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Inaugural Issue

IPEXELS

The Monthly Newsletter
of
Intellectual Property Analysis and Advocacy Center
National Law University Odisha



GUEST MESSAGE



MR. VIKRANT RANA

Managing Partner,
S.S. Rana & Co.

Intellectual Property in 2022 – Adapting to Disruptive Tech and Looking Back at the Effects of COVID-19 to Intellectual Property.

I am very excited to be a part of this new era of IP sensitization being undertaken by NLUO, and am glad to see this fine institution, with whom the association of our firm S.S. Rana & Co., stretches back to 2015, when we welcomed our first Associate from NLUO in our midst from the University's very first batch! The vision of the IPAAC is one which will surely lead to greater impact and involvement of academia in the realm on Intellectual Property.

As we usher into 2022, it is evident that concepts like Metaverse and NFTs and Crypto and Blockchain, will be the talk of the town for the next few months, if not years! However, one cannot simply wash away the memories of COVID-19 with the promise of future tech developments and the prospect of a new virtual environment. Thus, while looking back at 2020-2021, and visualizing where the world of Intellectual Property lies in the future, one must holistically look at IP developments and state of affairs with respect to a wide variety of topics – from patenting of vaccines and patent waivers, to the role of IP in this new world of disruptive technologies like those pertaining to NFTs and Metaverse.

GUEST MESSAGE



While India is certainly not a novice in the realm of Intellectual Property and is neither a jurisdiction wherein IP assumes a background role, there have nevertheless been wholesale changes and improvements in IP jurisprudence in India in the last few years. In fact, IP filings in India have steadily increased year by year. For instance, in 2015-16, 46,904 patent applications were filed in India, and in comparison, there were 56,279 filings in 2019-20! This shows how India is on its path to become one of the leading innovation hubs in the world. Similarly, trademark filings in 2019-20 were 3,34,805, in comparison to 2,83,060 in 2015-16. Thus, IP has become a force of nature, which simply cannot be relegated to the backbench in this day and age, especially with all these new exciting developments in the tech world in the making. This ever-growing IP ecosystem in India is further bolstered by the active participation and incentives offered by the Indian Government.

GUEST MESSAGE



**INTELLECTUAL
PROPERTY INDIA**

PATENTS | DESIGNS | TRADE MARKS
GEOGRAPHICAL INDICATIONS

For instance, on 25th January 2021, the Department for Promotion of Industry and Internal Trade (DPIIT) had published the Designs (Amendment) Rules 2021. The Amended Rules brought about some major changes in the Design Rules. The New Rules recognize start-up as an “applicant criteria” and shows a clear reduction of 75% of the Filing Fee of Designs. Another very relevant example of this is the release of the Patents (Amendment) Rules, 2021, which entailed a rebate of up to 80% rebate on Patent fees for Educational institutions.

In addition to the above, as a result of the pandemic, the Indian IP Offices as well as Courts in India (as well in many other countries) have successfully embraced the Virtual Modes for most proceedings. For instance, a substantial number of hearings of IP matters before various IP Offices, whether it be trademarks or patents, are now undertaken via virtual modes. This is a change which has been welcomed by a large number of practitioners. With the way the world of Metaverse is being envisioned by certain corporations, who knows, maybe even hearings and court proceedings may be conducted in the ‘Metaverse’ in future!

GUEST MESSAGE

I would hope that the IPAAC newsletter would be the vessel, which shines light upon such interesting IP issues and developments in the world of academia, and lead to greater co-operation between universities and the legal industry vis-à-vis Intellectual Property.

FACULTY MESSAGE



RUJITHA T.R. SHENOY

Assistant Professor of Law
National Law University Odisha

National Law University Odisha (NLUO), has always moved forward with a focus on deciphering and developing the legal domain, through timely ventures and opportunities in the wide ambit of law. Inclusive to this idea of structured growth, and moving ahead legal academia, NLUO fosters a culture of research and student led development. To this extent, there are multiple student run communities and research centers helped along towards various niche fields of law. They work to fruition on their specific domains, with events held, and also interactions within the legal community.

Under the aegis thus of Intellectual Property Analysis and Advocacy Center (IPAAC), NLUO also stems towards aspects in the intellectual property field, developing various aspects within the domain including promoting discourse, allowing academic opportunities and moving ahead the spectrum of legal thought, in an area as technical and wide reaching, and contemporary relevant as Intellectual Property Rights (IPR). IPAAC has since its inception, and functioning forwarded various avenues of discussions, including holding Web Sessions on topics for discussion with eminent panel members, who represent this field at the legal forefront. Furthermore, holding workshops, and other competitions to encourage student involvement and development from within and beyond NLUO.

FACULTY MESSAGE

The Center envisions to broaden perceptions within the Intellectual Property Domains, and encourages avenues of discourse and perceptiveness, not just within its bounds of NLUO but also beyond. On that note, it is highly encouraging to see developments within the center which is now moving towards its own Newsletter publications. IPEXELS, the Newsletter being forwarded for the community at large, in my opinion, seeks to ensure that there are timely updates on Intellectual Property Rights domain, which holistically examines and encompasses different facets. It also acts as a hallmark, for developments and discussions as opinion editorials for the various stalwarts in these fields who further the boundaries of the subject matter.

I wish this venture extreme success, and look forward to seeing developments on the Newsletter forthcoming.

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PATENTS



PATENTS



The Belgian Health Care Knowledge Centre (KCE) recently released an interesting report titled ‘Compulsory licensing for expensive medicines’. This report comes at an opportune moment. Public attention for intellectual property rights and the role it plays in the pharmaceutical sector has significantly revived due to Covid 19. The report does not focus on compulsory licenses (CLs) in emergency situations (like the Covid pandemic), but on the potential to use compulsory licenses for ‘excessively priced’ medicines outside of emergency situations.

Wealthy nations like the European Union (EU), the United Kingdom (UK), and Switzerland have been opposing and stalling the landmark TRIPS waiver for over a year now. The details of the initial proposal made by India and South Africa are available in the MSF briefing document [here](#). To break the stalemate, the EU, India, South Africa and the United States (quadrilateral discussion group) are working on a possible compromise in close door discussions, which will be presented to other WTO members, possibly this week for deliberation. Stat News has put out a ‘leaked text’ which gives insight into the proposed solution of the potential compromise.



PATENTS

The WIPO General Assembly, on July 21, 2022, approved to move to diplomatic conferences for two proposed international agreements – one, covering protection of designs and the other, on intellectual property (IP), genetic resources and traditional knowledge (TK) associated with genetic resources.

Diplomatic conferences are negotiating rounds which can result in the adoption of multilateral treaties. WIPO members have approved convening of diplomatic conferences for the two proposed treaties no later than 2024. The proposed Design Law Treaty (DLT) seeks to streamline global systems for protection of designs. It aims to make cross-border acquisition and protection of design rights significantly easier for small-scale designers from low and middle income countries. The overall objective is to help designers obtain easier, faster and cheaper global protection for their designs.

The WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) started work on simplification of procedures for protection of designs in 2006. The work of the SCT has resulted in draft articles and regulations for a treaty. (2016 draft [here](#))

The DLT has been styled as a ‘formalities treaty’ aimed at streamlining administrative processes. However, there have been diverging views on certain substantive issues e.g. Article 3 (contents of applications) and the related requirement to disclose source of traditional cultural expressions, traditional knowledge or biological / genetic resources used in the industrial design.



PATENTS



A case of double-speak on pharma patents-

As the year comes to a close, one major highlight has been the proposal at the World Trade Organization of Indian and South African governments to waive intellectual property (IP) rights, including patents, for medical tools. If the proposal is approved, it will pave the way for access to Covid-19 vaccines, medicines and other health products for developing countries. India can do the same for Covid-19, TB and other diseases, if the Government takes lead at the WTO against IP barriers. India's generic industry helped in fighting the HIV/AIDS epidemic by producing low-cost drugs for developing and developed nations.

India's number of patents granted almost triple in 5 yrs, moves up in GII rankings-

India recorded an almost threefold increase in the number of patents granted in the last five years. . It has pushed India up the Global Innovation Index rankings by more than 20 notches. The Department for Promotion of Industry and Internal Trade (DPIIT) coordinates the implementation of the government initiative Startup India. These positive improvements in India's patent landscape have also been aided by the Department of Scientific and Industry Research and others, as well as industrial organizations. Not only have startup registrations grown dramatically, but so have existing corporations like as telecommunications firms, IT companies, Indian Institutes of Technology, and pharmaceutical enterprises.



PATENTS

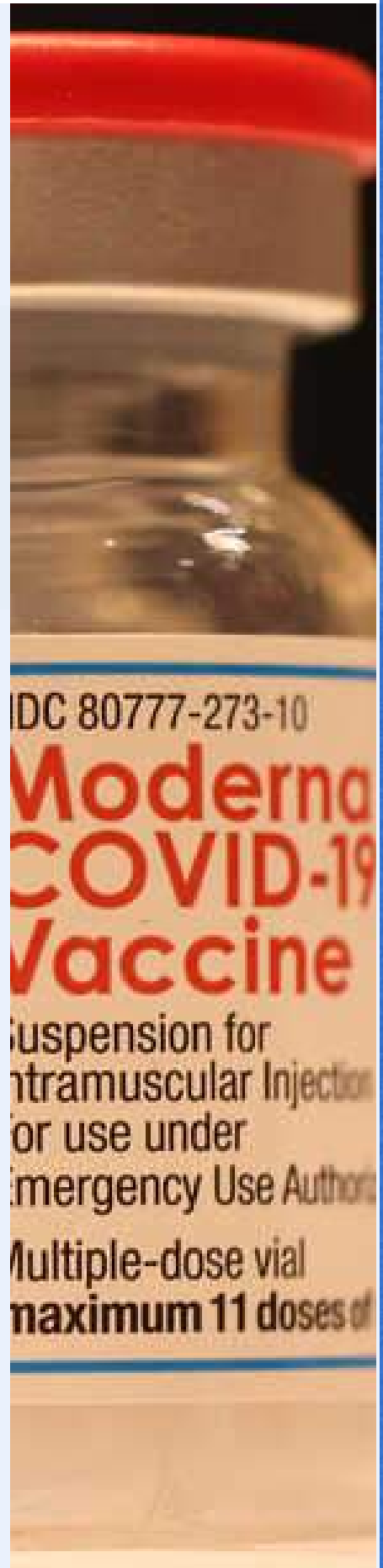
Moderna's patent application names several employees as the sole inventors of a crucial component of its coronavirus vaccine, excluding three government scientists.

Moderna and the National Institutes of Health (NIH) are at crossroads about who deserves patent recognition for designing the focal part of the organization's incredible Covid immunization, a contention that has ramifications for the vaccine's distribution and billions of dollars in ongoing as well as future profits.

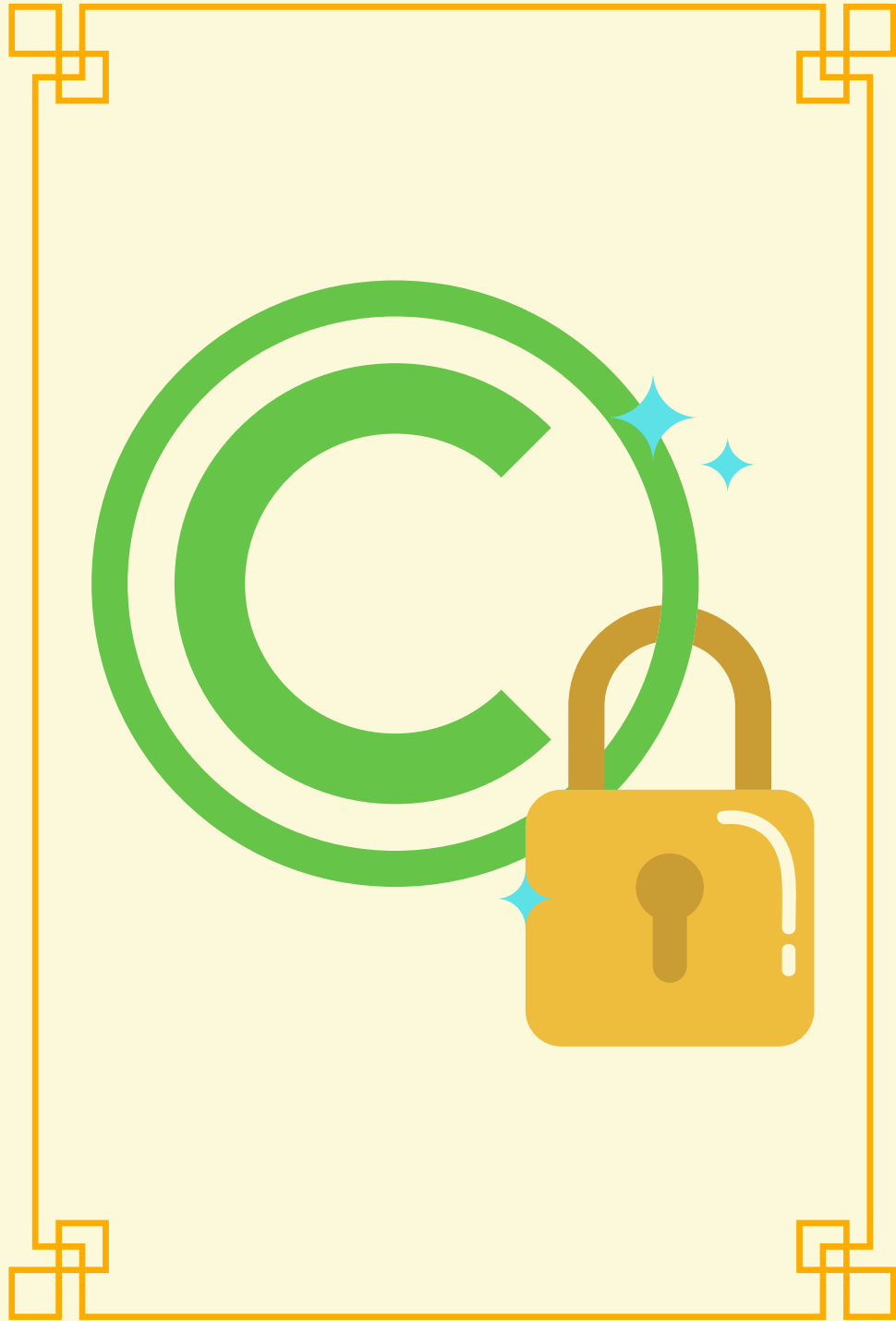
The vaccine was a result of a four-year cooperation between Moderna and the N.I.H., US Government's biomedical research office — an organization that was globally acclaimed when the shot was viewed as exceptionally powerful. A year prior, the US Government referred to it as the "N.I.H.- Moderna Covid-19 Vaccine."

NIH says three of its researchers — Dr. John R. Mascola, the agency's chief; Dr. Barney S. Graham, who as of late resigned; and Dr. Kizzmekia S. Corbett, who is presently at Harvard — worked with Moderna researchers to plan the hereditary arrangement that prompts the antibody to create a safe reaction, and must be named on the "principal patent application.

The debate is substantially more significant than logical honors or self image. Assuming the three organization researchers are named on the patent alongside the Moderna representatives, the national government could have a greater say, as to where organizations produce the vaccine, which thus could impact which nations gain admittance.



COPYRIGHT

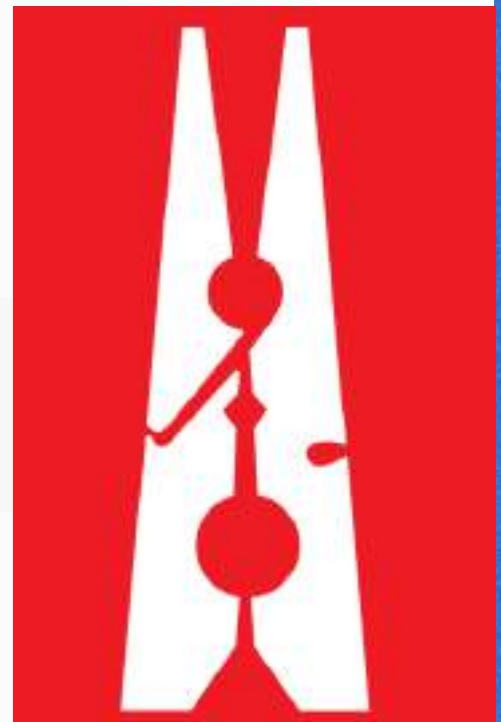


COPYRIGHT



The Madras High Court has clarified the meaning of the phrase "actually and voluntarily resides, carries on business, or personally works for gain" in Section 134(2) of the Trade Marks Act and Section 62(2) of the Copyright Act, which determines the territorial jurisdiction of the courts concerned, in a significant order. Justice Anand Venkatesh has observed that "the discretion of the plaintiff to file a suit where the plaintiff carries on business is not unconditional."

Newslaundry's YouTube activity was banned in October pending an investigation into 53 distinct copyright warnings received from Aaj Tak. Aaj Tak reportedly used copyright claims to prohibit Newslaundry from commenting on and criticizing its reporting. The Copyright Act's section 52(1)(a)(ii) exempts 'fair dealing' with any work for the purpose of criticism or review from infringement. This raises concerns about the scope of the fair dealing rights, as well as the stifling impact copyright takedowns have on free expression and criticism.



COPYRIGHT

Ireland takes a step further in boosting the rights of content creators-

The government of Ireland incorporated the European Union Directive on Copyright in the Digital Single Market (Directive (EU) 2019/790) into Irish law. The said incorporation is projected to significantly boost the rights of content creators by reducing the value gap with respect to the profits accumulated by online platforms (such as search engines and social media) and content creators.



SCC Blog

Singapore Copyright

COPYRIGHT

On November 21, 2021, Singapore's new Copyright Act came into force. The new Act, which replaces the Copyright Act of 1987, is projected to enhance the copyright regime of Singapore by taking into account the various technological developments over the years. Also, a shift has been made from "fair dealing" to "fair use" as the general exception to copyright infringement.

COPYRIGHT



Winnie-The-Pooh reaches the public domain: On 1st January 2022, Winnie-The-Pooh and the other characters from the Hundred Acre Wood opened up to the public domain which means that Disney can't sue anyone who uses the original book in a new project. They can however go after derivative works that clearly stem from iterations of Winnie the Pooh franchise after 1926. This has paved way for creative works by any person, and a notable use of such liberty is the upcoming Winnie the Pooh horror movie "Blood and Honey"

Lofi Girl Disappeared from YouTube: In yet another incident of bogus copyright claims on YouTube videos, the popular Lofi Girl, who has become an internet icon could not be found on YouTube. The stream was taken down due to a false copyright claim which made fans confused and angry. YouTube quickly apologized for the mistake, and the stream returned two days later.



COPYRIGHT

Disney to lose copyright to the original Mickey Mouse- In 2024, the earliest iteration of Disney's Mickey Mouse (Steamboat Willie) will enter the public domain. As per US law, works published before 1978, like Mickey Mouse, have a copyright for only 95 years since the date of publication which is set to be completed in 2024. Once it has entered the public domain, "Steam Boat Willie" will be free for the public to use in new works and distribute as they see fit. However, it is important to note that later designs of the characters would still be copyrighted until their terms end.



Lewis Black sues Pandora for \$10 million over copyright infringement:

Comedian Lewis Black filed suit against SiriusXM-owned audio streamer Pandora on Thursday, arguing that the company ran recordings of his performances without obtaining the copyright to his written work. This suit, along with several others filed against Pandora, seeks back pay for millions of dollars worth of publishing royalties and to fundamentally change the way copyright for comedy functions. If the comedians win, it could have major ramifications for Pandora, Spotify, and other audio streamers.

TRADEMARKS



TRADEMARKS



WIPO Arbitration and Mediation Center transfers domain name to Tolkien Estate

Crypto 'JRR Token' infringes trademark rights The WIPO Arbitration and Mediation Center Panel decided that the disputed domain name 'J R R TOKEN' be transferred to Tolkien Estate Ltd as it had been registered and was used in bad faith by Respondent, Domain Investments/Matthew Jensen. The Estate had established a prima facie case that the Respondent did not have any rights or legitimate interests in the disputed domain name.

The removal of the letters 'L' and 'I' did not mean that the Respondent's mark was not confusing similar to the Complainant's trademark. (Case No. D2021-2571)



In January, the Delhi High Court in the case of Hamdard National Foundation (India) v. Sadar Laboratories Pvt. Limited refused to grant an interim injunction in favour of the plaintiff in a case of trademark infringement concerning the plaintiff's mark 'Rooh Afza' and the defendant's mark 'Dil Afza'. While the case has been settled, it provides an interesting example of how the boundaries of trademark protection are often tested by claimants seeking the enforcement of their rights.

TRADEMARKS



Bajaj trademarks the name 'Twinner'

The name 'Twinner' has been trademarked by Bajaj. Bajaj is working on a twin-cylinder motorbike, as implied by the name. Although it is too early to declare, Rajiv Bajaj, Managing Director of Bajaj Auto, said that the company is working on a completely new product. However, we're not entirely sure whether Bajaj will make a motorbike with the name 'Twinner'. It might also refer to a Bajaj Qute variant with a larger twin-cylinder engine.

Tata Sons Private Limited v. Hakunamatata Tata Founders & Ors. [CS(COMM) 316/2021 & I.A.8000/2021]
 The plaintiff, a company incorporated in India approached the Delhi HC, seeking an ad interim injunction restraining the defendant from using their trademark, 'TATA' as part of their cryptocurrency. The defendants were situated in the US and UK and there was no clear indication of intent to target the Indian market. The court observed that it could not issue any injunctive direction to the defendants as they are outside its territorial reach.



TRADEMARKS



McDonald's files trademarks for virtual restaurants in the metaverse [The world's biggest fast-food restaurant business has filed trademarks to operate a location in the metaverse. McDonald's claims to be able to deliver meals both in-person and online, with over 39,000 outlets in over 100 countries. The corporation submitted ten trademark applications for the McDonald's and McCafe brands with the US Patent and Trademark Office earlier in the year.

The Delhi HC passed an ad interim injunction, restraining 'Good Day Oral Care' from using the deceptively similar mark 'GOOD DAY', and directing it to suspend the operation of its website under the domain name 'gooddayoralcare.com' The plaintiff had registered the trademark since 1986 and the IPAB had declared it to be a well-known mark in 2020. Therefore, the same being used by the defendants would amount to an infringement under Section 29(4) (b) of the Trade Marks Act.



TRADEMARKS



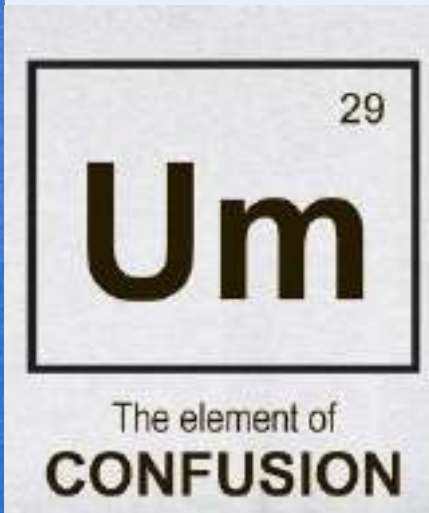
World over companies are rushing to protect their trademarks in the online, virtual environment – the metaverse. A list of trademarks applied for in the EU for ‘downloadable virtual goods’ and ‘online virtual services’ was recently published by The IPKat here. In the US too, several companies are protecting their trademarks for similar goods and services. Hermes has sued a Californian artist, Mason Rothschild, for his “MetaBirkins” digital artworks alleging trademark infringement. Nike has also brought an action for trademark infringement against StockX alleging that StockX’s NFTs depicting Nike shoes violates its trademarks.

In an order dated 27th April 2022, Justice Prathiba M. Singh awarded an interim injunction in favour of Makemytrip (within the territory of India) in the matter of Makemytrip India Private Limited vs Booking.com B. V. & Ors. Defendants were restrained from using the plaintiff’s registered marks on the Google Ads Program as keywords because this would amount to trademark infringement and constitute passing-off. There have been similar cases filed by the plaintiffs where the various defendants were restrained from bidding for any ‘keywords’ on the Google Ads Program that are identical or deceptive variants of the Plaintiff’s mark ‘MakeMyTrip’ on the ground that this action of the defendants constitute trademark infringement and passing off.



oh roaming

TRADEMARKS



In a recent pharma trademark infringement and passing off dispute, the Delhi High Court permitted the defendant to sell its existing stock (pending further orders) without vacating the interim injunction against the defendant. The Delhi High Court characterised this arrangement as an ‘interim arrangement’ required to serve public interest. While the Delhi High Court did not interfere with the ex-parte interim injunction, its decision to permit the appellant to continue to sell its existing stock reversed the very effect of the injunction. If the court was really concerned about public interest then the ex parte interim injunction should have been vacated on the ground that there was no likelihood of confusion.

Revlon, the iconic cosmetics brand, has filed for bankruptcy. Revlon has a more direct connection with India in the trademark sense. The Trade Marks Registry (TMR) lists Revlon and its related brands as ‘well-known’ trademarks in India since 1997. The commercial implications of being declared a well-known trademark are tremendous. Once recognized, trademark protection is granted across all goods and services. Prior to the enactment of the Trade Marks Rules, 2017, a trademark could be declared as well-known either by a court or by the Registrar in an opposition, rectification or infringement / passing off action.



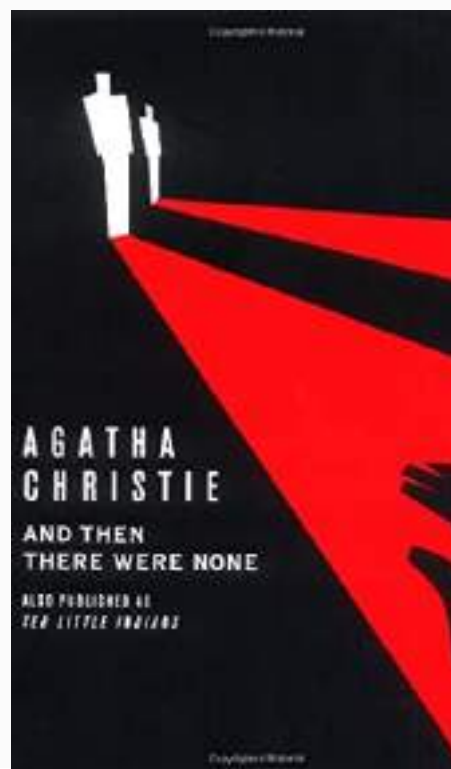
TRADEMARKS



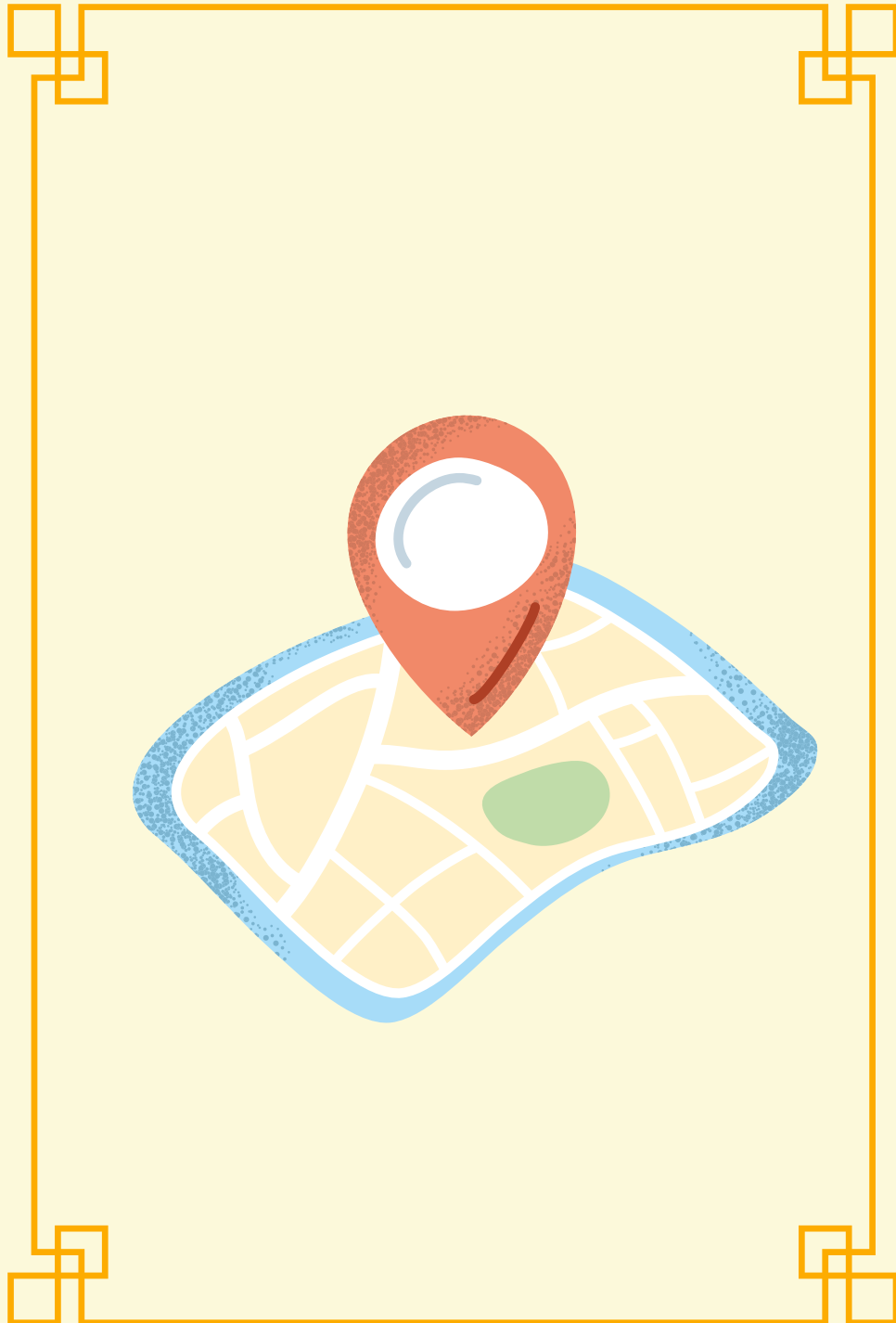
The Delhi High Court passed an injunction order (CS(COMM) 124/2021) in favour of the Jumeirah Beach Resort LLC restraining the real estate developer, Designarch Consultants Private Limited from using ‘BURJ’ in any manner for any upcoming projects including ‘BURJBANGALORE’, ‘BURJMUMBAI’, ‘BURJDELHI’, ‘BURJGURUGRAM’ and ‘BURJGURGAON’. The Court, however, allowed the use of ‘BURJNOIDA’ for an ongoing residential project which has been under construction in India for the last ten years.

An impugned order was passed rejecting the application of Agatha Christie Ltd for the registration of the trademark “And Then There Were None”. On 8 December, 2021 the Delhi High Court set aside the impugned order stating that there were no findings that the trademark was incapable of being represented graphically or distinguishing the services being provided, or intended to be provided by the appellant from those of others.

The Court observed that the applied mark is not descriptive and stated that prima facie, there exists an association between the trademark and the appellant.



GEOGRAPHICAL INDICATIONS



JUDIMA RICE WINE GI TAG



Judima Rice Wine of Assam becomes 1st traditional brew from northeast to get GI tag

This wine is brewed by the Disama Community of the state's Dima Hasao district in Assam. "Ju" in Judima means wine and "dima" means belonging to the Dimasa. This wine is local fermented drink made with sticky rice that has been steamed and combined with traditional herbs, and it takes about a week to produce. Judima is unique to the socio-cultural life of the Disama community. Getting this tag now adds to the benefit and gives the right to those in a refined manner and prevent it from being misused by a third party whose product does not meet the required criteria. A Geographical Indication (GI) tag is awarded to products associated with a specific geographical origin.

JUDIMA RICE WINE GI TAG

The recognition of a GI aids not only in locating product origins, but also in verifying authenticity and marketing of local specialties. Since Judima is traditionally made in homes, Subodh Maibongsha, principal scientist and head of Krishi Vikash Kendra (agriculture development centre) at Diphu in Assam and his colleagues at Youth Association for Development and Empowerment (YADEM) applied to get GI tag in 2018. Getting a GI tag will now offer the community to start its branding, manufacturing and other things required. This tag is issued by the Geographical Indication Registry under the Department of Industry Promotion and Internal Trade, Ministry of Commerce and Industry, as per the Geographical Indications of Goods (Registration and Protection) Act, 1999.



DARJEELING TEA GI TAG



Background

Geographical Indications (GI) Tags were originally devised as a form of protection towards the intellectual property of certain goods or products from any particular part of the world that is unique to its own geographical location. It not only serves to protect the economic interest of its owners but also for the sake of protecting the culture and heritage of a product which has significant ties to its own area. It serves as a crucial protection which has seen rapid adoption internationally in the last century. GI tags can date their first usage back to France in the early 20th century under the name “appellation d’origine controlee” and has since spread internationally to various countries which are a member of the World Trade Organization through the agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), one of them being India.

DARJEELING TEA GI TAG

GI Tags in India

The GI Tags in India are issued under the provisions of the Geographical Indications of Goods (Registration and Protection) Act, 1999 which allows for any individual or organization recognized by law to apply and gain a GI tag for a period of 10 years on any product which falls within its classification. It also allows for subsequent renewals for a further period of 10 years every time a GI tag runs out. The Law would come into force in September of 2003 and the very first GI Tag to be granted would be provided to Darjeeling Tea. This would be done with the purpose of protecting a product which had become a reputed staple since British times and had seen knock offs crop up both in India and Abroad. The GI Tag was as such provided to the Indian Tea Board in an effort to protect the culture and heritage of a product which had come to become synonymous with India



DARJEELING TEA GI TAG

Since 2003,

Since the very first Indian GI Tag was granted to Darjeeling Tea in 2003, countless other applications have been filed and the number of GI Tags in India have grown exponentially. The number currently at well over 300 and are set to grow in the future. Darjeeling Tea, having received the Indication has become a mainstay all over the world serving not only to protect itself from knock offs but also serving as a product almost universally associated with India Internationally. It has additionally allowed its creators to separate themselves from the rest of the Global Market and stand out and reap the benefits of their products.



INDIA PAKISTAN BASMATI ISSUE



Background

India had filed for the Protected Geographical Indication (PGI) status from the European Union’s Council on Quality Schemes for Agricultural Products and Foodstuffs. Notification for the same was made on 11th September, 2020, and parties, including nations were allowed to file objections to India’s application until 10th December, 2020. Basmati rice is grown only in the Indo-Gangetic Plains (IGP region) in India, and in 18 districts of Punjab in Pakistan, and any rice even similar or better than the Basmati cannot be conferred with the same name. International laws mandate a protection of products under the Geographical Indication laws of a country, before it can apply for the registration of said product in the international market. This made Pakistan pass the “Geographical Indications (Registration and Protection) Act” in March 2020, to give itself the power to challenge India’s application.

INDIA PAKISTAN BASMATI ISSUE

Present Situation

After Pakistan's opposition, India and Pakistan had six months to come to an amicable conclusion, however, that failed. India then sought another extension, which expired on 10th September, 2021. The present situation points to this matter being taken up to the European Court for settlement. India's case is backed by strong facts like the acknowledgement of "Dehradun Basmati" in 1939 by the Britishers after its examination by AGMARK officers. There is also a claim by historian S Chandrashekharan which states that West Punjab (Now Pakistan) never grew basmati rice in the pre-partition days.

Significance

Basmati offers a high premium, especially due to exports, and India is the largest Basmati exporter in the world, with Pakistan being the only other exporter. Getting a PGI, would have economic consequences which would not just benefit India, but also negatively impact Pakistan's exports. Previously, a US based company, 'RiceTec' had applied for a patent for the rice varieties it had bred from basmati strains. It was granted the patent in 1997, but after a challenge by the Indian Government, the US narrowed the scope of the patent in 2001 to only three variants produced by RiceTec.



INDIA PAKISTAN BASMATI ISSUE

The Road Ahead

The most logical next step of this issue would be to approach the European Court, since even bilateral negotiations between Indian and Pakistan bore no fruit. When it comes to cross border GI issues, the EU has voted on certain issues for a particular side due to ‘political reasons’, and at other times, strictly adhered to the area of cultivation. A similar approach could be adopted in the Basmati Case as well.



JULY 2022 | ISSUE 1 | INAUGURAL ISSUE

OPINION-EDITORIALS



OPINION-EDITORIALS



Copyright Regarding Paparazzi Photos

Author: Vikrant Rana

*Affiliation: Managing Partner,
S.S. Rana and Company*

Co-Author: Pranit Biswas

*Affiliation: Associate
S.S. Rana and Company*

Key Words

Copyright

Copyright and Paparazzis

Copyrights and Photographs

Introduction

Paparazzi and celebrities, in this day and age of instant communication, are simply non-severable. All it takes is one second and a decent smartphone to snap a photograph. Stereotypically, it is the celebrities who are the aggrieved party and the paparazzi the alleged jackals, who aim to profit from violating the privacy of celebrities. However, in the past few years, the tables have been turned and it is celebrities and influencers who have been sued for posting photos of them, which have been taken by paparazzi! It is not only TV or movie stars facing this problem, but even political leaders such as the French President Emmanuel Macron, who sued a paparazzi photographer for invasion of right to privacy.

The tug of war between paparazzi photographers, who sell these photos to media outlets for a commercial profit and celebrities, who rarely consent to such photos being taken, has taken a legal turn in nations like the US and France, and India may soon follow suit. In this piece, we analyze the various legal nuances surrounding this issue, and look at the issue from both sides' perspective.



In the past few years, the tables have been turned and it is celebrities and influencers who have been sued for posting photos of them, which have been taken by paparazzi!

Rule in India



A person's voice, signature and traits would constitute their personal rights.

Under section 2(d)(iv) of the Copyright Act, 1957, it is clear that any person taking a photograph, is the author of that work, and the copyright is explicitly provided for under section 17 of the Act. A photograph is considered to be an artistic work (section 2(c)(i)). However, personality rights have not yet been statutorily recognized in India, but the same has indeed been mentioned in various Supreme Court judgements. In the ICC Development case, the Hon'ble Apex Court held that a person's voice,

signature and traits would constitute their personal rights [1]. Additionally, in Titan Industries Ltd Vs. Ramkumar Jewellers, regarding 'personality rights', the court stated that it is an "enforceable right in the identity or persona of a human being." [2]

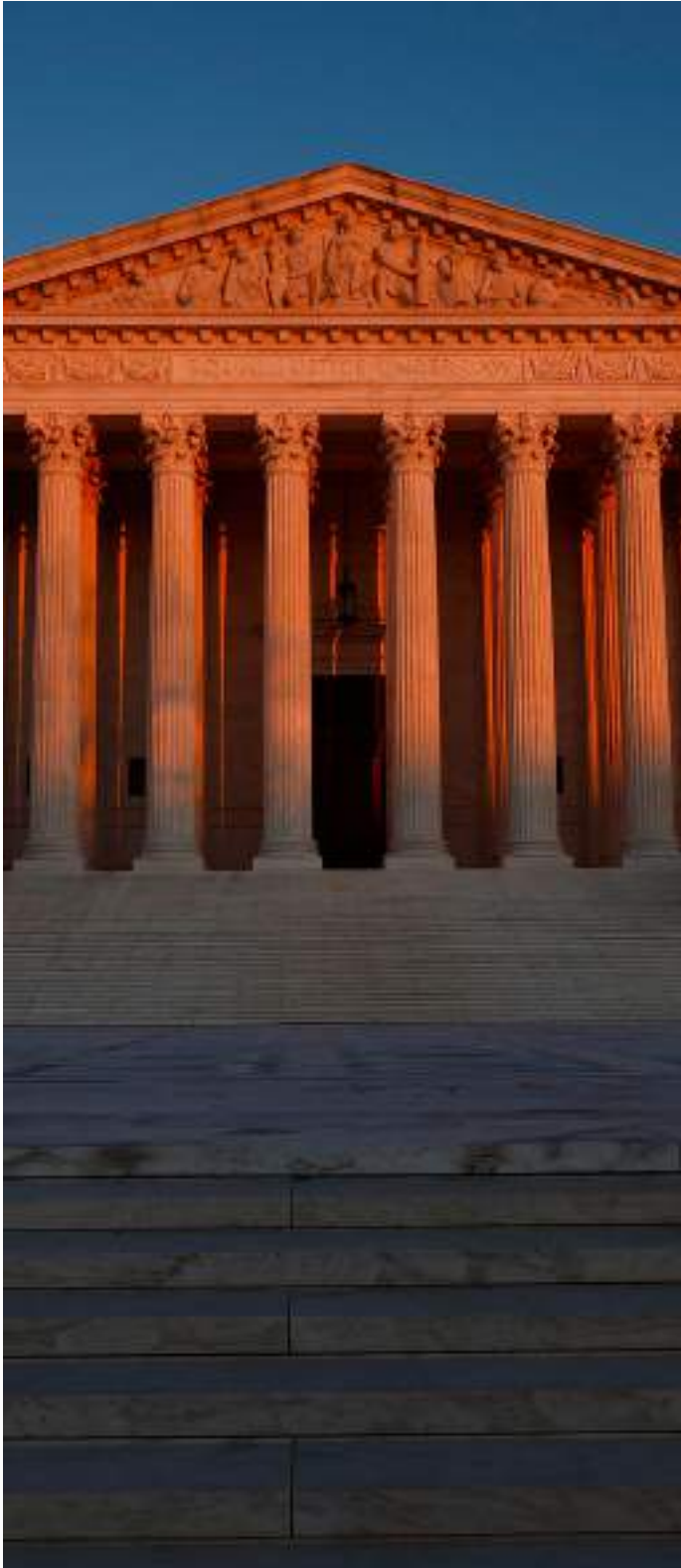
Rights of Photographers Vis-à-vis the Rights of Celebrities and Legal Liability



Does co-authorship arise since the celebrity forms the subject matter of such a composition? This was an argument raised by Gigi Hadid

There are multiple questions that arise regarding whose rights are being infringed and which side has the legal liability in a cases wherein a celebrity re-shares a copyrighted photograph clicked by paparazzi. It is patently clear that the photograph taken is the legal property of the photographer, but does co-authorship arise since the celebrity forms the subject matter of such a composition? This was an argument raised by Gigi Hadid when facing a suit of copyright infringement from an agency named Xclusive-Lee. The famed model argued that since she posed for the photograph and was in charge of her appearance, she should be considered a co-author of the work.

For a photograph, the subject matter does play a role in the rights of the work. However, in the present, while Gigi Hadid ultimately prevailed in the case, the same was not because the Learned Judge accepted the argument of co-authorship, but because the paparazzi agency did not possess a copyright registration over the photo in question prior to filing the suit, although they had filed an application and the same was pending at that time. However, what was deemed as more controversial by many commentators at that time was that the Court's decision was predicated upon a Supreme Court ruling (in *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*) which was passed subsequent to filing of the suit!



The said SCOTUS case basically ruled that copyright registration is a prerequisite for making a case of infringement (which, as many readers would not, is not a prerequisite in India). Thus, the Court did not adjudge upon the rather crucial question of whether such celebrities can be considered to be co-authors and/or if such usage falls under the ambit of fair-use.

The case of Jonathan Mannion Vs Coors Brewing Co [3], cemented this role, by stating, inter alia, that the rendition, timing and coordination of the subjectmatter plays a role in its copyrightability. In contrast, the Hadid case was eventually disposed of on procedural grounds rather than on meritof arguments, and the LearnedJudge did not engage with this contention. There have not been any cases of co-authorship of a photograph by a model and a photographer, but with increasing popularity of models and celebrities, the rules of collaborative photoshoots between both parties needs to be hashed out.



Posts made on social media do not have the privilege of being called private communication when they are made on a public account.

In India, an author is clearly defined as the one who takes the photograph, and as such there is no ambiguity in the legislation.

No celebrity would be able to claim fair use or fair dealing under Section 52 of the Copyright Act, with respect to copyrighted photographs, as even though the Act provides for “private and personal use”, sharing of the photograph on a public account is beyond the scope of public communication and has a clear commercial aspect. Communication is only considered private, when it is made to a restricted audience.

Posts made on social media do not have the privilege of being called private communication when they are made on a public account [4]. Since the owner of a copyright possess the right of communication to the public, and posting of such photograph prima facie amounts to ‘public communication’, an assertion of fair use by the celebrity in such context, would not be construed as a valid defense, especially because as per law, the author is distinct from owner of copyright, and it is the exclusiveright of the owner.

Global perspective



In the United States, there are 4 factors that are considered to validate fair use: the purpose, nature, amount or substantiality and commercial effect of any usage of protected material.

In this context, India's perspective of fair use is more restricted than that of USA. In the United States, there are 4 factors that are considered to validate fair use: the purpose, nature, amount or substantiality and commercial effect of any usage of protected material. In the aforementioned case of Gigi Hadid, a four pronged argument was made on the basis of these factors and fair use was asserted. She argued that the purpose of re-sharing the photograph was purely personal and not commercial, and thus it should not constitute a violation of the copyright. Secondly, the candid photograph clicked on the streets made it a factual work and not a creative one, since no set-up or preparation was involved.

Additionally, since Hadid used only a part of the photograph and not the entire image (as the image was purportedly cropped to increase the focus on her), a significant amount of the work was not used. Lastly, as Hadid used the work after it had already been published, there was thus no real impact on the economic output of the photograph borne out of her act. It is still unclear how different Courts would have responded to these arguments, especially with respect to personality rights of such celebrities, when pitted against the copyright rights of the photographers. France's specifically recognizes the right to privacy in its Civil Code. This recognition provides a much needed shield for celebrities from pictures being taken of them even when they are in the public eye.



The right to respect is enshrined in Article 8 of the European Convention on Human Rights (ECHR), which protects the right of every individual to keep their life private. A Court, in the case of *Von Hannover v. Germany* [5], decided that it was this article that was violated, when photographs of Princess Caroline von Hannover taking part in non-official activities were posted.⁵ The Court categorically stated the principle that any person has the right to hide their life from the public view, and the general public of a nation does not have the vested interest in anyone's life. The court noted that "... people known to the public, had to have a "legitimate expectation" that his or her private life would be protected." Thus, a subject of such photographs can object to them being taken at least in the EU.

Right to Privacy v. Copyright?



Thus, the dilemma that emerges from the above discussion is what would prevail in cases of copyrighted paparazzi photos being shared by the subject matters of the photos. While looking into his question, one must analyze the various factors that are worth consideration in dissecting this dilemma:

- The setting of the photograph – whether the same was clicked in a public place or a private place, wherein unauthorized ingress or unauthorized photography is prohibited.
- Permission – whether the celebrity posed for the photo, or was the photo adversarial (for instance, the celebrity was clearly shying away from photographers and unwilling to be clicked).

In this regard, it is also to be kept in mind that certain photos of celebrities have immense monetary value. For example, one would imagine that a paparazzi photo taken in a secret wedding of 2 celebrities may be sold for thousands of dollars, if not millions! For instance, the Indian celebrity couple Katrina Kaif and Vicky Kaushal were purportedly offered hundreds of thousands of dollars (or crores of rupees) to sell the rights over content such as photos and videos pertaining to their recent much talked about wedding, wherein unauthorized photography was restricted [6].

Further, in such cases, the celebrities in question reserve the right to privacy and deliberately restrict unauthorized photography, specifically for the above reason, that the photos can be sold by them for profit. As such, the above two questions as outlined above, would play an important part in determining who would prevail in a battle between the celebrities' right to privacy versus the copyright in the photograph taken by paparazzi.

However, if a legislation were to fill the void in the law regarding the subject matter, and try to balance the rights of photographers vis-à-vis rights of the subjects, then the above factors would definitely be of use.

Conclusion



There is a need for the Courts or Legislation to balance the interests of both, celebrities and photographers. There is no doubt, that sharing paparazzi photographs is a violation of the copyright held by the photographers in India – insofar as the fact that the photographer is the author, as well as first owner of the photograph, is set in stone in Section 2(c)(i) and 2(d) of the Copyright Act, 1957. Thus, in order to factor in the current paradigm regarding celebrities and paparazzi photographers, the question of co-authorship, or even co-ownership, in this context, needs to be specifically addressed.

A legislative change, either by way of amendment to the Act, or by judicial interpretation, is the only way to ensure that rights and liabilities are balanced in similar scenarios. There has been limited judicial research into this topic, although the ownership of the copyright is not in question. An approach to personality rights in a detailed manner, which would further outline the relationship in question, has become a requirement. Especially in this day and age, a balanced and holistic view is the need of the hour, which provides for a mutually profitable ecosystem.

References

[1] ICC Development (International) Ltd.,Vs. Arvee Enterprises and another, 2003 (26) PTC 245.

[2] Titan Industries Ltd Vs. RamkumarJewellers, 2012 (50) PTC 486 (Del).

[3] Jonathan Mannion Vs Coors Brewing, Co 377 F.Supp.2d 444.

[4] Garware Plastics And Polyester v Telelink And Ors., AIR 1989 Bom 331

[5] Von Hannoverv. Germany, (application no. 59320/00).

[6] <https://www.india.com/entertainment/bollywood-news-katrina-kaif-vicky-kaushal-to-sell-wedding-photos-rights-to-international-magazine-for-a-whopping-price-5121661/>

FACULTY ADVISORS

Ms. Rujitha TR Shenoy

Assistant Professor of Law

Director - Intellectual Property Awareness and Advocacy Center

National Law University Odisha

Email: rujitha@nluo.ac.in

Ms. Divya Singh Rathor

Assistant Professor of Law

Co-Director - Intellectual Property Awareness and Advocacy Center

National Law University Odisha

Email: divya.rathor@nluo.ac.in

Ms. Sonal Singh

Assistant Professor of Law

Co-Director - Intellectual Property Awareness and Advocacy Center

National Law University Odisha

Email: sonal@nluo.ac.in

DESIGN TEAM

Kaushik Das

Devan Kakar

Gyanesh Mishra

EDITORIAL TEAM

Kaushik Das

STUDENT MEMBERS AND CONTRIBUTORS

Kaushik Das

Tanushka Joshi

Harshit Bhoi

Himani Jaruhar

Riya Thawani

Anusha Agrawal

Sharvani Rai

Ruchika Mohanty

Kushagra Dash

Samridhi Prakash

Madhulika Tripathy

Akhil Raj

Devan Kakar

Gyanesh Mishra

Putul Mehta

Deepshikha Bagauria

Snigdha Dash

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