

# The Indian Journal of Intellectual Property Law

**Jagdish Sagar**, What Is a Film, Who is its Author and Who Owns Copyright?

**Sanya Samtani**, IP and' Claims in India: Integrating International and Domestic Legal Methods

**Eashan Ghosh**, Survey of Contemporary Indian Case Law on Prior Publication of Designs

**Advika Muralidharan**, An Inky Enigma: The Challenges Associated with Copyright Protection for Tattoos

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**Veera Singh**, Comparative Analysis of Judicial Enforcement of Trademark Laws in Mauritius with India and South Africa



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## TABLE OF CONTENTS

<b>Editorial Note</b> .....	v
What is a film, Who is its Author and Who Owns Copyright? <i>Jagdish Sagar</i> .....	1
‘IP and’ Claims in India: Integrating International and Domestic Legal Methods <i>Sanya Samtani</i> .....	43
A Survey of Contemporary Indian Case Law on Prior Publication of Designs <i>Eashan Ghosh</i> .....	70
An Inky Enigma: the Challenges Associated With Copyright Protection for Tattoos <i>Advika Muralidharan</i> .....	99
The Waiver of The TRIPS Agreement For COVID-19 at The WTO: A Rhetorical Analysis <i>Emmanuel Oke</i> .....	128
Comparative Analysis of Judicial Enforcement of Trademark Laws in Mauritius With India And South Africa <i>Veera Singh</i> .....	170

## **EDITORIAL NOTE**

The Editorial Board is proud to present the Twelfth Volume of the Indian Journal of Intellectual Property Law (IJIPL). IJIPL is the flagship intellectual property law journal of NALSAR University of Law, Hyderabad. It is India's first student-run journal that is wholly devoted to the study of intellectual property law with eleven successful volumes. This year, we were delighted to receive a positive engagement and response from contributors to present a wide array of contemporary topics and issues in the field of intellectual property law. Accordingly, the Editorial Board for 2021-2022 has sought to publish and highlight diverse and enriching academic scholarship within the ambit of the Journal.

We would like to thank well-wishers and supports of IJIPL, including our Peer Reviewers: Prof. Peter Mezei, Prof. Sajid Shaikh, Prof. Akanksha Kumar, Prof. Kanika Dhingra, Prof. Abhijeet Kumar, Prof. M Sakthivel, and Prashant Reddy for their invaluable inputs and assistance during the editorial process.

To start off the volume, we have an article by Jagdish Sagar, concerning the dilemma regarding the distribution of copyright in the context of a film. The article elegantly traces the evolution of copyright law in relation to films, and engages in a comparative analysis as to who should be entitled to copyright in relation to a film. He compares the various solutions regarding ownership of a film in a cross-jurisdictional analysis, and explores the unity of the film. He makes the case for understanding a film not only as a collection of various works, but as an amalgamation and union of all the works which constitute it.

Next, we have an article by Sanya Samtani which provides a blueprint for the appropriate identification and interpretation of 'IP and' claims in the domestic Indian context. "IP and" claims refer to those areas of law which lie at the intersection of IP and this paper looks at interpreting those claims from the lens of constitutional law, public international law, and the interpretation of

statutes. Viewing ‘IP and’ claims through this lens provides clarity on the various overlapping bodies of law and the obligations they impose upon the State – both domestically and internationally. While she specifically looks at interpreting ‘IP and claims’ in the context of educational material, it provides an overall blueprint for how constitutional and other domestic actors can interpret them in consonance with various constitutional rights and obligations.

Then, we present an article by Eashan Ghosh, wherein he undertakes a comprehensive empirical survey of case laws post the enactment of the Designs Act, 2000. His article sheds light on the development of prior publication laws in instances of design infringement and on challenge to design registrations. The Act, enacted in 2000, expanded the ambit of prior publication to include publications not only from India, but from any other country. The author demonstrates different standards that the Courts have developed in India from forensic examination of prior publications to an enquiry more focussed on subjective relatability of publications. He makes a case for a layered enquiry which incorporates features from these different standards to ensure a more comprehensive and predictable methodology to determine any finding on prior publication of a design.

Next, we present Advika Muralidharan’s article on the challenges associated with affording copyright protection to tattoos. The author analyses whether copyright laws in general have taken into consideration the variety of challenges associated with providing intellectual property protection to tattoos and tattoos artists. At the outset, the author highlights the basic requirements of obtaining copyright protection, such as originality and fixation, and whether tattoos can satisfy these requirements. The lack of legal precedents on how tattoos fare in the current regime, is one of the reasons for persisting ambiguity, and in this context the stance taken by the Indian Copyright Office contributes to this ambiguity. The author believes moral

rights to one's own creation, as accepted by various jurisdictions across the world, is one way to afford copyright protection to tattoos. The author also goes beyond limiting tattoos to copyright protection laws, and showcases how tattoos can be protected using industrial designs; the interface of trademark law and tattoos, and the protection afforded by some social norms against trademark infringement; and lastly, integrating traditional cultural expressions into the IP framework to afford protection to designs rooted in traditional cultural expressions. While the nature of the tattoo industry avoids litigation as a means of dispute resolutions, the judiciary may be called on soon enough to concretely lay down the level and scope of protection offered to tattoos and tattoo artists.

Next, we have an article by Emmanuel Kolawole Oke, Lecturer in International IP Law at the University of Edinburgh, where he engages in a rhetorical analysis of the WTO negotiations relating to the waiver from TRIPS in light of the COVID-19 pandemic. The said waiver was proposed by India and South Africa at the World Trade Organisation in 2020, and was opposed by developed nations, including the European Union which presented its own counter proposal. He discusses the waivers in great detail, and presents an all-encompassing analysis which critically evaluates the debates and discussions, and subsequent negotiations that took place surrounding these waivers. The paper enquires whether the intellectual property regime is a barrier or a solution to effectively respond to the pandemic.

Lastly, we present an article by Veera Singh examining the effectiveness of Mauritian civil courts in enforcing trademark rules against widespread counterfeiting. Due to the similarities in the origins of their legal systems, the author has undertaken a comparative analysis between the approach used by civil courts in Mauritius, India, and South Africa in trademark infringement cases. In addition, the author analyses the effectiveness of the remedies

offered by Mauritian courts comparing the approach used by Indian and South African courts, along with suggesting incorporation of their best practices.

## **WHAT IS A FILM, WHO IS ITS AUTHOR AND WHO OWNS COPYRIGHT?**

*Jagdish Sagar\**

### *Abstract*

*The subsistence of copyright in films is loosely harmonised by the international copyright treaty system, leaving authorship and copyright ownership to municipal law.*

*The film is the most complex copyright work, orchestrating a wide range of skilled professional inputs to create a unified audience experience. Copyright cannot subsist merely in the fixation of a film, encompassing both free-standing copyright works and non-copyright contributions. Indeed, films were initially protected as dramatic works, and the fixation as a series of photographs. This dualism has persisted in one form or another: thus, India's Copyright Act, 1957 explicitly preserves dual protection for the fixation ("visual recording") and the cinematographic work itself. In civil law jurisdictions the fixation is protected at least as a "neighbouring" right, but is not the main subject matter of copyright.*

*As regards authorship and copyright ownership, the notion of a sharp divide between "common law" and "civil law" jurisdictions is oversimplified historically, though since the 1950s common law jurisdictions uniformly*

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\* Jagdish Sagar retired from the IAS in 2004. While in service, he had been India's sole copyright negotiator in the WTO negotiations leading up to the Treaty on Trade-Related Intellectual Property Rights (TRIPS); led the drafting of amendments enacted as the Copyright (Amendment) Act, 1994 and also represented India in various WIPO conferences. Until retirement, though posted in other departments, he continued to be consulted by the Government in copyright matters, chairing the Core Committee formed to consider further amendments to comply with the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT). He took up legal practice in 2006. Was a partner in Anand and Anand, then practiced independently from 2012 onwards; copyright, especially in the entertainment business, was his main area. He has recently discontinued his practice (except pro bono) in order to write.

*make the producer the author. (From 1994 the UK made the producer and principal director joint authors for no reason but to comply with EU requirements.) Civil law jurisdictions in Europe have different solutions all focusing on some form of joint authorship amongst contributors, the director being one among these. There are varying degrees of presumption of copyright transfer to the producer, who always enjoys at least a neighbouring right in the fixation. The very significant variety in the solutions chosen in different jurisdictions reflects the inherent difficulty of identifying and valorising different contributions, given their interlinked nature and the unitary character of the film as a whole; hence roles in the production process are difficult to standardise. In India, a concerted attempt to single out the “principal director” to be joint author with the producer failed largely because the former term is undefined and the pre-eminent role of the producer, whose role is much broader and more creative than mere financing, cannot be gainsaid. The different authorship solutions existing in different jurisdictions have different roots, but are not fungible: hence the case for pragmatism.*

## INTRODUCTION

A film is something like a conjuring trick: the mechanics of its production need to be opaque to the audience. Sidney Lumet said the less the audience is aware of how an effect is being achieved, the better the film.<sup>1</sup> We have to accept what we see; we cannot try to see things for ourselves.<sup>2</sup>

Its techniques deepen our perception of the world. Walter Benjamin referred to close-ups, angle and proximity of vision, editing, whereby the film could “reveal” what a live performance could not. He reflected that a different nature opened itself to the camera than to the naked eye, and went so far as to

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<sup>1</sup> Sidney Lumet, *Making Movies* (Vintage 1996) Ch 10.

<sup>2</sup> VF Perkins, *Film as Film: Understanding and Judging Movies* (De Capo Press 1993); Chapter 8 is most relevant to our subject.

liken its elicitation of “unconscious optics” to the revelations that psychoanalysis makes of our unconscious impulses.<sup>3</sup> Indeed this sequence of discontinuous moving images presenting an illusion of coherence in the magic of a darkened theatre, is not entirely unlike a dream.<sup>4</sup> Altogether, film provides a more immersive experience than any other kind of work.

Nevertheless, for all its expressive potential, a film, especially a narrative feature film, is a commercial venture<sup>5</sup> constrained by a budget and targeting some particular audience. It is an industrial product assembled in a process that is more or less standardised, unifying several kinds of subject matter and engaging the talents, specialised skills and professional expertise of diverse contributors. Consider, for example, how professional awards recognise some of these contributions. Academy Awards, BAFTA Awards and, in India, Filmfare Awards, have gone to such contributors as screenwriter, lead and supporting actors and actresses, director, assistant director, cinematographer, composer, editor; and for makeup and hairstyling; production design; sound; special visual effects; casting.

Who then should, and who does, get rights for what? Film most exemplifies the truth that terms like “work” or “author” are but cultural and legal constructs. Different countries have adopted different legal solutions to attribute authorship and allocate rights, for different pragmatic or ideological reasons, that may be embedded in their own legal culture and in the history,

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<sup>3</sup> Walter Benjamin, *The Work of Art in the Age of Mechanical Reproduction* (first published in 1936, translated from the German by Harry Zohn, Andanson Press 2018), this is an influential essay also to be found in almost any collection of Benjamin’s writings; Richard Koszarski, ‘The Men with the Movie Camera’ in Barry Keith Grant (ed), *Autuers and Authorship: A Film Reader* (Blackwell Publishing 2008) discusses styles of cinematograph.

<sup>4</sup> This dream metaphor has long had a place in film theory; see Laura Rascaroli, ‘Oneiric Metaphor in Film Theory’ (2002) *Kinema: A Journal For Film and Audiovisual Media* <<https://openjournals.uwaterloo.ca/index.php/kinema/article/download/982/1054?inline=1>> accessed 26 May 2022.

<sup>5</sup> Not necessarily for profit; see *Chief Commissioner of Delhi & ors v The Federation of Chambers and Commerce of India, Delhi & ors* (1975) 3 SCC 64 for the meanings of “commercial” and “business”.

commercial organisation and generally the ecology of their own film industries. These different legal solutions can be unstable, are never ideal and anyway are not fungible.

Copyright subsists in the film as a whole and independently in some underlying works including screenplay; a novel or biography on which the screenplay might be based, music, choreography etc., but copyright may not subsist in many of the most vital contributions like direction, cinematography and editing. We have to consider the nature of film, and of the contributions to a film—debates about the director’s claim to authorship being specially interesting here—and the difference that is conventionally perceived between “copyright” and “*droit d’auteur*”<sup>6</sup> in order to appreciate the context in which alternative solutions to the problem of film authorship have been devised. There can never be any “right” solution to the problem of identifying “authors” or granting statutory ownership of copyright.

We should not forget, either, that the legal issues we are concerned with here are not necessarily part of the daily life of the industry. Participants in film-making speak of themselves as director, actor, screenwriter, cinematographer and so on: “author,” actually a technical term in copyright law (used in common language only for literary works) is not one of these terms. Admittedly, agreements are executed under which the producer’s being “author” of the film is accepted very routinely,<sup>7</sup> but in ordinary speech the producer is simply called the producer.

Copyright law cannot be discussed usefully without some appreciation of the nature of the subject matter; this is *a fortiori* the case with film. However, before we delve into this further, we need to review the relevant history and current provisions of the law of film copyright in India, in a few other

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<sup>6</sup> The former term refers to the copyright law of common law jurisdictions and the latter to the corresponding law in other or “civil law” jurisdictions.

<sup>7</sup> This is based on the author’s professional experience.

representative jurisdictions and under the international copyright treaty system. The 1908 Berlin Act of the Berne Convention,<sup>8</sup> the first Act of the Convention to deal with film, is a convenient starting point.

Article 14(1) of the Berne Convention for The Protection of Literary and Artistic Works, as it stood after the Berlin Act (“Berlin Act”) gave authors “the exclusive right of authorising the reproduction<sup>9</sup> and public performance of their works by cinematography”, thus settling the relationship between underlying works and the “cinematographic work”.

The rights that vested in underlying works flowed from authorship but the Convention did not (and still does not) define the term “author” or deal with ownership in any kind of work: this is because there were and are serious difficulties in doing so, arising mainly from the unwillingness of many “civil law” countries to accept that a juridical person can be an “author”; common law countries suffer no such inhibition.<sup>10</sup> The Convention therefore evades all questions of authorship and merely addresses rights in works and, in some cases, relationships between copyright owners (howsoever identified by municipal law) in different categories of work. This lacuna has serious potential and sometimes unpredictable consequences for *locus standi* to enforce rights across jurisdictions. It substantially negates the purpose of “national treatment”.<sup>11</sup>

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<sup>8</sup> All Acts of the Berne Convention, together with the Committee Reports and proceedings of Diplomatic Conferences, are conveniently collected in World Intellectual Property Organisation (WIPO), *The Berne Convention for the Protection of Literary and Scientific Works from 1886 to 1986* (International Bureau of Intellectual Property 1986).

<sup>9</sup> This includes adaptation.

<sup>10</sup> See *Ramesh Sippy v Shaan Ranjeet Uttamsingh* 2013 SCC OnLine Bom 523, (2013) 5 Mah LJ 37.

<sup>11</sup> Article 5(1) of the Convention requires what is called “national treatment”. It reads: “Authors shall enjoy, in countries of the Union other than the country of origin, the rights which their respective laws do now or hereafter grant to their nationals, as well as the rights specially granted by the Convention.” Article 5(2) lays down *inter alia* that “the extent of the protection, as well as the means of redress, shall be governed exclusively by the country where protection is claimed” which, read with the preceding provision, is also ambiguous.

Paragraphs 2 Article 14 of the Berlin Act laid down that

Cinematographic productions shall be protected as literary or artistic works if, by the arrangement of the acting form or the combinations of the incidents represented, the author has given the work a personal and original character.

Paragraph 3 of the same Article clarified that this right was ‘Without prejudice to the copyright in the original work the reproduction by cinematography of a literary, scientific or artistic work<sup>12</sup> shall be protected as an original work.’

These provisions, in effect, conferred a separate right on the author (whoever that might be under municipal law) of the film as a dramatic work, distinct from the fixation.<sup>13</sup>

This effectively excluded non-narrative film: a sad failure to appreciate the nature of the medium. The distinction was invidious. A dramatic work is a work of action created to be performed (in the case of film, shown to an audience). The term should include *any* film. Every film is created specifically for performance before an audience and no documentary film or film showing an event, even a live event, can be created by just anyone without the application of some cinematographic skill and creativity: at the minimum there will have to be choices of camera angle, choice of lens, some panning, probably some zooming and some editing. The subsistence of copyright in what is filmed should be irrelevant to the subsistence of copyright in the film itself.

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See Mireille van Eechoud, *Choice of Law in Copyright and Related Rights: Alternatives to the Lex Protectionis* (Kluwer Law International 2003).

<sup>12</sup> The three words together are the Convention’s omnibus term for works that it protects as copyright works; the term “scientific work” merely means what we would now call a literary work on a scientific subject.

<sup>13</sup> “Fixation” means fixation in material form, in this case the master copy of the film in whatever format it may be captured (including digital) as distinct from the content captured in the fixation.

The Berlin Act assimilated the fixation of the film to the copyright conferred on photographs under Article 3, the fixation being conceived of as a series of photographs. Photography copyright subsisted in the fixation and dramatic copyright in the “cinematographic work”, and the two were intertwined: ‘The person who takes the cinematographic shots and develops the negatives will also be the person who has imagined the subject, arranged the scenes and directed the moves of the actor’.<sup>14</sup> Further, fixations of films that might not qualify as dramatic works would still enjoy narrower protection as series of photographs.

### **THE COPYRIGHT ACT, 1911/ INDIAN COPYRIGHT ACT, 1914**

Before the Copyright Act, 1957 came into force, our copyright law was the (British) Copyright Act, 1911, with modifications (not relevant here) made by the Indian Copyright Act, 1914. This 1911 Act was, with local variations as in India, the copyright law of the British Empire and Commonwealth for well over half a century, leaving a valuable legacy of relative harmonisation of copyright law.

The articulation of film rights in the 1911 Act, paralleling the Berlin Act, suffered from the same shortcomings. The definition of “dramatic work” included ‘any cinematographic production where the arrangement or acting form or the combination of incidents represented give the work an original character.’<sup>15</sup>

The 1911 Act was similar to the Berlin Act in its treatment of films. The film could be protected as a dramatic work, but the fixation was protected as a series of photographs. However, as in the Berlin Act, there was no copyright in the film *per se* as distinct from the dramatic work and the fixation as a

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<sup>14</sup> International Union for The Protection of Literary and Artistic Work, ‘Records of the Conference Convened in Berlin’ (11 November 1908).

<sup>15</sup> Copyright Act 1911, s 35. Further, “cinematograph” was defined as ‘including any work produced by any process analogous to cinematography’.

series of photographs. Therefore, as with the Berlin Act, this left some uncertainty regarding the subsistence of dramatic copyright in non-narrative films like documentaries and news reportage. Worse, it was actually held that films of sports events were not “dramatic works” because the “drama” lay in the event itself!<sup>16</sup>

The 1911 Act remained silent as to the authorship of a film, though there seems to be no reason why this should have been so: the British Parliament was under no such constraint as the negotiators of the Berne Convention. Nor did this Act use the terms “director” and “producer” which in years to come, for most of time that this Act was still in force, would become common currency.

We are told that commentators were not unanimous but that the weight of opinion in subsequent years favoured the director as “author”.<sup>17</sup> However this attribution (if it existed) did not give the director any copyright. As regards the fixation, the owner of the negative of a photograph at the time when the negative was made was deemed the author.<sup>18</sup> This would, of course, be the person whom we would now call the producer. Further, if a photograph had been ordered for valuable consideration, the first owner of copyright was the person who had ordered it.<sup>19</sup> Again, if a work was authored by an employee, the employer was the first owner of copyright.<sup>20</sup> However, we should be

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<sup>16</sup> *Canadian Admiral Corp v Rediffusion Inc* [1954] Ex CR 382, 20 CPR 75; *Australian Olympic Committee v Big Fights Inc* [1999] 46 IPR 53 (Federal Court of Australia); Both cases were decided under the 1911 Act and are discussed in Nicholas Caddick, QC, Gwilym Harbottle and Professor Uma Suthersanen, *Copinger and Skone James on Copyright* (16<sup>th</sup> Edition, Sweet & Maxwell 2021) para 3-34.

<sup>17</sup> I owe this information entirely to Kamina Pascal, *Film Copyright in the European Union* (2nd edn, CUP 2016) 24-25, which refers to commentators and authorities that I do not have access to.

<sup>18</sup> Copyright Act 1911, s 21.

<sup>19</sup> Copyright Act 1911, s 5(1)(a); thus, the person ordering the series of photographs comprising the fixation of the film would in fact be the person who financed the film, usually by commissioning this series of photographs and paying valuable consideration for it, who came to be regarded in common speech as the producer.

<sup>20</sup> Copyright Act 1911, s 5(1)(b).

careful not to diminish the producer's role to mere financier or employer: it is improbable that a person investing or arranging for the financial or other resources necessary to produce the film would refrain from exercising some degree of control—indeed as much as he chose to exercise—over its content and production.

I. Definition of “film” in subsequent UK law

The Copyright Act of 1956 (“1956 UK Act”) did indeed still use the term “cinematograph film” but narrowed the definition:

...any sequence of visual images recorded on material of any description (whether translucent or not) so as to be capable, by the use of that material, -

(a) of being shown as a moving picture, or

(b) of being recorded on any other material ... by the use of which it can be shown.<sup>21</sup>

The Act also, in a departure from the past, excluded films from the definition of “dramatic work”.<sup>22</sup> This clearly reflected an intent to limit film copyright to the fixation, excluding any kind of creative standard; perhaps more so since the Act continued the omission of the 1911 Act to ascribe authorship to anyone. Instead, it merely identified the “maker” of the film as first owner of copyright. This “maker” was defined as ‘the person by whom the arrangements necessary for the making of the film are undertaken’. This language was not precise but in practice was understood as being, essentially, the person who financed the film.<sup>23</sup> These changes, clearly, intended to create

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<sup>21</sup> Copyright Act 1956, s 13(10).

<sup>22</sup> Copyright Act 1956, s 48(1).

<sup>23</sup> See Benedict Atkinson, *The True History of Copyright: The Australian Experience, 1905-2005* (Sydney University Press, 2007) 265-267 for a brief, lucid discussion of the “philosophical transformation” that the 1956 UK Act implied.

a new class of “work”<sup>24</sup> of an entrepreneurial nature that comprised only fixations of content. The object was to facilitate the film industry in exploiting works that, though still described as copyright works, were objectively akin to the subject matter of a neighbouring right or related rights (although the terminology of UK law did not envisage such a thing at the time: the treaties on “neighbouring rights”, starting with the Rome Convention of 1961, still lay in the future.)

The 1956 UK Act was, thus, strictly non-compliant with the requirement of the Berne Convention, that the film needed to be protected as a work over and above the fixation of it. (It can be indeed be argued, alternatively, that what the Act literally protected was “any sequence of visual images” that had been fixed in a manner capable of being exploited as a cinematographic film. This can be read to imply that fixation was only a necessary condition of the protection of a sequence of visual images (hence film copyright might extend to the moving visual images.)<sup>25</sup> But the Act was never actually interpreted in this way.

However, an incidental consequence of delinking film copyright from dramatic works, and of locating copyright purely in the fixation, was that all films including documentaries and news reportage would enjoy equal, if more constricted, protection.

The 1956 UK Act has been replaced by the current Copyright, Patents and Designs Act 1988. The statute no longer expressly excludes films from the definition of dramatic works, but neither does it expressly include them. “Film” is defined as ‘a recording on any medium from which a moving image may by any means be produced’.<sup>26</sup> This statutory definition would appear,

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<sup>24</sup> Sound recordings were the other main instance of a copyright work of this kind.

<sup>25</sup> See *Kamina* (n 17) 31; however, *Kamina* too did not consider this to be the actual intention of the statute.

<sup>26</sup> Copyright, Designs and Patents Act 1988, s 5B(1).

literally, to limit film copyright to the fixation, but not definitively so since the statute does not rule out a film's being a dramatic work.

Then, in *Nowrozian v Arks*,<sup>27</sup> the English Court of Appeal held, in effect, that the film is also an independent derivative dramatic work that cannot be reduced to the screenplay or to the fixation, hence rights in this derivative dramatic work and in the fixation were not mutually exclusive.

The 1988 Act finally used the term "producer" whom it dignified with the designation of "author" though defining it exactly like "maker" under the 1956 Act: "the person by whom the arrangements necessary for the making of the film are undertaken". Judicial interpretations of this term therefore apply to either Act. The "arrangements necessary" continue to be interpreted as referring to the financial arrangements.<sup>28</sup> However, even this definition, with its simplicity, may not always be straightforward: in *Slater v Wimmer*,<sup>29</sup> though on very unusual facts, the Court actually had to determine who among five persons was producer of a documentary film.

In 1996, the "principal director" was added as joint author with the producer, with retrospective effect from 1994.<sup>30</sup> This was done with the sole purpose of compliance with the EU Rental, Lending and Related Rights Directive (the UK then being a member of the EU)<sup>31</sup> and, it would seem, without much thought. It actually makes nonsense of the notion of joint authorship: if the producer and the principal director are to be joint authors, then their contributions should be inseparable and indistinguishable. Here we have a strange animal, a hybrid of two "joint authors" who have made essentially different contributions.

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<sup>27</sup> *Norowzian v Arks Ltd & Anr* [1999] EWCA Civ 3014, [2000] FSR 363.

<sup>28</sup> *Copinger and Skone James* (n 16) para 4-49.

<sup>29</sup> [2012] EWPC 7.

<sup>30</sup> Copyright, Designs and Patents Act 1988, s 9(2)(ab).

<sup>31</sup> *Copinger and Skone James* (n 16) para 4-47.

However, this eccentric definition is at least incompatible with limiting copyright in a film to the fixation: there has to be something that the principal director can enjoy credit for and this can't be the fixation.

**“CINEMATOGRAPH FILM” AS DEFINED IN THE (INDIAN) COPYRIGHT ACT,  
1957**

The Copyright Act, 1957 (“1957 Act”) followed close on the heels of the 1956 UK Act. but the two statutes are sufficiently different in their organisation and content to belie the common impression that the former was based on the latter. In any case, the UK legislative process did not sufficiently precede India's for that to be the case and the 1957 Act itself speaks that our legislature did its own thinking.

The definition of “cinematograph film” is quite different from that in the UK Act. The original definition in the Copyright Act, 1957 was:

‘Cinematograph film’ includes the sound track if any and ‘cinematograph’ shall be construed as including any work made by a process analogous to cinematography.<sup>32</sup>

This inclusive definition cannot be read as limiting the scope of protection to the fixation. This is anyway beyond doubt from subsequent clarificatory legislation.

Unfortunately, the definition of “dramatic work” now excluded a cinematograph film:<sup>33</sup> this irrational exclusion seems to have been the one instance where our legislature blindly copied the 1956 UK Act. It was not retained in the 1988 UK Act but remains in ours.

In *Academy of General Education v Malini Mallya*,<sup>34</sup> the Supreme Court recognised the difference between literary and dramatic works:

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<sup>32</sup> Copyright Act 1957, s 2(d)(v).

<sup>33</sup> Copyright Act 1957, s 2(h).

<sup>34</sup> *Academy of General Education, Manipal v B Malini Mallya* (2009) 4 SCC 256.

... the provisions of the Act make a distinction between “literary work” and “dramatic work” ... there cannot be any doubt ... that copyright in respect of performance of “dance” would not come within the purview of the literary work but would come within the purview of the definition of dramatic work.

The definition in the Copyright (Amendment) Act, 1994, was technology-agnostic and distinguished film from fixation (emphasis added) as follows:

... “cinematograph film” means any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying such visual recording and “cinematograph” shall be construed as including any work produced by any process analogous to cinematography including video films ...

The Notes on Clauses to the amending Bill explained this as being to “improve the definition” which has to mean that the amendment was clarificatory. Now a cinematograph film was defined as a *work* of visual recording, not just any visual recording—while, to underscore the point, a sound recording remained merely any recording of sounds.<sup>35</sup> The definition thus met the minimal creativity requirement spelt out in the 1908 Berlin and all subsequent Acts of the Berne Convention and generally in the law of copyright.

The further improved definition in the Copyright (Amendment) Act, 2012 made the intention clearer by adding a definition of “visual recording”, distinguishing it from the film itself, leaving no scope for doubt that film copyright subsists both in the work of visual recording and in the fixation (i.e., visual recording) itself.

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<sup>35</sup> Copyright Act 1957, s 2(xx).

(f) 'cinematograph film' means any work of visual recording and includes a sound recording accompanying such visual recording and "cinematograph" shall be construed as including any work produced by any process analogous to cinematography including video films; ...

(xxa) 'visual recording' means the recording in any medium by any method, including the storing of it by any electronic means, of moving images or the representation thereof, from which they can be reproduced and communicated by any method;

Sadly, there remains a school of thought that cinematographic copyright subsists only in the fixation: the Bombay High Court embraced this "physical format" theory in *Star India Private Limited v Leo Burnett (India) Pvt Ltd*<sup>36</sup> This throwback to the 1956 UK Act is too often very casually assumed, though there was never any warrant for such an interpretation in successive definitions of "cinematograph film" in our statute or, indeed, in the international conventions. Further, it is settled law that, where two interpretations of a statute are possible, the one that is compatible with an international treaty that India has acceded to, is the one that should prevail.<sup>37</sup>

Fortunately, two other High Courts have interpreted our law correctly. In *MRF Ltd v Metro Tyres Ltd*<sup>38</sup> the plaintiff's grievance was that the defendant had copied its film advertisement. The defendant, whose own advertisement very closely followed the story and visual content of the plaintiff's, relied on *Star India*. In a well-reasoned judgement, the Delhi High Court decided for the plaintiff, concluding that:

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<sup>36</sup> (2003) 2 Bom CR 655, (2003) 105 (2) Bom LR 28.

<sup>37</sup> *Commissioner of Customs, Bangalore v GM Exports & Ors* (2016) 1 SCC 91 and a catena of other decisions.

<sup>38</sup> (2019) 262 DLT 734.

... a cinematograph film may not infringe any of its underlying works, namely a literary, dramatic, musical or artistic work, but may nevertheless lack originality because it infringes another cinematograph film ... a film must not be a copy of any other work, including any other film.

This decision was not appealed, and stands. It followed an earlier, less detailed, Calcutta High Court decision.<sup>39</sup>

The best-known Indian judicial pronouncement touching the nature of film is Justice Krishna Iyer's exuberant concurring "footnote" in the Supreme Court's decision in *Indian Performing Right Society v Eastern India Motion Picture Association*:<sup>40</sup>

A cinematograph film is a felicitous blend, a beautiful totality... Cinema is more than long strips of celluloid, more than miracles in photography, more than song, dance and dialogue and, indeed, more than dramatic story, exciting plot, gripping situations and marvellous acting. But it is that ensemble which is the finished product of orchestrated performance by each of the several participants, although the components may, sometimes, in themselves be elegant entities... S. 13 (4) of the Act preserves the separate survival, in its individuality, of a copyright enjoyed by any 'work' notwithstanding its confluence in the film. This ... does not cut down the copyright of the film qua film... the film producer is the master of his combination of artistic pieces and the two can happily co-exist.

The case was mainly about underlying works but these observations are definitive on the subsistence of copyright in the film itself: the film is more than celluloid and the Bombay High Court decision was *per incuriam*.

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<sup>39</sup> *Shree Venkatesh Films Pvt Ltd v Vipul Amrutlal Shah & Ors* SCC OnLine Cal 2113.

<sup>40</sup> AIR 1977 SC 1443.

### FILM AUTHORSHIP IN INDIAN LAW

Under the 1957 Act as originally enacted, the author of a cinematograph film was ‘the owner of the film at the time of its completion’ The term “producer” was not used.

Since the Copyright (Amendment) Act, 1994, the author of a film, usually a juridical person,<sup>41</sup> is the producer, defined as a person who “takes the initiative and responsibility for making the work.” This language is different from that of the 1956 and current British Acts and surely cannot limit the term to mean the financier: taking the initiative and responsibility for a film has to be more than merely making “necessary arrangements”.

An attempt in the Copyright (Amendment) Bill, 2010 to add the “principal director” as a joint author with the producer was shot down by the Parliamentary Committee.<sup>42</sup> First, the Committee noted the role of the producer (that we have discussed above.) Second, the Committee noted with justified surprise that the Bill did not propose any definition of “principal director” and very rightly disagreed with the contention that the term was well understood in the industry. It saw no basis for any equal partnership between the producer and a director or “principal director”: directors were well compensated but bore no risk. Thus we were spared the anomaly of the present UK law, though the very fact that it was proposed in the Bill seems ominous.

The producer’s rights in regard to underlying works have changed. The 1977 judgement in *IPRS v East India Motion Picture Association* had made the producer *ab initio* owner of copyright in underlying works.<sup>43</sup> But now, under

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<sup>41</sup> *Ramesh Sippy v Shaan Ranjeet Uttamsingh* (n 10).

<sup>42</sup> Department-Related Parliamentary Standing Committee on Human Resource Development, Two Hundred Twenty-Seventh Report On The Copyright (Amendment) Bill, 2010 (23 November 2013) <<http://164.100.47.5/newcommittee/reports/EnglishCommittees/Committee%20on%20HRD/227.pdf>> accessed 9 June 2022.

<sup>43</sup> The controversy surrounding this judgement is not relevant here.

the second proviso to section 17 inserted in 2012, the producer will need to obtain assignments from all contributors of underlying copyright works; and thus, does not enjoy any protection against any contributor's obtaining an interlocutory injunction restraining exploitation of the film. Our law does not even attempt to provide the protection intended by Article 14<sup>bis</sup> of the Berne Convention (discussed below).

However, assuming some problem with the producer's title, the producer would still have paid for each contribution, and would have an equitable right to use it in the film.<sup>44</sup> There is also a catena of English case law under which, in some circumstances, the producer might even have an equitable right to become the assignee.<sup>45</sup> These principles could be applied in India.

Before parting with the subject of film authorship in India, we may notice *Sartaj Singh Pannu v Gurbani Media*<sup>46</sup> The Delhi High Court, dismissing an application for interim relief by a director claiming intellectual property rights, held that 'Whether a work of a director in a particular film can be stated to be a work of artistic craftsmanship will be a matter for evidence.' This should give us pause: there does not appear to have been any judicial exploration of the full scope of "artistic work" as defined in section 2 of the Copyright Act, taking into account the words 'any other work of artistic craftsmanship' in section 2(c)(iii). Are all artistic works 'works of artistic craftsmanship'? If so, what does that imply? An interesting, unanswered question. However, the director of a film does not create any identifiable underlying work; the notion that he might uniquely enjoy any independent copyright, as an artist who creates a work of artistic craftsmanship for inclusion in the film, but that too only if he can prove his special contribution

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<sup>44</sup> *Clearsprings Management Ltd v Businesslinx Ltd* [2005] EWHC 1487 (Ch).

<sup>45</sup> *Massine v de Basil* [1936–45] MCC 223 (Court of Appeal); *Robin Ray v Classic FM* [1998] FSR 622; *R Griggs Group & Ors v Evans & Ors* [2005] EWCA Civ 11; see also *Slater v Wimmer* [2012] EWPC 7.

<sup>46</sup> (2015) 220 DLT 527.

at trial, is surely farfetched. Unfortunately, this was an application for interim relief in a matter going to arbitration, hence the outcome will not be reported.

#### **FURTHER DEVELOPMENTS IN THE INTERNATIONAL TREATY REGIME**

The definitions of “cinematographic work” in subsequent Acts of the Berne Convention also do not support any limitation of film copyright to the fixation.

Article 14 as included in the 1928 Rome Act of the Berne Convention (“Rome Act”) retained the principle of the 1908 Berlin Act:

Cinematographic productions shall be protected as literary or artistic works if the author has given the work an original character. If this character is absent, the cinematographic production shall enjoy protection as a photographic work.

In the 1948 Brussels Act, Article 14(2) read as follows:

Without prejudice to the rights of the author of the work reproduced or adapted, a cinematographic work shall be protected as an original work.

The intention was to remove the past distinction between, for example, films of a “dramatic” character and documentaries or films of events. The conference report explains:

This text has to be interpreted to mean that there is no reason to make any discrimination in the protection of films, and that the Convention abstained from proposing a criterion concerning the nature of cinematographic production. The very conception of a work entails an intellectual effort.

The 1967 Stockholm Act reorganised the provisions, inserting Article 14<sup>bis</sup> to deal exclusively with cinematographic works. The relevant portion of Article 14 (which is at some pains to steer clear of the question of authorship) reads:

Without prejudice to the copyright in any work which may have been adapted or reproduced, a cinematographic work shall be protected as an original work. The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work...

The current (1971) Paris Act, to which India has acceded, retains the Stockholm definition.

India has also acceded to the WIPO Copyright Treaty (“WCT”). Article 8 of WCT also covers making available/interactive communication to the public, i.e., the internet and, under the terms of the treaty, effectively makes it an obligation under the Berne Convention.<sup>47</sup> Our Copyright Act was already compliant when WCT was first adopted in 1996, by virtue of the 1994 amendments, which were further clarified by the Copyright (Amendment) Act, 2012.<sup>48</sup> (However, India did not actually accede to WCT until 2018).

#### I. Current provision on multiple authorship of films in the Berne Convention

As we have seen, the Berne Convention leaves the definition of “author” and matters of copyright ownership to municipal law for want of agreement as to whether a juridical person can be an author. However, the 1967 Stockholm Act made a slight departure, inserting Article 14<sup>bis</sup> to address difficulties that had arisen regarding the exploitation of copyright in films as between different jurisdictions. The relevant portions are extracted below:

- (a) Ownership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed.

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<sup>47</sup> See Mihaly Ficsor, *Guide to The Copyright and Related Rights Treaties Administered by WIPO And Glossary of Copyright and Related Rights Terms* (WIPO 2003) 89- 90.

<sup>48</sup> Copyright Act 1957, s 14(a)(iii); Copyright Act 1957, s 14(c)(ii); Copyright Act 1957, s 14(d)(iii); see also Copyright Act 1957, s 2(ff); Section 2(ff) also applies to sound recordings (section 14(e)(iii)) though not protected as copyright works under The Berne Convention or WCT.

(b) However, in the countries of the Union which, by legislation, include amongst the owners of copyright in a cinematograph work authors who have brought contributions to the making of the work, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work ...

(c) By ‘contrary or special stipulation’ is meant any restrictive condition which is relevant to the aforesaid undertaking. ...

(3) Unless the national legislation provides to the contrary, the provisions of paragraph (2)(b) above shall not be applicable to authors of scenarios, dialogues and musical works created for the making of the cinematographic work, or to the principal director thereof ...<sup>49</sup>

The WIPO Guide<sup>50</sup> unpacks these confusing provisions as follows:

Paragraph 2(b): This does not apply to jurisdictions (like India) where the producer is the “author” or at least the first owner of copyright, nor does it apply to jurisdictions where the producer, though not the author, nevertheless becomes the first owner of copyright by operation of law. It applies, rather, to jurisdictions whose laws recognise multiple natural persons as authors but presume them to have transferred their rights to the producer absent any “contrary or special stipulation”. This is a “presumption of legitimation” subject to clause (c).

Under clause (c), a contractual stipulation is what obviously comes to mind, but there could be other restrictive conditions built into a statute. The Guide

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<sup>49</sup> Berne Convention for the Protection of Literary and Artistic Works (adopted on September 9 1886, as amended on 14 July, 1967) TRT/BERNE/003 (Stockholm Act) art 14*bis*.

<sup>50</sup> Ficor (n 47); The comments, however, are my own.

suggests that the presumption of legitimation could have been better described as a rebuttable presumption--but then a rebuttable presumption might be of limited value.

Paragraph (3): Here we run into further problems. Member countries are not obligated to apply even the rebuttable presumption of legitimation against authors of “scenarios, dialogues and musical works”.<sup>51</sup> Now, Article 14<sup>bis</sup> was inserted in the text of the Convention to ensure that the producer of a film should not face difficulties in enforcing copyright in the film in jurisdictions having radically different laws of copyright ownership in films. The potential difficulties that continue to be faced, in any jurisdiction, by a foreign producer on account of the rebuttable nature of the presumption in paragraph 2 of Article 14<sup>bis</sup> are compounded by the liberty allowed under paragraph 3.

The international treaty system thus provides no real guidance and remains unsatisfactory and inadequate to deal with cross-border issues, particularly of *locus standi* arising from differences between municipal laws on the vital questions of authorship and ownership of copyright.

### FILM COPYRIGHT IN US LAW

Film copyright in the United States, like that country’s copyright law in general, is *sui generis*. We have to devote some space to it, given the magnitude and global dominance of the US film industry.

The US remained aloof from the international treaty system governing copyright until its belated accession to the Berne Convention in 1988, having prepared the ground by replacing its Copyright Act of 1909 with a new one in 1976.

The 1909 Act was amended in 1912 to address film copyright, defining a “motion picture” as ‘a series of photographs giving the impression of motion,’

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<sup>51</sup> “Musical works” includes accompanying words: Berne Convention Article 2(1). “Principal director” is undefined.

but it did not make any such invidious distinction between rights in the motion picture and rights in the fixation as in the 1908 Berlin Act of the Berne Convention and the UK Acts of 1911 and 1956. Rather, it classified all films as “motion picture photoplays” or “motion pictures other than photoplays”: the former were derivative works by virtue of underlying narrative works like novels or plays. Copyright in the photoplay could be exploited only subject to the prior claim of the owner of the underlying work: this was the reason for the distinction and it did not affect the subsistence of copyright in other motion pictures. This legislative recognition that a film is more than the fixation, and that it was possible for a film to infringe an underlying literary work (notwithstanding that all films were silent at the time) substantially followed the ratio of the landmark US Supreme Court decision in *Kalem Co v Harper Bros.*<sup>52</sup>

This structure created no problem for the copyrightability of motion pictures of events, in which no copyright subsisted, showing a better grasp of the nature of film than did the Berne Convention until the 1948 Stockholm Act, and the UK law until the 1988 Act.

The 1976 US Act did not retain the distinction between photoplays and other motion pictures, but copyright continued to subsist in films of events. In *Production Contractors, Inc. v WGN International Broadcasting Co.*,<sup>53</sup> it was held that though copyright did not subsist in a parade, it did subsist in a film of the parade, including one made in the course of broadcasting. The court cited legislative history, quoting the relevant Congress report:

When a football game is being covered by four television cameras, with a director guiding the activities of the four cameramen and

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<sup>52</sup> *Kalem Co v Harper Brothers*, 222 US 55 (1911) (US November 13, 1911); See also Peter Decherney, *Hollywood's Copyright Wars: from Edison to the Internet* (Columbia University Press 2012) Ch 1.

<sup>53</sup> *Prod. Contrs v WGN Cont'l Broad Co*, 622 F Supp 1500 (ND Ill November 29, 1985).

choosing which of their electronic images are sent out to the public and in what order, there is little doubt that what the cameramen and the director are doing constitutes ‘authorship’.<sup>54</sup>

Further, the US requirement of fixation was met if the shooting was being fixed simultaneously with the live broadcast. The court also referred to earlier decisions<sup>55</sup> regarding sporting events.

#### I. Film authorship in US law

As in other common law jurisdictions (except, currently, the UK) the producer is the author and first owner of copyright in a film. However, US law has arrived at this position by a different route: the contributions to a film are “works for hire”. This is a wide term: unlike our law and that of other common law jurisdictions, US law does not make our clear distinction between contracts *of* employment and contracts *for* employment (the latter being with independent contractors who remain the first owners of copyright.) Rather, in the U.S., both categories are often clubbed under the rubric of “works for hire” and the employer or person commissioning the film is both the first owner of copyright and the author.<sup>56</sup> This was also the position under the 1909 Act.<sup>57</sup>

Further, it has been held that the many contributions to a film ‘ultimately merge to create a unitary whole,’<sup>58</sup> a separate work that is more than the sum of its parts, hence a director, or any contributor whose contribution is

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<sup>54</sup> *ibid* 1503.

<sup>55</sup> *Nat'l Ass'n of Broadcasters v Copyright Royalty Tribunal*, 675 F2d 367 (DC Cir April 9, 1982); *New Boston TV, Inc v Entm't Sports Programming Network*, 1981, 215 USPQ (BNA) 755, (D Mass August 3, 1981);

<sup>56</sup> 17 USC §201(b); the statute does not make this position universally the case, but specifically covers specially-ordered motion pictures: The law on works for hire is, otherwise, somewhat complex; see *Nimmer on Copyright* (Lexis Nexis Butterworth Wadhwa & Co 2010) para 5.03.

<sup>57</sup> *Nimmer*, (n 55) para 5.03.[B][1][a][ii].

<sup>58</sup> *16 Casa Duse, LLC v. Merkin*, 791 F3d 247 (2d Cir NY June 29, 2015) (Sack J).

inseparable from, and integrated into, the work cannot maintain a separate copyright interest in their contribution.<sup>59</sup>

## II. Films and film authorship in civil law jurisdictions

It is a platitude that there are two schools of copyright: a commercial, utilitarian approach in common law countries (making the producer the author of a film), and one founded on the humanistic notion of the work as an emanation of the author's unique personality (conferring film copyright on creative contributors who are natural persons.) The term "*droit d'auteur*" or "author's right" is quite often used in civil law countries to (rhetorically) distinguish their law from the "copyright" of common law countries.<sup>60</sup>

In fact, however, the present legal recognition of joint authorship as being shared among contributors to the film is to a large extent a creation of the second half of the twentieth century.<sup>61</sup> During much of the twentieth century several civil law countries, including France,<sup>62</sup> Germany, the Netherlands, Denmark and Finland conferred economic rights solely on the producer, who might be a juridical person.<sup>63</sup>

It will suffice here to describe the current law in a few representative jurisdictions. The paradigm is to have a list, or a presumptive list, of contributors who are designated as authors of the film, which is a work of

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<sup>59</sup> *ibid.*

<sup>60</sup> The Berne Convention uses neither term but only speaks of the economic and moral rights of authors; subsequent treaties use the term "copyright".

<sup>61</sup> David Saunders, *Authorship and Copyright* (Routledge 1992) punctures some myths about the supposed historical and logical consistency of "*droit d'auteur*" philosophy in France and Germany, from the 18<sup>th</sup> century onwards (Ch 3 and 4).

<sup>62</sup> By judicial decisions eventually overruled in 1947. For his and most of the factual information (but not necessarily opinion) on EU jurisdictions that follows; see Pascal Kamina: *Film Copyright in the European Union* (2<sup>nd</sup> edn Cambridge University Press 2016) 141-189; Opinions, and any errors in understanding or expressing such facts, and are my own.

<sup>63</sup> Kamina (n 62).

joint authorship: unfortunately, however, such lists vary and are sometimes absent.

In France, under the law of 1957, the list comprises the authors of the scenario (screenplay), the “adaptation”, dialogue, musical works (including words) if created specifically for the film, and the director. This list is not exhaustive and, interestingly, includes the authors of adapted works like a novel, if copyright subsists in it. There is (confusingly) an irrebuttable presumption of joint authorship, yet the presumption of authorship itself, in the case of each person in the list in a particular film, including the director, is rebuttable. All the joint authors are equal regardless of their contribution and the concurrence of all is required to assert their rights by litigation or to enter into agreements. Each joint author may exploit his/her work separately, unless otherwise agreed. Fortunately, by a further law of 1985, a wide-ranging right to exploit the film is deemed to have been transferred to the producer. The copyright laws of Belgium, Spain and Portugal are substantially influenced by French law.

Italian film copyright law, which had its own course of evolution, currently sets out a list of presumptive joint authors comprising the author of the ‘subject matter or treatment’;<sup>64</sup> the author of the scenario, the music composer and the director. However (with exceptions like dubbing and some other adaptation rights) the producer is the statutory assignee of exploitation rights.

Initially, from 1910, German film copyright law matched the 1908 Berlin Act of the Berne Convention. Since 1965, all films, including documentaries etc, get equal protection. The film has always been a work of joint authorship, but there is no presumptive list of authors; and the authors of works that are capable of separate exploitation (like music) are excluded. There is a presumption of grant of copyright to the producer.

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<sup>64</sup> This unexplained term is taken from Kamina (n 62).

In the Netherlands, where again film copyright matched the requirements of the 1908 Berne Act, the producer (who might be a juridical person) was the author of the film until 1985; since then, the film is a work of joint authorship by unspecified authors. There is a presumption of assignment of copyright, including most adaptation rights, but excluding music, to the producer.

The Rental, Lending and Related Rights Directive of 1992 requires EU countries to maintain a dual protection for films as audiovisual works and for the fixation: the latter is only a ‘neighbouring right’; hence it may be owned by a juridical person. E.U. members are further required to provide authorship rights to contributors, whom countries were free to specify as they see fit, but which must include the principal director. We have seen how this does not really bring about much harmonisation. Further, the complete divorce of rights in the film as a copyrighted work itself from rights in the fixation of it, is difficult to grasp.

Outside the EU, in Russia, the authors are the director, the screenwriter and the composer of any music (including accompanying words) created specifically for the film.<sup>65</sup>

In Japan, the law of film authorship is hybrid: the authors of a film, unless otherwise stipulated contractually, are “those who by taking charge of producing, directing, filming, art direction etc have contributed to the creation of the work as a whole but the authors of works that are merely adapted or reproduced in the film (novels scenarios, music, etc.) are excluded. However, absent a contract to the contrary, the producer who has taken the initiative for a film, though a juridical person, is still the author if such contributors were employees and the film was released in the producer’s name.<sup>66</sup>

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<sup>65</sup> The Civil Code of the Russian Federation (chapter 70) Article 1263; cf *The Law of Copyright of the Russian Federation* (Kline Preston Publishing Co 2008).

<sup>66</sup> Christopher Heath, Peter Ganea and Hiroshi Saito (eds), *Japanese Copyright Law: Writings in Honour of Gerhard Schricker* (Kluwer Law International 2005) 38-40.

In China the first owner of copyright is the producer, but the “playwright, director, cameraman, word-writer, composer and other authors of the work shall enjoy the right of authorship” and are entitled to compensation according their contracts with the producer. This is, in effect, a statutory transfer of exploitation rights to the producer.<sup>67</sup>

### SO, WHO MAKES THE MOVIE?

Sometime in 1972 two young men who aspired to be screenwriters met the producer, GP Sippy and his director son Ramesh, peddling a four-line film concept. At the end of the meeting, GP Sippy said, ‘I want to make a big film. Develop the four lines.’ The two young men were Salim Khan and Javed Akhtar, and the film that eventually came out of this meeting was *Sholay*, the most enduring success in Indian cinema. And the making of the film was almost as much a saga as the film itself.<sup>68</sup>

The two screenwriters sat down immediately to give shape to the proposed film, but they did not go away leaving a final document, rather they remained on the job throughout the production; one may infer that the screenplay evolved, as did the scenes and the story—including a last-minute change of ending made reluctantly to satisfy wantonly interventionist film censors. The director, Ramesh Sippy, did his job very professionally, took decisions on his own, but the producer was a hands-on presence from start to finish, on the spot and taking or approving the most important decisions, ultimately calling the shots. The director did not, for example, choose the cinematographer, who had a mind of his own, and did not appreciate him (the cinematographer) initially (but did later). At the end of the process, the editor was fortunately someone the director found congenial—though directors are not usually

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<sup>67</sup> Yimeei Guo, *Modern China's Copyright Law and Practice* (Springer 2017); this does not apply to Hong Kong.

<sup>68</sup> Anupama Chopra, *Sholay, the Making of an Indian Classic* (Penguin Books 2000); I owe all my factual information about the production of *Sholay* to this lively account of it; however all comments, inferences and views expressed are my own.

involved at this stage. Throughout, the production house was arranging complicated logistics onsite in, practically, the wilderness; personnel movements to be planned daily in advance, equipment must be in the right place, railway officials to be convinced, local extortionists dealt with, and more.

We get the picture of a great team working together, the drama of the endeavour enlivened by personalities and transient interpersonal conflict, to realise the remarkable, improbably successful, transposition of an alien genre, the “Western,” to an Indian environment in an Indian story, set in India for a Bollywood audience. The script, the difficult choice of location (found after a desperate search for what would work, avoiding cliché); the memorable casting (which, as told, came about partly by chance), the music, everything came together to fit the producer’s grand intention.

That is not to say that everything was charted out in advance or that it worked to plan: consider, for example, the midstream decision to send someone to the UK to recruit British stunt experts. There were moments of great anxiety. To bring the venture to fruition required great vision and will power on the part of the producer: that was the *sine qua non*, though the film couldn’t have been what it is without the screenwriters, the director, the actors and other fortunate choices. But all said and done, it was a great achievement of teamwork in which it might be difficult to discern any single guiding hand that made the film what it is, unless it was Providence itself. And we must resist any temptation to look back at the whole process through rose-tinted lenses of teleology: it could have come out very differently. Because of its collaborative nature, and the inevitably messy process of film production (which we will discuss further) there is much in every film that can never be foreseen, and the process of production can never be repeated.<sup>69</sup>

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<sup>69</sup> See VF Perkins (n 2) Ch 8.

One of the screenwriters of *Sholay* is quoted as saying, '*Sholay* can't be improved upon. Why would anyone want to remake that film? There can be only one *Sholay*!'<sup>70</sup>

To put the thought in more abstract terms, and widen its scope, film has been described as "autographic," not "allographic."<sup>71</sup> Though it is a dramatic work in the sense discussed above, a film is not at all like a play or a song that can be performed over and over again, if differently, at least to some extent each time, yet remain the same untouched, complete, self-sufficient work. Many films have been made of any one of Shakespeare's best-known plays: the plays are "allographic" but each such film is "autographic." it is what it is and can't be changed or recreated. In the case of the play, text and performance are distinguishable: the play is a text that can be enacted in different ways, yet it remains distinct and inviolate. But in the case of a film, the film is its own "aesthetic text".<sup>72</sup> Luhr and Lehman concede that the dialogue of a film (but not the whole screenplay which is wider in its scope and much more malleable) might be considered as analogous to the script of a play, but that does not affect the totality of the film as its own text. All this is no less true of a "remake".<sup>73</sup>

None of this is new, but it does not seem to have been considered in connection with the law of copyright. It should influence the way we look at authorship. The unity of the film, and the impossibility (and irrelevance) of disaggregating different contributions made during the production process,

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<sup>70</sup> Stephen Alter, *Fantasies of a Bollywood Thief* (Harcourt Inc 2007), quoting Javed Akhtar; I am not suggesting that Javed Akhtar intended the further discussion and opinions expressed here.

<sup>71</sup> William Luhr and Peter Lehman, *Authorship and Narrative in the Cinema* (GB Putnam Sons 1977) Ch 1; see Peter Lehman, 'Script, Performance, Text: Performance Theory and Auteur Theory' in Barry Keith Grant (n 3); see also Graham Petrie, 'Alternatives to Auteurs' in Barry Keith Grant (n 3); all these writers draw upon Nelson Goodman, *Languages of Art* (Bobbs-Merill 1968), which has not been consulted for this paper, for the distinction between 'allographic' and autographic.

<sup>72</sup> William Luhr and Peter Lehman (n 71).

<sup>73</sup> William Luhr and Peter Lehman (n 71) 192.

can be considered at two levels: we can perceive the indivisibility of the film both in its character as an autographic “aesthetic text” and, at the more conventional level, in the futility of trying to identify precisely the contributions of different participants in the process. Both these considerations justify treating the film as a work of joint authorship. However, as will be argued below, that does not resolve the problem of who should be granted statutory rights, whether as author or as first owner of copyright.

#### I. Are there candidates for “authorship”?

The credits as displayed on the screen are usually negotiated and specified contractually. There may be some politicking about them and they may not be accurate.<sup>74</sup>

More important, even “accurate” credits may leave us with the impression of a sharper delineation of roles than actually existed.<sup>75</sup> Without actually spying on the entire production process (and taking notes!), we may never know that, say, the screenwriter is not responsible for memorable words and actions that the director or an actor may have improvised on the sets, that memorable visual effects may not have actually been conceived and developed by the director; and we never know how much happened in the editing room and who, besides the editor, was involved.<sup>76</sup>

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<sup>74</sup> Stated from professional experience in India but there is plenty of foreign writing with examples particularly from Hollywood. See, merely for example, Paulin Kael, *Raising Kain* (first published as an essay in 1971, Methuen 1985) and Robert L Carringer, *The Making of Citizen Kane* (University of California Press 1985); Jack Stillinger, *Multiple Authorship and the Myth of Solitary Genius* (OUP 1971) Ch 8; Also see Gore Vidal, ‘Who Makes the Movies?’ in Barry Keith Grant (n 3).

<sup>75</sup> Glenn Frankel, *High Noon: The Hollywood Blacklist and the Making of an American Classic* (Bloomsbury, 2017) is a thorough, highly instructive account of the making of the eponymous classic (implicitly) substantiating all that said in this paper about the collaborative nature of authorship, narrating very clearly the interaction, technical as well as personal, of the producer, screenwriter, director, cinematographer and lead star, all of whom made contributions that are indissolubly linked in the final product; and extraneous political events that influenced the content of the film as production proceeded.

<sup>76</sup> VF Perkins (n 2).

The screenplay, which is logically the starting point, is a very special kind of work; it has to be formatted in a special way as a preliminary guide to what each participant on the set is supposed to do. It is detailed: ideally about one page per minute of screentime.<sup>77</sup> The specialised skills of screenwriters, and the genius of a few of them, are not in question,<sup>78</sup> but the extent to which the final film preserves the original screenplay varies. Typically, the screenplay is likely to be modified frequently as the production of the film proceeds, in a manner that may attenuate any claim to sole authorship.<sup>79</sup>

The “cinematographer”<sup>80</sup> is the person most intimately related to what makes the film a film. The job involves complex skills and artistry:<sup>81</sup> The choice of lens, of shooting angle; the movement of the camera, zooming in or out, panning, or just stationary; the creation of scale by the juxtaposition of objects; lighting, close-ups, slow motion, the composition of each scene, the maintenance of continuity: these are the some of the most obvious elements of a highly developed art.

The cinematographer’s independent contribution to the film, as against the degree of the director’s control and creative contribution, is very much a variable, though there are technical decisions that are the cinematographer’s

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<sup>77</sup> The craft of screenwriting is described in Syd Field, *Screenplay: The Foundations of Screenwriting* (rev edn, Delta Books 2005).

<sup>78</sup> See Gore Vidal (n 74) for a passionate if unpersuasive statement of the case for the screenwriter as author of the film.

<sup>79</sup> My knowledge of the process in India derives largely from what producers say, but the collaborative nature of many or most screenplays is also widely described in literature about Hollywood and in academic film studies; see Tom Dardis, *Some Time in the Sun: The Hollywood Years of F Scott Fitzgerald, William Faulkner, Nathaniel West, Aldous Huxley and James Agee* (Limelight Editions 1988); see also Stillinger (n 74) Ch 8.

<sup>80</sup> Oxford Dictionary of English: ‘a person who oversees or directs photography and camerawork in film-making, especially one who operates the camera’; example: ‘the film has been shot by an award-winning cinematographer’.

<sup>81</sup> Joseph W Mascelli, *The Five C’s of Cinematography: Motion Picture Filming Techniques* (Silman James Press 1965) 147-171 is an accessible introduction; also includes a chapter on cutting.

to make; and the work of both director and cinematographer may be constrained by management decisions and modified by editing.<sup>82</sup>

Finally, when all else has been done and the shooting is over, the raw footage goes for editing. The footage is mere raw material until edited: it is the editing that makes the film and can determine its quality and its commercial or critical success. Bad editing can destroy what might have been a great film. This activity is far removed from literary text editing: it does not merely correct or improve a pre-existing work, but is itself an essential part of the process of creating the work. The raw footage for a feature film is a dozen or more times the final length of the film, anywhere including in India.<sup>83</sup> The footage shot for an acclaimed American film, *Apocalypse Now*, would if fully performed have run for over 230 hours.<sup>84</sup>

It might indeed be possible to make two quite different films from the same footage: at the level of a scene, the editor could decide whether, for example, the viewer knew in advance that a gun was present before the victim got into the car or whether the viewer learnt it only after a shot was fired.<sup>85</sup> Such editing choices, which in effect devise the narrative, pile up scene after scene right through the film. And the editor usually reports to the producer and no one else: very few, privileged, directors have any final say in the editing.

The persons whom audiences most recognise, and may even feel personally familiar with, are the lead performers. Popular films are often made around them: in a Bollywood film the stars typically account for half the cost of production, and a producer might have to submit several different ideas, even scripts, one after another, to get a desperately-wanted star on board.<sup>86</sup> Further,

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<sup>82</sup> Graham Petrie, 'Alternatives to Auteurs' in Barry Keith Grant (n 3).

<sup>83</sup> Information about India acquired in the course of my professional experience.

<sup>84</sup> Walter Murch, *In the Blink of an Eye* (Silman-James Press 2001); see also the chapter on cutting in Mascelli (n 81).

<sup>85</sup> This example is borrowed, but modified, from one in Murch (n 84).

<sup>86</sup> Information acquired from clients in legal practice.

actors might make invaluable contributions to dialogue, scene changes and so forth,<sup>87</sup> and a really big star might even exercise more control than the director.<sup>88</sup> This is not acting *per se* but is another illustration of the collaborative nature of film-making.

It is also worth exploring an actor's contribution to the film *qua* actor. Cinema gives the actor more personal visibility than the stage and calls for skill and talent to realise the medium's ability to exploit the 'unprecedented possibilities of the human face', a 'micro drama of the human countenance'.<sup>89</sup> George Bernard Shaw, no less, said, 'I consider the cinema far more capable of fine and intimate work than the stage.'<sup>90</sup> But there is also something in Walter Benjamin's vivid depiction of the chasm between the "aura" of the stage actor, who makes a continuous performance before a live audience, and the screen actor who performs only for a camera: what the audience actually sees of the screen actor is what others choose to show, and personality can become a substitute for performance.<sup>91</sup>

Legally, performers have never been "authors," not being identifiable as authors of copyright works.<sup>92</sup> (The amending Acts of 1994 and 2012 have given performers certain "neighbouring rights" under sections 38 and 38A of the Copyright Act, which are relatable to different international treaties.)<sup>93</sup> Nevertheless the line between author and performer is not necessarily as sharp

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<sup>87</sup> Patrick McGilligan, *Cagney: the Actor as Auteur* (De Capo Press 1980); Other instances, besides Cagney, could also be cited.

<sup>88</sup> See Graham Petrie (n 82) for examples; this would also be the case in India.

<sup>89</sup> George Bluestone, *Novels into Film* (John Hopkins Paperback 2003) 27; George Bernard Shaw recognised the great potential of the screen contrasted with the limitations of the stage.

<sup>90</sup> Bernard F Dukor (ed), *Bernard Shaw on Cinema* (Southern Illinois University Press 1997) 81.

<sup>91</sup> Benjamin (n 3) para 8-10.

<sup>92</sup> *Fortune Films International v Dev Anand & Ors* AIR 1978 Bom 17.

<sup>93</sup> Rome Convention, TRIPS Agreement, WIPO Performances and Phonograms Treaty (WPPT); Beijing Treaty on Audiovisual Performances. India has acceded to all but the last, though our law protects "audiovisual" performers and is generally compliant with the Beijing Treaty.

as commonly assumed.<sup>94</sup> The film actor's contribution, like those of others contributors who do not enjoy independent copyright, is part of the autographic whole and reflects the indeterminacy of authorship in this medium.

Critical discussion (especially in the West, where "film studies" is a formal discipline) has often been congenial to the notion of the director as the author, but in no jurisdiction does the law of copyright actually recognise the director as the sole author of the film; among common law jurisdictions (except the UK) the director is not an author at all.

The pivotal role of the director cannot be denied, but what the director actually does, or is allowed to do, varies greatly: this is the one participant in film production (the producer apart) who is not engaged to perform some particular highly specialised function. Few directors have complete control: they do not enjoy the last word on script decisions, on the choice of actors and other contributors, or on editing decisions, unless the director is also the producer or has *carte blanche* from the producer. Graham Petrie<sup>95</sup> names Charlie Chaplin as the only instance where the director was a creator with complete control, though he adds twenty-one others as also qualifying substantially at different points in their careers or in some films.<sup>96</sup> We might

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<sup>94</sup> See, for example, the discussion of musical composition and improvisation in Bjorn Herti, 'Who wrote Duke Ellington's music?' in Andreas Rahmatania (ed), *Concepts of Music and Copyright* (Edward Elgar Publishing 2015).

<sup>95</sup> Graham Petrie (n 82).

<sup>96</sup> Eisenstein, Griffith, Keaton, Von Sternberg, Lubitsch, Capra, Hitchcock, Bergman, Truffaut, Kubrick, Von Stroheim, Welles, Ford, Bunuel, Lang, Renoir, Losey, Pudovkin, Kurosawa, Chabrol, Mann.

put Satyajit Ray in the same exclusive class as Chaplin.<sup>97</sup> Raj Kapoor<sup>98</sup> could possibly be added to the twenty-one others.<sup>99</sup>

Anecdotal information is not to be despised in such matters, but there is interesting discussion and debate, with plenty of factual content, around Orson Welles as director and screenwriter of the revered film, *Citizen Kane* and it is difficult to evaluate his actual role, and claim to authorship. Orson Welles' insertion of himself as the main author of the screenplay is considered to be untrue and grossly unfair to Joseph Mankiewicz. The film also owes much to innovation, creative thinking and access to the vast resources of the studio from people not chosen by Welles.<sup>100</sup> None of this is to question Welles' gifts, but it exemplifies the debatable nature of most directors' claims to sole authorship.

Our consideration of the director's job would be incomplete without referring to "*auteur* theory,"<sup>101</sup> which most scholarly discussion of the subject seems to centre around, or did for many decades.<sup>102</sup> A group of young film directors associated with the "New Wave" of the 1950s and 1960s called for better recognition of cinema as an art form in itself. Unfortunately, they tried to achieve this by distinguishing between the genuine *auteur* (like themselves)

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<sup>97</sup> This seems clear from Ray's own writings; see Sandip Ray (ed), *Deep Focus: Reflections on Cinema* (Harper Collins 2011).

<sup>98</sup> Rahul Rawail, *Raj Kapoor: The Master at Work* (Bloomsbury 2021); the author is Raj Kapoor's son.

<sup>99</sup> For India, this is hardly a complete or representative list, but little material on the question seems available.

<sup>100</sup> See Robert L Carringer, *The Making of Citizen Kane* (rev edn, University of California Press 1996); Paulin Kael, *Raising Kain* (first published as an essay in 1971, Methuen 2002); Stillinger (n 74), all of which support the view expressed here.

<sup>101</sup> *Auteur* is French for "author" but the particular connotations in this context are untranslatable, being deeply rooted in the "civil law" notion of authorship; hence the French word is always used in discussion of the theory. For a powerful elaboration of the theory, see Peter Wollen, *Signs and Meaning in the Cinema* (5th edn, Bloomsbury 2013).

<sup>102</sup> Barry Keith Grant (n 3); David A Gerstner and Janet Staiger (eds), *Authorship and Film* (Routledge 2013); John Caughie (ed), *Theories of Authorship, A Reader* (Routledge 2015).

who leaves his stamp on every film, and the *metteur en scène*,<sup>103</sup> a mere craftsman, competent only to comply with a producer's requirements.

Such a distinction obviously cannot withstand scrutiny<sup>104</sup> and, anyway, if *auteurs* are only an elite who achieve an exalted standard of originality (which courts can hardly be expected to identify) the claim must undermine any legal case for directors as authors. However, the movement contributed to a general climate of opinion elevating the perceived status of directors,<sup>105</sup> and reasserting a romantic view of authorship.<sup>106</sup> This new pre-eminence of the director owes much to these ideas on film that developed in France in the 1950s.<sup>107</sup>

The final defence of *auteur theory* is weak but telling: it is the circular argument that identifying the director as author at least provides a focus that facilitates the critical discussion of films.<sup>108</sup> Indeed, we have been conditioned to look for an author for a work; a director (or in India, a producer) can become a brand. It has even been suggested that the whole notion of art cinema has become a form of commoditisation.<sup>109</sup>

Some find it difficult to think of the producer as an author. However, the producer's role is seldom really passive, notwithstanding the constricting statutory language and its narrow interpretation (in the UK for example) that would reduce the producer to a mere financier. The producer is the *sine qua non*: there is no film without the producer. The film producer cannot be compared, for example, to the publisher of a book: the latter paradigmatically

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<sup>103</sup> Another term for which the French is always used in English-language discussion.

<sup>104</sup> See Sidney Lumet (n 1) Ch 3; the papers by André Bazin, Pauline Kael, VF Perkins in Barry Keith Grant (n 3).

<sup>105</sup> See Gore Vidal (n 74) 149 passionately resenting the effect of *auteur* theory on received opinion.

<sup>106</sup> Edward Buscombe, 'Ideas of Authorship' in Barry Keith Grant (n 3).

<sup>107</sup> Kamina Pascal (n 62) 168-69; also, very polemically described by Gore Vidal (n 74).

<sup>108</sup> See Andrew Sarris, 'Notes on the Auteur Theory' in Barry Keith Grant (n 3).

<sup>109</sup> Michael Budd, 'Authorship as a Commodity: The Art Cinema and the Cabinet of Dr Caligari' in Barry Keith Grant (n 3).

publishes and markets a work by a person identifiable (for copyright purposes) as its author.

The film producer initiates the film and takes or has the last word on every major decision, and the final shape of the film is determined at the stage of editing where, usually, the producer involves no one but the editor. An extreme case of the producer's exercising control, but illustrative of what the producer can do, is the making of the American popular classic *Casablanca*. The producer engaged a second screenwriter to write an alternative screenplay to be on the safe side, and then actually got two alternative endings filmed to make it possible to take a last-minute decision about which hero should get the heroine.<sup>110</sup>

It is the producer as industrial enterprise that has to take myriad administrative and managerial decisions before, during and after the production, all of which cumulatively create the final product. The producer company is not necessarily impersonal. Individuals can take charge where the company is the author in principle; consider impresarios like GP Sippy, Yash Raj Chopra, or the Movie Moguls of yore in Hollywood.<sup>111</sup> Walt Disney left an enduring stamp on the corporation that he founded. In India, notwithstanding corporate authorship, an individual is often named as the "producer" in the credits.

Again, a corporate culture is an identity, and can be a compelling force, guiding not only the choice of films but a whole style.<sup>112</sup> Corporate culture does not change easily, and contributors to film (like the employees of any industry) may have to modify their own methods and styles when they change employers. The evolution of an industry and of its products is an instructive

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<sup>110</sup> Stillinger (n 74).

<sup>111</sup> For a Hollywood example, see Scott Eyman, *Darryl F Zanuck and the Creation of the Modern Film Studio* (Hachette 2021).

<sup>112</sup> See Jerome Christiansen, 'Studio Authorship, Corporate Art' in Barry Keith Grant (n 3).

area of study.<sup>113</sup> And different producers, or the same producer at different times in history, might make very different films out of the same story: this, at least, is very consistent with the idea of authorship.

But all this while, there has been an elephant in the room: the increasing industry share of animated films, and the tremendous technical improvements in recent years. Everything I have said so far is about as true of eighty years ago as now, but little of it applies to this new phenomenon, this new mode of filming, though its products are cinematograph films both in law and for the commercial purposes of the film industry. These digital works are far removed from the short cartoons we grew up watching: they are becoming an alternative kind of feature film. There are no actors, film cameras, sets, costumes, makeup, site crews and so on. The director plays the usual coordinating role, putting together the work and the different skill-sets of a highly trained professional team to create what might be seen as a distinct art form: the creative process is very different, requiring quite different talents quite different from those deployed in the conventional film.

This new kind of film is very manifestly “autographic” and also raises the same broad issues of authorship that arise in the case of conventional film. The contributors are of a different kind and play different roles, but the endeavour has to be a collaborative one and the issue of how to allocate rights among contributors would surely, have something in common with conventional film. A more detailed examination of these aspects and of the nature of different contributions is not attempted here; however, everything that we have said about the producer would remain broadly true here as well.

## CONCLUSION

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<sup>113</sup> See, for example, Debashree Mukherjee, *Bombay Hustle, Making Movies in a Colonial City* (Columbia 2020); Thomas Schatz, *The Genius of the System: Hollywood Filmmaking in the Studio Era* (2nd edn, Henry Holt and Co 1996).

Over the last hundred years the law of film copyright globally has evolved to recognise film copyright as subsisting in the content of a film beyond the fixation. But there is still and, for the foreseeable future, will be an irremediable want of harmonisation among national laws (except in common law jurisdictions) as to authorship and copyright ownership.

The laws of jurisdictions outside the common law system are premised on the (irreproachable) assumption that if legal authorship rights are to be granted only to natural persons, then such rights will have to be granted to more than one such person; nor do they err in treating the film as a work of joint authorship. But the very nature of films and film-making makes it impossible to identify and allocate rights—which should also be proportionate to contribution, which is not susceptible to quantification—on a consistent basis. The laws of countries that provide for multiple authorship rights in films perforce leave some discretion (contractual among participants and/or subject to judicial determination) in the allocation of rights, which in all logic needs to be film-specific. We should also flag the point that this kind of distribution of rights has implications for the compensation of contributors to a film, more so because it is either skewed in favour of the authors of underlying works that are capable of separate exploitation or, in some cases, excludes them, or more often excludes others whose contributions are no less important. There appears to be no reasonable probability that this want of harmonisation will, or can, ever be rectified.

This situation also creates difficulties in exercising rights of exploitation; Article 14<sup>bis</sup> of the Berne Convention does not succeed in addressing this problem, which failure reflects the practical impossibility of ever making exploitation rights sufficiently secure, especially across jurisdictional borders. (The amendments to Indian law made in 2012<sup>114</sup> needlessly extend

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<sup>114</sup> Copyright Act 1957, s 17 (second proviso).

this problem of security for the producer in exploiting underlying works within the film, to a common law jurisdiction where there was no ideological compulsion to do so.)

There is no room for doctrinaire, *a priori*, opinions about how copyright and the rights of contributors should subsist in a cinematograph film. Such questions can never be answered definitively or in a vacuum. The two basic solutions that have been adopted are to either make the producer the author and/or first owner of copyright in the film, or to split authorship rights amongst a number of different contributors (not merely producer and director) and then identify such contributors and somehow apportion rights among them. The solutions adopted for the latter are, as we have seen, more jurisdiction-specific and have greater potential for confusion and uncertainty, besides the problem of exploitation rights that Article 14<sup>bis</sup> of the Berne Convention fails to resolve. Nor would multiple authorship on the existing EU pattern (unsatisfactory as it already is) necessarily fit unforeseeable developments like the new generation of animated films. The essential problem with the civil law kind of solution is that, notwithstanding its acceptance of joint authorship, it shows a want of appreciation of the unity of the film, both conceptually as a work of which the elements are frozen permanently in a single “autographic” work and because of the inherent impossibility of accurately allocating credit to different “authors” or even determining whether a particular contribution entitles someone to be an “author” at all. Making the director, or principal director, the author under copyright law would be as arbitrary as any other solution, and hitherto the director has not been made the sole “author,” or even a special “author” above other “authors” anywhere.

One issue that we have not touched upon, which is beyond the intended scope of this paper and which I have not researched, but which may be flagged, is the basis for compensating contributors to the film. The basic principle must

unavoidably be contractual, for when the statutory allocation of rights is itself arbitrary, any statutory allocation of rewards that is linked to it will be no less so. Collective bargaining has been the main solution in the United States, but may not be feasible everywhere. In India, the 2012 amendments attempted to fix statutory compensation for just a couple of influential contributors contributing just a couple of the underlying works of a film, and the drafting of the statute left much to be desired.<sup>115</sup> Royalty-based methods of compensation in any case impose commercial risk (which is considerable in the Indian film industry) on contributors to the film. As of now, contract seems the only realistic basis, but we should keep an open mind.

Admittedly, it would be no more realistic to try to impose common law solutions on civil law jurisdictions than *vice versa*. However, potential problems for cross-border exploitation are, at least, less of a problem among common law jurisdictions to the extent that they have similar, and simpler, laws on film authorship and copyright ownership. It is important for India that the common law jurisdictions (the Commonwealth plus the United States, Israel and Hong Kong) comprise the largest area where copyright laws on authorship are harmonised (with, as we have seen, the ironic exception of the UK)

Finally, how troubled do we need to be about film authorship, and the practical impossibility of comprehensively identifying “authors” or standardising the list of authors? VF Perkins vividly and persuasively describes how, given the vagaries of the production process, there is ultimately no way of knowing (or knowing with certainty) how far the outcome or meaning was originally intended. There is a sense in which films are “accidental” and to that extent “impersonal”. They are not often derived

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<sup>115</sup> Insertion of the 4<sup>th</sup> and 5<sup>th</sup> provisos in Copyright Act 1957, s 18; Copyright Act 1957, s 19(9); Copyright Act 1957, s 19(10).

from any one person's conception.<sup>116</sup> Indeed, at a higher conceptual level the very notion of authorship, in any kind of "work", is in question.<sup>117</sup>

Nevertheless, the law has its own dynamic: the evolution of the law and of theory do not necessarily move in tandem, and need not.<sup>118</sup> Given the necessarily arbitrary nature of any attribution of authorship in films, in any possible copyright law, and not being encumbered with the ideological baggage that has led to such confusion, inconsistency and want of international harmonisation—and for all that even more arbitrariness—in civil law jurisdictions, our legislature has not erred in retaining the simplest principle, which is no more arbitrary than any other and which is also the one that is more closely harmonised in the jurisdictions all Anglophone or partly so, that are home to most of the Indian diaspora, and therefore are important foreign markets for our films and, among foreign countries, the ones whose films are watched the most in India and which invest the most in our film industry. In the end, absent any advantage in doing otherwise, there is a pragmatic case for keeping the law simple.

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<sup>116</sup> VF Perkins, 'Direction and Authorship' in Barry Keith Grant (n 3); see also VF Perkins (n 2).

<sup>117</sup> Hence, Barry Keith Grant also found it necessary to include Roland Barthes' famous essay, *The Death of the Author* (Fontana Press 1977) in his compilation, that we have referred to so often. A good starting point for those interested.

<sup>118</sup> This is one of the important insights of David Saunders (n 62).

## **'IP and' Claims in India: Integrating International and Domestic Legal Methods**

Sanya Samtani\*

### *Abstract*

*Intellectual property (IP) law has been treated as lex specialis in the international and domestic law literature. While it is true that there are subject matter peculiarities unique to IP, it is equally true that IP is a creation of law – both international and domestic. This paper calls for close attention to be given to the nature of IP law - as law – in interpreting claims that arise under it. In particular, this paper focuses on 'IP and' claims which lie at the intersection of intellectual property law and other bodies of law. The central question that this paper poses is: what is the appropriate methodological approach to identifying and interpreting 'IP and' legal claims, in the domestic Indian context? In addressing this question, the paper sets out the appropriate methodological approach to identify and interpret such claims, drawing on public international law, the interpretation of statutes, and constitutional law. Viewing 'IP and' claims through this integrated lens provides clarity on the various overlapping bodies of law and the myriad obligations they impose upon the State – both domestically and*

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\* Sanya Samtani (DPhil, Oxon.; BCL, Oxon.; BA LLB, NALSAR), postdoctoral research fellow at SARCHI Chair for International and Constitutional Law, Department of Public Law, University of Pretoria. Email: sanya.samtani@up.ac.za. ORCID: <https://orcid.org/0000-0003-0448-8798>. Author's note: This piece draws significantly from Chapter 6 of my DPhil thesis titled 'The right of access to educational materials and copyright: International and domestic law' available at Oxford Research Archive, and also from a forthcoming monograph with Brill-Martinus Nijhoff that draws on the research conducted for the thesis. The author presented a version of this argument at the Courts and the Constitution Conference organised by Azim Premji University, NALSAR University of Law, and Law and Other Things Blog (April 2022) as part of the Shammad Basheer Memorial Roundtable in response to an invitation from the organisers. The author thanks the anonymous reviewers for their comments and the editorial board for their hard work. The author recognises the financial support provided by the National Research Foundation (NRF) South Africa to make this research possible as part of the postdoctoral research conducted at the SARCHI Chair.

*internationally. While locating its central example in the realm of educational materials, the approach developed in this paper offers a rubric for how constitutional (and other domestic) actors can approach 'IP and' claims in a manner that does not risk violating constitutional rights.*

## INTRODUCTION

More often than not, intellectual property law overlaps with other areas of legal regulation.<sup>1</sup> This is by virtue of its subject matter. Intellectual property law seeks to vest ownership in forms of knowledge in particular entities and persons in order to create economic value.<sup>2</sup> Different types of intellectual property law function with differential logic, based on their stated purpose – for instance, copyright law seeks to create a limited legal monopoly over the use of literary, artistic, musical, dramatic and other creative works. Other areas of law also regulate the same subject matter – for instance, constitutional law seeks to give effect to the right to education, which includes access to educational materials (eg., literary works); participation in cultural life, which includes access to literary, artistic, dramatic and other creative works etc.

While the burgeoning IP and human rights literature has begun to recognise and address the above overlap in international law,<sup>3</sup> there has been limited attention paid to the mechanics of this overlap in specific domestic

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<sup>1</sup> And often within the field itself. See, Shamnad Basheer and Neil Wilkof, *Overlapping Intellectual Property Rights* (OUP 2012).

<sup>2</sup> See generally, Amy Kapczynski and Gaëlle Krikorian (eds), *Access to Knowledge in the Age of Intellectual Property* (Zone Books 2010).

<sup>3</sup> See generally, for instance, LR Helfer, 'Regime Shifting: The TRIPs Agreement and New Dynamics of International Intellectual Property Lawmaking' (2004) 29 *Yale Journal of International Law* 1; LR Helfer, 'Toward a Human Rights Framework for Intellectual Property' (2006) 40 *University of California Davis Law Review* 971; LR Helfer and GW Austin, *Human Rights and Intellectual Property: Mapping the Global Interface* (Cambridge University Press 2011).

jurisdictions and the impact of its non-recognition.<sup>4</sup> Similarly, what has also received limited attention in this context is the relationship between international and domestic law and its role in conditioning the domestic fulfilment of competing obligations. In the Indian context, the existing literature often focuses on either international law or domestic law – but not on how they interact (or ought to interact),<sup>5</sup> and less so on overlapping subject matter in the nature of constitutional law and human rights,<sup>6</sup> requiring the understanding and operation of several areas of law at once. In any event, there has been no work that has aimed to systematise and set out the overarching methodological approach that ought to be adopted in considering such claims.

This paper aims to fill this gap in the Indian domestic context. The central question that this paper poses is: what is the appropriate methodological approach to identifying and interpreting ‘IP and’ legal claims in India? Since intellectual property is a creation of law, the first step in the enquiry is to identify which bodies of law create and regulate IP, and their rules of interpretation. In doing so, crucially, any other body of law that regulates the same subject matter must also be identified, as well as their rules of interpretation. The specific type of IP, as well as the overlapping bodies of law, depend entirely on the subject matter and fact-specific claim at issue. In order to provide an example of how this approach can be applied, and the considerations to bear in mind in its application, I consider copyright law. The same approach is equally applicable to other bodies of IP law, bearing in

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<sup>4</sup> See one of the few articles in this regard, Andrew Rens and Jimcall Pfumodorze, ‘Neglect of the Human Rights Dimension in African IP Policymaking’ [2015] *South African Journal of Information and Communication* 82.

<sup>5</sup> With a few notable exceptions, for instance, Shamnad Basheer, ‘Trumping TRIPS: Indian Patent Proficiency and the Evolution of an Evergreening Enigma’ (2018) 18 *Oxford University Commonwealth Law Journal* 16.

<sup>6</sup> With a few notable exceptions, for instance, Lawrence Liang, ‘Exceptions and Limitations in Indian Copyright Law for Education: An Assessment’ (2010) 3 *Law and Development Review* 198.

mind the differentiated content and logic. Moreover, the particular context in which such claims are considered is also crucial – if these claims are considered in international institutions different considerations would be at play, as opposed to if they are considered within domestic Indian institutions. For the purposes of this paper, I focus on Indian institutions – in particular, Parliament, courts, and the executive.

For the purposes of the analysis in this paper, ‘IP and claims’ are those legal claims, whether made before courts or other institutions, that recognise an overlap between IP and other bodies of law. These claims can be made in the form of a lawsuit, a parliamentary debate about the interpretation of a particular legal provision as well as during the process of law reform and policy-making by the executive to implement such laws amongst other forms. The paper is not wedded to a particular form of the claim or a particular institution interpreting a claim. It aims to offer a methodological viewpoint located in recognising that such claims sit at the intersection of several legal frameworks, each of which have their own rules of interpretation based on their nature. In this way, the method proposed in this paper is equally applicable across domestic institutions, while accounting for their particular institutional constraints in practice.

The paper first identifies those international and domestic legal instruments that create and regulate copyright in India. I focus on those international agreements by which India has consented to be bound. Second, the paper maps the subject matter of copyright law in order to determine overlapping areas of regulation. In particular, I identify educational materials as the example for the purposes of this paper. Third, the paper sets out those international and domestic legal instruments that regulate educational materials. Similarly, here, it focuses on binding international agreements that create obligations at international law and domestic law, for India. Fourth, given that the paper only focuses on domestic Indian institutions, it sets out

the role of the Indian Constitution in interpreting these claims. This is replicable in respect of other constitutional democracies. And in conclusion, I discuss how the particular institutional framework within which such claims are being considered influences their consideration. In sum, this paper sets out a guide to the doctrinal legal methods to be followed in identifying and interpreting 'IP and' claims in India.

### **IDENTIFYING LEGAL INSTRUMENTS CREATING AND REGULATING COPYRIGHT**

In this section I identify the international and domestic legal instruments that regulate copyright in the Indian context.

#### **I. International Instruments**

In the copyright example used by this paper, international law is particularly important as the Berne Convention for the Protection of Artistic and Literary Works, 1861 predates independent India's domestic copyright legislation (the Copyright Act, 1957).<sup>7</sup> An understanding of the relevant instruments is key to understanding India's domestic copyright laws – both in the historical sense as is explained in this section, as well as in a methodological sense that is explained in subsequent sections discussing relevant constitutional provisions. The Berne Convention previously applied to the territory of present-day India through the United Kingdom's accession in 1887. India (governed by the colonial British administration at the time) deposited an instrument of continued application of the Berne Convention in 1928.<sup>8</sup> The Indian delegation to the Stockholm Revision Conference of the Berne Convention played a key role in lobbying for what eventually became the

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<sup>7</sup> India is a former British colony. See also, section 1.2.2. of this paper for a brief historical note.

<sup>8</sup> 'India, Berne Convention: Treaties and Contracting Parties' (*WIPO*) <<https://wipolex.wipo.int/en/treaties/parties/remarks/IN/15>> 21 March 2021.

Berne Appendix.<sup>9</sup> However, the Berne Appendix is largely considered to be a failure<sup>10</sup> – despite this, India recently renewed its acceptance.<sup>11</sup> After enacting its domestic copyright statute in 1957, India acceded to the Brussels Act of the Berne Convention in 1958, signed the Stockholm Act in 1967, and subsequently acceded to the Paris Act in 1984.<sup>12</sup> The Berne Convention thus binds India. India signed the United Nations Educational Scientific and Cultural Organisation (UNESCO) Universal Copyright Convention (UCC) at its inception in 1952 and subsequently at its revision in 1971.<sup>13</sup> The UCC provides for priority to be given to the Berne Convention.<sup>14</sup> Since the Berne Convention and, subsequently, Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) has near universal application, the UCC has fallen into disuse.<sup>15</sup>

India ratified the World Intellectual Property Organisation (WIPO) Convention in 1975, becoming a member of WIPO.<sup>16</sup> Recently, in 2018, India acceded to the WIPO Copyright Treaty and WIPO Performances and

<sup>9</sup> Eva Hemmungs Wirtén, ‘Colonial Copyright, Postcolonial Publics: The Berne Convention and the 1967 Stockholm Diplomatic Conference Revisited’ (2010) 7 *SCRIPTed: A Journal of Law, Technology & Society* 532, 541–543.

<sup>10</sup> Eg., RL Okediji, ‘Sustainable Access to Copyrighted Digital Information Works in Developing Countries’ in KE Maskus and JH Reichman (eds), *International Public Goods and Transfer of Technology Under a Globalized Intellectual Property Regime* (1st edn, CUP 2005) 156–158; Victor Nabhan, WIPO Study On Limitations And Exceptions For Copyright For Educational Purposes In The Arab Countries, *SCCR* 19/6, 7 October 2009 [56-57].

<sup>11</sup> Declaration by the Republic of India Relating to arts II and III of the Appendix to the Paris Act (1971), Berne Notification No. 280 <[https://www.wipo.int/treaties/en/notifications/berne/treaty\\_berne\\_280.html](https://www.wipo.int/treaties/en/notifications/berne/treaty_berne_280.html)> accessed 21 March 2021.

<sup>12</sup> Subject to India’s declaration on the ICJ and cinematographic works. See, ‘India, Berne Convention: Treaties and Contracting Parties’ (*WIPO*) <<https://wipolex.wipo.int/en/treaties/parties/remarks/IN/15>> accessed 21 March 2021.

<sup>13</sup> Universal Copyright Convention (*UNESCO*) <[http://portal.unesco.org/en/ev.php-URL\\_ID=15241&URL\\_DO=DO\\_TOPIC&URL\\_SECTION=201.html#STATE\\_PARTIES](http://portal.unesco.org/en/ev.php-URL_ID=15241&URL_DO=DO_TOPIC&URL_SECTION=201.html#STATE_PARTIES)> accessed 21 March 2021.

<sup>14</sup> UCC art XVII(1).

<sup>15</sup> S Ricketson and JC Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond* (2nd edn, Oxford University Press 2006) para 18.27-18.29.

<sup>16</sup> ‘WIPO Convention Contracting Parties’ (*WIPO*) <[https://wipolex.wipo.int/en/treaties/ShowResults?treaty\\_id=1&country\\_id=80C](https://wipolex.wipo.int/en/treaties/ShowResults?treaty_id=1&country_id=80C)> accessed 21 March 2021.

Phonograms Treaty.<sup>17</sup> India is a founding member of the World Trade Organisation (WTO).<sup>18</sup> It is thus bound by the ‘covered agreements’ which include the (TRIPS) and the WTO Dispute Settlement Understanding. TRIPS, the Berne Convention and the UCC have been domestically incorporated into Indian law through the International Copyright Order, 1999, read with the Copyright Act.<sup>19</sup> India was the first country to ratify the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled (Marrakesh VIP Treaty) 2013, strengthening its commitment to ensuring access to materials under copyright for persons living with visual and print disabilities.<sup>20</sup> In addition to these treaties, other relevant instruments include regional or bilateral free trade agreements that may impose TRIPS-plus measures.<sup>21</sup>

## II. Domestic Instruments

A preliminary survey of domestic legislation indicates that the Copyright Act is relevant in the context of this example. Other domestic statutes and attendant regulations may be relevant when applying the argument set out in this paper to other forms of intellectual property law. Independent India enacted its first copyright law in 1957.<sup>22</sup> Prior to this, the copyright laws that

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<sup>17</sup> ‘WCT Contracting Parties’ (*WIPO*), <[https://wipolex.wipo.int/en/treaties/ShowResults?search\\_what=C&treaty\\_id=16](https://wipolex.wipo.int/en/treaties/ShowResults?search_what=C&treaty_id=16)> accessed 21 March 2021; ‘WPPT Contracting Parties’ (*WIPO*), <[https://wipolex.wipo.int/en/treaties/ShowResults?search\\_what=C&treaty\\_id=20](https://wipolex.wipo.int/en/treaties/ShowResults?search_what=C&treaty_id=20)> accessed 21 March 2021.

<sup>18</sup> ‘Member Information: India’ (*WTO*) <[https://www.wto.org/english/thewto\\_e/countries\\_e/india\\_e.htm](https://www.wto.org/english/thewto_e/countries_e/india_e.htm)> accessed 21 March 2021.

<sup>19</sup> International Copyright Order 1999.

<sup>20</sup> ‘Ratification by the Republic of India, Marrakesh Notification No. 1’ (*WIPO*) <[https://www.wipo.int/treaties/en/notifications/marrakesh/treaty\\_marrakesh\\_1.html](https://www.wipo.int/treaties/en/notifications/marrakesh/treaty_marrakesh_1.html)> accessed 21 March 2021. See also, Anita Joshua, ‘India ratifies Marrakesh Treaty for visually impaired’, (*The Hindu*, 03 July, 2014).

<sup>21</sup> Eg., in the context of patents, Ping Xiong, ‘Patents in TRIPS-Plus Provisions and the Approaches to Interpretation of Free Trade Agreements and TRIPS: Do They Affect Public Health?’ (2012) 46(1) *Journal of World Trade* 155-186.

<sup>22</sup> For a full discussion of the politics behind the Copyright Act 1957, see generally Prashant Reddy Thikkavarapu and Sumathi Chandrashekar, ‘New Delhi Challenges the Berne

were enacted were either extensions of the British Copyright Act to its then-colonies or used identical language to the British Act.<sup>23</sup> The Copyright Act 1957 has been subsequently amended to include new technological developments and evolving international norms.

Moreover, depending on the particular fact situation, contract law is likely to be salient. The particular licencing agreement or contract between authors and intermediaries relating to the copyright in the work in question is key to determining the copyright holder and the relevant terms.<sup>24</sup> This has been widely documented in the context of the music and film industry.<sup>25</sup>

#### **DETERMINING SUBJECT MATTER: A PRELIMINARY EXERCISE**

Once the specific international and domestic instruments that create and regulate intellectual property (copyright, in the example used in this paper) have been identified, it becomes important to conduct a preliminary interpretive exercise to determine the subject matter under regulation.<sup>26</sup> For instance, in the context of copyright, the subject matter as specified in the Berne Convention is ‘literary and artistic works’, including ‘every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression’.<sup>27</sup> In domestic law as well, the Copyright Act 1957 provides for exclusive control over the use of artistic, literary, musical,

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Convention’, *Create, Copy, Disrupt: India’s Intellectual Property Dilemmas* (Oxford University Press 2017).

<sup>23</sup> Lionel Bently, ‘Copyright, Translations, and Relations between Britain and India in the Nineteenth and Early Twentieth Centuries’ (2007) 32 *Chicago-Kent Law Review* 1181, 1183–1185.

<sup>24</sup> See eg., Giuseppina D’Agostino, *Copyright, Contracts, Creators : New Media, New Rules* (EE 2010).

<sup>25</sup> See eg., Shubha Ghosh, ‘A Roadmap for TRIPS: Copyright and Film in Colonial and Independent India’ (2011) 1 *Queen Mary Journal of Intellectual Property* 146.

<sup>26</sup> For an overview of the complexities of determining the same subject matter in international law, see ILC, ‘Fragmentation of International Law: Difficulties arising from the Diversification and Expansion of International Law: Report of the Study Group’, 13 April 2006, A/CN.4/L.682 [254]-[256].

<sup>27</sup> Berne Convention art 1(1).

dramatic and cinematographic works, computer programmes and sound recordings to vest in the creator, subject to exemptions.<sup>28</sup>

It is important to stress that this is a preliminary interpretive exercise. For the purposes of the ‘educational materials’ example, this paper considers literary works that includes textbooks, journal articles, monographs, edited collections and other scholarly works. These works are covered by both the Berne Convention and the Copyright Act 1957. More specifically, from its text, article 10(2) of the Berne Convention is particularly relevant in that it refers to ‘teaching’. In domestic law, from its text, section 52 of the Copyright Act lists certain acts that are exempt from infringing copyright. In particular, section 52(1)(i) refers to ‘reproduction by a teacher or a pupil in the course of instruction’.<sup>29</sup> This provision is salient, as well as sections 52(1)(h) (publication of a collection of non-copyright matter for instructional use), 52(1)(j) (performance in the course of education), 52(1)(o) (reproduction from a library where a book is no longer commercially available), 52(1)(p) (reproduction of a library copy of an unpublished work for research) as well as 52(1)(a)(fair dealing of a work for research purposes). Where the particular claim relates to the digital environment or new technologies, the WIPO Copyright Treaty becomes relevant. Where the person making the claim or the person affected is a person living with a print disability, the Marrakesh VIP Treaty becomes relevant, as do the other provisions in the Copyright Act that relate specifically to accessible format shifting (section 52(1)(zb)).

Depending on the subject matter, different provisions in different intellectual property treaties and domestic legislation will have salience.

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<sup>28</sup> Copyright Act, s 13.

<sup>29</sup> See, for an interpretation of this provision, *The Chancellor, Masters & Scholars of the University of Oxford v Rameshwari Photocopy Services* 2016 SCC OnLine Del 5128: (2016) 160 DRJ (SN) 678 (‘Endlaw J’ or ‘Single Bench’); *The Chancellor, Masters & Scholars of the University of Oxford v Rameshwari Photocopy Services* 2016 SCC OnLine Del 6229: (2016) 235 DLT 409 (DB); (2017) 69 PTC 123 (‘Division Bench’). Collectively ‘DU Photocopy’.

Having identified the applicable provisions that would require interpretation here, based on the particular fact situation underlying the claim, at this stage in the enquiry it becomes important to consider whether and how educational materials are regulated by any other bodies of law.

#### **IDENTIFYING OVERLAPPING LEGAL INSTRUMENTS REGULATING EDUCATIONAL MATERIALS**

Having determined the subject matter at issue to be educational materials (depending of course on the particular facts of a particular claim), the next step in the enquiry is to determine the legal framework, both domestic and international, relating to educational materials. In this section, I identify the overlapping international and domestic instruments.

##### **I. International Instruments**

The International Covenant on Economic, Social and Cultural Rights (ICESCR) contains a right to education.<sup>30</sup> India acceded to the ICESCR in 1979,<sup>31</sup> but has neither signed nor ratified the Optional Protocol to the ICESCR (OP-ICESCR). Individual communications cannot be brought to the Committee on Economic, Social and Cultural Rights (CESCR). The ICESCR has been domestically incorporated by the Protection of Human Rights Act, 1993, that provides for National and State human rights commissions to be set up to ensure that the rights in the ICESCR, International Covenant on Civil and Political Rights (ICCPR) and constitutional rights are adequately protected.<sup>32</sup> Further, India ratified the UN Convention on the Rights of Persons with Disabilities (UNCRPD) in 2007, the UN Convention on the Elimination of Discrimination against Women (CEDAW) in 1993, the International Convention on the Elimination of all Forms of Racial

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<sup>30</sup> ICESCR, art 13.

<sup>31</sup> 'India' (*OHCHR*) <<https://www.ohchr.org/en/countries/asiaregion/pages/inindex.aspx>> accessed 21 March 2021.

<sup>32</sup> Protection of Human Rights Act, 1993 (as amended by the Protection of Human Rights Amendment Act 2006).

Discrimination (ICERD) in 1968, and the UN Convention on the Rights of the Child (CRC) in 1992.<sup>33</sup> India has not consented to a single communications procedure under these treaties. Individuals and groups thus cannot file individual complaints at any of the above treaty bodies. However, India bears reporting obligations regarding the domestic application of these treaties. India ratified the United Nations Educational, Scientific, and Cultural Organisation (UNESCO) Convention in 1946.<sup>34</sup> As a member of UNESCO, India participated in the World Conference on Education for All in 1990, that resulted in the non-binding World Declaration on Education for All and a Framework for Action: Meeting Basic Learning Needs.<sup>35</sup> India has expressed political commitments to ensure equal access to education for all by participating in the subsequent World Education Forum at Dakar, and adopting the non-binding Dakar Framework for Action in 2000.<sup>36</sup> Most recently, in 2015, India participated in the World Education Forum at Incheon, adopting the non-binding Education 2030 Framework for Action based on Sustainable Development Goal (SDG) 4.<sup>37</sup> Although these instruments are not in the nature of treaties and do not create binding obligations, they affirm India's commitment to realising the right to education for all.

## II. Domestic instruments

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<sup>33</sup> *OHCHR* (n 31).

<sup>34</sup> 'Constitution' (*UNESCO*) <[http://portal.unesco.org/en/ev.php-URL\\_ID=15244&URL\\_DO=DO\\_TOPIC&URL\\_SECTION=201.html](http://portal.unesco.org/en/ev.php-URL_ID=15244&URL_DO=DO_TOPIC&URL_SECTION=201.html)> accessed 21 March 2021.

<sup>35</sup> UNESCO, World Declaration on Education for All and Framework for Action to Meet Basic Learning Needs, (1990) ED-90/CONF205.

<sup>36</sup> UNESCO, World Education Forum, Dakar: Final Report, (2000) ED2000/WS/29.

<sup>37</sup> UNESCO, Education 2030: Incheon Declaration and Framework for Action for the implementation of Sustainable Development Goal 4: Ensure inclusive and equitable quality education and promote lifelong learning opportunities for all, (2016) ED-2016/WS/28. See also, UNGA, Transforming our world: the 2030 Agenda for Sustainable Development, 21 Oct 2015, A/RES/70/1.

In respect of educational materials, there are a plethora of domestic legal instruments that are salient: the Indian Constitution, domestic statutes including education law, competition law, and contract law. Apart from education law which is relevant due to the specific nature of the example in this paper, these domestic legal instruments are likely to be salient for other 'IP and' claims.

The Indian Constitution is an important starting point given its status as the supreme law of the land. Indian Constitution did not have an explicit right to education until 2002 when it was amended to add art 21A.<sup>38</sup> Before this, the courts developed an enforceable right to education as an aspect of the right to life under art 21 read with the relevant Directive Principles of State Policy.<sup>39</sup> In addition to 'facilities for reading, writing and expressing one-self in diverse forms',<sup>40</sup> the Supreme Court has included the right to educational facilities and the right to compulsory primary education within the right to life.<sup>41</sup> On the basis that it would be a retrogressive step for art 21A to extinguish rights that existed under art 21,<sup>42</sup> I identify both the implicit right to education and explicit right to education as salient for the purposes of this enquiry. I address their particular interpretation in the next section. Further, depending on the claimant and their socio-economic position, the right to equality and non-discrimination becomes relevant as it brings to the fore considerations of access to educational materials.<sup>43</sup> The questions that arise are – to what extent is access available to the claimant ? To what extent

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<sup>38</sup> Constitution (Eighty-Sixth Amendment) Act of 2002. For an overview of the political and civil society contestation around the amendment and its critique see Vijayashri Sripati and Arun K. Thiruvengadam, 'India: Constitutional Amendment Making the Right to Education a Fundamental Right' (2004) 2 International Journal of Constitutional Law 148.

<sup>39</sup> Constitution of India, art 45 (before amendment in 2002).

<sup>40</sup> *Francis Coralie Mullin v The Administrator, Union Territory of Delhi* 1981 AIR 746 [7]-[8].

<sup>41</sup> *Bandhua Mukti Morcha v Union of India* (1997) 10 SCC 549 [11].

<sup>42</sup> ICESCR art 2. See also, Sandra Liebenberg, 'Between Sovereignty and Accountability: The Emerging Jurisprudence of the United Nations Committee on Economic, Social and Cultural Rights Under the Optional Protocol' (2020) 42 Human Rights Quarterly 48.

<sup>43</sup> Constitution, arts 14, 15.

does the claimant's location at the intersection of protected characteristics, or group membership, or identity, or status condition their access to these materials and consequently their right to education ?

In terms of domestic statutes, the Right to Education Act, 2009 ('RTE Act') is relevant. It was enacted pursuant to art 21A.<sup>44</sup> It is an instance of a 'constitutional statute', where the State is *required* to legislate to fulfil a positive constitutional obligation.<sup>45</sup> The RTE Act describes the manner in which the right to free and compulsory education must be implemented by the State.<sup>46</sup> The right to education under this Act includes an equal right to the same quality of education,<sup>47</sup> without discrimination, for children living with disabilities;<sup>48</sup> children whose parents or guardians earn an annual income lower than the minimum amount specified by the State through notification and children who are disadvantaged by virtue of their caste, class, language, gender or any other social, cultural, economic, geographical or such other factor.<sup>49</sup> Indirect costs of education, including the cost of textbooks and other educational materials as barriers to access are contemplated by this Act.<sup>50</sup> The

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<sup>44</sup> See generally, Archana Mehendale, 'Compulsion to Educate' in Krishna Kumar (ed), *Routledge handbook of education in India: debates, practices, and policies* (Routledge 2018).

<sup>45</sup> For another example of a constitutional statute in the Indian context see, Malavika Prasad, 'Guest Post: Right To Information (RTI) and the Idea of a Constitutional Statute' (*IndConLawPhil*, 31 July 2019) <<https://indconlawphil.wordpress.com/2019/07/31/guest-post-rti-and-the-idea-of-a-constitutional-statute/>> accessed 21 March 2021; Gautam Bhatia, 'The Amendments to the Right to Information Act are Unconstitutional' (*IndConLawPhil*, 25 July 2019) <<https://indconlawphil.wordpress.com/2019/07/25/the-amendments-to-the-right-to-information-act-are-unconstitutional/>> accessed 21 March 2021. See also, Farrah Ahmed and Adam Perry, 'Constitutional Statutes' (2017) 37 *Oxford Journal of Legal Studies* 461.

<sup>46</sup> *Pramati Educational and Cultural Trust v Union of India* (2014) 8 SCC 1 [40] ('*Pramati Educational Trust*').

<sup>47</sup> Although, the Supreme Court has excluded the application of the RTE to minority schools whether aided or unaided by the State, *ibid* [47].

<sup>48</sup> RTE Act, s 3(3). See also, Persons with Disabilities (Equal Opportunities, Protection and Full Participation) Act 1996.

<sup>49</sup> RTE Act, ss 8(c), 9(c). See also, s 12(1)(c) requiring private unaided schools to reserve 25% of seats in class 1 for children from the same disadvantaged sections of society. This was held to be constitutional in *Pramati Educational Trust* (n 46) [42].

<sup>50</sup> RTE Act, s 3(2).

Model Rules<sup>51</sup> pursuant to the RTE Act also explicitly include the provision of free textbooks as well as free assistive learning materials and support for children living with disabilities.<sup>52</sup>

Further, given that textbooks and other educational materials are more often than not produced and marketed by business actors, such as the publishing industry, competition law becomes relevant. Its particular relevance depends on the claim at issue – but for instance, comparatively, in the South African context, the Competition Commission of South Africa was investigating a case of price fixing in the publishing industry that led to an increase in prices of educational materials.<sup>53</sup> The Indian Competition Act 2002 could also offer potential for a similar claim, if the fact situation supports it.

Finally, as mentioned in the section on identifying intellectual property instruments above, contract law may have an important role to play in structuring the relationships between the copyright holder, and institution or individual seeking to access educational materials. In interpreting relevant contracts, regard must be had to ss 23 and 24 of the Indian Contract Act that effectively provides for the supremacy of statutory law and public policy over contractual relations.

#### **INTERPRETING THESE INSTRUMENTS AND UNDERSTANDING THEIR RELATIONSHIP WITH ONE ANOTHER**

The instruments I have identified above are all in the nature of *law*. They are all related to one another, on the basis that they are either undertaken, promulgated, or otherwise structured by the Indian State. In this section, I set

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<sup>51</sup> These rules provide direction to state legislatures for the enactment of state-based RTE Acts as education is a matter within the competence of both the central and state legislatures.

<sup>52</sup> Model Rules, Rule 5, 14(3).

<sup>53</sup> ‘Media Statement: The Commission uncovers cartel of book publishers’ (Competition Commission of South Africa, 29 August 2018).

out the relationship between these different instruments and how they should be interpreted.

### I. Determining the content of international treaty obligations

I first deal with the rules of interpretation in respect of the relevant international instruments. India has consented to be bound by the instruments I have outlined above. This is key in respect of understanding their domestic application. I address this in the next section. Given the pluralistic nature of international law, identifying the relevant legal rules is an important first step.<sup>54</sup> Crucially, however, in order for India to consider *how* to domestically apply the relevant rules of international law, it becomes important for the content of the relevant international obligations to be determined. In this section I set out the rules of treaty interpretation that must be applied to determine the extent of the obligations imposed on India under international law in respect of educational materials.<sup>55</sup>

According to the Vienna Convention on the Law of Treaties, treaty provisions must be interpreted in good faith.<sup>56</sup> This includes deciding whether an evolutionary interpretation of a treaty provision is appropriate.<sup>57</sup> An interpreter must interpret the ordinary meaning of the text in its surrounding context and in light of the treaty's object and purpose.<sup>58</sup> The context includes

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<sup>54</sup> Martti Koskenniemi, 'Methodology of International Law' [2007] Max Planck Encyclopaedia of Public International Law 9; Christian Dominicé, 'Methodology of International Law' in Jeanne Belhumeur and Luigi Condorelli (eds), *L'ordre juridique international entre tradition et innovation* (Graduate Institute Publications 1997).

<sup>55</sup> For the desirability of the VCLT's application in domestic legal systems' interpretation of international law, see Odile Ammann, *Domestic Courts and the Interpretation of International Law: Methods and Reasoning Based on the Swiss Example* (Brill-Nijhoff 2020) 191–222; Dire Tladi, 'Interpretation of Treaties in an International Law-Friendly Framework' in Helmut Philipp Aust and Georg Nolte (eds), *The Interpretation of International Law by Domestic Courts* (Oxford University Press 2016).

<sup>56</sup> VCLT art 31(1). See, Hugh Thirlway, 'Treaty Interpretation', *The Law and Procedure of the International Court of Justice: Fifty years of Jurisprudence* (1st edn, Oxford University Press 2013) 1229–1232.

<sup>57</sup> Eirik Bjørge, *The Evolutionary Interpretation of Treaties* (Oxford University Press 2014).

<sup>58</sup> VCLT art 31(1).

the preamble and annexes to the treaty, as well as those treaties that have been concluded in connection with the treaty in question.<sup>59</sup> Along with the context, the interpreter must take into account subsequent agreements regarding how the treaty must be interpreted and applied;<sup>60</sup> the domestic implementation of the treaty (including domestic court decisions) as evidence of how States parties understand the treaty in the form of subsequent practice;<sup>61</sup> and the development of other relevant international law norms.<sup>62</sup> Finally, if intended, special meanings must be given to a term under interpretation.<sup>63</sup> Although the text is the necessary starting point, all the materials referred to in art 31 are equally important to interpretation.<sup>64</sup> *Only* if an interpretation pursuant to the rule described above leads to an ‘obscure or ambiguous’ meaning, or a ‘manifestly absurd or unreasonable’ result, the interpreter must turn to the *travaux préparatoires* to confirm the interpretation.<sup>65</sup>

All the treaty provisions identified above are part of a single overarching system of international law.<sup>66</sup> The organising principle at work is systemic integration, which requires that States’ international obligations be interpreted harmoniously (to the greatest extent possible) and as a part of a coherent system.<sup>67</sup> This principle is codified by the VCLT as subsection

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<sup>59</sup> VCLT arts 31(2)(a), (b).

<sup>60</sup> VCLT art 31(3)(a).

<sup>61</sup> VCLT art 31(3)(b). See also, LB de Chazournes, “‘Subsequent Practice’”, and “‘Family-Resemblance’”: Towards Embedding Subsequent Practice in Its Operative Milieu’ in Georg Nolte (ed), *Treaties and Subsequent Practice* (Oxford University Press 2013) 53–62.

<sup>62</sup> VCLT art 31(3)(c). See section 1.5.1.2.

<sup>63</sup> VCLT art 31(4).

<sup>64</sup> ILC, Draft Articles on the Law of Treaties with commentaries, (1966) A/CN.4/185, 220 [9]. See also, DH Regan, ‘Understanding What the Vienna Convention Says About Identifying and Using ‘Sources For Treaty Interpretation’ in Samantha Besson and Jean d’Aspremont (eds), *Oxford Handbook of the Sources of International Law*, vol 1 (Oxford University Press 2018) 1053–1054.

<sup>65</sup> VCLT art 32. See also, Oliver Dörr and Kristen Schmalenbach (eds), ‘Article 32’, *Vienna convention on the law of treaties : a commentary* (2nd edn, Springer).

<sup>66</sup> P Sands, ‘Treaty, Custom and the Cross-Fertilisation of International Law’ (1998) 1 *Yale Human Rights and Development Law Journal* 85, 95.

<sup>67</sup> Yuval Shany, ‘One Law to Rule Them All: Should International Courts Be Viewed as Guardians of Procedural Order and Legal Uniformity?’ in André Nollkaemper and Ole

3(c) of the golden rule of interpretation, art 31.<sup>68</sup> This principle and its application has received much attention in academic literature<sup>69</sup> as well as courts and tribunals.<sup>70</sup>

In respect of the treaties set out above, the particular content of the obligation imposed by the Berne Convention and other copyright treaties must be determined. It is outside the scope of this methodological paper to conduct this exercise in full, but I have done so comprehensively elsewhere.<sup>71</sup> Further, the particular scope of application, content and nature of the right to education in the ICESCR and other human rights treaties must be determined through this process of interpretation as well as the nature and extent of the obligations imposed upon the State – to what extent the obligation is progressively realisable and immediately realisable and what aspects of it are part of the minimum core and bind States to take immediate action.

Once the content of the international obligations at issue has been determined using the above method, the next step is for the particular interpreter – whether courts, Parliament or the executive – to consider what effect these obligations have domestically.

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Kristian Fauchald (eds), *The Practice of International and National Courts and the (De-)Fragmentation of International Law* (Hart 2012) 16–17.

<sup>68</sup> VCLT art 31(3)(c).

<sup>69</sup> Eg., Chin Leng Lim, ‘Trade Law and the Vienna Treaty Convention’s Systemic Integration Clause’ in Julien Chaisse and Tsai-yu Lin (eds), *International Economic Law and Governance* (Oxford University Press 2016); Campbell McLachlan, ‘The Principle of Systemic Integration and Article 31(3)(c) of the Vienna Convention on the Law of Treaties’ (2005) 54 *International and Comparative Law Quarterly* 279; Martins Paparinskis, ‘Come Together or Do It My Way: No Systemic Preference’ (2014) 108 *Proceedings of the ASIL Annual Meeting* 246. See also, Ivo Tarik de Vries-Zou, ‘Divided but Harmonious? The Interpretations and Applications of Article 31(3)(c) of the Vienna Convention on the Law of Treaties’ (2020) 16 *Utrecht Law Review* 86, 88. See, for a book-length treatment of the issue, Panos Merkouris, *Article 31(3)(c) VCLT and the Principle of Systemic Integration: Normative Shadows in Plato’s Cave* (Brill-Nijhoff 2015) 84–101.

<sup>70</sup> Eg., *Iron Rhine Arbitration, Belgium v Netherlands*, Award, ICGJ 373 (PCA 2005) [58], [79]; *Golder v United Kingdom* App No 4451/70 (1979) 1 EHRR 524; *Ahmadou Sadio Diallo (Guinea v DRC)*, Judgment on compensation [2012] ICJ Reports 324 [65]-[69].

<sup>71</sup> Sanya Samtani, *The Right of Access to Educational Materials and Copyright: International and Domestic Law* (Brill-Martinus Nijhoff, forthcoming).

## II. Domestic effect of international obligations

The constitutional text, as well as interpretations of it, offer clear rules for the domestic application of India's international obligations. In sum, the effect of international obligations that bind India is largely interpretive rather than direct. The Constitution vests exclusive legislative competence in Parliament<sup>72</sup> to make laws on matters related to India's participation in international law-making and the domestic application of international obligations.<sup>73</sup> Under the Constitution, the powers of Parliament are coextensive with those of the Union Executive.<sup>74</sup> The Executive is thus empowered to exercise its functions within the particular areas of legislative competence of Parliament. Further, the Constitution specifically enables the Union Executive to 'exercise such rights, authority and jurisdiction as are exercisable by the Government of India by virtue of any treaty or agreement'.<sup>75</sup> Read with arts 253, 246 and the Seventh Schedule of the Constitution, this provision indicates that the Union Executive is equally empowered to enter into treaties on the international plane, *and* apply international obligations domestically.<sup>76</sup> The Constitution does not provide clarity on how this coexistent power is apportioned between Parliament and the Union Executive.<sup>77</sup> The only constitutional constraint is that all executive

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<sup>72</sup> Constitution The impact of India's quasi-federal structure on legislative competence at both levels is captured under Constitution art 246, read with the Seventh Schedule. In the Seventh Schedule, there are three lists detailing the fields within which the central government (through Parliament) may make laws (the Union List), the state governments (through state legislative assemblies) may make laws (the State List) and a third list where both the centre and state may make laws concurrently (the Concurrent List).

<sup>73</sup> Constitution, Seventh Schedule, entries 10, 11, 12, 13, 14, 15. See also, entries 1, 2, 3, 16, 17, 18, 19, 21, 25, 29, 31, 37, 41 and 57.

<sup>74</sup> Constitution, art 73(1)(a).

<sup>75</sup> Constitution, art 73(2)(b).

<sup>76</sup> VS Mani, 'Effectuation of International Law in the Municipal Legal Order: The Law and Practice in India' (1995) 5 *Asian Yearbook of International Law* 145, 161.

<sup>77</sup> This, it has been argued in the literature, is problematic in that it entails that international obligations are entered into almost entirely through the executive. See, Vinai Kumar Singh, 'International Treaties and the Indian Legal System: New Ways Ahead' (2017) 26 *The Italian Yearbook of International Law Online* 63; Aparna Chandra, 'India and International Law: Formal Dualism, Functional Monism' (2017) 57 *Indian Journal of International Law* 25;

and legislative exercises of power must be compliant with the Constitution in general and the fundamental rights in particular.<sup>78</sup>

The Supreme Court has clarified that the deposit of consent to be bound by international treaties does not on its own have domestic direct effect.<sup>79</sup> However, as noted in the limited literature on the question, the Supreme Court has recently moved towards directly incorporating India's international human rights obligations.<sup>80</sup> Its decisions assume that the judiciary is equally competent to give direct domestic effect to treaty obligations, without any further steps taken by the executive or legislature.<sup>81</sup> A closer look at the jurisprudence indicates that the Court has used this doctrine of 'judicial incorporation' as but *one* explanation for its utilisation of India's treaty obligations.<sup>82</sup> The other interpretive explanation provided by the Court,<sup>83</sup> fits better with the constitutional scheme and the place of international law within it.

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Nihal Jayawickrama, 'India' in David Sloss (ed), *The Role of Domestic Courts in Treaty Enforcement: A Comparative Study* (Cambridge University Press 2010). See also, setting out the need for legislation to apportion specific roles and responsibilities to Parliament and the national executive, National Commission to Review the Working of the Constitution, 'A Consultation Paper on Treaty-making Power under our Constitution' (8 January 2001, New Delhi) <<https://legalaffairs.gov.in/sites/default/files/Treaty-making%20power%20under%20our%20Constitution.pdf>> .

<sup>78</sup> Constitution, art 73(1), 13(1).

<sup>79</sup> *Maganbhai Ishwarbhai Patel v Union of India* (1970) 3 SCC 400 (Shah J) [80] ('*Maganbhai*'). See also, BN Patel, *The State Practice of India and the Development of International Law* (Brill-Nijhoff 2016) 13.

<sup>80</sup> VG Hegde, 'Indian Courts and International Law' (2010) 23 *Leiden Journal of International Law* 53, 60–61; Lavanya Rajamani, 'International Law and the Constitutional Schema' in Sujit Choudhry, Madhav Khosla, and Pratap Bhanu Mehta (eds), *The Oxford Handbook of the Indian Constitution*, vol 1 (Oxford University Press 2016) 148.

<sup>81</sup> *Gramophone Company of India Ltd v Birendra Bahadur Pandey* (1984) 2 SCC 534 [5]-[7].

<sup>82</sup> See also, *KS Puttaswamy v Union of India* (2017) 10 SCC 1 (Nariman J) ('*Privacy-9J*') [532]-[535] for a recent iteration of direct application stating

In the absence of any specific prohibition in municipal law, international law *forms part* of Indian law and consequently must be read into or as part of our fundamental rights. (emphasis added).

<sup>83</sup> *ibid* (Chandrachud J) [91]:

In the view of this Court, international law has to be construed as a part of domestic law in the absence of legislation to the contrary and, *perhaps more significantly, the meaning of constitutional guarantees must be*

In India, the interpretive functions of international obligations have been judicially evolved by interpreting art 51(c). Art 51(c) of the Constitution states, '[t]he State shall endeavour to [...] foster respect for international law and treaty obligations in the dealings of organised people with one another.'<sup>84</sup> This provision is a Directive Principle of State Policy.<sup>85</sup> An analysis of its nature is important to understanding its application. Art 51 places a non-justiciable obligation upon the State to 'endeavour'. According to the ordinary meaning of 'endeavour', the State is obliged 'to try, make an effort for a specified object; attempt strenuously' towards the fulfilment of an object.<sup>86</sup> This exhortative obligation is one of effort rather than outcome.<sup>87</sup> Under art 51(c) specifically, the object of the State's efforts is to 'foster respect' for 'international law' in general, and 'treaty obligations' in particular.<sup>88</sup>

To fully understand the domestic effect of the treaty obligations set out above and how they relate to the other relevant domestic legal instruments, it becomes important to set out the principles of interpretation relating to all of the above.

*a) Statutes must be interpreted consistently with binding treaty obligations*

Courts have interpreted art 51(c)'s injunction to 'foster respect' to mean that statutes must be interpreted compatibly with India's binding treaty obligations, where such an interpretation is reasonably possible.<sup>89</sup> In addition, the 'interpretive guide' function of art 51(c) *qua* DPSP, entails using relevant

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*illuminated by the content of international conventions to which India is a party.* (Emphasis added).

<sup>84</sup> Constitution, art 51(c).

<sup>85</sup> Constitution, part IV.

<sup>86</sup> Oxford Dictionaries, 'Endeavour'

<<https://www.oed.com/view/Entry/61902?result=2&rskey=kZMcgo&>> accessed 24 November 2020.

<sup>87</sup> Lavanya Rajamani (n 78) 145; VG Hegde (n 78) 57.

<sup>88</sup> BN Patel (n 77) 122.

<sup>89</sup> *Union of India v Meghmani Organics Ltd* (2016) 10 SCC 28 [26]; *Jolly George Verghese v Bank of Cochin* [1980] 2 SCR 913 [9].

international law (both binding and non-binding) to inform the interpretation of a statute when it is unclear or contested.<sup>90</sup> Since access to educational materials is regulated by a domestic copyright statute, this interpretive injunction is relevant to its interpretation.<sup>91</sup>

*b) International law as an interpretive framework for the interpretation of fundamental rights*

Art 51(c) also creates an ‘interpretive framework’ function for the scope and content of fundamental rights. Most recently, in the absence of an explicit right to privacy, the Court has employed international law to ‘enlarge’ the scope and content of the fundamental rights to life, equality and freedom in the fundamental rights to include this right,<sup>92</sup> drawing on binding and non-binding international instruments.<sup>93</sup> It suffices to note that international law has been used to interpret the fundamental rights purposively. With regard to the right to education, international law has been used to clarify the State’s duties.<sup>94</sup>

These interpretive principles set out in brief the domestic effect that international obligations must be given under the Constitution. I now turn to the rules of interpretation governing the interpretation of statutes and the fundamental rights in the Constitution.

### III. Interpreting domestic law: relevant statutes, contractual relationships, and the Constitution

<sup>90</sup> *PUCL v Union of India* (2005) 2 SCC 436 (Sabharwal J) [17], [41], (Dharmadhikari J) [51]-[58]; *Githa Hariharan v. Union of India* (1999) 2 SCC 228 [14].

<sup>91</sup> The Supreme Court invoked international treaties that bind India to interpret the Copyright Act in *Gramophone Company of India* (n 81) [29].

<sup>92</sup> *K S Puttaswamy v Union of India* (2019) 1 SCC 1 [112], [508.14] (‘Aadhaar-5J’).

<sup>93</sup> See, *PUCL* (n 90) [20]-[26]; *Thalappalam Service Coop Bank Ltd v State of Kerala* (2013) 16 SCC 82 [57]-[59]; *Navtej Singh Johar v Union of India* (2018) 10 SCC 1 (Misra CJ) [162]-[167]; *Privacy-9J* (n 82) (Chandrachud J) [148]-[154].

<sup>94</sup> *Society for Unaided Private Schools of Rajasthan v Union of India* (2012) 6 SCC 1 [213], [222]-[225].

The Copyright Act, 1957 is by its nature a statute – as is the Right to Education Act. Its interpretation is thus subject to the rules of statutory interpretation. The right to education and the right to equality and non-discrimination are constitutional fundamental rights. Their interpretation is subject to the rules of constitutional interpretation. This is something that the decision-maker / the interpreter of the claim (Parliament, for instance) must take into account in determining its contours (in amending the Copyright Act, for instance). In this section I set out the interpretive principles to be applied to determine the relationship between both sets of instruments. I also set out how these legal instruments relate to contractual relationships, given that contracts are key to structuring access to educational materials.

*a) Interpreting fundamental rights*

In the Indian context, it becomes important to interpret the scope of application and the content of the relevant constitutional rights in the fundamental rights that are at issue, drawing on the case law surrounding it.<sup>95</sup> Further, the nature and extent of duties that the relevant right imposes upon the State must also be determined in the same manner. In particular, while understanding the unique socio-economic position of the claimant, the right to equality and non-discrimination becomes salient as well, and is subject to the same rules of interpretation.

*b) No law can 'abridge' or violate the rights in the fundamental rights*

The Constitution provides that

[t]he State shall not make any law which takes away or abridges the rights conferred by this Part and any law made in contravention of this clause shall, to the extent of the contravention, be void.<sup>96</sup>

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<sup>95</sup> See section “II” “Domestic Instruments” under “Identifying Legal Instruments Regulating Educational Material” (page 53-56) for an interpretation of the fundamental rights at issue in this example.

<sup>96</sup> Constitution, art 13(2).

The fact that a law cannot be interpreted consistently with international law does not affect its constitutionality. However, the constitutionality of a law is suspect if it abridges or violates fundamental rights. Here, law is defined broadly, and includes delegated legislation.<sup>97</sup> If a law violates a right in the fundamental rights, courts must first exercise their discretion to attempt to read down the law so as not to violate the right.<sup>98</sup> If that is not possible, courts are empowered to strike down the law as unconstitutional to that extent.<sup>99</sup> Put differently, this means that *all* law must comply with the fundamental rights and give effect to the DPSPs; but if it cannot give effect to a DPSP this does not in and of itself render it invalid.

*c) Limitations of rights in the fundamental rights must be constitutionally justified*

Different fundamental rights have different standards of review.<sup>100</sup> However, the Supreme Court has recently noted that ‘the thread of reasonableness runs through the entire fundamental rights chapter’.<sup>101</sup> Where the State fails to fulfil the relevant standard in justifying a limitation, the law is unconstitutional to the extent that it infringes that particular right.<sup>102</sup> Differential standards apply to the constitutional right to primary

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<sup>97</sup> Constitution, art 13(3)(a). See also, HM Seervai, *Constitutional Law of India*, vol 1 (4th edn, Universal Book Traders 2002) 400.

<sup>98</sup> Eg., *Indra Das v State of Assam* (2011) 3 SCC 380 [32]-[40].

<sup>99</sup> Constitution, arts 32, 226. See generally, for a statement of the law on severability, *RMD Chamarbaugwalla v Union of India* AIR 1957 SC 628.

<sup>100</sup> Aparna Chandra, ‘Proportionality in India: A Bridge to Nowhere?’ (2020) 3 University of Oxford Human Rights Hub Journal 55, 62. See also, an attempt by the same author to draw on common elements used in limitations analyses across rights, Aparna Chandra, ‘Limitation Analysis by the Indian Supreme Court’ in Mordechai Kremnitzer, Talya Steiner, and Andrej Lang (eds), *Proportionality in Action* (1st edn, Cambridge University Press 2020) 461.

<sup>101</sup> *Shayara Bano v Union of India* (2017) 9 SCC 1 [91] (*‘Shayara Bano’*).

<sup>102</sup> Eg., *Shreya Singhal v Union of India* (2015) 5 SCC 1 [55]-[68], [79].

education,<sup>103</sup> the right to equality and non-discrimination,<sup>104</sup> and the right to life,<sup>105</sup> which include the right to education at all levels.

In sum, all obligations, whether international or domestic, must be fulfilled in conformity with the fundamental rights.<sup>106</sup>

*d) Contracts cannot be concluded if they contravene existing statutes or if they are against public policy*

Contractual relationships are key to understanding how educational materials are actually delivered in society. Contracts structure relationships between authors and publishers, and publishers and libraries among other essential relationships required for the delivery of educational materials. This section briefly discusses them. The Indian Contract Act provides that contracts whose objects are in contravention of existing statutory law are unlawful and therefore void. Moreover, those contracts whose objects are against public policy are also unlawful and therefore void.<sup>107</sup> This applies even where objects are partly unlawful.<sup>108</sup> Further, it is arguable that these provisions of the Indian Contract Act provide a basis for its constitutionalisation.<sup>109</sup> Since the Contract Act, 1872 is a statute, according to the interpretive injunctions set out above, it must be interpreted to give effect to the fundamental rights and the directive principles of state policy. Moreover, the Supreme Court has

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<sup>103</sup> Constitution, art 21A.

<sup>104</sup> Constitution, arts 14, 15.

<sup>105</sup> Constitution, art 21.

<sup>106</sup> Except for where statutes that restrict fundamental rights pass reasonableness review.

<sup>107</sup> Indian Contract Act 1872, s 23. See also, in the context of housing discrimination, Anindita Mukherjee, 'Pervasive discrimination, segregated spaces and the chimerical right to housing' *The Leaflet* (6 June 2019) <<https://theleaflet.in/pervasive-discrimination-segregated-spaces-and-the-chimerical-right-to-housing/>> accessed 10 June 2022.

<sup>108</sup> Indian Contract Act 1872, s 24.

<sup>109</sup> See, Shyamkrishna Balganes, 'The Constitutionalisation of Indian Private Law' in Sujit Choudhry, Madhav Khosla, and Pratap Bhanu Mehta (eds), *The Oxford Handbook of the Indian Constitution*, vol 1 (Oxford University Press 2016). See also, Divyanshu Sharma, 'Making a case for the constitutionalising contract law in India' *The Leaflet* (3 February 2022) <<https://theleaflet.in/making-a-case-for-constitutionalising-contract-law-in-india/>> accessed 10 June 2022.

interpreted the scope of ‘public policy’ in s 23 of the Indian Contract Act as including the realisation of fundamental rights.<sup>110</sup>

The above interpretive injunctions indicate that outside of using fundamental rights to make legal claims, they remain crucial to interpreting statutes, the Constitution, and indeed private contracts. Any institution grappling with ‘IP and’ claims, however they may be couched, must consider this cumulative effect of the above injunctions. In respect of claim-making, although there is a generally held assumption of ‘verticality’ in respect of enforcing fundamental rights violations in comparative constitutional law,<sup>111</sup> the Indian Constitution contains explicit provisions regarding the horizontal application of particular fundamental rights in particular circumstances.<sup>112</sup> Of particular relevance is art 15(2)(a) that prevents private discrimination with respect to access to shops, interpreted by the Supreme Court in a broad sense to include access to service providers in general.<sup>113</sup> This is likely to be relevant with regard to interpreting contracts that concern delivery of educational materials.

## CONCLUSION

The institutional context in which the ‘IP and’ claim is being considered has particular relevance in respect of applying the methodological approach set

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<sup>110</sup> *CESC Ltd. etc v Subhash Chandra Bose* 1992 AIR 573 para 302 E-G. See also, *Delhi Transport Corporation v DTC Mazdoor Congress* 1991 AIR 101.

<sup>111</sup> Gautam Bhatia, ‘Horizontal Rights: An Institutional Approach’ DPhil thesis (Balliol College, University of Oxford) 19, 21. In the Indian Constitution, art 12 encapsulates this vertical approach.

<sup>112</sup> *ibid* 47. See, Constitution, arts 15(2)(a), 17, 23(1) and 24.

<sup>113</sup> *Indian Medical Association v Union of India* (2011) 7 SCC 179. But see, with the same bench strength, *Zoroastrian Co-Operative Housing Society v District Registrar Co-Operative Societies (Urban)* AIR 2005 SC 2306. The latter has been critiqued on the basis of conflating statutory policy with public policy. See, for this argument, Gautam Bhatia, ‘Exclusionary Covenants and the Constitution – III: Zoroastrian Cooperative and Political Liberalism’ *Indian Constitutional Law and Philosophy* (13 January 2014) <<https://indconlawphil.wordpress.com/2014/01/13/exclusionary-covenants-and-the-constitution-iii-zoroastrian-cooperative-and-political-liberalism/>> accessed 10 June 2022.

out in this paper.<sup>114</sup> The institutional actors interpreting the claim are also subject to constitutional constraints. For instance, as has been recently reported,<sup>115</sup> if Parliament seeks to consider amendments to the Copyright Act, it must act in accordance with constitutional constraints imposed upon Parliament's law-making function. This would entail applying the above methodology to understand the extent to which the current Act fulfils fundamental rights (and other overlapping areas of law that impose obligations upon the State), and crucially, the impact of the amendments on fundamental rights. The institutional constraints of Parliament such as parliamentary voting procedures would play a key role in determining who ultimately applies these tools and how they do so.

In sum, the integrated method proposed in this paper is as follows: first, an identification of the international and domestic legal instruments concerning the particular form of intellectual property law in question; second, a determination of the subject matter of the claim; third, an identification of the international and domestic legal instruments concerning the overlapping subject matter; fourth, an inquiry into the rules of interpretation applicable to the identified instruments as well as their relationship with one another - in particular, the impact of constitutional law, given that this analysis is located within the Indian domestic context, the role of constitutional law in governing the domestic application of international law, and the interpretation of statutes in light of international and constitutional law; and finally, an understanding of the rules governing the institution within which such interpretation is taking place. This method is one that takes cumulatively a single State's competing international and

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<sup>114</sup> This is an understanding of 'structural bias' but applied to the domestic context. See, Martti Koskeniemi, 'The Politics of International Law - 20 Years Later' (2009) 20 EJIL 7.

<sup>115</sup> Parliament of India, Report on Review of Intellectual Property Rights Regime in India (Rajya Sabha, 23 July 2021) <[https://rajyasabha.nic.in/rsnew/Committee\\_site/Committee\\_File/ReportFile/13/141/161\\_2021\\_7\\_15.pdf](https://rajyasabha.nic.in/rsnew/Committee_site/Committee_File/ReportFile/13/141/161_2021_7_15.pdf)> accessed on 20 February 2022.

domestic obligations and ensures that an interpretation of an IP claim does not take place in isolation to other areas of law that regulate the same subject matter. While the paper uses copyright and educational materials as its central case to develop such a rubric, the integrated method proposed in the paper is equally applicable to other intellectual property law claims that overlap with other areas of legal regulation.

## **A SURVEY OF CONTEMPORARY INDIAN CASE LAW ON PRIOR PUBLICATION OF DESIGNS**

*Eashan Ghosh*\*

### *Abstract*

*Few areas of Indian intellectual property law have been as fundamentally altered by a single legislative act as prior publication under designs law was by the Designs Act, 2000. Under the 2000 Act, quite literally, it was out with the old and in with the new. Out went the narrow and limited search for materials to find if a design registration had already been published in India before. In came an intelligent and dynamic search for disclosures which could pre-empt and scupper design registrations using materials from anywhere in the world.*

*Now, over two decades on from that seismic change, prior publication law in India is spoilt for choice. Indian courts can dip into a deep and diverse body of case law on the subject and customise their approach to the facts and materials available to them. The results are frequently fascinating, touching on themes as trivial as the angles at which indentations on steel bars are made and as philosophical as how much you can truly rely on what you read on the internet.*

*In this essay, I survey Indian prior publication case law with a focus on the last five years. Following an introduction to the subject in §1, I set out the functions of and qualifications to prior publication under the 2000 Act in §2. This is followed, in §3, by a deliberation on disclosure and publication with*

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\* Eashan Ghosh is an intellectual property lawyer in private practice in New Delhi. He is the author of *The Finished Article: Essays on Indian Designs Law* (Thomson Reuters, 2022), and *Imperfect Recollections: The Indian Supreme Court on Trade Mark Law* (Thomson Reuters, 2020).

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*the help of two prominent rulings in Bharat Glass and Reckitt. In §4, I briefly examine recent prior publication law as it applies to design applications and cancellations, before §5-§8 identify some important contemporary trends to emerge from Defendants pressing into service prior publication as a defence to design infringement. I conclude in §9 with some thoughts on what a comprehensive and layered prior publication inquiry might look like, and how best to draw the balance between the objectivity demanded by the law and the subjectivity inherent to designs.*

### INTRODUCTION

In May 2000, India enacted fresh designs legislation for the first time in over eighty-nine years.

By the time it arrived, the Designs Act, 2000 was at least two decades overdue. Its enactment replaced the shell of the Patents and Designs Act, 1911, of which forty sections addressing the law of patents had already migrated to the Patents Act in September 1970. The endeavour by the 2000 Act to ‘consolidate and amend the law relating to protection of designs’<sup>1</sup> was, therefore, a considerable one.

The task inevitably demanded wholesale changes to the 1911 Act. Ironically, one of the most radical changes introduced by the 2000 Act was provoked by the addition of a mere five words.

Indian law has historically recognised prior publication both, as a ground for rejecting an application for the registration of a design and as a ground for cancellation of a registered design.<sup>2</sup> Prior publications are permitted to be read against design registrations in this manner for a simple reason. Design registrations, and the exclusive term of protection that come with them, are

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<sup>1</sup> Preamble to the Designs Act, 2000, The Gazette of India (Extraordinary Part II, Section I), dated May 12, 2000.

<sup>2</sup> See, for instance, Sections 43(1) and 51A(1)(a)(ii) of the 1911 Act.

offered in exchange for a disclosure to the Designs Office of a new or original design. If it transpires that the design at issue has already been published or disclosed to the public prior to its registration, the *quid pro quo* underpinning the grant of the registration itself no longer holds good.

The 1911 Act drew one limit around this ground of prior publication. Under Section 51A(1)(a)(ii), it stated that the publication of the design must have been *in India* prior to the date of registration.<sup>3</sup> The 2000 Act, under Section 19(1)(b) which replaced Section 51A(1)(a)(ii) of the 1911 Act, expanded this language to a publication in India ‘*or in any other country*’.<sup>4</sup> Quite literally overnight, the introduction of these five words turned prior publication into a demanding and expansive global inquiry.

Major upheaval was not long in coming.

Predictably, the opening up of the prior publication inquiry aggressively favoured those challenging design registrations. Its impact was keenly felt by two categories of designs litigants. One, naturally, was Petitioners in cancellation actions. The other, however, was Defendants in infringement actions. Under the freshly minted Section 22(3) of the 2000 Act, these Defendants were given the liberty to raise, as a defence against infringement, any ground that could ordinarily be used to challenge a registration in a cancellation action. This had the effect of formalizing an erstwhile practice of denying or vacating interlocutory injunctions to Plaintiffs in design infringement actions on the ground of prior publication, even though their registrations could not directly be challenged in such proceedings.<sup>5</sup>

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<sup>3</sup> An amendment had previously replaced ‘British India’ with ‘India’ under Section 51A(1)(a)(ii) in 1930.

<sup>4</sup> *Fun World & Resorts v Nihil K. K.* 2020 (81) PTC 441 (Ker), [15].

<sup>5</sup> *Doraiswamy v Integrated Engineering* (1996) 1 MLJ 554 [2], 7-8, *Baldev Singh v Shriram Footwear* 1997 (17) PTC 268 (Del) [2], 7, 11, 13, *Agarwal v Mayur Plastics* 1998 (18) PTC 182 (Del) [11], *Singh v Godran Rubber* 1999 (19) PTC 375 (Del) [8-12], *Kemp & Co v Prima Plastics* 2000 (20) PTC 96 (Bom) [11-13], are all good illustrations of this practice from the decade preceding the 2000 Act.

Section 22(3) had another upshot. Previously, Petitioners (in cancellation actions) and Defendants (in infringement actions) had been constrained to cite prior material published within India. However, under the 2000 Act, both these categories of litigants were now empowered to bring conflicting publications from around the world to challenge Indian registrations.

A raft of anti-registrant rulings duly followed.<sup>6</sup> Some of them cast an especially harsh light on the difficulties of transitioning between the two standards. One prominent difficulty was that the 2000 Act permitted a global prior publication search to prejudice registrations that had been issued based on domestic publication searches only.<sup>7</sup>

Prior publication law in India has also been non-committal on another crucial question. This is the question of how much publication is sufficient to constitute prior publication under the Designs Act.

Whether certain cited material is significant enough to support a prior publication finding against a design registrant is bound to be subjective to some degree. Part of this subjectivity comes from the fact that India has never committed to a statutory definition of ‘publication’.<sup>8</sup> Even so, Indian law on the subject is remarkably uncertain. In the main, sufficiency of publication

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<sup>6</sup> *Rotela Auto v Jaspal Singh* 2002 (24) PTC 449 (Del) [16], [28] for instance, applied this liberalized law to vacate an interim injunction issued to the Plaintiffs by looking to prior publications by Taiwanese and Korean companies. *Claridge Moulded Fiber v Mohan Fiber Products* 2004 (2) ShimLC 432, [29-32], meanwhile, ruled for the Defendants on facts that would have invited prior publication findings in favour of the Plaintiffs under the ‘prior publication in India’ standard.

On the flip side of this divide, *Texla Metals & Plastics v Anil K. Bhasin* 2001 (21) PTC 146 (Del) [16] rejected a prior publication defence based on foreign publication under the 1911 Act that would almost certainly have succeeded under the 2000 Act.

<sup>7</sup> The Plaintiffs’ arguments in *Faber Castell v Pikpen* 2003 (27) PTC 538 (Bom) [12] supplied an excellent – and compelling – articulation of this difficulty.

<sup>8</sup> The *Wimco v Meena Match Industries* 1983 (3) PTC 373 (Del) [8], *Venus Industries v Magpie Exports* 2003 (26) PTC 312 [11], *Dart Industries v Techno Plast* 2007 (35) PTC 285 (Del) [20], and *Reckitt Benkiser India Ltd. v Wyeth* 2013 (54) PTC 90 (Del)(FB) [10], have combined to make this observation, in respect of the 1911 Act as well as the 2000 Act.

boils down to this: Can a single or isolated instance of disclosure of a design be considered prior publication?

This question has split Indian courts down the middle. Some courts have held that a single instance of disclosure does constitute prior publication;<sup>9</sup> others have held that it does not.<sup>10</sup>

To summarise: Prior publication in India is an open-ended, worldwide search, with no consensus on how much publication is sufficient to knock out a design registration. The weight of this context is profound. It means that prior publication cases turn almost entirely on the substantive prior publication inquiry. As a result, there is tremendous pressure on Indian courts to get this inquiry right.

In this essay, I contribute to Indian prior publication law with a comprehensive survey of recent precedent. In particular, I focus on the development of the prior publication inquiry by Indian courts. I narrate how, despite prior publication being a dominantly factual inquiry, the rigour it is applied with has steadily been in decline, especially in cases of design applications and cancellation of design registrations. On the other hand, the bulk of the contested growth of prior publication law has emerged from its deployment as a defence to design infringement actions. In this context, this essay highlights two key trends. One is the important role being played by industry standards as prior publications in testing the validity of design registrations. The other is the strength of prior publication defences which is

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<sup>9</sup> *Joginder Singh v Tobu Enterprises* 1989 (9) PTC 175 (Del), [10]-[11]. See also *National Trading Co v Monica Chawla* 1994 (14) PTC 233 (Del), [1], 5, relying on *Otto v Steel* (1886) 3 RPC 107, *Humpherson v Syer* (1887) 4 RPC 407, and *Harris v Rothwell* (1887) 3 RPC 383.

<sup>10</sup> *Tobu Enterprises v Joginder Metal Works* AIR 1985 Del 244, [7], *Indo Asahi Glass v Jai Mala Roller Glass* 1996 (16) PTC 220 (Del), [11]-[13], *Jg Vacuum Flask v Eagle Flask* 1996 (16) PTC 558 (Del), [8]; *Wimco* (n 8) [10], was also presented with this issue of the sufficiency of an isolated instance of publication and though it did not endorse *Tobu Enterprises'* refusal of a single commercial event as adequate prior publication, it did not explicitly depart from *Tobu Enterprises* either.

often dictated by the availability and reliability of materials sourced from the internet.

What emerges from this survey of precedent is that, despite the odd opposing viewpoints, Indian courts have an enviable range of options in determining how to do justice in prior publication claims.

I propose that the best way forward is to take a little from each of these approaches in the form of a layered inquiry. Though such an inquiry will not be entirely free from subjectivity, it should help avoid apparent errors, promote good outcomes, and ensure that the core purpose of prior publication as a ground for testing design registrations is preserved.

### **THREE FUNCTIONS, TWO QUALIFICATIONS**

Prior publication of a design serves three broad functions under Indian law.

For one, it is a condition *disqualifying* the registration of a design. If a design application sought to be registered is established as having been published prior, it cannot proceed to registration. This ground is covered by Section 4(b) of the 2000 Act. It takes a broad view of publication. The operative category is ‘disclosure to the public’, of which ‘publication in a tangible form’ is one category. Instructively, Section 4(b) of the 2000 Act references ‘disclosure in India or in any other country’.

Prior publication also functions as a *ground for cancellation* of a registration. In effect, this allows the inquiry that ought to have been carried out in the prosecution of a design application to be re-agitated following registration. Section 19(1)(b) of the 2000 Act mandates that a registration can be cancelled if the design ‘has been published in India or any other country prior to the date of registration’. Like Section 4(b), this provision, too, expands the prior publication search to ‘in India or in any other country’.

Finally, prior publication can be pressed as a *defence to design infringement*. This rendition, as I mentioned at §1, rests on Section 22(3) of the 2000 Act.

Under it, Defendants against whom design infringement is alleged can urge that the registered design being enforced against them is susceptible to cancellation on any of the grounds mentioned in Section 19. One such ground is the prior publication of the design under Section 19(1)(b).

The next thing to say is on the *qualification of publications* cited against registered designs. Whether at the stage of disqualification or cancellation or infringement, the Indian law tests publications conflicting with registered designs in two ways.

First, the publication is scrutinised from a *timing* standpoint. Under this test, a publication must cover the same territory as a registered design *and* have been created prior to the date of registration of the subject design. If this is so, the publication may anticipate the subject design. In most circumstances, the presence of a prior publication of this description will raise a *de facto* challenge to the novelty or originality of the subject design. A design can hardly claim to be new or original,<sup>11</sup> after all, if a design matching its description was in existence prior to its registration.

Second, the publication is examined from a *disclosure* standpoint. The standing test here is that any publication against which a registration is to be tested must give “a fair and complete idea of the design”.<sup>12</sup> In other words, the test calls for the prior publication to *sufficiently*, rather than *exactly*, disclose the registration at issue.<sup>13</sup>

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<sup>11</sup> Section 4(a) of the 2000 Act.

<sup>12</sup> *Domestic Appliances v Globe Super Parts* 1981 (1) PTC 239 (Del), [7]. See previously a similar prior publication litigation involving the same Defendants fourteen months prior in *Globe Super Parts v Paramount Electricals* 1987 (2) ArbLR 181 (Del).

<sup>13</sup> The examination of the prior publication, under this view, must also examine whether there is a substantial difference between the general features of the publication and the registration at issue. *Wimco* (n 8) [10], [16].

Both the timing and disclosure tests bear more than a passing resemblance to the equivalent standards under patent law.<sup>14</sup>

### DISCLOSURE VERSUS PUBLICATION

The Indian Supreme Court has examined prior publication at length only once in its history.

*Bharat Glass v Gopal Glass*<sup>15</sup> in May 2008 presented a question to fall from the internationalization of the prior publication search under the 2000 Act. Another ground for challenging a registration under the Act is similar to prior publication. It speaks to prior *registrations*. Historically, the search for prior registrations, much like prior publications, had been restricted to registrations in India.<sup>16</sup> However, where the prior publication search went global under Section 19(1)(b) of the 2000 Act, Section 19(1)(a) conspicuously kept the prior registration search restricted to registrations in India.

In *Bharat Glass*, the Supreme Court was asked whether this statutory oversight was a deliberate one. The case had come up in appeal following a Calcutta High Court decision which had ruled on the issue in some detail. The High Court had found that this oversight was, indeed, deliberate.<sup>17</sup>

The facts in *Bharat Glass* involved drawings accessed from the United Kingdom Patent Office website. These were cited as prior publications. The Petitioners' registration applied certain patterns to glass sheets. The drawings were pressed in aid of the patterns they depicted, which could be applied to glass sheets to arrive at the Petitioners' registration.<sup>18</sup>

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<sup>14</sup> Sections 25(1)(g), 25(2)(g) and 64(1)(h) of the Patents Act all accommodate the failure of a patent to sufficiently and clearly/fairly describe the invention as a ground to oppose or revoke the patent. To be clear, this is far from surprising considering the common point of origin for patent and designs law in India under the 1911 Act.

<sup>15</sup> 2008 (37) PTC 1 (SC).

<sup>16</sup> Section 51A(1)(a)(i) of the 1911 Act.

<sup>17</sup> *Gopal Glass v Assistant Controller* 2006 (33) PTC 434 (Cal), [30], 41-46.

<sup>18</sup> *ibid* [45].

*Bharat Glass* made two points of interest on prior publication.

The first was that a relevant prior publication must speak to the *precise mode or method* in which the impugned registration applies the design. On these facts, for instance, the Respondents' registration went to the application of patterns onto glass sheets. For the cited drawings to qualify as prior publications, therefore, the element of fixation was critical. A mere abstract comparison of resemblance between drawings on the one hand and applied patterns onto glass sheets on the other would not meet the requirement. Simply put, the Petitioners needed to establish that the designs disclosed by the prior published drawings were being reproduced onto glass sheets.<sup>19</sup> The Supreme Court found "no evidence whatsoever" of this.<sup>20</sup>

The other point of interest was that a design registration against which a prior publication is to be cited must be held to an exacting substantive standard. It is not good enough merely for the registration to be new or original *relative* to the prior publication. Instead, in order to survive a prior publication challenge, the registration must be new or original in the sense of being invented for the *first time* or not having been reproduced by *anyone*.<sup>21</sup>

However, one detail escaped judicial notice in *Bharat Glass*.

Under Section 4(b) of the 2000 Act, novelty or originality can be refuted if a design:

...has been disclosed to the public anywhere in India or in any other country *by* publication in tangible form or by use or in any other way

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<sup>19</sup> An important reason for this like-for-like requirement was disclosed by the Calcutta High Court. It had ruled that a pattern applied to glass sheets mechanically and the same pattern applied to glass sheets manually could have different kinds of visual appeal. Making room for this possibility would not be consistent with permitting prior publication of one of these techniques to be read over the registration bearing the other technique. *Gopal Glass*, ¶46.

<sup>20</sup> *Bharat Glass* (n 15) [8], [14].

<sup>21</sup> *ibid.*

prior to the filing date, or where applicable, the priority date of the application for registration.

Under Section 19(1)(b), though, the ground for cancellation demands that the design must have ‘...been published in India or in any other country prior to the date of registration.

Evidently, Section 4(b) refers to ‘disclosure to the public’ through one of three avenues: by publication in tangible form, by use, or in any other way. However, Section 19(1)(b) speaks of publication *only*, whether in India or abroad. Section 4(b) is therefore inarguably broader than Section 19(1)(b). It means that there is more scope to reject a design *application* for prior disclosure than there is to reject a design *registration* for prior publication.

This missing piece was supplied by *Reckitt v Wyeth* in August 2009.<sup>22</sup> The Delhi High Court here endorsed a limited divergence from *Bharat Glass*. It concluded that *prior registrations* abroad, despite being excluded under Section 19(1)(a), could be treated as *prior publications* since they did meet the broader criteria under Sections 4(b) and 19(1)(b).<sup>23</sup>

On appeal in October 2010,<sup>24</sup> a Division Bench of the Delhi High Court expanded prior publication even further. It first held, confirming the 2009 ruling, that a prior registration abroad constituted prior publication under Section 19(1)(b).<sup>25</sup> A failure to recognise this, said the Court, would open the door to entities to squat on designs in India that are evidently disclosed *via* foreign registrations.<sup>26</sup> It also supplied an alternate reason for this view. This

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<sup>22</sup> 2009 (41) PTC 24 (Del).

<sup>23</sup> *ibid* [28]-[29].

<sup>24</sup> *Reckitt v Wyeth* 2010 (44) PTC 589 (Del)(DB).

<sup>25</sup> It was “quite apparent”, said the Division Bench, that the Plaintiffs’ designs were already available in the public domain prior to registration in India; *ibid* [6, 8, 10, 12, 15].

<sup>26</sup> A case for a larger apprehension that shutting out foreign registrations would create “patent and absurd consequences” was also made out by the Division Bench. *Reckitt* (n 24) [13].

drew on Section 44 of the 2000 Act, which accords value to foreign registrations in India *via* certain reciprocal arrangements.<sup>27</sup>

To make its position stick,<sup>28</sup> the *Reckitt* Division Bench referred the Section 44 issue to a Full Bench. In March 2013, this Full Bench affirmed the Division Bench on all counts.<sup>29</sup>

An important wrinkle added by the Full Bench was to frame an understanding of ‘publication’ from the ground up. Section 4(b), of course, offered three avenues of disclosure.<sup>30</sup> Of these, the phrases mentioning disclosure in a ‘tangible form’ and ‘in any other way’ had not been scrutinised by *Bharat Glass*.<sup>31</sup> To qualify as disclosure, a design on paper must be depicted in such a way that its features are “made clear to the eye,” said the Court.<sup>32</sup> Under *Reckitt*, therefore, not just the design at issue but even the prior disclosure challenging it had to be judged in terms of its visual impact.<sup>33</sup>

It is fair to say, then, that *Reckitt* introduces an element of subjectivity into the otherwise objective question of what material can be considered prior publication.<sup>34</sup> This subjectivity, in turn, depends on the fullness of the

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<sup>27</sup> The reasoning involved a fairly elaborate and circuitous path through Section 44, and need not detain us here. *Reckitt* (n 24) [13].

<sup>28</sup> At the time, the field was held by *Dabur India Ltd. v Jain* 2009 (39) PTC 104 (Del)(DB). It had ruled the other way on classifying foreign registrations as prior publications but had not considered Section 44. *Reckitt* (n 24) [16].

<sup>29</sup> In summary, foreign registrations could not qualify as prior registrations in India under Section 19(1)(a) due to the express statutory bar but could qualify as prior publications under Section 19(1)(b). Perhaps wary of taking issue with a Supreme Court decision, the *Reckitt* Full Bench reconciled, in some detail, its view with that of *Bharat Glass*. Broadly, its reading of the Supreme Court was this: *Bharat Glass* did not set out “an absolute rule” that registration abroad *cannot* be prior publication. Instead, *Bharat Glass* cautiously examined the evidence before it for the purpose of assessing if the Designs Office records of a foreign country could be considered prior publications. *Reckitt Benckiser v Wyeth* 2013 (54) PTC 90 (Del)(FB) [3-7, 19-20].

<sup>30</sup> This focus was led by the fact that application of the design to physical articles would incontestably amount to publication. “Once there is actual use of the design,” said Mehta J, “there would surely be publication.” *Reckitt* (n 29) [10, 12(ii)].

<sup>31</sup> *Reckitt* (n 29) [14-16].

<sup>32</sup> *Reckitt* (n 29) [19(i)].

<sup>33</sup> *Reckitt* (n 29) [18(i)].

<sup>34</sup> *Reckitt* (n 29) [22(v)].

disclosure. A foreign registration, for instance, must be so depicted that it sufficiently constitutes the full expression of a design onto an article, judged visually. In line with precedent, the *Reckitt* Full Bench concluded that this subjective assessment was an evidentiary question.<sup>35</sup>

### A DECLINE OF RIGOUR

Despite their differences, *Bharat Glass* and *Reckitt* were united in an important way. Both cases endorsed robust examinations of prior publication material. This robustness has, however, flattened out in recent years. Indian courts have adopted a changed outlook when ruling on design applications submitted for approval as well as cancellation actions against design registrations. Many such rulings have simply short-circuited the rigour of prior publication analysis. They have preferred, instead, to return short, formulaic prior publication findings.<sup>36</sup>

Two decisions from 2014 marked the clear beginning of this trend.

*Britannia v Controller*<sup>37</sup> issued a cancellation on prior publication grounds. The Court thought it apparent that the registration was not novel or original, having regard to the nature and character of the article, in view of prior publications. However, instead of an explanation for this conclusion, the Court merely asserted that the registrations were merely “minor variations” of published designs.<sup>38</sup> The Court was, of course, fully authorised by *Reckitt*

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<sup>35</sup> *Reckitt* (n 29) [22(v), 23].

<sup>36</sup> A similarly decisive shift – in favour of brusque summary applications of the tests for substantive design infringement – can also be documented. See, illustratively, *Schröder v Chand & Sons* 2011 (45) PTC 157 (Del), *Veeplast Houseware v Bonjour International* 2011 (46) PTC 479 (Del), *Holland v SP Industries* 2014 (59) PTC 212 (Del), *Holland v AD Electro Stell* 2017 (70) PTC 512 (Del), *Bhatia Enterprises v Arora* 2016 (65) PTC 364 (Del), *Kent RO Systems v Aggarwal* CS (COMM) 1468/2016 (Delhi High Court, 02 November 2017), *Kent RO Systems v Yadav* CS (COMM) 1469/2016 (Delhi High Court, 19 December 2017), *Bhiwadi Polymers v Gupta* 2019 (77) PTC 290 (Del), *Symphony v Thermo King* CS (COMM) 321/2018 (Delhi High Court, 28 February 2019) and *Symphony v Life Plus Appliances* CS(COMM) 324/2018 (Delhi High Court, 28 February 2019), and *Philips v Amazestore* 2019 (78) PTC 618 (Del).

<sup>37</sup> AID No. 2/2011 (Calcutta High Court, 08 May 2014).

<sup>38</sup> *ibid* [28], relying on *Chawla & Sons v Bright Auto Industries* AIR 1981 Del 95 (DB).

to engage in a subjective assessment of the publications. Even so, it offered little more than a perfunctory opinion based on a casual eye-test. The registrations were cancelled.<sup>39</sup>

*Mahendra Perfumery Works v Assistant Controller*,<sup>40</sup> on the other hand, upheld a registration against a prior publication challenge on similarly flimsy grounds.<sup>41</sup> Notable in this case was the willingness of the Court to defer to the expert opinion of the Controller of Designs.<sup>42</sup>

In 2017, a stack of Calcutta High Court decisions consolidated these tendencies into an irrefutable trend.<sup>43</sup> In each instance, the Court entered a summary finding on cancellation actions challenged for prior publication. Also, in each instance, the Court extended blanket support to the findings entered by the Controller of Designs as the expert authority in the first instance.<sup>44</sup>

Taken together, the decisions effectively shouted down the evidence-heavy approach endorsed by the *Reckitt* Full Bench just four years prior.

### PRIOR PUBLICATION AS INFRINGEMENT DEFENCE

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<sup>39</sup> *Britannia* (n 37) [30-31, 44].

<sup>40</sup> AID No. 5/2011 (Calcutta High Court, 11 July 2014).

<sup>41</sup> See further, *Bharat Balar v Rajendra Distributors* AIR 2015 Mad 202 [10, 13], confirmed in appeal in *Bharat Balar v Rajendra Distributors* 2016 (66) PTC 28 (Mad)(DB).

<sup>42</sup> “The Controller is the competent authority in order to determine the novelty of a design,” ruled the Court. *Mahendra Perfumery Works* [45].

<sup>43</sup> *Atul Narsibhai Patel v Assistant Controller of Patents & Designs* MIPR 2017 (1) 421, ¶25, *ITC v Controller of Patents & Designs* 2017 (71) PTC 178 (Cal) [22, 66, 72], *Doval v Controller of Patents & Designs* 2017 (71) PTC 288 (Cal) [39], *TK Shawal v Controller of Patents & Designs* 2017 (71) PTC 253 (Cal) [7], and *Philco v Deputy Controller* 2017 (72) PTC 37 (Cal) [5], all between January 2017 and July 2017.

See further *Reckitt v Controller of Patents & Designs* 2017 (1) CHN 597 (Cal) [26-27], *Yash Plastomet v Assistant Controller of Patents & Designs* 2017 (1) CHN 755 (Cal) [18], *Klassic Wheels v Assistant Controller of Patents & Designs* AIR 2018 Cal 276 [27, 29], *Shree Vari Multiplast v Deputy Controller* 2018 (5) CHN 299 (Cal) [42], and *International Cycle Gears v Controller of Patents & Designs* 2019 (3) CHN 256 (Cal) [31].

*Per contra*, see *Lucky Exports v Controller of Patents & Designs* 2019 (78) PTC 448 (Cal), [40-41, 63-64].

<sup>44</sup> The trend was not unknown prior to 2017; see previously *Anchor Health & Beauty Care v Controller* AID No. 7/2008 (Calcutta High Court, 19 May 2011) [11-14].

However, by far the most popular invocation of prior publication by Indian courts in recent years has been as a defence to infringement. The majority of these have been rulings on interlocutory injunction motions. In fact, a prominent recent case has directly admitted that interlocutory injunction motions are game, set and match in intellectual property infringement cases.<sup>45</sup>

As such, it is undoubtedly significant that Indian courts have hesitated to go into the weeds of prior publications in such cases. Typically, they have done so only in clear and obvious cases. In other words, the threshold for dipping into the issue on merits is that the prior publications raise questions over the tenability of the registration serious enough to deny interlocutory relief to the Plaintiffs.<sup>46</sup> Even this weighty finding has often been reached with just a surface-level eye-test comparison between the prior publications and the registration at issue.<sup>47</sup> Only on a few occasions have prior publication cases raised against design registrations in interlocutory injunction proceedings been subject to “painstaking factual analysis”.<sup>48</sup>

On a survey of contemporary Indian case law in this field, two other principles stand out.<sup>49</sup>

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<sup>45</sup> *Shree Ganesh Besan Mill v Ganesh Grains* APO 69/2021 (Calcutta High Court Division Bench, 24 December 2021).

<sup>46</sup> *Hi-Tech Carbons v M&K Technologies* (2008) 3 MLJ 604 [20-23, 27, 29-32].

<sup>47</sup> *Dabur India Limited v Mr. Rajesh Kumar* 2008 (37) PTC 227 (Del) [8, 11].

<sup>48</sup> *Dart Industries v Techno Plast* 2016 (67) PTC 457 (Del)(DB) [24-25] affirming *Dart Industries v Techno Plast* 2007 (35) PTC 285 (Del) [26-29].

See also *Whirlpool v Videocon* 2012 (52) PTC 209 (Bom) [13], *Add Print (India) Enterprises Private Limited v Mohan Impressions Private Limited* 2013 (53) PTC 485 (Mad) [21-23], and *Steelbird Hi-Tech v Gambhir* 2014 (58) PTC 428 (Del) [14-19, 22-27].

<sup>49</sup> I exclude for the present purpose three otherwise significant design infringement decisions from this period. The first is a December 2019 Calcutta High Court Division Bench decision in *Super Smelters v SRMB Srijan Private Limited* 2020 (81) PTC 101 (Cal)(DB) [18, 38-41]. *Inter alia*, it ruled in the negative in considering whether a design registration cancelled on the ground of prior publication would impede its proprietor from claiming the substance of that design as a shape trade mark.

The second is *Cello Household Products v Modware* 2017 (70) PTC 325 (Bom) [15, 17, 28]. Here, the Defendants attempted, unsuccessfully, to reason that the fact that they had their own models of the contested design of a common article in the market was proof of prior publication.

The first is a limitation on Defendants. It states that:

Defendants asserting the novelty or originality of their own design cannot oppose the Plaintiffs' claim for infringement of an identical design on the ground that the Plaintiffs' design was published prior.

This was the sum and substance of the Delhi High Court decision in *Vega Auto v Jain Bros.*<sup>50</sup>

*Vega Auto* saw the position as such: If a party asserts the novelty or originality of its own design, then it is (and ought to be) legally inconsistent for it to separately claim that another party's design, identical to its own, is prior published. Authorising this would, in effect, involve sacrificing the Defendants' own novelty claim for the express purpose of dodging an infringement claim. As such, either the novelty claim could survive or the prior publication defence. Since novelty was affirmatively asserted by the *Vega Auto* Defendants, the prior publication defence had to go.<sup>51</sup> The finding was supported by a similar principle of prosecution history estoppel under trade mark law,<sup>52</sup> in addition to designs precedent from other High Courts.<sup>53</sup> A Division Bench of the Delhi High Court has since backed up this estoppel against raising prior publication defences, affirming *Vega Auto*.<sup>54</sup>

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Lastly, *Maya Appliances Private Limited v Butterfly Gandhimati Appliances* 2017 (70) PTC 31 (Mad), 9 Jan 2017 [75], swatted aside a prior publication defence since it was hard to accurately establish the timing of the publications *i.e.*, whether the conflicting materials had been published prior to the Applicants' registrations. The decision was overturned on appeal on different grounds in *Maya Appliances Private Limited v Preethi Kitchen Appliances* 2018 (74) PTC 209 (Mad)(DB).

<sup>50</sup> (2018) 75 PTC 59 (Del).

<sup>51</sup> *Vega Auto* (n 50) [30-33].

<sup>52</sup> *Vega Auto* (n 50) [27], relying on *Automatic Electric v R. K. Dhawan* (1999) 77 DLT 292, *Indian Hotels v Jiva Institute* 2008 (37) PTC 468 (Del)(DB), and *Procter & Gamble v Anchor Health & Beauty Care* 2014 (59) PTC 521 (Del)(DB), affirming *Anchor Health & Beauty Care v Procter & Gamble* 2014 (59) PTC 105 (Del).

<sup>53</sup> *Vega Auto* (n 50) [27-29], relying on *Asian Rubber Industries v Jasco Rubbers* 2013 (53) PTC 495 (Bom), *Kalpesh R. Jain v Mandev Tubes Private Limited* 2018 (73) PTC 591 (Bom)(DB), and *Dart Industries v Cello Plastech* MIPR 2017 (3) 158.

<sup>54</sup> *Pentel Kabushiki Kaisha v Arora Stationers* 2019 (79) PTC 42 (Del)(DB) [22, 25-32].

The second principle to find endorsement emerges from *RB Health v Dabur* in November 2020.<sup>55</sup> This was a design infringement and passing off claim. In arriving at its ruling, the Delhi High Court considered ‘whether the prior publication defence advanced by the Defendants offered a credible challenge to the Plaintiffs’ registration’. From the list of known designs, the Court zeroed in on two prior publications. Both contained the principal features of the Plaintiffs’ registration, judged from the standpoint of an instructed eye.<sup>56</sup>

The Court went further. It held the prior publications to the yardstick of being able to clearly depict, within the publication, the features of the article. If they passed this yardstick, the publications would have to be compared visually with the Plaintiffs’ registration if it were to be applied to the article.<sup>57</sup>

To be sure, the Court’s explanation was abbreviated. It only briefly dealt with how and why the two relevant prior publications covered the registration itself. Nevertheless, this discussion was deemed sufficient to support the conclusion that there was a credible challenge to the Plaintiffs’ registration.<sup>58</sup>

#### THE ROLE OF INDUSTRY STANDARDS

Another prominent trendline in prior publication litigation involves testing registrations against relatable prior publications.

In contemporary terms, the subject was first broached in a design infringement claim in January 2017. *APL Apollo Tubes v Surya Roshni*<sup>59</sup> attempted to tie together two partly opposing influences: a *Reckitt*-style attention to detail, and the economy demanded by interlocutory injunction adjudication.

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<sup>55</sup> 2020 (84) PTC 492 (Del).

<sup>56</sup> The cited publications lent “significant heft” to the Defendants’ case that the Plaintiffs’ registration had not been validly registered, ruled the Court. *ibid* [11].

<sup>57</sup> The legal tests adopted here were derived from the Full Bench decision in *Reckitt. RB Health* (n 55) [12].

<sup>58</sup> *RB Health* (n 55) [13].

<sup>59</sup> 2017 (72) PTC 229 (Del).

The results were interesting. *APL Apollo* expanded its search for prior art beyond the summary exertions of the Calcutta High Court in the 2017 cancellation cases. However, it still fell some way short of a detailed evidentiary examination. In effect, it conducted a search for *relatable prior art*. Through this approach, the Court identified a set of relevant designs, as well as some industry specifications and standards. These searches revealed some prior published products similar to those protected by the Plaintiffs' registration. The prior publication defence was upheld.<sup>60</sup>

*APL Apollo*, thus, added a substantive twist. The Plaintiffs' failure to show that their registration did not raise its head above the water of industry standards, so to speak, would dent the credibility of the registration itself. This opened up a path to deny the Plaintiffs' interlocutory relief.

*Kamdhenu v Aashiana Rolling Mills*<sup>61</sup> examined similar facts. Here, the Delhi High Court heard the argument that the impugned design, for ribbed steel bars, was functional in nature. This compromised the Plaintiffs' registration for two reasons. The first was that it activated the functionality prohibition under the Designs Act.<sup>62</sup> More importantly, though, the functional elements meant that it was no different from prior published surface patterns on other equivalent steel bars.<sup>63</sup>

The Defendants sought to entrench this claim. They did so by contending that the Plaintiffs' registration was an iteration of a set of specifications that were drawn from prior published industry standards. On its face, this claim was a strong one. Nevertheless, the Court ruled for the Plaintiffs. It noted that the Defendants had "not placed on record any credible material at this stage" to

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<sup>60</sup> *APL Apollo* (n 59) [59-61].

<sup>61</sup> 2018 (73) PTC 96 (Del).

<sup>62</sup> Sections 2(d) and 19(1)(d) of the 2000 Act.

<sup>63</sup> *Kamdhenu* (n 61) [5].

conclude if the Plaintiffs' registration had been copied from the industry standard.<sup>64</sup> In the event, this was not a 'no'; it was, instead, a 'not yet'.

The appeal, *Aashiana Rolling Mills v Kamdhenu*,<sup>65</sup> was decided in August 2018. In it, the Defendants reprised their claim that the Plaintiffs' registration reproduced a prior published industry standard.<sup>66</sup>

The Defendants prevailed before the Division Bench. They did so principally on the Division Bench's conviction that the Plaintiffs' registration fell in line with the quoted industry standards. These were so detailed that they permitted the manufacturer "a limited range of possibilities for the ribbing of the bars."<sup>67</sup> To this, the Court added its *prima facie* observation that the Plaintiffs' steel bars lacked any distinct feature worthy of a design registration.<sup>68</sup>

The facts strongly dictated this conclusion. The framing of the Court's finding, however, was on sketchier ground. The Court had effectively found that the industry standards applicable to this product were so precise that the manufacturer had little option but to adopt a design likely incapable of registration. Taken at its fullest, this finding appeared to shut out *an entire category of products* from design protection rather than just the Plaintiffs' version.

Another go-around between the same litigants soon followed in *Kamdhenu v Aashiana Rolling Mills*.<sup>69</sup> The Delhi High Court once again found for the Defendants. It did so on the suggestion that the Plaintiffs' products were covered by prior published industry standards. The Plaintiffs attempted both to discredit the industry standards as relevant prior art, and to distinguish their products from these standards. However, the Court took the view that the

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<sup>64</sup> *Kamdhenu* (n 61) [5].

<sup>65</sup> 2018 (76) PTC 81 (Del)(DB).

<sup>66</sup> *ibid* [9].

<sup>67</sup> *Kamdhenu* (n 65) [20].

<sup>68</sup> *ibid*.

<sup>69</sup> 2021 (86) PTC 501 (Del).

standards themselves disclosed the same surface pattern scheme – transverse and longitudinal ribs at an angle to each other – that the Plaintiffs had claimed. The standards thus offered “a detailed enumeration of the elements of the design.”<sup>70</sup>

Critically, the Plaintiffs asserted that the novelty of their design lay in the *pattern itself* rather than *the angles of its presentation*. This prompted the conclusion that the Plaintiffs’ registration could not be clearly distinguished as novel as against the industry standards.<sup>71</sup> Finding no merit in the case absent the credibility of the registration, the Court issued summary judgment against the Plaintiffs.<sup>72</sup>

The value of clearing the prior publication bar set by industry standards was thus made clear. The *Kamdhenu* cases highlighted that the consequences of failure can be quite drastic.

#### A RIDE ON THE WAYBACK MACHINE

Scrutiny based on industry standards is one of two significant recent trends in Indian prior publication law. The other is of prior publication materials drawn from the internet.

The internet has been a gamechanger in finding prior publication ammunition against design registrations. Though the controversy over internet-based materials in this domain is relatively recent, the role of the internet in this field has been acknowledged for a long time.

This is what the Bombay High Court had to say on the subject as early as August 2005:

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<sup>70</sup> The Court ruled itself “satisfied that an instructed reader of the Standards would have been able to imagine the design without recourse to his/her own originality.” *ibid* [58, 60].

<sup>71</sup> *Kamdhenu* (n 69) [58-59].

<sup>72</sup> *Kamdhenu* (n 69) [69, 71], invoking powers under Order XIII-A of the Code of Civil Procedure.

The information may [only] be available on the internet, but when the same contains statements about parties [apart from the Plaintiffs] using such designs from 1984-85, it cannot be brushed aside straight away. The truth and veracity of such statements, in addition to the assertions on affidavit, will have to be decided at trial...[However] there is ample material produced by the Defendants to *prima facie* negative the pleas of the Plaintiffs.<sup>73</sup>

Observations such as this were instrumental in sending out a constructive and balanced early message on the issue. For one, there was no taboo on internet-based materials. They would be considered *prima facie* credible, and would not simply be dismissed out of hand. Conversely, the door was always open for their reliability to be held up to evidentiary standards where warranted.

Much water has, of course, flown under the bridge since 2005. Recent case law controversy in this area, however, has called back to these very principles.

A good starting point is *Crocs v Liberty Shoes*.<sup>74</sup> Here, the Delhi High Court was tasked with examining published material on the internet going back to a time prior to the Plaintiffs' professed first use of their design for footwear. The prior publications appeared to *prima facie* establish that a design similar to that of the Plaintiffs, minus a strap on the back of the footwear, was in existence in the public domain. This group of publications was sourced from the Internet Archive's Wayback Machine tool.

The Defendants produced two printouts from third party webpages from December 2002 and February 2003. Both pre-dated the Plaintiffs' own first claimed use, legally dating back to May 2003. The Defendants also produced five further printouts from the Plaintiffs' own website, forming a tight cluster around a four-week period in October-November 2002.<sup>75</sup> Evidently, all of

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<sup>73</sup> *Taparia Tools v Ambica Overseas* 2005 (31) PTC 257 (Bom) [21].

<sup>74</sup> 2018 (73) PTC 425 (Del).

<sup>75</sup> *ibid* [16-17].

these prior publications were formally relatable *and* prior to the Plaintiffs' date of priority.<sup>76</sup>

The Plaintiffs were unable to refute these claimed instances of prior publication adequately. They also did not explain away the appearance of the designs on their own website in October-November 2002. As a result, the court of first instance duly ruled for the Defendants.<sup>77</sup>

The case was taken up in appeal in *Crocs v Bata*.<sup>78</sup> A Division Bench of the Delhi High Court confirmed the reading of the publications by the court of first instance. Applying the *Reckitt* approach, the Plaintiffs argued that the depictions uploaded to the internet in the 2002-2003 period did not pertain to their registered designs and, even if they did, were incomplete. They also stapled onto these materials doubts about their reliability. In the main, they contended that the archive dates displayed by the Wayback Machine tool gave off a misleading impression. According to the Plaintiffs, they spoke to the HTML files of the relevant webpages only. They did not necessarily correspond to the image files linked on these respective webpages.<sup>79</sup>

The Division Bench brushed aside the reliability concerns. The electronic materials from the Wayback Machine tool were supported by the documentation necessary under the Evidence Act. For an assessment of *prima facie* merits, this was good enough.<sup>80</sup> The Division Bench concluded:

The Court cannot carry out a mini-trial; it has to consider the broad probabilities of the rival claims, having regard to the available pleadings and the documents. Whether the [argument that the

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<sup>76</sup> *ibid* [11-17].

<sup>77</sup> *ibid* [28-29].

<sup>78</sup> 2019 (78) PTC 1 (Del)(DB).

<sup>79</sup> *ibid* [18].

<sup>80</sup> *ibid* [32].

Wayback Machine material might not be true or be unreliable] are to be considered during the trial.<sup>81</sup>

The merits of the case were also turned back. The Plaintiffs had contended, in sum, that the Wayback Machine materials were not proof that the product existed at the time. However, if this was so, asked the Division Bench, then the Plaintiffs ought to have had no difficulty in producing the archives of those websites from those dates too. This material could establish that there was no similarity. The Plaintiffs, however, were unable to do so. Their appeal was dismissed.<sup>82</sup>

Close on these heels, *Kent RO Systems v Kishnani*,<sup>83</sup> initiated a design infringement claim in February 2019. In these proceedings, in October 2020, the Defendants brought a curious interlocutory motion. In it, they claimed that they did not know of the Wayback Machine until *Crocs* appeal in January 2019. However, having seen the Division Bench rely on prior publication evidence sourced from that website, they jumped on the website too. Their efforts had yielded “various webpages” carrying advertisements of products comparable to that of the Plaintiff, but prior to the Plaintiff’s registration.<sup>84</sup> These documents, they claimed, were prior publications *de facto*. Their motion was for placing these documents before the Court *after* the Plaintiff had filed its evidence,<sup>85</sup> some twenty months after the proceedings had opened. The Court shut down this blatant attempt to ride the coattails of *Crocs*.<sup>86</sup>

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<sup>81</sup> *ibid*.

<sup>82</sup> The finding against the Plaintiffs by the court of first instance, said the Division Bench, “was arrived at after a careful though *prima facie* analysis of the materials on record.” *ibid* [36-37, 40].

<sup>83</sup> 2021 (222) AIC 458 (Del),

<sup>84</sup> *ibid* [5].

<sup>85</sup> *ibid* [6, 14].

<sup>86</sup> *ibid* [17].

High Courts at Delhi,<sup>87</sup> Bombay,<sup>88</sup> and Kerala<sup>89</sup> all returned prior publication findings soon after *Crocs*. Though they took different approaches, they were all broadly in line with *Crocs*. However, three decisions, delivered within a few days of each other in October 2021, appear to have now swung the balance back the other way.

### THE OCTOBER EFFECT

In October 2021, *Relaxo Footwear v. Aqualite Industries*<sup>90</sup> revisited a prior publication defence in a claim over design rights in footwear. The Defendants urged two instances of prior publication of rival products to resist an interlocutory injunction for design infringement.<sup>91</sup> However, the defence was rejected. The publications, found the Court, contained no details as to the date of publication or launch of the footwear they disclosed. These materials were not *prima facie* convincing, and would have to be examined at trial.<sup>92</sup>

Four days after *Relaxo*, the Delhi High Court issued judgement in *EN Project & Engineering v KVT Electrical*<sup>93</sup> on a design infringement claim over cable trays. It asked the Court to consider a prior publication defence supported by extensive internet materials. The Defendants cited industry standards, Wayback Machine webpages to show the publication of these industry standards, and pages from a rival proprietor's website.<sup>94</sup> Despite the range of these materials, the Court ruled against the Defendants.

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<sup>87</sup> *Symphony Limited v Thermo King India Private Limited* CS (COMM) 321/2018 (Delhi High Court, 28 February 2019), *Symphony Limited v Life Plus Appliances* CS(COMM) 324/2018 (Delhi High Court, 28 February 2019), and *Nishi Gupta v Cattle Remedies* 2021 (87) PTC 100 (Del).

<sup>88</sup> *Frito-Lay North-America Inc. v Balaji Wafers Private Limited* AIR 2020 Bom 304.

<sup>89</sup> *Frontline Polymers Private Limited v Aloysious* AIR 2019 Ker 156.

<sup>90</sup> 2021 (88) PTC 161 (Del).

<sup>91</sup> *ibid* [10(iii), (iv), 13, 26].

<sup>92</sup> *ibid* [27, 31].

<sup>93</sup> 2021 (88) PTC 387 (Del).

<sup>94</sup> The Defendants also claimed that instructional videos directing viewers on how to install the product were available on YouTube, pre-dating the Plaintiff's registration. *ibid* [13].

It first set aside the industry standards. It did so on the basis that they admitted of several possible variations in the design of the product and carried a disclaimer to this effect. As such, these were generic installation guidelines.<sup>95</sup> They were not rigid, *Kamdhenu*-style standards which restricted the scope of the finished product.

Next, the Court discarded reliance on the material from the rival proprietor's website. This proprietor and the Plaintiffs did not share "commonality of design", said the Court.<sup>96</sup> The rival design also did not reproduce the specific configuration pattern which the Plaintiffs claimed was unique to their own design.<sup>97</sup>

Finally, to discredit the Wayback Machine webpages, the Court cited a 2013 affidavit brought to its attention by the Plaintiffs. The affidavit was from the manager of the Internet Archive – the creator of the Wayback Machine tool – in a proceeding before the United States Patent Office. This spoke to the fact that the images to appear on catalogued versions of webpages "may not have been archived on the same date" assigned by the Wayback Machine tool to its corresponding HTML file.<sup>98</sup> The Court accepted this statement as indicative of unreliability, with no further comment.<sup>99</sup> With the aid of an expert opinion, the Court ultimately ruled for the Plaintiffs.<sup>100</sup>

Later in October 2021, a prior publication defence was front and centre before the Gujarat High Court in *Kapoor v Raj Cooling System*.<sup>101</sup>

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<sup>95</sup> *ibid* [15].

<sup>96</sup> *ibid* [16].

<sup>97</sup> A physical sample of this rival product was also furnished by the Defendants. Without supporting documentation establishing it as a close enough replica of the Plaintiffs' product, this, too, did not meet the threshold for a prior publication. *ibid* [16, 20-21].

<sup>98</sup> *ibid* [17].

<sup>99</sup> The YouTube videos were also discarded from the prior publication inquiry because neither the details of the designs nor their date of publication were discernible in any of the videos. *ibid* [17-18].

<sup>100</sup> *ibid* [26].

<sup>101</sup> CS 2/2021 (Gujarat High Court, 29 October 2021). The rest of §8 reproduces an edited extract of the December 2021 review of this decision first published as Eashan Ghosh,

The claim here was for design infringement over grills used in air coolers. On the strength of a series of designs registered in 2019, the Plaintiffs secured interlocutory injunction orders, *ex parte* against the Defendants, in May 2021.<sup>102</sup>

The case for infringement appeared to be open and shut.<sup>103</sup> As a result, there was inordinate focus on prior publication, canvassed by the Defendants as their *only* substantive defence. In aid of this defence, the Defendants asserted some screenshots taken from the Amazon and Facebook pages of the Plaintiffs. Through these documents, an attempt was made to contend that the Plaintiffs themselves opened the door on prior publication by exposing the grill design that they later sought to register.<sup>104</sup>

*Prima facie*, the screenshots appeared to provide visual (and not just written) evidence of prior publication, emanating from the Plaintiffs themselves. The Plaintiffs' rebuttal went simply to the admissibility of the screenshots.<sup>105</sup> Controversially, the Court sided with the Plaintiffs. It concluded that the screenshots:

Cannot be said to be **cogent evidence** so as to come to the *prima facie* conclusion that the registered design of the Plaintiff has [been prior published]... such material is required to be proved by the Defendant by **leading evidence**.<sup>106</sup> (emphasis mine).

Evidently, this was not a rejection based on an absence of material supporting prior publication. It was, instead, a rejection of that material for its failure to

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<sup>102</sup> “Kapoor v. Raj Cooling: Are Screenshots ‘Cogent Evidence’ of Prior Publication?”, <https://medium.com/@EashanGhosh/kapoor-v-raj-cooling-are-screenshots-cogent-evidence-of-prior-publication-46ff5127998a> (last visited 25 January 2022).

<sup>103</sup> *ibid* [4-15].

<sup>104</sup> “It is clear to the eye,” observed the Court, “that [the Defendant’s design] is essentially the same as the registered design in almost all respects.” *ibid* [21-30, 66].

<sup>105</sup> *ibid* [68-69].

<sup>106</sup> *ibid* [70].

<sup>107</sup> *ibid*.

meet the rules of evidence. Though this was never stated, presumably, the concern was that the screenshots were internet-based materials, and were therefore at risk of being falsified. However, to recall the *Crocs* appeal, the screenshots here were no different from other types of electronic materials routinely admitted into evidence in interlocutory injunction proceedings.

There was also the puzzling framing of the screenshots as not being *cogent evidence*. This seemed to indicate a *logical gap* – a gap of *cogency* – between the screenshots and the legal standards for prior publication, rather than an admissibility problem. However, if so, the Court failed to explain what this logical gap might be.

Overall, then, *Kapoor* comes across as a deeply unsatisfactory rejection of the prior publication defence before it.

### CONCLUSION

Despite occasional conflicts, Indian prior publication law today is remarkable for the sheer variety of options it offers to courts. Even the modest slice of contemporary case law considered in this essay – which, in turn, forms a small fraction of the body of judicial work under the 2000 Act – demonstrates this in spades.

The *Reckitt* cases, for instance, highlight the value of an evidence-heavy, forensic-style examination of prior publication citations. Meanwhile, *APL Apollo*, *Kamdhenu*, and *Crocs* suggest an inquiry less heavy on detail but more focused on relatability. At the opposite end of the scale, the 2017 Calcutta High Court cases show that prior publication claims can be disposed of by formula. *Relaxo*, *EN Project*, and *Kapoor* have adopted a similarly brisk approach in opting to leave more complex facts to be fully considered at trial.

Moving forward, the objective for Indian law ought to be to ensure that this expansion of options does not beget choice paralysis. Fortunately, the survey

of case law in this essay helps us along here. Relying on it, I now proceed to sketch out the core of a layered, all-purpose prior publication inquiry.

First, *Bharat Glass* and *Reckitt* make clear that the sweep of prior publication must be understood broadly and inclusively. A list of potentially conflicting citations must, at a pinch, err on the side of being a longlist rather than a shortlist. *Reckitt* goes further still. It explains the *method* of selection and scrutiny for prior publications. These publications must be assessed for the fullness of their disclosure of the design. The determining factor must be whether the design disclosed passes the eye-test when set against the registration.

So far, evidently, the inquiry is on safe ground.

To this foundation, a smattering of other cases offer instructions on additional elements of framing the search for prior publications. It is critical to ascertain when a publication was made public. This helps establish whether the publication was, in fact, prior. Similarly, the search must be qualified under Section 4(b) or Section 19(1)(b). This is necessary to assess whether the priority asserted is over a disclosure or a publication. Even the recently formulated bar on Defendants asserting the twice-told case of a prior publication defence as well as the novelty of their own design is a useful framing tool. Each of these elements performs a gatekeeping function. They allow a potential publication (or a set of publications) to be rejected from or admitted into the prior publication inquiry.

This brings us to the recent prior publication controversies addressed in this essay.

The industry standards controversy may be framed as such: Does the registration at issue elevate itself, through a showing of novelty or originality, above specifications or configurations disclosed by industry standards applicable to the article to which the design relates? Naturally, this is a heavily

fact-specific inquiry. However, it is instructive that the law from *APL Apollo* to *Kamdhenu* to *RB Health* is consistent that the bar to be cleared is a high one.

The issue regarding the reliability of internet materials is harder to frame with certainty. Even so, it should be clear that such materials can be considered if they meet the appropriate rules and procedures relating to electronic evidence. It should also be uncontroversial, though *EN Project* and *Kapoor* demonstrate it is not, that these materials can be relied on to form a *prima facie* impression of the merits in interlocutory proceedings.

Ideally, these principles should to form the core of the prior publication inquiry under Indian designs law.

However, when taken together, these principles perform yet another function. They feed the big picture question in prior publication law, which comes to us *via RB Health*: Do the prior publications raise a credible challenge to the validity of the registration?

In answering this question, it might be wise to avoid too dogmatic a position. This is because any assessment of a credible challenge is bound to be subjective. We can assert, with some confidence, that so long as the prior publication determination is conducted according to the layers of the inquiry above, any outcome generated will at least be reasonably supported by the facts. Equally, it is imperative to recognise that tests such as prior publication must not be *too* prescriptive. Prior publication is, by its architecture, intended to fit into the larger statutory machine of design scrutiny. As such, it must be repeatable, predictable, and easy to apply. The layered approach endorsed here may only be as strong as its weakest link, but it is certainly capable of fulfilling at least these functions.

There is one final reason why the prior publication inquiry I have detailed here cannot always prevail. It has its roots in a deep irony embedded in

designs law in general. The very nature of the subject forces legal language, with all its limitations, to engage subjective faculties in reading visual appeal and aesthetics. In these unfamiliar environs, there can be a counter-tendency to zealously bolt to the floor of objectivity everything not already coloured by that subjectivity. The prior publication inquiry, with its various moving parts, is a prime candidate for this tendency. There is something to be said, then, for trying to reign in this tendency. This is not least because, as I have demonstrated in this essay, prior publication law in India is stubbornly resistant to objective influences.

Ultimately, the survival of a semblance of the inherent subjectivity of designs law, even in a relatively objective domain such as the prior publication inquiry, is inevitable. Surely it is no great hardship to accommodate this subjectivity while still endeavouring to generate robust and reliable prior publication outcomes.

**AN INKY ENIGMA: THE CHALLENGES ASSOCIATED  
WITH COPYRIGHT PROTECTION FOR TATTOOS**

*Advika Muralidharan\**

*Abstract*

*Copyright law, being a substantially well codified piece of legislation, is yet to address certain ambiguities. One of the most perplexing subjects is the scope of protection for tattoos and other forms of body art. The art of tattooing has come a long way from its tribal origins, and is now a large-scale commercial industry valued at a hefty three billion USD per year. Tattoo artists, however, have long been distanced from the protective shroud of Copyright law, and are reluctant to enforce their rights. There is a pressing need for clarity in order to provide relief to the industry, and to reaffirm the public goals of copyright law.*

*There has been a dearth of cases regarding copyright protection of permanent tattoos. In fact, the copyrightability of tattoos itself has been the subject of many contemporary debates. Firstly, this article examines whether tattoos meet the thresholds of copyright protection, and analyses Dr. David Nimmer's controversial deposition in the case of *S. Victor Whitmill v. Warner Bros. Entertainment*. The article then delves into the ambiguities surrounding IP protection for tattoos and the negative impact it has had on the tattoo, sport, and entertainment industries. The division of rights between artist and client is probed into, along with an analysis of a 2009 Belgian case.*

*The article argues that tattoo artists are entitled to a set of reasonable economic and moral rights. An interesting example of a Japanese tattoo museum, and its consequence on Artist's rights is discussed. This article also evaluates a puzzling response given by the Indian Copyright Office in*

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\* Penultimate year law student at SASTRA University, Thanjavur.

*response to a query regarding the copyrightability of tattoos in 2020. The consequences of multiple cases of tattoo infringement are discussed, including the recent US case of Solid Oak Sketches, LLC v. 2K Games. The other forms of IP protection for tattoos are also discussed, in an effort to broaden the scope beyond just copyright law. Finally, a comprehensive study is done on the challenges surrounding implementation of IP protection, without isolating it from the actual norms and practices of the tattoo industry.*

## INTRODUCTION

The art of tattooing is not foreign to the Indian landscape.<sup>1</sup> For centuries, tribal people revered the practice; North-Eastern tribes frequently tattooed their young women, perhaps to make them unappealing to invaders. In South India, nomadic tribes wandered through villages offering ‘*pachakutharathu*’, a form of permanent tattooing. Tribes in Central India also used tattoos as a way to prove their warrior status, and as a testament to their valor.<sup>2</sup>

The art of permanent tattooing has come a long way from the ancient cultural practice it was, and is now a large-scale commercialized industry, with scores of tattoo parlors, websites, magazines, and even museums dedicated to the practice and history of the art. This growth has been steady in spite of the negative connotations associated with the practice.<sup>3</sup> Although society is slowly but surely growing to embrace it, the same cannot be said for the legal

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<sup>1</sup> Sanchari Pal, ‘Skin Deep: The Tale of India’s Tattoo Tradition’ (The Better India, 14 June 2016) <<https://www.thebetterindia.com/58170/india-tattoo-tradition-history/>> accessed 22nd September 2021.

<sup>2</sup> *ibid.*

<sup>3</sup> A. R. Timming & D. I. Perrett, ‘An Experimental Study of the Effects of Tattoo Genre on Perceived Trustworthiness: Not All Tattoos Are Created Equal’ , (2017), 7:2, 115128, Journal of Trust Research, 7:2, 115128, DOI: <10.1080/21515581.2017.1289847 > accessed 22nd September 2021;. See also Savannah Ramion, ‘Tattoos: The Road to Acceptance in Western Society’ (Honors thesis, Indiana State University, 2012).

community, which has been silent regarding the scope of protection for the art form.<sup>4</sup>

Individual tattoo studios, often being small scale businesses, generally do not possess the resources to track down infringing works. Certainly, society's attitude and marginalization of the practice does not help. With the lack of concrete protection, it comes as no surprise that these artists are unwilling to pursue litigation to enforce their rights.

India, to date, has not had a single case of tattoo infringement. To glean some semblance of clarity, we look towards the USA, which has had a handful of cases regarding the protectability of tattoos. Even then, no concrete decisions exist that delve into the division of rights between the artist and the client. In fact, there have been debates regarding the copyrightability of tattoos itself. Tattoo artists have distanced themselves from the shroud of IPR protection, as evidenced by their reluctance to approach the Court to enforce their rights.<sup>5</sup> This has had a negative impact on several industries: tattoos, sports, entertainment, and media, with artists struggling to regain control of their works.

### **COPYRIGHTABILITY OF TATTOOS: ORIGINALITY & FIXATION**

In order to ascertain the copyrightability of tattoos, it is important to discuss whether they meet the requirements of (a) originality and (b) fixation mandated by most copyright statutes.<sup>6</sup> It is also critical to examine the determination of authorship.

#### **I. Originality**

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<sup>4</sup> Yolanda King, 'The Challenges 'Facing' Copyright Protection for Tattoos' (2013) Vol. 92 Oregon Law Review <<https://ssrn.com/abstract=2802292?>> accessed 22nd September 2021.

<sup>5</sup> Aaron K Perzanowski, 'Tattoos & IP Norms' (2013) 47 Faculty Publications <[https://scholarlycommons.law.case.edu/faculty\\_publications/47](https://scholarlycommons.law.case.edu/faculty_publications/47)> accessed 22nd Sept 2021.

<sup>6</sup> Indian Copyright Act 1957, s 13(1)(a); 17 U.S.Code § 101.

Not all tattoos are protected by copyright. According to the Copyright Act, 1957, copyright subsists in original artistic works.<sup>7</sup> The Indian Supreme Court discarded the English Sweat of the Brow doctrine in favor of the more discerning ‘Minimum Modicum of Creativity’ approach.<sup>8</sup> In the US, a work can only claim valid copyright if it is an independent creation, and contains the minimal degree of creativity outlined in the Feist standard.<sup>9</sup> Therefore, originality implies the existence of (a) independent creation, and (b) a minimal degree of creativity.

So, in all likelihood, an unoriginal and common tattoo probably would not get copyright protection, but if it were to include some unique stylistic elements, it could satisfy the originality requirement and become protectable. The standard of creativity required is not a very demanding one. Lack of novelty by itself is not fatal, but could possibly undermine the tattoo artists’ claim to the originality requirement. Most tattoo studios possess a set of generic designs called ‘tattoo flash’. They are designs that are meant to act as stencils for walk-in customers. Unlike customized tattoos, tattoo flash can be sold and transferred between parties. They are generally regarded to be a subset of industrial design.<sup>10</sup> It is in the case of customized tattoos that disputes of originality and authorship arise.

In the US, many claims could also be tempered by the *Scenes a Faire* doctrine, which excludes certain works from the protection of copyright law as they are ‘typical of a genre’. As per *Nimmer on Copyright*,<sup>11</sup> certain ideas that follow from a common theme can be immunized from liability. Just as you cannot copyright a *femme fatale* character in a spy thriller, a tattoo of say,

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<sup>7</sup> Indian Copyright Act 1957, s 2(c) and s 13.

<sup>8</sup> *D.B. Modak & Another v. Eastern Book Company & Others* [2014] (2014) 7 SCC 662

<sup>9</sup> *Feist Publications, Inc. v. Rural Telephone Services*, [1991] 499 US 340, 345.

<sup>10</sup> John Heskett, *Industrial Design* (Thames & Hudson 1980) 10–11.

<sup>11</sup> Nimmer, Melville B. *Nimmer on Copyright: A Treatise on the Law of Literary, Musical and Artistic Property, and the Protection of Ideas*. (M Bender 1978)

a snake cannot be copyrighted as such unless it incorporates unique stylistic elements.

## II. Authorship

It must be noted that it is rare for a tattoo to be solely the work of the artist himself- tattoos are an incredibly personal thing, and clients sometimes play an important role in the design as well. This complicates matters. Depending on the contract, it could either qualify as a work of joint authorship (collaboration),<sup>12</sup> or a work for hire (commission).<sup>13</sup>

In Indian law, in order to qualify for joint authorship<sup>14</sup> two or more authors must collaborate to create a work where the contribution of one author cannot be distinct from the contribution of the other author. Similarly, under 17 U.S. Code § 101, two or more authors must make copyrightable contributions to a work, and intend that it be merged into a unitary whole, for it to qualify for joint authorship.<sup>15</sup> In both cases, this would involve an equal sharing of rights, and the artist and the client would be considered to be co-authors.

On the other hand, tattoo artists are not employees who created the work in the scope of their employment; at least, as per American law. In *Community for Creative Non-Violence v. Reid*,<sup>16</sup> a multi-factor test was applied for the determination of whether the hired party was an employee. On application of this test in the context of tattoos, the following is apparent: tattoo artists are skilled, procure their own materials and tools, operate in their own studios, and the connection between the parties usually lasts only one day. While it is true that the person receiving a tattoo exercises a certain level of discretion over the design made by the tattoo artist, the hiring party, i.e. the

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<sup>12</sup> 17 U.S. Code § 201 (a); Indian Copyright Act 1957, s 2 (z).

<sup>13</sup> 17 U.S. Code § 201 (b); Indian Copyright Act 1957, s 17.

<sup>14</sup> Indian Copyright Act 1957, s 2(z).

<sup>15</sup> Thomson v. Larson, [1998] 147 F.3d 195 (2d Cir. 1998).

<sup>16</sup> Community for Creative Non-Violence v. Reid, [1989] 490 US 730 (1989).

client, is not in the tattooing business. Hence, it cannot be resolutely said that tattoo artists fit into the criteria of an employee.<sup>17</sup>

Tattoos are not amongst the 9 categories of work for hire outlined in the American statute.<sup>18</sup> If there is no written agreement that specifies the tattoo to be a work for hire, and it doesn't fit into the categories, it cannot be considered to be a work-for-hire, and ownership is vested in the original author. These kinds of contracts are almost unheard of in the tattoo industry that operates based on norms and informal agreements. Therefore, it is of no surprise that cases of tattoo infringement are very rare. Interestingly, New Zealand manages to avoid most copyright disputes involving tattoos. This is because their copyright laws have an underlying presumption that in the absence of a contract to the contrary, the person who pays or commissions a work owns the copyright.<sup>19</sup>

### III. Fixation:

At first glance, tattoos come under the subject matter of copyrightable work under various copyright statutes: the Indian Copyright Act 1957,<sup>20</sup> and 17 USC § 102.<sup>21</sup> According to the latter, copyright protection subsists in original works of authorship fixed in a 'tangible medium of expression'. Tattoos, being inked engravings on human skin fulfil this criterion and come under category (5) i.e., pictorial, graphical, and sculptural works. The piece of art, or the tattoo design is fixed in a stable, tangible medium that allows itself to be perceived for a period of time that is longer than a transitory duration.

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<sup>17</sup> AD Chronis, 'The Inky Ambiguity of Tattoo Copyrights: Addressing the Silence of US Copyright Law on Tattooed Works' (2019) 104(3) Iowa L. Rev. <<https://ilr.law.uiowa.edu/print/volume-104-issue-3/the-inky-ambiguity-of-tattoo-copyrights-addressing-the-silence-of-u-s-copyright-law-on-tattooed-works/>>.

<sup>18</sup> 17 US Code § 101.

<sup>19</sup> Copyright Act 1994 (NZ), s 21.

<sup>20</sup> Copyright Act 1957, s 13(1) and s 2(c).

<sup>21</sup> 17 US Code § 102.

Tattoos, being permanent body modifications, are made to last forever. Thus, it appears that they fulfil the fixation requirement with no issues.

David Nimmer, renowned expert on US Copyright law, disagreed in the infamous case of *S. Victor Whitmill, v. Warner Bros. Entertainment, Inc.*<sup>22</sup> Here, Studio Warner Bros. was being sued for copyright infringement of former heavyweight champion Mike Tyson's tribal face tattoo, having emblazoned a strikingly similar one on actor Ed Helms' face without taking permission from the original artist. The plaintiff tattoo artist had not sketched his original design on any medium previously, and the first instance was Mr. Tyson's face. As such, the issue laid out before the Court was whether an original work of authorship could claim copyright protection, when it has been fixed on human flesh. Nimmer, appearing for the Defendants as an expert witness, reconsidered his long-standing view that tattoos were, in fact, copyrightable, and surprisingly declared that an 'augmentation of the body' cannot be subject to copyright protection. Nimmer mentioned that he 'used to' think tattoos were copyrightable, and had asserted the same in a footnote of his oft-quoted treatise. His sudden change of mind, according to him, could be attributed primarily to two factors:

- (1) Firstly, he delved into the moral rights assured by statutes, and pointed out the conflicts it would pose with respect to bodily autonomy. According to him, if copyright protection was provided to body art, it would render it an "instrument to impose, almost literally, a badge of involuntary servitude, akin to the mark with which ranchers brand the cattle they own".<sup>23</sup> Tattoo artists could exercise their rights to modify, destruct, or even prevent public display, posing a serious concern to the

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<sup>22</sup> *S. Victor Whitmill, v. Warner Bros. Entertainment, Inc* [2011] WL 2038147 (E.D. Mo. Apr. 28, 2011), *dismissed*. See also *Declaration of David Nimmer*, <[https://www.wired.com/images\\_blogs/threatlevel/2011/05/nimmerdec.pdf](https://www.wired.com/images_blogs/threatlevel/2011/05/nimmerdec.pdf) > accessed 22 Sept 2021.

<sup>23</sup> *Ibid* [20], [26] - [41].

bearer's free will. Indeed, this contentious submission seems to have some support from scholars, who concur that human flesh cannot, by any means, purport to serve as a viable medium of expression due to the disastrous consequences of the same.<sup>24</sup> Permanent body modifications such as tattoos cannot be modified or destroyed without undergoing a surgical process. Would this modification/removal amount to an implication on the artist's moral rights? How could one balance the artists continuing rights over his creation and the rights of bodily autonomy?

(2) Secondly, Nimmer then went on to claim that Mr. Tyson's head, serving a minor purpose as the medium of artistic expression, also served a much larger utilitarian function, rendering it a useful article.<sup>25</sup> The useful article doctrine serves to exclude objects that have an intrinsic utilitarian use, that is separate from its aesthetic or informative value, from the ambit of copyright protection. Indeed, he was right in pointing out that Mr. Tyson's head served a useful and functional purpose, and not just a medium whose sole purpose was to hold and display the creative work. The minor aesthetic purpose it serves is largely offset by the much larger purpose i.e., brain function and thought process.

He claimed that the only "legally cognizable" test that could be applied here was the test of physical separability, in order to avoid the conflict that would arise between the Copyright Act and the Thirteenth Amendment i.e., the constitutional protection awarded against the fetters of slavery. Applying the classical understanding of the theory of separability, Nimmer claimed that protection would only be extended to the work if it is physically separable

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<sup>24</sup> Arrielle S Millstein, 'Slaves to Copyright: Branding Human Flesh as a Tangible Medium of Expression' (2014) 4(1) Pace. Intell. Prop. Sports & Ent. L.F. <<https://digitalcommons.pace.edu/pipsself/vol4/iss1/5>> accessed 24 September 2021.

<sup>25</sup> 17 U.S.C. § 101.

from the medium of expression.<sup>26</sup> As mentioned earlier, the artist had not recorded the design anywhere except on Mr. Tyson's face, and hence, failed the physical separability test. The tattoo was part of the subject's face and could not be separated whatsoever, meaning that there was no existing copyright.

The Nimmer Declaration has received its fair share of criticism- it is worthwhile to note that his deposition was barred by the Court as it constituted opinion on what the law should be, and not the law as it is. The Judge dismissed his arguments as frivolous, and stated resolutely that tattoos and their design by itself could be copyrighted, as it was entirely consistent with copyright law. The plaintiff was by no means restricting Mr. Tyson from the usage of his own head, or even the modification/removal of the tattoo. However, as the parties dismissed the case in favor of an out of court settlement, no written legal precedent was established to that regard. Nimmer's sudden change of heart and deviation from his earlier comments supporting copyright protection for tattoos in his treatise were noted by several scholars, who accused him of conveniently attempting to reconfigure the law in favor of his client's immediate interests.<sup>27</sup> His controversial statements equating the artist-client relationship to slavery were also the subject of censure.

However, the Nimmer Declaration is not without its merits, regardless of the criticism it received and the somewhat alarming statements it included. More specifically, his argument regarding the rights of personhood and bodily autonomy cannot be ignored.<sup>28</sup> According to several eminent philosophers, the rights of a person cannot rest anywhere, except the person himself. No

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<sup>26</sup> *Whitmill* (n 22).

<sup>27</sup> Ann Bartow, 'When a Treatise Writer Tries to Reconfigure Copyright Law to Benefit a Client', (MADISONIAN.NET, May 25, 2011), <<http://madisonian.net/2011/05/25/when-a-treatise-writer-tries-to-reconfigure-copyright-law-to-benefit-a-client>> accessed 21<sup>st</sup> Sept 2021

<sup>28</sup> *Whitmill* (n 22).

individual can claim to hold property rights or interest in another person's body, a principle affirmed in the works of William Ellery Channing,<sup>29</sup> as well as in Lockean ideals.<sup>30</sup> No tattoo artist can claim to exercise any form of influence over his client so as to curtail their personal liberty. So, how are the intellectual property rights of tattoos divided between the artist and the bearer? This will be discussed in detail in coming sections.

### CASES THAT ADDRESS THE INKY AMBIGUITY

Although there is a clear lack of authoritative court decisions regarding the same, most legal experts agree that tattoos are copyrightable, and hence enjoy legal protection. The current statutory framework makes it almost impossible to ascertain the true legislative intent with respect to the division of rights between artist and client, both in the Indian and American statutes.

The ambiguity that arises regarding the extent of protection afforded is harmful to many parties. Firstly, the tattoo industry, which is quickly growing and shows no signs of slowing down. It is valued at a hefty 3 billion dollars per year in the US,<sup>31</sup> and INR 20,000 Crores in India.<sup>32</sup> This industry is hindered by the lack of defined legislative protection of their intellectual property rights, and regain control of their works with respect to mass media. Secondly, it affects celebrities and the entertainment industry, such as Television studios and video game developers. Individuals whose

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<sup>29</sup> William Ellery Channing, *A Human Being Cannot Be Justly Owned* (Libertarianism.Org, first published 1 Aug 1835) <<https://www.libertarianism.org/publications/essays/human-being-cannot-be-justly-owned>> accessed 21st Sept 2021.

<sup>30</sup> William Uzgalis, *John Locke* (Spring 2020 Edition) Edward N. Zalta (ed.) *The Stanford Encyclopedia of Philosophy* <<https://plato.stanford.edu/archives/spr2020/entries/locke/>> accessed 21st Sept 2021.

<sup>31</sup> John LaRosa, 'Tattoo Parlors & Tattoo Removal Is Now a Booming \$3 Billion Industry' (Market Research, 12 September 2018) <<https://blog.marketresearch.com/tattoo-parlors-tattoo-removal-is-now-a-booming-3-billion-industry>> accessed 22 September 2021.

<sup>32</sup> Prabhjote Gillaug, 'India's ₹20,000 Crore Tattoo Industry's Lax Standards Are Putting Lives At Risk' (*Business Insider India*, 26 Aug 2019) <<https://www.businessinsider.in/indias-tattoo-industry-needs-regulation-and-standards-to-protect-customers-and-artists/articleshow/70835880.cms>> accessed 22 Sept 2021.

appearances are inevitably tied to their livelihood, are especially vulnerable; there is already a trend of celebrity athletes being sued for infringement. It is important to address these concerns while balancing these differing interests.

*Reed v. Nike*<sup>33</sup> is regarded by many to be the first case of copyright infringement over a tattoo. In 2005, Reed, a tattoo artist, initiated a suit against Nike Inc. and Rasheed Wallace, an NBA player, who had appeared in a commercial for the former sporting his tattoo and discussed its significance and meaning. Wallace had discussed the details of the tattoo he wanted, and Reed drew up a few sketches for him. After taking his changes into account, the artist then tattooed the design on Mr. Wallace. There was no discussion regarding ownership of the copyright. Ironically, the artist had accepted a modest consideration in lieu of the exposure he would receive from Wallace's public display of the work. However, it seems that things went too far when the player appeared in Nike's commercial highlighting the tattoo.

Reed brought an action against Nike for contributory infringement, stating that they were violating his exclusive right to reproduce, adapt, and publicly display the work. He claimed that even if Wallace was to be considered a joint author, he was still entitled to his right to an accounting for profits. Unfortunately, the parties settled out of court before a satisfying conclusion could be reached for the sake of tattoo jurisprudence- a motif that will become apparent soon.

Reed opened up a Pandora's box: a number of copyright infringement suits were filed by tattoo artists against entertainment companies that used their designs in their media. A mere six years later, *Whitmill v. Warner Bros*<sup>34</sup> i.e. the Mike Tyson tattoo case went to court. This case created ripples not only in the entertainment and tattoo industry, but also in the legal fraternity, due to David Nimmer's controversial deposition in favor of the Defendants, Warner

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<sup>33</sup> *Reed v Nike Inc.*, 17 Civ. 7575 (LGS) (S.D.N.Y. May. 31, 2019).

<sup>34</sup> *Whitmill* (n 20)

Bros. He claimed that tattoos were not subject to copyright protection as human flesh does not qualify as a tangible medium of expression. The Judge in the particular case had in fact dismissed the Defendant's arguments as silly and frivolous, and stated that the tattoo artist had a strong likelihood of prevailing in the case.<sup>35</sup> Once again, since the parties settled, the merits and demerits of the case were not discussed by the Court. One cannot help but wonder how the Court would have treated the Defendant's arguments if the case had actually gone to trial.

In *Christopher Escobedo v. THQ Inc.*,<sup>36</sup> a tattoo artist sued a UFC themed video game developer in 2012 for allegedly infringing upon his registered lion motif that he tattooed on fighter Carlos Condit's torso. It was claimed that unless there was a written assignment of copyright, or a work for hire agreement, ownership of the IPR would rest in the hands of the original author, i.e. the artist. The judge in the present case acknowledged the artist's right of ownership, but leaned towards fair use. The more relevant question that arose here was whether the artist was entitled to a cut of the profits, if there was a commercial aspect involved. Once again, the parties settled and agreed that all editions of the UFC video game series would remove all instances of the tattoo.

In *Allen v. Electronic Arts, Inc.*,<sup>37</sup> similar to the facts of *Reed v. Nike*- the tattoo artist Allen had tattooed football player Ricky William's upper arm. Although Allen, as the copyright owner expected some violation of his exclusive rights, the tattoo appearing on the cover of EA Sport's video game proved to be too far. He filed a copyright infringement suit, claiming violation due to a

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<sup>35</sup> *ibid.*

<sup>36</sup> *Christopher Escobedo v. THQ Inc.*, 2:12-cv- 02470-JAT (U.S. District Court, District of Arizona [Phoenix] 2013).

<sup>37</sup> *Allen v. Electronic Arts, Inc.* [2012] 5:12-CV-3172 (W.D. La. 2012)(dismissed April 9, 2013).

featured use of an unauthorized derivative work based on his tattoo. The parties settled rather quickly- a short four months later.

In the 2016 case of *Gonzalez v. Transfer Technologies, Inc.*,<sup>38</sup> the Defendant reproduced and then sold temporary tattoos of the Plaintiff's copyrighted design. After the filing of the suit, the Defendant promptly ceased his actions. The Illinois District Court awarded minimum statutory damages, but declined to award attorney's fees on the grounds that the Defendant's Act was not the kind of flagrant behavior that justified the awarding of attorney's fees. On appeal, The Court ruled in the tattoo artist's favor, stating that this explanation was not sufficient to deny an award on that basis. Nimmer makes an appearance once more, quoting this case in his deposition for *Whitmill*. Citing this case as one that focused merely on the Defendant's conduct, he claimed that it was unprecedented for tattoos to claim copyright protection, as no clarity was offered on whether the Plaintiff could claim copyright in a tattoo.<sup>39</sup> In spite of being one of the rare published decisions regarding tattoos and copyright, *Gonzalez* does not offer any significant clarity regarding the same.

#### AN INDIAN PERSPECTIVE

For better or for worse, there have been no cases of copyright infringement filed against any party regarding tattoos in India. However, the Indian Copyright Office granting a valid copyright to actor Shahrukh Khan's tattoo<sup>40</sup> seems to suggest that tattoos come under the ambit of 'artistic work' mentioned in Section 13 of the Act. An interesting aspect of this is that it was not the tattoo artist who registered for the same, but rather the bearer.

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<sup>38</sup> *Gonzales v. Transfer Techs. Inc.*, 301 F.3d 608 (7th Cir. 2002).

<sup>39</sup> *Whitmill* (n 22).

<sup>40</sup> 'SRK Registers Don 2 Tattoo in His Name' (The Indian Express, 15 July 2011) <<http://archive.indianexpress.com/news/srk-registers-don-2-tattoo-in-his-name/817871/>> accessed 22 Sept 2021.

However, there is still some ambiguity as to which specific criterion it can be pigeonholed into: a painting, drawing, or engraving.<sup>41</sup>

In response to a postal query made by a public-spirited scholar,<sup>42</sup> the Indian Copyright Office declared the following perplexing contentions, which have been summarized below:

1. Tattoos come under the scope of artistic work under 2(c), and are categorized as a drawing.
2. It was stated that the client would become the owner of the tattoo, but special rights would still rest with the artist.
3. Even if the artist still holds copyright over the tattoo- by virtue of his taking of valid consideration, the artist cannot interfere with the public display of the tattoo as per Section 17(b), i.e., work made for valid consideration.
4. If the work is categorized under Sec 17(c) i.e., work made in the course of employment, the subject matter would be the work first created as a drawing.
5. When enquired whether the work could be categorized as under a contract of service/apprenticeship under 17(c), with the client as the employer and artist as employee, the Office rejected the same, stating that this analogy could not apply here.

This response raises more questions than it answers. The points raised are contradictory and devoid of clarity. Firstly, the classification of a tattoo as a drawing itself is debatable. Tattoos, by definition, are inked engravings on human skin. There is uncertainty in pigeonholing this unique form of art

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<sup>41</sup> Indian Copyright Act 1957, s 2(c).

<sup>42</sup> Shruti Shukla, 'Tattoos And Copyright: Can Getting Inked Lead You To The Court?' (Lex Forti, 8 Oct 2020) <<https://lexforti.com/legal-news/tattoos-and-copyright/>> accessed 23 Sept 2021.

under Section 2(c) of the Copyright Act. Once again, we take the case of *S Victor Whitmill*. Here, the very first instance of the tattoo was Mr. Mike Tyson's face. It was not rendered on any other medium. Can art made on human flesh be classified as a drawing? In such a case, it is understandably more difficult to claim copyright protection while claiming it to be a drawing. Secondly, perhaps the most glaring inconsistency: If tattoos are being categorized as a drawing, they cannot come under the purview of Section 17(b) which applies to only 5 cases- photographs, paintings, portraits, engravings, and cinematograph films.<sup>43</sup> It appears that the Copyright Office is itself unclear as to how tattoos fit into the current copyright classification. If tattoos do not qualify for the application of Sec 17(b), it is likely that the tattoo artist may not be considered to be the first owner of the tattoo. Thirdly, the Copyright Office has vaguely asserted that tattoo artists still enjoy special rights, but has not expanded on what rights they are entitled to.<sup>44</sup>

Without any actual cases of tattoo infringement appearing before the Court, it is unlikely that this issue will be resolved anytime soon. With the lack of clarity regarding protection, tattoo artists are unwilling to pursue litigation in order to enforce and protect their rights. The 2020 case of *Solid Oak Sketches v. 2K Games* may have been the only case that authoritatively established copyright protection for tattoos.<sup>45</sup>

#### **DIVIDING THE RIGHTS OF OWNERSHIP: SOLID OAK SKETCHES V. 2K GAMES**

Although the work is in possession of the person who got it tattooed, copyright is vested in the author of said work. This is a principle accepted in previously discussed cases. Unless the bearer provided the design, ownership of copyright will rest with the tattoo artist. This also vests in the copyright

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<sup>43</sup> *ibid.*

<sup>44</sup> *ibid.*

<sup>45</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, 449 F Supp 3d 333 (SDNY 2020).

holder a bundle of rights, including the right to reproduce, modify, and create derivative works, among other things.

The tattoo artist owns the artwork, but not the body it is on. In this case, could they require the person to perform tattoo removal if they don't want the tattoo to be displayed, or to modify the tattoo? Can they prevent public display of the tattoo by filing an injunction? Clearly, this is absurd, and infringes upon the bearer's free will and bodily autonomy. Tattoos are part of a person's personal expression/likeness, and once the artist puts their art on another person's body, their exclusive rights to the art will be diminished. In exchange for the consideration paid, the tattoo bearer owns an implied license to the work and has the right to display the design in public.<sup>46</sup>

The pressing question of how the rights are divided between the artist and the bearer was tentatively answered in the 2020 case of *Solid Oak Sketches, LLC v. 2K Games*.<sup>47</sup> This may have been the first case to authoritatively establish the copyrightability of tattoos. Here, a videogame developer, Take Two, recreated the tattoos of popular basketball players on a digital medium without permission from the owners of the design. Solid Oak sketches, the tattoo artist filed a copyright infringement suit in 2016. Surprisingly, in this case, the court did not agree to the contention that there was a substantial similarity between the designs. It was held that as the tattoos appeared on a mere 3 characters out of 400 possible ones, the tattoos had not been displayed with enough detail for the average lay observer to identify neither the subject matter, nor the style used in creating them. It was resolutely ruled that Take Two's use of the artwork was *De Minimis*,<sup>48</sup> i.e., too miniscule to be taken into consideration.

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<sup>46</sup> *ibid.*

<sup>47</sup> *ibid.*

<sup>48</sup> *Rogers v. Koons*, 960 F.2d 301, 307-08 (2nd Cir. 1992).

Here, the court explained that once Take Two portrayed the players in the game, they could use the tattoos as well. This is because the tattoo artists had given the players an implied license to their work, and once the players licensed their likeness to Take Two, the tattoos passed along with it. Moreover, since the tattoos were recreated in the digital medium in order to lend authenticity to the depiction of the players, and that the tattoos were “merely incidental” to the commercial nature of the game, the fair use defense was accepted. Another pitfall for the tattoo artists was the lack of originality in their designs.

Unauthorized reproduction or creation of a derivative work featuring an original tattoo work could be illegal if it has a commercial aspect of unjust enrichment to it. In other words, if someone stands to profit from the exploitation of the artwork without paying the customary price or consideration, they could be held liable for infringement by the owner of copyright. So, hypothetically, had Take Two used the players’ tattoos in, say, an advertisement to publicize their game, perhaps then the court might have ruled in the tattoo artists’ favor, ignoring the other pitfalls like a lack of originality.

It is celebrities who are more likely to be held liable for formal infringement suits regarding the copyright of tattoos, as their appearance is inevitably tied to their livelihood. The portrayal of tattoos on a celebrity’s body could conceivably be covered by their personality and image rights-as tattoos may form indicia of their personality.<sup>49</sup> The media company purports to use the likeness of the celebrity- this implies that tattoos, scars, moles and other permanent marks that appear on the celebrity’s body passes along with them. In fact, the Indian Copyright Act affirms this principle via Section 52: the inclusion of any artistic work, if it is incidental to the principal matters

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<sup>49</sup> Devika Agarwal, ‘Rights of Tattoo Artists’ (*SpicyIP*, 18 June 2014) <<https://spicyip.com/2014/06/rights-of-tattoo-artists.html>> accessed 28 September 2021.

highlighted in the film, would not amount to copyright infringement, provided that such inclusion is merely by way of background.<sup>50</sup>

However, since *Reed v. Nike*, perhaps as a precautionary measure, Video Game developers and other media companies have begun to exercise caution in this regard. These companies have begun to actively seek out permission from tattoo artists before including their art in games.<sup>51</sup>

So, how could one mitigate the possibility of such suits? It is not as simple as merely paying royalties to artists. This would give rise to several logistical difficulties with respect to owners of existing tattoos, and then securing agreements with them. If the artist has expired, it would bring the added nightmare of attempting to track down the heirs to the estate. Add to this the celebrity factor, and individuals may come forward claiming to be the artist for their fifteen minutes of fame. This would result in complicated legal battles to prove ownership. The need for clarity has become even more apparent subsequent to the *Reed v. Nike* decision.

#### **EFFECT ON MORAL RIGHTS: THE CASE FOR TATTOO ARTISTS**

The general consensus seems to be that tattoo artists own the artwork, but do not receive the entire bundle of rights generally vested in copyright owners. When they have spent countless hours of labor in preparing the original design, to study the art of tattooing and perfecting their craft, it seems unfair that compensation stops at the fee received for the tattoo, when it is not only their labor that has gone into the work, but rather their heart and soul. There is a deep emotional bond connecting an artist and his work. Morality and law should recognize the continuing control an artist possesses over his creations.

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<sup>50</sup> Indian Copyright Act 1957, s 52(1) (u).

<sup>51</sup> Brendan Maloy, 'Colin Kaepernick's Tattoos Will Be Featured In This Year's Madden' (*SI*, 5 June 2014) <<https://www.si.com/extra-mustard/2014/06/05/colin-kaepernicks-tattoos-will-be-featured-in-this-years-madden>> accessed 28 September 2021.

Courts have recognized the subjective intent of an artist regarding the purpose and character of their work, so why not in tattoos? As long as the demands are reasonable, the law is required to respect the bond between an artist and his work. After all, property rights are important for the self-realization of an individual in order to be recognized as a free-agent. Control over one's own creative work reflects self-expression, and that is necessary for self-fulfilment. Nobody should be allowed to violate their copyright by using it to promote or sell their product without their permission. This is deeply rooted in the principles of justice, equity, and good conscience. Applying the theory of equity, it is apparent that the artists should receive a share of the profits proportional to the amount of effort they have put into it.<sup>52</sup>

Being a rare published decision on the subject, the European case of *JDH v. JM* has attempted to separate the rights between artist and the client.<sup>53</sup> In 2009, the Court of Appeals in Ghent, Belgium adjudicated a dispute between a tattoo artist, who had used one of his creations in an advertisement to promote his business, and the client who was bearing the tattoo. The Court drew a distinction between the actual design of the tattoo, and the tattoo as reproduced on the client's body. The tattoo artist's right to reproduction is restricted to the actual design. This means the artist has no say whatsoever on the client's right to modify/destroy the tattoo. He is also barred from imposing restrictions that interfere with the client's bodily autonomy, and cannot restrict the client's right to be photographed by third parties and so on. To put it simply, the bearer's image rights and right to bodily autonomy triumphs the artist's right to reproduction, as well as their moral rights.

Of course, tattoo artists cannot be allowed to infringe upon a person's bodily autonomy, by preventing them from performing tattoo removal when they

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<sup>52</sup> Andrews, Stephen Pearl, *The Sovereignty of the Individual* (first published 1938, Freeman Press). See also Dan-Cohen, Meir, *Harmful Thoughts: Essays on Law, Self, and Morality* (Princeton University Press 2002) 296.

<sup>53</sup> *JDH v JM* (2009) 2007/AR/912 (Juridat) (Ghent CA).

aren't satisfied with the tattoo, or by preventing them from displaying the work in public. Certainly, the Belgian Court is right in this aspect. But the contention that tattoo artists are completely excluded from the realm of moral rights is worrying. Just because the medium of expression is a human body, are artist rights completely extinguished?

Tattoo artists may be entitled to a set of reasonable moral rights such as a limited right to attribution. This right provides that the original author of the work is entitled to be known as the author in the case of performance, publication, reproduction, or adaptation of his or her work. Due credit must be given to the artist in all cases. So, if the bearer was to appear in a commercial highlighting the tattoo, à la *Reed v. Nike*, the tattoo artist should be entitled to a percentage of the profits made from the commercial usage or exposure of the tattoo. Regarding the right of integrity, the tattoo artist in all likelihood, cannot prevent the tattoo bearer from modifying, or destroying the work of art, as this infringes on bodily autonomy. But perhaps, in case of modification, he can still hold copyright over the parts of the artwork that have not been modified.

#### I. An Interesting Example

Staying on the topic of division of rights between the artist and bearer, it would be interesting to explore the principle of an artist's continuing control over his creations with a rather macabre example.

The preservation and display of tattooed human skin dates back hundreds of years with a number of collectors dedicated to the practice. In fact, there's a museum of tattooed skin in Japan, hosting an impressive collection of over 100 pieces of art,<sup>54</sup> as well as many collectors who spend large sums of money

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<sup>54</sup> 'The Bodysuit Collector: Doctor Fukushi Masaichi and The Art of Preserving Tattooed Skin' (*Yamato Magazine Home Blog*, 14th Sept 2020) <<https://yamatomagazine.home.blog/2020/09/14/the-bodysuit-collector-doctor-fukushi-masaichi/>> accessed 25 September 2021.

to acquire tattooed skin. So, when there's a commercial aspect, i.e. people making profit off the artist's creation, perhaps it would not only be the deceased person's heirs that get a share of the profit, but also the artist, as it is his labor that has gone into the work. This is also rooted in the French concept of *Droit de Suite*. Also known as the Artist's Resale Right, this refers to the right of the artist to collect a reasonable fee when works are resold.

There is also some justification for the application of the first sale doctrine.<sup>55</sup> This American principle significantly limits the rights of an intellectual property holder when his or her works are resold. This concept was introduced to avoid liabilities that could arise when products entered the distribution chain. Essentially, it acts as an exception to the right of distribution assured to the copyright holder, by stipulating that he or she cannot control resale, or the terms and conditions of said resale. However, its application to tattoos is still uncertain. Law protects not the idea, but the expression of the idea. So once the tattoo bearer's skin is sold to a collector, perhaps the artist cannot control the sale, but may still be entitled to compensation, if the work is displayed or modified in a commercial setting.

### **OTHER FORMS OF PROTECTION FOR TATTOOS: THINKING BEYOND COPYRIGHT**

#### **I. Industrial Design**

In spite of the debates surrounding the topic, there is one subset of tattoo design that has indisputable IPR protection: Tattoo flash. This generally refers to pre-drawn, generic designs that are meant to act as stencils for walk-in customers. The origin of tattoo 'flash' can be traced back to 20<sup>th</sup> century New York, where Lew 'The Jew' Alberts developed and popularized the sample

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<sup>55</sup> 17 U.S.C. 106(3); Indian Copyright Act 1957, s 14(a) (ii).

tattoo design sheets, still seen in tattoo parlors today.<sup>56</sup> Flash art is meant to adapt to an increasingly fast paced world; for customers who do not want to spend too much money on a custom design, or do not have the time to commit to multiple long sessions.

These designs are created in two ways: they may have been created by the tattoo artist themselves, or sold to the parlor by a third party. The copyright for these designs lies with the original artist. It can be transferred between parties, and unauthorized reproduction- in all likelihood- would lead to an infringement suit. On purchase, the buyer was entitled to replicate the designs on as many customers as he chose. He or she was also entitled to make changes as required. This would come within the ambit of copyright law as a 'limited implied license'.<sup>57</sup> The original artist grants a non-exclusive license, through conduct that creates a reasonable inference in the buyer's mind that the owner consents to their usage for a particular purpose. A good example would be an architect delivering drawings to a client. It is 'limited' in the sense that if the designs were used for something other than tattoos, it would exceed the scope of the transfer.

A better way to protect tattoo flash would be by means of industrial design, to protect the ornamental aspect of the creation. In order to receive protection, the tattoo must be a 'registered design'. Indian designs are governed by the Designs Act of 2000. Some countries bring designs under the ambit of patent law, and refer to them as 'design patents'. This statutory protection enables the owner to prevent integration or embodiment of a design which is a copy, or considerably a copy, when done for merchandising purposes. It is however, important to keep in mind that there cannot be simultaneous copyright and

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<sup>56</sup> Marcus Bunyan, 'Painless' Jack Tyron Tattooed By Charlie Wagner and Lewis (Lew) Alberts' (ArtBlart, 17 April 2017) <<https://artblart.com/tag/painless-jack-tyron-tattooed-by-charlie-wagner-and-lewis-lew-alberts/>> accessed 21 January 2022.

<sup>57</sup> Perzanowski (n 5).

design protection.<sup>58</sup> According to clause 2 of Section 15, if an article is capable of registration under the Designs Act, but is not registered as such, then the copyright protection ceases once the article is reproduced over 50 times by means of an industrial or mechanical process. Thus, if creators relied primarily on copyright protection, especially for flash tattoos that are meant to be reproduced on a large number of clients, they would be left in a vulnerable position.

## II. Trademarks

At this point, it is worthwhile to examine the infringement issues that arise when trademarked symbols are reproduced in the form of tattoos. One of the main principles of trademark law is that commercial use of a registered trademark is prohibited. The purchaser of a pair of counterfeit Nike shoes wouldn't be the one facing an infringement suit, but rather the counterfeiter i.e. the person selling the shoes. By this principle, a person sporting a Disney tattoo wouldn't be served with an infringement suit, but rather, the tattoo artist would. If the person who received the tattoo brandishes it in say, a commercial, they could also be held liable under trademark law.

Take the case of Sam Penix, a New York City resident, who tattooed "I [coffee cup] NY" across his fist. Penix, being a coffee shop owner, had featured the tattoo quite significantly in his store's logo. However, as the "I ♥ NY" trademark was owned by the NY State Department of Economic Development, he was threatened with a trademark infringement lawsuit. In order to avoid liability, he had to agree to a set of terms and conditions, including an agreement that significantly restricted the ways in which his tattoo could be photographed.<sup>59</sup> Penix's case is an isolated one- a rare case

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<sup>58</sup> Copyright Act 1957, s 15(1).

<sup>59</sup> Andy Newman, 'A Cup Is at the Heart of a Trademark Dispute' (*New York Times*, 29 May 2013) <<https://www.nytimes.com/2013/05/30/nyregion/new-york-challenges-a-coffee-shop-logo.html>> accessed 21 January 2022.

where tattoos were the subject of a trademark infringement suit. It is also a somewhat justifiable one, seeing that there was a clearly defined commercial aspect to the case. But it appears that when there is a lack of a commercial element, right holders are far more likely to let unauthorized reproduction of their trademarks as tattoos slide.

Take the case of George Reiger, a particularly devoted fan of Disney, who adorned almost 90% of his body with various tattoos of Disney characters. There is no instance of Disney ever suing or taking any form of action against Reiger.<sup>60</sup> This lack of action does not mean that the gigantic corporation is not aware of the usage of their trademarked material- it appears that there has been a deliberate choice made to remain silent. This could be due to various reasons. Firstly, a person choosing to get such a tattoo is a sign of deep devotion, and reflects on the company's goodwill. If the company has no stake in the tattoo market, there would be no loss or economic harm to the company. If anything, such exposure would be beneficial and act as an advertisement for the company. There are, in fact, instances of corporate companies offering monetary benefits to their employees to get their logos tattooed.<sup>61</sup> Secondly, the company would have to incur expenses for tracking down infringers, who are wide and dispersed. Add to this the heavy costs of litigation, and it suddenly becomes apparent as to why companies seem more than happy to let potentially infringing tattoos slide.

### III. Traditional Cultural expressions

When tattoos incorporate designs that are rooted in Traditional Cultural expressions, another set of problems arise. In 2013, Nike faced heavy outrage from the Polynesian community after the company launched a women's

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<sup>60</sup> Perzanowski (n 5).

<sup>61</sup> *ibid*; see also 'Brooklyn Realtor Is Giving A 15% Raise To Workers Who Get A Tattoo Of Their Logo' (Business Insider, 4 May 2013) < <https://www.businessinsider.in/personal-finance/Brooklyn-Realtor-Is-Giving-A-15-Raise-To-Workers-Who-Get-A-Tattoo-Of-heir-Logo/articleshow/21136006.cms>> accessed 7 May 2022.

sportswear line inspired by Samoan traditional tattoos.<sup>62</sup> The design was one that denoted honor and was reserved for male chiefs. Although Nike issued an apology and withdrew the line, this incident has exposed the glaring need for protection of TCEs and TK.

Once again, we examine Victor Whitmill's case. Mike Tyson's tribal face tattoo was heavily inspired by traditional Māori designs: *Tā Moko*, the traditional practice of the Māori people native to New Zealand, is considered to signify high social status. The tattoo artist had been successful in securing a valid copyright registration for this design and therefore was able to file an infringement suit against Studio Warner Bros. for reproducing the tattoo on an actor's face. If he could receive protection for the design despite it being a derivative work, could he, hypothetically, sue Māori tattoo artists if their designs are similar to his creations?

It is extremely difficult to enforce protection of TCEs and TK in the current IP framework; one of the main criticisms is that the WIPO principles do not endeavor to protect TCE/TK as such, but rather to the extent that it intersects with the IP interface.<sup>63</sup> For instance: the element of ownership of TCE/TK is a challenge to demarcate, as current IP law recognizes not collective but individual rights alone. The current IP laws have also clearly evolved to reflect the economic or commercial interests of a society, and not the cultural or moral interests. Last but not the least, the transcendental nature of TCE/TK means that it cannot be constricted by the limited duration of protection offered by IP law.

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<sup>62</sup> 'Outrage over Nike's Use of Cultural Icon' (*ABC News*, 15 August 2013) <<https://www.abc.net.au/news/2013-08-15/an-samoa-nike-tattoo-row/4888662>> accessed 21 January 2022.

<sup>63</sup> Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, WIPO, *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Table of written comments on revised objectives and principles* (Document prepared by the Secretariat) (WIPO/GRTKF/IC/11/4(b)) paras 4.1- 4.8.

There must be a reasonable set of rights granted to communities to enable them to protect their cultural heritage, and assert their intellectual property rights. There is however, a fine line to tread here: the community's moral and economic rights must be upheld, while fostering interculturality and artistic freedom. The challenges here are that pre-existing TCE works which are currently in the public domain under copyright law, are available for use by anybody, creating a conflict of interest between the rightful owners and the users. Moreover, it is difficult to document the potentially infringing cases. Efforts must be made to broaden the current IP framework. Countries may consider developing a *sui generis* system of protection, or strengthening the current framework by incorporating legal, as well as non-legal remedies. India could consider creating a digitized library of traditional art, designs, and so on- similar to the TKDL (Traditional Knowledge Digital Library). This codification could go a long way in protecting TCEs. The costs involved are likely to dissuade Government investment, but perhaps the costs could be offset by encouraging community participation.

#### **THE STATE OF THE TATTOO INDUSTRY**

Ironically, though tattoos come under the ambit of protection offered by Copyright law, the latter has little to no part to play in the actual practice of the tattoo industry. Rather, tattoo artists seem to prefer informal methods of enforcing their rights. As evidenced, tattoos are especially vulnerable to unauthorized reproduction. However, there aren't many cases of infringement in the industry. Public displays of the work often act as a form of unpaid advertisement for the artists, so lawsuits between clients and artists are rare, and generally only arise in high profile cases of the work being reproduced in merchandise or other mediums i.e., a commercial aspect is present, as exhibited by the cases discussed.

Tattoo artists acknowledge the clients right to public display, as well as modification/destruction of their works. It is very rare for them to replicate

one person's tattoo on another, as it is a design born out of a relationship based on faith- so if another tattoo artist were to engage in non-literal copying, they might be looking at a copyright infringement suit.<sup>64</sup> But once again, considering the cost and long term of the lawsuits, most cases don't really go to court. Copying is instead seen as an unavoidable part of the creative process, and even considered desirable in some circumstances.

When interviewed, tattoo artists admitted to being reluctant to pursue copyright infringement suits in Court, and appear to prefer solving these matters within themselves. Instead of resorting to the legal system, which they had mixed feelings about, they prefer direct confrontation of the infringing artists.<sup>65</sup> They also added that with copying being so common these days, it was hardly worthwhile to actually track down infringers and seek remedies. There is nothing that would justify the time, money, and effort that a lawsuit demands. This norm-based system of copyright protection is reminiscent of the informal system set up by stand-up comedians to safeguard themselves from joke stealing, as copyright law does not offer them a better alternative.<sup>66</sup> They seem to shy away from court-enforced mechanisms for copyright due to the significant practical barriers it poses.

The conventional master-servant relationship is difficult to apply in the absence of a clear, written contract. In order to avoid conflicting interests, it is best to clearly spell out the ownership rights of the tattoo. Preferably, a release or a waiver must be signed in order to avoid liability. Not every tattoo studio actually makes the effort to prepare these documents, leading to

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<sup>64</sup> Perzanowski (n 5)

<sup>65</sup> Matthew Beasley, 'Who Owns Your Skin: Intellectual Property Law And Norms Among Tattoo Artists' (2012) Vol. 85 Southern California Law Review <[https://southerncalifornialawreview.com/wp-content/uploads/2018/01/85\\_1137.pdf](https://southerncalifornialawreview.com/wp-content/uploads/2018/01/85_1137.pdf)> accessed 28 September 2021.

<sup>66</sup> Hannah Pham, 'Standing Up for Stand-Up Comedy: Joke Theft and the Relevance of Copyright Law and Social Norms in the Social Media Age', (2019) 30(1) Fordham Intell Prop Media & Ent LJ 55 (2019). <<https://ir.lawnet.fordham.edu/iplj/vol30/iss1/2>> accessed 28 September 2021.

problems in the future. With the steady growth of the tattoo industry and the increasing professionalization of tattoo artists, it seems that there will be an unceasing stream of tattoo infringement suits in the near future. The need for formal protection has never been more necessary.

### CONCLUSION

The challenges associated with copyright protection for tattoos have been at the center of many contemporary debates since *Reed v. Nike*. Tattoo artists, just like any other artist, are entitled to copyright protection of their work. However, due to the ambiguity surrounding the protection of the art, they are actively discouraged from pursuing the same. The general consensus seems to be that tattoos are copyrightable, however the actual division of rights between the artist and client are yet to be established. It appears that the unauthorized reproduction or display of tattoos warrants an infringement lawsuit when someone stands to gain from the exploitation of the artwork without paying just and fair consideration. Tattoo artists should also be entitled to a set of reasonable moral rights.

The lack of a clear, well-defined court ruling regarding IP protection for tattoos has hurt many parties: artists, their clients, celebrities, and the media and entertainment industries. It is impossible to address these doubts in the current legislative framework. Hence, policymakers must take tattoo artists seriously and keep in mind the norms of tattoo artists while drafting statutory additions and rules regarding their protection. They must take into account the intricacies that surround copyright protection for tattoos and provide suitable suggestions, while balancing the interests of the clients and concerned industries. There is a need for the general public to be given awareness, as well as tattoo artists to band together and make an organized effort to secure formal protection of their intellectual property. Until the law plays a bigger role, it seems that social norms will be the only recourse that artists can turn to for relief.

*Solid Oak Sketches* is one of the first authoritative decisions regarding the copyrightability of tattoos. It is undoubtedly more fact-driven, as the Court did not resolutely pronounce whether an artist can claim copyright to a tattoo on another person's body. The growing trend of tattoo artists filing copyright infringement suits seems to suggest that the judiciary will soon be called upon to answer this burning question. Only time will tell whether clarity will arrive, in order to provide relief to the industry, and to reaffirm the public goals of copyright law.

## **THE WAIVER OF THE TRIPS AGREEMENT FOR COVID-19 AT THE WTO: A RHETORICAL ANALYSIS**

*Emmanuel Kolawole Oke\**

### *Abstract*

*This article presents a rhetorical analysis of the discussions and debates at the WTO's TRIPS Council regarding the request submitted by India and South Africa for a waiver of certain obligations under the TRIPS Agreement in response to the COVID-19 pandemic. Considering the engagement in 'rhetorical action' by both sides of the COVID-19 waiver proposal debate, the article explores whether the discussions, debates, and negotiations at the TRIPS Council regarding the proposed waiver is likely to produce any useful solution. The article is structured into three main sections. Section 1 presents a brief overview of the role of the TRIPS Council in international intellectual property law. Section 2 examines both the waiver proposal by India and South Africa on the one hand and the counter-proposal by the EU on the other hand. Section 3 contains a rhetorical analysis of the discussions and debates surrounding the waiver proposal at the TRIPS Council.*

### **INTRODUCTION**

The COVID-19 pandemic has once again brought the World Trade Organisation (WTO) and other international institutions into the spotlight. Specifically, as it relates to intellectual property rights, the WTO's Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS Council) is once again at the centre-stage for discussions and debates regarding what should be the precise and appropriate role of intellectual property rights in a public health crisis such as a pandemic.

There is a sense of *déjà vu* in this regard because, in the early 2000s, just around 6 years after the entry into force of the WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), the TRIPS Council had to provide a response to the demands of developing and least-developed countries for greater access to antiretroviral medicines due to the HIV/AIDS epidemic.<sup>1</sup> The demands made by developing and least-developed countries at the TRIPS Council eventually led to the adoption of the Declaration on the TRIPS Agreement and Public Health at the WTO's Ministerial Conference in Doha (Doha Declaration) in November 2001.<sup>2</sup>

The Doha Declaration kick-started a process that eventually culminated in the amendment of the TRIPS Agreement via Article 31*bis* which is aimed at facilitating the use of compulsory licensing to export patented medicines to countries that lack (or possess insufficient) domestic manufacturing capacity.<sup>3</sup> Article 31*bis* of the TRIPS Agreement waives the obligations under

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\* Lecturer in International Intellectual Property Law, Edinburgh Law School, University of Edinburgh. Email: emmanuel.oke@ed.ac.uk

<sup>1</sup> See WTO (Council for TRIPS) 'Special Discussion on Intellectual Property and Access to Medicines' held on 18 to 22 June 2001, IP/C/M/31, (10 July 2001); WTO (Council for TRIPS) 'Minutes of Meeting', held on 19 and 20 September 2001, IP/C/M/33, (2 November 2001); WTO (Council for TRIPS), 'Ministerial Declaration on the TRIPS Agreement and Public Health' (4 October 2001) IP/C/W/312, WT/GC/W/450 (Proposal by the African Group, Bangladesh, Barbados, Bolivia, Brazil, Cuba, Dominican Republic, Ecuador, Haiti, Honduras, India, Indonesia, Jamaica, Pakistan, Paraguay, Philippines, Peru, Sri Lanka, Thailand and Venezuela).

<sup>2</sup> WTO Ministerial Conference, 'Declaration on the TRIPS Agreement and Public Health' Adopted on 14 November 2001, WT/MIN(01)/DEC/2, (20 November 2001).

<sup>3</sup> Paragraph 6 of the Doha Declaration states that: 'WTO Members with insufficient or no manufacturing capacities in the pharmaceutical sector could face difficulties in making effective use of compulsory licensing under the TRIPS Agreement. We instruct the Council for TRIPS to find an expeditious solution to this problem and to report to the General Council before the end of 2002.' As a result of this, the WTO's General Council, in order to implement paragraph 6 of the Doha Declaration, adopted a decision in August 2003 to temporarily waive the obligations in Articles 31(f) & (h) of the TRIPS Agreement. WTO, 'Implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health' Decision of 30 August 2003, WT/L/540, (2 September 2003). Thereafter, in December 2005, the General Council adopted a decision to amend the TRIPS Agreement by making the temporary waivers a permanent part of the TRIPS Agreement. WTO, 'Amendment of the TRIPS Agreement', Decision of 6 December 2005, WT/L/641, (8 December 2005). This amendment to the TRIPS Agreement, i.e., Article 31*bis*, entered into force on 23 January 2017.

Article 31(f) of the TRIPS Agreement.<sup>4</sup> While the waiver codified in Article 31*bis* is indeed a solution, it is questionable whether it is in fact a useful solution as it has only been used once, prior to the COVID-19 pandemic, to export drugs from Canada to Rwanda.<sup>5</sup>

In October 2020, almost 20 years after the adoption of the Doha Declaration, in response to the COVID-19 pandemic, India and South Africa tabled a proposal before the TRIPS Council requesting for the waiver of certain obligations under the TRIPS Agreement.<sup>6</sup> The proposal seeks a waiver of the obligations relating to the implementation and enforcement of the provisions relating to copyright, industrial designs, patent rights, and the protection of undisclosed information under the TRIPS Agreement. However, as will become evident from the analysis below, most of the discussions and debates on the waiver proposal have focused on patent rights and the protection of undisclosed information because a key aim of the waiver proposal is to scale up the global manufacturing capacity for vaccines to combat COVID-19. This proposal has been opposed by some other WTO members, principally developed countries, and it is equally opposed by the European Union (EU)

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<sup>4</sup> Article 31(f) of the TRIPS Agreement provides that the grant of a compulsory licence ‘shall be authorized predominantly for the supply of the domestic market of the Member authorizing such use’.

Article 31*bis*(1) of the TRIPS Agreement provides that: ‘The obligations of an exporting Member under Article 31(f) shall not apply with respect to the grant by it of a compulsory licence to the extent necessary for the purposes of production of a pharmaceutical product(s) and its export to an eligible importing Member(s) in accordance with the terms set out in paragraph 2 of the Annex to this Agreement.’

<sup>5</sup> Holger Hestermeyer, ‘Canadian-made Drugs for Rwanda: The First Application of the WTO Waiver on Patents and Medicines’ (2007) 11(28) *ASIL Insights* (10 December 2007) available at <<https://www.asil.org/insights/volume/11/issue/28/canadian-made-drugs-rwanda-first-application-wto-waiver-patents-and>>.

<sup>6</sup> WTO (Council for TRIPS) ‘Waiver from Certain Provisions of the TRIPS Agreement for the Prevention, Containment and Treatment of Covid-19’, Communication from India and South Africa, IP/C/W/669, (2 October 2020). A revised waiver proposal was subsequently submitted to the TRIPS Council in May 2021. WTO (Council for TRIPS) ‘Waiver from Certain Provisions of the TRIPS Agreement for the Prevention, Containment and Treatment of Covid-19’, Revised Decision Text, IP/C/W/669/Rev.1, (25 May 2021).

which has submitted its own counter-proposal.<sup>7</sup> As at the time of writing in early 2022, the TRIPS Council has not yet been able to reach any consensus on this issue.

This article critically evaluates the discussions and debates regarding the waiver proposal at the TRIPS Council from a rhetorical perspective. Morin and Gold have contended that ‘when consensus-seeking is elevated to the status of procedural norm’, as is the case with the decision making process at the WTO, ‘it is likely to bring participants into a position of “rhetorical action.”’<sup>8</sup> They define ‘rhetorical action’ as the ‘strategic deployment of an organized set of claims with the purpose of convincing an audience or depriving opponents of rhetorical materials’.<sup>9</sup> Moreover, as they point out, ‘rhetorical action’ is ‘based on using arguments to persuade others but without a willingness to give up on maximizing one’s own gains.’<sup>10</sup> This article explores how the key actors involved in the debates surrounding the waiver proposal have engaged in ‘rhetorical action’. Due to constraints of space, the focus here will be on India and South Africa (as proponents of the waiver proposal) on the one hand and the EU (as opponents of the waiver proposal) on the other hand. The analysis here is based on the minutes of the TRIPS Council meetings between October 2020 and June 2021 where the waiver proposal has been debated and discussed.<sup>11</sup>

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<sup>7</sup> WTO (Council for TRIPS) ‘Draft General Council Declaration on the TRIPS Agreement and Public Health in the Circumstances of a Pandemic’ (18 June 2021) IP/C/W/681 (Communication from the European Union to the Council for TRIPS); WTO (Council for TRIPS) ‘Urgent Trade Policy Responses to the Covid-19 Crisis: Intellectual Property’ (4 June 2021) IP/C/W/680 (Communication from the European Union to the Council for TRIPS).

<sup>8</sup> Jean-Frédéric Morin and E Richard Gold, ‘Consensus-seeking, Distrust and Rhetorical Entrapment: The WTO Decision on Access to Medicines,’ (2010) 16(4) *European Journal of International Relations* 563, 566.

<sup>9</sup> *ibid.*

<sup>10</sup> *ibid.*

<sup>11</sup> The analysis in this article is based on the minutes of the meetings of the TRIPS Council as recorded in the following documents: WTO, Council for TRIPS, ‘Minutes of Meeting’, held on 15-16 October and 10 December 2020, IP/C/M/96/Add.1, (16 February 2021); WTO, Council for TRIPS, ‘Minutes of Meeting’, held on 23 February 2021, IP/C/M/97/Add.1, (7

Specifically, this article critically highlights how the key actors involved in the debates on the waiver proposal have employed the rhetorical device known as ‘narrative’ in presenting their case both for and against the proposal. In other words, this article shows how both the proponents and opponents of the waiver have engaged in a careful selection of key ideas, facts, and issues in making their case to the TRIPS Council. In doing this, the article makes the case that neither side is presenting or attempting to present the complete picture regarding the precise and appropriate role of intellectual property rights in the fight against COVID-19. As Reyman points out:

...narratives, particularly as they appear in discourse about the law, participate in legitimizing and normalizing certain states through their selection of content. Narratives do not relate objective facts and complete pictures of the way the world operates, but rather offer different versions of the truth from various perspectives about the way the world should be. While narratives appear as coherent wholes, no story can include all there is to tell; a narrative is, by nature, a rendering. It is constrained by time, with a set cast of characters, a selection of events, and a resolution point ... These selections contribute to the rhetorical work of narratives, creating versions of experience that define the terms of a conflict and its appropriate resolution while presenting a given version as the natural or complete story.<sup>12</sup>

Thus, with regard to the debates on the waiver proposal at the TRIPS Council, it is pertinent to ask what both the proponents and opponents are either including, or excluding, in their narratives before the Council and what are the potential implications of engaging in such ‘rhetorical action’. Therefore,

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April 2021); WTO, Council for TRIPS, ‘Minutes of Meeting’, held on 8, 9, and 29 June 2021, IP/C/M/100/Add.1, (20 October 2021).

<sup>12</sup> Jessica Reyman, *The Rhetoric of Intellectual Property: Copyright Law and the Regulation of Digital Culture* (Routledge, 2010) 39.

this article is not aimed at supporting or opposing the waiver proposal. Rather, it shows how the negotiations on the waiver proposal may not necessarily produce a solution that will be useful in the long run.

In this regard, it is worth recalling that Article 31*bis* of the TRIPS Agreement codifies a waiver that was originally adopted by WTO members in 2003.<sup>13</sup> However, as widely acknowledged by a number of scholars, the waiver mechanism in Article 31*bis* has not really been helpful in terms of facilitating access to medicines in countries with no or insufficient manufacturing capacity.<sup>14</sup> Morin and Gold have attributed this to the fact that the 2003 waiver decision is the result of the procedural norm of consensus-seeking at the WTO which fosters “rhetorical action” on the part of negotiators and which ultimately produces unhelpful outcomes or agreements.<sup>15</sup> This article thus contends that, considering the engagement in ‘rhetorical action’ by both sides of the COVID-19 waiver proposal debate, unless there is a change in this regard, it is highly likely that any outcome or agreement (if there is one) may be an unworkable or unhelpful agreement.

The article is structured into three key sections. Section 1 presents a brief overview of the role of the TRIPS Council in international intellectual property law. Section 2 examines both the waiver proposal by India and South

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<sup>13</sup> WTO, ‘Implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health’, Decision of 30 August 2003, WT/L/540, (2 September 2003).

<sup>14</sup> Muhammad Zaheer Abbas and Shamreeza Riaz, ‘Compulsory Licensing and Access to Medicines: TRIPS Amendment Allows Export to Least-Developed Countries’ (2017) 12(6) *Journal of Intellectual Property Law and Practice* 451; Carlos Correa, ‘Will the Amendment to the TRIPS Agreement Enhance Access to Medicines?’ Policy Brief No. 57, South Centre (January 2019); Nicholas Vincent, ‘TRIP-ing Up: The Failure of TRIPS Article 31*bis*’ (2020) 24(1) *Gonzaga Journal of International Law* 1.

<sup>15</sup> Jean-Frédéric Morin and E Richard Gold (n 8) 581 (noting that, ‘...a procedural norm can influence both process and outcome. The procedural norm of consensus-seeking brought all interlocutors into a process of rhetorical action that led to an “unworking agreement”. This situation is arguably common in world politics, as the procedural norm of consensus-seeking seems to be spreading in multilateral settings, especially in contexts in which economic, social, and environmental objectives converge.’). They further note at 580 that an ‘unworking agreement’ is made of “sham standards” that allows ‘a claim to the *de jure* existence of a mechanism and [relieves] pressures for the continuation of the debate as previously framed.’

Africa on the one hand and the counter-proposal by the EU on the other hand. Section 3 contains a rhetorical analysis of the discussions and debates surrounding the waiver proposal at the TRIPS Council.

### **THE ROLE OF THE TRIPS COUNCIL IN INTERNATIONAL INTELLECTUAL PROPERTY LAW**

The TRIPS Council plays a crucial role in international intellectual property law. Article IV.5 of the Agreement Establishing the WTO (AEWTO) establishes the TRIPS Council as the organ of the WTO responsible for overseeing the functioning of the TRIPS Agreement. Considering the preeminent status of the TRIPS Agreement in international intellectual property law, the role that the TRIPS Council plays (and can play) in shaping the direction and content of international intellectual property law cannot be over-emphasised. Article 68 of the TRIPS Agreement provides some elaboration on the functions of the TRIPS Council and it states that:

The Council for TRIPS shall monitor the operation of this Agreement and, in particular, Members' compliance with their obligations hereunder, and shall afford Members the opportunity of consulting on matters relating to the trade-related aspects of intellectual property rights. It shall carry out such other responsibilities as assigned to it by the Members, and it shall, in particular, provide any assistance requested by them in the context of dispute settlement procedures. In carrying out its functions, the Council for TRIPS may consult with and seek information from any source it deems appropriate. In consultation with WIPO, the Council shall seek to establish, within

one year of its first meeting, appropriate arrangements for cooperation with bodies of that Organization.<sup>16</sup>

From the above text, one can discern a number of roles. First, the TRIPS Council is charged with monitoring the operation of and the compliance of WTO members with the TRIPS Agreement. This provides a useful forum for ventilating grievances concerning, for instance, the violation of or non-compliance with the TRIPS Agreement by a WTO member and it can potentially be used as a precursor to the initiation of dispute settlement proceedings. Second, the TRIPS Council is meant to provide a forum for WTO members to consult with each other on topics and issues concerning the trade-related aspects of intellectual property rights. This arguably provides a basis for the TRIPS Council to engage in discussions on issues such as patent rights and access to medicines in developing countries. This equally makes the TRIPS Council an appropriate forum for WTO members to discuss and examine the role of intellectual property rights in the fight against the COVID-19 pandemic. Third, WTO members can assign responsibilities to the Council including requesting for the Council's assistance in the context of dispute settlement procedures. Fourth, the TRIPS Council has an obligation to make arrangements for cooperation with the World Intellectual Property Organization (WIPO).

Another key function of the TRIPS Council that can be found in the AEWTO is the one relating to the consideration of requests for waivers concerning the TRIPS Agreement. Article IX.3(b) of the AEWTO provides that all waiver requests regarding the TRIPS Agreement must first be submitted to the TRIPS Council for consideration for a period not exceeding 90 days and, after 90 days, the TRIPS Council is meant to submit a report on the waiver request to the Ministerial Conference. If there is no consensus, a decision can be taken

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<sup>16</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted on 15 April 1994) 1869 UNTS 299 (TRIPS Agreement) art 68.

by the Ministerial Conference to grant the waiver request by the vote of three-fourths of the WTO members. However, given the usual practice of seeking consensus at the WTO,<sup>17</sup> in reality, where no consensus has been reached on a waiver request, further consultations are held in order to arrive at a consensus.<sup>18</sup> Importantly, as noted in the introduction, it is this practice of consensus-seeking that encourages states to engage in ‘rhetorical action’ which ultimately leads to the adoption of unhelpful solutions and agreements. Furthermore, Article X.1 of the AEWTO empowers the TRIPS Council to submit to the Ministerial Conference proposals to amend the provisions of the TRIPS Agreement. Thus, the 2003 decision that waived the obligation contained in Article 31(f) of the TRIPS Agreement<sup>19</sup> was subsequently submitted for adoption as a permanent amendment to the TRIPS Agreement in 2005.<sup>20</sup> This amendment eventually entered into force as Article 31*bis* of the TRIPS Agreement in 2017 after it was accepted by two-thirds of WTO

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<sup>17</sup> See Article IX.1 of the AEWTO which provides in part that: ‘The WTO shall continue the practice of decision-making by consensus followed under GATT 1947. Except as otherwise provided, where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting.’

<sup>18</sup> See James Harrison, ‘Legal and Political Oversight of WTO Waivers’ (2008) 11(2) *Journal of International Economic Law* 411, 412 (noting that, ‘A request for a waiver should first be submitted to the specific Council responsible for administering the agreement from which a waiver is sought. However, a formal decision is made by the Ministerial Conference or General Council. As with all other decisions in the WTO, Member States should attempt to seek consensus on the grant of a waiver. In the case of a waiver, on the other hand, the search for consensus is specifically time limited so that after ninety days, a vote may be taken. The consent of three-fourths of the Members is needed for the adoption of a waiver. Although Article IX.3 [of the AEWTO] provides for voting, the Chair of the General Council has stated that decisions on waivers will ordinarily be sought in accordance with Article IX.1. In other words, consensus is to be preferred to voting.’); WTO, ‘Statement of the President of the General Council, Decision-Making Procedures under Articles IX and XII of the WTO Agreement, as agreed by the General Council on 15 November 1995,’ (24 November 1995) WT/L/93. It should be noted that, in accordance with Article IV.2 of the AEWTO, the General Council of the WTO is empowered to conduct the functions of the Ministerial Conference in the intervals between the meetings of the Ministerial Conference.

<sup>19</sup> WTO, ‘Implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health’, Decision of 30 August 2003, WT/L/540, (2 September 2003).

<sup>20</sup> WTO (Council for TRIPS) ‘Implementation of Paragraph 11 of the General Council Decision of 30 August 2003 on the Implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health’ (6 December 2005) IP/C/41 (Proposal for a Decision on an Amendment to the TRIPS Agreement).

members. Therefore, discussions and negotiations (including consideration of waiver requests) at the TRIPS Council can potentially lead to an amendment of the TRIPS Agreement. Thus, as demonstrated by the adoption of Article 31*bis* of the TRIPS Agreement, the consideration of a waiver request can ultimately result in norm-setting in international intellectual property law via an amendment of the text of the TRIPS Agreement.<sup>21</sup>

### **INDIA AND SOUTH AFRICA'S WAIVER PROPOSAL AND THE EU'S COUNTER-PROPOSAL**

Prior to analysing the debates and discussions surrounding the waiver proposal, it is necessary to examine the precise content of the waiver proposal (as well as the EU's counter-proposal). In October 2020, in response to the COVID-19 pandemic, India and South Africa tabled a proposal before the TRIPS Council requesting for the waiver of the obligations of certain provisions of the TRIPS Agreement for the prevention, containment and treatment of COVID-19.<sup>22</sup> In their communication to the TRIPS Council in this regard, India and South Africa stressed the importance of ensuring that intellectual property rights do not become barriers to timely access to affordable medical products needed to combat COVID-19:

...it is important for WTO Members to work together to ensure that intellectual property rights such as patents, industrial designs, copyright and protection of undisclosed information do not create barriers to the timely access to affordable medical products including vaccines and medicines or to scaling-up of research, development,

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<sup>21</sup> Isabel Feichtner, 'The Waiver Power of the WTO: Opening the WTO for Political Debate on the Reconciliation of Competing Interests' (2009) 20(3) *European Journal of International Law* 615.

<sup>22</sup> WTO (Council for TRIPS) 'Waiver from Certain Provisions of the TRIPS Agreement for the Prevention, Containment and Treatment of Covid-19' (2 October 2020) IP/C/W/669 (Communication from India and South Africa).

manufacturing and supply of medical products essential to combat COVID-19.<sup>23</sup>

Observing that there are ‘several reports about intellectual property rights hindering or potentially hindering timely provisioning of affordable medical products to the patients’,<sup>24</sup> they therefore requested for the waiver of certain obligations under the TRIPS Agreement. A major component of the waiver request is the contention of the sponsors regarding the difficulties that developing countries face when they use or try to use the existing flexibilities in the TRIPS Agreement. Indeed, the sponsors stressed that Article 31*bis* of the TRIPS Agreement, which as noted in the introduction codifies a waiver decision originally adopted in 2003, is not particularly helpful to countries with insufficient or no manufacturing capacity. According to the sponsors:

...many countries especially developing countries may face institutional and legal difficulties when using flexibilities available in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). A particular concern for countries with insufficient or no manufacturing capacity are the requirements of Article 31*bis* and consequently the cumbersome and lengthy process for the import and export of pharmaceutical products.<sup>25</sup>

The operative paragraphs of the waiver request (annexed to the communication to the TRIPS Council as a draft decision text) are reproduced below:

1. The obligations of Members to implement or apply Sections 1, 4, 5 and 7 of Part II of the TRIPS Agreement or to enforce these Sections under Part III of the TRIPS Agreement, shall be waived in relation to

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<sup>23</sup> *ibid* [3].

<sup>24</sup> *ibid* [9].

<sup>25</sup> *ibid* [10].

prevention, containment or treatment of COVID-19, for [X] years from the decision of the General Council.

2. The waiver in paragraph 1 shall not apply to the protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organizations under Article 14 of the TRIPS Agreement.

3. This decision is without prejudice to the right of least developed country Members under paragraph 1 of Article 66 of the TRIPS Agreement.

4. This waiver shall be reviewed by the General Council not later than one year after it is granted, and thereafter annually until the waiver terminates, in accordance with the provisions of paragraph 4 of Article IX of the WTO Agreement.

5. Members shall not challenge any measures taken in conformity with the provision of the waivers contained in this Decision under subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994, or through the WTO's Dispute Settlement Mechanism.

The text of the waiver request reveals a number of things about the objective and scope of the proposed waiver. Firstly, the proposal seeks a waiver of the obligations relating to the implementation and enforcement of the provisions relating to copyright, industrial designs, patent rights, and the protection of undisclosed information under the TRIPS Agreement. However, with regard to copyright, Article 14 of the TRIPS Agreement is specifically exempted from the scope of the waiver request. Secondly, the waiver is aimed at the prevention, containment, or treatment of COVID-19. Thirdly, the duration of the waiver is not specified. Understandably and unsurprisingly, the waiver proposal was supported by a number of developing countries but it was opposed by developed countries including the United States and the European

Union. However, in May 2021, the United States eventually expressed its support for the waiver proposal although this support is strictly limited to the production of vaccines.<sup>26</sup>

Subsequently, on 25 May 2021, India, South Africa, and other co-sponsors submitted a revised waiver request to the TRIPS Council. According to the co-sponsors of the revised text, the submission of the revised waiver request is aimed at facilitating ‘text-based discussions, taking into account the discussions and feedback received’.<sup>27</sup> The revised text does contain some clarifications regarding the scope and duration of the waiver proposal. The operative paragraphs of the revised waiver proposal are reproduced below:

1. The obligations of Members to implement or apply Sections 1, 4, 5 and 7 of Part II of the TRIPS Agreement or to enforce these Sections under Part III of the TRIPS Agreement, shall be waived in relation to health products and technologies including diagnostics, therapeutics, vaccines, medical devices, personal protective equipment, their materials or components, and their methods and means of manufacture for the prevention, treatment or containment of COVID-19.
2. This waiver shall be in force for at least 3 years from the date of this decision. The General Council shall, thereafter, review the existence of the exceptional circumstances justifying the waiver, and

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<sup>26</sup> See Office of the United States Trade Representative, ‘Statement from Ambassador Katherine Tai on the COVID-19 TRIPS Waiver’ (5 May 2021) available at <<https://ustr.gov/about-us/policy-offices/press-office/press-releases/2021/may/statement-ambassador-katherine-tai-covid-19-trips-waiver>> accessed 25 June 2022 (stating that, ‘The Administration believes strongly in intellectual property protections, but in service of ending this pandemic, supports the waiver of those protections for COVID-19 vaccines. We will actively participate in text-based negotiations at the World Trade Organization (WTO) needed to make that happen.’).

<sup>27</sup> WTO (Council for TRIPS) ‘Waiver from Certain Provisions of the TRIPS Agreement for the Prevention, Containment and Treatment of Covid-19’ (25 May 2021) IP/C/W/669/Rev.1.

if such circumstances cease to exist, the General Council shall determine the date of termination of the waiver.

3. The waiver in paragraph 1 shall not apply to the protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organizations under Article 14 of the TRIPS Agreement.

4. This decision is without prejudice to the right of least developed country Members under paragraph 1 of Article 66 of the TRIPS Agreement.

5. This waiver shall be reviewed by the General Council not later than one year after it is granted, and thereafter annually until the waiver terminates, in accordance with the provisions of paragraph 4 of Article IX of the WTO Agreement.

6. Members shall not challenge any measures taken in conformity with the provision of the waivers contained in this Decision under subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994, or through the WTO's Dispute Settlement Mechanism.

As can be seen from the revised text, some key changes have been made to the original text. First, while the revised waiver proposal still requests for a waiver of the obligations to implement the provisions relating to copyright, industrial designs, patent rights, and the protection of undisclosed information under the TRIPS Agreement, this aspect of the request now specifically includes a request for a waiver of the obligations to enforce these parts of the TRIPS Agreement under Part III of the TRIPS Agreement. In other words, the co-sponsors were now specifically requesting a waiver of the obligations to apply provisions of the TRIPS Agreement dealing with enforcement with regard to copyright, industrial designs, patents, and the protection of undisclosed information.

Second, the co-sponsors equally clarified the aim of the waiver. While the initial proposal was aimed at the ‘prevention, containment or treatment of COVID-19’, the revised text now states that the waiver is ‘in relation to health products and technologies including diagnostics, therapeutics, vaccines, medical devices, personal protective equipment, their materials or components, and their methods and means of manufacture for the prevention, treatment or containment of COVID-19.’

Third, the duration of the waiver is now clearly stated in the revised text. According to the revised waiver proposal, the waiver ‘shall be in force for at least 3 years from the date of this decision.’ After 3 years, the General Council shall ‘review the existence of the exceptional circumstances justifying the waiver, and if such circumstances cease to exist, the General Council shall determine the date of termination of the waiver.’ The original waiver did not clearly specify the duration of the proposed waiver.

Between October 2020 when the initial proposal for a waiver was submitted and May 2021 when the revised waiver proposal was submitted to the TRIPS Council, India and South Africa were able to secure the support of more countries. Also, as noted above, the United States equally expressed its support for the waiver albeit strictly limited to vaccines. Nevertheless, a number of other developed countries remained steadfast in their opposition to the revised waiver proposal. In this regard, the EU is worth singling out. The EU did not just oppose the revised waiver proposal, it equally submitted its own counter-proposal.

The EU’s counter-proposal is contained in two documents submitted to the TRIPS Council in June 2021. The first document is titled ‘Urgent Trade Policy Responses to the Covid-19 Crisis: Intellectual Property’ which was

submitted to the TRIPS Council on the 4th of June 2021.<sup>28</sup> The second document is a ‘Draft General Council Declaration on the TRIPS Agreement and Public Health in the Circumstances of a Pandemic’ which was submitted to the TRIPS Council on the 18th of June 2021.<sup>29</sup>

The main thrust of both documents is that the EU takes the view that a clarification of the provisions relating to compulsory licensing in Articles 31 and 31*bis* of the TRIPS Agreement is a better response to the COVID-19 pandemic. Specifically, the relevant portion of the operative paragraphs of the text of the EU’s proposed Draft Declaration provides that:<sup>30</sup>

We agree that:

- a. A pandemic is ‘a national emergency or other circumstances of extreme urgency’ within the meaning of Article 31(b) of the TRIPS Agreement. For the purposes of issuing a compulsory licence pursuant to Articles 31 and 31*bis* of the TRIPS Agreement, a Member may waive the requirement of making efforts to obtain authorization from the right holder, provided for in Article 31(b).
- b. In the circumstances of a pandemic and to support manufacturers ready to produce vaccines or medicines addressing the pandemic at affordable prices for low- and middle-income countries, a Member may provide, for the purposes of determining the remuneration to be paid to the right holder pursuant to Article 31(h) and paragraph 2 of Article 31*bis* of the TRIPS Agreement, that the remuneration reflects

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<sup>28</sup> WTO (Council for TRIPS) ‘Urgent Trade Policy Responses to the Covid-19 Crisis: Intellectual Property’ (4 June 2021) IP/C/W/680 (Communication from the European Union to the Council for TRIPS).

<sup>29</sup> WTO (Council for TRIPS) ‘Draft General Council Declaration on the TRIPS Agreement and Public Health in the Circumstances of a Pandemic’ (18 June 2021) IP/C/W/681 (Communication from the European Union to the Council for TRIPS).

<sup>30</sup> *ibid.*

the price charged by the manufacturer of the vaccine or medicine produced under the compulsory licence.

c. In the circumstances of a pandemic, for the purposes of Article 31bis and paragraph 2.c) of the Annex to the TRIPS Agreement, the exporting Member may provide in one single notification a list of all countries to which vaccines and medicines are to be supplied by the exporting Member directly or through indirect means, including international joint initiatives that aim to ensure equitable access to the vaccines or medicines covered by the compulsory licence. It shall be presumed that such joint initiatives supply those vaccines and medicines to eligible importing Members within the meaning of paragraph 1.b) of the Annex to the TRIPS Agreement.

The EU's Draft Declaration can be read as a tacit admission that the existing flexibilities in the TRIPS Agreement, especially those contained in Articles 31 and 31bis of the Agreement, are insufficient to address the needs of developing countries with regard to the COVID-19 pandemic. Nevertheless, the counter-proposals contained in the Draft Declaration arguably do not go far enough in terms of rectifying the situation.

The first point of the EU's counter-proposal, i.e., point (a), is claimed by the EU as a clarification of Article 31(b) of the TRIPS Agreement.<sup>31</sup> Article 31(b) of the TRIPS Agreement provides in part that the requirement to make efforts

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<sup>31</sup> WTO (Council for TRIPS) 'Urgent Trade Policy Responses to the Covid-19 Crisis: Intellectual Property' (4 June 2021) IP/C/W/680 [10] (noting that: 'Point (a) refers to Article 31(b) of the TRIPS Agreement, which provides that a compulsory licence may be granted if "the proposed user has made efforts to obtain authorisation from the right holder on reasonable commercial terms and conditions and that such efforts have been unsuccessful for a reasonable period of time". Article 31(b) further provides that "this requirement may be waived by a member in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use". The EU proposes to clarify that the circumstances of a pandemic fulfil the requirement of a national emergency and therefore the requirement to demonstrate the efforts to negotiate for a certain period of time can be waived. Waiving this requirement ensures that any WTO member can proceed quickly to issue a compulsory licence...').

to obtain a voluntary license from the right holder on reasonable commercial terms within a reasonable period of time prior to the grant of a compulsory license ‘may be waived by a Member in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use.’ It is not really clear how the EU’s counter-proposal offers any further clarity to the already clear text of Article 31(b) of the TRIPS Agreement. Even without the EU’s counter-proposal, it is highly doubtful whether any WTO member can seriously challenge a claim that the COVID-19 pandemic is a circumstance of national emergency or a circumstance of extreme urgency.

In relation to the second point of the EU’s counter-proposal, the EU claims that this is aimed at clarifying the provisions of Article 31(h) of the TRIPS Agreement in the context of a pandemic.<sup>32</sup> Article 31(h) of the TRIPS Agreement provides that, where a compulsory licence has been granted, ‘the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorization’. In this regard, the EU is proposing that, in the context of a pandemic, the remuneration paid to the right holder should reflect ‘the price charged by the manufacturer of the vaccine or medicine produced under the compulsory licence.’ While this is not completely unhelpful, one could however argue that the text of Article 31(h) of the TRIPS Agreement is already flexible

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<sup>32</sup> *ibid* [11] (noting that: ‘Point (b) concerns a clarification of Article 31(h) on the adequate remuneration to be paid to the right holder. Article 31(h) provides “that the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorisation”. Paragraph 2 of Article 31*bis* specifies this rule for circumstances of export to countries that lack manufacturing capacity. It provides that in a situation of a compulsory licence for export purposes the adequate remuneration is to be determined taking into account the economic value of the licence to the importing member. The EU proposes to clarify that in the circumstances of a pandemic, WTO Members can set the remuneration to the right holder at a level that reflects the price charged by the manufacturer of the vaccine or therapeutic under a compulsory licence. This would support production and supplies of vaccines and therapeutics at affordable prices to low and middle-income countries...’).

enough to permit states to do what the EU is now proposing that states should do in the context of a pandemic.

The third point of the EU's counter-proposal can be regarded as, more or less, an explicit admission of the complexities associated with using the waiver mechanism contained in Article 31*bis* of the TRIPS Agreement. This indicates that the EU concedes that, as it currently exists, Article 31*bis* of the TRIPS Agreement is quite unhelpful in the fight against COVID-19. Indeed, as at the time of writing, no WTO member has successfully used Article 31*bis* of the TRIPS Agreement in response to the COVID-19 pandemic. In its explanation of this particular aspect of its proposal, the EU stated that:

Under point (c), the EU proposes to tackle a procedural aspect of Article 31*bis* and the Annex to the TRIPS Agreement. Under the procedure established in the Annex, each eligible importing Member makes a notification to the TRIPS Council that specifies in particular the names and quantities of the product needed. At the same time, the exporting Member must also notify the Council for TRIPS of the grant of the licence, including any conditions attached to it. The exporting Member must include the information of the licensee, the product and the quantities, the duration of the licence and the "country(ies) to which the product(s) is (are) to be supplied". The EU proposes that in the circumstances of a pandemic, the WTO Members agree that the exporting Member may provide in one single notification a list of all countries to which vaccines and therapeutics are to be supplied directly ... The objective is to ensure that with a single notification providing the elements required under Article 31*bis* for transparency purposes, the export can go ahead.<sup>33</sup>

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<sup>33</sup> *ibid* [12].

While this is a welcome proposal, one wonders whether it would have been more helpful for the EU to propose an amendment of the text that is at the source of this problem, i.e., Article 31(f) of the TRIPS Agreement. Article 31(f) of the TRIPS Agreement provides that the grant of a compulsory licence should be ‘predominantly for the supply of the domestic market of the Member authorizing such use’. Thus, a proposal to, for instance, simply waive the requirements of Article 31(f) of the TRIPS Agreement in the context of a pandemic instead of tweaking the complex provisions of Article 31*bis* of the TRIPS Agreement would perhaps be a more realistic and beneficial proposal from the perspective of developing countries, especially those developing countries with insufficient or no domestic manufacturing capacity.

Thus, given the tokenistic nature of the EU’s counter-proposal in this regard, it is unsurprising that it has not helped to resolve the current impasse at the TRIPS Council regarding the debates surrounding the waiver proposal. Having considered the texts of the waiver proposal and the EU’s counter-proposal, it is now necessary to critically analyse how both sides of this debate have presented their case before the TRIPS Council.

#### **A RHETORICAL ANALYSIS OF THE TRIPS COUNCIL’S DISCUSSION OF THE WAIVER PROPOSAL**

To start with, it must be acknowledged that both sides of the debate agree that the COVID-19 pandemic is a global problem that requires a global solution. However, beyond this, the parties are not agreed on what this global solution should be. Essentially, while India, South Africa, and the other co-sponsors of the waiver proposal believe that a waiver of some of the obligations under the TRIPS Agreement is the best global solution, opponents of the waiver proposal such as the EU believe that the protection of intellectual property rights is an integral part of any global solution to the pandemic. What follows

below is a rhetorical analysis of the discussions and debates on the waiver proposal at the TRIPS Council.

As noted in the introduction, the focus will be on the contributions made by India and South Africa (as proponents of the waiver proposal) on the one hand and the EU (as opponents of the waiver proposal) on the other hand. Specifically, the rhetorical analysis shows how both sides of the debate have carefully selected issues, ideas, and facts in presenting their narratives to the TRIPS Council.<sup>34</sup> Thus, the rhetorical analysis below shows how both sides have not really presented the complete picture regarding the precise and appropriate role of intellectual property rights in the fight against COVID-19 while arguing for or against the waiver proposal at the TRIPS Council.

#### I. COVID-19 is a Global Problem that requires a Global Solution

As noted above, one point on which both sides of the waiver proposal debate seem to be agreed upon is the fact the COVID-19 pandemic is a global problem that requires a global solution.<sup>35</sup> As stressed by India at the October 2020 meeting of the TRIPS Council:

At the outset, we would like to emphasize that this is not a proposal only for India but for the global community at large. India may be having the required manufacturing capacity, the national legislations

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<sup>34</sup> Due to space constraints, only some of the key issues debated by the parties will be analysed here.

<sup>35</sup> According to South Africa, 'COVID-19 does not respect national borders; nor does it care about the gross domestic product of a country, no country in the world can insulate itself, even the best plans will be laid to waste. Let us ensure that everyone has access to effective vaccines in the shortest possible time.' WTO, Council for TRIPS, 'Minutes of Meeting', held on 23 February 2021, IP/C/M/97/Add.1, (7 April 2021), para 18. The EU equally acknowledged the fact that covid-19 requires a global solution. It noted that there was a 'need to find solutions for everyone, whether in the developed or developing countries, because it is a challenge we face together and because no one is safe until everyone is safe.' WTO, Council for TRIPS, 'Minutes of Meeting', held on 15-16 October and 10 December 2020, IP/C/M/96/Add.1, (16 February 2021), para 1026.

to cater to its needs but we believe that in a global pandemic, where every country is affected, we need a global solution.<sup>36</sup>

Nevertheless, while the proponents of the waiver proposal take the view that the waiver proposal is the best global solution,<sup>37</sup> the opponents of the waiver proposal disagree with this view.<sup>38</sup>

## II. Are Intellectual Property Rights a Barrier or a Solution?

The proponents of the waiver proposal claim that intellectual property rights are hindering or could potentially hinder access to medical products. In presenting the original waiver to the TRIPS Council in October 2020, South Africa noted that '[t]here are several reports about intellectual property rights hindering or potentially hindering timely provisioning of affordable medical products to ... patients.'<sup>39</sup> In the same vein, India pointed out that:

... there can be no denying the fact that the development of and equitable access to the tools – such as diagnostics, therapeutics,

<sup>36</sup> WTO (Council for TRIPS) IP/C/M/96/Add.1 (n 35) [1408].

<sup>37</sup> As India notes: 'Our waiver proposal represents an open and expedited global solution to allow uninterrupted collaboration in development, production and supply of health products and technologies required for an effective COVID-19 response. The Proposal is targeted and proportionate as it seeks waiver for a limited period from four specific sections of TRIPS Agreement, namely patents, copyrights, industrial designs and undisclosed information, in so far as they hinder the production of health products and technologies, for prevention, treatment and control of COVID pandemic. Every country has been taking extraordinary and unprecedented measures, unheard of before. This includes requiring weeks and months of lockdowns, imposing quarantine, nationalising private hospitals, mandating wearing of masks, seeking military help etc. Viewed against that, the waiver is definitely a proportionate response to the problem we are trying to address.' WTO (Council for TRIPS) IP/C/M/96/Add.1 (n 35) [1411]. In the same vein, South Africa contended that: '...Our TRIPS Waiver offers a global solution. The world is facing its worst ever crisis since perhaps World War II, and the response of WTO Members opposing the Waiver Proposal is to engage in "business as usual" approaches, and for WTO to do nothing to address IP monopolies around the technology and know-how, to scale up production and to bring this crisis to an end.' WTO (Council for TRIPS) IP/C/M/97/Add.1 (n 35) [13].

<sup>38</sup> As the EU pointed out: 'There is no doubt that all WTO Members agree on the objective in this global fight against the COVID pandemic: to rapidly develop and manufacture safe and effective therapeutics and vaccines and to distribute them equitably across the world as soon as possible. However, our extensive discussions have shown that our views as to the best way of achieving this objective are far apart.' WTO (Council for TRIPS) IP/C/M/97/Add.1 (n 35) [141].

<sup>39</sup> WTO (Council for TRIPS) 'Minutes of Meeting' IP/C/M/96/Add.1 (n 35) [860].

treatments, vaccines etc.– required to fight the COVID-19 pandemic are limited by IP barriers. It is quite evident from an array of lawsuits filed by private companies in different parts of the world for IP infringement on COVID-19 products. In the past few months, we have also seen that IPRs do come in the way of scaling up production of test kit reagents, ventilator valves, N95 respirators, therapeutics, fluorescent proteins and other technologies used in development of vaccines etc.<sup>40</sup>

The proponents of the waiver further claim that monopoly rights such as intellectual property rights are unnecessary for inventors to recoup their investments in situations such as the COVID-19 pandemic where governments have expended a lot of public funds on the development of medical products such as vaccines.<sup>41</sup> The EU, however, disagrees with this perspective. While acknowledging that public funding has been provided to support the development of vaccines against COVID-19, it stressed that researchers and the pharmaceutical industry have equally ‘put extraordinary efforts into the development of future treatments and vaccines against COVID-19.’<sup>42</sup> According to the EU, ‘[a] well-functioning intellectual property rights system is crucial to ensure that these efforts are adequately incentivised and rewarded.’<sup>43</sup>

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<sup>40</sup> *ibid* [867].

<sup>41</sup> *ibid* [868] (India stating that: ‘...governments across the globe are supporting development of new health technologies, in particular vaccines by pouring billions of USD of public funds into research and development ... Therefore, the often-repeated argument that monopoly rights are needed to allow the inventors to recoup their investment does not seem to apply in case of development of health products and technologies required for handling the ongoing COVID-19 crisis.’). In the same vein, South Africa contends that: ‘Never has there been a weaker case for the granting of monopolies. Governments have been funding the development of COVID drugs and vaccines, and no company is able to meet the global demand. In the context of COVID-19, despite the billions of taxpayer dollars invested in R&D, and announcements that COVID-19 vaccines should be considered a public good, no government has openly stated committed to this undertaking.’ *ibid* [1164].

<sup>42</sup> *ibid* [1027].

<sup>43</sup> *ibid*. According to the EU at [1031]: ‘...The public funding and support is contributing significantly to the development of the future vaccines, potentially within a timeframe

The EU equally questions whether intellectual property rights have been a real barrier with regard to access to COVID-19 related medical products. According to the EU, the problem here may be due to, *inter alia*, an increase in demand and the lack of manufacturing capacity:

There is no indication that IPRs issues have been a genuine barrier in relation to COVID-19-related medicines and technologies. While we agree that maintaining continued supply of such medicines and technologies is a difficult task we all face, non-efficient and underfunded healthcare and procurement systems, spike in demand and lack of manufacturing capacity or materials are much more likely to have an impact on the access to those medicines and technologies.<sup>44</sup>

Thus, in the EU's view, rather than serving as a barrier, intellectual property rights can actually play a role in expanding access to COVID-19 vaccines.<sup>45</sup> One could however argue that the debate regarding whether or not intellectual property rights are a barrier or a solution in this regard is only relevant to countries that already possess domestic manufacturing capacity to produce medicines and vaccines. Thus, for countries such as least-developed countries that are currently exempt from implementing the TRIPS Agreement<sup>46</sup> but that

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between 12 and 18 months. However, it is the researchers and the industry with their know-how, previous and current investment that will be delivering these new vaccines, including the running of clinical trials in parallel with investing in production capacity to be able to produce millions, or even billions, of doses of a successful vaccine. This work must be incentivised and adequately rewarded and the IPRs system is one the main economic incentives.').

<sup>44</sup> *ibid* [1028].

<sup>45</sup> *ibid* [1271] - [1272] (According to the EU: 'The challenges that we face are enormous. The manufacturing at huge scale, the distribution of vaccines, their storage and even their administering will test our financial capacity, our logistical skills and perhaps, most of all, our global collaboration and solidarity in the face of this crisis. We believe that the intellectual property system, with its checks and balances, does not stand in the way of these efforts. Indeed, it is part of the solution to the challenge of universal and equitable access to vaccines and COVID-19 treatments.').

<sup>46</sup> Least-developed countries were initially given ten years to implement the TRIPS Agreement (Article 66.1 of the TRIPS Agreement). This has been extended a number of times and the latest extension took place in July 2021 when they were granted a further extension till July 2034 with regard to the implementation of the TRIPS Agreement; see

equally lack domestic manufacturing capacity, the debate on this particular issue is largely irrelevant as they will still need to depend on countries with domestic manufacturing capacity for the supply of medicines and vaccines. Whether or not countries that lack domestic manufacturing capacity may nevertheless still benefit from the proposed waiver is an issue that is addressed in section 3.4 below.

### III. Are the Existing Flexibilities in the TRIPS Agreement Sufficient?

The proponents of the waiver proposal claim that the existing flexibilities contained in the TRIPS Agreement are insufficient to tackle the pandemic. They stress that even the waiver mechanism codified in Article 31*bis* of the TRIPS Agreement is unhelpful to countries with insufficient or no manufacturing capacity.<sup>47</sup> As stated by South Africa:

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WTO (Council for TRIPS) 'Extension of the Transition Period under Article 66.1 for Least Developed Country Members' (29 June 2021) IP/C/88. In a separate decision, in November 2015, least-developed countries were granted a further extension till January 2033 with regard to the provision of patent protection for pharmaceutical products; See WTO (Council for TRIPS) 'Extension of the Transition Period under Article 66.1 of the TRIPS Agreement for Least Developed Country Members for Certain Obligations with Respect to Pharmaceutical Products' (6 November 2015) IP/C/73.

<sup>47</sup> With regard to Articles 31 and 31*bis* of the TRIPS Agreement, India pointed out that: 'Article 31 compulsory licences are issued on a case-by-case, country-by-country basis according to national patent law procedures and practices. It is an impractical option if one takes into consideration the need for regional and international collaboration to scale up supply, the need to source materials from various countries, and the need for economies of scale to make manufacturing viable. We have already highlighted the limitations associated with the use of Article 31*bis*. Countries that have never utilised compulsory license or the Article 31*bis* mechanism will have to consider what are the national procedures for doing so, what to do if procedures do not exist, who should request this license, who should issue the license, what would be the adequate remuneration to be paid, what are the requirements of Article 31*bis*, can an importing country that has not implemented Article 31*bis* in its national law utilise the provision, what are the Article 31*bis* requirements for the exporting country, what are the national law requirements in the exporting country. Many a times, countries also have to deal with pressures from other trading partners and from pharmaceutical companies while dealing with such issues. Given the urgency to save lives and the time it takes to get a compulsory license implemented on ground in most of developing countries, use of this flexibility in context of COVID-19 pandemic does not present a viable solution.' WTO, Council for TRIPS, 'Minutes of Meeting', held on 15-16 October and 10 December 2020, IP/C/M/96/Add.1, (16 February 2021), [1416].

...many countries especially developing countries may face institutional and legal difficulties when using flexibilities available in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). A particular concern for countries with insufficient or no manufacturing capacity are the requirements of Article 31bis and consequently the cumbersome and lengthy process for the import and export of pharmaceutical products.<sup>48</sup>

The initial response of the EU to the claim that the existing flexibilities in the TRIPS Agreement are insufficient in the fight against COVID-19 was to disagree and instead claim that the existing flexibilities are indeed enough to respond to COVID-19. At the October 2020 meeting of the TRIPS Council, the EU contended that:

The TRIPS Agreement together with the principles endorsed in the Doha Declaration, is fit for purpose and allows for the necessary flexibilities in relation to IPRs protection, including in the case of a health emergency, such as the COVID-19 pandemic.

If all voluntary solutions failed and IP became a barrier to treatments or vaccines against COVID-19, mechanisms to overcome it are already available. The EU has consistently supported the use, where necessary and justified, of the flexibilities provided under the TRIPS

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<sup>48</sup> *ibid* [860]. This line of argument was also echoed by India at [870] ('...with regard to existing flexibilities under the TRIPS Agreement, the same are not adequate to address the fast-changing landscape of COVID-19. Of particular concern for countries with insufficient or no manufacturing capacity is Article 31bis, which is limited to pharmaceutical products, and was not designed to address challenges arising from pandemics of this scale and magnitude. Medical devices like ventilators, dialysis machines etc. that are crucial for combating the ongoing pandemic, may not be covered under the scope of Article 31bis. There is a reason why the Special Compulsory Licensing system has been used only once. Requirements under this System that exporters and importers have to comply with, are extremely onerous and time-consuming, thereby rendering it of no practical utility towards handling the ongoing pandemic.').

Agreement and the Doha Declaration with the objective of ensuring effective access to medicines.

In particular, the TRIPS Agreement provides for the possibility, under certain conditions, of issuing a compulsory licence for local consumption of medicines and provides for fast-track procedures in health emergencies. The TRIPS Council Secretariat has, regularly and consistently, offered its services to any WTO Member that sees itself in the need of getting help to manage the process of Article 31bis. This was confirmed in the presentation we saw the previous day.

This system is accompanied by other inbuilt TRIPS flexibilities, applying to the various IP rights. In addition, we note that the least developed countries are exempt from the application of the TRIPS Agreement and, in particular, its pharmaceutical-related provisions.<sup>49</sup>

In response to this, South Africa countered by restating its previous position that the existing flexibilities are not enough and that the waiver proposal offers the best global solution in the circumstances:

We heard the refrain from the EU and others that the TRIPS Agreement is fit for purpose and its flexibilities are usable without limitation or any problem? We once again contest this this notion. Delegations that have taken the floor to condemn this waiver proposal claim that that TRIPS flexibilities already include the option to issue compulsory licences where necessary.

The proposal for a waiver on certain IP provisions offers an expedited, open and automatic global solution that allows for uninterrupted collaboration in development and scale up of production and supply and that collectively addresses the global challenge facing all countries. Countries should continue to use TRIPS flexibilities to

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<sup>49</sup> *ibid* [1038] – [1041].

safeguard public health, including issuing compulsory licences and placing limitations on or making exceptions to exclusive rights.

However, the “case by case” or “product by product” approach required when using flexibilities to address IP barriers at the national level could be limiting during the pandemic. Some countries also face limitations with respect to their national laws, pressures from their trading partners, or lack the practical and institutional capacity required to exercise TRIPS flexibilities during the pandemic quickly and effectively. The existing mechanisms for compulsory licences under Article 31 and Article 31bis of the TRIPS Agreement contain territorial and procedural restrictions that make the practice of issuing product-by-product compulsory licences a complex process, making it difficult for countries to collaborate. Article 31 requires that compulsory licences are issued on a case-by-case basis and used predominantly to supply domestic markets, thereby limiting the ability of manufacturing countries to export to countries in need.

Article 31bis requires that any product produced and exported under a compulsory license be identified with specific packaging and quantities, which can lead to unnecessary delays in the context of COVID-19 where countries need urgent access to medical tools. There is even less experience in areas such as industrial designs, trade secrets, algorithms and copyright, applying compulsory licences to such areas may be legally complicated and novel.<sup>50</sup>

The EU however eventually changed its tone regarding the difficulties experienced by developing countries with the use of the existing flexibilities under the TRIPS Agreement. At the meeting of the TRIPS Council in June 2021, the EU presented its own counter-proposal to the waiver proposal

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<sup>50</sup> *ibid* [1153] – [1156].

which centres on clarifying the rules regarding compulsory licensing in Articles 31 and 31*bis* of the TRIPS Agreement.<sup>51</sup> As pointed out in section 2 above, one can construe the counter-proposal contained in the EU's Draft Declaration as a tacit admission that the existing flexibilities in the TRIPS Agreement are insufficient to address the needs of developing countries with regard to the COVID-19 pandemic. The tokenistic nature of this counter-proposal has already been examined in section 2 above and will, therefore, not be repeated here.

The proponents of the waiver proposal are, therefore, correct in highlighting the fact that developing countries have experienced difficulties with using the flexibilities contained in the TRIPS Agreement. Indeed, the waiver mechanism codified in Article 31*bis* of the TRIPS Agreement has only been used once prior to the COVID-19 pandemic and (as at the time of writing) it has in fact not yet been successfully employed by any country in the context of the COVID-19 pandemic.

Nevertheless, one could also argue that without domestic manufacturing capacity, a number of the flexibilities in the TRIPS Agreement may not be particularly helpful. In this regard, it should be recalled that least-developed countries are currently exempt from implementing the TRIPS Agreement but this does not mean that they have the capacity to produce medicines and vaccines. Thus, even if the proposed waiver is adopted, the fact still remains

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<sup>51</sup> WTO, Council for TRIPS, 'Minutes of Meeting', held on 8, 9, and 29 June 2021, IP/C/M/100/Add.1, (20 October 2021), [279] (According to the EU: 'The discussions in the Council for TRIPS since the start of the COVID-19 pandemic have identified aspects related to the use of compulsory licensing that, in the view of a number of WTO Members, limit the use of this tool. In order to address these aspects, provide more legal certainty and enhance the effectiveness of the system, the EU considers that all WTO Members should be ready to agree on the following: first, the pandemic is a circumstance of national emergency and therefore the requirement to negotiate with the right holder may be waived; second, to support manufacturers ready to produce vaccines or therapeutics at affordable prices, especially for low- and middle-income countries, on the basis of a compulsory licence, the remuneration for patent holders should reflect such affordable prices; and third, the compulsory licence could cover any exports destined to countries that lack manufacturing capacity...').

that several least-developed countries would still be dependent on other countries that possess domestic manufacturing capacity for the supply of medicines and vaccines.

IV. Will the Proposed Waiver Help Countries that Lack Manufacturing Capacity?

A key claim of the proponents of the waiver proposal is that the waiver would be helpful to countries that possess insufficient or no manufacturing capacity. As India contended at the TRIPS Council meeting in October 2020 when the initial waiver request was presented to the Council: ‘we would like to emphasize that this proposal is, particularly important to cater for those who have insufficient or no manufacturing capacities in the health products required to combat the COVID crisis.’<sup>52</sup> At the meeting of the TRIPS Council in February 2021, South Africa also argued that the waiver proposal would help countries to tap into unused production capacity:

The Waiver Proposal constitutes a very real compromise that will immediately enable countries to tap into unused production capacity by accessing spare capacity in the developing world which will satisfy the ongoing demand for COVID-19 vaccines (including therapeutics and diagnostics) and will also negate the need for any donations from rich countries. Take the African continent for example: as a whole, Africa currently imports more than 80% of its pharmaceutical and medical consumables. This is unsustainable and puts the continental population of 1.3 billion people at the mercy of a few monopolistic companies. This is a recipe for disaster as we have witnessed not only

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<sup>52</sup> WTO, Council for TRIPS, ‘Minutes of Meeting’, held on 15-16 October and 10 December 2020, IP/C/M/96/Add.1, (16 February 2021), [865].

with the COVID-19 pandemic but with all other diseases and pandemics that continue to affect the continent.<sup>53</sup>

At the same meeting, India equally stated that, '[i]f the existing global manufacturing capacity can be used for mass manufacturing by providing legal certainty to manufacturers over [the] use of COVID-related IP, which is the chief objective of the Waiver, then humanity can accelerate the fight to win over the virus.'<sup>54</sup> However, India seems to have tacitly admitted that implementing the waiver alone may not necessarily be enough to increase global manufacturing capacity for the production of vaccines as the scaling up of production capacity may require further investments to either enhance existing capacity or to create new capacity:

...Once the Waiver is in place, the existing manufacturing capacity worldwide can be put to immediate use for production of COVID products. Our past experience suggests that if supported with adequate regulatory framework, vaccines are relatively quick and inexpensive to make. The other option is to scale up the existing capacity through brown-field investments which can be done in a few months. Yet another option is to invest in creating new capacity through green-field investments, a matter of a few quarters.<sup>55</sup>

The proponents of the waiver proposal further contend in this regard that voluntary licences are not the best way to expand manufacturing capacity in response to COVID-19 due to the unwillingness of pharmaceutical companies to offer non-exclusive licenses with worldwide coverage.<sup>56</sup> Thus, in the view

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<sup>53</sup> WTO, Council for TRIPS, 'Minutes of Meeting', held on 23 February 2021, IP/C/M/97/Add.1, (7 April 2021), [17].

<sup>54</sup> *ibid* [69].

<sup>55</sup> *ibid* [75].

<sup>56</sup> WTO, Council for TRIPS, 'Minutes of Meeting', held on 15-16 October and 10 December 2020, IP/C/M/96/Add.1, (16 February 2021), [869] (India stating that: '...we have heard from some Members in the previous meetings that voluntary licenses are the most appropriate solution to scale up manufacturing in response to COVID-19. However, the fact remains that not a single IP holder has shown willingness to commit to the COVID-19 Technology Access

of the proponents of the waiver proposal, only the proposed waiver can help to scale up manufacturing capacity across the globe.

The EU however takes the view that voluntary licensing, and not the waiver proposal, can help to expand the manufacturing of COVID-19 vaccines. According to the EU:

What is most needed now, beyond developing vaccines, is the ramping up of manufacturing of vaccines and the best way of achieving that is by disseminating the technology and know-how of those who developed the vaccines through licensing arrangements. Manufacturing cannot take place without the required technology and know-how. In addition, we need these vaccines to be produced in a manner that ensures their efficacy and safety. Intellectual property is a key factor in providing a framework that enables these arrangements. Developers of vaccines can enter into manufacturing agreements, transfer technology and expand production with their licensees. Our main concern is that suspending the relevant IP rights will not enhance such collaboration and manufacturing but, to the contrary, will slow it down or even block it, to the detriment of all.<sup>57</sup>

In addition, the EU contended that, even if there is underused capacity anywhere in the world, the best way to utilise this capacity is through the

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Pool (C-TAP) and the ACT-Accelerator voluntary initiatives launched under the aegis of WHO. In fact, the representative from WHO in the Council admitted in response to a question that no pharmaceutical company has committed to sharing its IP and technologies in the C-TAP pool since its launch more than five months ago. Given the refusal by pharmaceutical industry to routinely offer nonexclusive licenses with worldwide coverage to facilitate global access, clearly the solution to ending the pandemic does not lie in voluntary licenses.’). In the same vein, South Africa notes that: ‘IP rights can be exercised by their owners to decide on whether to grant a license or withhold from licensing the technology, designs and knowhow required for manufacturing or for further developing the products required for COVID-19. By enforcing exclusive rights backed by IP, such as patents, pharmaceutical companies slow down research and innovation. The use of restrictive voluntary license terms limits the catching up and innovation made by generic competitors.’ *ibid* [1159].

<sup>57</sup> *ibid* [1274].

transfer of technology and know-how and this can only be facilitated by intellectual property rights which provide a basis for collaboration.<sup>58</sup> In this regard, the EU pointed out the examples of some pharmaceutical companies that had already entered into partnerships with companies in developing countries to facilitate the manufacturing and distribution of vaccines:

Many pharmaceutical companies have committed publicly and are already working closely with governments to ensure that the vaccines will be available and affordable to all who need them. We also see agreements on expanding manufacturing capacity, we understand that e.g. AstraZeneca entered into agreements with companies in various countries to support the manufacturing, procurement and distribution of vaccines. It also entered into a technology transfer agreement with Serum Institute of India to supply doses for low and middle-income countries. We also understand that Johnson & Johnson entered into manufacturing service agreements for large-scale manufacturing for its vaccines. And there are other examples, also as regards collaboration to increase manufacturing of promising COVID-19 therapeutics.<sup>59</sup>

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<sup>58</sup> The EU notes in this regard that: ‘Where such capacity exists and can be deployed quickly, the best way of using it to the fullest is by disseminating the technology and know-how of those who developed the vaccines through a collaboration with other companies that can contribute to the developers’ manufacturing capacity. Intellectual property is a key factor in providing a framework that enables this collaboration. This is because the IP system is crucial in providing a legal framework for the collaboration and dissemination of any new technology. The objective of an IP system is not merely to create exclusivity for the owner of intellectual property, but also to ensure the publication and dissemination of research results when otherwise they would remain secret. And this dissemination is precisely what we need now. The IP system enables commercialisation of the research results and their transfer through licensing agreements. Developers of vaccines can enter into manufacturing agreements, transfer technology and expand production with their licensees.’ WTO, Council for TRIPS, ‘Minutes of Meeting’, held on 23 February 2021, IP/C/M/97/Add.1, (7 April 2021), [152] – [153].

<sup>59</sup> WTO, Council for TRIPS, ‘Minutes of Meeting’, held on 15-16 October and 10 December 2020, IP/C/M/96/Add.1, (16 February 2021), [1275].

It is not really clear how the proposed waiver would help countries with no or insufficient domestic manufacturing capacity. Crucially, even if the waiver can help to increase manufacturing capacity in other countries that possess such capacity, it is not entirely clear how private pharmaceutical companies can be compelled to disclose the necessary know-how and trade secrets that may be required to produce medical products such as vaccines.

Indeed, the EU had requested the proponents of the waiver proposal to ‘explain in more detail how concretely the waiver could operate with regard to the vaccine production, including the transfer of the required technology and know-how’.<sup>60</sup> In response to this, India contended that:

...The EU has sought an explanation as to how the waiver could operate with regard to the vaccine production, including the transfer of the required technology and know-how...

...In the area of vaccines, there are two primary barriers, patents and protection of undisclosed information. Patents are used to protect various aspects of the underlying technology as well as the product itself.

In addition, manufacturing know-how, test data, and cell lines are needed to facilitate diversification of vaccine production. Hence the importance of addressing protection of undisclosed information under Article 39 of the TRIPS Agreement.

The wide range of patents and patent applications as well as exclusivity related to undisclosed information creates a complex and uncertain legal environment for scaling up vaccine development, production and supply. The waiver, if granted, would provide potential manufacturers the freedom to operate and achieve

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<sup>60</sup> *ibid* [1283].

economies of scale, thereby incentivizing production and supply of therapeutics and vaccines.<sup>61</sup>

While it is true that a waiver may make things easier for other potential manufacturers, besides the owners of patent rights, to engage in vaccine production, India's response does not actually provide a concrete answer to the question of how private pharmaceutical companies with know-how and trade secrets regarding the production of vaccines can be compelled to transfer such to other manufacturers. This may not be a problem when it comes to the production of patented medicines. But it may arise with regard to the production of vaccines.<sup>62</sup> If a key objective of the waiver proposal is to ramp up the production of vaccines, then this is a problem that requires a viable solution.

Thus, it is unclear how a waiver would be useful with regard to the production of vaccines as patent rights are quite distinct from trade secrets and know-how. It is true that there could be some potential shortcomings in relation to relying on voluntary licences such as the inclusion of restrictive terms in licensing agreements or the inclusion of restrictions with regard to the territories where the licensed products can be supplied to. It is however far from certain that simply waiving intellectual property rights (in particular, the protection of undisclosed information) would encourage or compel private

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<sup>61</sup> *ibid* [1419] – [1422]; South Africa also did not provide a satisfactory answer to this question. It simply stated in this regard that: 'It is also worth recalling that Article 31 and 31*bis* only address patent barriers while there are also challenges with respect to protection of undisclosed information, a barrier which remains unaddressed. Our colleagues have addressed problems surrounding Article 39.3 so I will not go into the matter further.' *ibid* [1494].

<sup>62</sup> As the EU pointed out: 'Contrary to simple chemical medicines that are relatively easy to replicate, COVID-19 vaccines involve a complex biological process which requires the relevant know-how.' WTO, Council for TRIPS, 'Minutes of Meeting', held on 8, 9, and 29 June 2021, IP/C/M/100/Add.1, (20 October 2021), [275].

pharmaceutical companies to disclose their technical know-how or trade secrets to other potential manufacturers.<sup>63</sup>

### CONCLUSION

In sum, a rhetorical analysis of the debates and discussions of the proposed waiver at the TRIPS Council between October 2020 and June 2021 reveals a number of things. First, both the proponents and the opponents of the waiver proposal agree that the COVID-19 pandemic is a global problem that requires a global solution. However, they differ with regard to what the appropriate global solution should be. Proponents of the waiver proposal believe that the waiver proposal is the best solution but opponents of the waiver proposal disagree with this.

Second, whether or not intellectual property rights are a barrier or a solution with regard to tackling the COVID-19 pandemic is only relevant to countries that possess domestic manufacturing capacity. Third, despite the difficulties with using the existing flexibilities in the TRIPS Agreement, only countries that possess domestic manufacturing capacity can even meaningfully consider utilising the existing flexibilities in the TRIPS Agreement to produce medicines and vaccines to combat COVID-19.

Fourth, a key claim of the proponents of the waiver proposal is that the proposed waiver would be helpful to countries that possess insufficient or no manufacturing capacity because it would help to scale up manufacturing capacity across the globe. However, even if it is true that there is unused production capacity waiting to be unlocked after the proposed waiver is

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<sup>63</sup> Of course, it may be possible to produce vaccines without the transfer of know-how or trade secrets through the process of reverse-engineering. This would however only require the waiver of the obligations relating to patent rights but not the waiver of the obligations regarding the protection of undisclosed information. The key point being made here is that it is not entirely clear from the narratives of the proponents of the waiver how the waiver of the obligations regarding the protection of undisclosed information would necessarily compel or encourage pharmaceutical companies to transfer the required know-how and trade secrets that may be needed for the production of vaccines to other potential manufacturers.

adopted at the WTO, it is unclear how the proposed waiver can compel or encourage pharmaceutical companies to disclose and share the technical know-how and trade secrets that may be required to produce vaccines. In this regard, the proponents seem to be conflating patent rights with the protection of undisclosed information. Fifth, the counter-proposal of the EU is merely tokenistic in nature and it would not make any significant difference to the situation of countries that lack domestic manufacturing capacity to produce medicines and vaccines.

Thus, it appears that the members of the TRIPS Council are once again engaged in 'rhetorical action' which is unlikely to produce any meaningful solution. As can be seen from the above, both the proponents and the opponents of the proposed waiver are not really attempting to present a full and complete picture of the precise and appropriate role of intellectual property rights in the fight against COVID-19. Both sides seem content in presenting their carefully crafted narratives to the TRIPS Council.

Importantly, a more viable solution that may be useful both to countries that possess manufacturing capacity and those that do not is, perhaps, an amendment of Article 31(f) of the TRIPS Agreement to permanently remove the requirement that compulsory licences should 'predominantly' be used 'for the supply of the domestic market of the Member authorizing such use'. The removal of this requirement can be specifically limited to situations such as when there is a pandemic like the COVID-19 pandemic. This would enable states with domestic manufacturing capacity to grant compulsory licenses that can be used to export products like medicines and vaccines to other countries that lack domestic manufacturing capacity. Crucially, under this proposal, states with domestic manufacturing capacity can use the threat of compulsory licensing as a leverage to obtain better terms for voluntary licences from pharmaceutical companies.

It is further suggested here that developing and least-developed countries should equally intensify their efforts with regard to improving their national and regional capacities to produce medicines and vaccines. Ultimately, enhancing a country's domestic manufacturing capacity is one crucial way to unlock that country's ability to make use of the existing flexibilities under the TRIPS Agreement. In this regard, the initiative being spearheaded by the World Health Organization (WHO) to boost the manufacturing capacity of countries in Africa and in other developing countries outside Africa in order to help them produce vaccines is a welcome development.<sup>64</sup> It is worth pointing out that one of the reasons why India has been able to make use of the flexibilities in the TRIPS Agreement<sup>65</sup> is because it does possess domestic manufacturing capacity.

#### POSTSCRIPT

After this article was written, but prior to its publication, WTO members adopted a TRIPS waiver decision at the Twelfth Ministerial Conference in June 2022.<sup>66</sup> As highlighted below, a critical assessment of the text of the TRIPS waiver decision confirms the thesis of the article that, considering the engagement in 'rhetorical action' by both sides of the COVID-19 waiver

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<sup>64</sup> WHO, 'WHO Announces First Technology Recipients of mRNA Vaccine Hub with Strong Support from African and European Partners' (18 February 2022) available at <<https://www.who.int/news/item/18-02-2022-who-announces-first-technology-recipients-of-mrna-vaccine-hub-with-strong-support-from-african-and-european-partners>> accessed 24 June 2022; WHO, 'Moving Forward on Goal to Boost Local Pharmaceutical Production, WHO Establishes Global Biomanufacturing Training Hub in Republic of Korea' (23 February 2022) available at <<https://www.who.int/news/item/23-02-2022-moving-forward-on-goal-to-boost-local-pharmaceutical-production-who-establishes-global-biomanufacturing-training-hub-in-republic-of-korea>> accessed 25 June 2022.

<sup>65</sup> Emmanuel Oke, 'Exploring the Flexibilities in TRIPS: Lessons from India's Pharmaceutical Patent Law,' (2015) 41(1) *Commonwealth Law Bulletin* 82.

<sup>66</sup> See, WTO, Ministerial Conference, Twelfth Session, 'Draft Ministerial Decision on the TRIPS Agreement', WT/MIN(22)/W/15/Rev.2 (17 June, 2022). It should be noted that this waiver decision is largely based on the outcome of informal quadrilateral negotiations between the United States of America, the European Union, India, and South Africa. See, WTO, Council for TRIPS, 'Communication from the Chairperson', IP/C/W/688, (3 May 2022).

proposal debate, it is highly likely that any outcome or agreement may be an unworkable or unhelpful agreement.

The provisions of the TRIPS waiver decision are far from the demands contained in the revised waiver proposal submitted by India and South Africa. Indeed, one could plausibly argue that the waiver decision is closer to the positions of both the EU and the US in this regard. In other words, the waiver decision merely provides some concessions regarding the rules governing compulsory licensing contained in Article 31 of the TRIPS Agreement and its scope is limited to the production and supply of COVID-19 vaccines. Specifically, paragraph 1 of the waiver decision provides that:

Notwithstanding the provision of patent rights under its domestic legislation, an eligible Member<sup>1</sup> may limit the rights provided for under Article 28.1 of the TRIPS Agreement (hereinafter "the Agreement") by authorizing the use of the subject matter of a patent<sup>2</sup> required for the production and supply of COVID-19 vaccines without the consent of the right holder to the extent necessary to address the COVID-19 pandemic, in accordance with the provisions of Article 31 of the Agreement, as clarified and waived in paragraphs 2 to 6 below.

Nevertheless, when compared with the permanent waiver codified in Article 31*bis* of the TRIPS Agreement, one could say that the provisions of the waiver decision are not as cumbersome and complex as the provisions contained in Article 31*bis* of the TRIPS Agreement.

In terms of aspects of the TRIPS waiver decision that may be considered as positive or gains for proponents of the waiver request, a few points are worth pointing out. Paragraph 2 of the waiver decision allows an 'eligible Member' to 'authorize the use of the subject matter of a patent under Article 31 without the right holder's consent through any instrument'. So, this could be done via executive orders, emergency decrees, government use authorisations, and

judicial or administrative orders. In this regard, the ‘law of a Member’ pursuant to Article 31 of the TRIPS Agreement is deemed as not limited to legislative acts for the purposes of the waiver decision.

Perhaps, the most significant concession in the waiver decision can be found in paragraph 3(b) which permits an eligible member to ‘waive the requirement of Article 31(f) that authorized use under Article 31 be predominantly to supply its domestic market’. Paragraph 3(b) goes on to provide that an eligible member ‘may allow any proportion of the products manufactured under the authorization in accordance with this Decision to be exported to eligible Members, including through international or regional joint initiatives that aim to ensure the equitable access of eligible Members to the COVID-19 vaccine covered by the authorization.’ This is a crucial departure from the strictures codified in Article 31*bis* of the TRIPS Agreement which was ironically originally intended to address the problems associated with Article 31(f) of the TRIPS Agreement especially for countries with no or insufficient domestic manufacturing capacity. Although the scope of the waiver decision is currently limited to the production of vaccines, paragraph 3(b) of the waiver decision is an implied admission of the practical difficulties associated with the use of Article 31*bis* of the TRIPS Agreement.

According to paragraph 6 of the waiver decision, eligible members can apply the provisions of the waiver decision ‘until 5 years from the date of this Decision.’ The second sentence of paragraph 6 states that the duration of the waiver decision may be extended by the WTO’s General Council. Another positive aspect of the waiver decision can be found in paragraph 4 which provides that: ‘Recognizing the importance of the timely availability of and access to COVID-19 vaccines, it is understood that Article 39.3 of the Agreement does not prevent an eligible Member from enabling the rapid approval for use of a COVID-19 vaccine produced under this Decision.’ One could however contend that this merely confirms the existing flexibilities in

Article 39.3 of the TRIPS Agreement, although it is certainly helpful to clarify this in the text of the waiver decision.

An examination of what could be perceived as the negative aspects of the TRIPS waiver decision provides an insight as to why it may be considered to be a compromise that may not necessarily be helpful in the fight against COVID-19. First, whereas the waiver proposal requests for the waiver of obligations relating to copyright, patents, industrial designs and the protection of undisclosed information, the waiver decision only covers the compulsory licensing of patents.

Second, as noted previously, the scope of the TRIPS waiver decision is limited in paragraph 1 to the production and supply of COVID-19 vaccines. Furthermore, paragraph 8 of the waiver decision provides that: ‘No later than six months from the date of this Decision, Members will decide on its extension to cover the production and supply of COVID-19 diagnostics and therapeutics.’ It is unclear why it was deemed necessary to postpone the decision on diagnostics and therapeutics to a later date.

Third, the definition of an ‘eligible Member’ in footnote 1 of the waiver decision is quite restrictive to say the least. While the first sentence of footnote 1 states that all developing country members are eligible members, the second sentence of footnote 1 goes on to state that: ‘Developing country Members with existing capacity to manufacture COVID-19 vaccines are encouraged to make a binding commitment not to avail themselves of this Decision.’ So, on the one hand, only developing countries are eligible members; on the other hand, those developing countries with manufacturing capacity are not supposed to use this waiver decision. This, in a sense, undermines the waiver of Article 31(f) of the TRIPS Agreement in paragraph 3(b) of the TRIPS waiver decision.

Fourth, while the waiver proposal requests for the waiver of all obligations relating to the protection of undisclosed data, the TRIPS waiver decision only addresses Article 39.3 of the TRIPS Agreement in its paragraph 4. Fifth, there are equally obligations regarding taking reasonable efforts to prevent the re-exportation of vaccines imported via this waiver decision (paragraph 3(c)) and to notify the TRIPS Council of any measures adopted pursuant to this waiver decision (paragraph 5). Although it should also be noted that footnote 3 of the waiver decision provides that: ‘In exceptional circumstances, an eligible Member may re-export COVID-19 vaccines to another eligible Member for humanitarian and not-for-profit purposes, as long as the eligible Member communicates in accordance with paragraph 5.’

**COMPARATIVE ANALYSIS OF JUDICIAL  
ENFORCEMENT OF TRADEMARK LAWS IN MAURITIUS  
WITH INDIA AND SOUTH AFRICA**

Veera Singh\*

*Abstract*

*Counterfeit hotspots in the form of physical marketplaces in Mauritius are a testament to its struggle with the rampant trade of counterfeit products. With references to the new Industrial Property Act 2019 passed by Mauritius, this paper examines the decisions of Mauritian civil courts while enforcing trademark laws and studies whether such decisions efficiently curb the illegal trade of counterfeit goods as compared to corresponding measures undertaken by India and South Africa. The paper uses a comparative methodology to draw on differences in approach between Mauritian civil courts and its Indian as well as South African counterparts while dealing with trademark infringement cases. It then examines the effectiveness of the civil remedies granted by Mauritian courts to deal with, inter alia, infringement of and brand names, treatment of well-known. It is followed by a brief look into how Indian and South African courts dealt with the same issues. The paper reflects on the manner in which the courts make up for any deficiencies in the law and help in achieving objectives outlined by the Mauritian IP-Policy. While there is no best formula to curb the illegal trade of counterfeit goods, the paper suggests that studying Indian and South African case-decisions could assist in incorporating their best practices in Mauritian judicial decisions to tackle a common enemy i.e., trademark infringement. This endeavour would entail creative tailoring of civil remedies based on the facts of each case.*

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\* JD Candidate at Sidney Law School, University of Sydney.

## BACKGROUND

Trademarks are primarily used to condition the consumers to expect a certain quality from the product that bears the mark and identify it among others. The practice can be traced back to Ancient Romans marking their most valued product, wine, with a trident-pattern mark or inscriptions on the jug describing its origins and manufacturer-details<sup>1</sup>.

Counterfeiting is a kind of theft that harms the IP-holder as well as its users. For instance, the financial proceeds from the sale of the counterfeit article never reach the IP-holder even if the counterfeiter used the mark without permission and profited from the sale of a knock-off or use of the IP-holder's mark. Moreover, since the counterfeit product is not subjected to any industrial regulatory standards, the consumer may end up with a sub-standard product, quality-wise. There are two situations where a counterfeit product is sold: one where the consumer is deceived into believing the good is genuine and one where the consumer is aware the product is not original.<sup>2</sup> In the first scenario, the fact that the consumer does not intend to breach the IP holder's right makes it difficult for the consumer to partake in the counterfeiting. However, in the second scenario, the case is of non-deceptive counterfeiting, and it is a major driving force behind creating a demand for such products despite its illegal nature.<sup>3</sup>

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<sup>1</sup> Benjamin G. Paster, 'Trademarks – Their Early History: Part I' (1969) 59 Trademark Reporter 551.

<sup>2</sup> Gene M Grossman and Carl Shapiro, 'Foreign Counterfeiting of Status Goods' (National Bureau of Economic Research, 1985) <[https://www.nber.org/system/files/working\\_papers/w1915/w1915.pdf](https://www.nber.org/system/files/working_papers/w1915/w1915.pdf)> accessed 5 September 2022.

<sup>3</sup> Nicolas Hamelin, Sonny Nwankwo and Rachad El Hadouchi, 'Faking Brands: Consumer Responses to Counterfeiting' (2012) 12(3) Journal of Consumer Behaviour <[https://onlinelibrary.wiley.com/doi/full/10.1002/cb.1406?saml\\_referrer](https://onlinelibrary.wiley.com/doi/full/10.1002/cb.1406?saml_referrer)> accessed 5 September 2022.

Yet, the illegal business grows due to the average consumer's desire to own fake-branded products at a much cheaper price. As per the statistics released by Organization for Economic Cooperation and Development (OECD) and EU Intellectual Property Office (EUIPO)<sup>4</sup> on seizures by custom authorities, the fake items that were mostly seized were footwear, clothing, leather goods, and electrical machinery and electronic equipment. In June 2021, OECD and the EUIPO jointly published a report titled 'Global Trade in Fakes', that estimated that counterfeit and pirated goods accounted for about 2.5 percent of world trade in 2019, which amounts to about US\$464 billion.<sup>5</sup>

Mauritius is among several other countries that are battling the rampant instances of counterfeiting in its physical marketplaces.<sup>6</sup> Mauritius has enacted legislations that comply with the WTO requirements and has also incorporated TRIPS within its provisions. Mauritius' marketplaces, still, are havens for counterfeit items, this is influenced by social, economic, political and historical factors which are unique to Mauritius.<sup>7</sup>

#### I. Choosing India and South Africa as Comparators.

Mauritius shares a common political history and legal origin with India and South Africa, since they were under British Rule hence, their legal system bears features of English Common Law. India and South Africa gained independence from British rule in 1947 and 1961, respectively, around the same time as Mauritius, in 1968. Importance of this period stems from fact that when the European nations entered into multilateral agreement to protect

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<sup>4</sup> Organisation for Economic Cooperation and Development (OECD) and EU Intellectual Property Office (EUIPO), 'Global Trade in Fakes' (OECD Publishing, 22 June 2021) <<https://www.oecd.org/gov/global-trade-in-fakes-74c81154-en.htm>> accessed 8 June 2022.

<sup>5</sup> *ibid.*

<sup>6</sup> Tim Lince, 'Counterfeit Hotspots in Mauritius That Brand Owners Must Be Aware Of' (World Trade Mark Review, 30 July 2020) <<https://www.worldtrademarkreview.com/anti-counterfeiting/counterfeit-hotspots-in-mauritius-brand-owners-must-be-aware-of/>> accessed 8 June 2022.

<sup>7</sup> *ibid.*

their IP interests in 1883<sup>8</sup> their colonies in Africa and Asia automatically found themselves bound by an international intellectual property framework.<sup>9</sup> By the time Mauritius, India and South Africa emerged as independent states they inherited a body of domestic laws formulated by the English along with obligations inherited from international agreements. This essentially gave all three countries, more or less, the same jumpstart to build their IP regime. Notably, all three countries struggle with trade of counterfeit goods despite a comprehensive body of laws governing IP rights.

India and South Africa gained independence from British -rule in 1947 and 1961, respectively, i.e., around the same time as Mauritius, in 1968. The importance of these years is buoyed increased by the fact that when the European nations decided to enter into multilateral agreement to protect their IP interests in 1883,<sup>10</sup> their colonies in Africa and Asia automatically found themselves under the aegis of the bound by the international intellectual property framework system.<sup>11</sup> By the time Mauritius, India and South Africa emerged as independent states they already had domestic laws formulated by the English along with obligations inherited from international agreements. This essentially gave all three countries, more or less, the same jumpstart to build their IP regime.

Notably, all three countries struggle with trade of counterfeit goods despite a comprehensive body of laws governing IP rights.

## II. Economic Disparity and Culture of Buying Counterfeit Goods

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<sup>8</sup> Paris Convention for the Protection of Industrial Property (adopted on March 20, 1883, entered into force September 24, 1976) 828 UNTS 305 [hereinafter Paris Convention].

<sup>9</sup> Okediji R, 'The International Relations Of Intellectual Property: Narratives Of Developing Country Participation In The Global Intellectual Property System' (2003) 7 Singapore Journal of International & Comparative Law 315 <<http://www.commonlii.org/sg/journals/SGJIntCompLaw/2003/14.pdf>> accessed 25 April 2022

<sup>10</sup> Paris Convention (n 8).

<sup>11</sup> Okediji R (n 9).

There are two situations where a counterfeit product is sold: i.e., one where the consumer is deceived into believing the good is genuine and one where the consumer is aware the product is not original.<sup>12</sup> In the former case the fact that the consumer does not intend to breach the IP -holder's right makes it difficult for the consumer to partake in the counterfeiting. However, in the latter scenario, the case is of non-deceptive counterfeiting, and it is a major driving force behind creating a demand for the such products despite its illegal nature.<sup>13</sup>

Counterfeiting is generally attributed to the average-earning consumer's desire to show that they belong to a particular social class, and in the process give up the functional aspect i.e., buy the lower quality of the product in exchange for the status associated with the brand.<sup>14</sup> This tendency neatly ties in with the fact that countries with high disparity in distribution of wealth are breeding grounds for non-deceptive counterfeiting.<sup>15</sup> In Mauritius, the disparity in wealth distribution is discussed in the same breath as high economic growth due to a 'progressive shift' from traditional and low skill sectors. This shift resulted in skilled workers being paid a lot more, thus widening the income gap with respect to poorer households.<sup>16</sup> Similarly, India is home to about 119 billionaires where the top 10% of the population holds 77% of the total national income.<sup>17</sup> The income inequality in South

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<sup>12</sup> Gene M Grossman and Carl Shapiro (n 2).

<sup>13</sup> Nicolas Hamelin, et al (n 3).

<sup>14</sup> Ammar Hussain, Alexander Kofinas and Sandar Win, 'Intention to Purchase Counterfeit Luxury Products: A Comparative Study Between Pakistani and The UK Consumers' (2017) 29(5) *Journal of International Consumer Marketing* 331.

<sup>15</sup> Chen L, Lian Z and Yao S, '*Consumer Status Signalling, Wealth Inequality and Non-deceptive Counterfeits*' (2021) SSRN <[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3889503](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3889503)> accessed 1 August 2022.

<sup>16</sup> World Bank, 'Mauritius: Earnings Mobility and Inequality of Opportunity in The Labor Market in Four Charts' (2021) <<https://www.worldbank.org/en/country/mauritius/publication/mauritius-earnings-mobility-and-inequality-of-opportunity-in-the-labor-market-in-four-charts>> accessed 5 September 2022.

<sup>17</sup> Oxfam India, 'India: Extreme Inequality in Numbers' (Oxfam, 2017) <<https://www.oxfam.org/en/india-extreme-inequality-numbers>> accessed 1 September 2022.

Africa also is so out of control that 20% of the richest population controls almost 70% of the resources.<sup>18</sup> This economic disparity common to the 3 countries, actively fosters non-deceptive counterfeiting which causes a substantial loss to each economy. In 2019, Mauritian Customs Department seized 261,267 counterfeit goods worth US\$2.3 million.<sup>19</sup> While South African revenue service data from 2018 reported seizures worth US\$116 million in just 6 months,<sup>20</sup> India saw a rise in counterfeit incidents, lately, which costs its economy almost US\$13.4 billion per year.<sup>21</sup>

Among other enforcement agents, courts play an important role in implementing trademark laws through criminal and civil proceedings to curb illegal activities. Not only do such proceedings penalize the guilty, they also compensate the IP holder for the harm suffered. However, when an instance of trademark infringement surfaces, the first concern of the injured party is to stop the offender through an injunction to prevent any further damage rather than pursuing a criminal action. Thus, civil courts reinforce the meaning of law through creative remedies to make up for any deficiencies in practical application of legislations,<sup>22</sup> and protect the IP-holder's interest.

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<sup>18</sup> Oxfam South Africa, 'Reclaiming Power: Woman's Work and Income Inequality in South Africa' (Oxfam, 2020) <<https://www.oxfam.org.za/wp-content/uploads/2020/11/oxfam-sa-inequality-in-south-africa-report-2020.pdf>> accessed 1 September 2022.

<sup>19</sup> US Department of State, '2021 Investment Climate Statements: Mauritius' (2021) <<https://www.state.gov/reports/2021-investment-climate-statements/mauritius/>> accessed 5 September 2022.

<sup>20</sup> Liam Ngobeni, 'Counterfeit Goods Crippling SA Economy – Experts' (Pretoria Rekord, 2019) <<https://rekord.co.za/204963/counterfeit-goods-crippling-economy-experts/>> accessed 1 September 2022.

<sup>21</sup> Jinoy Jose, 'Counterfeiting Costs India ₹1 Lakh Crore Every Year: Ennoventure CEO' (The Hindu Business Line, 2020) <<https://www.thehindubusinessline.com/info-tech/counterfeiting-costs-india-1-lakh-crore-every-year-ennoventure-ceo/article32358558.ece>> accessed 28 August 2022.

<sup>22</sup> Khadijah Mohamed and Ratnaria Wahid, 'Fighting Counterfeiting: Importance of Enforcement of Intellectual Property Rights' (2014) 9(4) *Journal of International Commercial Law and Technology* 249.

The next sections will examine judicial enforcement of trademark laws through a study of decisions by Mauritian, Indian and South African civil courts in the cases that dealt with trademark infringement.

### COMPARATIVE STUDY OF JUDICIAL DECISIONS

Among several matters that are dealt by the courts the following are a few that have instigated the Mauritian courts into giving out judgements that have affected IP holders.

- I. Infringement of brand names
- II. Treatment of Well-known Marks
- III. Parallel imports of trademark-protected products

Each of the above is also discussed in the context of Indian and South African cases that actively contributed to making their economies investor-friendly. The rationale for examining these particular aspects is that the courts primarily deal with these issues when adjudicating matters involving trade of counterfeit goods. And it is these areas and the corresponding decisions that directly affect the rights of the IP-holder as well as the circulation of counterfeit products in the economy. Ultimately the study will identify the practices/rationale behind decisions dealing with counterfeit-goods cases in India and South Africa that the Mauritian courts can seamlessly incorporate in own their decisions.

#### I. Infringement of Brand Names

, 'Counterfeit trademark goods' as per Article 51 of TRIPS means any good that either bears a trademark ("**Mark A**") that is identical to the one validly registered ("**Mark B**") in respect of such goods, or Mark A cannot be distinguished in its essential aspects from such registered Mark B. Both of

these cases, the Mark A infringes the rights of the owner of the Mark B under the law of the country of importation.<sup>23</sup>

The role of the court is seen as one that not only penalizes the infringing party but also inculcates a sense of accountability.<sup>24</sup>

*a) Mauritius*

Mauritius grants statutory protection only to registered trademarks under Section 98 of the Industrial Property Act.<sup>25</sup> However, like its predecessor, the new legislation does not extend this protection to unregistered marks. This stance was highlighted in the case of *Smart For Success Ltd v Platinum Leisure Ltd*<sup>26</sup> where the plaintiff had registered its mark 'XIA' only *after* the defendant started using it. In this case, the plaintiff had used the mark for some time for its trade and, sought to restrain the defendant from using the mark in its logo.

Ultimately, the Supreme Court refused protection to the plaintiff on the grounds that for marks to be protected under Patents, Industrial Designs and Trademarks Act 2002 it needs to be registered and no protection can be granted to unregistered marks on the mere basis of usage or trade.

The protection of unregistered marks will be discussed further under the 'Treatment of Well-Known Marks' sub-head.

*b) India*

The provisions of the Indian Trademark Act provide sufficient protection to the registered IP-holder and the courts used international jurisprudence to set a framework to streamline the application of laws in India.

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<sup>23</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted on 15 April 1994) 1869 UNTS 299 (TRIPS) art 51.

<sup>24</sup> Kaushik Goburdhun, 'Enforcement of Intellectual Property Rights – Blessing or Curse? A Perspective from Mauritius' (2007) 32(3) Africa Development 131.

<sup>25</sup> Industrial Property Act 2019 (Mauritius).

<sup>26</sup> 2018 SCJ 183.

In *FDC Ltd v Docsuggest Healthcare Services (P) Ltd*,<sup>27</sup> the plaintiff alleged infringement of its registered trademark, ZIFI, and domain name. 'zifi.co', by defendant because of its use of the mark ZIFFI/ ZIFFI.COM. The court noted that both the marks were phonetically, structurally and visually similar. It concluded that the defendant's mark was deceptively similar and relied on the case of *British Sugar Plc v James Robertson & Sons Ltd*<sup>28</sup> where the UK court laid the objective test for similarity of description of goods/services: if the respective use is the same, intended purpose of each product was diverse, same client base, physical nature of the goods are similar insofar that that it confuses the customer, whether both products are in the same sectors, and same trade channels to reach the customer are the same.

Applying the test, the Delhi High Court noted that although the plaintiff's product was a range of medicines whereas the defendant's services included fixing appointments with doctors/diagnostics for medical check-ups --- both catered to the same demographic, i.e. patients. Moreover, the available evidence suggested that the goodwill and reputation of the plaintiff's registered mark inherently made it distinctive and, thus, warranted protection from defendant's infringement.

c) *South Africa*

In *Accounting Made Easy CC v School Accounting Made Easy (Pty) Ltd, Gauteng Division*<sup>29</sup>, the plaintiff alleged infringement of its registered mark whereas the respondent challenged the registration on the grounds that the mark itself was generic and descriptive. The plaintiff's tradename was 'Accounting Made Easy' whereas the respondent traded under the name 'School Accounting Made Easy' and both the parties, inter alia, offered lessons in accounting.

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<sup>27</sup> (2017) 1 HCC (Del) 16.

<sup>28</sup> 1996 RPC 281.

<sup>29</sup> (81365/2016) [2019] ZAGPPHC 215.

Here, the court referred to the principle framed by the European Court of Justice in *Sabel BV v Puma AG, Rudolf Dassler Sport*<sup>30</sup> and a South African case, *Plascon-Evans* case<sup>31</sup> which observed that The IP-owner ought to prove that a substantial number of people will probably be confused as to the origin of the goods or the existence or non-existence of such a connection. The court must only consider the marks side by side but also must view them separately. The marks also ought to be viewed as they might be seen in the marketplace. The court must consider any dominant feature or idea contained in the mark that is likely to make an impact on the mind of the consumer. When comparing marks, the court must consider sound, appearance and meaning. The court also ought to consider whether the average customer is likely to be deceived. On the basis of above principles, the court held that the marks were unique and there was no infringement. This case also indicates an inclination to rely on the element of confusion. In the prior South African case of *Plascon-Evans*, the court noted the impact of the similarities of the trademarks on the consumer of average intelligence who were likely to purchase the goods that bore the mark, even in cases where goods were not placed side by side. Thus, relying on the imperfect recollection of the ordinary purchaser, South African courts placed the onus on the plaintiff to show that the likelihood of deception or confusion exists.

Similarly, in the *Sabel* case the European Court of Justice analysed the likelihood of association as follows:

(1) where the public confuses the sign and the mark in question (likelihood of direct confusion); (2) where the public makes a connection between the proprietors of the sign and those of the mark and confuses them (likelihood of indirect confusion or association); and (3) where the public considers the

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<sup>30</sup> [1997] ECR I-06191, [1998] RPC 199 (ECJ) 221.

<sup>31</sup> *Plascon-Evans Paints (TVL) Ltd v Van Riebeck Paints (Pty) Ltd* (53/84) [1984] ZASCA 51 [1984] 2 All SA 366 (A).

sign to be similar to the mark and perception of the sign calls to mind the memory of the mark, although the two are not confused (likelihood of association in the strict sense).

Here the concept of the likelihood of association was used to define the scope of the likelihood of confusion.<sup>32</sup>

*d) Observations*

All of the three jurisdictions have similar legal structure that protects the registered trademarks. However, as was apparent in the case of *Smart for Success Ltd v Platinum Leisure*,<sup>33</sup> Mauritius grants protection to whichever party that is ‘*first to file*’ for the registration of the trademark.<sup>34</sup> It was for this purpose that the court considered the time frame in which the mark was unregistered while deciding whether the mark was protected. Although, both India<sup>35</sup> and South Africa<sup>36</sup> follow the ‘*first to use*’ rule to determine if the party is entitled to trademark rights, this means the party that proves the prior use of the trademark in the concerned jurisdiction will have superior rights as compared to the party that seeks to use or register the trademark later.

This could impact the way the courts deal with infringement cases. Another mechanism that helps courts is the ‘*first to file*’ rule. This affords protection to the first mark that files the trademark application even if other party shows prior use. Whereas the other practice of ‘*first to use*’ recognises prior use of the mark.

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<sup>32</sup> *Sabel BV* (n 30).

<sup>33</sup> *Smart for Success* (n 26).

<sup>34</sup> ‘Mauritius Trade Marks - Trade Mark Attorneys - Smit & Van Wyk’, Smit & Van Wyk (Webpage, 2021) <<https://www.svw.africa/mauritius-trade-marks>> accessed 1 September 2022.

<sup>35</sup> IP Australia, ‘IP Protection in India’ (IP Australia, 5 June 2020) <<https://www.ipaustralia.gov.au/understanding-ip/taking-your-ip-global/ip-protection-india>> accessed 1 September 2022.

<sup>36</sup> Spoor & Fisher, ‘Trademark Rights and Protection In South Africa’ (Lexology, 14 December 2018) <<https://www.lexology.com/library/detail.aspx?g=1f68427a-0552-40bb-82b4-5c54075fec60>> accessed 29 August 2022.

The '*first to file*' rule might help in quick disposal of cases as compared '*first to use*' jurisdictions, because the latter requires detailed evidence of prior use of the mark. However, the '*first to use*' rule does provide unregistered marks some protection in cases where there are no statutory safeguards.

Another notable aspect is that the *Smart for Success* case is a fairly recent decision, which could possibly indicate that the Mauritian courts have gravitated towards rigidly policing infringement. According to this case, if the subject mark is unregistered, no protection will be afforded on the basis of '*trade and usage*'.

However, this is only one ground of protection is not valid in Mauritius i.e. protection on the basis of registration of mark. Few landmark decision ensure that Mauritian unregistered marks are not left defenceless, as discussed in the following section.

## II. Treatment of Unregistered and Well-Known Marks

Trademark is possibly one of the most important marketing tools that helps grow clientele and businesses. Unregistered trademarks are marks that are granted protection under common law on the basis of usage<sup>37</sup>. However, this protection is not secure since it is not backed by statute, which is why the practice of registering trademarks is favoured more. An owner of unregistered mark bears the burden of proof of proving the usage and goodwill attached to the mark. Whereas the registered mark holder enjoys the benefit of the presumption that he is indeed the owner, a kind of statutory protection. Using unregistered trademarks is not illegal but a decision that business owners need to take.

On the other hand, while the concept of the well-known marks is not defined by the Paris Convention, TRIPS agreement and WIPO Joint

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<sup>37</sup> Department of Trade and Industry, 'Making a Mark' [2013] Intellectual Property for Business Series 12.

recommendations of 1999, the Joint recommendations does provide uniform guidelines to assist its member states in formulating criteria that identifies well-known marks, including Article 2(b), which lists a non-exhaustive list of considerations for identifying a well-known mark. Article 4(1)(b), which protects well-known marks even in cases where the mark is not registered in a member country, and Article 4(1)(c), which suggests that member states may require a well-known mark to be recognised by the public at large. A well-known mark could be understood as a trademark that enjoys widespread reputation and public recognition which grants it a wider protection than an ordinary mark.

### III. Unregistered Marks

#### a) *Mauritius*

Before the enactment of the Industrial Property Act 2019, it was the now-repealed Protection Against Unfair Practices (Industrial Property Rights) Act 2002 (**PUPA**) that addressed unregistered trademarks. Discussion about infringement of unregistered marks in Mauritius would be incomplete without mention of the landmark decisions in *Polo/Laurent Co Ltd Partnership v Dino and Others*<sup>38</sup> and *Polo/Laurent Co Ltd Partnership v Regent Ltd and Others*<sup>39</sup> (**Polo cases**). In the *Polo cases* the Mauritian courts proactively shutdown the trade of counterfeit articles. In these cases, the right-holders sought an injunction against the trade of the counterfeit products bearing the polo-player marks, for instance POLO, POLO SPORT, POLO etc. On the other hand, the respondent contended that, in the absence of local registration, there existed no legal grounds to bar exploitation of these marks.

The Court held that the Respondent's use of the marks amounted to 'unfair practice' under PUPA. The Court used Section 5 (Causing confusion with

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<sup>38</sup> 2004 SCJ 44.

<sup>39</sup> 2004 SCJ 45.

respect to another's enterprise or activities) and Section 6 (Damaging another's goodwill or reputation) of PUPA as legislative support for decision, since Sections 5(2)(a) and 6(2)(a) both protected marks irrespective of whether they were registered in Mauritius.

In *Sofap Ltd v Mauvillac Co Ltd*,<sup>40</sup> the applicant was the registered owner of PERMOFIX and had sought injunction against the respondent's use of PROFIX on the ground that it would cause confusion to the public since it was similar to its own registered trade name and both tradenames were used in relation to cement based tile adhesives. The applicant also argued that the respondent's use of PROFIX was in breach of honest market practices and amounted to unfair competition and was contrary to honest commercial practice. The court identified factors clarifying the grounds for an action of passing-off that would create confusion in the minds of the public.<sup>41</sup> These factors are: the psychological reaction and mental association, whether the totality of the proposed trademark was such that it would likely to cause mistake or deception or confusion, similarity in ideas conveyed by the marks, and whether the person who sees the proposed trademark in the absence of the other trademark, might be deceived. The court then concluded that to an average purchaser who was accustomed to the applicant's PERMOFIX, the mark, PROFIX was likely to cause confusion if the respondent's mark was seen without the applicant's mark to differentiate. On this ground, applicant was granted an injunction.

*b) India*

Unlike Mauritius, India does not provide statutory protection to unregistered marks but allows the use of Sections 34 and 35 of the Indian Trademark Act

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<sup>40</sup> 2010 SCJ 143.

<sup>41</sup> Kaushik Goburdhun, 'An overview of the application of the law governing Trademarks in Mauritius' <<https://www.yumpu.com/en/document/read/31523744/trademark-mauritius-research-council>> accessed 1 September 2022.

1999 to grant protection to the prior user of the unregistered mark allowing them to continue their business.<sup>42</sup>

Another remedy that owners of unregistered marks in India resort to is 'passing off'. In several cases, Indian courts have held that irrespective of the duration of the use, the important element to prove passing off are the loss to the reputation and goodwill of the plaintiff's business caused due to the infringing act. In *Britannia Industries Ltd v ITC Ltd and Ors*,<sup>43</sup> the plaintiff claimed that the red and yellow colours on the defendant's packing of the product were similar to its own and could possibly create confusion in the minds of the customers and was hence passing off. India allows registration of colour combinations as marks.<sup>44</sup> But in this case, the plaintiff had not registered the red and yellow colour combination. The Delhi High Court eventually decided in the favour of the defendant on the basis that they found stark dissimilarities in the packing and that it would not cause any confusion to the consumer. It also held that:

Passing off has to be viewed from the perspective of the customer who wants to purchase the product. Is he, having earlier bought the product of the plaintiff, likely, on later coming across the product of the defendant, likely to confuse it as having been made by the plaintiff? Are the packs so similar that the customer, of average intelligence and imperfect recollection may, on later coming across the defendants' pack, associate it with the plaintiff?<sup>45</sup>

### c) South Africa

South Africa, like India, relies on common law to protect against infringement of an unregistered trademark i.e., actions for passing off and unlawful competition.<sup>46</sup> In *Capital Estate and General Agencies (Pty) Ltd and Others*

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<sup>42</sup> See Trade Marks Act 1999, s 34 and s 35.

<sup>43</sup> 2017 SCC OnLine Del 7391, (2017) 70 PTC 66.

<sup>44</sup> Trade Marks Act 1999, s 2(m).

<sup>45</sup> Kaushik Goburdhun (n 24).

<sup>46</sup> Spoor & Fisher (n 36).

*v Holiday Inns Inc and Others*<sup>47</sup>, the Supreme Court of Appeal described the essence of passing off as action:

The wrong is known as passing off consists in a representation by one person that his business (or merchandise, as the case may be) is that of another, or that it is associated with that of another, and, in order to determine whether a representation amounts to a passing-off, one enquires whether there is a reasonable likelihood that members of the public may be confused into believing that the business of the one is, or is connected with, that of another.<sup>48</sup>

The *Capital* case adopted an approach that enquired whether the representation confused the public.<sup>49</sup> This approach was later adopted in more recent cases.

While dealing with passing-off cases, South African courts prefer using 'reputation' instead of 'goodwill'.<sup>50</sup> In *Herbal Zone (Pty) Ltd and others v Infitech Technologies (Pty) Ltd and others*<sup>51</sup> from the year 2009 until 2014, the plaintiff used the tradename 'Phyto Andro' for capsules containing a root extract believed to have aphrodisiacal properties. Since 2014, respondent used 'Phyto Andro for Him' in competition with the plaintiff's product. However, none of the parties had registered the tradename. The court held that to prove passing off firstly, the reputation of the business, whether there is a misrepresentation that will likely deceive the public into believing it is the others business and damage was suffered due to the misrepresentation

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<sup>47</sup> (227/2015) [2016] ZASCA 74, 1977 (2) SA 916.

<sup>48</sup> *ibid.*

<sup>49</sup> W Alberts, 'The Relevance of Prior Trade Mark Use In South African Common Law' (2007) 2 Journal for Juridical Science 47 <<https://www.bowmanslahttps://www.bowmanslaw.com/article-documents/Wim%20Article%20Trade%20Mark.pdf>> accessed 20 November 2021.

<sup>50</sup> Wayne Meiring, 'Goodwill Hunting' [2018] Intellectual Property Magazine <<https://www.spoor.com/wp-content/uploads/2021/09/passing-off.pdf>> accessed 5 September 2022.

<sup>51</sup> (204/2016) [2017] ZASCA 8; [2017] 2 All SA 347 (SCA).

must be established. These principles are the classical trinity test discussed in the UK's *Jif Lemon* case<sup>52</sup> in respect of a passing off action.

The South African court adopted the *Jif Lemon* test for this case and concluded that the respondent's product represented to the public that its product was one that enjoyed a reputation in South Africa under that name. The issue before the court was whether the plaintiff enjoyed a reputation in South Africa. It was held that the plaintiff failed to prove that the reputation in the mark vested in it and not the respondent.<sup>53</sup>

This test is supplemented by requirement listed in *Premier Trading Company (Pty) Ltd v Sporttopia (Pty) Ltd*,<sup>54</sup> to prove the existence of a reputation and deception or at least confusion caused by the conduct of the defendant which would influence members of the public to purchase the goods. In cases where reputation cannot be pro, in *Reckitt and Coleman SA (Pty) Limited v SC Johnson & Son (SA) (Pty) Limited*<sup>55</sup> the court held that in absence of direct evidence of widespread reputation, inferences can be made from the facts on record. For instance whether the reasonable customer could distinguish the prominent from any other mark.

#### IV. Well-Known Marks

##### a) *Mauritius*

In Mauritius, the well-known marks were protected by PIDTA under Section 36(2)(e) which barred registration of a trademark that 'is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well-known in Mauritius for identical or similar goods or services of

<sup>52</sup> *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491.

<sup>53</sup> *Herbal Zone v Infitech Technologies* (204/2016) [2017] ZASCA 8, [2017] 2 All SA 347, 349.

<sup>54</sup> *Premier Trading Company (Pty) Ltd and Anr v Sportopia (Pty) Ltd* [1999] ZASCA 48, 2000 (3) SA 259 (SCA).

<sup>55</sup> *Reckitt & Colman SA (Pty) Ltd v SC Johnson & Son (SA) (Pty) Ltd* [1995] 1 All SA 414 (T) 417-418; 1995 (1) SA 725 (T).

another enterprise'.<sup>56</sup> This provision placed an obligation on the controller of Industrial Property Office to refuse registration of well-known marks even if the IP-holder does not object. Otherwise, the owner of the well-known IP could sue the infringing party<sup>57</sup>. The well-known trade names were also further protected under section 104(2) PIDTA which provides that trade names shall be protected whether or not the mark is registered. Like its predecessor, Section 91 of the Industrial Property Act 2019 protects famous marks against identical or confusingly similar third-party trademarks for the same types of goods and services. However, the Act falls short of protecting well known trademarks from use for dissimilar goods and services.<sup>58</sup>

The observations of the court in *Polo* cases indicate how serious the courts are when it comes to protecting a well-known brand from infringement by local vendors even if it was not registered locally,. In this case, the respondent raised a possible employment crisis for thousands of people who were employed by the infringing parties who would lose their job if the court granted the injunction. Despite such consequences the court took a strict stand when it observed that the fault for such drastic effect lies not with the copyright owner. It is the vendors who tried to reap benefit from the work of the IP-holders who through their skill, judgment, expense and know-how had created a work. The court labelled the practice as fraudulent and contrary to commercial morality.<sup>59</sup>

With respect to proving that the mark was well-known, in *Deceuninck NV v Zendow Comfort Co. Ltd and Anr*,<sup>60</sup> the Supreme Court emphasised the need to place relevant evidence on record to prove that the mark was used over

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<sup>56</sup> Patents, Industrial Designs and Trademarks Act 2002, s 36(2)(e).

<sup>57</sup> Patents, Industrial Designs and Trademarks Act 2002, s 40(2) and s 40 (4).

<sup>58</sup> Nora Ho Tu Nam and Marius Schneider, 'Mauritius: Protecting Your Well-Known Brands In Mauritius'. (Mondaq, 2 September 2021) <<https://www.mondaq.com/trademark/800048/protecting-your-well-known-brands-in-mauritius>> accessed 2 September 2022.

<sup>59</sup> Kaushik Goburdhun (n 24).

<sup>60</sup> (2011) SCJ 51.

extensive number of years, wide recognised, registered in several countries, known to the public as well as widely promoted across several countries and has great value or prestige associated with the mark.

*b) India*

India has been known to protect well known marks using common law (passing off) even before granting it statutory protection under Trade Marks Act 1999. One of such famous cases was the 1994 case of *Daimler Benz Aktiengesellschaft & Anr v Hydo Hindustan*<sup>61</sup> where the plaintiff objected to the use of the mark 'BENZ' along with a 'three-pointed human being in a ring' and the words 'German perfection. It need not be restricted to mere machines. Or horizons,' in relation to underwear by the respondent, an Indian company. The plaintiff sued the respondent alleging passing off. The Court held that<sup>62</sup>:

Such a mark is not up for grabs—not available to any person to apply upon anything or goods. That name [...] is well known in India and worldwide, with respect to cars, as is its symbol, a three-pointed star.

This case was possibly the only one where the court did not indulge in the analysis of the likelihood of confusion or deception and instead relied on the ubiquitous reputation and goodwill attached to the tradename 'BENZ' in relation to the cars.

Enacted a few years later, Section 11(6) of the Indian Trade Marks Act 1999<sup>63</sup> lays down the factors to be considered while considering whether a trademark was well-known, which include the knowledge or recognition of that trademark in the relevant section of the public including knowledge in India obtained as a result of the promotion of the trademark, the duration, extent

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<sup>61</sup> AIR 1994 Del 239.

<sup>62</sup> *ibid.*

<sup>63</sup> Trade Marks Act 1999, s 11(6).

and geographical area of any use, promotion and registration of that trademark, and the record of successful enforcement of the rights in that trademark.

In 2016, the Delhi High court yet again proved its willingness to tread with times in *Toyota Jidosha Kabushiki Kaisha v Deepak Mangal*,<sup>64</sup> where the mark 'Prius' was not registered in India. Toyota sued the defendant for using the mark 'Prius' on the grounds of prior use of the mark even though it was unregistered. Toyota also adduced considerable evidence to prove its' extensive use of the mark worldwide. However, the decision was overturned by the Supreme Court of India which invoked the principle of territoriality and asked Toyota to produce evidence if it had used the mark in India.<sup>65</sup>

Following this decision, just proving international reputation would not be enough to protect unregistered well-known brands in India. To seek an injunction against a third party the mark owner will need to place evidence on record showing that it enjoys considerable goodwill in India as well.

*c) South Africa*

Like India, South Africa is one of the few countries that afford statutory protection to well-known marks under sections 35<sup>66</sup> and 10(6) of the Trademarks Act (**SA Act**). Owners of well-known marks are entitled to prevent the use and registration of marks that constitute, whole or in part, a reproduction, imitation, or translation of a trademark as per Section 35(1) of the SA Act and which is used for goods or services identical or similar to the goods or services in respect of which the trademark.

Section 35 of the SA Act prescribes due regard to the knowledge of the trademark in the relevant sector of the public, including knowledge that has

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<sup>64</sup> 2016 SCC OnLine Del 3809, (2016) 67 PTC 374.

<sup>65</sup> See *Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries Ltd* (2018) 2 SCC 1.

<sup>66</sup> Well know marks are also afforded protection under Paris Convention.

been obtained as a result of the promotion of the trademark to assess the well-known aspect of the mark. However, only the South African nationals or those with domicile or real and effective industrial or commercial establishments in a convention country, are entitled to the benefit of protecting their well-known marks, irrespective of whether they carry on business or have any goodwill in South Africa. So, if a foreign trademark is not registered locally in South Africa but is registered and used by a person in a foreign country, such foreign registration/use will not in itself bar any person to adopt and register it in South Africa.<sup>67</sup>

The case of *Victoria's Secret Inc v Edgars Stores Limited*<sup>68</sup> is a clear example of the treatment of foreign well-known marks. Each party to the dispute had applied to register as proprietor of the trademark Victoria's Secret 'VS'. VS Inc, the plaintiff, was a specialty retailer in the clothing sector, owned and operated a chain of more than 300 retail clothing stores located throughout the United States of America. Whereas, the respondent was a South African that sold a wide range of goods, including clothes. Identifying a substantial demand for intimate female wear with a satin finish, the respondent launched a new range of ladies' intimate wear and used the trademark Victoria's Secret 'VS'. The plaintiff alleged that the respondent's claim to register the mark ought to be barred because it had deliberately adopted its marketing strategy and various aspects of their trading style.

Since the parties were competing for registration of an identical trademark the court, looked into the guiding principle '*encapsulated in the maxim qui prior est tempore potior est jure: he has the better title who was first in point of time*'. Here, 7 February 1986 was a crucial date when the respondent filed a trademark application. Although it had not used the mark yet, the respondent showed the intention to use the trademark 'VS' in the immediate future. The

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<sup>67</sup> *Victoria's Secret Inc v Edgars Stores Ltd* [1994] ZASCA 43, 1994 (3) SA 739 (AD).

<sup>68</sup> *ibid.*

plaintiff produced evidence of its advertisements appearing in magazines and that it was registered in several countries (e.g. Denmark, France, Ireland, etc.), however, it did not prove that it used the trademark 'VS' in South Africa before the crucial date of 7 February 1986.

The plaintiff's difficulty lay in the fact that it could not prove that it had a reputation in South Africa on the crucial date, especially since it never sold its goods in South Africa. The court observed that plaintiff's claim of having had a reputation in South Africa was based on speculation and no evidence. On this basis, the court rejected the plaintiff's claim to use of trademark 'VS' and cited *P Lorillard Co v Rembrandt Tobacco Co (Overseas) Ltd*<sup>69</sup> to support its reasoning.<sup>70</sup> The rationale borrowed from *Lorillard* case is that a trade mark is purely a territorial concept. This means that nothing prevents a person from asserting a proprietary right in a trademark in relation to which no one else has acquired a similar right in the same territory.

*d) Observations*

The Mauritian decision in the *Deceuninck* case identified specific factors that could help the court in identifying well-known marks. While helpful, the court did not clarify if the considerations for identifying well-known marks listed in the *Deceuninck* case were exhaustive. If not, then it is preferable to have the option of adding additional factors to the list over time. The lack of statutory support to the well-known trademarks means the courts will be free from a legislative straitjacket and that could assist them in making additions to the *Deceuninck*-factors based on the need for each case that is brought for judicial resolution.

The Indian considerations for ascertaining a well-known mark bear close resemblance to those set out in *Deceuninck* case. However, the *Deceuninck*

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<sup>69</sup> 1967(4) SA 353(T).

<sup>70</sup> *Victoria's Secret Inc* (n 67).

case does miss out on including evidence to prove successful enforcement of the rights in that trademark, especially by the court or relevant officer of the Industrial Property Office. Such evidence could include prior litigation involving the same mark or some dispute that was already settled by the officers of the Mauritian Industrial Property Office or tribunals. Repercussions from such an exclusion could take the form of multiple litigations in relation to the same mark where the courts refuse to lend credence to prior instances of enforcement of rights by other courts or the IP officers/tribunals. While this may not hinder parties from producing these records before the court, there is no guarantee that these will be given due credit. Through decisions in *Polo* and *Deceuninck*, the Mauritian courts have tried to protect the interest of the international brands by laying the guidelines for future decisions. If the considerations in the cases are also followed in the registration process by asking the well-known brands to submit proof of conducting business in multiple countries, it could curb the endless litigation. For instance, in *Strategic Foods International Company LLC v Meher Banon Gokhool* the Mauritian Industrial Property Tribunal ruled in the favour of an international brand owner of the label and the words ‘*Mini Crème Cookies*’. When the owner had applied for the registration of the words earlier, it was refused based on non-distinctiveness. However, the brand owner challenged the successful registration of the same words by an importer of the cookies. The Tribunal justified its decision by extensively relying on laws from the UK and EU. Now, in such a case, where the Tribunal protects an unregistered mark by relying on several foreign case laws, if the importer goes on to file a fresh challenge before the courts, it is difficult to predict if the Tribunal’s decision and reasoning will be taken into consideration at all.

The *Polo* cases ensure considerable protection to the foreign well-known marks from local instances of infringement that comes as a major boost to the foreign-based IP-owners of an unregistered well-known mark. Comparing the

Indian position above, it is unclear if the brand owner needs to prove a presence in the Mauritian market as well, otherwise, the IP-owner's position in the Mauritian market seems pretty secure. In this aspect Mauritius seems better off than South Africa which does not bar registration of a well-known mark locally, even if it is being used in foreign countries extensively. However, this optimism needs to be taken with a pinch of salt especially as the *Polo* cases happened about 18 years ago and unregistered well-known marks for dissimilar goods and services are afforded no protection by Mauritian laws.<sup>71</sup>

Regarding unregistered well-known marks concerning similar goods, registration is seen as a strong deterrent against third party usage. Since there is no register that lists well known trademarks, owners of unregistered marks will be burdened to prove the *Deceuninck*-factors as opposed to registered marks where the rightsholder is supported by the presumption of validity of the registration and the rights conferred by the relevant IP-authorities.

On the other hand, the Indian Trade Marks Act 1999 (which entered into force in 2003) has a more clear-cut set of considerations to make the courts' job easier i.e., section 11(6). It not only expressly protects well-known trademarks for similar goods but also for dissimilar ones<sup>72</sup> and even goes on to maintain a register of well-known marks based on court decisions that have recognised these marks.<sup>73</sup> This is a kind of organised structure is missing from the Mauritian IP-structure.

#### V. Parallel imports of trademark-protected products

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<sup>71</sup> Nora Ho Tu Nam and Marius Schneider (n 58).

<sup>72</sup> Trade Marks Act 1999, s 11(2); *International Society for Krishna Consciousness (ISKCON) v Iskcon Appaeral (P) Ltd* 2020 SCC OnLine Bom 729.

<sup>73</sup> Mohandas Konnanath and Ranjan Narula, 'India: Courts step up when it comes to famous marks' (World Trademark Review, 1 November 2016) <<https://www.worldtrademarkreview.com/article/india-courts-step-when-it-comes-famous-marks>> Accessed 30 June 2022.

Parallel importation is a trading practice that involves the importation of genuine or original goods from another country without the permission of the IP-holder.<sup>74</sup> Due to the territorial nature of the trademark, such importation affects the right of the IP-holder to place its products in the market.<sup>75</sup>

The doctrine of exhaustion is another concept that has shaped the remedies that IP-holders have over the sale or resale of their goods. Per the doctrine, the IP-owner's control over products bearing its mark ceases as soon as it undergoes the first valid transaction of sale. This exhausts the IP owner's exclusive right to sell its products in the market after the first sale. The different kinds of exhaustion are:

- a. International exhaustion, wherein it is assumed that the entire world is one market. And after the first sale of its trademarked goods, the IP-owner has no control over further sales, no matter where the resale happens
- b. Regional Exhaustion, under which after the first sale in a specific region, the IP-owner cannot restrain further resale of its goods anywhere in that particular region. Adoption of such a mode of exhaustion is seen in the European Union, and;
- c. National exhaustion, which ensures that once the IP-owner sells goods bearing its trademark in a domestic market of a country, it does not have any control over the subsequent sales. However, the right of the first sale in the country belongs to the IP-Owner. This means, the first sale in the country has to be either by the IP-owner directly or someone who has the IP-owner's permission to sell the trademarked goods in that country.

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<sup>74</sup> Shrabani Rout, 'Parallel Imports And International Exhaustion' (Mondaq, 21 May 2018) <<https://www.mondaq.com/india/international-trade-investment/703104/parallel-imports-and-international-exhaustion?login=true>> accessed 2 September 2022.

<sup>75</sup> Christopher Heath, 'Parallel Imports and International Trade' (1997) 28(5) IIC <[https://www.wipo.int/edocs/mdocs/sme/en/atrip\\_gva\\_99/atrip\\_gva\\_99\\_6.pdf](https://www.wipo.int/edocs/mdocs/sme/en/atrip_gva_99/atrip_gva_99_6.pdf)> accessed 1 September 2022.

However, since Article 6 of TRIPS expressly states ‘Nothing in this Agreement shall be used to address the issue of the exhaustion of intellectual property rights’,<sup>76</sup> each nation is free to frame its own exhaustion regime.

a) *Mauritius*

Mauritius followed a national exhaustion regime that enabled IP-owners to take any instance of parallel import to court unless it already exhausted its right of the first sale in Mauritius.

In the *Polo* cases, the Supreme Court had confirmed the application of the national exhaustion principle and went a step ahead when it held that a genuine product could not be imported from anywhere in the world to Mauritius without the consent of the right-holder even after the trademark owner has already introduced its product in Mauritius.

This restriction even extends to circumstances where the parallel importer was allowed to import goods in the past<sup>77</sup>. This principle was then reconfirmed in *Unilever PLC v Matrix Impex Ltd.*<sup>78</sup> In this case, Matrix Impex was importing beauty products that bore Unilever PLC’s trademark, however, the customs did not provide clearance for it. Unilever PLC was a registered owner of the trademarks in Mauritius and the beauty products were being supplied by its subsidiary, Unilever International. The court held that although Unilever International and Unilever PLC were linked, no one except the trademark-owner could provide the permission to sell unless such party was authorised by the trademark owner. Here the burden to prove that they have obtained the consent of the trademark owner was on the parallel importer. Such a provision protects not only the IP-holder but also its authorised local distributors who often sell such products at a high price as

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<sup>76</sup> TRIPS (n 23) art 6.

<sup>77</sup> *Nissan Jidosha Kabushi Kaisha v Zario Ltd* 2012 SCJ 494.

<sup>78</sup> 2017 SCJ 427.

compared to that sold in the market created by the activity of parallel importation

The system of national exhaustion is now statutorily supported by Section 98(1) of the Industrial Property Act, 2019 which reproduces section 40 (1) of the PIDTA, and provides that ‘no person, other than the registered owner, shall use a registered mark in relation to any goods or services for which it has been registered, except with the agreement of the owner’

*b) India*

Section 30 of the Indian Trademark Act 1999 refers to the exhaustion of rights after the product undergoes the first sale in the market. It was unclear till 2012, whether the term ‘*market*’ in the provision meant the domestic or international market i.e., whether India followed the doctrine of international or national exhaustion.

In *Kapil Wadhwa v Samsung Electronics*<sup>79</sup> (‘**Samsung case**’), the Delhi High Court clarified this term while dealing with the exhaustion regime and the legality of parallel import in India. In this case, Samsung sued Kapil Wadhwa, (the erstwhile authorized dealer of Samsung products) on the grounds of parallel-importing Samsung products from foreign markets and selling them at cheaper rates than Samsung India. The Delhi High Court held that the parallel import of goods did not amount to infringement of the IP-owner’s rights, and further confirmed that India recognises the International Exhaustion principle. This meant that once the product was placed on the ‘market’, anywhere in the world, it could lawfully be imported and sold in India without the permission of the IP-owner.

However, it must be noted that Indian trademark law allows IP-owners to take parallel importers to court if their trading of trademarked goods compromises

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<sup>79</sup> (2012) 194 DLT 23 (DB).

the goodwill, reputation, or the quality associated with the mark<sup>80</sup>. This restriction is seen as a reasonable measure to protect the reputation and quality of the IP-owner's assets even after the first sale.

c) *South Africa*

South Africa, like India, subscribes to international exhaustion.<sup>81</sup> Section 34(2)(d) of the Trade Marks Act 1993 protects the practice of parallel importation by providing that '*the importation into or the distribution, sale or offering for sale in the Republic, of goods to which the trademark has been applied by or with the consent of the proprietor thereof*'<sup>82</sup> does not infringe the registered trademark.

However, such permission is not unqualified. The South African courts have tried to protect the integrity of the goods bearing registered trademarks by clarifying in their decisions that parallel imports that have been altered, could constitute an infringement of the trademark to the extent of such alteration. Moreover, the court observed the possibility of classifying an altered product as a counterfeit.

In *Hampo Systems v Audiolens (Cape)(Pty) Ltd*<sup>83</sup> the court held that the sale of '*genuine goods*', properly marked by or on behalf of the trademark-owner with its mark, does not constitute an infringement of the trademark. However, the court noted that this protection would not extend to cases where an original product was adapted, altered, modified, or changed after the affixing of the trademark and before its sale by the alleged infringer. The key

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<sup>80</sup> Aabir Shoaib, 'Legality Of Parallel Imports In India', (Lexlife India, 2021) <<https://lexlife.in/2021/02/15/legality-of-parallel-imports-in-india/>> accessed 29 August 2022.

<sup>81</sup> Sarah McKeith, 'Pharmaceutical Patents In Developing Nations: Parallel Importation And The Doctrine Of Exhaustion' [2014] 6(2-3) African Journal of Legal Studies African Journal of Legal Studies 287 <<https://doi.org/10.1163/17087384-12342030>> accessed 5 September 2022.

<sup>82</sup> Trade Marks Act 1993, s 34(2)(d).

<sup>83</sup> (282/85) [1987] ZASCA 33, [1987] 2 All SA 173 (A).

takeaways from the case were that the goods sold must be ‘*genuine*’ i.e., the trademark-owner or its authorised agent must have applied the trademark to the product. Thereafter, once the product bearing the trademark reaches South African shores, it cannot be altered or changed in any way before the sale.

Another relevant case was *Television Radio Centre (Pty) Ltd v Sony Kabushiki Kaisha*.<sup>84</sup> Here Sony successfully restrained Television Radio from using the mark ‘*Sony*’ in selling parallelly imported Sony video recorders. The recorders were made for the UK market and did not operate properly in South Africa. So, Television Radio made its modifications to Sony’s products to make them compatible with South African television systems.

Sony placed expert evidence on record in support of its contention that the alterations thus performed were major and inexpertly done. As a result, the modified machines were inferior in quality in relation to their products. The court held that it is a matter of fact and degree, whether the modifications effected, were so substantial that it was no longer ‘*genuine*’ goods. It was concluded Television Radio had indeed infringe on Sony’s rights, and rightly so since the integrity of the original product was compromised due to the modifications.<sup>85</sup>

#### *d) Observations*

While parallel imports allow for a free market and benefits the ultimate consumer, restricting the practice benefits the IP owners and the local licensees of the products. Moreover, assuring IP owners regarding the safety of their products often translates into foreign direct and indirect investment.

Like India and South Africa, Mauritius could look into possibly balancing these interests, by allowing parallel imports as well as placing reasonable

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<sup>84</sup> *Television Radio Centre (Pty) Ltd v Sony Kabushiki Kaisha t/a Sony Corporation and Another* (465/85) [1987] ZASCA 32, [1987] 2 All SA 196 (A).

<sup>85</sup> O H Dean, ‘Infringement: Parallel Importation and Trademark Infringement’ (1987) 17 *Businessman’s Law* 3.

restrictions to protect the IP-owner's assets. While the exhaustion principle protects the rights of the IP-owners it could give impetus to monopolistic endeavours of trademark owners that may tip the balance of fair competition in the market. Allowing parallel imports in the market allows traders apart from the authorised dealers to sell the product. The benefits of this include availability of options to the consumer such that if a genuine product is available at competitive market prices, the counterfeit version may not hold as much sway with the public.

Moreover, while deciding trademark infringement cases courts often find themselves navigating between the interests of not just the IP-owner but the general public as well. Revisiting the *Polo* cases, the Mauritian court dealt with the 'public interest' aspect of its decision that more or less indicated that a pro-investor attitude may not always benefit the people.

In these cases, an injunction was sought by the IP-owners against the sale of counterfeit products that bore the polo-player marks, like POLO, POLO SPORT, POLO, etc. Among the main arguments tendered by the respondent against the grant of an injunction, such a measure would mean thousands of people would lose their jobs. Despite such consequences, the court took a strict stand when it decided that the use of 'polo' marks infringed the Copyrights Act 1997 and stated that no person must be allowed to steal and reap the fruits of those who through their skill, judgement, expense, and know-how had created the work.<sup>86</sup>

While it seemed like a victory for the IP-owner, the only losers were the people who worked for the entrepreneurs who sold the counterfeit products bearing the polo-marks. Following the court's order, 108 outlets that traded the counterfeit items in Mauritius were shut down and thousands of such

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<sup>86</sup> *Polo/Laurent Co Ltd Partnership v Dinoo and Ors* 2004 SCJ 44; *Polo/Laurent Co. Ltd. Partnership v Regent Ltd and Ors* 2004 SCJ 45.

people had lost their jobs.<sup>87</sup> The court did not make provisions to provide them with any financial support and this only added fuel to the debate on whether the protection of intellectual property rights superseded public welfare.

Whereas in India, a catena of judgements show courts doling out creative remedies and orders that tended to favour public interest in their decision related to IP-infringement. This effort was gradually made to balance the commercial and the public interest i.e., make the infringers pay for the wrong and promote public welfare.

In *Unilever PLC & anr v Masqati Dairy Products*,<sup>88</sup> on the plaintiff's application, the Bombay High Court granted the injunction and restrained the Respondent from using the registered trademark 'Feast' in its similar mark of 'Choco Feast'. And the infringing goods that were seized, were distributed among poor children. A public interest approach like this favours a welfare-based justice system where the courts protect the commercial rights as well as use a part of the punitive damages in favour of public-interest.

Taking a different approach, the South African court used constitutional values while dealing with commercial and public interests in *Laugh It Off Promotions CC v South African Breweries International (Finance) B.V t/a Sabmark International*.<sup>89</sup> Laugh It Off Promotions CC (**LIOP**) sold t-shirts that bore corrupted versions of well-known trademarks. These alterations were like a social commentary or a parody of the well-known marks. In this case, LIOP parodied the mark 'CARLING BLACK LABEL', which was registered by South African Breweries International (Finance), and printed 'BLACK LABOUR' on its t-shirt. South African Breweries (**SAB**) alleged

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<sup>87</sup> Susan Isiko Štrba, *International Copyright Law and Access To Education In Developing Countries* (Brill 2012).

<sup>88</sup> Commercial IP Suit (L) No 599 of 2019 (Bombay High Court).

<sup>89</sup> (CCT42/04) [2005] ZACC 7, 2006 (1) SA 144 (CC).

that the t-shirts caused a detriment to its reputation and sought to restrain LIOP from infringing its registered trademark whereas LIOP defended its actions on the grounds of freedom of speech.

Considering the facts, an objective test was used i.e., whether an independent observer who is sensitive to both the free speech values of the Constitution and the property protection objectives of trademark law, would say that the harm done by the parody to the property interests of the trademark owner outweighs the free speech interests involved<sup>90</sup>

So, trademark rights were looked at through the lens of the South African Constitution and interpreted in a way that is least likely to interfere with the freedom of expression aka public rights.<sup>91</sup> It was held that LIOP had not infringed the trademark. This case indicated the courts' willingness to strike a balance between the rights of the trademark owners and the public.<sup>92</sup>

A Mauritian court could easily draw inspiration from the Indian tactic of using public welfare as a manner of imposing a penalty on infringers in a way that serves the society it caused harm to in any way. For instance, in the *Polo* cases where the welfare of the people who lost jobs could have been dealt with such that the infringer could have at least paid compensation to them or ensured alternate employment so that they did not lose their source of livelihood. The lop-sided decision compromised public welfare and laid bare a need for a more creative solution that does not leave the public high and dry, unable to care for their basic needs due to the loss of their livelihoods. Indian and South

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<sup>90</sup> *ibid.*

<sup>91</sup> Owen Dean, 'Trade-Mark Dilution Laughed Off', (2005) 447 *De Rebus* <<https://blogs.sun.ac.za/iplaw/files/2012/08/Trade-mark-dilution.pdf>> accessed 1 September 2022.

<sup>92</sup> Sebastian D Beck-Watt, 'Just Laugh It Off: Trademark Parody and The Expansion of User Rights' (2017) 30(1) *Intellectual Property Journal* <[https://www.cba.org/CBAMediaLibrary/cba\\_na/PDFs/Sections/Just-Laugh-It-Off.pdf](https://www.cba.org/CBAMediaLibrary/cba_na/PDFs/Sections/Just-Laugh-It-Off.pdf)> accessed 2 September 2022.

African decisions showed a willingness to temper the decisions to benefit public needs.

### CONCLUSION

The practice of counterfeiting flourishes in developing countries where purchasing power concerning luxury commodities exists in a market where commercial transactions are unregulated. The sheer volume of illegal transactions strains the national resources that work to curb them and renders their efforts ineffective.

Considering its steady economic growth, it is likely Mauritian consumers are swayed by a brand enough to buy it for its promise of good quality and the esteem attached to the product, even if it means compromising on functionality or quality. It is probably this tendency that has the courts coming down hard on the cases of infringement and actively advocating registration of the marks through the *Smart for Success* case. While Mauritius, India, and South Africa have legal frameworks to protect registered marks, the real test lies in the protection of unregistered marks.

As discussed earlier, Mauritius statutorily protects unregistered marks but not for dissimilar goods and services. One way to overcome this hindrance to take a cue from Indian and South African decisions to build a common law safety net i.e. judicial decisions that protect this excluded category of unregistered marks. This is possible if the courts recognise the concept of passing off which will allow claims for trademark infringement in case of dissimilar goods but it might disturb the findings in the *Smart of Success* case. Alternatively, there is an option to claim ‘*concurrence déloyale*’ under Articles 1382 and 1383 of the Mauritian Civil Code wherein the aggrieved party will need to prove ‘*faute*’ i.e., that the offending party simply misrepresented its products as those of the aggrieved party.<sup>93</sup> This is possibly

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<sup>93</sup> *Federal Marine Ltd v Vijayen Veerapen* 1999 SCJ 161.

the only remedy available since no protection on the basis of trade and usage can be granted owing to the *Smart for Success* case.

Apart from establishing a regime that protects commercial interests, the Mauritian court decisions seem to lack sensitivity to public welfare which may lead the public to lose trust in the courts and resort to illegal practices like counterfeiting. Moreover, to invite and sustain well-known brands into the country, it is imperative that Mauritius maintains a positive purchase experience. While the legislative framework seems adequate, Mauritius requires the support of the courts in a way that not only synthesises remedies that work best per the circumstances of the case but also considers general public welfare.

For a country that has consistently has taken a pro-investment stance (read *Polo* cases), Mauritian courts could consider strengthening the tradition and recognising transnational reputation (i.e., global reputation of the brand) as seen in the Indian case of *Daimler Benz*. It is very similar to the decision given in the *Polo* cases where the court took cognisance of the Polo's business, goodwill, or reputation abroad to grant protection to an unregistered mark.

While India has reverted to the territoriality principle with the *Toyota* case<sup>94</sup> possibly to protect indigenous businesses, such a move may not benefit Mauritius as much given its reliance on foreign investment i.e., in September 2021 Mauritian foreign direct investment recorded a growth of about 91% of its nominal GDP.<sup>95</sup> It would bode well with its aspirations of economic growth to tread the fine line of keeping foreign trademark mark owners protected while balancing the interests of its own citizens as was discussed earlier.

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<sup>94</sup> *Toyota* (n 65).

<sup>95</sup> 'Mauritius Investment: % Of GDP, 1999 – 2022' (CEIC Data, 2022) <<https://www.ceicdata.com/en/indicator/mauritius/investment--nominal-gdp>> accessed 2 September 2022.

That being said, public interest can be pursued in ways that help economic growth as well. For instance, parallel importation may also be good for the Mauritian economy over the long term as well. This practice may seem detrimental initially since it ensures no one except the mark owner or its authorised distributor trades in the marked goods. However, as discussed earlier subscribing to international exhaustion will possibly allow for local businesses to import the goods once it is placed in the market by the owner the prices of the goods anywhere in the world, and allow the forces of the market to decide the prices of the goods like seen in the Indian and South African market. The competition will allow more people to contribute to the economy and possibly avoid counterfeit products.

This also does not particularly harm the mark owners and their distributors, just encourages them to price their products prudently to make them market-friendly. This way Mauritius can encourage more local businesses to import various goods and conduct business in a way that goods are legally sold ensuring their public gets the worth of the money spent as well as contributes to their economy.

Alas, no solution is fool-proof. Yet the judicial initiative to venture beyond the black-letter law will work wonders to iron out loopholes in the Mauritian IP framework that currently allows for the counterfeit industry to flourish.



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