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Overlap of Trademarks with Other Intellectual Property Rights: The Strategies of Global Brands

Madhumitha Dharmapuri Selvakumar

Cornell Law School, Ithaca, USA
Email: md993@cornell.edu

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Abstract

Intellectual property protection is granted through law for the creators of the intellectual creations. Many may confine to one specific intellectual property protection for their creations when in fact to sustain the competitive market edge it is necessary to overlap the IP protections. Patent, Copyright, Industrial Design, Traditional knowledge, Trademarks can often overlap when a business carries out its activities in a market. The value of the intellectual property increases by its efficient management in a business from generating revenue through utilization of different protections offered by law. From providing valuable function to utilization of IP in the market, the process has become more personalized than addressing the consumer's needs. It is also to be noted that not all commercially valuable ideas can be patented, but with the help of other IP protection, it can claim a protection similar to patents. Whether such overlapping use of IP leads to ever-greening of life of a product or it is just a recycling process is discussed in this paper in correlation with various case laws and current business management study of IP, where overlap of Trademark with other IP rights has been helpful in sustaining and enhancing the competitiveness.

Keywords

Intellectual, Rights, Trademark, Overlap, Brands

1. Introduction

Enormous benefits are to those who use the law wisely. IPR is one such field where both traders and consumers economically and through expansion of law get benefitted and protected. There are different forms of Intellectual Property

(IP): such as Patent, Copyright, Geographical Indication (GI), Trademark (TM), (WIPO Intellectual Property Handbook, 2004). The combination effect of IP deters others from making a duplicate of the existing IP asset that may arise from the market. If one studies IP in the first glance, they are bound to come across the duration limits for the protection and the criteria of protection for each IP right. The brands which aim to reach globally have to have firm logic that is strategic enough to foresee the market dynamics which may have a longer life cycle than probably just patent or copyright. What is meant is that even for an invention, it is necessary that the business requires more than patent such as copyright, trademark to protect the product and its identity to get competitive edge in the long run (Khan, 2010).

Trademark is the intellectual property protection that most commonly overlaps with other rights. What is a trademark? According to the layman's terms, it is the mark that gives an identity to a business. A legal understanding to the definition of trademark can be conferred from the definition under Sect2(1) (zb) of Indian Trademark Act, 1999 whereby a trademark is a mark that is inclusive of words, pictures, signs that serves as an identity distinguishing one's business/goods/services with that of another. It is a usual practice that common names should not be registered since it will bar others from using that name. However, upon proving the secondary meaning/distinction of the mark, trademark for the common name could be secured. Example: Apple, the tech company has a common name, but it doesn't deal with fruits as a mode of business but rather technology. It obtained its secondary meaning in the tech world as a well-known mark.

1.1. Research Objective

- To study and understand the nature of Intellectual Property;
- To analyse the overlap of Trademark with other IP Rights;
- To analyse and comment on the overlap of IP Rights in commercial environment.

The analysation will be studied, critically commented and concluded based on Indian Intellectual Property laws: Indian Trademark Act, 2000, Indian Patent Law, 1970, Indian Copyright Act, 1957, Designs Act, 2000 and Geographic Indication Act, 1999 along with judicial precedents, brand analysis.

1.2. Research Questions

1) Upon understanding the peculiarity of each intellectual property, can there be overlap of IP rights?

a) If yes, how does trademark overlap with the other IP rights?

2) Could the overlap of rights be commercially practicable and economically efficient in the stream of commerce?

1.3. Research Methodology

This article would be a doctrinal based research. There are various methodolo-

gies used in this article, including Content Analysis Method with secondary data collection from books and articles. The methodology that is being adopted in the said project is purely doctrinal in nature. The research is completely relying on primary resources, such as statutes and also secondary resources such as notices, commentaries and various books of eminent authors have been referred and cited. The said research paper also has a high reliance on the study articles and other works of eminent universities/colleges and also websites have also been referred which can be viewed in the Bibliography.

2. Management Perspective: IP Framework

The IP framework is of two types: IP atom and IP continuum. The framework sets and analyses the combination of various IP rights in relationship with time and validity of other IP Rights. The IP managers use the concept of IP Atom and Continuum to address the scope and viability of business in competition to assess its survival and commercial edge. IP asset identification is one of the ways in which the IP can be effectively protected (BBA Press, 2019). A manager of the company will manage the IP to the market advantages usually in an order. For example: If a company wants to get noticed using a tech invention, it got to patent the invention to have its exclusive limited monopoly, then go for copyright in case of contents, advertisements, then for the overall protection of the company, the brand is protected through trademark while the trade secret tends to exist throughout.

The viability of the technology will be analysed through three tests: 1) Technical brightness, 2) Economic potential, 3) Legal strength. Technical brightness examines whether the product provides for technical solution to a problem. The second test takes the technical brightness and examines whether it is eligible and has economic potential to license or practise the product in the world with competition. The third and final test analyses whether given a patent for the product it will survive and has the strength to destroy any suit of infringement against it. The reason for having the three walls of protection on the IP asset is to give an incentive thereby deterring third parties from duplicating its property and sustaining the business edge.

2.1. IP Atom

Intellectual Property regime has various IP protection for different aspects (Copyright, Patent, Trade Secret, Trademark etc.). IP Atom has three layers in which the core layer covers the functional utility of a product by patent protection. Any product that has a reach with its customers and provides a functional utility by giving a novel solution to a problem, it is eligible to be protected by patent. Ex: Facebook provides a platform where a person can connect with others, view information in a social media platform (BBA Press, 2019).

While the functionality of the product is protected through patent, the Copyright framework is broad enough to protect the original expressions from the

product such as advertisements of the brand thereby forming the second layer. The outer layer of protection is trademark and trade dress which is wider and covers the rest of the asset such as identity, quality and tradename (Conley, 2009). Ex: Apple iPhone 13 Pro's chief function is protected in patent, the advertisement that reaches the customer is enforced through Copyright, Apple iPhone 13 Pro's name, identity and tradename Apple is protected in trademark. In total, a person has to break at least 3 barriers to pull a business down. The fourth wall is in the form of trade dress. Trade dress is the overall phenomena of the product from the dressing to the packaging, everything falls within the ambit of trade dress.

This diagram shows the methods and skill used by the IP Managers of various brands with business strategies to correlate trademarks with other IP Rights overlapping them in such a way to get the best of all rights with maximum protection as shown in **Figure 1**.

2.2. IP Continuum

IP Continuum relates to the life of the product protected through various IP rights. Patent protects the functionality of a product which cannot be renewed after a period of 20 years. As the business protection for patent decreases by the number of years, the wide protection of functionality reduces. Functionality requires utility benefit characteristic to acquire patent protection; however, trademarks need not have such; it just has a market and an identity (Conley, 2009). Copyright is given for the author's original expression (WIPO Copyright), as the life and timeline of the product increases, the protection increases on different regimes. As the life of functionality of the product reduces, the life and the protection to the mark aspect increases. Trademark has indefinite life period. When a company advertises or makes a brand global by promoting the functionality, the advertisement is protected by its original expression, the trademark carries the reputation and quality over the lifetime of patent and copyright for indefinite period of time. Thus, retaining the market advantage and competitiveness through effective and efficient management of IP using different IP Regimes can enhance the life of a company (Conley, 2009) (**Figure 2**).

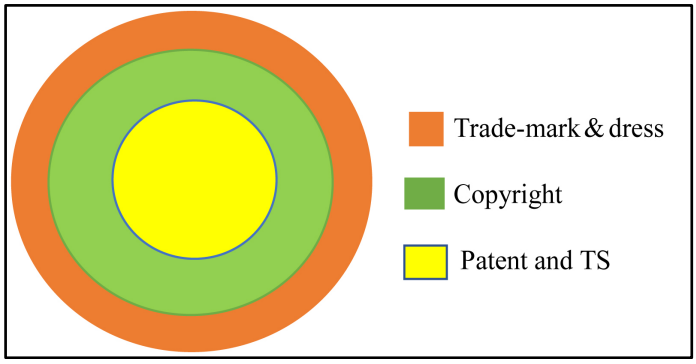

Figure 1. IP Atom.

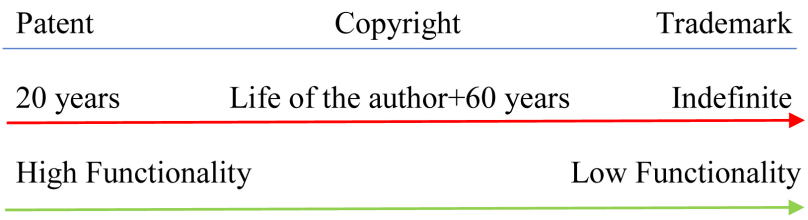

Figure 2. IP continuum.

2.3. Value Transference

Another market strategy that is used along with IP Atom and Continuum is value transference method which is interrelated with the time and allocation of resources to transfer the highest value obtaining/yielding maximum market advantage in competition. It can be from practice of the functionality of patent or original expression of copyright or a result of trademark successfulness can be termed as value transference (Evans, 2006).

The combination of IP rights use may render in variety of profits and economic value to the business. For Example: Coco-Cola, KFC uses the combination of trade secret, copyright through original expressions in advertisements, trademark and trade dress to obtain maximum benefits. Apple product has many patented technologies, does advertisements and obtains copyright and has the trademark for the general term "Apple" in the technology Industry. The resources and timely allotment and use of IP has created multitude of value through transference.

3. Brands Study

The brands play an important role in the management of IP using value transference. The following brands will showcase the overlap of IP for better understanding the IP Atom and IP Continuum.

3.1. Complan

Complan launched by Glaxo came to India during the year 1994, it was quick enough to capture the audience and use the value transference method efficiently through its target audience and marketing strategies (Brandyuva, 2019) Complan targeted the growing children and athletic adults to provide them adequate and balance nutrition. It displaces and effectively advertises to the target audience by keeping the milk on the table and Complan side by side. The Complan uses the emotional capture strategy: using either a kid or sports person stating that in a milk a person can obtain only 9 vital ingredients but Complan has almost 23 Ingredients (Mehta, 2014). Positioning Complan in a unique psyche and furnished itself as nourishment need. Complan kept some ingredients as a trade secret. To improve their market, they enhanced the type and number of products by bringing 7 different flavors, 2 different biscuits and a concept called as NutriGo specially focusing on the kid's nutrition (Mehta, 2014). The brand name Complan was trademarked, its trade dress was unique in nature with a simple

logo containing a wordmark "Complan" with pictures of kids. Complan changes the color of the packaging according to the target audience and as the indicator for the product inside. Packaging as the whole used to come with glass bottles in a package with toys and extra kid's attractive products as a marketing strategy. Complan has now reduced much in use and existence than it was before but the trademark Complan is still recognised as a product with exceptional Nutri growth due to its impact of advertising (Copyright), Trademark (the wordmark, Device mark and 3d mark).

3.2. Aspirin

Felix Hoffman developed the medicine Aspirin in the year 1897 for the Bayer Company, Germany (Aspirin-History of Aspirin). Aspirin was patented in the year 1899 and in the span of few years, patent got expired the substance came to the public domain. But the company benefits up until now using the trademark protection called Aspirin, on the quality and product safety. Bayer used a similar strategy for Cipro product Ciprofloxacin (WIPO, 2009). The value transference and the lifetime protection using the trademark protection beyond the life of the patent can be observed here (Strowel, 2011).

3.3. Gilead's Remdesivir

Gilead Sciences is the one of the major leading companies striving and aiding to stop the spread of Coronavirus using the drug called as Remdesivir. It was originally created in the year 2009 for the Hepatitis C, there was no major success by the Remdesivir for the treatment of Hepatitis C but seemed to have worked well as a potential treatment for Ebola and Marburg Viruses (Saey, 2020). Eventually Gilead came to discover that the Remdesivir works well against many viruses such as: filovirus, Paramyxovirus, Pneumovirus and Coronavirus. USPTO granted to two patents on Remdesivir in 2019: 1. for Arenavirus and Coronavirus 2. Filovirus (AWA, 2020). Remdesivir created quite a stir with the national institutions and WHO on whether Remdesivir has any improvements in reducing the spread of COVID-19, so the WHO and the U.S National Institute of Health along with National Institute of Allergy and Infectious Diseases have stated that in comparison to Placebo, Remdesivir reduced the number of hospitalization days from 15 to 11 days (Silverman, 2020). In April 2020 the use of Remdesivir in EU was allowed by the European Medicines Agency. On May 2020, the U.S Food and Drug Administration granted the Emergency use Authorization to Gilead to license to the other health care providers. It is a process controlled by the US Government where the Gilead will supply the vials to the government who in turn will re-distribute to the hospitals (FDA, 2020). The Committee for Medicinal Products for Human Use in June 2020, evaluated the impact of Remdesivir on COVID Patients. So, with the test trial in Rhesus Macaque Monkeys Remdesivir proved to reduce the disease progression (National Institute of Health, 2020). All these information from national institutes was like an indirect adver-

tisements and approval of the drug Remdesivir by which Gilead gained a lot of attention and monetary funds. Due to the growth of Remdesivir and its advantageous talks all over the world, Gilead gave Non-Exclusive Licenses to five other drug companies in India and Pakistan to distribute to almost 127 countries (Spry, 2020), the License agreement played a crucial role granting the licensee the power to set the rate and the Licensee need not pay any royalty to the Licensor until WHO declares that Coronavirus has declined.

Gilead managed its asset very wisely that instead of compulsory Licensing and the drug be acquired by the government, Gilead gave a non-exclusive license thereby spreading its trademark on the Remdesivir drug and gaining reputation by reducing the spread of harmful COVID 19 diseases over the other drugs when the pandemic broke out (Gilead, 2021).

3.4. The Lion King

The song Lion King sleeps tonight became an overnight hit over during the 1990's and was incorporated in the Walt Disney Movie "The Lion King", which has brough millions of USD to the Walt Disney but the credit was given where it wasn't due. The history unfolds during the 1930's where a Zulu Tribesman in South Africa named Solomon Linda composed and wrote the song named "Mbube" which means "Lion" in the language of Zulu (Aljazeera, 2006) Gallo Records recorded the song and for an amount of ten shillings and Solomon Linda assigned his copyright for the song Mbube to Gallo (Dean, 2006) Around 1950's the singer named Pete Seeger upon hearing Mbube recorded "Wimoweh" which was later assigned to Folkways, a Music Publisher in U.S. Lyricists Weiss, Peretti and Ceatore rearranged this song to "The Lion Sleeps Tonight" turning it to a popular song overnight (Fu, 2019) Walt Disney incorporated the song in the movie "The Lion King" crediting the three lyricists for procuring millions of USD without any acknowledgement to the original singer Solomon Linda (Browne, 2019).

In the year 2000, an article was published by South African Journalist focusing on the unfortunate Solomon Linda who died in 1962 without a penny or credit while on his songs earned millions in the Lion King movie with a royalty of $15 million. Gallo Africa to whom Solomon Linda assigned his song appointed an attorney who found an innovative solution to the issue using the 1911 Imperial Copyright Act (Dean, 2006). The copyright of Solomon Linda reverted to his estate executor in South Africa. Walt Disney was sued for royalties on using Solomon Linda's Song in a movie but the jurisdiction was a problem since Walt Disney was a U.S based corporation. By using the evidence of Walt Disney having nearly 200 South African trademarks and Copyrights in South Africa on "The Lion King", they brought forward the jurisdiction and succeeded. The parties settled out of Court amicably in which an undisclosed sum was paid to the three daughters of Solomon Linda and an agreement was signed that stated that Royalties would be paid in case of future uses (Lafraniere, 2006).

3.5. Montblanc

From 1906 MontBlanc has made history by using its writing equipment "Pen" in exclusivity for creating a brand before it divulged to watchmaking and jewellery. The company headquarters in Germany created its famous logo of six pointer star taking inspiration from the glaciers located at the Europe's highest peak. There was n number of patent filed by the Montblanc for the Fountain-pen (JUSTIAPatents, 2020), example of the patents would be the Montblanc-Simplo GmbH fountain pen and other specific functionalities such as ordinary eye-dropper, safety pens with push rod mechanism etc., The name "Montblanc" wasn't trademarked until 1910 in Germany and U.S, however, the use of the name as a trademark for the fountain pen was enforced during 1913. Up until today Montblanc uses various forms of commercial exploitation, one such was during 1924 when it introduced its highly achieving masterpiece called as "Meisterstuck" with a distinctive and unique a black resin finish with three gold rings which has been the Montblanc's design along with the talismanic figure "4810" engraved in the pens and its nibs as a practice till today. It became so famous that it was used by many politicians, popular people and leaders of the world including Pope John Paul II and Nelson Mandela and this became an innovative way for advertising Montblanc. They even made limited edition version of pen for the 140th anniversary of Mahatma Gandhi. The advertising effect went to make history to be featured in the 1983 James Bond movie Octopussy that held a listening device earpiece "containing a handy metal-dissolving mixture of nitric and hydrochloric acid" (Campaign, 2013). An unexpected publicity occurred during the signing cologne's Golden book where the west German Chancellor Konrad Adenauer having not able to find his pen borrowed a pen from president JFK which happened to be the Meisterstuck 149. The Montblanc pens were even used to sign the wedding certificate of Prince Charles and Lady Diana's. In 1991 the Russian president was rumoured to have written his resignation letter with the Montblanc. Montblanc was placed in the Guinness book of records for its limited edition of Meisterstuck Solitaire royal which was decorated with 4810 pave diamonds as the most expensive pen on the planet in the year 1994 (Campaign, 2013). With its unique Patents, designs and shapes, Montblanc marketed its trademark worldwide through its quality and elegance with Celebrity endorsements (Chamat, 2016).

4. Legal Perspective

The following subtitles will analyse the individual overlapping of IP with other IP rights and how successfully they have defended their brand commercially.

4.1. Patent and Trademark

Aspirin is one of the finest examples that use patent and trademark together in bringing a change of business and competitive advantages to the company (Chamat, 2016). Patent grants exclusivity to the products but the time period if lim-

ited cannot be re-registered for patent protection, the cycle of exclusivity remains only for 20 years in India after which the patent enters the public domain for the public use. To remain in market for the long term, the protection of business through trademark is required, to reach people with its quality products. This strategy of patent and trademark combination is usually used by many tech companies such as Microsoft, Apple-iPhone, mac, iPod. Anything that carries the suffix of "i" in any tech products is considered and related to Apple products. Companies like Bayer, Natco, AstraZeneca pharmaceuticals industry make use of the patent and the trade name to carry on its business in competition against others using the yearlong quality and reputation.

4.1.1. Hoffmann L. Roche

Invention and innovation to the prevailing problems and medical conditions have a priority to the Roche family, they still fight to produce drugs for the world's uncurable diseases such as Alzheimer, cancer. The company has a specialization in virology, inflammation, genetics etc. (GIP Research & Consultancy Services, 2019). Having 308 international patents, 12 US Patents, 11 tradenames (DRUGPATENTWATCH, 2020), Hoffmann utilises different IP rights and regimes to capture the market advantage in medical field. The statistics show that there are more number of patents that will expire in 2023 and quite few in 2020. One of the patents that expired Rituxan, Avastin treatment medicines for cancer are the tradenames that are still carried even after the expiration of patent through trademark.

4.1.2. Dabus

A real life example of technological advancement in AI's creation of an invention without any human intervention is Dabus. Scientists have made an AI named Dabus (Device for the Autonomous Bootstrapping of Unified Sentience) at the University of Surrey. Dabus as an inventor without human interventions filed the first patent application for its inventions. Based on the inter connecting neural networking system variation of connections it connects to generate a new idea whereas the other layer in it is used for detecting the consequences of the ideas. Dabus has invented two devices, one invention is different type of drinking container having different geometrical variations whereas the other is for attracting attention in cases of search and rescue operations. "Modern AI may fundamentally change how research and development takes place. In some cases, AI is no longer a tool, even a very sophisticated tool. In some cases, AI is automating innovation." Technology is moving in faster pace each and every day and to protect the same is very important as if left unprotected, the incentive and utilitarian objective of creating an invention for the people betterment will be foregone by the in inventor (Selvakumar, 2020).

Dabus can be protected with patent protection if a state allows it as a subject matter that is eligible for patent protection. Since AI is an invention of its own, the uniqueness to it, can be patented, while the name "Dabus" can be trade-

marked. However, there is an issue with any invention made by the AI. Since AI has knowledge of all the works that is inputted, its ordinary person skilled in the art would be another AI. So, when another AI is inputted with the same contents it might deliver the same result. It becomes difficult to assess the mechanism of intellectual property in this field. The same principle applies when it comes to the copyright protection, it is unclear on how the copyright protection can be given for an AI that has indefinite life term. It is equally unclear to make the IP rights overlap with each other.

So, for companies that develop AI as an integral part, they can gain protection for their invention, for any advertisement or copyrightable work that they do on their AI and any identification mark that they give to the AI. However, for the AI and on the subject matter that AI makes, the company cannot overlap the protection with patent, copyright and trademark as the jurisdictions are confused about how the law should govern the AI. So, the only IP that will cover the AI definitely is trademark. The identification mark cannot be given to any other AI, as the AI will be recognised immediately. Ex. Sophia the Robot, that talks and is given a citizenship in Dubai recognising the robot as a human.

4.2. Copyright and Trademark

Copyright and trademark are the two of the most overlapping rights, there are no certain restrictions when it comes to trademark protecting a subject matter that is copyrightable when used commercially nor does the Copyright Act in India exclude trademark protection (Bhatia, 2011). There are no restrictions that prevent the combination of copyright and trademark for a business or a single product of the business. Sec. 11(3)(b) of the Indian Trademarks Act,1999 states that any mark that is similar or same or infringing a copyright of another shall not be granted registration. A similar provision can be observed under the Indian Copyright Act, 1957 under Sec. 45(1) where any application for copyright registration shall not be considered for registration if it violates or conflicts with a registered trademark on the same subject matter. The copyright application should be accompanied by the no objectionable certification stating that there exists no violation of prior existing marks. It doesn't matter whether or not the copyright is registered, if it bears a TM of another and not falls within the exception of the Copyright Act, 1957 it would amount to infringement. To be specific when it comes to a person's character merchandising, copyright and trademark protection co-exist most of the time.

Character merchandising is using a character to promote a business and services. It is commercially exploiting a character through trade with both copyright and trademark protection. Character merchandising (Kewalramani & Sandeep, 2012): 1) Fictional or cartoon-based merchandising: Rests with the copyright owner of the cartoon in absence of license or contract. 2) Celebrity based merchandising is divided into two (Kumari, 2004): a) personality based: personally belonging to the celebrity b) Image merchandising: In case of specific con-

tract then copyright owner of the film will have rights over the image. Ex: Ironman, in case Robert Downey doesn't have a specific contract that Ironman relates to him as well, the creation of Ironman rests with the Copyright owner of the creator of ironman. A reason for obtaining the protection of copyright over a work is to stop the exploitation of work by others commercially and to prevent confusion and deceptive similarity in trade. The protection is given not on basis of quality but on the purpose and the original expression. The merge of trademark with copyright in Character Merchandising occurs when you use the character in business. Example: If someone copies or produces a similar work to the copyrighted work of Ironman comic and uses it in a business for commercial exploitation; to prevent confusion the protection of trademark comes to protect the identity. TM is basically about protecting the traders and consumers from being wrongly exploited either by deception, confusion or misrepresentation when a product or service or a mark is used in trade. Copyright covers the protection for artistic use. Copyright and Trademark prevents confusion and deception in the market. It is clever to use both to gain maximum advantage.

Overlapping of copyright and trademark protects various other players apart from consumers and traders such as competitors, creators, start-ups. Overtime expansion of intellectual property regime has changed the perspective of the intellectual property holders and consumers to merge various rights to obtain maximum advantage.

4.2.1. Angry Birds Copyright and Trademark Injunction Case

Rovio Entertainment Limited who owns the copyright of "Angry Birds" video game filed a complaint against the infringer Royal Plush Toys Inc., from California along with Jong K. Park company's president and other affiliated companies stating that the infringer manufactures and produces stuffed toys that are nearly identical to the birds from "Angry Birds" (Mandour & Associates, 2020). It would infringe the license agreement of the Commonwealth Toy and Novelty Co., Inc which produces angry birds toys based on the license agreement from Rovio. Consumers might mistake and confuse both products as Rovio's with same quality and get deceived. There is unjust enrichment by the infringer as they take away the effort of the Rovio company that incurs great deal of costs and time in creation of angry birds. Rovio started the game angry birds in the iPhone platform which has been downloaded billion of times and been recognised worldwide. The Rovio Company has copyright over the image, the concept and the characters that are used in the movie "Angry Birds". Rovio before the U.S. District Judge opted for temporary injunction which was denied by the Judge based on the fact that there is no proof that Royal Plush would destroy any evidences present among its property. However, a period of 14 days was given to Rovio to produce the records where Royal Plush have infringed Rovio's IP. Based on the identity even though Copyright is present, Rovio used trademark and the distinctiveness of the product to win the case based on merit. The District Judge has held that based on the confusion and the deceptive similarity of the product

which may rise to cause confusion among the public, it is violating the trademark of the Rovio in substantial similarity.

4.2.2. Disney Mickey Mouse

Disney have been extending their image of their characters, from mickey mouse to Cinderella to products such as stationary, clothing etc., for merchandising the products through their image in attracting the children. However, as the demand for the product and image is increasing so are the counterfeiting products (Intellectual Property News, 2020). Disney Enterprises Inc., is the owner of the trademarks (Registered & Unregistered) for all the Disney cartoon characters with copyrights and designs. There are many cases in which Disney sued another person for copying the character and using it commercially through the protection of trademark, since it serves and sources to Disney for identification. The consumers are deceived that the counterfeit products are actually authenticated products of Disney (WIPR, 2018). The cartoon characters of Disney Inc namely "Mickey Mouse" and "Minnie Mouse" have been held to be famous and popular around the world by the Hon'ble Supreme Court of India and hence was accorded the status of "well known marks" in the case of *Disney Enterprises Inc* & *Anr vs Gurmeet Singh* & *Ors,* CS(OS) 1451 of 2011. Disney got many injunctions and damages for using its cartoon characters commercially without obtaining prior permission or licenses. In the Indian case: *Disney Enterprises Inc & Anr vs Gurcharan Batra*, MANU/DE/4122/2011, selling school bags using Disney's cartoons was considered as infringement of trademark and permanent injunction was granted along with 1 Lakh Rupees as damage. Similar case of use of Disney characters in *Disney Enterprises Inc* & *Anr vs Harakchand Keniya*, CS (OS) 1254/2007 and *Disney Enterprises*, *Inc vs Mr. Rajesh Bharti* & *Ors*, CS(OS) 1878/2009 & I.A. 12833/2009, the Court ordered for permanent injunction along with 2 lakh Rupees damage compensation to be paid and in Rajesh Bharti's case a punitive damage of 3 Lakh Rupees along with the compensation was paid for producing Disney characters in bicycle. In 2014, Disney sued Balraj Muttneja for manufacturing, producing and selling chocolate with Disney wrappers, Disney Enterprises Inc. & Anr. vs Balraj Muttneja & Ors, High Court of Delhi, Civil Suit No. 3466 of 2012. In the case of Disney v. Santhosh Kumar for using various Disney characters such as "Micky mouse" "Minnie Mouse" "Winnie the pooh" "Donald Duck" and "Hannah Montana" for merchandising and selling such goods violating Sec.2(c) artistic character, liable under Sec.51 Copyright Act, 1957, infringing sec.29 of Trademarks Act, 1999 in India (Legitquest, 2020). A Local commissioner was appointed by the court to inspect the infringing products on the premises of defendants. It was observed that the average unit price of plaintiff's products were 120, the Local commissioner seized 2350 + 7900 goods in the premises of the defendants that incurred monetary loss amounts to Rs.12,30,000 (exclusive of taxes) to Disney (Lath, 2014). There are other trademark cases such as copyright and trademark protection over the use of tinkerbell (Mandour & Associates, 2013) copyright and trademark claim was also done

over the company characters for hire that has made unauthorized use of Disney's characters including Frozen's Elsa, Aladdin, Iron Man, Princess Aurora, Hulk, Mickey mouse etc., Disney claimed the exclusive use of the characters and dilution of trademark including modification of the same (Brachmann, 2017).

4.3. Trademarks and Designs

Sec.2(d) of the Designs Act, 2000 gives protection to designs which are capable of commercial production and that which are not trademarks. Any artistic works, shapes, package designs used for commercial purpose will be granted design protection as form of IP right provided they don't acquire any secondary meaning, acquired or inherent distinctiveness that makes them part of trademark (Wilkof & Basheer, 2012). Designs are granted for that which is solely judged by eye, only for visual perception, once the function of the design starts to be identified as the source indicator, it will be registrable under trademark and not under Designs Act, 2000 as the protection will cease to exist (Lexorbis, 2020).

Sec. 9(3)(b) of Trademark Act, 1999 states that a mark shall not be considered for registration or be registrable if the shape of goods is from the nature of the goods itself, Ex: Apple as a fruit when it is commercially sold as a fruit., or if the shape of goods is to obtain a technical result or the shape of goods that gives substantial value of the goods. If a design is solely for the purpose of visual appearance of the goods sold than the result is in technical effect rather than functional one. When the goods sold is recognised through the shape of the product then the effect is of functional one which can be registered under Sec.2(zb) of the Trademarks Act, 1999 (Basheer, 2012). Some packaging products have designs that do not contribute much towards the overall value of the product but when the design on the shape of the product has the substantial value to the overall worth of the product then it is excluded from registration under Trademark in the case *Carlsberg Breweries v Som Distilleries and Breweries* (2018) SCC OnLine Del 12912.

Trademark registration and Design registration cannot co-exist is known from the above explanation of the sections but can passing off action co-exist with Design registration?

In the 1983 case of Tobu Enterprises v Meghna Enterprises, (1983) PTC 359, the court gave a decision barring the plaintiff to get benefit and relief out of two statutes. He relied that there was infringement of unique design of the tricycle manufactured by the plaintiff along with the claim that the defendant was passing off his goods as if it were the defendants and causing loss of reputation and quality to the plaintiff. The Court said that the common law practice has to be given in a statute to claim a remedy, the Designs Act, 1911 does not permit the claim of passing off only the Trademark Act, 1958 does.

"The right against "passing off" is a common law right. But that right is subject to the provisions of a particular statute. In the present case …the (designs) act …does not provide for any remedy against any alleged passing off. Therefore,

no injunction can be issued on the ground that a defendant is likely to pass off his goods as that of the plaintiff …Had there been any intention of the legislature that the passing off would entitle a plaintiff to obtain an injunction, that could have been so expressly stated, as done in section 27 of the Indian Trade and Merchandise Marks Act, 1958", *Tobu Enterprises v. Meghna Enterprises*, (1983) PTC 359, Para 12-13.

The following case laws such as *SmithKline Beecham v. Hindustan Lever*, 2002 (25) PTC 243 Del, the Court held that for the same subject matter there can be overlapping of IP rights and such rights can be claimed in the Court of law. The facts of the case were similar to the Tobu Enterprises where the defendant infringed the plaintiff's registered design and passed off of the "S-shaped tooth brush". The Court held that rights can co-exist with one another and the registered design infringement can be claimed under Designs Act whereas the passing off can be claimed as the Common law rights provided by the Indian law.

In the 2011 case, *M/S Micolube India Limited v Rakesh Kumar Trading As Saurabh*, *Delhi High Court*, I.A. No.9537/2011 & I.A. No. /2011, took precedence from Tobu Enterprises decision and the Court held that there is no saving clause in the Designs Act, 2000. Since the plaintiff solely relied on the Designs Act infringement, he cannot accuse on passing off. The provision of saving clause given only in Trademarks Act, 1999, but the question framed in the Court of law is whether passing off is provided as a right under Designs Act. Designs Act is majorly kept for protection of the intellectual creations such as aesthetic patterns, designs made for visual perception whereas the sole purpose of passing off in the common law tort is for the trademark protection. The Judge relied on the dual protection doctrine of election to substantiate his Judgement. "There are three elements of election, namely, existence of two or more remedies; inconsistencies between such remedies and a choice of one of them. If any one of the three elements is not there the doctrine will not apply" (Mcghee, 2005). In the case of *Transcore v. Union of India*, (2008) 1 SCC 125, the case was decided that Designs Act, 2000 excludes the passing off action so the question of election does not arise.

However, Crocs USA v Aqualite India & Ors, (2019) SCC OnLine Del 7409 case: In light of this decision, a registered design will no longer be eligible for trademark registration. However, it clarified that even though a design cannot constitute a trademark, the relief of passing off may exist in a trade dress comprising "something extra" or something in addition to a registered design. For instance, the proprietor of a registered design in a strap of a shoe may claim the relief of passing off with respect to the overall trade dress of the shoe (which would exclude the strap). As a trade dress apart from the design protection, the claim maybe allowed (Brijesh & Seth, 2019).

4.4. Trademarks and GI

Geographical Indication (GI) is an IP right that indicates the origin of the goods

by the quality and recognition, such as turmeric, Palani Panchamirutham, Basmati Rice etc., which are registered in Sec.2(1)(e), Geographical Indications of Goods (Registration and Protection) Act, 1999. GI is different from appellation of origin followed in the EU. Appellation of origin requires the production from raw materials till end product to be made from one place but geographical indications simply require the raw material to origin from one place. There is not much difference from trademarks but the registration of GI as a trademark is prohibited and will be absolutely refused by the registrar at the time of application under Sec.9(1)(b) of the Trademarks Act, 1999. Trademark is an individual right while GI is a community tag. Trademark carries with it the protection of many elements of a product as a mark however GI specifically focuses only on the origin and source along with quality as per Art.22 of TRIPS Agreement. Sec.25 of the Geographical Indications (Registration and protection) Act, 1999 of India states that there shall be cancellation of trademark containing GI in case it causes confusion amongst the consumers on the good's origin or source. However, if a mark has obtained a distinctive secondary acquired meaning, then trademark can be granted over the GI. Example of such cases can be the *Tea Board, India v. ITC*, CS 250 of 2010, whereby ITC named a lounge called as "Darjeeling Lounge" as a service mark in a five-star hotel in Kolkata called as "Sonar Bangla". GI Act extends only to goods and not services so ITC had a valid usage. Along with that the Court said that Trademarks Act, 1999 Sec.75-78 specifies that in case of certification of a mark, it can extend only to the specific class in which it is registered not to other class of goods and services. Here Darjeeling is only for tea whereas in ITC usage it is a service for food and refreshments. In case of passing off, the Court held that the defendants and the plaintiffs are engaged in different services and goods, they were not competitors to be passing off (Khaitan & CO, 2019). Similarly, for secondary and acquired distinctive meaning the *Imperial Tobacco Company of India ltd v. Registrar of Trademarks*, AIR 1968 Cal582, where the registrar of TM didn't grant the registration for a product containing the word "Simla" considering that it is a GI and the usage of Simla in tobacco could present that the product is specifically from that origin. Sales is not enough to submit as evidence for distinctiveness but the acquired distinctiveness has to be seen from the consumers, traders, intermediaries and competitors which the "Simla" Tobacco failed to establish. In case in future a person who is from Simla wants to manufacture cigarettes, it would be difficult for him if TM is granted for the mark "Simla" as TM is a private exclusive right (Rastogi, 2015). In EU, a company used DEVIN for the product mineral water but Devin is a geographical place name. However, Devin established secondary meaning as consumers in the very own town knew that Devin is a mineral water company trademark. The whole of Bulgaria knows about Devin and it provided evidence for secondary acquired distinctive meaning to the trademark. Thus, rendering it possible for registration (DEVIN and the EU IP Office) Similar cases in EU for well-known Trademark is Vittel and Evian (Weickmann & Weick-

mann, 2019).

4.5. GI of Tequila

Tequila is considered to be originating from Mexico having its own bottle designs carrying various Mexico's characteristic symbols. This drink is produced only in certain specific areas in Mexico that grow a cactus-like agave plant which serves as a raw material for production of the tequila. Tequila is protected under the IP Regime-Geographical Indication of Mexico which is acknowledged and declared as Presidential Decree, 1977. Tequila should be produced only in the five states of Mexico. Lisbon Agreement Protection of Appellate of Origin protects "Tequila" as Appellation of origin. This prevents the counterfeit goods with substitutes or different ingredients to make tequila from being sold, thus tainting of tequila product is prevented.

4.6. Trade Secret and Trademark

Trade secret is mostly a strategy used by a company to sustain the market for infinite endless period. Trade secret doesn't have a specific protection period like patent for 20 years and copyright for life + 60 years. It lives as long as the business lives. One disadvantage of the trade secret is that the company cannot enforce its exclusivity in the Court or anywhere, once they do so, the secret don't remain a secret anymore, it will be out in the public domain for anyone to use. There are lot of Companies that use Trade Secret as their strategy such as KFC, Coco-Cola. They keep the secret and use their trademark to sell the trade secret. People love to explore something that is hidden, in that journey of exploration the trademark recognition shall rise to give the market advantage and consumer loyalty.

4.7. Critical Analysis

From the above brand analysis of the various intellectual property rights, it is evident that the brands overlap trademark with other IP rights, in placement for ever-greening of IP. With everlasting protection and commercial standing in the market, the above brands have stood the test of time to be a successful both commercially and economically. Although the patent protection granted exclusive reign to a company for 20 years along with copyright protection for over 60+ years to literary, dramatic, musical and artistic works, it may be concluded from the research and analysis of the brands that it is the trademark protection which effected an efficient edge in the market for eternity in consumer's mind as it overlapped with other IP rights.

5. Infringement

Passing off or infringement occurs when a person uses the IP asset without the authorization or consent from the business thereby violating the exclusive right granted to a person under Sec.29 of TM Act, 1999 of India invoking sec.102 &

103 of TM Act as falsely using the registered mark in case of registered TM. In case of character Ex: Walt Disney uses Belle and does t-shirts, makeups etc., if another business uses Belle's face in a t-shirt for commercial purpose, then it would amount to unauthorized character merchandising. Passing off can also be claimed in case of unauthorized use. Ex: Kylie Jenner's KYLIE cosmetics up to date hasn't been registered as TM but have sued and faced cases in and about 3 - 4 for using the mark similar to Kylie.

6. Critical Analysis and Conclusion

Using effective management on IP strategies, one brand or business may hold the business edge for indefinite period. There are case laws that are decided on the basis of the overlapping of IP, however some IP rights in relation to trademark can't co-exist together, and one good example would be GI and Designs. However, most commercial and business industries that have patent and copyright, overlapping of trademark will occur naturally for the protection amongst competition. Trademark needs to have the distinctiveness proof to be registrable in the IP Office. Usually, dual protection isn't allowed as such but a single product may contain different IP Protection unless barred by a statutory right. For Design and TM, the dual protection is not applicable, but for Copyright and TM dual protection is applicable (Ex: Character Merchandizing). Overlapping of Copyright, Patent, TM, the protection for the Function, Expression and Identity is available. Expired Design can't be registered as TM unless it has acquired a secondary distinctive meaning. There can be overlapping of IP, however, it is not considered as an ever-greening process but rather a process of recycling.

Conflicts of Interest

The author declares no conflicts of interest regarding the publication of this paper.

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