

PRINCIPLES OF INTELLECTUAL PROPERTY (2014). By N.S. Gopalakrishnan and T.G. Agitha. Eastern Book Company, 34 Lallbagh, Lucknow. Pp. XLVIII+619. Price Rs. 535/-.

THE BOOK¹ under review is unique in the sense that the authors have successfully covered important topics on the basic principles of intellectual property through a case study method. The book does exceedingly well in explaining the situation in India through a comparative approach. The “Introduction” gives an insight into the reasons for the sudden importance of intellectual property in different countries and the difference in incorporation of the laws among the developed and developing nations. The authors go on to emphasize the role played by the TRIPS Agreement in the introduction of an IP standard across the globe. There has been an obvious conflict between the intellectual property legislations that have focused on rewarding creators and inventors and the objective of providing access to science, technology and culture.² It has been asserted that the post TRIPS scenario resulted in the domination of the commercial businesses over the owners’ rights. Therefore, a balance must be struck between the rights of the owners and the interest of the business sector, and the public at large. The present day IP norms are more favourable towards the international traders and thus, there is a rising concern that developing countries would focus more on economic development and international trade than on providing the basic needs of the citizens.³ As a continuation of this trend, strict IP laws have been enacted that has restricted dissemination of information. This situation has in turn resulted in an enormous growth on the availability of open source software on the internet. The IP ecosystem especially the one in India has been subjected to a lot of debates and deliberations. So far the judicial decisions in India have mostly followed English cases as precedent. Critics feel that the courts should decide a case after looking into its wider implications on the Indian society and not simply based on English laws.⁴ The implications of IP legislations and its effects have thus assumed a very important role over the past decade.

The book begins with the “Conceptual Basis for Intellectual Property Protection” through an assessment of the minimum standards required under copyright, patents, designs and trademarks. Copyright and the concept of originality have been discussed with reference to literary works with a special reference to databases, case reports and computer programs in the framework of the idea-expression dichotomy. Although

1 N.S. Gopalakrishnan & T.G. Agitha, *Principles Of Intellectual Property* (2d ed., 2014).

2 *Id.* at XLII.

3 *Id.* at XLIV

4 *Id.* at XLVII

there are sufficient cases covering the aforementioned literary works, the concept of originality in computer programs in India is a fairly new topic with no reported cases so far. Therefore, looking beyond the Indian jurisdiction the book has referred to the jurisprudence that has developed in the US case, *Computer Associates International Inc. v. Altai Inc.*⁵ It laid down three tests in evaluating the originality of a computer program – abstraction, filtration and comparison. The concept of novelty, inventive step and utility has been discussed with regard to patents. It has been said that an invention has to be “new enough so that it has not been anticipated by the public and is not obvious to a person of ordinary skill”.⁶ Especially in the area of pharmaceuticals, the test of inventive step has undergone a lot of advancements. This is reflected in the recent case *Novartis AG v. Union of India*.⁷ The Supreme Court of India held that the 2005 amendment to the Patents Act has brought in a higher standard of inventive step for grant of a patent. The first chapter in the book has discussed the tests of originality and novelty in case of a design. It stated that the originality of a design is linked to its application and the purpose.⁸ Novelty on the other hand should ensure that a design is different and the test of novelty must be perceived through the eyes of a consumer. The task of identifying novelty should not be a difficult task.⁹ The authors referred to *Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd.*¹⁰ where three important questions on the originality of a design prior to its registration have been considered. The cases of *Hello Mineral Water (P) Ltd v. Thermoking California Pure*¹¹ and *Glaxo Smithkline Consumer Healthcare GMBH & Co. v. Anchor Health & Beautycare (P) Ltd.*¹² discussed in this chapter covered the aspect of novelty in a design.¹³ The last segment is on trademarks. For trademarks, distinctiveness is a requirement and a trademark can either be inherently descriptive or can acquire distinctiveness with extensive use.¹⁴ The test of deception and confusion in relation to trademarks has been nicely covered in the book. If a mark causes confusion with respect to its origin from the point of an average man, it shall cease to be registrable.¹⁵ The concluding section of this chapter covers the test

5 982 F 2d 693 (3rd Cir 1992).

6 *Lallubhai Chakubhai Jarivala v. Shamaldas Sankalchand Shab*, AIR 1934 Bom 407. (2013) 6 SCC 1.

8 *Gammeter v. Controller of Patents and Design*, AIR 1919 Cal 887.

9 *Glaxo Smithkline Consumer Healthcare GMBH & Co. v. Anchor Health & Beautycare (P) Ltd.*, (2004) 29 PTC 72 (Del).

10 (2008) 10 SCC 657.

11 2000 Arb LR 491 (Del).

12 2004 (29) PTC 72 (Del).

13 *Ibid.*

14 *National Bell Co. v. Metal Goods Mfg. Co. (P) Ltd.*, (1970) 3 SCC 665.

15 *Amritdhara Pharmacy v. Satya Deo Gupta*, AIR 1963 SC 449.

of acquired distinctiveness for trademarks and its distinction from “adapted to distinguish”.

Chapter 2 of the book discusses the subject matter of intellectual property protection under copyright, patents, and trademarks. Under literary works, the authors have examined the status of question papers.¹⁶ Further, the authors have suggested that a typeface does not fall within the definition of artistic work due to restrictions of *ejusdem generis*,¹⁷ thereby reaffirming that copyright exists in the entire work and not on a single alphabet. In the comparison to the situation in India, the British copyright Law has however been amended to include typefaces within the purview of artistic work.¹⁸ The realm of dramatic work has been covered in *Fortune Films International v. Dev Anand*.¹⁹ The case considered whether a performance by an actor is covered within the definition of artistic or dramatic work. Further, there is mention of musical work and computer program. If the aforementioned issues relate to copyright, this chapter considers the niche area of pharmaceuticals under patents. The book goes on to talk about the test of inventive step in pharmaceuticals. In *Novartis AG v. Union of India*,²⁰ the Supreme Court of India looked into the issue of inventiveness in a pharmaceutical patent. The Supreme Court has also stated that biotechnological inventions can be interpreted as a subject matter under patents.²¹ This change in law was brought about by the 2002 amendment to the Patents Act. The concept of patent protection of computer programs has been debated in India. Till the 2002 amendment to the Patents Act, it was believed that computer programs cannot be protected. The chapter suggests that the introduction of section 2(k) left an uncertainty as to what types of computer programs are patentable. The third part of this chapter considered the fate of registrable marks. Under this category, the authors have tried to see whether a geographical name is capable of creating distinctiveness in a good and thus becomes entitled to registration under the Trademarks Act.²² The present law in India is that “if the geographical name propounded for registration is that of a country or a district of commercial importance, the mark cannot be registered.”²³ This chapter has also dealt with well-known marks and their use in India. Chapter 3 talks about the rights of owners of intellectual property. In this chapter, the authors have considered the rights under

16 *Agarwala Publishing House v. Board of High School & Intermediate Education*, AIR 1967 All 91.

17 *Ananda Expanded Italics (reg)*, RE (2002) 24 PTC 427

18 *Ibid.*

19 AIR 1979 Bom 17; (1978) 80 Bom LR 263.

20 *Supra* note 7.

21 *Dimminaco A.G v. Controller of Patents & Designs*, 2002 IPLR 255 (Cal).

22 *ITC Ltd. v. Registrar of Trademarks*, (1950-2000) 23 Supp (2) PTC 533 (Cal).

23 N.S. Gopalakrishnan & T.G. Agitha, *supra* note 1 at 188.

copyright law namely economic rights, moral rights, right of communication to the public and the co-existence of rights of different works. Economic rights include the right of reproduction, right of adaptation, communication rights, public performance rights, translation rights, *etc.* This section is followed by the rights under patent law and the exhaustion of rights under copyright and trademark. It has been asserted that the owners of copyright of a cinematograph film can claim damages for infringement only if the new film is a physical copy or actual duplication of the original film.²⁴ Even production of the same film by another person does not lead to the infringement of copyright. If an industrial production is substantially drawn from an existing drawing, it leads to the infringement of copyright.²⁵ The Copyright Amendment Act 2012 ushered in a new definition of “communication to public”. According to the authors, it is still unclear as to whether the transmission of work through computers falls within the ambit of communication to public.²⁶ In the case *Garware Plastics and Polyester Ltd. v. Telelink*,²⁷ the issue was whether the showing of a video film by a person not having the copyright to the video amount to communication of the film to the public. The court gave an affirmative response and stated that broadcasting can amount to communication keeping in view the relationship between the owner of the copyright and the audience, and also the nature of the audience who views the broadcast. The Indian courts have also expanded the scope of the right to communication to the public by recognising newer modes of broadcasting like video broadcasting and satellite broadcasting.²⁸ The book goes on to discuss about the moral rights of an owner of copyright. The Copyright (Amendment) Act 2012 inculcated moral rights under section 38 B. Section 57 of the Copyright Act has been interpreted in this chapter to include the right against destruction of a work of art as a moral right.²⁹ The book also talks about the co-existence of rights of different works, economic rights under the Copyright Act and rights under the Patent Act.³⁰ Further, the authors have discussed the related rights under copyright Act in the background of *Fortune Films International v. Dev Anand* and *ESPN Star Sports v. Global Broadcast News Ltd.*³¹ The chapter

24 *Star India (P) Ltd. v. Leo Burnett (India) (P) Ltd.* (2003) 27 PTC 81 (Bom).

25 *Escorts Construction Equipment Ltd. v. Action Construction Equipment (P) Ltd.* (1999) 19 PTC 36 (Del).

26 N.S. Gopalakrishnan & T.G. Agitha, *supra* note 1 at 222.

27 AIR 1989 Bom 331.

28 *Video Master v. Nisbi Productions* (1998) Arb LR 47 (Bom)

29 *Amar Nath Sehgal v. Union of India* (2005) 30 PTC 253 (Del).

30 *Indian Performing Right Society Ltd. v. Eastern India Motion Picture Assn.* (1977) 2 SCC 820.

31 AIR 1979 Bom 17; 2008 (38) PTC 447 (Del).

ends with a part on exhaustion of rights covering copyright, patents and trademark law.³²

In chapter 4 the authors discuss “Ownership and Transfer of Intellectual Property Rights”. The first part of the chapter deals with authorship and ownership of copyright in the context of joint author. In this context, the authors said that the creators/ authors are the initial owners or first owners of copyright. In *Najma Heptulla v. Orient Longman Ltd.*³³ it was ruled that “if two persons collaborate with each other and, with a common design, produce a literary work then they have to be regarded as joint authors.” The chapter also discusses the true and first inventor and the patentee. *V.B. Mohammed Ibrahim v. Alfred Schafrank*³⁴ answers the question if a firm can be treated as an inventor. The chapter also deals with intellectual property rights during employment.³⁵ If a work is done in the course of employment and under a contract of service, the ownership vests with the employer, unless there is a contract to the contrary. According to the authors, there has not been a significant attempt by the Indian judiciary in the field of intellectual property law to distinguish cases of contracts of service from contracts for service.³⁶ The case *Indian Performing Right Society Ltd. v. Eastern India Motion Picture Association*³⁷ takes up the issue whether the producer of a cinematograph film can defeat the right of the composer of music or lyricist by engaging him. The chapter focuses on transfer of copyright as well. The Indian Copyright Act recognizes licenses and assignment as the two methods of copyright transfer. In *Raj Video Vision v. K. Mohankrishnan*³⁸ it was said that when producers are not aware of their rights accrued to them due to scientific advancements, it cannot be said they have already transferred the rights not in existence by way of assignments. The last part of this chapter considers the issue of assignment of trademark involving trafficking in trademarks. In *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*³⁹ the court opined that it is just and proper to register one or more articles under a class or genus if in reality registration only in respect of such articles is intended, by specifically mentioning the names of such articles and by indicating the class under which such articles are to be comprised.

Chapter 5 gives an insight about “Public Interest and Intellectual Property Rights”. The chapter begins on a note that public interest is involved in the protection of

32 *Kapil Wadhwa v. Samsung Electronics Co. Ltd.* (2012) 53 PTC 112 (Del.); *John Wiley and Sons Inc. v. Prabhat Chander Kumar Jain* (2010) 44 PTC 675 (Del); *Penguin Books Ltd v. India Book Distributors*, AIR 1985 Del 29.

33 AIR 1969 Del 63.

34 AIR 1960 Mys 173.

35 N.S. Gopalakrishnan & T.G. Agitha, *supra* note 1 at 318.

36 *Id.* at 323.

37 AIR 1977 SC 1443.

38 AIR 1998 Mad 294.

39 AIR 1996 SC 2275.

intellectual property. While protecting copyright, the government is always concerned with the maintenance of balance between the right of the copyright holder and public interest in using the work. The authors identified promotion of growth of knowledge as the primary objective behind protection of intellectual property. This chapter referred to the freedom that a country may enjoy, while setting up the limitations and exceptions to intellectual property rights as long as there is compliance of the three-step-test developed under the TRIPS agreement.⁴⁰ The chapter then proceeds to discuss on the concept of fair dealing under copyright and the interplay between the concepts of public domain and fair use.⁴¹ The Indian law deals with cases of fair dealing on the basis of the “principles of modicum of creativity, access and affordability with respect to social, economic, educational and industrial considerations of the society.”⁴² There is a brief reference to the exceptions under the Patents Act before the section covering trademark and fair use. In case of trademarks, there is no explicit application of the concept of fair use. In *Tata Sons v. Greenpeace International*⁴³ it was held that the concept of fair use of trademark will be judged based on public interest. The authors next deal with the differences between statutory and compulsory licensing and the justifications behind using statutory license or compulsory licences under copyright and patents.⁴⁴

Chapter 6 discusses the “Infringement of Intellectual Property Rights and Passing Off”. The chapter starts by explaining primary and secondary infringement in case of copyright with reference to *R.G. Anand v. Delux Films*, *Zee Telefilms Ltd v. Sundial Communications (P) Ltd* and *Super Cassettes Industries Ltd v. Myspace Inc.*⁴⁵ A copyright in a work is said to be infringed if it is used by another person without the permission of the exclusive owner of the copyright. The authors highlighted the difficulties in ascertaining the parameter for infringement in the framework of idea/expression dichotomy.⁴⁶ One option could be the abstraction test as formulated in *Nichols v. Universal Pictures Co.*⁴⁷ If after abstraction the portions are found to be substantially similar to the original work, it will be an infringement of copyright. The Supreme Court has also held that an expression of a concept can be copyrighted but a concept

40 N.S. Gopalakrishnan & T.G. Agitha, *supra* note 1 at 369.

41 *Syndicate of Press of University of Cambridge v. B.D Bhandari* (2005) 31 PTC 58 (Del); *Academy of General Education v. B. Malini Malhya* (2009) 4 SCC 256; *Civic Chandran v. AminiAmmu* (1996) 16 PTC 670.

42 N.S. Gopalakrishnan & T.G. Agitha, *supra* note 1 at 379.

43 (2011) 178 DLT 705.

44 *Entertainment Network (India) Ltd. v. Super Cassette Industries Ltd.*, (2008) 13 SCC 30; *Bayer Corporation v. Union of India*, OA/35/2012/PT/PTIMUM, decided on Mar. 4, 2013.

45 (1978) 4 SCC 118; (2003) 27 PTC 457 (Bom); (2011) 49 PTC 49 (Del).

46 N.S. Gopalakrishnan & T.G. Agitha, *supra* note 1 at 436.

47 45 F 2d 119 (2d Cir 1930).

per se is not copyrightable.⁴⁸ The issue of secondary infringement has been discussed in the context of the liability of internet service providers. In *Super Cassettes Industries Ltd. v. Myspace Inc.*,⁴⁹ the court interpreted section 51 of the Copyright Act, 1957 to include not only entertainment but also other spaces in the internet within the purview of the Act. Subsequent to the part on copyright the authors have considered the issue of infringement of pharmaceutical patents with reference to the recent decision in *F.Hoffman-LA Roche Ltd v. CIPLA Ltd.*⁵⁰. Other than copyright and patents this chapter also covers trademark, passing off and several other important topics like functional designs, character merchandising, ambush marketing, domain name disputes and infringement of geographical indications.⁵¹In *Pepsi Co. Inc. v. Hindusthan Coca Cola*,⁵² the court dealt the issue of comparative advertisement and whether the use of trademark in the course of trade constituted the infringement of an existing well known trademark. In case of a design, the infringement can be judged by matching the old design with the newly registered design and in the instance of substantial similarities.⁵³

Chapter 7 talks about the “Enforcement of Intellectual Property Rights”. The chapter classifies the remedies under three divisions: civil, criminal and administrative duties. Civil remedies like injunction, damages, accounts of profits, *etc* are available. In *Novartis AG v. Mehar Pharma*,⁵⁴ the Bombay High Court stated that an “interlocutory injunction will not be granted where damages will provide an adequate remedy should the claim succeed”.⁵⁵ There has to be a balance of convenience to determine the civil remedy that is to be adopted by the court. The authors go on to discuss the Anton Piller Order which was first laid down by the Court of Appeal in England.⁵⁶ The Indian courts have interpreted order 39 rule 7 of the Code of Civil Procedure in a similar manner. Section 55 and 58 of the Copyright Act⁵⁷ gives a person a right to

48 *R. G. Anand v. Delux Films*, AIR 1978 SC 1613.

49 (2011) 49 PTC 49 (Del).

50 (2012) 52 PTC 1(Del).

51 *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* (2001) 5 SCC 73; *Smithkline Beecham Plc. v. Hindustan Lever Ltd.*, (2000) PTC 83 (Del); *Star India (P) Ltd. v. Leo Burnett (India) (P) Ltd.* (2003) 27 PTC(Bom); *ICC Development (International) Ltd. v. Arvee Enterprises*, (2003) 26 PTC 245 (Del); *Yaboo Inc. v. Akash Arora* (1999) 19 PTC 201; *Scotch Whiskey Assn. v. Pravara Sabakar Shakar Karkhana Ltd.* AIR 1992 Bom 294.

52 2001 PTC 699 (Del).

53 *Britannia Industries Ltd v. Sara Lee Bakery*, AIR 2000 Mad 497.

54 (2005) 30 PTC 160 (Bom).

55 *Ibid.*

56 *Piller (Anton) KG v. Mfg. Processes Ltd* (1976) 2 WLR 162.

57 Copyright Act, 1957.

recover damages in cases of infringement and conversion of intellectual property respectively. However, a patentee is not entitled to both a right to account of profits and an inquiry into damages.⁵⁸ The Copyright Act and the Trademark Act provide for criminal remedies but there is no such remedy in case of infringement of a patent or a design. In order to prove *mens rea*, there is a need to prove the person knew that his act would cause infringement.⁵⁹ Under “Administrative Remedies”, the authors discuss the various cross border movement of goods and goods in transit that result in difficulty in dealing with the issues of infringement of intellectual property. The protection of intellectual property can also be enforced through the Drugs and Cosmetics Act. The purpose of section 156 of the Patents Act, however, is not to enable the Drugs Controller to uphold the patent but to provide for a negative obligation on the government not to infringe a patent.⁶⁰

Some reflections:

In the introductory chapter, this book has rightly pointed out the delicate balance between auguring incentive through the enactment of intellectual property legislations and the need for such legislations. Although the chapter gave a broad overview of the requirement of balance, there is no mention of the European Database Directive.⁶¹ Critiques have argued that this directive is one of the glaring examples of how legislation may tilt the balance in favour of the publishers by offering limited exceptions for other use including private access.⁶² The idea behind the passage of the directive was to create an atmosphere of confidence amongst European publishers. It was believed that with the protection in place, European publishers will invest more towards the production of databases that are non-original by copyright standard.⁶³ Even after the passage of the directive, the number of databases remained the same if one draws a comparison with the number prior to such passage.⁶⁴

58 *Pillalamarri Lakshmi Kantam v. Ramakrishna Pictures*, AIR 1981 AP 224.

59 *Sheo Ratan Upadhyaya v. Gopal Chandra Nepali*, AIR 1965 All 274.

60 *Bayer Corporation v. Union of India* (2010) 43 PTC 12 (Del).

61 Council Directive of 1996/9/EC of 27 March 1996 on the legal protection of databases [1996] OJ L 77/20.

62 Mark J Davison, *The Legal Protection of Databases* (Cambridge University Press Cambridge 2003); Annemarie Beunen, *Protection for Databases: The European Database Directive and its effects in Netherlands, France and United Kingdom* (Wolf Legal Publishers Leiden, 2007).

63 ‘DG Internal market and services working paper: First Evaluation of Directive 96/9/EC on the legal protection of databases (*Commission of the European Communities*, Dec.12, 2005), available at: <http://ec.europa.eu/dgs/internal_market/evaluation/evaluation_data_basesdirective.pdf> last visited on Oct. 20, 2008.

64 *Ibid.*

While considering the originality in databases, there is a pre-conceived notion about the nature of databases. It has been suggested that databases are electronic compilations.⁶⁵ This means that databases can only be electronic in nature. In reality, compilations in paper format can still be considered as databases and it depends on how one defines a database. If one were to follow the definition of a database defined under the database directive, compilations in paper format would still be considered as databases. This is primarily due to the broad nature of the definition.⁶⁶ The book covers the issues surrounding the geographical indications but to a great extent remains silent on the issues of traditional knowledge and traditional cultural expressions. In the context of a developing country or country in transition, these issues are of vital importance. There is however a question included under general points for discussion in chapter 2. This question essentially asks the readers to assess the scope of treating traditional knowledge as a subject-matter for intellectual property protection.

This book provides an excellent platform providing endless opportunities to do further research in the multi-faceted discourse surrounding the application of intellectual property laws. The additional materials provided at the end of each chapter are simply outstanding and exceptional. Furthermore, the book provides a comparative perspective of the application of copyright, patents, designs and trade mark laws. The present edition has included latest case law on the topics and so is well updated. On an overall note, this book would require the readers to have a basic knowledge of intellectual property legislations before they can utilize the book to its true potential.

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65 *Supra* note 1 at 10.

66 Art. 1, Council Directive 96/9/EC.

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