

**BOOK REVIEW: “OVERLAPPING INTELLECTUAL
PROPERTY RIGHTS” BY NEIL WILKOF AND SHAMNAD
BASHEER (eds.)**

*V. Lakshmi Kumaran**

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Introduction

The Intellectual Property laws have a foundation, as many believe, in John Locke's labour theory of property and broadly recognise the need to protect the fruits of one's intellectual labour. The creative nature of the human mind has no contours but, while the human tendency to compartmentalize and segregate subject matter does help in making things simpler, it may not always be the case. Many creative minds are free from the fetters of classification and 'compartmentalisation' and may create something that could be subject matter of more than one 'IP regime'.

Moreover, with the advent of complex technologies which have applications in multiple sciences, the lines between distinct disciplines like engineering, art and life sciences, can be seen to be diminishing. This raises several questions for the stakeholders. Can a plant variety or parts thereof, be offered protection under both plant variety and patent law? If yes, which one should the individual choose and what should be the considerations involved when choosing one over the other? What do the UPOV Convention and TRIPS agreement have to say about this? Similarly, a product may be covered by Design protection law as well as Patent law, covering the functionality attached to the design itself. Is there interplay between right to publicity and trademark law? Are there overlaps in the moral and economic rights of authors over their works? How complex is the

* Managing Partner, Lakshmi Kumaran & Sridharan, Attorneys, B-6/10, Safdarjung Enclave, New Delhi-110029.

relationship between Patents and Utility Models? These and many more are very contemporary issues which need to be addressed.

About the Book

The book *Overlapping Intellectual Property Rights*, edited by Neil Wilkof and Shamnad Basheer, seeks to give answers to these issues or, at least, offers comprehensive insight into the issues and stakes and is therefore an invaluable addition to the existing literature on Intellectual Property Law. The legal context given to these questions of overlap is from the perspective of US and English law with inferences drawn from the EU as well. Although, it may seem as a limitation, it only provides for uniformity in the analysis and readers have, at their disposal, what can be described as comprehensive chart at the end of the book that contains snippets on the overlapping IPR regimes in 17 countries. The size of the five hundred page book does not do justice to the spectacular labour of several authors that has gone into creation of this work which has a vast reach in terms of number of fields and jurisdictions. A perusal of the “list of contributors” would show that the authors of different chapters are from diverse background such as leading universities, research institutes, and prominent law firms from different parts of the world such as USA, UK, Singapore, Australia, India, Belgium etc. This lets the reader have a wider perspective over the underlying theme.

The theme itself is intriguing and is something that has, at one point or the other, caught the imagination of many academicians, students and professionals, but a comprehensive work such as this is not common. The book follows a unique pattern while discussing an issue and this is what makes it much more interesting to read than other traditional works in the same field. Going by its theme, a perusal of the index would show the reader the huge canvas on which multiple authors have written about overlapping IPRs.

The chapters in the book have been organized in clusters so as to allow the reader to grasp all the possible overlaps which can take place while considering one particular IP law. While most works introduce the concept first and proceed with the practical applications thereafter, this book follows the opposite methodology. Each chapter begins with a hypothetical and practical fact situation, which introduces the reader to the various intricacies of IP law which can originate from a single

creation. More often than not, these hypothetical fact situations are based on real cases; *See Franek v. Franco* in the overlap between patents and design and *Theberge v Galeri d'Artu Petit Champlain* concerning the correlation between moral rights and economic rights. The hypothetical fact situation therefore, forces the reader to think and introspect, about the possible solutions to the problem. The fact situation serves as a spring board for the imagination of the reader to appreciate the theme of every chapter of the book i.e. overlap of the specific intellectual property rights.

After a thorough evaluation of the relevant provisions of law and the overlaps between the same, the authors give a complete analysis of the hypothetical fact situation. Finally, each chapter of the book concludes with a summary of the contradictions/similarities between the laws in various jurisdictions and the best course of action if and when a similar overlap does take place. Hence, the book touches upon a multidisciplinary area of law, which was yet to be properly explored and analyzed, and it deserves critical appraisal for the same.

Brief highlights on some of the chapters will enable any prospective reader to get an idea of the extensive and interesting nature of the work. Through 17 chapters, one can see the sheer brilliance in the exceptional work of the authors in covering the most prominent and complex overlaps in intellectual property rights. An example is the overlap between design protection and patent protection wherein the position of law varies considerably across jurisdictions. For instance, if the technical advantage in the concerned creation trumps the presence of eye appeal, then design protection may be refused in the US. The sensitive interplay between breeder's rights and patents, particularly, the conflict between farm saved seed vis-à-vis patentee's rights over the plant, have also been deliberated upon. The book also takes the reader through more contemporary issues with regard to the relationship between trademark rights and unfair competition, such as 'slavish imitation' and comparative advertising. Further, the book sheds light on the design vis-à-vis copyright debate wherein, laws in various jurisdictions expressly prohibit an overlap between the two, however the definitions of the subject matter being governed by the two laws are not clear and this is the reason behind the ensuing confusion. The book also analyses the overlap between domain names and trademarks. After providing an interesting history of how the relationship between the two regimes has developed, practical solutions have been offered that may be very useful for practitioners, especially the US. Similarly, the book offers an extensive discussion on interplay

between publicity rights and trademark law. While both may seem to have some similarity insofar as they relate to asserting the right to unique name and image, both are distinct when it comes to enforcement, the former enforced by showing unauthorized usurping of commercial benefit from a person, the latter is enforced by showing likelihood of confusion. Moreover, the book, in its last chapter, attempts to harmonise the stand between, intellectual property rights and competition rules which traditionally, have been viewed to be in conflict with each other.

The book explains the individual concepts very clearly, thereby enabling the reader to have a better perspective over the instances where overlaps can occur. As mentioned already, the book gives an overview of the position of law on the specific overlapping IP rights in multiple jurisdictions, particularly, the United States, the United Kingdom, the European Union, along with a chapter dedicated to India. Where necessary, the book also highlights the provisions of law in other jurisdictions so as to give a holistic understanding of the discrepancies which exist in the laws across jurisdictions when considering the same issue.

The India chapter

A special mention is imperative for this chapter on the Indian perspective, written by no less a person than Prof. Shamnad Basheer, the First Ministry of Human Resource Development Chair Professor in IP Law at WB National University of Judicial Sciences. This Chapter traces the doubling of the number of IP over the years and then goes on to examine the common underlying thread that runs through these categories of IP. It begins with the classic example of complete software – whether it is a literary work entitled to copyright protection and/or also to patent protection. The article very aptly examines the issue of overlapping of IPs by noting the two extreme positions – only single IP or multiple protections. At the same time, he also highlights the fact that the perceived overlap may not be overlap at all. While copyright on software, for example, protects the actual expression of the source code, the patent may protect the underlying idea / functionality. Thereafter, he goes on to examine overlap of IP in India. The overlap between patents and copyrights, patents and trademarks, copyrights and trademarks, copyright and trade secrets, copyrights and designs, trade marks and G.I., etc., are discussed in detail. The Chapter concludes with the decision in *Microtube* case, which has been referred to a large bench of the Delhi High Court, to

see if Judges will lay down a doctrine of preclusion or prune down the scope of specific IP regimes to avoid overlap.

The larger bench has now decided the issue (May 15, 2013) wherein the majority opinion, delivered by Justice Shakti, states that passing off remedy will be available to a person with respect to a design already registered under the Designs Act, 2000. However, Justice Manmohan Singh has differed and cautioned that passing off remedy is not available for those features/aspects of the design which are covered under the novelty of the registered design, even after the expiry of the registration. Other aspects of passing off, as per Justice Singh, like trade dress etc. are open for challenge so long as they do not conflict with the registered design under the 2000 Act.

Concluding thoughts

The book would have a good impact in stimulating professional legal minds on such 'juicy' issues that they would, if not already seen, surely see in courts sometime soon. At the same time, it would be of great help in introducing students to such advanced concepts of overlapping IPRs and to fields such as publicity rights and unfair competition law, which usually may not form a part of the regular IP law curricula. Although the book was written by authors from various countries and varied fields, it presents a remarkably coherent style of writing. It would certainly help professionals in appreciating that, irrespective of jurisdictions, the core issues arising out of overlap may be very similar. At the same time, practitioners would also find that questions on overlap may appear very simple at the outset, but they are indeed much complex when one goes deeper in the fact situation. The wide array of recent cases which have been included in the book, would also enable the reader to appreciate the current position of law. Needless to say, lawyers from all over the world would also benefit from this scholarly work, since it focuses on contemporary issues which may arise while practicing law in the IP sector. For any experienced practitioner it would not be difficult to contemplate such interesting overlaps and thus, find this book valuable, especially in competitive and developing countries like India where IP laws such as trademark and copyright law have significant number of precedents, whereas laws relating to Patents, plant variety, competition law etc. are still at a nascent stage. In the circumstance that a particular creation can be protected under multiple IP laws, it becomes essential for a lawyer to work out the best mode of protecting the

concerned creation. Overall, the Book is a veritable feast to practitioners and academics in the IP field.

Lastly, it would be interesting to see the additions and supplements which the authors would make in the subsequent editions of this book.. Some IP regimes like copyright are so diverse that it may be pertinent to discuss scenarios of such overlap within different forms of copyrightable works such as musical work, sound recording or performance which would be interesting to see because nature and extent of protection may vary for different kinds of works under Copyright law. Moreover, although not an overlap per se, intellectual property rights do have close relationship with some regulatory obligations. One of them has been discussed in the chapter dealing with Patents and Regulatory data exclusivity. However, there are other interesting subjects that may be looked at such as obligations arising out of biodiversity concerns which have a significant impact on research, patents or plant variety protection. Needless to say, study of overlaps is crucial as overlaps in intellectual property rights, are only set to increase in the future
