Intellectual Property dates back from 500 BCE where the chefs of the ancient Greek colony of the Sybaris were granted monopoly to exploit new recipes from the Chefs for one year.⁸⁸ Another instance which can relate to the origin of Intellectual property can be traced back from first century C.E. where the Roman Jurists had discussed about the various interests of owners in relation to their Intellectual Work. A few centuries later in 1432, the Senate of Venice introduced a law providing monopolies to those inventing any machine or any process which

⁸⁷ B.A. LL. B (Hons.), 4th & 5th Year (resp.) Maharashtra National Law University, Nagpur.

⁸⁸ Curtis Reid v. Clarice B. Covert, [1957] 701 U.S. 351, 487.

could enhance the production of silk.⁸⁹ Therefore, invention and ideas started acquiring protection under laws and the inventors acquired certain rights over their product.

During the times of European reformation in sixteenth Century, the system of protecting the invention, ideas, art, and craft became stricter due to the advent of printer's guild. Licenses were granted to these guild members who bought manuscripts from the authors for a onetime fee, and then all the sales profits went to the printers.⁹⁰

With the rapidly developing world and globalization spreading its wings, there was a huge influx of readers and demand for literature put a strain on the current system of guilds and a new supply of writers arose. Now these authors did not only want the right of authorship, but they also demanded for the shares off profits from the sales. The increasing demand of literature also reared piracy, cheap reprints by those who didn't hold the authority to print. Such problems gathered immediate attention by the lawmakers and philosophers and the process of development of Intellectual Property Laws started to promote the progress of science and arts.⁹¹ But today, there are numerous disputes regarding the scope, implementation, and interpretation of Intellectual Property since its emergence.

Currently, the Patents laws are protecting various new discoveries and professional inventions whereas the Copyright Law is to safeguard certain forms of expression covering computer software, movies, novels, etc. Similarly, the Trademark laws are to safeguard the words or symbols that are registered to identify a particular product or company. The right of Publicity is to safeguard a personality's right in their names, images, and other identities. The importance of such legal implications is rapidly increasing, and fortunes of various occupations are heavily dependent on intellectual property laws.

In the last two decades, many conundrums have arisen regarding the patenting of animals, plants, computer screen displays, computer chips, recorded music, sports telecasting, and various other things. For a healthy discussion on Intellectual Property as it can be noticed that IP laws are at its developing stage in many parts of the world, it is of vital importance to have proper account of the jurisprudence and justification of the IP laws. The interpretation and justification of the IP laws and polices is mostly based upon two major approaches of

⁸⁹ Elizabeth Verkey, *Law of Patents*, (1st edn, Eastern Book Company, Lucknow 2005) 2.

⁹⁰ Carla Hesse, *The Rise of Intellectual Property, 700 B.C.-A.D. 2000: An Idea in the Balance*, 26-45, *Daedalus* (131st ed. 2002).

⁹¹ *Id.*

libertarianism and utilitarianism.⁹² This article will at length discuss the application of these theories and then will also throw light upon certain approaches that helps in interpreting the IP laws.

II. UNDERSTANDING INTELLECTUAL PROPERTY

The idea of '*property*' is fundamentally ingrained in our standard life and articulation. Property in general is regarding ownership of things. Ownership sequentially is about our rights to possess or use things. Law and economic scholars, particularly, argue that property rules serve only to provide a background license that helps as a footing for future exchanges. So, with this perspective, it can be said that property is nothing but a series of personam legal obligations.⁹³

Property typically carries some liberties (to use and possess), powers (to sell their property), claims (to prohibit others from trespass) and immunities. Property rights are important because they determine use of resources. Property rights comprise of a set of formal and informal rights to either use or transfer resources. One of the functions of state is to describe, interpret and impose property rights. Although, Property rights contain right to possession, but it is not always the case. For instance, if government agents take possession of a stolen government property from a thief who confesses to have stolen it, there will be no violation of property rights.⁹⁴ Also, various laws can prohibit the homeowner from unnatural use of his land.

The incentive of maintaining a value of property increases with respect to the exclusiveness of property rights for an individual or a group. For example, in case of land, value of an asset can be increased by investment, but if the individual or group is cash poor, investment may not be sufficient to maintain its value. In this scenario, ability to invest can be aided if the asset can be used as collateral to secure a loan.⁹⁵

It is often accepted that the expression '*intellectual property*' signifies the right over an intangible object of a being whose mental efforts constructed it. After ideas were considered to be property, it became intellectual property. Since more than one person can have same idea about a particular thing, so intellectual properties are non-exclusive. For instance, more than one person residing at different place can develop same computer program, devise identical

⁹² Peter S. Menell & B. Bouckaert, *et.al.* Intellectual Property: General Theories, (2003).

⁹³ Meredith Render, The Concept of Property, (University of Pittsburgh Law Review 2017) 78.

⁹⁴ Hugh E. Breakey, Two Concept of Property: Ownership of Things and Property, (The Philosophical Forum 42, 2011) 3, 239-65.

⁹⁵ James E. Krier, Evolutionary Theory and the Origin of Property Rights, 95, 139 (Cornell L.R, U. of Michigan Law and Economics, 2009).

machine, derive same business title or symbol etc. IP laws provide people with the exclusive rights and control over things that are non-exclusive. There is a difference between entitlements that make up physical property ownership and one that make up intellectual property ownership. Therefore, it is required to guard the fallacies arising when we say physical property and intellectual property ownership as a non- identical species of same genus. To analyse intellectual property ownership, we first need to realize what it actually involves.

Copyrights, trade secrets, trademarks, license, patents, rights of publicity are categorized under the heading of intellectual property as they comprise of valuable thoughts and creation of mind. Copyright governs specific means of conveying feelings, thoughts, facts, etc. Trademarks prohibit the use of a particular symbol or title that signifies a relation between commercial products and services with their sources. However, trade secrets and patent laws, cover up for information.⁹⁶

Patent protects an information of how to produce copies of an invention or protection a process that could produce a useful result, for example, techniques of Louis Pasteur for pasteurization or Alexander Graham's telephone. Trade secrecy laws also to some extents do similar thing and protect same sort of information but it does so by protecting certain illegitimate disclosure or use of information from those who have acquired it illegally or have been let it on secret, a classic example of Coca- Cola, unlike patents which asks inventor to disclose the information and then forbidding illegal use of that particular information.⁹⁷

The development in intellectual property in west to some extent influenced the evolution of intellectual property rights in India also. The Copyright Act of 1872 was extended to India by East India Company. Indian Copyright Act of 1914 was a modification of British Copyright Act of 1911 which comprised of provisions such as rights of author came up as soon as he completes his work, it also said that protection will be given to the material form and not to the idea by which it was created and gave exclusiveness to the author for his lifetime and even after his death for 25 years.⁹⁸

Apart from the above mentioned, other things can also be regarded as IP such as confidential, personal information, medical history and records, financial records etc. Many companies use

⁹⁶ Arif Hossain, Basic Concept of Intellectual property Rights (IPRs), 9 (Bangladesh Journal of Bioethics, 2018).

⁹⁷ T.G. Agitha, Trademark Dilution: Indian Approach, 50, 339-366 (Journal of Indian Law Institute, 2008).

⁹⁸ Cornish, *supra* note 10.

this private information of individuals and with the desire of enhancing their marketing and advertising. So, if this information of an individual is considered as IP, then, he can use his rights and sue for theft, conversion etc.

Design is also an aspect which is treated as IP and Great Britain was the first country to do so. It was made with the hope of encouraging arts of design and printing linens, muslins, cotton etc. Till 1883, patents, trademarks and design remained separate but after 1905, patent and design law remain together. Plagiarism can also be seen as theft as he has copied the idea and words of someone else without mentioning him and without proper citation. Some might argue that it involves copyright law, but it is not so. For instance, one can just not copy the work directly but can plagiarize all the ideas and thus they would not be guilty of trademark but for plagiarism.

With the growth in society in past few years with respect to technology has blurred the boundaries between different types of intellectual property. The importance of these rules is rapidly increasing in both economic and cultural aspect. Also now, fortunes of many large businesses depend on these cluster of rights said to be as IPR. There are different theories and approaches that should be taken into consideration for a better understanding IP and its evolution. These approaches can also provide with the most suitable methods and ideas in law-making and implementation.

III. THE UTILITARIAN SAGA

The Utilitarian approach generally lays its foundation upon “*the greatest happiness principle*” and it is very important to study the views of utilitarian thinkers like J. S. Mill and Jeremy Bentham to understand the application of utilitarian theory in IPR. The Utilitarian theory is by far the most dominant approach to intellectual property especially in Copyright and Patent laws. As per the extended explanation of the Utilitarian theory, several good actions are done not for the profits of the world but for the benefits and moral rights of the individual⁹⁹ and along the same lines the justification of the copyright laws lies which provides exclusive rights to authors for a limited period to protect their work from duplicate and unauthorised use to promote original literary and artistic work. Similarly, the patent laws provide the investors with the right over certain invention and valuable technology for a limited period. Such exclusive

⁹⁹ J S Mill, *Utilitarianism*, 1863, (Batoche Books, 2001) pp. 20-21.

rights are provided to investors, authors, scientists, and inventors to promote original invention, art, technology, and literature work by maximizing the social utility.¹⁰⁰

As J. S. Mill puts it, “*actions are right in proportion as they tend to promote happiness; wrong as they tend to promote reverse of happiness*” and laws that protect individual rights are important as they uphold greater good of the society.¹⁰¹

Utilitarian argument finds its place in the US constitution and is often justified as well by giving the power to Congress to “promote the progress of Science and the useful arts, by securing limited times to Authors and Inventors the exclusive right to their respective Writings and Discoveries.”¹⁰² This clause of the US Constitution is in conformity with the idea of the utilitarian theory. Following the principle of utilitarian, the copyright and patent laws grant rights to author inventors for a limited scope and time. The logic behind the copyright and patent laws is to acknowledge the work of art, literature, and technology by providing certain individual rights to their authors and inventors thereby overall social good.

Moral theorists are basically categorised by act-utilitarianism and rule-utilitarianism. Act-utilitarianism proposes to perform such action which is likely to promote the maximum social welfare and utility. Rule-utilitarianism proposes to perform acts according to a set of moral rules which promote overall social utility.¹⁰³ Mill was a rule-utilitarian thinker according to whom actions that promote social utility are necessary but at the same time such actions must protect the individual’s rights and liberties.¹⁰⁴ Mill was also of the opinion that it is unjust if a person is deprived of personal liberty, property, rights or anything else which by law belongs to him.¹⁰⁵

The ideas of Mill can be rightly justified when it comes to application to IP rules, pursuant to utilitarianism, the copyright and trademark laws as it saves the rights of inventors and authors by balancing the good or bad consequences in the society. Such rights conferred by the patent copyright rules maximises the overall social utility and encourages the original art, literature, inventions etc.¹⁰⁶

¹⁰⁰ Jeanne Former, Expressive Incentives in Intellectual Property, 98 (Virginia Law Review, 2012).

¹⁰¹ *Supra* at 13.

¹⁰² U.S. CONST. Art 1, § 8, cl. 8.

¹⁰³ S Scheffler, Consequentialism and Its Critics; (ed.), (Oxford University Press, 1988) pp. 293.

¹⁰⁴ J S Mill, Utilitarianism, 1863, pp. 43 (Batoche Books 2001).

¹⁰⁵ *Ibid.*

¹⁰⁶ S Scheffler, Consequentialism and Its Critics; (ed.), (Oxford University Press, 1988) pp. 293.

Another general argument that evolves from the utilitarian view and is also very closely related to Jeremy Bentham's perspective of utilitarianism '*greatest good for the greatest number*' advocate those legal rules and policies which are socially beneficial and also promote economic utility.¹⁰⁷ However, when it comes to application of this theory to intellectual property, the first and foremost question is to determine the most socially beneficial outcome between giving a monopoly (through legal rules, such as intellectual property) of certain product to its author/inventors which legally forbids others to utilize the benefit from it; and to not consider such property rights at the peril of discouraging art and innovation. The creation of artistic works, literature and technological innovations is mainly for the advancement and benefits of the society at large, however, utilitarian justification of the intellectual property laws also advocates the idea of providing the appropriate rights and benefits to the creators for their efforts.

Despite of being widely accepted as a dominant theory of intellectual property laws, the utilitarian model has faced certain criticisms. The general question which is still under critical analysis of many jurists and legislators is - *whether the status quo laws of intellectual property are in their best form to protect the greatest good of the society or is there a scope to make the laws socially more beneficial?*

Another problem with utilitarian perspective is that the theory does not provide a detailed account of rights of individuals; the theory rather focuses upon what is desirable or what the result that is beneficial for overall social utility. Also, moral rules are well defined and elaborated in this theory and it is generally contended that these moral rules are designed in a manner to protect individual rights and distributive justice.¹⁰⁸ However the idea of utilitarianism rests upon desirable outcome and moral rights; it is not a theory of individual rights and distributive justice. The utilitarian theory is centralised to moral rules and these moral rules primarily focus upon net gain of the society rather than focusing upon distributive justice and the individual rights. On the contrary, intellectual property laws has its roots connected to the idea of individual rights and distributive justice and at the basic of the intellectual property laws, it can be observed that the utilitarian view does not have a direct right.

¹⁰⁷ Jeremy Bentham, *An Introduction to the Principles of Morals and Legislations*, (chapter V, 1988).

¹⁰⁸ *Supra* note at 20.

Further, taking an example from the recent pandemic times, we see that many of the pharmaceutical companies are developing a vaccine for SARS-CoV-2. Such a vaccine is a need of the world and what is required is that once it is developed, its production must be in such a manner that it reaches to most of the people in least of the time. But, once a vaccine is developed, it will be certainly governed by certain patent and pharmaceutical laws and such laws would limit the production of the vaccine to safeguard the rights of the developers. However, as per the utilitarian theory, it should be the interest of the people that should be given priority and the people's interest here lies in the rapid production of the vaccine and timely procurement of the same. Further, the patent laws would not only limit the production, but it will also delay the procurement of the vaccine. Therefore, in certain aspects like these, the Utilitarian theory fails to provide a convincing ground. Further in the matters of trade secrets, personality rights, the approach of utilitarian views does not hold a very strong ground as the theory follows the propaganda that the secrets must be disclosed if there is a public interest involved, however this approach has many discrepancies if we relate it to the idea of trade secrets.

IV. THE LIBERTARIAN PERSPECTIVE

John Locke, a 17th century philosopher, came up with the natural rights justification for private properties that remains as a strong and central pillar in modern property rights theory. His development of the libertarian approach theory was expanded by modern philosophers like Rothbard, Palmer, Spooner etc. Although Locke made many thoughtful claims in his justification, but it will be an overstatement to say all his discussion clear. He said that the labour of one's body and work of his hand should be called as his. In general, this means that if a person founds unknown land, clears it, cultivates crops, builds a house, and obtains a property right by engaging in these activities.¹⁰⁹

He believed that at the beginning, everything that nature provides is common to all but as one applies his own labour or something of his own to it, thereby making it his own. He openly and constantly uses what appears to be a metaphor such as image of mixing labour with physical objects without disclosing any non-literalist intention.¹¹⁰

¹⁰⁹ Adam D. Moore, *A Lockean Theory of Intellectual Property Revisited*, 49, 1069, (San Diego Law Review, 2012) pp. 1075-76.

¹¹⁰ Menell, *supra* note 5, at 157-58.

Locke claims that human have natural rights to liberty, life and property and the sole purpose of government should be to protect these rights.¹¹¹ His theory said that all these legal rights are based on moral right.

Locke's theory can be better understood as '*no harm, no foul principle*'. Any legal obligation or restriction is valid only if violates another person's natural rights. When a person takes a glass of water from a river it is as if he takes nothing at all. Others will not be affected by this acquisition at all. This is '*enough and as good*' proviso defined by Locke. In a same way, in terms on intellectual property, an invention or a discovery takes a lot of time, labour, skills and efforts. For instance, creating a poem and keeping it as a secret does not prohibit others from making their own poems. This libertarian model believed that all creations of a human mind such as literary works, inventions etc. should be freely accessible and can be utilised by anyone.¹¹²

Rothbard argued that libertarians acknowledge the implementation of legal contracts by the idea that we should be bound and must follow the agreement which we had entered freely, and without any coercive interference with anyone. Rothbard supported theory of copyright, that if an author in his agreement properly conditions the sale of his work '*not to reproduce or recopy this work for sale*' then this arising copyright protection will be completely valid and legal on the libertarian grounds. Rothbard distinguished between two types of intellectual properties that is, copyrights and patents. Unlike Copyrights, he claims that patents are invalid and contradictory to free market as they go beyond copyrights that are by providing protection beyond of the original legal contracts. For him, if another person invents something independently, he will be perfectly able to use and sell it on the free market.¹¹³

Spooner argues that only tangible and physical objects are not the one that has value, but ideas should be seen as labour. He compares ideas to 'new forms and beauties' that human labour gives to physical objects. For Spooner, property rights can and must extend beyond physical objects that the acquisition of property relies upon something that cannot be physically touched or seen, i.e., human efforts.¹¹⁴

¹¹¹ Garima Gupta et al. Avih Rastogi, Intellectual Property Rights: Theory and Indian Practice, (Centre for Civil Society, New Delhi, 2002).

¹¹² *Supra* note at 23.

¹¹³ David S. D' Amato, Libertarian view of Intellectual Property: Rothbard, Tucker, Spooner and Rand, Libertarianism (May. 28, 2014), <https://www.libertarianism.org/columns/libertarian-views-intellectual-property-rothbard-tucker-spooner-rand>.

¹¹⁴ *Ibid.*

Even though these theories appear to be ideal, but its application of enforcement in reality is to some extent a formidable task. We must realize that laws, in context of property, are outcome of the moral unanimity among people. Whereas Intellectual property laws did not derive in nature but people living in civil societies slowly and progressively converged to them. Secondly, the market has developed methods to prohibit piracy and imitations. But with the evolution of technology, people will somehow always find a way to duplicate which eventually will lead to chaos in society and thus society will have to adopt and enforce a system of intellectual property rights whether it be legally or through mutual consent.¹¹⁵

Also, it is not entirely coherent whether Locke's labour theory supports any of the intellectual property rights. The question arises that why should the labour upon a resource that has been held common, entitle a labourer to claim property rights in the resource itself. Above all, most of the inventors and authors work very hard and their intellectual labour is much more crucial in the total value of a creation than the raw materials they have employed. Locke suggests that a property one acquires from his labour over a resource held in common must last forever, that is, are inheritable and devisable for indefinite period. On the other hand, unlike physical property, most of intellectual property expires sooner or later.¹¹⁶

Another problem regarding these theories is that it does not provide clarity on distribution of intellectual credit. Many intellectual works such as writing papers, movie scripts, scientific experiments have more than one person involved, and the problem arises that arises is credit cannot be always given based on labour. For instance, in an experiment there are many technicians are involved under a senior investigator, technicians might work for more than 100 hours but senior investigator only contributes in 4% of the total labour, but it can be argued that senior investigator should be given the credit of first author despite of labour applied in the work.

V. HEGEL'S APPROACH TO INTELLECTUAL PROPERTY

One of the justifications of IPR is through *Personality theory*. As claimed by this theory, any invention or work done by its inventor or author belongs to him or her because it depicts his or her personality. This theory, to some extent, seems to protect intellectual property from criticisms based on utilitarian approach. So far, it can be said that utility approach rejects natural rights and acknowledges property only with respect to achieving social goals of utility

¹¹⁵ Gupta, supra note 2.

¹¹⁶ William Fisher, *Theories of Intellectual Property*, (Harvard University, 1987).

or for maximization of wealth. This personhood justification of intellectual property derives mostly from Hegel's philosophy of rights and has been further explained with respect to modern context by Radin. It can be said that Hegelian theory looks notably like Lockean theory except for the fact that in Lockean theory, labour is mixed with an external thing while in Hegelian theory, one's will, or personality is mixed with an external thing. As personality has one of the central roles in Hegelian theory, it is said to be as Personhood theory.

In most specific form, it can be said that an idea is owned by its creator as it is exhibiting his or her own personality or self. Its main objective is that to achieve a proper development, to be a 'person' and achieve 'individual freedom' particularly, one needs to have a certain control over the resources that are present in the external environment. A person can describe his or herself only by manipulating or controlling external objects or environment and disavowing a person's right over a property is same as restricting his or freedom.

Hegel gives more priority to individual will than external property, which is the '*manifestation*' or '*actualisation*' of that will. Hegel says that when a person expresses himself through his property or work to the society, it is nothing but the manifestation of his own personality thus providing him status of a person and individual freedom. Hegel's Personality theory can be used to justify the claims by artists, writers, musicians etc. for instance, a writer's personality or will is manifested through his or her work.¹¹⁷ A book, which is an external property, written by an author is manifestation of his inner personality, i.e., feelings, emotions, experiences etc. and so it justifies the right of the author over that particular property.

We need property to express ourselves in the world and personhood theory also known as self-expression theory resolves the property in question which reflects person's unique knowledge, skill, genius etc. If a person has devoted him or her "*self*" into a work or object, then that object or work, without any doubt, should be his or her property.¹¹⁸

On the other hand, there underlies several shortcomings and disagreements in this theory. Personhood or self-expression theory, like labour mixing theory, works mostly when there is a single person related to the property. It fails or is not able to provide us with the satisfactory results while dealing with case of collaborative efforts. There is no certain answer of what sort of right should emerge from joint authorship. Personality theory falls short while providing guidance when there is a clash between the creators of how their work should be manifested in

¹¹⁷ Waldron, J. *The Right to Private Property* (Clarendon Press, Oxford, 1988).

¹¹⁸ *Ibid.*

the world. One of the concerns that arise is the conceptions of ‘*self*’ or personhood that we are trying to protect through adjustments in intellectual property, is too thin and abstract to provide many specific questions. Either we need to have a more coherent vision of human nature, which will require addressing such grand questions like the importance of creativity or will to human soul, or this understanding of personhood with respect to culture or time if lawmakers need to answer the questions arising out of disagreements with the theory.¹¹⁹

One of the other problems that arises out of personality theory is that it seems ineffective when used in support of property rights that are produced using automation or intellectual property that are not so clearly expression of individual will or personality, such as industrial process or computer software. In contemporary world, most of the factories have replaced people with machines. Today even music, arts and animations etc. are generated through computer. Although this automation does not completely polish off human expression or personality from creation of information, but it lessens down that unique contribution which sabotages the argument that any product is the reflection of person’s special talent, edge, or creativity. All the above-mentioned arguments, to some extent show that our current IP laws are more concerned with utility or liberty approach than personhood approach.¹²⁰

VI. HOW THESE THEORIES ARE IMPORTANT?

These theories, though cannot provide wholesome account for IPR, are the foundation of the development of modern and advanced IPR laws. The IPR laws must be seen through the prism of the principles laid down in these theories. The common idea and objective that has been talked about by many of the philosophers and lawmakers is to strike a balance between the rights and interests of the inventors/service provider and the interest of the public who are the consumers. What one can notice from the outset is that the matters of intellectual property are a two-way traffic where on one side we have the manufacturers/ inventors/ authors/ publishers etc. and on the other hand we have consumers or users. The initial intent that leads to the formation of the modern intellectual property laws was to promote the skilled arts, literature, inventions, creative works, etc. and to motivate and lure the artists, scientists, skilled workers, such intellectual property laws were formed with the objective to provide the desired incentives for their works, and this would lead to the promotions of art and invention.

¹¹⁹Peter S. Menell & B. Bouckaert & G. Geest, *Intellectual Property: General Theories*, (2003).

¹²⁰ *Ibid.*

However, it must be noted that the public and societal interest cannot be compromised to fulfil the interests and incentives for the promotion of art and literature. It is evident that these approaches although do not provide a complete prescription of intellectual property laws, but it cannot be ignored that these approaches are the guiding light to strike a balance between the rights of the inventors/manufacturers and rights of the consumers and that is why IP laws become important, but such laws shall not encroach upon the interests of the society.¹²¹

If we take a sharper view, *the ideas laid down in these theories come under the wider ambit of natural justice*. The above discussion on these approaches helped us to know the rights and interests of the inventors and artists and why it is important to provide them the incentives for their work by safeguarding these rights. On the other hand, we had a detailed discussion on the importance of determining the utility of the consumers and users and why balancing both these sides are of importance. Therefore, these theories become much relevant in invoking a conversation amongst the lawmakers and the academicians on the law-making process and fitting a balance between the consumers and producers.

We see that the utilitarian view widely discusses the utility and rights of the consumers and on the other hand the libertarian approach strongly supports the rights and autonomy of the producers. Why the lawmakers and academicians delve into such theories is because these theories act as a guiding light in drafting the ideal shape of the laws to provide a right balance so that they well be implemented within the current market regulations.

For example, the newly evolving Publicity Rights or Celebrity Rights which is to put on control on the commercial use of the identity of a person without his/her consent. These laws are made to safeguard the publicity rights is believed to be primarily based on the privacy approach which promotes corporate or personal privacy. However, a proper inspection of such laws all around would certainly show that these laws do not exclusively follow or rely upon the privacy approach. It is so because privacy approach is clearly extreme which is not fit for efficient market regulations and laws evolving out of such extreme privacy views would lead to an imbalance between the producers and users.¹²² That is why the lawmakers also investigate the utility of market players, the contractual agreements, convenient market regulation etc. for a better facilitation of such laws.

¹²¹ D.B. Resnik, A Pluralistic Account of Intellectual Property, 46, 319-335, (Journal of Business Ethics, 2003).

¹²² Samuelson, Privacy as Intellectual Property? (Stanford Law Review, 2000), pp. 1125-1172.

Rigidly following a single approach would evolve such laws that would be tough to fit into the current market regime. Therefore, this paper advocates the idea of pluralistic approach to pitch the right balance between the consumers and producers/manufacturers for efficient market regulations. Also, it provides the correct measures to the rights of the manufactures/producers/inventors and at the same time it also eyes to uphold the overall public interest in the law-making process.

VII. CRITIQUES OF THE PLURALISTIC APPROACH

As we have already reviewed the different approaches and their importance with respect to each other. The crux of the above discussion clearly shows us that different approaches have different values which mostly are autonomy, justice, freedom, and utility. Now, apart from the point that other approaches provide an inadequate account of IP, there are two other most important factors for assuming and preferring pluralistic approaches. Firstly, the IP is highly diverse such as it includes trade secrets, patents, economic interests, interests in authorships etc. Second reason is that modern society is pluralistic in nature. People have different moral, cultural, religious beliefs and provided this diversification, it is highly unrealistic that “*one size would fit all approaches*”.

However, before concluding this paper, we must address the objections raised by critiques on the pluralistic approach. First major objection raised with respect to this approach is that it is inconsistent as it gives priority to different values in different situations. There should be a ranking system to achieve consistency for which pluralism fails to do so.¹²³ To answer this objection, it must be said that although pluralism provides priority to different values in different situation, it still is consistent as it provides us with a principled reasoning for shift in priority of values. Consistency in moral reasoning clearly has a requirement that similar cases should be treated similarly and different cases differently. The second objection raised by critiques is that Pluralism includes too many values in IP Law thus making it unnecessarily complicated. Therefore, it is not a very useful guide to policy formation. Now, with respect to this objection, it must be said that although pluralism is complex than other approaches, but it is still practical. Social policies are not very often framed in simple terms of *costs v. benefit*. Policy makers must wrestle competing basic values and even though balancing competing values is not so simple, but it is still realistic and practical.

¹²³ Beauchamp, T.L. and Childress, J.F. Principles of biomedical ethics, (5th Edition, Oxford University Press, Oxford, 2001) 59.

VIII. CONCLUSIVE REMARKS

In summary, this research paper has analysed and critiques different approaches to Intellectual Property and further argued or rooted for a pluralistic approach. According to which, different types of fundamental moral values such as autonomy, justice, utility, play an important role in making IP laws and policies. To dispose of arising disputes, one must weigh and consider different values in accordance with particular facts. The paper has also further provided two major reasons why pluralism provides best account of IP, which are, firstly, that IP is diverse in nature and secondly that the society is diverse as well and people accept different moral and philosophical beliefs.

Since, Intellectual property is rarely justified on one theory and we live in a pluralistic society in which different people want to control information for various reasons, a pluralistic approach is politically, morally and technologically realistic, sound and practical.



Case Comment: Lupin Limited V. Johnson and Johnson

*Harshita Shukla*¹²⁴

ABSTRACT

The business undertaken by the plaintiff company is that of manufacturing, marketing and selling pharmaceutical products. The defendant company is also engaged in the business of manufacturing, marketing and selling of pharmaceutical products. Plaintiff has independently conceived and adopted a distinctive mark "LUCYNATA" and registered it in class-5 of Fourth Schedule 2 to the Trade Marks Rules, 2002 on 9th March 2012 from 20th August 2012.¹²⁵ A new drug was invented by the defendant named "TAPENTADOL" and he got registered a distinctive trademark "NUCYNTA" for it.¹²⁶

The plaintiff filed a suit against the defendant claiming for the ad interim relief in the form of injunction on the ground of infringement of the trademark, and seeking from the court to restrain the use of the alleged mark by the defendant, since it is infringing the plaintiff's registered trademark "LUCYNATA". The plaintiff has also taken out notice of motion for certain reliefs during the pendency of the suit and also moved this Court for grant of ad-interim orders.¹²⁷

Before deciding whether or not there exist infringement of the trademark, the court considered it necessary to dwell upon the view taken by the Division Bench of this Court in Appeal in M/s. Maxheal Pharmaceuticals v. Shalina Laboratories Pvt. Ltd. that when the court is at the stage of considering whether or not to grant interlocutory orders with respect to the Trademark it is not for the court to dwell into the question of validity of the mark so long the mark remains on the register whether rightly or wrongly.¹²⁸

The provisions relevant to the discourse in this case were Section 27, 28, 33 and 31 of the Trademark Act, 1999. Section 27¹²⁹ provides that any proceedings for the prevention or

¹²⁴ B.A. LL.B. (4th Year), Chanakya National Law University, Patna.

¹²⁵ Lupin Limited v. Johnson and Johnson <https://indiankanoon.org/doc/197290730/>

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ S. 27, Trademarks Act, 1999, Act No. 47 of 1999 (India).

claiming damages with respect to the infringement of an unregistered trademark cannot be instituted however it is subject to the exception of the suit for passing off, giving effect to which sub section (2) of the provision provides that any person who is passing off his goods or services as that of another person can be taken action against by such another person. Section 28¹³⁰ provides for the rights that emanate to the registered proprietor, as a result of the registration which are basically the exclusive right to use and obtain relief upon infringement of the trademark with respect to the goods and services it is registered for. These rights though exclusive are subject to the conditions or limitations to which the registration is subjected.

Next relevant provision in the case is Section 31(1)¹³¹ which provides that the registration and the subsequent assignments of it are the evidence prima facie of the validity of the Trademark. Section 33(1)¹³² gives out a limitation on the right of instituting proceedings by placing a bar on seeking declaration or opposing the use thereof by a subsequent registered proprietor of the trademark (allegedly committing passing off thereby) if he doesn't exercise such right within 5years of being aware of that use and acquiesces for a continuous period, unless the registration was not applied in good faith.

Section 30(1) (d)¹³³ also referred to by the court for reaching to the conclusion the relevant part of which provides that some acts as mentioned in the provision do not constitute infringement.

ARGUMENTS

It is the contention of the plaintiff that the plaintiff has singly conceived and espoused a distinctive mark "LUCYNATA" and registered it in class-5 of Fourth Schedule 2 to the Trade Marks Rules, 2002 on 9th March 2012 from 20th August 2012. It is the contention of the plaintiff that the defendant would be committing an act of infringement by using the impugned mark "NUCYNTA". In this demesne, the plaintiff has come up with this injunction suit to cause the defendant to cease the usage of the trademark NUCYNATA by him in the wake of the resulting infringement of the trademark LUCYNATA of the plaintiff.¹³⁴

¹³⁰ *Supra* note 129, s.28

¹³¹ *Ibid.* 5 §31(1)

¹³² *Ibid.* §33(1)

¹³³ *Ibid.* §30(1)(d)

¹³⁴ *Supra* note 125.

As against this, it is the case of the defendant that a new drug TAPENTADOLE was invented by them and registered under the trademark of the NUCYNTA back in 2008 itself in the international market. The defendants contend that their trademark has been registered in various countries much before the plaintiff's trademark LUCYNTA was registered in India. So a rather logical approach is that actually the Plaintiffs have infringed the trademark of the defendants by deceptively imitating. It is their stance that the adoption of the plaintiff itself being deceptive leaves no scope for getting relief to them. The defendants also brought the fact to the light that the plaintiffs have instituted the suit of passing off already in Delhi High Court against them which is still pending.¹³⁵

The plaintiff argued that the defendants by passing off their goods as their own are deceiving the public and thereby hurting the reputation and goodwill of the plaintiff already established taking advantage of the legal technicalities. The defendant to this argued that the plaintiff doesn't hold currently any registration to the trademark claimed by them while the defendants do. Therefore they have the absolute rights to use it and no injunction can be claimed against them.

Lastly, it was argued by the plaintiff that being the imitation of their trademark, the defendant's trademark is not valid.

CASES CITED

The court majorly referred to four cases namely N R Dongre v. Whirlpool Corp.¹³⁶, Milmento Oftho Industries and others v. Allergan Inc.¹³⁷, Lowenbrau AG v. Jagpin Breweries Ltd.¹³⁸ and Marico Limited v. Agro Tech Foods Limited.¹³⁹ Before advancing to the cases cited the court first and foremost considered the judgment of the court in Hindustan Embroidery Mills Pvt. Ltd. V. K Ravindra and Co.¹⁴⁰, where it was held that "it is not the practice of this court to consider the validity of registration of a trade mark on a motion for interlocutory reliefs taken out by the person who has got the mark registered in his name. While a mark remains on the register (even wrongly), it is not desirable that others should imitate it. Moreover

¹³⁵ *Supra* note 125.

¹³⁶ 1996 PTC (16) 476

¹³⁷ 2004 (28) PTC 585 (SC)

¹³⁸ 157 (2009) DLT 791

¹³⁹ 2010 (44) PTC 736 (Del)

¹⁴⁰ (1974) 76 BOMLR 146

the respondents have already applied for rectification of the registration in favour of the American Remedies."

In *N R Dongre v. Whirlpool Corp.*¹⁴¹ the Whirlpool Corp. undertook the business of manufacturing, selling and servicing of washing machines registered under the Trademark Whirlpool in India which due to some reason had lapsed but notwithstanding the lapse of registration, the trademark was used in India through sale of its washing machines to U. S. Embassy and U.S.AID offices in New Delhi and also through advertisements in various publications having a circulation in India. It also had entered into a JV with TVS for which the same trademark was sought and the company had the trademark as its global reputation since years. However, upon an application by M/s. Chinar Trust the registrar registered the trademark in its name. The plaintiff filed an infringement petition for cancellation and removal of the said registration where the matter went into appeal and the court held that action for passing off against any subsequent user of an identical trade mark, including a registered user thereof is maintainable. Applying this principle, the court came to the conclusion that the appellants have acquired reputation and goodwill in respect of its goods bearing trade mark 'WHIRLPOOL' in this country. The appellants have been using the trademark WHIRLPOOL despite having no connection at all with the defendants. Prima facie it appears that buyers are likely to be deceived or confused as to the origin and source of the goods. It will cause them to believe the fact that the products have been manufactured by the respondents which is not true. Therefore the interim injunction at the instance of Whirlpool Corp. against the registered proprietor is maintainable.

In *Milmento Oftho Industries and others v. Allergan Inc.*¹⁴², the court had to consider the matter of injunction based on the passing off with respect to OCUFLOX, an eye care product, of which the plaintiff was the prior user marketed the same in various countries worldwide and sought registration therein. The court here recognized the global characteristic of the drugs and medical products produced nowadays and admitted that there are various forms of literature which make the medical inventions known to all worldwide so allowing a trademark for a product which is already known worldwide having an identical trademark would be the infringement of it. However the judgment was qualified by the opinion of that court that "Multinational corporations, who have no intention of coming to India or introducing

¹⁴¹ *Supra* note 136.

¹⁴² *Supra* note 137.

their product in India should not be allowed to throttle an Indian Company by not permitting it to sell a product in India, if the Indian Company has genuinely adopted the mark and developed the product and is first in the market. Thus the ultimate test should be who is first in the market.”¹⁴³

The court in the case of Lowenbrau AG v. Jagpin Breweries Ltd.¹⁴⁴, an injunction application by the plaintiffs, manufacturers of beer under the registered mark "LOWENBRAU", came before the court on the ground that defendants undertake the same business under the mark "LOWENBRAU BUTTENHEIM" infringing their proprietary rights on the trademark. The court here held that in a bid to decide whether or not to grant injunction, a tentative view on the question of the validity of registration is required but the final decision is that of the court and in that respect, the registration is neither conclusive proof nor binding on the court. Onus however, will be on the party which questions validity of registration to show that the registration is prima facie and tentatively bad or invalid.”

In Marico Limited v. Agro Tech Foods Ltd.¹⁴⁵, the plaintiff was using the trademark LOSORB and the defendant used the trademark LOW ABSORB against which the plaintiff filed a suit for injunction on the ground of passing off. Here also the court held itself entitled to venture into the question of validity at the stage of interim relief.

JUDGMENT

The court interpreted the provisions involved so as to find the standi of prior user to question the registration in favour of current registered user. Section 28(1) begins with the words, “subject to other provisions” which make it unmistakably clear that the rights conferred thereunder are not absolute and is subject to other provisions which, as further is clarified by the reading of the statute, is section 27(2) of the Act, which provides that any person who is passing off his goods or services as that of another person can be taken action against by such another person. Thus, section 27(2) holds an overriding effect over section 28 and all other provisions. Similarly section 33, laying down a limitation on the right of instituting proceedings, by placing a bar on seeking declaration or opposing the use thereof by a subsequent registered proprietor of the trademark (allegedly committing passing off thereby),

¹⁴³ *Supra* note 137.

¹⁴⁴ *Supra* note 138.

¹⁴⁵ *Supra* note 140.

if he doesn't exercise such right within 5 years of being aware of that use and acquiesces for a continuous period, unless the registration was not applied in good faith, saves vested rights of a prior user. Thus the right created by section 28(1) of the Act in favour of a registered proprietor of a trade mark is not an absolute right.¹⁴⁶ Placing reliance on section 28(3) of the Act the learned counsel for the appellant contended that when two registered proprietors of identical or near similar trademarks cannot be deemed to have acquired exclusive right to the use of any of those trade marks against each other, how can an unregistered user of the trade mark maintain an action for passing off against a registered user of the same mark and seek an injunction restraining him from using it. Answering this contention of the defendant that being registered gives those unquestionable absolute rights to use the trademark, on the basis of the above reasoning court also said that the registration of a trade mark under the Act is an irrelevant consideration in an action for passing off. Now as to the question whether the grant of injunction in favour of plaintiff will be in consonance with the settled principles the court cited an excerpt from *NR Dongre v. Whirlpool Corp.*, which meant that injunction is an equitable relief so if a mark is used by the plaintiff for a long time which has established a worldwide (transborder) reputation in favour of the plaintiff then wherever used it will give the impression of being originated from the plaintiff only and thus defendant's act of using the same trademark is nothing but passing off and creating confusion in the minds of the consumers even though plaintiff's mark is unregistered. Thus, the injunction can be granted.¹⁴⁷ The court in this case adopted the reasoning propounded in the *Whirlpool* case and found no ground to take a different view and thereby interfere with the injunction order.¹⁴⁸ The court thereby agreed with the contention of the plaintiff that defendants are actually deceiving the public by depicting the trademark similar to that of the plaintiff's with respect to the goods similar or identical to that of the plaintiff.

The court adopted the principle laid down in *Marico Ltd. Case* that looking into the validity of the registration is very well accepted practice by the courts.

The Full Bench of this Court in *Abdul Cadur Allibhoy v. Mahomedally Hyderally*¹⁴⁹ has taken a view that the plaintiff, who himself has imitated his mark from somebody else's mark, is not entitled to an equitable relief of injunction. In this case, the plaintiffs' label was designed by combining the labels of four other manufacturers and therefore were so unoriginal in

¹⁴⁶ *Supra* note 125.

¹⁴⁷ *Supra* note 136.

¹⁴⁸ *Id.*

¹⁴⁹ 1901 (3) Bom.L.R. 220

their origin and conception that no relief could be granted on the basis of it. The court answered the question as to the entitlement of the plaintiff to an injunction against the defendants was answered negatively on the basis of the principles stated by Lord Westbury in the *Leather Cloth Company Ltd. v. The American Leather Cloth Company Ltd.*¹⁵⁰ The same was held in the case of *M/s. J. K. Sons v. M/s. Parksons Games & Sports.*¹⁵¹ These judgments have led the court to draw the conclusion that if the registered proprietor has himself imitated someone else's trademark then they can't have absolute enjoyment of rights under S. 28(1). The court on the basis of *Maxheal* and *M/s J. K. Sons* judgment clearly held that "an action for passing off would lie at the instance of prior user even against the registered user."¹⁵²

The effect on the Indian economy of the liberalization, privatization and globalisation cannot be totally ignored even under the Intellectual Property regime. At the same time, it also cannot be ignored that technological advancement has put the worldwide information and knowledge on the fingertip and any drug or innovation launched anywhere outside India will be available in India right after being introduced to the general public, via internet and vice versa. This is the fact that local manufacturers, as soon as come to know of any product launched overseas, imitate immediately and get registered in their favour. The perplexing question is whether, even in such a case, the courts would be precluded from considering the question of validity of registration and would be forced to grant an order of injunction in favour of the registered proprietor of the trademark merely on the ground that the Court cannot go into the question of validity of registration so long as the mark remains on the register whether wrongly or rightly. Going as per the judgment of *M/s.Maxheal Pharmaceuticals v. Shalina Laboratories Pvt. Ltd.*¹⁵³, the courts would be bound to grant injunction in favour of the registered proprietor.¹⁵⁴ Thus here again the court agreed with the contention of the plaintiff that they first started using the trademark in the world market therefore using a deceptively similar trademark is violation of plaintiff's rights.

The important factor which has been directed to be taken into consideration in such matters by the Apex Court in the case of *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*¹⁵⁵ of ensuring public interest, if the injunction is to be granted in favour of such fraudulent

¹⁵⁰ 4 De. G.J. & S. P.144

¹⁵¹ 2011 (113) BLR 1150.

¹⁵² *Supra* note 125.

¹⁵³ Appeal No.88/2005 in Notice of Motion No.2638/2004 in Suit No.2663/2004 dated 16th February 2005

¹⁵⁴ *Supra* note 125.

¹⁵⁵ 2001 PTC 300 (SC).

and deceptive registered user of trademark. So the court held the judgment of the M/s J K Sons case applicable equally to this action of infringement and passing off, would have the effect of permitting the question of tentative validity of the registration being gone into at the stage of granting injunction.¹⁵⁶ The task of finding whether the plaintiff himself has imitated someone else's trademark or not can't be undertaken without deciding the question of validity. The perusal of section 28 of the Act would also reveal that the protection granted in favour of the proprietor of the registered trademark is on the condition that the said registration is valid.

The court considering the view of the court in M/s J.K. Sons to be more appropriate opined for the Maxheal judgment to be referred to a larger bench and disposed of the matter.

ANALYSIS

Thus, no new right is conferred upon the proprietor by the registration of the trademark than what he already has under common law without registration. The right of goodwill and reputation in a trade mark was recognised at common law even before it was subject of statutory law. The earlier situation was also that no provision for registration existed and the right over the trademarks was obtained by use only. So prior use, going by this reasoning, has the right to save his goodwill and reputation vested in the trademark used by him which for some reason is not registered currently but the business under the Trademark is still continuing. For this purpose he is legally entitled to challenge the registered proprietor for using the identical trademark with respect to the same or similar goods misleading or deceiving the public to believe it to be the goods from the prior user.

It is confirmed by various decisions that the relief if injunction can be granted against the registered proprietor at the behest of a prior user where the latter has established such identity of its own trademark. This principle can't be challenged also due to equity consideration as even the common law under equity would consider it the perfect view and the fact that the intention of all laws is derived from the common law itself gives validity to this principle. The court further confirmed that the question would be as to who was first in the world to begin use the trademark.

The law is that the one who has used a trademark for a considerable length of time and whose goods are thereby known by that trademark, gets a practical derivation in his favour that, he has practically got a right to the use of that mark. It appears to me that it would come

¹⁵⁶ *Supra* note 125.

within the rule *Ex turpi causa non oritur actio*; and if the trade mark contains a false representation calculated to deceive the public, a man cannot by using the fraudulent trademark obtain any right at all."¹⁵⁷

Subsequently, the world is a home. After globalization has spread across the globe and especially after it has been accepted as part of the policy in India in 1991, the inventions made in one country don't just remain indigenous thereto. Rather they naturally are circulated to the entire world by way of various literatures. It is pretty easy to look up for the foreign inventions not introduced in the country and copy it by one's own product claiming it to be their trademark. However there is no novelty to be protected here as the invention is not their own. Thus the rights of the actual innovators of a trademark though not in the market of the country have to be protected. Thus who came first in the global market must be considered.

Additionally the rights of a registered proprietor of a trademark are not absolute as no right is absolute not even the constitution rights. Thus the contention that having a registered trademark makes the registered proprietor unaccountable to any questions upon the validity therein is beyond reason. Therefore the researcher totally agrees with the decision of the court in the case of *Lupin Limited v. Johnson and Johnson* that the validity of a registered trademark can be questioned in the interim proceedings.

CONCLUSION

Lupin Limited v. Johnson and Johnson is a case regarding trademark where the previous proprietor's trademark lapsed for some reason and was not renewed. The defendant then got the identical trademark registered as his own for the similar product. The use of such trademark for the manufacturing and selling of such product was challenged by the plaintiff in an injunction proceeding on the ground of passing off. Passing off is the action meant for the protection and safeguarding of an unregistered trademark. So in case of the breach of proprietor's rights under a registered trademark the infringement suit is filed and that under an unregistered one the action of passing off is undertaken. The principle of passing off, i.e. "Nobody has the right to represent his goods as the goods of somebody else" was decided in the case of *Perry v. Truefitt*. Section 27 of the Trademarks Act, 1999 provides for it. The main issue in the case was whether at the stage of merely granting interim injunction, the court can or not look in the validity of the trademark of the registered proprietor. In some initial cases it was held to the effect that at the stage of injunction the matter is not decided upon merits

¹⁵⁷ *Supra* note 125.

so the courts are not at all entitled to look into the validity of the trademark of the registered proprietor but in later cases some of which have been referred to in this case, the courts were of the opinion that in order to decide whether or not the injunction should be granted the prima facie instance of infringement, balance of convenience and damages to the plaintiff are to be proved. Here the damages will be caused to the plaintiff only when he legitimately owns the right to the trademark otherwise it will be the cause of 'no cause, no action'. Thus, it will completely be valid for the court to look into the validity of the trademark at the stage of interim relief itself.



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TRADITIONAL KNOWLEDGE AND INTELLECTUAL PROPERTY ASSETS

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ABSTRACT

Traditional knowledge is that which has passed from one generation to another generation. The conservator of these knowledge did not considered it as public good and not worthy of commercialisation. However, after 19th century, traditional knowledge also fall within the domain of intellectual property eligible enough to be exploited for monetary gain. The bigger industries of western countries tried to commercially exploit the traditional knowledge of indigenous communities of Asian countries without prior informed consent because most of the indigenous knowledge are centred in these countries. This has happened more particularly in pharmaceutical industries, which has been properly explained in this article. Though, some cases of bio-piracy of traditional knowledge has been successfully redeemed but several measures have to be taken to conserve it. Thus, the author has tried in this article to explore the concept of traditional knowledge, concept of bio-piracy, various national and international instruments regarding protection of traditional knowledge and also suggested the possible measures that can be taken to protect traditional knowledge.

Keywords: Indigenous Community, Traditional Knowledge, Bio-Piracy, Informed Consent.

Introduction: Traditional Knowledge

Traditional knowledge is defined as understanding that has been acquired over time by members of an indigenous community in one or more societies through perception and acclimatization to the local culture and environment. It has historically been a gem that is simple to get to, making it vulnerable to theft. An intangible aspect of biological resources is the traditional knowledge connected to them. It is typically passed on orally from generation

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to generation. This knowledge has been influenced over time by innovations and practices from previous generations. Traditional knowledge is extremely broad and includes insight about a variety of topics, including experience and understanding of animal and plant species and their characteristics, comprehension of mineral resources and soils and their characteristics, permutations of anthropocentric sources, knowledge of medicines, and manifestations of folk tales mostly in the forms of music, dance, song, craftsmanship, stories, and art. The term "old knowledge" refers to all intellectual creations in the sectors of science, technology, biology, healthcare, agribusiness, biodiversity, as well as art and literature that have been created by progenitors and steadily refined by successive generations of a particular community. Traditional knowledge is utilised to preserve the community, its customs, and the hereditary resources needed for the community's continuous survival. The psychological and social context, of which indigenous knowledge is an essential component, must be preserved. Traditional knowledge is progressive, responsive, and culture- and context-specific. It provides useful leads that cut down on the amount of money and effort invested in research and advancement. Thus, multinational corporations make use of natural resources and the corresponding knowledge. Indigenous people develop these commodities and traditional knowledge, yet often get little credit or payment from said transnational corporations.

An Introduction to Intellectual Property Rights and Assets

These days, the terminology underlying intellectual property rights scarcely needs to be expanded. Anyone who matters in the scientific community is discussing intellectual property rights and how crucial it is to safeguard scientific breakthroughs that have the capacity to be commercially successful in a complex web of patents. The legitimacy of the international system of intellectual property rights is in doubt since it is unable to create equal opportunity for traditional knowledge holders and pioneers in the formal sector. The treatment of traditional knowledge and tradition raises serious ethical, judicial, cultural, and political issues. Such understanding is not restricted to clearly defined or articulated collections of components that can be known.

To prosper today, a country needs more than simply land, labour, and money. The new engines of the global economy are creativity and ingenuity. The concept that its source material is a creation of the mind or intellect is reflected in the expression intellectual property (IP). The provision of intellectual property rights (IPRs) serves to reward and protect innovators whose inventiveness might otherwise be freely used by others. The makers are expected by society to put their creations on the economy so that people can buy and sell them. Although society

wants to support inventiveness, it is unwilling to assist in the development of unfavourable market power.

However, there is an issue that arises—biopiracy and it leads to numerous instances of unwarranted difficulties in both India and other nations. Traditional knowledge has been protected through both offensive and defensive measures using a variety of tactics. Traditional knowledge has benefited from the Government of India's Council for Scientific and Industrial Research's effective attempt to record it in the TKDL (Traditional Knowledge Digital Library). Because of some flaws in the IPR system, biopirates employ intellectual property rights (IPR) as a tool to pilfer traditional knowledge and plunder biodiversity. Therefore it is required to introduce some sui-generis elements in the existing IPR system. India is listed among the 12¹⁵⁹ countries with the highest biodiversity levels. India is renowned for its high biological diversity, with over 91,200 animal species and 45,500 plant species having been identified so far in its 10 bio-geographic regions.¹⁶⁰ India is a recognised hub for agricultural diversity and is home to numerous wild cultivars of crop cousins. India has a large agro diversification and ranks among the twelve main origins of cultivars. India has a wealth of traditional knowledge about the qualities and applications of its natural capital due to its distinctive biodiversity and plentiful natural resources. The foundation of cultural heritage is customary wisdom (traditional knowledge). The majority of indigenous and local groups are found in regions with a wide range of ecological diversity. Traditional knowledge on preservation and long-term sustainable use is stored in indigenous communities.¹⁶¹ To achieve sustainable development, traditional wisdom is a crucial component.

Human Rights Conservation with respect to Traditional Knowledge

In India, perspectives of science and its application have undergone a significant change as a result of liberalisation and globalisation. In the West, the blatant desire to monopolize and protect any imaginable technological advancement, no matter how small, has now reached an absurd level. American and international corporations, who are not known for their restraint and consideration when it comes to business interests, have set out to fence off major portions of academia under the pretence of preserving intellectual assets. Setting the new IP agenda for the twenty-first century will be difficult given the explosive increase of scientific knowledge,

¹⁵⁹ NBA, <http://www.nbaindia.org/faq.htm> (last visited on Dec. 12, 2022)

¹⁶⁰ MINISTRY OF ENVIRONMENT AND HEALTH, <http://moef.nic.in/downloads/public-information/in-nr-04.pdf> (last visited on Dec. 11, 2022)

¹⁶¹ AMIT JHA, TRADITIONAL KNOWLEDGE SYSTEM IN INDIA 12-44(Atlantic 2022)

the rising demand for new forms of IP protection and access to IP-related information, the growing dominance of the emerging knowledge economy over the old "brick and mortar" economy, and the complexity of the links between IP and traditional knowledge, community knowledge, and living things. Trade Related Aspects of the Intellectual Property Rights (TRIPS) and the Convention on Biodiversity (CBD), which are associated to trade and business, respectively, called for the development of new economic rights and obligations to supplement the IPR system under the World Intellectual Property Organization (WIPO).

Matters concerning traditional knowledge, hitherto pursued only in the form of cultural rights or heritage issues at the UN, UNESCO and WIPO are regarded relevant also for development rights for which the United Nations Conference on Trade and Development (UNCTAD) was created and economic rights for which earlier UN-ECOSOC and more recently, WTO have been mandated. Additionally, the Traditional Medicine Strategy for 2002–2005 of the WHO includes several subcategories of traditional knowledge, such as traditional medicine, that continue to support public health targets. Additionally, traditional knowledge is treasured not merely because it is ancient but rather because a greater portion of it is passed down orally, making it a vital component of the information required to maintain livelihoods and means of subsistence. It also has a fluctuating economic value.

Approaches for the Protection of Traditional Knowledge

Traditional knowledge may be maintained in two ways under the current Intellectual Property Rights (IPR) system: positive protection and defensive protection. There are certain gaps in the boundaries between defensive and proactive intellectual property regulations. Therefore, both methods should indeed be employed to effectively conserve traditional knowledge.¹⁶²

Defensive Protection and Positive Protection

Leveraging intellectual property techniques, two precautionary paradigms have been applied to safeguard cultural heritage. The first preventive perspective (or defensive protection) is designed to prevent others from making use of traditional knowledge or obtaining rights of intellectual property over it. For instance, in order to demonstrate their indigenous practices as previous art and stop alleged abuses like biopiracy, several people have built traditional knowledge archives. Databases do expose such conventional knowledge to the public, even though they may prevent individuals from obtaining rights to such information. Since many

¹⁶² MONDAQ, <https://www.mondaq.com/india/patent/743482/ipr-vis--%C3%A0--vis-traditional-knowledge>
:~:text=Positive%20protection%20means%20protecting%20TK,property%20rights%20over%20traditional%20knowledge (last visited on Dec. 14, 2022)

societies would like to preserve such cultural heritage within their individual communities, this poses a difficulty. Several cultures adhere to their own customary or historical rules that govern the application of traditional knowledge; these laws may be somewhat different from their country's or the world's legal framework for intellectual property rights. These conventions may be broken by disclosures.

The second preventive paradigm, commonly referred to as "positive protection," aims to provide legal protections for traditional knowledge. Either current laws are used to do this, or novel sui generis laws are enacted through legislative procedures.

Several have claimed that allowing such groups eternal liberties may cause constitutional issues in certain nations, such as the United States. Additionally, they present pragmatic objections towards the idea of giving traditional knowledge constitutional protection. For example, certain traditional knowledge (like medical remedies) may very well be exploited to benefit individuals, while some proprietary rights may be retained. The equal distribution of advantages and assets is the subject of many other worries.

Local and indigenous cultures often asserted that they don't typically employ any incentives for development. Their usage of information is influenced by both spirituality and culture. Customary rules that are fundamental to their communal and ethnic history may be broken if this information is misappropriated or used inappropriately. Several legal clauses and statutory regulations presently safeguard these views, and the UN is gradually recognising them as unique human rights.

Prior Informed Consent (PIC)

PIC refers to the authorization obtained from the original owners of natural resource and accompanying traditional knowledge in order to acquire and utilise these assets and wisdom for commercial gain. PIC might be useful in addressing the issue of managing biological resources. Before directly gaining possession of a resource, a corporation or person must first get the prior informed consent of any and all communities as well as all members within each community who've already utilised and helped collaboratively towards the breakthrough in biodiversity-related knowledge. PIC will promote fair profit distribution and stop the exploitation of conventional knowledge.¹⁶³

¹⁶³ FOOD AND AGRICULTURAL ORGANISATION OF THE UNITED NATIONS, <https://www.fao.org/indigenous-peoples/our-pillars/fpic/en/> (last visited on Dec. 14, 2022)

Benefit Sharing:

Benefit sharing is the commitment to divide with a traditional community any financial and non-financial gains from the commercialization of its biological resources and related expertise. The establishment of an initiative like a trust fund for a particular demographic of beneficiaries, the transference of information, the creation of work opportunities, the improvement of infrastructure, the development of competence, and intellectual cooperation are a few of the monetary and non-monetary advantages.¹⁶⁴ Benefit-sharing arrangements might exist among: • A bio prospector and the local community; • A bio prospector and a collaborator who is not a member of the community, such as a university or a government agency; • The National Gene Fund trustees and bio prospector.

Equitable benefit-sharing arrangements have the potential to fully recognise and safeguard the entitlements of indigenous and local people to their genetic assets and knowledge. Effective PIC and fair reimbursement contracts should be implemented to stop bio-piracy and safeguard indigenous people's rights.

Protection of Traditional Knowledge through Documentation & Database

Concerning biodiversity and associated traditional knowledge, several patents have been awarded. This is due to the absence of traditional knowledge recordkeeping, particularly in India. For many decades, traditional wisdom has been handed down verbally from one person to another. There is a necessity of a practical record for precedent art to demonstrate that a patent is indeed not innovative and completely novel. The correct documenting of traditional knowledge is necessary to protect it from dishonest influences. Such records would act as a dataset for information searches prior to patent award. Tracking of indigenous tribes with whom sharing of the advantages of commercialising such products and expertise would be much easier, thanks to this. The Indian government has undertaken a number of attempts to record traditional knowledge. Some examples of the before mentioned attempts are:

People's Biodiversity Register: Comprehensive data on the accessibility and understanding of regional natural capital, along with any indigenous knowledge systems related to them, is recorded in the Register.¹⁶⁵

¹⁶⁴ KASHISH, Traditional Knowledge And Access-Benefit Sharing, (Dec. 14, 2022, 1:22 AM), KASHISH WORLDBLOG <https://www.kashishworld.com/blog/traditional-knowledge-and-access-benefit-sharing-abs/>

¹⁶⁵ NBA, http://nbaindia.org/uploaded/pdf/PPT_PBRs_Guidelines.pdf (last visited on Dec. 22, 2022)

The creation of such registers involves steps including targeting specific resource user groups, going on field trips, charting the area, and having conversations with locals on ecological sustainability. Locals create biodiversity registers at the block, district, and state levels with the aid of specialists or academic NGO institutions. These registries are recognised under the Biodiversity Act of 2002 as a legitimate and genuine method of establishing material evidence and as a foundation for assessing IPR applications.

The Beej Bachao Movement (Save the Seeds Movement) was started in 1995 by the NGO Kalpavriksh in association with the locals of Jardhar in the Teri Garhwal region of Uttar Pradesh. The movement's goal was to catalogue the variety of regional seedlings plus local populations' conservation methods.

Utilization of IPR to defend traditional knowledge

Notwithstanding many restrictions in the current IPR framework, certain components can be employed in either a positive or defensive approach to safeguard traditional knowledge.

Biological Diversity Act, 2002

India, a signatory to the CBD, felt it was important to implement the aforementioned agreement. In order to encourage the preservation of species diversity, India approved the Biological Diversity Act in 2002.

Section 36 of said Act dictates what actions must be made to conserve the ancient knowledge of land. The law calls for the creation of the National Biodiversity Authority (NBA) in accordance with Section 8 of the Act, the State Biodiversity Board (SBB) in accordance with Section 22 of the Act, and Biodiversity Management Committees (BMCs) at the level of the local community. The law also calls for the monitoring of ecology using biodiversity registers and the advocacy of biodiversity conservation and sustainable usage. Without the NBA's consent, data and information derived from studies cannot be disseminated. The NBA will examine any petitions for allegations of intellectual property rights as well as keep track of biodiversity preservation.

Shortcomings of the Biological Diversity Act, 2002:

There are certain gaps in the Act's IPR provisions since NBA, which was created under the Biological Diversity Act of 2002, possesses extraterritorial jurisdiction and is unable to keep track of requests for rights to intellectual property outside of India. The Act is primarily concerned with state rights and IPRs like patents. The Act doesn't really empower current right

holders, such as local farmers or local communities, to secure their rights in the exact same manner as it does for the state to combat biopiracy.

Protection of traditional knowledge through Patent Act 1970

IP rights are founded on the idea of private property ownership, while a traditional society has joint ownership over traditional knowledge. That knowledge belongs to the group as a whole. Due to its very distinct character from contemporary science, defending traditional knowledge under the current IPR framework is difficult. A defence mechanism against the improper usage traditional knowledge is the patent system. The primary benefit of a defensive system of protection is the fact that it stops commercial entities from completely monopolizing natural resources and associated traditional knowledge. This method views traditional knowledge connected to biodiversity as a shared human legacy that shouldn't be subject to private entities. Provisions under Sections 25[1(k), 2(k)] and 64[1(q)] of the Act were integrated to include expectation of innovation through readily available local expertise, such as oral knowledge, as a primary basis for both pre-grant opposition¹⁶⁶ and post-grant opposition¹⁶⁷ in addition to patent revocation.

Shortcomings of the Patent Act 1970:

Due to the collaborative character of traditional knowledge, it is hard to pinpoint a specific creator or group of inventors. The traditional communities' knowledge system is based on the development of a product by the community in its entirety with community rights in such productions rather than the total monopoly of a single identified person or group of individuals. Their ancestors and succeeding generations have been creating and perfecting this art for aeons. As a result, no single individual can be credited as being the only originator of the property rights produced.

Protection of traditional knowledge through Copyright

Copyright only safeguards the manner of speech, not the ideas themselves. Any of the acts listed in Section 14 of the Copyright Act, 1957, may be performed by the copyright holder. Traditional knowledge bearers can utilise copyright to safeguard their artistic expressions from unlawful duplication and commercialization, notably if those creators are from indigenous or aboriginal cultures. The link between the authors, artists, as well as other creators and their works is addressed under moral rights. Those very same rights may be a powerful tool for

¹⁶⁶ GLOBALJURIX, <https://www.globaljurix.com/patent-opposition/> (last visited on Dec. 12, 2022)

¹⁶⁷ EXCELONIP, <https://excelonip.com/> (last visited on Dec. 12, 2022)

defending the rights of indigenous peoples in work that draw upon their knowledge.

Shortcomings of the Copyrights Act 1957:

Most likely, traditional knowledge pertaining to natural commodities can hardly be protected by copyright.

Protection of traditional knowledge through Trade Secret

A list of clients, a machine or device blueprint, a chemical compound formulation, an industrial production, treatment, or preservation procedure, or a method can all be considered trade secrets. It is knowledge that is economically valuable while not being widely recognised or easily discernible. There is no explicit law in India that guard sensitive information and business secrets. In India, trade secrets are safeguarded by contract law or the equitable theory of confidentiality violation.

Shortcomings of Trade Secret:

Traditional knowledge may be protected as a trade secret if it is used by a small group of people within a traditional society. However, it cannot be used in situations when conventional knowledge is old. In the case of TM, it can be impossible to keep the fact that specific plants, animals, or minerals provide therapeutic effect as a secret.

Protection of traditional knowledge through the Protection of Plant Varieties and Farmer's Rights Act, 2001

In September 2001, the Protection of Plant Varieties and Farmer's Rights Act went into effect. The unique legislation was developed to comply with the TRIPS requirements set out by the WTO. Original, already-existing, fundamentally sourced, and farmer varieties of plants are all entitled to protection under the Act.

Limitations of the 2001 PPV&FR Act:

It is challenging to identify the ownership of a traditional variety because historical varieties were created and utilised by communities over a long period of time jointly. The Act makes no provision for how to handle such divergent assertions of ownership. It is the farmer's responsibility to officially safeguard their variety by registering it. This approach is less suited to a farming society since farm workers typically are not informed of said farmer's rights and plant variety protection laws.

Protection of traditional knowledge through Trademarks

Indigenous goods, including those in the agricultural and biological fields, can be protected

under the Trademark Act of 1999. By means of trademarks and service marks¹⁶⁸, all types of goods and services manufactured and provided by manufacturers, technicians artisans, as well as businessmen in native and indigenous societies, or by the organisations which symbolise them or within which individuals are aggregated (cooperatives, factions, etc.), can be differentiated from similar products or services supplied by others.

Shortcomings of Trade Mark Act of 1999:

Due to its restrictions on specific uses in connection to the category of products and services under which it is registered, trademark protection only extends to a small portion of indigenous peoples' cultural heritage.

Large enterprises have used trademark registrations as a way to profit commercially from indigenous peoples' cultural heritage. Because they cede ownership of their emblems and signs to a registered trademark owner, this may act against indigenous people and turn things south.

Protection of traditional knowledge through Geographical Indications of goods

The indigenous tribes are the sole custodians of traditional knowledge, and GI is the most effective method of protection for it. A local community is rewarded under the Geographical Indications of Goods (Regulation and Protection) Act. The duration of GI protection is 10 years, however it can be extended indefinitely by renewing it several times. To enhance production quality, manufacturing processes are evolving with time. The products have developed their legacy and trustworthiness over many decades or even centuries.

Shortcomings of the Geographical Indications of Goods Act of 1999:

Geographical indications aren't the best tools for protecting all types of items made from traditional knowledge since they do not cover certain of its intangible forms, such as dances, folk music, medicinal practices, and methods of treating illnesses. Traditional processes or technology are not protected; only traditional products are. So, without crediting the valuable contribution of the technology's rightful owners, anybody can exploit traditional technology and get IPRs on inventions founded upon it.

Traditional Knowledge Digital Library

As a result of these lawsuits, which served as a wake-up call, the Indian government established the Traditional Knowledge Digital Library (TKDL) and included indigenous practices to the International Patent Clarification System. India has launched the TKDL programme to digitalize and catalogue knowledge that is already in the public eye in order to speed up

¹⁶⁸ INVESTOPEDIA, <https://www.investopedia.com/terms/s/service-mark.asp> (last visited on Dec. 30, 2022)

information organisation, distribution, and access. Authorities compare an idea to publicly available search criteria before awarding a patent. Knowledge preservation will enable them to identify inventions in the public sphere and determine whether they qualify for patents, minimizing the theft of knowledge systems.

The preservation of nature and its active components depends heavily on traditional knowledge. The latest technical advancements unequivocally show how conventional wisdom may be applied to the creation of novel, commercially significant products. Millions of individuals in underdeveloped and economically developed nations depend on it for their food and nutritional security.

Health: The understanding of particular plants' qualities has led to the creation of several phytochemical-based treatments and aesthetics. The Indian medical systems of Ayurveda and Unani rely on a variety of organic sources and related traditional knowledge. Traditional medicine provides the only inexpensive treatment option in underdeveloped nations.

Traditional medicine (TM) is described by the World Health Organization (WHO) as the "totality of all knowledge and practises, whether describable or otherwise, used in diagnosis, prevention, and eradication of tangible, mental, or social discrepancy and having to depend strictly on workable observations and experience passed transmitted from generation to generation, regardless of whether verbally or in writing." Even in many affluent nations, 70% to 80% of the populace uses some alternate kind of treatment¹⁶⁹ (for example acupuncture).

The traditional medicine system is significant in that it offers therapeutic strategies for some age- and degenerative-related illnesses, including rheumatism, for which there are no other adequate treatments. Traditional medical knowledge is essential to the health care sector since the goods that result from it are environmentally friendly and have little to no adverse effects. The health care industry's economy benefits from this knowledge since clients like herbal products.

Agriculture: Plant variety creation, pest control techniques, selection techniques, breeding procedures used by farmers, and the domesticating of animals by rural farmers all play significant roles in agroecosystems of emerging nations. With their traditional traditions and agricultural methods, local populations enhanced and nourished variety in both flora and fauna.

¹⁶⁹ WHO FACT SHEET N° 134 DECEMBER 2008, <https://www.who.int/mediacentre/factsheets/fs134/en/> (last visited on Dec. 15, 2022)

Case Studies on IPR and Traditional Medicine

The Neem Case

The issuance of a patent to the corporation W.R. Grace sparked controversy, which may be regarded as a landmark for India and cast questions on the strictness of the patent regime. The business was awarded a patent in the USA and the EU for a formula that contained azadirachtin, the active element in the neem plant, and was intended to be repurposed for its pesticidal characteristics. The applicant acknowledged that he was aware of neem's pesticidal properties and emphasised that it is challenging to store azadirachtin for a prolonged period of time without neem.

'Jeevani' and the 'Kani' tribes

The use of benefit-sharing frameworks for indigenous entrepreneurship is starting to see new tests. It is worthwhile citing an illustration from India. It has to do with a medication that was created from and is centered on the active components of a plant called *Trichopus zeylanicus* (Arogyapaacha), which is located in South-Western India. Researchers from Kerala's Tropical Botanic Garden and Research Institute (TBGRI) learned about the plant that is believed to strengthen the immune system and provide additional energy.

The Kani Tribe uses the medication since it is conventional wisdom. These researchers separated, examined, and combined the component to create a substance they called "JEEVANI," the source of life. A significant Kerala-based Ayurvedic pharmaceutical firm is producing the restorative.

Turmeric Patent

On March 28, 1995, Suman K. Das and Harihar P. Cohli, two Indians living in the US, were issued US Patent No. 5, 40,504 concerning the use of turmeric in wound healing. The University of Mississippi Medical Centre in the United States received the patent. This patent made the unique discovery of administering an optimal dose of turmeric orally and topically to speed up the healing of wounds. Prior to being awarded, a patent must satisfy the fundamental criteria of invention, non-obviousness, and usefulness. As a result, the patent is rendered null and void if the assertions have indeed been addressed by the pertinent published information. 32 references, some of which were over a century old and written in Sanskrit, Urdu, and Hindi, were found by CSIR, demonstrating that this discovery was widely known in India previous to the granting of this patent. On October 28, 1996, CSIR formally requested a re-examination of said patent with the USPTO. The examiner once more dismissed all the allegations on November 20, 1997, citing their foreseeability and obviousness. The re-examination process

was completed on this case on April 21, 1998, when the re-examination credential was issued.

Case Studies on Biopiracy in the Pharmaceutical Industry

Kwaokrua

The Thai plant Kwaokrua has been used for than a century, and Thai writings first noted its medical benefits in 1931. On the contrary hand, numerous hormones produced by plants have only lately been identified in plants. These hormones have been utilised in contemporary medicine to enhance male sex, enlarge and shape human breasts, and tighten the skin. A South Korean company has a patent in the US on an infusion from kwaokrua for a number of these applications. The extraction methods disclosed in the patent are the same ones used for over a century by practitioners of traditional medicine, which has raised concerns among the Thai people. However, publications outlining this strategy were not taken into account for the US patent. Local Kwaokrua farmers have been hindered by legal threats, and the species has been quickly harvested for commercial use, allowing very little time for regrowth. The issuance of intellectual property protection in this historically used plant and its extract has altered indigenous peoples' traditions connected to the plant's normal cultivation and usage.

Hoodia

Since ancient times, the San people of the Kalahari Desert in South Africa have utilised hoodia, a local botanical, as a hunger suppressor. They became enabled to go on prolonged hunting expeditions with less supplies since Hoodia suppressed their appetites, increasing the effectiveness of the hunt. Under the auspices of a worldwide agreement called as the Convention on Biodiversity, the San people have earned royalties from multinational pharmaceutical firms marketing drugs incorporating hoodia (CBD). The integrity and legitimacy of these profit-sharing arrangements continue to be seriously questioned, though. Additionally, as the US is not a signatory to the CBD, the San people do not benefit in any manner from the money made from using US patents on Hoodia. As an outcome, several patents that include the indigenous Hoodia knowledge of the San people have been granted in both the US and Europe, with the San people earning little to no profit from the marketing of the items protected by those patents.

Madagascar Rosy Periwinkle

The marketing of the therapeutic properties of the Madagascar rose periwinkle is another instance of a pharma company benefiting from Eastern medicinal plants. Indigenous tribes in

Madagascar and other places had long used the herb in traditional medicine. Vinblastine and vincristine were found to be the two substances that give this plant its medicinal powers by Eli Lilly & Company, who were motivated by the use of this plant in mainstream medicine. The corporation presently uses these extracts in cancer-treatment drugs that it sells. These therapies bring in about \$100 million a year for the global pharmaceutical Eli Lilly, yet the indigenous populations of Madagascar receive no payment. Malagasy healers never used the pink periwinkle for the objectives that Eli Lilly suggests, despite the pink periwinkle being allegedly used against Malagasy tradition. The main purpose of it was to cure diabetes. Because Eli Lilly used the facility to produce innovative compounds for fresh medical applications, they could be eligible for intellectual property protection under the America Invents Act. However, Eli Lilly's capacity to patent these kinds of discoveries would be impacted by the new Section 102's widened scope of previous art. Multinationals like Eli Lilly could be required to limit their patent claims to only encompass the new breakthrough as a result of the Malagasy usage. Because of this, even while prior art may not entirely exclude new inventions, its assessment may have an effect on the variety of modern patent claims.

Case Studies regarding Protection and Promotion of Traditional Knowledge

Re-examination of United States Patent on Basmati

Well before UK Trademark Registry, Rice Tec Inc. submitted an application for registration of the mark "TEXMATI." Agricultural and Processed Food Exports Authority successfully resisted it (APEEDA). The US Patent No. 5,663,484 (hereinafter referenced to as the "484 patent"), issued to Rice Tec by the US Patent Office on September 2, 1997, was among the papers cited by Rice Tec as substantiation for the licensing of the aforementioned mark. This is how this patent came under dispute. The aforementioned patent included 20 claims that addressed new unique rice crops as well as different rice lineages, seedlings and grains that resulted, seed depositing claims, and a technique for choosing the rice varieties for breeding and multiplication.

After this incident, the Indian government formed a task force under leadership of the secretary of the ministry of industrial development to investigate the viability of challenging the aforementioned US patent through reconsideration. The Task Force then established a working group, mostly made up of ICAR and CSIR scientists, to thoroughly review the product specification and gather any relevant documentation in order to submit a petition for reassessment of the US patent. IARI Bulletin data was offered as testimony against Claim 1517.

On April 28, 2000, a complaint seeking re-examination of such a patent was finally submitted. The potential of illegality through the shipment of Basmati rice to the US was already avoided because to Rice Tec's decision to drop 15 allegations shortly after submitting the re-examination plea. Even the stated risk towards the shipment of grains of unresponsive rice genotypes from India has indeed been avoided as a result of the submission of all the additional wide claims.

Rulings relevant to Yoga

In this respect, the petitioner filed a supplementary registration—a clarification made when the initial certification is inaccurate or incomplete—with the Copyright Office in order to establish his intellectual ownership of the book describing the sequencing of yoga postures. The applicant was claiming rights to the sequential manner of 26 postures presented inside the volume in addition to the ownership to the book itself, under the aforementioned additional registration. A group called Open Source Yoga Unity opposed this ancillary authorization and questioned the US District Court for said Northern District of California to publish a motion for summary judgment stating that the appellant was not entitled to unique privileges over the pattern of asana as described in the book. According to its website, this group is a non-profit confederation to ensure the ongoing instinctual unhindered growth of yoga. The Court, nevertheless, dismissed the aforementioned argument in 2005, finding that the sequence could be able to be protected as a composition. Later, in response to a request for the Copyright Office's conclusion on the subject, the agency released its Policy Statement in June 2012, concluding that because yoga asana patterns are not collections of works of literature, artistic recordings, or any other types of works covered by the copyright law, they cannot be shielded as compilations. This excludes choreography.

When the United States District Judicial for the Central District of California was presented with a new Bikram Yoga issue in December 2012, the Policy Statement served as the foundation for a further court ruling under six months.

Two yoga teachers in Buffalo, New York, who had finished the claimant's certification programme and had been given permission by his institution to teach the fundamentals of yoga stood at the centre of the conflict. They established a number of yoga schools under the banner of their personal instructional company, Evolution Yoga LLC. The applicant filed a lawsuit against Evolution Yoga LLC citing copyright infringement, but the court awarded Evolution summary judgement, ruling that a series of asana cannot legally be protected by copyright.

Aranmula Kannadi

Aranmula, a rural community in the Pathanamthitta District of Kerala State in India, is well-known for the unusual "Aranmula kannadi"- a kind of metal mirror. The superior mirror, which is composed of a tin and copper alloy, distinguishes it from regular mirrors. This metal mirror is only made by a small number of ancestral families. The family members keep this precise tin and copper combination, which is used to make mirrors, a household secret. The prestige of the commodity and the long-standing ownership of the business solely within certain family units are due to the long-standing practice of having the traditional expertise linked with the creation of unique mirrors as a heavily protected secret. In accordance with the Act, the Society "Parthasarathy HandiCraft Centre" has certified "Aranmula Kannadi" as a GI (geographical Indication). Cultural traditions are effectively protected thanks to makers' efforts to maintain the traditional process a closely-kept mystery and the security of commodities under the GI Act.

Conclusion and Suggestive Measures

Many communities and countries have sought for a sui generis international legal instrument since the current international intellectual property system may not properly safeguard traditional knowledge and traditional cultural manifestations.

Traditional knowledge and cultural manifestations would be defined in an international legal document, together with the rights holders, the process to be used to settle conflicting community claims, and the appropriate rights and exceptions. There are conflicting opinions on the optimal strategies moving ahead, like whether intellectual property-type rights seem suitable for safeguarding traditional kinds of invention and originality. Figuring out the specifics is complicated.

Botanical Survey of India (BSI) and Zoological Survey of India should be utilised to verify the veracity of the animals and vegetation included in the People's Biodiversity Registers and used by the community (ZSI). The BMCs ought to have the legal authority to safeguard these Registers.

To maintain the credibility of GI items, quality assurance control procedures should be used. The monetary and cultural significance of ancient medical experience should be safeguarded, and robust defence strategies should be created to prevent others from getting protection for information over which they have no legal rights.

To encourage the expansion and evolution of both traditional and modern knowledge that is possessed by both people and organisations, incentives for the protection and sustainable

utilization of biodiversity will need to be sufficiently stable and diversified while being malleable.

The optimal strategy to safeguard biodiversity and related information from the dangers posed by the conventional IPRs regime has not yet been universally agreed upon. A worldwide and national effort should be made to defend the wrongful seizure of local reserves and the interests of indigenous people.

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An Analysis of the Patentability of AI-Based Innovations with Special Reference to the ‘DABUS’ Case in the United Kingdom

*Sanjana Shikhar*¹⁷⁰

ABSTRACT

The field of theoretical study for Artificial Intelligence (AI) has advanced. A number of concerns related to patent law arise from the fact that AI technologies allow machines to learn systematically from data and experience, think in concepts, and finally transform them into a source of innovative knowledge. AN important question which arises here is: Is it possible to list artificial intelligence as an inventor in patent applications? By rejecting patent applications with the AI called DABUS, named as the inventor by its programmer, Dr Thaler, the UK has maintained its stance and demonstrated that the court applied a strict interpretation of the statutory language. In order to give readers a complete picture of the situation, this paper discusses the topic of patentability of AI-based innovations with particular reference to the "DABUS" Case and analyses the decision, focusing on the justifications underlying the courts' arguments and implications of the same on future AI-based innovations. It also offers future challenges and suggestions.

Keywords: Artificial Intelligence, DABUS, Patent, Programmer

INTRODUCTION

The definition of intelligence is typically elusive. When twenty-four eminent theorists were asked to define the phrase, each of them provided an equal number of "slightly diverse" definitions. Similarly, defining AI is not a simple task. There isn't a set definition that everyone agrees upon. In general, the term "AI" is used to describe a variety of algorithms that roughly replicate the cognitive processes of the human brain. Modern Artificial Intelligence is capable of producing a wide variety of complex creative outputs, and it is increasingly helping inventors in their job. Consequently, the query is: Should AI be listed as an inventor in patent applications? Inventorship is still a matter of national discretion, despite the international

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harmonisation of patent law. In this regard, the "Artificial Inventor Project"¹⁷¹ was launched in 2019 by a group of academics, attorneys, and inventors. The project's goal is to submit patent applications globally with AI listed as the inventor, accepting AI Inventorship, in order to elicit reactions from significant IP offices. With only two exceptions—South Africa and Australia in the first instance—those patent applications are currently either pending or refused by most IP offices. But in April 2022, the Australian Court of Appeal overturned the ruling and disallowed patent protection, agreeing with judgements from other countries, such as the United Kingdom (UK).¹⁷²

THE 'DABUS' CASE: GRANT OF PATENT TO AI- BASED INNOVATIONS AROUND THE WORLD

Historically, human inventors have been considered when developing patent law. Thus, the application of creative AI systems introduces a number of fresh difficulties that the current patent framework would find difficult to handle. These days, AI systems can test and solve some issues with little to no human input. As a result, the role of computers in the creative process can be understood as a continuum that progresses from inventions that are entirely human-made through inventions that are supported by computers and, finally, inventions that are generated by computers.¹⁷³ Predictably, the later end of this spectrum is the one that is most contentious in terms of patent law.

Two inventions (a "beverage container based on fractal geometry" and a "flickering light device to draw attention during search and rescue operations") that were the focus of patent applications in multiple nations were made possible by an AI technique known as "DABUS." The DABUS technology was created and even patented by a person, Mr. Thaler, but the aforementioned two ideas were purely machine-generated, with no human input.¹⁷⁴

Since DABUS is not recognised as a person under Sections 2 and 6 of the Patents Act, 1970,¹⁷⁵ the Controller General of Patents in India stated objections in the Examination Report of

¹⁷¹ THE ARTIFICIAL INVENTOR PROJECT, <https://artificialinventor.com/> (last visited Dec. 24, 2022).

¹⁷² Oliver Bell and Vito Petretti, Australian Court Overturns AI Inventorship Ruling, JDSUPRA (Dec. 22, 2022, 8:46 AM), <https://www.jdsupra.com/legalnews/australian-court-overturns-ai-1320594/>.

¹⁷³ Michael McLaughlin, Computer-Generated Inventions, SSRN PAPERS (Dec. 21, 2022, 9:48 AM), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3097822.

¹⁷⁴ Jackie O'Brien and Isobel Taylor, The year that was for DABUS: The World's First AI Inventor, INSIDETECH LAW (Dec. 20, 2022, 7:36 AM), <https://www.insidetechlaw.com/blog/the-year-that-was-for-dabus-the-worlds-first-ai-inventor>.

¹⁷⁵ Patents Act, 1970, No. 39, Acts of Parliament, 1970 (India).

Thaler's Indian patent application, claiming that the application could not pass formal and technical examination. As a result, it is not viable to recognise AI as patent holders under India's current statutory framework.

If we look at other countries, the UK Intellectual Property Office and the High Court both rejected Dr Thaler's application because they believed that a machine could not be considered an inventor under the current rules of the UK Patent Act, 1977.¹⁷⁶ It is interesting to note, though, that the UK Supreme Court has granted the further appeal. This implies that they believe the case has significant ramifications, which may be related to the expanding usage of AI systems in a variety of industries.¹⁷⁷

The Australian Patent Office initially turned down Dr Thaler's patent application there. Interestingly, the Federal Court of Australia decided that AI might be recognised as an inventor under the Patents Act, 1990¹⁷⁸ when the case was brought before it since the Australian Patents Act does not clearly prohibit an inventor from being a non-human AI. However, an expanded 5-judge appeal Bench of the Full Federal Court overturned this decision and brought Australia back in line with the stance adopted by other countries. The Full Court cited Section 15 of the Patents Act of 1990, which stipulates that only "a person who is an inventor" may receive a patent for an invention; as a result, a person is to be understood as a natural person.¹⁷⁹

By discussing the entire timeline of the 'DABUS Case,' from the facts of the case, the issues, the arguments put forth by the parties, the court's reasoning and observations, to the UK Court of Appeal's judgement, which was backed by the pertinent provisions of the UK Patents Act, 1977 and some significant precedents, this paper provides the readers with a comprehensive outline of the case.

ANALYSIS: THALER V. COMPTROLLER GENERAL OF PATENTS TRADE MARKS AND DESIGNS

A. APPLICATIONS TO THE UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE

¹⁷⁶Patents Act, 1977, No. 27, Acts of Parliament, 1977 (United Kingdom).

¹⁷⁷ PINSENT MASONS, <https://www.pinsentmasons.com/out-law/news/supreme-court-inventorship-dabus-patent-dispute> (last visited Dec. 18, 2022).

¹⁷⁸ Patents Act, 1990, No. 83, Acts of Parliament, 1990 (Australia).

¹⁷⁹ Nayantara Sanyal and Simran Lobo, Inventions By Artificial Intelligence: Patentable Or Not?, MONDAQ (Dec. 23, 2022, 12:37 PM), <https://www.mondaq.com/india/patent/1223510/inventions-by-artificial-intelligence-patentable-or-not>.

Stephen Thaler submitted two distinct patent applications via application forms dated 17 October 2018 and 7 November 2018. The title of the first was "Food Container" and addresses the design of specific food packaging components. The title of the second is "Flashing lights are one of the "Devices and Methods for Attracting Enhanced Attention" devices. On July 23, 2019, he subsequently submitted statements of inventorship and a completed right to grant patent forms. In the section for the family name of the inventor, he listed the name "DABUS" (Device for the Autonomous Bootstrapping of Unified Sentience), which is the name of Dr Thaler's AI machine. Dr Thaler checked the box asking him to explain how he was entitled to a patent and wrote, "By ownership of the creative machine "DABUS"". The IPO reacted on August 8 with the claim that Dr Thaler had disregarded S.13 (2) of the 1977 Act, which obliged him to name the inventor and explain how he had acquired his rights from them.

Asserting that "the applicant specified no individual or persons whom he considers to be an inventor as the invention was wholly and solely developed by DABUS", Dr Thaler submitted an amended form on August 28, 2019. The information that is currently accessible also makes it abundantly evident and without doubt that Dr Thaler not only founded DABUS but also set it up to create the challenged inventions.

The provisions in question were S.7 and S.13 of the Patents Act 1977.

Section 7 of the Act, 1977 states:

“(1) Any person may make an application for a patent either alone or jointly with another.

(2) A patent for an invention may be granted—

(a) Primarily to the inventor or joint inventors;

(b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.

(3) In this Act ‘inventor’ in relation to an invention means the actual deviser of the invention and ‘joint inventor’ shall be construed accordingly.

(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the

persons so entitled.”

S.13 of the Act, 1977 states as follows:

“(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned, if possible, in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.

(2) Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement—

(a) Identifying the person or persons whom he believes to be the inventor or inventors; and

(b) Where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent; and, if he fails to do so, the application shall be taken to be withdrawn.

(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.”

B. JUDGEMENT OF MR. HUW JONES: COMPTROLLER GENERAL OF PATENTS, DESIGNS AND TRADE MARKS

The hearing before Mr. Huw Jones took place on 14 November, 2019. He announced that he had decided against Dr Thaler and stated that, “I have found that DABUS is not a person as envisaged by S.7 and S.13 of the Act and so cannot be considered an inventor. However, even if I am wrong on this point, the applicant is still not entitled to apply for a patent simply by virtue of ownership of DABUS, because a satisfactory derivation of right has not been offered.”¹⁸⁰

Thus, the rejection was on two grounds that DABUS cannot be the inventor because he is not a person, and Dr Thaler is not qualified to submit a patent application.

Dr Thaler appealed this denial to the High Court on the grounds that (1) the hearing officer had

¹⁸⁰ Saransh Chaturvedi, The Curious Case of Dabus: Who should own the AI- Related inventions? SCC ONLINE (Dec. 23, 2022, 10:56 AM), <https://www.sconline.com/blog/post/2020/12/26/the-curious-case-of-dabus-who-should-own-the-ai-related-inventions/>.

predetermined the result, (2) he had taken the wrong tack in how he read the relevant statutes, and (3) he had illegally denied the applicant's rights by using the requirement in S.13 (2) of the Patents Act of 1977 that the inventor be identified. However, Marcus Smith J. denied the appeal in a ruling dated September 21, 2020.¹⁸¹

C. REASONINGS AND OBSERVATIONS OF THE HIGH COURT

Dr Thaler had not established a claim to the invention, DABUS did not qualify as an inventor because it was not a person, and the hearing officer's finding that the applications were declared withdrawn in line with S.13 was accurate and all these led to the appeal's dismissal.

With regard to the first issue, the judge found that the natural interpretation of S.7 (3) was that the inventor seems to be a person. The judge stated that *Rhone-Poulenc Rorer International Holdings v. Yeda Research and Development Company Ltd.*,¹⁸² addressed the meaning of this phrase. According to S.7 (3), an inventor is "the actual deviser of the invention." The term "actual" contrasts with a presumed or feigned deviser of the invention and refers to the natural person who came up with the creative thought, as stated by Laddie J in *University of Southampton's Applications*.¹⁸³

Because the claims could contain non-patentable integers drawn from prior art, it is not sufficient that someone contributed to the claims.¹⁸⁴ In order for an invention to be considered inventive, it must not be evident to "a person skilled in the art" when taking into account the current state of the art. Therefore, inventions that are accessible to the typical expert in the field—who is "usually regarded" to be a human being—cannot be granted a patent. Laddie J added that the "contribution must relate to the creation of the inventive concept" in the *University of Southampton Applications*. To ascertain who the inventor is, it will be required to evaluate the information provided by the parties concerning the nature of the creative idea and who contributed to it.

With respect to the second issue, the judge determined that Dr. Thaler was not eligible to receive a patent under S.7(2)(b) or (c), as both sections needed that the inventor have reassigned the right to apply to the applicant, which was impossible because DABUS could not have done

¹⁸¹ Amy Sandys, UK High Court rejects idea of invention by AI system Dabus, JUVE PATENT (Dec. 17, 2022, 8:34 PM), <https://www.juve-patent.com/news-and-stories/cases/uk-high-court-rejects-idea-of-invention-by-ai-System-dabus/>.

¹⁸² *Rhone-Poulenc Rorer International Holdings v. Yeda Research and Development Company Ltd.*, [2007] UKHL 43.

¹⁸³ *University of Southampton's Applications*, [2005] RPC 220, 234.

¹⁸⁴ *Henry Brothers (Magherafelt) Ltd v. Ministry of Defence*, [1999] RPC 442.

so because it is not a person.

On the third question, the judge rejected the applicant's claim that S.13 does not permit the Comptroller to deny a patent application by refusing to accept Dr Thaler statement of inventorship that accurately and honestly identifies Dr. Thaler as the invention's true inventor and details how Dr. Thaler came to be entitled to the patent. If S.7's provisions allowed a patent application to be awarded based solely on the applicant's sincere but unsupported conviction that they should be awarded a patent, then S.7's provisions would be rendered worthless. If the applicant cannot bring himself to fall within the parameters of S.7, the Comptroller is "justified—indeed compelled" to come to the conclusion that the application is unsatisfactory and liable to being presumed withdrawn.

D. ARGUMENTS BEFORE THE COURT OF APPEAL

When the case was heard by Lord Justice Arnold, Lady Justice Elisabeth Laing, and Lord Justice Birss in the Court of Appeal, it was reduced to three key questions: (i) Is the 1977 Act predicated on an individual's status as an inventor? (ii) What is S.13 of the 1977 Act's function, and what is its purpose? (iii) In accordance with S.13 (2), what is the appropriate response to the information Dr Thaler has provided?¹⁸⁵

Dr. Thaler claims that the requirement that an inventor must be a living person is expressly excluded from the description of an inventor as the "actual deviser" of an invention. The fact that inventors are people was not and should not be a requirement of the legislation, even though it was clear at the time the Act was written.

However, the Comptroller's attorney argued that for the purposes of this appeal, the Comptroller didn't challenge three issues. First, the inventions were actually created by DABUS; second, they were patentable; and third, DABUS was established and owned by Dr Thaler, who also owned the company that produced the technologies in question. Due to the law's requirement that inventors be people, none of these qualified DABUS as the inventor. Furthermore, due to the requirement for a "transfer," as previously noted, Dr Thaler did not have the authority to be given these patents.

¹⁸⁵ Toby Bond and Katharine Stephens, UK Court of Appeal rejects DABUS patent application, BIRD & BIRD (Dec. 24, 2022, 9:47 PM), <https://www.twobirds.com/en/insights/2021/uk/uk-court-of-appeal-rejects-dabus-patent-application>.

E. REGULATIONS AND RECOMMENDATIONS BEFORE THE ACT OF 1977

As none of the parties discussed the history of legislations before the act of 1977, it was necessary to deal with it in the present case. The Judge gave an overview of the same.

1. STATUTE OF MONOPOLIES, 1623

The issuance of patents "to the true and first inventor" was permitted by the Statute of Monopolies.¹⁸⁶ The Act prohibited a grant to anyone else, and it was difficult to transfer the right to obtain a patent until developments in the 20th century. It was also clear that when the term "true and first inventor" was used in the Statute of Monopolies, it referred to both true and first inventors as well as true and first importers into the industry.

2. PATENTS ACT, 1949

Under S.1 of the Patents Act of 1949,¹⁸⁷ only those claiming to be the true and first inventor or their assignee were permitted to submit applications. The Act of 1949 significantly altered the law in this regard. That Act made the right to a patent belonging to the actual and original inventor transferable. While there were no formalities necessary for a valid assignment, S.2(2) of the 1949 Act stipulated that when an application was made by an assignee, the true and original inventor must also have given his or her written consent to the application's making. It is plausible to assume that the introduction of the idea of "mention of the inventor" by S.16 of the 1949 Act was one effect of the legal reform that allowed the grantee of a patent to now be an assignee.

“(1) if the comptroller is satisfied, upon a request or claim made in accordance with the provisions of this section— (a) that the person in respect of or by whom the request is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and (b) that the application for the patent is a direct consequence of his being the inventor, the comptroller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application, in the complete specification, and in the register of patents: Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.”

¹⁸⁶ Statute of Monopolies, 1623, No. 3 21 Ja 1, Acts of Parliament, 1623 (United Kingdom).

¹⁸⁷ Patents Act, 1949, No. 87, Acts of Parliament, 1949 (United Kingdom).

“(2) For the purposes of this section the actual deviser of an invention or a part of an invention shall be deemed to be the inventor, notwithstanding that any other person is for any of the other purposes of this Act treated as the true and first inventor; and no person shall be deemed to be the inventor of an invention or a part of any invention by reason only that it was imported by him into the United Kingdom.”

This has a number of consequences. First off, it is clear from the way this section is written that the actual deviser is a person because S.16 (2) reads "notwithstanding... any other person." Second, the word makes a contrast between the actual deviser and those who, according to the law, are the "genuine and first innovators" but aren't the ones who actually came up with the innovation, such importers. Thirdly, enormous care has been taken to ensure that the real deviser's (or inventors) only legal claim under this clause is one of mention.

3. RECOMMENDATIONS OF THE BANKS COMMITTEE

In July 1970, the Banks Committee provided an assessment of the British patent system. The Committee stated at para. 526 that the phrase "true and first inventor" pertains to both the true inventor of the invention and anyone who introduces the innovation into the United Kingdom. The committee took notice of the need to submit an assent from the inventor in accordance with Section 2(2) of the 1949 Act at Paragraph 527.

The Committee had received complaints about this obligation, according to paragraph 528, that it was challenging to comply with because, frequently, the employers of the inventors may not be able to determine precisely whose assent is required.

The Committee recommended that the statute be streamlined in a number of ways at paragraph 530. Declarations of assent and inventorship ought to be eliminated. The approach to be taken should be that anyone purporting to be the inventor or to be authorized to receive the benefits of the patent when granted should have the right to submit an application.

The recommendations were as follows at paragraph 532:

1. The term "true and first inventor" should be replaced with the idea that the inventor is the one who actually devised the innovation.
2. Anyone asserting to be the inventor or to be entitled to receive the advantages of the patent when it is granted might very well apply for a patent, or in the case of an application asserting priority under the International Convention, anyone claiming to be that person's assignee or the person who filed the application abroad.

3. In no way should the submission of an application by someone other than the inventor be construed as the inventor's approval of the submission.
4. The applicants shall identify the persons they believe to be the inventors, and the inventors shall be recognized in the published specifications.
5. The Patents Act of 1949's requirement of declaration of assent in Section 2(2) should be removed.

F. ISSUES BEFORE THE COURT OF APPEAL

The judge next moved to the issues of this case.

i. Does the 1977 Act stipulate that inventors must be people?

The statement in S.7 (1) that "any individual" may submit an application for a patent without limitations has a purpose. The Banks Committee's recommendations included getting rid with the idea that anyone needed to fulfil any conditions before ever submitting a patent application. The legislation from the previous edition, which dates back to the Statute of Monopolies, was amended with the definition of "inventor" in S.7(3) in order to do away with the idea that an invention's actual and original inventor might not be the person who created it.

The concept of the actual creator of the invention has been a feature of British patent law since S.16 of the 1949 Act. The invention was made by the individual. That individual was being compared to people who had not yet done so and were considered to be the real and original creators, such as importers. Therefore, in the Yeda Case,¹⁸⁸ a distinction was made between the genuine deviser and a fictitious or assumed deviser.

The remainder of the 1977 Act is written assuming that the inventor is a person. Because it implicitly concedes that the law does not require that the real deviser of an invention be a person, the Comptroller's alleged submission that DABUS is the deviser of the innovations is incorrect and possibly unclear. Machines aren't people, either. Even if the machine was the thing that truly came up with these inventions, it has no business being credited as the creator.

ii. What is the purpose of and how does the 1977 Act's Section 13 function?

It is clear that this provision was created to implement the Banks Committee's recommendations for streamlining the application process. From the terms themselves, it

¹⁸⁸ *Supra* note 182.

appears that the only need for inventorship is that the petitioner names the person he believes to be the inventor. Even if the Comptroller can ask for a reason as to why the applicant failed to identify the person, they believed to be the inventor, the judge determined that the text of the section was satisfied. This interpretation of the wording is supported by the Banks Committee report, which shows that the legislation was to be changed from that under the 1949 Act, which placed an obligation demanding the identification of the actual and first inventor, along with a mandatory assent, among other things. Notably, the Banks Committee specifically allowed for situations when the inventor would not be able to be identified as acceptable.

The Comptroller would have a right to be sceptical if the statement of inventorship contained an absurd justification for why the applicant was unable to identify the inventor. But it seems that S.13 (2)(a) has been fulfilled if the Comptroller was convinced that what the petitioner had supplied was their sincere view. Regarding S.13(2)(b), the judge also provided an illustration, speculating on what might occur if the applicant claimed that the inventor had granted them the right through a communication that was illegal. According to the judgement, the Comptroller would have cause to consider such a declaration to be insufficient.

In *Nippon Piston Ring Co.'s Application*,¹⁸⁹ it was decided that in order to comply with S.13 (2) (b), it was at least essential to specify which of S.7 (2) categories (b) or (c) the applicant fell under. Whitford J rejected counsel's argument that it was unnecessary to state whether of S.7(2)(b) or (c) an applicant fell under when the case was on appeal and stated that this is the least one needs to do, according to the ruling, and it is correct. Given that it is understood that one does not need to provide extensive details while indicating how he derives the title, one may reasonably wonder why this indication must be sent to the Patent Office. According to the Office, the phrase "by assignment" is sufficient to meet the criterion. There is no requirement that any documentation supporting the claim to the title be sent to the Office. The Office need not in any way be convinced that the assertion being presented is credible.

Therefore, it is safe to say that S.13 (2)(b) can be satisfied without requiring a lot of detail. To meet the Act's requirement, no document proving title needs to be submitted. The applicant's claim to title does not require the Comptroller to be "in any way satisfied" that it is valid.

Whitford J. claims that the purpose of S.13 (2) is to provide the Comptroller with information that will be made public. The section's goal is not to compel or make it easier to examine the applicant's alleged claim to the patent. The Comptroller must only demand that the applicant

¹⁸⁹ *Nippon Piston Ring Co.'s Application*, [1987] RPC 120.

goes so far as to specify which portion of S.7 (2) he relies on.

iii. What is the appropriate response to Dr Thaler's declaration of inventorship in accordance with S.13 (2)?

Dr Thaler's statement begins with S.13 (2) (a), which names no specific person as the inventor because he doesn't think there is a human inventor. There is no implication that what he said wasn't an honest expression of what he believed. This case shows that not all inventions have a human who invented them simply because all inventors are persons. In certain cases, the Comptroller is not required to name anyone (or anything). Therefore, Dr Thaler has fulfilled with his legal duties as set forth in S.13 (2) (a).

Dr Thaler argued that he is entitled to a patent for an invention produced by DABUS under S.7 (2)(b) because he invented, owns, and operated the machine. According to the law, this right to apply for and receive a patent for an invention produced by a machine belongs to the owner and operator of the machine. It was noted that Dr Thaler had met with requirement of S.13 (2) as well. He has provided evidence of how his claim to the invention came about. In light of this, it was decided that the applicant satisfied the conditions of S.13 (2) and (ii) the applications were not regarded as withdrawn.

G. JUDGEMENT

It was determined that an inventor must be a person in accordance with the relevant provisions of the 1977 Act. Persons alone can possess rights. Not a machine. A patent can only be issued "mainly to the inventor" and only under the conditions outlined in S.7 (2)(c) and (d). Before the innovation is created, only one individual may enter into an agreement that is legally binding and grants him full ownership of the invention's assets (other than equitable interests). As a result, DABUS cannot by law be considered an "inventor" for the purposes of S.7 in the absence of a statutory deeming clause. Furthermore, Dr Thaler has not cited any legal statute that grants him the right to that property. A person alone has the authority to claim inventorship. The sole part of the 1977 Act that grants the right to file for a patent is Section 7. It was determined that, under its appropriate interpretation, the law prohibits the issue of a patent where the inventor is a non-person. No one has the legal right to submit a patent application for a machine's inventions if the inventor is a machine rather than a person.

The reasons being that first, it is a statement that claims categorically that there is no such "person" and fails to name any pertinent "person" who the applicant believes to be the inventor.

What is the appropriate response to Dr Thaler's declaration of inventorship in accordance with S.13 (2)? Second, it shows that the applicant does not have the right to submit a patent application under Section 7, both because it is categorically stated that the inventor is not a person and consequently, the inventor cannot have any property in the invention that could have belonged to the applicant or that could have become his property under Section 7(2)(c). It was noted that S.13 (2)(a) clearly requires the applicant to recognise the person he feels is the inventor, rather than only requiring the applicant to "assert their sincere belief regarding who the inventor was." A claim that the applicant honestly thinks the invention was created by a machine does not satisfy the criteria which is distinct. The appeal was therefore denied with the majority of 2:1.

The three judges on the Court of Appeal's panel did not all agree with this conclusion. Lord Justice Birss, a newly appointed but well-known and highly respected patent judge, concurred that the creator had to be a human and not a machine. Nevertheless, this did not preclude Dr Thaler from receiving a patent in spite of this, according to him.¹⁹⁰

In his opinion, the requirements of S.13 (2) were satisfied by merely delivering the requested information honestly. He disagreed with the other two judges on the panel and believed that this section's only goal was to provide the UK IPO with information that would later become public. Most people didn't concur.

According to Lord Justice Birss, it was not necessary to identify a person as an inventor in order for S.13 (2)(a) to be satisfied. It was sufficient for the petitioner to identify the inventor as they really believed them to be. The genuine identity of the creator was no longer important when deciding whether to grant a patent due to the history of UK patent law.

Lord Justice Birss also believed that because Dr Thaler had stated his justifications for requesting the patent, the conditions of S.13 (2)(b) had been satisfied. He believed that it was not necessary for the UK IPO to determine whether the basis was legally valid. The Patents Act provided tools for legitimate applicants to contest their eligibility for the patent. The stance taken by Birss LJ does have a logical foundation, and it may be argued that it reflects the realities of the real world in the early days of the AI era.¹⁹¹

¹⁹⁰ Peter Dalton and Rachel Montagnon, UK Court of Appeal dismisses DABUS appeal on AI as patent inventor but dissenting judgement leaves room for possible Supreme Court appeal, HERBERT SMITH FREEHILLS (Dec. 22, 2022, 2:57 PM), <https://hsfnotes.com/ip/2021/10/13/uk-court-of-appeal-dismisses-dabus-appeal-on-ai-as-patent-inventor-but-dissenting-judgment-leaves-room-for-possible-supreme-court-appeal/>.

¹⁹¹ OSBORNE CLARKE, <https://www.osborneclarke.com/insights/court-appeals-dabus-decision-highlights-Debate-patents-ai-derived-inventions> (last visited Dec. 19, 2022).

H. IMPLICATIONS

An AI system cannot be named as an inventor under the current legal framework in the majority of countries, as this is contrary to the presumption that patents are invented by natural persons with human involvement, as demonstrated by the DABUS case, which tested the patentability of an AI invention in several jurisdictions. Is this method the best one? Simply put, when a human has in fact had little to no part in the creative process, the law basically promotes a falsehood. One could argue that patent offices should impose a requirement for applicants to be open and reveal the use of computers in the innovative process rather than unintentionally encourage dishonesty.¹⁹² One could argue that patent offices should impose a requirement for applicants to be open and reveal the use of computers in the innovative process rather than unintentionally encourage dishonesty. Since it is doubtful that AI-invented patent applications will be granted, there is a chance that inventors may decide to rely on trade secrets instead, keeping the invention a secret and thereby weakening the concept of "patent bargain". The bargain theory of patent law is founded on the idea that an applicant should be given temporary exclusivity over an invention in exchange for disclosing it for the good of society.

However, as noted earlier, the UK Supreme Court has granted the further appeal. This implies that they believe the case has significant ramifications, which may be related to the expanding usage of AI systems in a variety of industries.¹⁹³

I. FUTURE CHALLENGES AND SUGGESTIONS

AI systems are getting increasingly capable of independently creating inventions. However, as patent law has always been created with human actors in mind, many of its fundamental tenets do not sit well with machine invention. The author has explored this complex topic in this contribution and made an effort to provide readers with a comprehensive understanding of it in respect to the DAIBUS Case in the UK. The DABUS decision profoundly transforms how intellectual property is viewed, and it makes clear a problem that patent systems are now beginning to face: Can an AI-based invention be granted a patent?

One problem with this is that there would likely be a lot more candidates for ownership if machines were to be recognised as inventors in the future. These candidates would include the owner of the AI, the AI software's programmer, the user who specifies the tasks, the data

¹⁹² Abbott, I Think, Therefore I Invent, 57 BCLR 1079, 1103 (2016).

¹⁹³ *Supra* note 177.

source, and the initial observer of the result's relevance.¹⁹⁴

The solution to this problem is obviously complex, therefore handling each situation individually may be the best course of action. This issue is only hypothetical at this time due to the fact that machines cannot be considered to be inventors.

Another problem is that AI systems might produce outputs using technology that has already been subject to patents; infringing conduct could result from some creative actions. Who should be held accountable when a machine employs patented technology to produce an output while functioning with a high degree of autonomy is the important question? Failure to hold those responsible for such actions accountable would stimulate the use of AI systems for infringement.¹⁹⁵ On the other side, if liability for AI-induced infringement is upheld, several parties may be held accountable, including the machine's end user, the creator, and the AI system itself.¹⁹⁶ Future arguments will likely concentrate on deciding whether end users or developers should be held accountable because AI systems lack a legal personality.

It is now acceptable to say that a separate AI-IP theory has the benefit that it might be adjusted to meet the specific conditions in which AI invention emerges, as opposed to retrofitting old patent laws to accommodate emerging technology like AI.¹⁹⁷ But there will be consequences for recruiting investment in cutting-edge businesses if a framework for patenting AI-generated discoveries is not established. Finally, we can draw the conclusion that many intellectual property laws still use antiquated methods and thinking. These strategies must be developed further to guarantee that rules and regulations are updated to reflect the status of technology.

¹⁹⁴ Dr. Noam Shemtov, A study on inventorship in inventions involving AI activity, EUROPEAN PATENT OFFICE (Dec. 24, 2022, 9:59 PM), [http://documents.epo.org/projects/babylon/eponet.nsf/0/3918F57B010A3540C125841900280653/\\$File/Concept_of_Inventorship_in_Inventions_involving_AI_Activity_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/3918F57B010A3540C125841900280653/$File/Concept_of_Inventorship_in_Inventions_involving_AI_Activity_en.pdf).

¹⁹⁵ B. Watson, A Mind of Its Own — Direct Infringement by Users of Artificial Intelligence Systems, 58 IDEA 65, 70, (2017).

¹⁹⁶ World Economic Forum, https://www3.weforum.org/docs/WEF_48540_WP_End_of_Innovation_Protecting_Patent_Law.pdf (last visited Dec. 24, 2022).

¹⁹⁷ Amar Diwakar, Can invention enabled by artificial intelligence be patented?, TRT WORLD (Dec. 24, 2022, 3:59 PM), <https://www.trtworld.com/magazine/can-an-invention-enabled-by-artificial-intelligence-be-patented-60299>.



Doctrine of Fair use in Trademark Law: Judicial Pronouncements

Saumya Sakshi¹⁹⁸

ABSTRACT

The trademark law has evolved as a structural framework for identifying goods and services and creating market profiles that are tied to those identities. “A trademark is solely the property of its owner, and any unauthorised use of the trademark by a third party violates the owner's rights”. Everything has its restriction, similarly exclusive right provided to its owner is not absolute. A popular defence used in trademark infringement cases is “fair use”, which is founded on the legal principle that a trademark owner cannot monopolise a descriptive term solely and deny a third party the ability to accurately represent their products. “The defendant may use a plaintiff's trademark to identify the plaintiff's products under the “fair use” doctrine if there is no likelihood of confusion regarding the origin of the defendant's product or sponsorship or association by the mark's holder”. This paper will analyse the concept of fair use, types of “fair use” and judicial pronouncement related to this doctrine.

Keywords: Fair use, Descriptive Fair use, Nominative Fair use, Trademark Infringement.

Introduction

A trademark is a distinctive mark that can serve as a symbol designating the origin of products or services and assisting the consumer in recognising them. Such trademarks not only help people recognise a particular brand's goods and services, but also help consumers determine the quality of such goods and services.¹⁹⁹ Identification of products and services is the fundamental function of a trademark, and the registered owner's negative right to exclude others from using a trademark that is identical to or deceptively similar to that trademark is the core benefit of a trademark.²⁰⁰

¹⁹⁸ LL.M., Hidayatullaah National Law University, Raipur.

¹⁹⁹ TRADEMARK, WIPO, <https://www.wipo.int/trademarks/en/>

²⁰⁰ “Mohan Lal vs. Sona Paint’s Hardware and Microlube India Limited vs. Rakesh Kumar, 2013 (55) PTC 61[Del][FB] at p.83”.

Everything has its restriction, similarly exclusive right provided to its owner is not absolute. In today's time competition is at its peak, and the trademark is being used by the third-party through different platforms like advertisements, parodies, campaigns, media, comparative product marketing etc. Though, unauthorized third-party uses have been included in punitive provisions of the legislation. However, in some instances, a person may utilise someone's trademark if the usage is regarded as "fair use." Most of the globe recognises this "fair use" exception.²⁰¹

"Section 30 of the Trademarks Act, 1999" in India includes the idea of "fair use," which provides an affirmative defence counter to a charge of infringement by the registered trademark owner.

Doctrine of Fair Use

According to this doctrine, any person is allowed to use any registered trademark only when the usage of such mark preserves the uniqueness and sanctity of the registered mark and the registered user.

Fair use is allowed only when although, there is the use of a registered trademark without permission of the registered owner but there is no loss occurring to them by such use and no monetary profit is made. The meaning of Fair Dealing depends upon various facts and situations. What might be fair dealing depends from case to case and courts decide by applying common sense and fundamental logic?

However, care should be taken to ensure that the usage of a trademark under this sort of "fair use" is consistent with ethical business practices, does not imply affiliation with the trademark owner, and does not devalue the goodwill associated with the mark.

Examples

1. "Ride-hard" the phrase used by Harley- Davidson (Motorcycle manufacturer) was considered fair use, not an infringer of "RIDE HARD" which is a trademark of an Apparel company. (The USA)
2. "Love potion" a term used on a fragrance product was considered fair use and not infringing the registered trademark named "LOVE POTION" which is a trademark used on a fragrance product. (The USA).²⁰²

²⁰¹ "Fair Use of Trademarks (Intended for a Non-Legal Audience) , International Organisation of Trademark," ["https://www.inta.org/fact-sheets/fair-use-of-trademarks-intended-for-a-non-legal-audience/"](https://www.inta.org/fact-sheets/fair-use-of-trademarks-intended-for-a-non-legal-audience/)

²⁰² *Ibid.*

The Concept of Fair Use in Different Legal system

TRIPS²⁰³

According to Article 16(1) of the TRIPS agreement, the owners have the negative right to exclude others from using their marks without their permission.²⁰⁴

Certain exceptions to the rights provided by trademark law are established in “*Article 17 of the TRIPS Agreement*”. “*Members may, in accordance with this, grant specific exceptions to the rights granted by a trademark, such as the fair use of the registered mark, if such exceptions take into account the legitimate interests of the trademark owner as well as third parties*”.

EUROPEAN COUNCIL DIRECTIVE²⁰⁵

Article 6 of the European council directive exempts specific trademark usage from infringement action. This permits the fair use of the registered trademark. It denotes three major categories of "fair usage," namely:

- (a) Use of one's own name or address
- (b) Information regarding the nature, quality, quantity, price, intended use, origin, timing of production, provision of services, and other attributes of products or services;
- (c) Particularly when they are accessories or replacement parts, it is crucial to describe the intended purpose of a good or service when using a trademark.

THE USA

The fair use defence in trademark law in the US is frequently referred to as "trademark fair use." The exception of “Fair use” is given under “section 45”²⁰⁶ of the USA Trademark Act, 1946.

Types of fair Use

1. Descriptive Fair Use:

This defence is used when there is a use of another person's trademark to identify the user's

²⁰³“Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994”.

²⁰⁴“The owner has the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.”

²⁰⁵“First Council Directive 89/104/EEC”.

²⁰⁶“The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or
(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any non-commercial use of a mark”.

product or service. Only where the disputed trademark has a descriptive meaning, and the same mark has a secondary meaning as a trademark, this defence can be used.²⁰⁷ It is also known as “Classic Fair Use”.

Example- Utilizing the phrase "sweet-tart" to describe a cranberry beverage despite a candy company's "SweeTarts" trademark is considered Descriptive fair use.

THE DEFENCE OF DESCRIPTIVE FAIR USE DOES NOT APPLY IN THE FOLLOWING CASES-

- Where the trademark is merely suggestive, such as when it takes assumption or mind to recognize the nature of the product or services, like the word "*TIDE for laundry detergent*", or where the mark is arbitrary, such as when the word or phrase has no connection with the products or services for which it is used, like the word "APPLE" for computers, or where the mark is fanciful, such as when an original word is registered as a brand name like- Nike.
- The use is not a descriptive use if the defendant employs the mark as a trademark or if the mark is used in a suggestive manner. If the defendant only uses a trademark as a descriptive term or phrase to appropriately depict something, which is considered fair use.

2. Nominative Fair Use:

The term "nominative usage" refers to the usage of a trademark to identify the plaintiff's products and services rather than the defendants. Nominative use is defined as use that "names" the rightful owner of the mark.²⁰⁸ The defendant may use a plaintiff's trademark to recognise the plaintiff's products under the nominative fair use doctrine “if there is no likelihood of confusion regarding the origin of the defendant's product or sponsorship or association by the mark's holder”.²⁰⁹

As long as the intent behind or result of the use of a mark does not lead to any form of doubt

²⁰⁷ *Supra* note 201.

²⁰⁸ “Chadha & Chadha Intellectual Property Law Firm”, “To Use or Not to Use: Understanding the Concept of Nominative Fair Use”, “<https://www.lexology.com/library/detail.aspx?g=82b78d04-41f5-4181-a87a-aadb0d04c9c7#:~:text=In%20the%20simplest%20of%20words,mark%20owner's%20goods%20or%20services>”

²⁰⁹ “Akerman LLP - Marks, Works & Secrets, Nominative Fair Use: The Second Circuit Joins Neither The Third Nor Ninth Circuits In Its Approach, <https://www.jdsupra.com/legalnews/nominative-fair-use-the-second-circuit-97807/>”

regarding the origin of the products or services, a third party is protected from trademark infringement lawsuits. *“News, blogs, commentary, criticism, parody, comparative advertising, and other non-commercial uses of a registered trademark are all covered by the concept of normative fair use”*.²¹⁰

For example:

When in a case where the auto repairing shop advertises that it repairs Fiats and BMWs. The mark “Fiats and BMWs” used are originally cars produced by the respective Motor Company, and use was just asserting that it is capable to repair those cars it was held as nominative fair use.

Origin of “Nominative Fair Use”

The notion of "Normative Fair Use" was first, brought up²¹¹ in the case *"New Kids on the Block Vs. News America Publishing, Inc."*²¹², in which a newspaper invited its readers to vote for their favorite singer in relation to a concert recently held by the well-known music group "New Kids on the Block." When the band sued for trademark infringement over the use of their brand name, the court ruled that the newspaper survey qualified as nominative fair use because it was done without any sponsorship or affiliation received from the brand owners and also there were no other means to gather public opinion.

The following conditions must be met by a user in order to be considered for nominative fair use, according to the Court:

- 1) *“The owner's registered trademark cannot be easily recognised without the use of the trademark”*;
- 2) *“The use of the mark must be restricted to identifying the product or services”*; and
- 3) *“The user must refrain from using the mark in any way that could be interpreted as being sponsored by or encouraged by the trademark holder”*.

In the case of *“Playboy Enterprises, Inc. Vs Welles”*²¹³, defendant Terri Welles, A Playboy Playmate who applied the phrase "Playmate of the Year" as metatags on her website was accused of violating trademark laws. The court held that the title was given to her by the trademark owner itself, so there is no infringement of the trademark. She was therefore permitted to apply for the trademark on her website.

The concept of nominative fair use must be applied with extreme care to distinguish between

²¹⁰ *Supra* note 204.

²¹¹ *Supra* note 208.

²¹² “Inc 971 F.2d 302 (9th Cir. 1992)”.

²¹³ “279 F.3d 796 (9th Cir. 2002)”.

circumstances where a registered trademark is used solely to gain unfairly benefit from the established reputation of the same.

In contrast to the other two, the nominative fair use is more contentious and challenging since it permits the use of a third party's trademark so far as there are no similarities or chances of ambiguity between the defendant and plaintiff's marks.²¹⁴

India's Scenario relating to the doctrine of fair Use

Since trademarks are the sole property of their registered owners, any unauthorised usage of a trademark by another party is an abuse of the owner's rights. But the Doctrine of "*fair use*" is an exception to these special rights. Fair use implies that the work should be used fairly. The Trademark Act 1999, which provides provisions related to the protection, prevention and registration of Trademarks in India, does not explicitly mention the definition of fair use but makes an exception for the doctrine of fair dealing.

The Trademark owner's exclusive rights are significantly reduced by fair dealing. The courts have frequently construed it by evaluating the financial impact it has on the trademark owner. The use can qualify as fair dealing if the economic impact is minimal.

Provisions under Trade Marks Act, 1999: The registered Trademark grants, its owner an exclusive and negative right to exclude others to adopt, use or register a mark identical to or misleading similar to their own. This granted privilege is not a qualified one, it is subject to the limitation of fair use. The notion of "fair use" is incorporated into the Trade Marks Act, 1999 (the "Act") under Section 30, which is an affirmative defence available against a claim of infringement by the owner of a registered trademark.²¹⁵

Previously, the 'concept of fair use' was mentioned under Sec 30 of the "*Trade and Merchandise Act, of 1958*". The Act grants fair use only a limited perspective. The following are the permitted fair use provided in the section-

(a) "*use in consonance with conditions or limitations of sale or export*";

²¹⁴ "Fair Enough: The "Fair Use" Defense to Trademark Infringement, <https://www.jaburgwilk.com/news-publications/fair-enough-the-fair-use-defense-to-trademark-infringement/>"

²¹⁵ Doctrine of 'Nominative Fair Use' Under Trademark Law, by IPR News | Jul 20, 2022
<https://unimarkslegal.com/blog/trademark-law/doctrine-of-nominative-fair-use-under-trademark-law/>

(b) “use by acquiescence”

(c) “use denoting adaptability being an accessory to another trademarked good” or

(d) “honest concurrent use”

These above provisions of the 1958 Act were *Pari Materia* with the 1938 Act in the UK.²¹⁶ The “*Yeast-Vite*” case, decided by the House of Lords in 1934, served as the foundation for the legislation relating to the idea of “Fair use” under Indian Trademark Law.²¹⁷ The plaintiffs, in this case,²¹⁸ filed a motion to stop the defendants from using the registered trademark “Yeast-Vite” in connection with their products. The defendants used “Yeast- Tablets” as a replacement for “Yeast-Vite” when using the company's products. It was determined that the user set the defendant's products apart from those of the plaintiffs. The House of Lords concluded held that there was no infringement because the purported mark had to be used to identify the source of the products as coming from him.

The court also held that the test of usage under the applicable provision is to evaluate from the standpoint of an average cautious consumer of the product while also checking the components of deceit. In instances of adoptive “use” of the plaintiff's trademark, the burden of proof shifts to the defendant.²¹⁹

Present Scenario: Although the core of the law is still the same under the “*Trade Marks Act of 1999*”, as it was under “the Act of 1958”, the grounds for finding an infringement have been greatly expanded to include protection from passing off, dilution, tarnishment of marks, as well as unfair, practises in comparative advertising.

Thus, the Trade Marks Act of 1999's provides a two-step fair use criterion by which it will not be an infringement of a registered trademark if:²²⁰

1. The use is by honest commercial matters and
2. The usage doesn't unfairly exploit the registered trademark's unique qualities or reputation or damage them in any other way.

²¹⁶ Sec 29 of the Trade and Merchandising Act, 1958 has been a re modified version of the UK Act of 1938, which itself was amended under the considerations of the Board of Trade: Trade Marks Committee, 1933 (Goschen Committee); for more discussions see <http://www.nationalarchives.gov.uk>

²¹⁷ Sarathi, Vepa P, *The Trade and Merchandising Act, 1958*, 2nd Edition (1982).

²¹⁸ *Irving's Yeast-Vite Ld. v. F.A. Horsenail*, (1934) 51 R.P.C 110.

²¹⁹ *Banga Watch Company v. N.V. Phillips*, AIR 1983 P&H 418

²²⁰ “The Trademark Act, 1999, Section 30(1) specifically establishes the following general conditions”:

a) “Use is in conformity with ethical standards in business or industry [bona fide use]”;

b) “Use does not in any way compromise the trademark's reputation or unique character or unfairly exploit it.”

Types of Fair Use in Trade Marks Act, 1999

1. Descriptive Fair use

In India, according to *Section 30(2)(a) of the Trade Marks Act, 1999*,²²¹ “the defence of descriptive fair use, is applied where the registered mark is used about goods or services to describe the nature, value, quality, proposed use, worth, geographical origin, manufacturing time of goods or the time of rendering of services, or any other features of goods or services”. Permission of fair use under section 30(2) (a) of The Trademark Act, 1999 is only given in the interest of free competition.

The Delhi High Court in the case of “*Carlsberg India Pvt. Ltd v. Radico Khaitan Ltd*”²²² stated that in an action for infringement, the 'fair use defence' is available solely to cases when the alleged infringer exploits a trademark only in a descriptive sense, as opposed to the trademark infringement. Therefore, the likelihood of infringement remains low if a mark is employed in a way that makes it likely that it will be interpreted as an indication of origin.²²³ According to Section 30 of the Act, an assessment of such use must be made.

Even while these rulings offer great guidelines for fair uses, the courts may still need to look into the other factors to determine whether there has been an infringement. This is especially true in light of the TRIPS agreement's requirement for the "balanced interest" of the owner and the third party, to which India is a party.

2. Nominative fair use

The nominative fair use defence has been accepted by courts all around the world while dealing with infringement proceedings. “Nominative fair use” is a permitted exception to the trademark's exclusive use right, as per the Trademark Act of 1999.

According to “*Section 30(2)(d) of the Trade Marks Act of 1999*”²²⁴, *nominative fair use by a third party is not regarded as trademark infringement as long as neither the purpose behind the use of the mark nor the result of it casts any doubt as to its source of commerce*”.

To put it another way, the law of nominative fair use allows a defendant to use a plaintiff's

²²¹ The Trade Marks Act, 1999, Section 30(2)(a).

²²² *Carlsberg India Pvt. Ltd v. Radico Khaitan Ltd* FAO (OS) 549 of 2011, 567 of 2011

²²³ *Durga Dutt Sharma v. Navaratna Pharmacy Laboratories*, AIR 1965 SC 980.

²²⁴ “Section 30 (2)(d) of The Trademark Act, 1999” provides that: “the use of a trademark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act r might for the time being be so used if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be”.

trademark to identify the plaintiff's goods as long as there is no chance of confusion regarding the source of the defendant's product or the mark holder's sponsorship or involvement.²²⁵ As an exception to trademark infringement that has been confirmed by Indian courts, the defence of nominative use is permitted in certain circumstances in order to safeguard the rights and interests of the brand owner.

In order to be considered under the defence of normative use, the defendant must prove that he/she was required to use the registered mark in question in order to identify their own product.

Judicial Pronouncements related to Fair Use

The Chennai High Court held the following in the case of *"Consim Info Pvt. Ltd vs Google India Ltd"*²²⁶.

"A usage is deemed an authorized nominative fair use if it fits three criteria, namely,

- 1. The contested commodity or service must be one that cannot be easily identified without the use of the trademark;*
- 2. Just as much of the mark or marks may be used to identify the good or service as is reasonably necessary; and*
- 3. The user must not use the mark in any way that might be seen as being sponsored by or endorsing the trademark proprietor."*

In the case of *"Hawkins Cookers Ltd. Vs Murugan Enterprises"*,²²⁷ Hawkins Cookers Limited, the owner of the trademark "Hawkins," which is used on a variety of items, including pressure cooker gaskets, filed a lawsuit against the defendants, Murugan Enterprises, for using their mark on the gaskets supplied by the defendants. The respondents claimed that the use of the Hawkins trademark was incidental given that they already owned the well-known *"Mayur"* brand, which prominently featured a peacock on its product packaging.

In this instance, the Delhi High Court determined that no reasonable customer or purchaser could conclude that the "Hawkins" brand of pressure cookers and the *"Mayur"* brand of gaskets were in any way related commercially. The court added that the defendant's use of the "Hawkins" mark was limited to demonstrating the product's appropriateness for use as an accessory item in a Hawkins pressure cooker and that this usage would clearly fall under the

²²⁵ "Nominative Fair Use: The Second Circuit Joins Neither the Third nor Ninth Circuits In Its Approach", <https://www.jdsupra.com/legalnews/nominative-fair-use-the-second-circuit-97807/>

²²⁶ *Consim Info Pvt. Ltd vs Google India Pvt. Ltd* (2010(6) CTC 813)

²²⁷ *Hawkins Cookers vs. Murugan Enterprises* (2008) 36 PTC 290 (Del).

exception established by Section 30 of the Trademarks Act, 1999. Neither had Murugan Enterprises attempted to establish a relationship between the two or attempted to make money off of Hawkins' trademark.

The court additionally stated that "honest use" has been met in the aforementioned situation. According to the court's opinion, the deception should be such that consumers would assume the mark is indicative of the same being a plaintiff's trademark in order for Hawkins' filing of the lawsuit to succeed in creating a monopoly on these (gaskets) supporting products in order to prevent competition.

The case went in the appeal²²⁸, and this time court held that in the use of the sentence "suitable for HAWKINS Pressure Cookers" the defendant had used the same font and colour for writing "HAWKINS" as it is used by the registered owner of the original trademark while doing so the defendant gives unjustified importance to the term "HAWKINS", and therefore, dismissing the defendant defence of normative fair use under section 30 (2) (d) of the Trade Marks Act, 1999. Thus, in order for the use of the registered trademark to be considered nominative fair use, the user must demonstrate that it was necessary for his product to be identified by the registered trademark.

Conclusions/Suggestions

The notion of fair use is an exemption to the owner of a trademark's special right guaranteed by the laws governing trademarks. This is seen as fair use defence when a trademark is used to allude to a trademark owner or their products or services for reporting in a news article, commentary on television or radio, in instances of constructive criticism and parody, as well as in instances of comparison advertising. However, the TRIPS agreement's requirement for the "balanced interest" of the owner and the third party must be taken into consideration when granting this right. Any person should only be allowed to use any registered trademark only when the usage of such mark preserves the uniqueness and sanctity of the registered mark and the registered user.

The courts must be extremely stringent to grant the remedy of fair use, even though it is exceedingly difficult for a user to prove all of the ingredients mentioned above. It should not be permitted for anybody and everyone to utilise a trademark that serves as the brand identification of a company. When evaluating the relief of fair use, one should take into account the labour, time, money, and effort the trademark owner invested in making the mark unique.

²²⁸ Hawkins Cookers vs. Murugan Enterprises (92012) (50) PTC 389 (Del-DB)

Few suggestions

1. The definition of Fair use has to be explicitly mentioned in the Trademark Act, of 1999 as it is not defined under the act. What might be fair dealing depends from case to case and courts decide by applying common sense and fundamental logic? There must be a specific definition provided under the act.
2. The concept of nominative fair use is more contentious and challenging since it permits the use of a third party's trademark so long as there are no similarities or chances of confusion between the defendant's and plaintiff's marks, thus the court has to be more stringent while granting the relief of fair use.

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Analysis of Fair Use of Sound Recordings in Marriages with Reference to Section 52(1) (za) of Copyright Act, 1957

Nilesh Beliraya K²²⁹

ABSTRACT

It is not the case that marriage ceremonies were never performed without music or sound recording. But with the advent of technology, sound recordings and Bollywood music are being used frequently now a day's. Use of music and sound recording have become 'expression' of not only the joy and happiness but also the social status. This is happening without even bothering about the fact that such 'expression' being 'original' might be already protected by the copyright law. Moreover, outsourcing the management of marriage ceremony from the event management companies has turned these personal ceremonies into a pomp and show. This conversion necessarily invites the objection from the owner of the copyright over such sound recordings. The reason is obvious that such commercial use is even without getting license of the owner of sound recording, let's not talk about sharing of the benefits with them. So, in the backdrop of these situations, the author has tried, in this article, to explore and discuss the scope and permissibility of using sound recordings in the marriage ceremonies with the help of leading Case laws.

Keywords: Sound-recording, Public use, Copyright, Fair use, Copyright Society.

Introduction

Recently, Delhi High court encountered an interesting suit wherein a 'Copyright Society' filed a case against an event management company for violation of copyright in music by playing copyright protected music without obtaining requisite licence.²³⁰ The defendants contended that usage of sound recording in marriages was protected under Section 52(1) (za). The High Court was of the view that the matter was a significant legal issue and had large-scale implications for artists, societies and other stakeholders.²³¹ Therefore, it appointed an expert to

²²⁹ B.B.A., LL.B. (Hons.) 4th Year, Chanakya National Law University, Patna.

²³⁰ Phonographic Performance Ltd v. Lookpart Exhibition, CS (COMM) 188/2022 & 4772/2022.

²³¹ See Para No. 4 in Phonographic Performance Ltd v. Lookpart Exhibitions, CS (COMM) 188/2022 & 4772/2022.

look into the matter.²³²

However, the court did not get an opportunity to consider the expert recommendation as the case was amicably settled.²³³ Nonetheless, this recent case has reignited the discussion regarding the fairness of section 52(1)(za) and the embargo surrounding its application in the Indian scenario. In order to have thorough analysis of the applicability of section 52(1)(za), an understanding and scope of applicability of section 52 of the Copyrights Act, 1957 is quintessential.

Section 52 of the Copyrights Act 1957

The Copyrights Act 1957 provides protection to i) original, literary, dramatic, music and artistic work, ii) cinematography films iii) sound recordings.²³⁴ Any infringement of a copyrighted work shall face civil, criminal and administrative proceedings.²³⁵ However, under Section 52 of the act an umbrella has been provided under which various acts are held not to be copyright infringement as they are considered to be fair dealing.

This includes section 52(1)(za) which holds performance or communication to the public of literary, dramatic or music work in the course of any religious ceremony or an official ceremony by the government not to be infringement. This provision contains an *explanatory clause* which specifically includes marriage procession and other marriage related activity under 'religious ceremony'. Thus, any music played during the baraat, haldi, reception or any other marriage related activity shall not be considered as a copyright infringement.

Even though the provision looks straight forward and free of ambiguity, it gives rise to various critical questions such as transmission of music to the 'public', monetisation of music work by an 'event management and its justifiability etc., Now that we have understood the provision it is pertinent to note how the legislative intent regarding section 52(1) (za) has evolved.

Section 52(1)(za) and Its Jurisprudence

With regard to the applicability of section 52(1)(za) the courts have been clear that the exemption is not to be taken for granted and the applicability of the provision shall be dependent upon the facts and circumstances of each case.²³⁶ In the case of *Devendra Kumar*

²³² Delhi High Court seeks Prof. Arul George Scaria's opinion on use music in marriage ceremony, available at, <https://www.bananaip.com/ip-news-center/delhi-high-court-seeks-prof-arul-george-scarias-opinion-on-use-of-Music-in-marriage-ceremonies/> (Last visited on 11.37 AM 19th December 2022).

²³³ See order dated 10th October 2022 in Phonographic Ltd v. Lookpart Exhibitions, CS (COMM) 188/2022 & 4772/2022.

²³⁴ The Copyrights Act, 1957, s.13, No. 14, Acts of the parliament, 1957 (India).

²³⁵ The Copyright Act, 1957, ss. 51, 62, No. 14, Acts of the Parliament, 1957 (India).

²³⁶ *Devendra Kumar Ramachandra Dwivedi v. State of Gujarat and Ors*, MANU/GJ/0440/2009.

*Ramachandra Dwivedi*²³⁷ the Gujarat High court rejected the contention of the plaintiff who was seeking an injunction against the action of the defendants who were claiming royalties for playing Garba and Dandiya in procession etc., In 2019, the copyright office released a notification stating ‘no licence is required for playing or utilisation of any sound recording in the course of religious ceremony including a marriage procession and other social festivities associated with a marriage.’²³⁸ However, the notice was subsequently challenged and the Punjab and Haryana high court ruled that the executive (here in this case the Copyright Office) has no authority under the Copyright Act to clarify or interpret the applicability of the law through public notices.²³⁹ The court’s decision was powered by the rationale that validating such notices would take away the right of a copyright owner to initiate proceedings for infringement of copyright.

Apart from a handful of High court judgements there is hardly any judgement, report or any legislative commentary that expands or clarifies the scope of use of sound recording in marriages. The courts have been keener to approach this provision on a fact-by-fact basis as setting up a broad umbrella of precedence may not essentially fit into all types of circumstances. Even though, the Delhi High court could not utilise the expert report in the case of *Phonographic Performance Ltd*, the report²⁴⁰ is a relevant and probably the most exhaustive piece of reference upon the scope of section 52(1)(za).

Section 52(1)(za) vis-à-vis Public Performance

One of the primary accusations against the exemption to usage of sound recording in marriages is that recordings played in the marriages amount to ‘public performance’ and thereby violates the rights of the copyright holder. Therefore, it becomes imperative to scrutinise the definition and ambit of ‘public performance’. The Copyright Act, 1957 does not define ‘Public Performance’ nor the term ‘Public’. The act only defines the term ‘Public use’²⁴¹. The Indian Courts have largely referred to English Jurisprudence to determine the scope of the term ‘Public’. In the Case of *Garaware Plastic and Polyester Ltd*²⁴² Bombay HC referring to various case laws and commentaries highlighted three pathways to determine the scope of “public”-

²³⁷ *Supra* note 236.

²³⁸ Notice dated August 27th 2019, available at, https://copyright.gov.in/Latest_Notice37.aspx

²³⁹ *Novex Communication Pvt. Ltd v. UOI & Anr*, CWP NO. 28758 of 2019.

²⁴⁰ *Phonographic Performance Ltd v. Lookpart exhibition CS(COMM) 188/2022 & 4772/2022* (Submission on behalf Dr. Arun George Scalia, the expert appointed under R. 31of the Delhi High Court Intellectual Property rights division)

²⁴¹ The Copyright Act, 1957 s.2 (ff) No. 14, Acts of the Parliament, 1957 (India).

²⁴² *Garaware Plastics & Polyester Ltd v. Telelink*, AIR 1989, Bom 331.

(1) the character of audience and whether it can be described as a private or domestic audience consisting of family members or members of the household, (2) whether the audience in relation to the owner of the copyright can be so considered and (3) whether permitting such performance would in any way whittle down the protection given to the author of a copyright under the Copyright Act resulting in the owner being deprived of monetary gains out of his intellectual property”.

The Courts might have pronounced pathways to determine ‘public’ but also have cautioned that a specific definition would not be possible. The question of what is ‘public’ ought not to be considered in the abstract, and in isolation, but in the context of the definition of ‘infringement’ of a copyrighted work, under Section 51.²⁴³

Therefore, the question of whether section 52(1) (za) is and its entitlement leads to public performance of a copyrighted work is specific to each case and a general answer cannot be ideal. Dr. Arun Lal Scalia, the expert appointed by Delhi High Court suggests that *though many of the marriage related ceremonies and festivities in India are held in public spaces, access to those events is generally restricted to the family/ social circles of the partners in the marriage. Such ceremonies and festivities may therefore be considered by a Court as private events in public spaces.*

Section 52(1) (za) vis-à-vis monetisation

In order to avail the benefit of section 52 of Copyrights Act, the person seeking exemption under the provision should not have used the copyrighted work for monetary purposes.²⁴⁴ In case of marriages, the sound recordings are played by Event Planners, Disco-jockeys and other organisers who are paid for their services. Is this not a type of monetary gain via use of a copyrighted product? The defence of the said parties has always been that the organisers are being paid for their service of management and not specifically for playing the music. But, with the rise of event organisers and management groups, it is giving rise to teams that specifically handle music. Under the veil of Section 52(1) (za), the organisers are garnering monetary benefits from a copyrighted product. This leads to violation of privacy of the copyright holders.

Section 52(1) (za) vis-à-vis privacy of the Copyright holders-

Marriage is one of the most important social institutions in the Indian socio-cultural context. It is often viewed as *“one of the sound social institutions to bring harmony and integration in*

²⁴³ IPRS v. Aditya Pandey, 2011 SCC Online Del 3113.

²⁴⁴ India TV v. Yashraj Films, 2013 (53) PTC (Del). University of Oxford v. Rameshwari Photocopying Press, (2016) 16 DRJ (SN) 678.

social fabric".²⁴⁵ Marriage across the country may encompass various traditions and customs, however the use of music in the marriage remains constant. With the rapid rise of use of sound recordings in the marriage and marriage related ceremonies, the privacy of the copyright holder with regard to his work is at grave risk. Copyright holder has a right to choose who can spectate/witness/view his/her work. However, the risk of violation of the same looms large with increase in liberties utilised under section 52(1) (za).

Conclusion and Recommendations-

Exemption of Copyright protection for religious purposes is not unique to India. Copyright Act of USA²⁴⁶ as well as that of Singapore²⁴⁷ exempt the use of copyrighted work for religious purposes. The International agreement and treaties also make way for countries discretion with regard to giving exemptions to copyright infringement.²⁴⁸ The problem with regard to India lies not in the autonomy that the laws provide but the widespread cultural practices and ethos surrounding it and the presence of parasites who take use of the opportunity to plunder law. So, what's a solution to this problem? Ideally, a precedent from the Supreme Court with regard to application of section 52(1) (za) might make things simpler. However, as Prof. Scaria, Hon. High Courts and this author pointed out it would not be possible to introduce a one thumb rule to all cases and the validity of 'fair use of sound-recording in marriages' have to be decided on a case-by-case basis. Even though it appears more cumbersome, complex and time-consuming introduction of one-rule to fit all would only further complicate this labyrinth and increase the myriad of legal dilemmas.

²⁴⁵ Valasamma Paul v. Cochin University, (1996) 3 SCC 545.

²⁴⁶ The Copyrights Act, 17 U.S.C. s. 110 (3) (1976).

²⁴⁷ The Copyrights Act, s. 42 (1987).

²⁴⁸ Berne Convention & Article 13 of the TRIPS agreement.



Challenges in IPR Due to Digitalization

Anchal²⁴⁹

ABSTRACT

Intellectual property is the product of creativity of human mind. Gradual development of humanity and their need to adapt to the changing problems compelled them to think and evolve new solutions to such problems. Earlier, such solutions as intellectual property was considered as public goods. But after seventieth century, the evolving of commercial aspect necessitated many States to intervene by granting monopoly rights to the inventor in various forms like, patent, copyright, trademarks etc. Thus, the concept of IPR emerged as a tool to balance the individual interest and the public interest so that after a fixed term such IPR would be available for all. However, during the term of protection no unauthorised person could have appropriate it without permission of the owner of such IPR. Now, since the IT revolution in the 19th century, such misappropriation/infringement of IPR have become easier. So, in the light of these developments, this article discuss the various challenges and solutions to prevent infringements of IPR using the digital techniques itself.

Keywords: IPR, Digitization, Infringement, Digital Signature, CIPAM.

Introduction

The term "intellectual property rights" is used to describe a group of rights attached to a particular product that result from an individual's inventiveness or technical acumen. Due to the fact that many times entire enterprises are founded on one or more intellectual properties (IP), they are now viewed as fundamental business assets. The enterprises heavily rely on this IPs for their business. The primary cause of this is the commercialization of new ideas or useful items that result from a unique expression of a concept that are then packaged and offered for sale. Therefore, it is crucial to keep both the idealistic reasoning of maintaining the integrity of the artist or creator in terms of literary works and even technological breakthroughs, as well as the financial rights of the original owner of an expressed idea.²⁵⁰

²⁴⁹ B.B.A. LLB. (Hons.) 2nd Year, Chanakya National Law University, Patna.

²⁵⁰ Colas, Bernard. Appendix A: Summary of Barriers to the Transfer of Clean Technologies and Solutions for

Today, due to numerous expansions and advancements, new and developing applications for intellectual property rights are being acknowledged. In these circumstances, the necessity for a complete set of IP Laws at a worldwide level is felt strongly across all of the countries. However, each country has its own perceptions, expectations, and justifications for enforcing laws that unintentionally tend to harm the interests of some other countries. The laws that address these demands are different because the needs and expectations of a developing country are always different from those of a developed country.²⁵¹ Therefore, international agreements and conventions have been formed to sustain the IPR regime in order to meet the interests of every beneficiary worldwide.

As the years go by and new people come into the picture, beliefs and preconceptions shift, and the availability of fresh ideas shows that society is developing and changing. Every part of life requires new ideas because they challenge the current quo and promote advancement. Ideas can completely erase or reduce an issue by changing presumptions. A concept's owner will be shocked into rethinking or recreating it, leading to a better and enhanced version, if it is rejected. Even if the notion is accepted, if the owner is unable to accept "no" as an answer, he or she will not be able to pursue it all the way to its actualization in reality. Since the beautiful production of ideas that encourage the evolution process and query the very birth of any individual creation sustains the entire human race, the establishment of intellectual property is a very crucial and safe shelter for these ideas. Ideas can therefore challenge what was once just an assumption and now is a reality. By preserving the right of ownership and fostering a favourable environment for the advancement of research and development, the growth and development of intellectual property aids a person in preserving the dignity of ideas.

IPR in digital World

Digital rights and IPR the topic of privacy is crucial in the digital age, where main privacy concerns include unlawful data sharing, data integration, unethical data use, and unauthorised public revelation. The following are the key points to think about:

1. Should digitalization be compared to replication methods like utilising a Xerox machine?
2. Is digitalization a creative endeavour like translating between languages?

Exporters. Centre for International Governance Innovation, 2019, pp. 23–27, International Transfer of Clean Technologies: Mitigating Legal Obstacles

²⁵¹ Aksan, Anna-Maria. "Appropriate Health R&D and Intellectual Property Rights Reform in Developing Countries." *Economica*, vol. 80, no. 319, 2013, pp. 475–495.

3. Can the release of digitised documents through the Internet be regarded as a form of broadcasting or commercial distribution?

4. Can we view a database as a unique collection of works that requires copyright protection?

5. What does "fair usage" mean in the context of the Internet?

6. What issues are the library community's top priorities?

7. How can the public make fair use of those works in the digital setting if access is restricted by the copyright owner?

The aforementioned problems are unique to the library. The libraries have made it possible for patrons to read a document, browse the entire collection, conduct a catalogue search, obtain Xerox copies of articles for research and educational purposes, obtain photocopies of articles from other libraries or clearinghouses, disseminate reprinted copies of documents widely for public awareness, and use the interlibrary loan service. How long will these activities last in the digital era? If digitization is viewed as a sort of reproduction, it is evident that this process essentially transforms the original work into a digital format while being automated and devoid of human creativity. The digitalization is a transition from natural human language to machine language if it is viewed as a translation from one language to another. However, digitization lacks creativity and can be compared to reprography because it is a repetitive process. Only artistic creations are protected by the copyright. The simple conversion of an original document into a digital format cannot be regarded as innovative. Information transmission through the Internet is comparable to broadcasting, hence copyright laws do not apply.

Methods for Digital and Intellectual Property Protection:

By identifying and securing the content, limiting access, preserving the integrity of the work, and ensuring payment for access, digital rights management (DRM) technologies, also referred to as electronic rights management systems, ensure copyright. DRM technology blocks unauthorised users from accessing the content. User identification and passwords, as well as licence agreements, protect access. Technical protection measures are yet another technique to safeguard digital assets (TPM). These technologies assist publishing firms in safeguarding and preventing unauthorised usage of content including music, text, and video. If an author wishes to charge for the usage of their work, DRM technology can be used. TPM and DRM technologies are being used to sell and distribute an increasing amount of content online.

Cryptography: Cryptography is the most established technique for ensuring the security and privacy of data transferred through networks. Only the authorised user is able to decode the information since it has been scrambled (or encrypted) to make it obscure or challenging to interpret (or decrypt). However, encryption only protects the work during transmission or distribution. The job provides no defence once it has been figured out.

Using digital technologies, watermarking

A watermark is a digital signal or pattern inserted into a digital document. It looks similar to the electronic on-screen emblem used by TV broadcasters. A unique identifier is used to identify the work. The message may contain information about ownership, sender, recipient, etc., as well as information concerning copyright licence. The system consists of a watermark generator, embedder, and watermark detector decoder. The authorised user can delete these watermarks using a pre-set technique. Watermarking technology is frequently used to protect multimedia creations.

Using digital signatures

A digital signature includes, among other things, details about the sender, the recipient, the date, the time, and any unique codes. This information may be included in digital items. Digitally bound and marked software is made ready for distribution to a particular customer. Digitally signed fingerprints guarantee a document's validity and prevent unauthorised copying.

Electronic Marking:

With this method, the system creates a special mark that is automatically linked to each copy of the document. In electronic publication, where papers are printed, duplicated, or faxed, this method is employed to preserve copyright.

Challenges due to Infringement of IPR

As a signatory to the Accord on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and a member of the World Trade Organization, India is expected to harmonise its intellectual property laws with the TRIPS agreement. Making laws is difficult, but so is putting them into practise since the Indian government must find a balance between the demands of the populace and the rights of patent holders. Given that foreign companies file the majority of India's patent applications, the subject has grown even more delicate. For instance, the number of

applications submitted by foreign applicants was more than double (32,304) those of Indian nationals, according to data from the Indian IP office's annual report for 2017–2018.

Indian Patent Rights Issuance and Protection Challenges

The Indian Patent Demonstration has explicit arrangements, covered under Segment 3, that make the patentability of an innovation connecting with topic, for example, a) subordinates of a drug; b) patentability of foundational microorganisms; c) symptomatic techniques and packs; d) secluded DNA groupings; e) PC related creations, and so on non-patentable topic. These arrangements are notwithstanding the worldwide patentability necessities for creations to have oddity, imaginative step, and modern appropriateness. These inventions are subject to a higher standard of inspection and scrutiny as a result. Although the Indian Patent Office has released guidelines regarding the patentability of software, biotech, and pharmaceutical inventions, patent holders nevertheless face the actual difficulties listed below:

(a) Inventions relating to computers: Patentability of algorithms or computer programmes as a whole is prohibited by Section 3(k). All computer-related inventions by default face this issue. With several controllers (at the patent office) formulating their own opinions regarding the necessary hardware and whether it must satisfy the patentability requirements, the result in such cases is inconsistent.

(b) The capacity to patent medicinal substance derivatives: The patentability of a pharmaceutical compound's derivatives is constrained by Section 3(d). To get over Section 3's barrier, a derivative must have a materially different level of therapeutic efficacy from the original drug (d). The Section 3(d) objection should, theoretically, only be brought up for derivatives of pharmaceutical substances, according to the justifications and judicial rulings. Even in the case of novel compounds, the issue is generally made for all applications involving pharmaceutical medications.

(c) The ability to patent in the field of life sciences and biotechnology: Because in-vitro diagnostic kits and procedures fall under the category of diagnostic/treatment methods, the life sciences industry faces challenges regarding the patentability of these products. Additionally, isolated DNA sequences are the focus of criticisms for failing to meet the novelty criteria. Therefore, the patentee encounters difficulties persuading the controller of the subject matter's patentability under such circumstances.

India's Difficulties in Enforcing Patent Rights

In India, civil courts can be used to enforce patent rights. There aren't any specialised IP courts established up to handle cases, though. Some of the notable difficulties are:

(a) The backlog and the timing of the decision: The primary difficulty in enforcing patent rights is the length of time it takes for the court to reach a judgement. If the opposing party challenges the validity of the patent, a patent case typically takes between five and seven years to reach a final verdict following a trial. Case management hearings and time-limited trials provided by the Commercial Courts Act aid in accelerating the procedure. The length of time it takes for a case to be decided, however, is influenced by the court's case backlog and the lack of judicial officers.

(b) Subject-matter authorities: The Indian Patent Act, Section 115, allows for the appointment of a scientific advisor to assist the courts in rendering judgments on technical issues. The courts have not regularly utilised the provision. The hiring of a technical specialist in patent infringement lawsuits will not only speed up the final decision process and aid to improve the quality of the result.

Favorable Developments

The Indian Patent Office's 2017–2018 Annual Report includes the following highlights:

- (a) 5.3% rise in filings from the previous year;
- (b) 108.2% rise in the examination rate;
- (c) 32.5% rise in the number of awarded patents;
- (d) The percentage of domestic patent applications filed increased to 32.5% from 29.2% in 2016-17.

Moreover, the recent changes in judicial doctrine imply that courts have begun issuing temporary restraining orders in patent cases. In the past, courts did not frequently do this because they believed that patent disputes were complex and so required a full trial. In the May 31 decision *Sterlite Technologies v. ZTT India Private*,²⁵² the court deemed injunctions in patent infringement cases to be the "need of the hour" and granted the injunction in this case. The court stated: "The life of a patent is limited, and further considering the time taken to determine whether there is patent infringement, non-grant of interim injunction often results

²⁵²(CS [COMM] 314/2019, IA No. 8386/2019, IA No. 8389/2019 & IA No. 8390/2019)

in, the defendant, even if ultimately found to have infringed the patent, continuing to reap fruits of infringement until the said determination."

Further, in some of the cases before the defendant could release the product, the plaintiff has been granted temporary injunction. In *Bristol-Myers Squibb & Ors v. Mr. JD Joshi & Anr*²⁵³ the Delhi High Court specifically made note of this in June 2015. The court stated: "The defendants have not released the product onto the market, and if they are prohibited from engaging in activities they have not yet started, no loss or irreparable harm will be caused to BDR Lifesciences Private Limited.

Therefore, it can be said that innovations will be important as India works to become a USD 5 trillion economy by 2024–2025. The Indian government must make an effort to overcome the substantive and procedural difficulties faced by IP holders.

Conclusion

The use of digital information raises a number of problems, including the publication of individual articles rather than complete issues of electronic journals, user-friendliness, incompatibility of hardware and software, formatting, graphics, scholarly acceptance, and obsolescence. In addition to safeguarding publishers' copyright, it's critical to safeguard users' and libraries' interests as well. It might be challenging to define what is acceptable, to what extent, and what constitutes violation in a digital context. Fair use may allow for minor infractions as long as they don't interfere with the owner's rights. It can be challenging to judge, understand fair use, access, and manage copyright law violations in the context of digital material. An owner of copyrights can hardly ever tell who has utilised their creation. It is vital to change the copyright legislation in this situation. In a digital setting, librarians have a duty to gather information and make it available to readers, even if it is in an electronic version. The purpose of copyright protection should be to promote creativity rather than to obstruct the use of knowledge. The librarians ought to act as a hub for the free exchange of information between the holders of copyright and the information's consumers.

Way Forward

The overwhelming variety of alternatives for product distribution in today's digital world presents fresh, constantly evolving obstacles. Owners of physical objects and digital contents are consistently and adaptably protecting their products within the worldwide IP legal system.

²⁵³ IA No. 15720/2009 in CS[OS] No. 2303/2009 and IA No. 5910/2013 in CS[OS] No. 679/2013)

However, neither judicial procedures nor regulatory action will ever be able to keep up with the rate of technical development or the pirates who try to defeat it. It's important to keep in mind that IP protection is necessary to promote innovation and maintain the diversity of creativity when planning your digital transformation and to incorporate such protective measures into your strategy. However, given that the fundamental idea of intellectual property protection has been challenged in the sharing economy, politicians and business leaders alike should consider novel and creative ways to compensate creators in a way that deters the infringement of rights.

Additionally, the Government of India has taken action to improve the IPR regime in the nation as a result of IPR's impact there. The National Intellectual Property Rights (IPR) Policy, which will serve as India's future road map for intellectual property, was approved in 2016. Among other things, it strives to raise awareness, encourage the development of IPRs, provide robust and effective IPR legislation, and modernise IPR administration.

In accordance with this strategy, the Cell for IPR Promotion and Management (CIPAM) has been established to streamline and simplify IP procedures as well as take action to increase IPR enforcement, commercialization, and awareness.

In India, where enforcement is lax and awareness is limited, protecting IPRs can be difficult. However, preserving copyrights, trademarks, and patents is essential for innovation and advancement. Even so, we still lag behind nations like China despite our remarkable advancement in the industrial, scientific, and economic fronts. A culture of invention and innovation will be fostered by effective IPR protection, which might help us quickly narrow that gap.



Joint Authorship of the Copyright

Garima Jargar²⁵⁴

ABSTRACT

The concept of 'Work in a Joint Authorship' is one of the oldest rights possessed by the people. This concept is ratified under the Copyright Act, 1957, which defines it as a work produced by the collaboration or collective initiative of two or more authors within which the contribution of each author is not distinct from the source contribution of the remaining authors. The subjective definition is not to be determined for joint authorship, which has been categorized as the role of judicial decision, suggestions, initiative, opinions of the jurist, and formal foreign court so, it is also essential to understand the Indian formal judgement and case laws. A provision statute similar to the UK copyright design, and patents act provides for joint authorship, which requires a significant amount of creative output. The joint author must participate in the written format and share the accountability for expressing ideas. Thus, in the light of these situations the author has discussed, in this article, the essentials of joint authorship, the problems in sharing the royalty to joint authors and at last has given suggestion to solve such problems.

Keyword: Copyright, Joint Authors, Fixation, Originality, Royalty.

Introduction

As per the understanding of the basic conceptual matter we, as a human always have a critical and intellectual mindset that everything which belongs to the individual should be under his or her possession irrespective of the nature or trait. In the contemporary world, globalization and privatization is also enrooting the subject matter in high concentration, as all the contribution have their own set of uniqueness which make the population astonish. From the ancient time till today each and every one wants their own signified credit which will be used as there earning as well as attribution for the defined work. In the historical contemplates all the rulers

²⁵⁴ B.A. LL.B., Maharashtra National Law University, Nagpur.

have their own antiques wherein their name has either been inscribed or have denoted their name as a remarkable critique.²⁵⁵ There is always a fear that what if the work will be forged or cheated, then to avoid these circumstances every person has a right to apply for the copyright. This particular concept is not a new phenomenon but rather it is considered as one of the oldest rights which is been possessed by the people.

In the current scenario the most common terminology that have been highlighted is ‘Work in a joint authorship’ which ultimately means that work in such an order that there should be collaboration among two or more authors within which every person contribute should be unique not distinct in nature. As Indian economy is known for the progressive growth which will welfare the nation with modern efficient thought however the copyright concept is been ratified under the Copyright Act, 1957. The concept of ‘joint authorship’ is every viable to define but though the understanding towards the term is quite tricky.²⁵⁶ An ambiguous subject for ascertaining the various factor for well-versing with the concept that has been defined under the act as- “a work which has been produced by the collaboration or collective initiative by two or more number of authors (person) within which the contribution of each author is not been labelled as distinct from the source contribution of the remaining authors”. However, the subjective definition is always not to be determined for joint authorship which have been categorized as the role of judicial decision, suggestions, initiative, opinions of the jurist, and formal foreign court that come into play.

As per the defined area segregated onto the codified intellectual property fundamental right is been relatively new, it is essential for analysing the understanding the Indian formal judgement and case laws on the subject for international levelled conventions.²⁵⁷

A provision statute which is similar to the worded under S. 2(z) of the act in India that is found within the UK legal procedure of the copyright design, and patents act. In the well-known authority wherein all the issue of copyright has been bifurcated as an essential ingredients for the joint authorship that would be provided in the defined sectors as – ‘a joint levelled author which must collaborate or cooperate with the other remaining author(s) for the production of the defined work. Subsequent and consequent authors which will not result in the defined set

²⁵⁵ Shilpa Sodhi, Joint Co-authorship in Copyrights, Legal services (28th Mar, 2022, 08:40 A.m.), <https://www.legalserviceindia.com/legal/article-7664-joint-co-authorship-in-copyrights.html>

²⁵⁶ Sofia Bhambari, Joint Authorship of copyright works, Sbambriasvocates (28th Mar, 2022, 10:50 A.M.), <https://www.sbhambriadvocates.com/post/joint-authorship-of-copyright-works>.

²⁵⁷ Sana Singh, Term and ownership of copyright, Mondaq (28th Mar, 2022, 12:30 P.M.), <https://www.mondaq.com/india/copyright/970282/term-and-ownership-of-copyright>

of work under joint authorship, however among the existence for the collaboration which must be questioned for the fact as well as degree.²⁵⁸ That the author must be providing with a significant amount of creative output for knowing the circumstances.’ Thus, for the joint author which is expected for contribution that have a significant amount of initiatives towards skills, examination tactics, labour, and efforts. Since the copy right should subsists for the expressing ideas in the literary work amount as the joint author must be participating in the written format and share the accountability for expressing the ideas.²⁵⁹

Research Questions

1. Do violation of right can be imposed in joint authorship of fixation towards the royalty?
2. Does the situation of proportionate principle can lead to rise of paternity and integrity rights of the holder?
3. According to the contemporary judgement, is there are any situation which give arise too the dispute for pleading of equal fixation towards joint authorship and publication authority?

Research Methodology

A standard form of doing the research and defined process such as philosophical perspectives, investigation regarding the crime scene, descriptive form of study, and scientific approach within which the researcher can gain an immense knowledge. It is a scientific discipline which pertains the definition and systematically, there are many appropriate ways through the discerning the subject matter of the scrutiny of the cases. Dealing with the adequate level of skills and approximation of the techniques for finding the relevant factors of the legal material for the adjudication of the judicial decisions. To cue from the defined decision of the legal research which can be bifurcated on a systematic finding as well as ascertainment of law within the identified topic or subject matter among this all the inquiry will be set into reviewing the judicial procedure. For making up the advancement in the field of science as well as law it is not an easy task to find out the vast mass of the legal statute which will be constantly under the

²⁵⁸ Copyright: Joint Authorship, Bird & Bird (29th Mar, 2022, 15:35 P.M.), <https://www.twobirds.com/en/insights/2019/global/copyright-joint-authorship>

²⁵⁹ Joint Authorship, University of California (29th Mar, 2022, 19:10 P.M.), <https://copyright.universityofcalifornia.edu/ownership/joint-works.html>

rectification process or amended according to the supplements referred to the rules, regulations, orders, directives principles, and doctrines that will require a categorised method into the probe for undertaking the principles for defining the reasons of the law. The research which regulated with the ambit of the boards that are taken into consideration by the legislators, jurist, lawyers, or the scholars who are been under the practice for several year.

Research Design and techniques or tools used

The method of research used in this project is doctrinal method and it will depend mainly on the secondary sources for this library form of research and the researcher has done some sort of sampling and data collection for better understanding of the defined project work. Since the topic chosen is more theoretical than analysis based, hence it is only appropriate to rely on works already produced on the topic. The doctrinal method is fully based on the given data which is used or already being published by some researchers or thinkers and that data is used in my research. The research part which is done by the practical skills then the analysis part becomes simpler. The research part which has further elaborate is Exploratory as well as Explanatory. As each topic will be well explained and well elaborated by the researcher and Exploratory to enhance the skill and technique understanding.

Within the topic which has been given to the researcher it is purely based on the Applied as well as pure legal research which elaborates as to find a perfect solution for diminishing the problem which can further be benefited for the public welfare and further it can be act under the press practical suggestion at the hands of the system. Within this subject the area where the research has been conducted have put under the criteria of practical knowledge within which it is live used by the people. The latter concentration is been under the observation on making the generalizing the work and formulation of the specified theory. The ideas have been originated because of various observations that have been discussed by some authors extensively. Justice as a matter of fact fails to have a perfect definition. Its purview changes with the change in situations and cases. It is both a political philosophy and a legal discourse. Hence, it is important to know the various areas where the concept is applied to know about the different ways of application. Justice is read more as a concept of fairness than a comprehensive moral doctrine which is applied to the structure of political and moral institutions.

Conditions which are precedent for Nationality or towards the Location of work

Although it is not at all necessary for believing in the joint authority of authorship for having a literal “writing” of the work, then they should be directly accountable for the appears and suggestion on the legal documents. As per the requirement which was to be described as the condition proportionate – ‘something which have an approximation to the penmanship’. According to the Indian Copyright based law, there are an ample of certain essential condition for conferring the possession over the work jointly that should be applied to all the authors irrespective of the trait.

1. If the doubt is been raised on the cases of the published work or the piece of work which is already been published that has to be first published in India or if the matter is been printed outside the boundaries of India then the author have to be holding the citizenship of Indian country o the date of publication (defined date where the piece of research have been published) or if the author is dead then there should be the information when he/she died, or he /she should be a citizen of India at the particulate time of his/her death time.
2. According to the case of matter of research of an unpublished work, bifurcating the matter other than work done by the architecture, author(s), at the specified time for creating the matter of work which has to be the citizen living in the Indian border or lastly should mandatorily possesses the domicile of Indian nation.
3. In the defined case of the work which is been performed by the architecture, and the work that has to be located in the stance of India.²⁶⁰

In the recent judgement and case law that has been elaborated in the English Appealing court who have set out for the legal alleged principles for considering the circumstances by deciding the situation that – whether the individuals are joint author or hold ay authorship of the copyright work or not. In the subsequent answering which was retrial by the English intellectual property enterprises court which was furtherance applied towards all these principles for taking the condition into consideration form wherein the legal principles can be applicable whenever there will be quantifying of the shared group of joint authors. Judgement and pronouncement which is solely concerned with the highlights towards importance for ensuring that the people on the same page have authorship and eventually hold the copyright of the defined work. This

²⁶⁰ Krupa Thakkar, What do you need to know about joint authorship in India?, Academike (30th Mar, 2022, 09:10 A.M.), <https://www.lawctopus.com/academike/joint-authorship-in-india/>

would be especially categorised as a true incident whenever there is more of individual involved in a piece of work that raise a question of getting the joint authorship arise.²⁶¹

Rights and obligation towards the Fixation of Royalty

Authorship and collaboration with the competent authority are established for the functioning of commonplace within the publishing industry that may be illustrator which includes the copyrighted material and stuff by which owned by the author. Whenever the occurrence of the numerical critiques happen then the issue have arisen for the rights of getting incentives for the work defined or have been done from the side of publisher and authors. Recognition over the act which have probably questioned the work of creator have been allotted with the safeguarding rights for further level of protection. Any type of assignment towards the copyright can be conformed for the following set of formalities that should be written in legal formatting and duly signed by the assignor of the contract which could be functioned by the agent for getting authorisation of the deed; and secondly identification of the work, nature if the matter, specification of the right which will be allotted, the duration of employment, territorial jurisdiction and extent over the work criteria, and lastly the amount of royalty which will be considered for the amount pay. All the above critique is mandatory for procedural formatting and protecting the rights of the author.²⁶²

The fixation of royalty depends upon the copyright licencing that will be conform for implied form of legality documents that should be over the bounding agreement, whenever the author is been implied within the copyrighted form. The copyright licence which has been authorised for the protection of the work that would be contrary towards the terms and ruling according to the rights that have already been licensed among the copyright societies which shall be settled as void.²⁶³ Furtherance, if the conditions defines that no copyright licence within the work that have make upon the cinematography that have filmed which can be affected upon the right of the authorship for claiming over an equal amount of share of the royalty and up to the consideration which would be payable in the situation like utilisation towards work and in other form of the communication in the public arena. Likewise, there will be no copyright

²⁶¹ Joint Authorship, University of California (30th Mar, 2022, 10:10 A.M.), <https://copyright.universityofcalifornia.edu/ownership/joint-works.html>

²⁶² Joint ownership and assignment of intellectual property rights, Lexology (30th Mar, 2022, 13:30 P.M.), <https://www.lexology.com/library/detail.aspx?g=6cf9c2fd-fc6c-4495-bce1-ef6921ee4aa>

²⁶³ Joint Authorship and Joint work, IP Law Glossary (30th Mar, 2022, 17:25 P.M.), <http://www.ipglossary.com/glossary/joint-authorship-joint-work/#.Ym7CkdpBxPZ>

infringement towards licencing in any of the work that make the sound recording which eventually do not harm any type of cinematography.²⁶⁴

Principles of the Joint Authorship: conditions applicable for possessing the copyright

Dealing and handling the form of outsets which will allow the appropriate arrangement which can be put in such a place that it can obtain over the assignment which were given to the authors or licenses for all the joint authors. for obtaining the appropriate amount of arrangement which can be put in the places for avoiding the rest issues that can be organized for investing in the field of copyright worked which can be inquiries and considered for the mitigating source of risk for resolving the issue of risk towards authorship disputes that can be obtained through the specified warranties and through indemnities from the purported among authors. According to the work which is done under the supervision of the joint authorship who would be contribute in the same efficient amount with distinct quality.²⁶⁵

- Collaboration – one of the most essential components of the joint authorship is to work collective and collaboration of the work which can differ in work but are not at all distinct. The work which is doe collectively is that type of matter which is produced for pursuant collaboration of the common design, wherein the undertake work which is performed jointly that should be possessing general outline for sharing the labour work. The important identification for the nature of interacting among the relevancy towards the fact of individual and among the nature of every person who have solely contributed with relation to the amount of work done. Another crucial element that would be recognised for the nature of interaction among individual suggestions and initiative for phrases wherein it can be provided under the editorial corrections and critique. Other than the course of the collaboration that they do not have any joint or co-author then the situation will be upheld by the single copyrights. Similarly, to the arm’s length subjective researcher that merely provides with some of the course of technical jargon, or an individual who merely act upon the sounding board that would not be a joint author. It is not been simple to handle the question of asking about the writing skills, as the author can collaborate in various different ways whenever it is been created for the working environment.

²⁶⁴ *Supra* note 260.

²⁶⁵ Anupriya Dhonchak, Lizzo’s Copyright victory in truth hurts: joint authorship and follow-on works in the music industries in india, Spicyip (30th Mar, 2022, 22:55 P.M.), <https://spicyip.com/2020/09/lizzos-copyright-victory-in-truth-hurts-and-joint-authorship-in-musical-works-in-india.html>

- Authorship – an individual who have not been held for the joint authorship that arise the situation wherein it is contributed in the ‘authorised’, in simpler word it can be must crucial for significant amount of the skill area that could be involved for the creation of the work. Furthermore, it is not been corrected for concluding the process that only the individual who does all the writing arena thing that can be author, herein the concept of the authorship involve a broader line towards the end for a literal way of dramatic concept which would include the tactics and principle that an individual possess - like ‘creating the content, selecting the facts or gathering the detailed form of concepts, or towards the emotion side of the people’.
- Contribution – one of the critical though mandatory principle wherein the work which will be categorised according to the amount of contribution which has been done of the individual, equal division of the work contribute to the expressive form of intellectual. For deciding the trait of work load it is subsequently categorised over the sufficient amount of justification in joint authorship that would test the contribution if element. This ultimately means if the author has to exercise in a free mode then the person should be creative and have an explicit choice for producing the relevant form of work which ultimately reflects the personality, suggestion towards the nature of matter, and stamping over the work which has been created.
- Non-distinctness from the contribution which is a little different from the actual individual contribution – a person which will not be settled as the joint author who have contributed in a distinct manner. In that particular case each and every author could be simply relying upon the copyright with the various different part. In the area of retrial as the court have considered by trying in the separate perspective and contribution which would bifurcate accordingly.²⁶⁶

Furtherance the law related to the copyright who have provided an author for creating the work for authorship that have at least first or primary instance, as the sole owner of the assignment even though the situation may imply the initial settlement of the sole ownership. Whenever there is more than one person who have involved in the defined authorship that have processed among the identity of the authors which do possess the rights and duties related to the authorship.²⁶⁷

²⁶⁶ Ananya Singh, the rights of the joint owners of intellectual property: an insight, I Pleaders (31th Mar, 2022, 11:25 A.M.), <https://blog.ipleaders.in/rights-joint-owners-intellectual-property-insight/>

²⁶⁷ Bharat Sharma and Eesha Das, Critical Analysis of Joint Ownership of copyright, ZEST IP (31st Mar, 2022, 15:40 P.M.), <https://zestip.com/critical-analysis-of-joint-ownership-of-copyright/>

Acts and critiques of the Authorship

1. Degree over the contribution for generating the thoughts and expression in different level – a mere arena of suggestion towards the ideas may be eventually used by the author or content generator in a piece of work which ultimately does not grant any type of joint authorship over the matter created. It was quite clear in the position of law and legal perspective that there would not be categorised onto the copyright over various set of ideas. Thus, within the order for claiming the joint authorship which was over the work as the claimant that should be contributed in the expression of perspective for the work which is generated. Such type of levelled contribution should be in need of non-equal contribution but as more of situation was in significant manner.
2. Tenants was in the common which cannot be termed as Joint tenants – joint authorship that can be settled for the own copyright as the tenant that was in common but eventually not be subjected as joint tenant. Within the absence of the perspective matter of any type of agreement even though towards the contrary statement – each of the implied equal share as o the death of one author or deceased author his or her share of contribution will go to the representative (legal heirs or legal ancestor). A situation wherein the joint authorship who have assign the rights for another circumstances without taking any prior permission from the remaining joint authors who have however showed the consent to all the joint authors as the primary requirement for granting the licensing of the occupation or else the interest for the purpose of copyright.
3. Right towards sue or been held convicted for violation – as a joint author who can sue or file any petition against the another party who have infringed and violated the rights or duties without getting any type of permission for the other side of the authors though it can be recovered through other set of remedial claims like compensation. However, it can be respect through the injuries who have been suffered by the shares for the copyright arena.
4. Terms over the copyrights – within the case law who have several conditions that have termed over the tenure of 60 years span which will be commenced after the death situation or deceased critiques. That ultimately depends on the varied level of factors that have several degrees of contribution and value towards the contribution.²⁶⁸

²⁶⁸ *Supra* note 260.

Speaking about the Case laws and pronouncement on Joint authorship within the international and national arena

Co-authorship, joint authorship, and collaboration usually emerge upon the commonplace within the publishing industry that arise with the situation of hiring and getting credit of their work. In many researches the publishers may not considered for the sole authorship whenever the commissioned of the work done by the publisher which may set a utility arena, if the publishers fails to satisfy the essentials among the author that grants over the rights which includes – copyright of ownership. For working under the critiques, possessing the rights for the work that would be surely owned that was exclusively right for the authorship, and in order to hire the authors in equal duties. The publishers have to compulsorily prevent for loss towards the right that could prove the qualification as the jointly segregated work which can arise through the work for creating an entirely portion for work in an efficient environment.²⁶⁹

Talking about the legal pronouncement – In the case of Institute for inner studies & Ors. V. Charlotte Anderson it was observed that the appellant has edited the matter and compiled all the lecture which was delivered. Wherein the prima facie of the given case law involve an adequate amount intellectual level of contribution towards the creativity of idea. Furthermore, the jurisdictional court also noted that after collecting, compiling, preparing the transcript, and scribing the lecture will be hard work. So, ultimately it was marked that the plaintiff could make the claim for contribution towards the authorship related to work. Similarly, there was another co-related judgement that give an expression over the joint authorship as Najma Heptulla v. Orient Longman Ltd. wherein the issue was elaborated as – whether the professor who have been translating and describing about the Maulana Azad ideology in English language which can be used as the joint authorship for working in the ‘India wins Freedom’ project. Accordingly, the high court deliver the judgement in both the language i.e. English and in Hindi for understanding the importance of subject matter. Thus, irrespective of the trait there were two people who have composed the pursuance over the work for the joint design which can be exercised through there intellects. Herein the joint work is compiled over the jurisdiction for getting the expression of thought in language of the work as the mode for understanding and medium for presentation of the work.²⁷⁰

In the case law of Ramesh Sippy v. Shaan Ranjeet Uttam Singh herein it was explained by Justice Kathawalla that made an essential highlight over the concerning matter of joint

²⁶⁹ *Supra* note 257.

²⁷⁰ *Supra* note 266.

authorship within the restricting area of partnership firm. In the LLP and legal partnership association it was held that the firm owns over the copyright statement as the individual partners as the joint owners of the copyright essentials. The creation over the thought which involve the various approaches that also include the film, so that all the partners can own their copyright. Joint authorship of the person means that the ownership of the copyright has to be categorised with all the stream for imposing the rights separately as well as jointly. This specifically implies that there is one joint authorship that cannot use any type of power or authority over his/her work without getting permission or granting other different joint authors within the absence of an implied form of agreement.²⁷¹

Other case law wherein the judgement was provided from Bombay High Court in the Angath Arts Private Limited v. Century Communications it was held that over the exploitation of the authorship for holding the copyright towards the protection of work in every manner likewise – assigning the matter, transferring, licensing over the thought, or sub-licensing that must happen on jointly within the concurrence of the other joint authors. Allahabad decision have been echoed over the similar viewpoint in the Nav Sahitya Prakash and Ors. V. Anand Kumar who have held upon the judgement of joint ownership over the copyright that could not be acted without the consent of other joint possession grant on license in the copyright holder.²⁷² The judgement which was also cited on the decision of Chancery Division in Powel v Head wherein it was been disclosed that if one of the joint authors have granted to the license without the mutual consent of the other, which does not bind over the former. As the final concluding result the other joint owners can hold the authority of suing the licensee for the violation of rights.²⁷³

In the case of Malabar Fisheries v CIT Kerala which was been decided in the apex court and Rajendra Kumar Sharma v. Brijendra Kumar Sharma which was been over ruled in the Allahabad high court. That elaborated about the post dissolution or conditions applicable for the resignation from the partnership wherein the partner is barely not allowed and entitled for using the co-relative created work which can be functioned without the permission of the other partners as well. In the Ramesh Sippy v. Shaan Ranjeet Uttam Singh wherein in this it was clearly specified that an important observation was totally been concerned towards the joint authorship within the partnership firm. Since the partnership institute as it has been associated

²⁷¹ *Supra* note 255.

²⁷² *Supra* note 267.

²⁷³ *Supra* note 265.

in the individual which was been held that whenever there is a partnership firms which was ultimately own the copyrights set of partners that are jointly owners of the copyright.²⁷⁴

Conclusion

It has been delivered evidently that all the above judicial pronouncement has their efficiency towards the jurisprudence which reflect the scenario of present subjective matter for the joint authorship that has evolved over a long period of time. However, the decision of various different judicial case whether it is of India or abroad it has been subjected through the settlement of the primary factor towards the joint authorship which is been actively involved for the creation of new idea and expression of the work. Examining all the factual information if a person have their literary subjective matter idea, artistic work trademark, and including the efforts for initiating the expression of thoughts, both of the person enjoy the rights of ownership but also one of the person is been held as the sufferer for exploitation of the fundamental rights. Consent and permission for taken or using the service holds an exclusive set of rights wherein no one is been solely benefited to the non-creditable work owner but also the person who have not initiated the doing. Thus, for collaboration within the future perspective that must enter into the contract for making the intention for collaborate upon the clearance or for avoiding the post scenario dispute. This is been undivided interest and mutual consultation have full right to sue, use, and licensing the work irrespective of the nature of work and extension towards their contribution.

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2. Copyright ownership: The Joint Authorship Doctrine, <https://corporate.findlaw.com/intellectual-property/copyright-ownership-the-joint-authorship-doctrine.html>
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²⁷⁴ *Supra* note 260.

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