

EXPLORING THE INTERSECTION OF TRADEMARK AND COPYRIGHT IN INDIA: A CRITICAL ANALYSIS OF OVERLAPPING INTELLECTUAL PROPERTY PROTECTION

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ABSTRACT

The increasing convergence between trademark and copyright law has generated significant legal concerns regarding the scope and duration of intellectual property protection in India. The paper proceeds on the assumption that overlapping protection, though beneficial for rights holders, may create uncertainties relating to ownership, enforcement, public domain access and competition. Adopting a doctrinal research methodology, the study analyses statutory provisions, judicial precedents and scholarly writings dealing with the interaction between trademark and copyright law. The article first examines the nature and extent of overlap between the two regimes and subsequently analyses the benefits arising from such coexistence. It further discusses the legal issues associated with parallel importation, comparative advertising and the artificial extension of copyright protection through trademark rights. On the basis of Indian and comparative jurisprudence, the paper argues that excessive overlap may upset the balance between private rights and public interest. The study concludes by recommending legislative clarification, harmonisation of standards and the development of judicial guidelines to ensure greater certainty in the administration of overlapping intellectual property rights in India.

KEYWORDS: *Trademark, Copyright, Overlapping Protection, Intellectual Property Rights, India, Parallel Importation, Comparative Advertising.*

1. INTRODUCTION

Those who make prudent use of the law stand to gain greatly. IPR is one area where businesses and consumers can benefit financially and legally through expanding the legislation. Intellectual property (IP) comes in a variety of forms, including patents, copyrights, geographical indications (GI), and trademarks (TM). The combination effect of intellectual property prevents potential competitors from creating a copy of an already-existing IP asset. When studying intellectual property, it is inevitable to encounter the time limits and protection requirements for individual rights¹. Globally successful brands need to have a solid strategy that anticipates market dynamics, which may take longer to develop than a simple patent or copyright. What is meant is that, even in the case of an innovation, the company needs to secure other forms of intellectual property, such as copyright and trademarks, in order to

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¹ Rochelle Dreyfuss and Justine Pila, *Oxford Handbook of Intellectual Property Law* (Oxford Handbook, 2017).

safeguard the product and its brand and gain a sustained competitive advantage².

Global filing trends reported by WIPO indicate that trademarks remain one of the most actively utilized forms of intellectual property, thereby increasing the likelihood of overlaps with copyright protection³.

1.1 OBJECTIVE OF THE STUDY

The primary objective of this research is to critically analyze the concept of overlapping rights between trademark and copyright law. It aims to explore the potential areas where these intellectual property regimes intersect, particularly in cases involving artistic works, logos, and branding materials that are eligible for protection under both trademark and copyright law. By examining the similarities, differences, and legal complexities, the study seeks to identify challenges in enforcement and protection when the same subject matter is protected under multiple IP laws. The paper will also evaluate the existing legal frameworks and suggest potential reforms or clarifications necessary for harmonizing these two regimes to avoid conflicts and ensure clearer protection for creators, businesses, and consumers.

The increasing significance of overlapping protection is reflected in the steady growth of trademark registrations in India. According to the Annual Report of the Office of the Controller General of Patents, Designs and Trade Marks, trademark filings have witnessed substantial growth during 2023–24⁴.

1.2 RESEARCH METHODOLOGY

This study adopts a doctrinal research approach, focusing on the critical examination of legal doctrines, case laws, and statutory provisions related to trademark and copyright law. It involves an in-depth analysis of primary legal sources, including national and international legislation, judicial decisions, and relevant treaties. Secondary sources, such as scholarly articles, commentaries, and legal opinions, will also be reviewed to provide a comprehensive understanding of the overlap between trademark and copyright law. The study will rely on legal reasoning and interpretation to address conflicts and ambiguities, with a focus on analyzing landmark cases where the two areas of law intersect.

² Eléonore Gaspar, “Interplay Between Copyright Protection and Trademark Protection in France” *International Trademark Association* 68 (2013).

³ World Intellectual Property Organization, *World Intellectual Property Indicators 2024* (WIPO 2024) 36.

⁴ Office of the Controller General of Patents, Designs and Trade Marks, *Annual Report 2023–24* (Government of India 2024) 78.

1.3 OVERLAP OF TRADEMARK & COPYRIGHT

The two most overlapping rights are copyright and trademark⁵. Neither the Copyright Act of India nor any specific limits apply to trademark protection of subject matter that is protected by copyright when utilized for commercial purposes. Copyright and trademark cannot be combined for a business or for a single product of the business due to any constraints. According to Section 11(3)(b) of the Indian Trademarks Act, 1999, a mark that violates another person's copyright or is identical to it cannot be registered. Section 45(1) of the Indian Copyright Act, 1957 contains a similar clause, stating that any application for copyright registration that infringes upon or clashes with a registered trademark on the same subject matter would not be considered for registration. The certification that there is no infringement of previously used marks should be included with the copyright application. Whether or not the copyright is registered, it would still be considered infringement if it contained another person's trade mark and did not fall under one of the Act's exceptions⁶. To be more precise, trademark and copyright protection typically coexist when it comes to a person's merchandise.

Using a character to advertise a company and its products is known as character merchandising. It is the commercial use of a character that is protected by trademark and copyright laws.

Character-based retailing includes:

- 1) Fictional or cartoon-based merchandise: In the absence of a license or contract, ownership of the cartoon's copyright remains with the owner.
- 2) Celebrity-based merchandise comes in two varieties:
 - a) personality-based: the celebrity's personal possession
 - b) Image merchandising: The film's copyright owner will have rights over the image in the event of a specified contract.

For example, the development of Ironman belongs to the copyright holder of Robert Downey, unless he has a special contract relating to Ironman as well. Getting copyright protection for a work is one way to ban others from using it commercially, as well as to avoid confusion and misleading similarities in trade. Protection is granted based on the original expression and purpose rather than quality. When a character is used for commercial purposes, trademark and

⁵ V.K. Ahuja, *Law Relating to Intellectual Property Rights* (3rd edn, LexisNexis 2017) 35.

⁶ Rochelle Dreyfuss and Justine Pila, *Oxford Handbook of Intellectual Property Law* (Oxford Handbook, 2017).

copyright are combined in character merchandise⁷. For instance, if someone creates a work that is identical to or replicates the copyrighted Ironman comic and uses it in a business for profit, trademark protection is necessary to avoid misunderstanding and preserve identity. The main goal of trademark protection (TM) is to prevent consumers and traders from being unfairly taken advantage of when a mark or product is utilized in trade, whether through confusion, fraud, or misrepresentation. Creative usage is protected under copyright. In the marketplace, copyright and trademarks stop fraud and confusion. It is shrewd to combine the two for optimal benefit⁸.

Copyright and trademark overlap protects a variety of additional parties besides customers and vendors, including rivals, authors, and start-ups. The growth of the intellectual property system throughout time has altered consumers' and intellectual property holders' perspectives, leading them to combine several rights in order to maximize benefit⁹.

Recent developments in India's intellectual property ecosystem further demonstrate the growing commercial importance of branding and creative assets¹⁰.

1.4 DISNEY MICKEY MOUSE

Disney has been using its characters, from Mickey Mouse to Cinderella, to market merchandise, including apparel and stationery, by using their image to draw in young customers. On the other hand, counterfeit goods were growing in popularity along with the product and image. The owner of all Disney cartoon character trademarks with copyrights and designs is Disney Enterprises Inc., both registered and unregistered. Since the figure serves as a form of identification for Disney, there have been numerous instances in which the company has sued third parties for duplicating and economically exploiting it under trademark protection. Customers are tricked into believing that the fake goods are genuine Disney merchandise. The Disney Inc. cartoon characters, Mickey Mouse and Minnie Mouse, were granted the status of "well known marks" in the 2011 case of *Disney Enterprises Inc. & Anr vs. Gurmeet Singh & Ors*¹¹, after the Hon'ble Supreme Court of India ruled that they were well-known and well-liked worldwide. Disney filed several injunctions and

⁷ Robert Burrell and Michael Handler, 'The Relationship between Copyright and Trade Marks' (2023) 18(5) *Journal of Intellectual Property Law & Practice* 379.

⁸ N.S. Gopalakrishnan and T.G. Agitha, *Principles of Intellectual Property* (2nd edn, Eastern Book Company 2014) 18.

⁹ Eléonore Gaspar, "Interplay Between Copyright Protection and Trademark Protection in France" *International Trademark Association* 68 (2013).

¹⁰ Intellectual Property India, *Annual Report 2023–24* (Government of India 2024) 54.

¹¹ CS(OS) 1451 of 2011

damages for utilizing its cartoon characters for commercial purposes without first securing the necessary rights or consent.

It is common for two distinct forms of intellectual property protection to overlap when it comes to a product's presentation, which includes any elements used to promote it such as its name, stickers, packaging, and appearance that may be protected under both copyright and trademark laws. This is because, while their origins and purposes differ, they both protect different subject matters and are governed by different statutes regarding ownership, infringement, tenure, certification, etc. This creates havoc when two parties to the same production have different copyrights and trademarks, and one of the protections is about to expire. It becomes too important to distinguish between the two distinct areas of intellectual property in order to address the overlapping difficulties.

For any large commercial house, the benefit of owning both rights together is a very successful company. Legal advice typically advises clients to acquire a copyright and then a trademark on one right, which may be anything. Unlike copyright and design, this approach has not been explicitly prohibited by law; yet, the legal system is effective in casting doubt on the ideas that support and oppose such multiplicity.

In order to protect their clients' interests and lessen the likelihood of piracy, weaken the case for infringement, or vigorously defend their rights, lawyers practically register some types of creative works under both statutes. There is uncertainty in this situation due to a risky set of verdicts that even wealthy countries have faced. As a result, there is an increasing practice of copyright and trademark rights overlapping. Without a doubt, the subjects of protection under each statute differ, as do the ways in which they serve distinct purposes in the economic sector. It is impossible for the copyright to be able to benefit generously without also having a secondary protected related to trademarks.

In order to appreciate the nature of overlapping protection, it is necessary to understand the fundamental distinctions between copyright and trademark law. Table 1 provides a comparative overview of the two regimes.

Table 1: COMPARATIVE FEATURES OF COPYRIGHT AND TRADEMARK PROTECTION

Particulars	Copyright	Trademark
Governing Statute	Copyright Act, 1957	Trade Marks Act, 1999
Subject Matter	Literary, artistic, dramatic, musical works	Names, symbols, logos, marks

Particulars	Copyright	Trademark
Purpose	Protection of creative expression	Protection of source identification
Duration	Limited period	Renewable indefinitely
Registration	Optional	Registration confers stronger rights
Basis of Protection	Originality	Distinctiveness
Main Concern	Unauthorized copying	Consumer confusion

Having discussed the concept and practical manifestations of overlapping protection between trademark and copyright, it becomes equally important to examine whether such coexistence produces any tangible advantages. The following section analyses the principal benefits associated with the simultaneous operation of these two intellectual property regimes.

The practical overlap between trademark and copyright protection arises in several commercial contexts. These areas of convergence are summarized in Table 2 below.

Table 2: MAJOR AREAS OF OVERLAP BETWEEN TRADEMARK AND COPYRIGHT

Subject Matter	Copyright Protection	Trademark Protection
Logos	✓	✓
Character Merchandising	✓	✓
Packaging and Labels	✓	✓
Artistic Works Used in Branding	✓	✓
Software Interface and Screen Displays	✓	✓
Product Get-up and Trade Dress	✓	✓

2. BENEFITS OF THIS OVERLAP

a. CHANGING TECHNOLOGY AND INNOVATION

Customarily, copyright law is employed to safeguard software. However, it can occasionally be difficult to use copyright alone to safeguard the ever-increasing advances because some technologies, like software visual displays, are not protected by copyright. Trademarks and copyright can be used together to protect software's visual displays in the context of emerging technologies like software. When displays are not otherwise protected by copyright, they can also be used to replace copyrights¹².

In the case of *Remington Rand Corp v Philips Electronics*¹³, it was observed by the court that “when shapes and colour displayed by software becomes distinctive and thus indicative of the source of the software, then such displays could qualify for the protection of trademark rights as distinguishing guise or trade dress. As long as any functional characteristics of the display remain non-essential, the display overall could withstand scrutiny and qualify for trademark protection”.

The Canadian court in *Delrina Corp v Triolet Systems Inc*¹⁴, observed “Copyright is extended to all parts of computer programs, except in the case of programs whose very purpose is to produce screens displays for use in playing of games or for some artistic or other like purpose.” This observation of the court indicates that there is a need for some other IP right to protect visual displays and the programs which produces such screen displays.

B. ARTIFICIAL EXTENSION OF DURATION

Using trademark rules to create a "artificial extension" of the duration of a work protected by copyright is another facet of this overlap. The right to copyright is not inalienable. Subject to the applicable land legislation, it is available to the holder and his heirs for a finite amount of time. The benefit of copyright can only be experienced temporarily, as the protected work automatically enters the public domain when the copyright protection expires. The work, which was previously copyright protected, may then be examined by the general public¹⁵.

¹² Robert Tomkowicz, *Intellectual Property Overlaps Theory, Strategies, and Solutions* (Routledge 2012) 101

¹³ *Remington Rand Corp et al v Philips Electronics N V*, (1995) 191 N. 204 (FCA)

¹⁴ *Delrina Corporation v Triolet Systems Inc* 2002 Can LII 11389, 58 OR (3d) 339

¹⁵ Irene Calboli and Shubha Ghosh, “Overlapping Intellectual Property Protection and the Exhaustion Doctrine,” 1 *Exhausting Intellectual Property Rights: A Comparative Law and Policy Analysis*, Cambridge University Press 137–57 (2018).

It is commonly acknowledged that whereas trademark rights are perpetual and cannot be lost unless the mark is declared generic or invalidated by a court, copyright rights are time-barred. Every ten years, the mark needs to be renewed as well. The mark will endure forever if these requirements are met. When other limited-duration intellectual property rights are due to expire, trademark monopoly is typically considered as a substitute.

The manufacturer and authors, who possess copyright and trademark over their individual works, benefit from this. A claim of trademark infringement could be made to prolong the copyright period. The fact that overlapping protection is one-sided profit-making should be obvious to readers by now, particularly in areas where it overlaps with other rights like design, copyright, and trademarks because of how trademark law handles mark renewals. This paper acknowledges two types of trademark and copyright overlap: the first is when both rights coexist at the same time, and the second occurs when trademark rights survive copyright expiration unless the right holder requests differently.

The public is concerned about both types of overlap regimes. The first type of overlap prevents society from benefiting from copyright through the well-recognized fair use concept, which is applied to expanding or recognized segments of society. The application of fair use and fair dealing would be prohibited by trademark rights coexisting with copyright, nevertheless, since nothing akin to the "doctrine of fair use" or of a similar nature is made available to or applicable by trademark rights, undermining societal interests.

c. INTERCHANGEABLE USE OF THIS OVERLAP

With the assistance of two levels of protection, the owner of these rights would be able to use them in turn, protecting the work from any infringement by outside parties in the process. It's interesting to note that one can take advantage of this combination of copyright and trademark legislation to stop other people from importing his products simultaneously, especially if the pricing differs between countries¹⁶. Because the Doctrine of Exhaustion permits parallel importation, parties are allowed to engage in it under a number of western jurisdictions. Additionally, the holder's claims of trademark infringement can be baseless because he has used up all of his rights to the product. Interestingly enough, the holder's copyright never expires. To prevent the simultaneous importation of one's goods, copyright should be used instead of trademark protection.

Another context in which the intersection of copyright and trademark laws may be helpful is comparative advertising. As long as the material being

¹⁶ Andrew Beckermann, "The Problem with Intellectual Property Rights: Subject Matter Expansion," *Yale Journal of Law and Technology* 13 (2011).

featured in comparison ads is true, they frequently do not infringe upon intellectual property rights¹⁷. Therefore, when someone compares his product to yours or uses your trademark when comparing your product to his, it would be fruitless and useless to file a claim of trademark infringement. Nevertheless, one may use copyright law's protection to get rid of such an advertisement. If the owner of the trademark filed a case for copyright infringement instead of trademark infringement, the advertisement would be taken down.

Although overlapping protection offers several commercial advantages, it also gives rise to important legal and policy concerns. The coexistence of copyright and trademark rights may create uncertainties regarding duration, exhaustion of rights and permissible commercial practices. Therefore, it becomes necessary to analyse the challenges associated with such overlap.

3. ISSUES ASSOCIATED WITH THIS OVERLAP

3.1 PARALLEL IMPORTATION AND OVERLAP OF COPYRIGHT WITH TRADEMARK

The doctrine of exhaustion or the doctrine of first sale is essentially a common law doctrine having an impeccable historic pedigree. When it comes to figuring out how intellectual property rules impact the flow of products and services during commerce, the concept of exhaustion is crucial. By granting their owners exclusive rights to profit from their labours, intellectual property rights seek to safeguard artistic creativity, investments made in the business sector, scientific advancement, and, generally, information and ideas that are valuable enough to be commercially exploited. The challenges concerning intellectual property rights are growing along with the body of knowledge and practice around them. The problem of parallel imports is one that is becoming more and more of a worry in the modern world, where owners of intellectual property rights are aggressive and watchful in defending their claims. Only after comprehending the idea of exhaustion and how it relates to intellectual property could one begin to grasp the concept of parallel imports.

One of the "iridescent and enigmatic phenomena" of global trade is parallel imports¹⁸. The doctrine of "parallel importation" describes products that are made, sold lawfully, and then exported¹⁹. This method is also referred to as "grey marketing or grey goods," which suggests that there is some doubt regarding its legality²⁰. According to the English Court in the *RousselUclaf v. Hockley international Ltd*²¹, popularly known as the Deltamethrin ruling, "in

¹⁷ *Ibid.*

¹⁸ *Frederick Warne & Co v. Book Sales* 481 F. Supp. 1191 (S.D.N.Y. 1979)

¹⁹ Christopher Heath, *Parallel Imports in Asia* (Kluwer Law International, 2004)

²⁰ *Ibid.*

²¹ [1996] RPC 441 [UK]

that sense; there is nothing grey about them; the goods are original and were initially placed on the market by or with authorization of the manufacturer." However, they are afterwards exported to another nation. "The question is not whether the market is grey or any other colour or shade, but rather whether or not conditions of a limited license were imposed when the product was first supplied," the English Court further stated in the aforementioned case.

The practice of parallel importation severely irritates manufacturers because it can interfere with their marketing strategies and cause obstacles, particularly when a product's price fluctuates across different countries. The owner's trademark rights may be adversely affected by parallel importation. Additionally, the law of exhaustion is generally used by most jurisdictions to put limitations on the use of trademark rights in order to avoid parallel importation, albeit the scope of these limitations may vary. Due to the doctrine of exhaustion, which states that all ownership rights over a product are lost as soon as it is sold, it is extremely difficult for a trademark owner to prove trademark infringement.

Parallel importation is typically legal in many jurisdictions, as it takes advantage of price differentials between markets and allows consumers to access products at potentially lower prices. However, it can create challenges for manufacturers and authorized distributors who may lose control over pricing, distribution, and brand image in the destination market.

In some cases, trademark infringement claims may be raised by manufacturers or authorized distributors to try to stop parallel importation. The argument here is that the unauthorized parallel importation of goods could potentially dilute the brand's reputation or confuse consumers, especially if there are differences in packaging, quality, or after-sales services between the authorized and parallel-imported products.

Trademark infringement claims in parallel importation cases often involve considerations of consumer confusion, potential damage to the brand's reputation, and the extent to which the parallel-imported goods are materially different from the authorized products.

Interestingly, this concept does not apply to works protected by copyright. As stated by the American Ninth Circuit Court: "It does not apply to copyright works manufactured and first sold overseas²²". The doctrine of exhaustion might operate differently in different areas of the intellectual property system, and manufacturers of goods quickly realized that they could take advantage of this gap to do things that were legally wrong. Seeking copyright protection even in cases of trademark infringement to stop parallel importation is fairly obvious.

²² 776 F.3d 692

In the case of *Omega S A v. Costco Wholesale Corp*²³, the petitioner was a watch maker selling his timepieces globally through authorized dealers. To stop parallel importations of his product, the petitioner chose to claim copyright infringement instead of seeking trademark protection, petitioner's assertion here is absurd. Not to assert infringement but rather to halt the importation of the timepieces was the goal of the legal action. Unfortunately, the court handled this case like any other copyright infringement case and made no comments on the petitioner's motivations for alleging copyright infringement.

3.2 COMPARATIVE ADVERTISEMENT & OVERLAP OF COPYRIGHT WITH TRADEMARK

Advertising in which a party compares its products or services to those of another party is known as comparative advertising. This other party is typically his rival and the industry leader in that specific trade. The major goal of this kind of comparison is to guarantee that the advertiser's goods sales increase. Businesses utilize comparative advertising because it allows them to quickly divert consumers' attention away from their attention and toward the offerings of the marketer²⁴. Through comparative advertising, competitors' brands or products whose names have not been disclosed during the advertising process can have their advantages contrasted side by side by the marketer.

Three parties are involved in a comparative advertising situation: the marketer, the rival that is the subject of the comparison, and the customers. The rivalry between the advertiser and the competitor is the most important of all of these. The competitor is worried about a possible decline in the market share of its product while simultaneously trying to preserve its goodwill in the marketplace²⁵. On the one hand, the advertiser utilizes comparative advertising as a strategy to effectively appeal to the customers of its product. The rival will always be uninterested in comparison advertising in such a situation. Put another way, the rival that is the target of this kind of comparative advertising will, at the absolute least, make an effort to stop the marketer from making fictitious and misleading claims about the products that are being compared. The likelihood that customers will believe an advertisement is intended for a competitor increases with each mention of the competition's name in the advertisement. Such advertising can effectively influence the thoughts of viewers whether it is distributed through print or broadcast media. It is a well-known fact that advertisements of this kind are likely to be interpreted as

²³ 776 F.3d 692

²⁴ Dev Gangjee, 'Trademark Functions and Overlap with Copyright' (2022) 53(4) *International Review of Intellectual Property and Competition Law (IIC)* 501.

²⁵ Graeme B Dinwoodie, 'Trademark Law and the Public Domain' (2021) 58 *Houston Law Review* 431.

promoting the products of their rivals. This can have disastrous consequences if a significant portion of the consumer base begins to believe that the advertised product is that of the rival²⁶.

3.2.1 HOW UNDER COMPARATIVE ADVERTISING COPYRIGHT COULD BE USED TO EXPAND TRADEMARK RIGHTS

In comparative advertising, a comparison is made with competing items either directly or indirectly. It is regarded as one of the most effective methods of advertising and is utilized by almost all industries. It is regarded as one of the best ways to market your work or product. Comparative advertisement is permitted and considered lawful, subject to the requirement that the advertisement's comparisons and substance be accurate. The use of their trademark does not constitute infringement even when you compare your product to another item with a comparable quality²⁷. False comparison advertising is forbidden by trademark law in order to prevent unfair competition. "It may be done unfairly when it involves statements about competing products that are not true and to prevent such unfair competition, trademark law prohibits false comparative advertising²⁸". In *Deere & Co v. MTD Prods Case*²⁹ it was discussed that: "Sellers of commercial products may wish to use a competitor's mark to identify the competitor's product in comparative advertisements. As long as the mark is not altered, such use serves the beneficial purpose of imparting factual information about the relative merits of competing products and poses no risk of diluting the selling power of the competitor's mark".

The accuracy of advertisement's comparisons and substance is significant in trademark law cases, but under copyright law, "there is no such obligation to prove fairness or truthfulness of the claim³⁰," meaning thereby, it is not required that the comparison be factually correct. Merely reproducing a company's logo can result in copyright infringement and the infringer is left with no choice but to remove the advertisement.

This has been explained by Robert Tomkowicz as "Exceptions to copyright infringement do not appear to accommodate comparative advertising, and this incompatibility of copyrights and trademark rights in relation to comparative advertising allows copyright owners to invoke copyrights in order to prevent

²⁶ Charlotte Romano, "Comparative Advertising in the United States and in France", 25 *Nw. J. Int'l L. & Bus.* 371 2004-2005.

²⁷ Trademark Act, no.47, 1999, §30(1)(a), §30(2)(a).

²⁸ Lanham Act 1946, § 43(a).

²⁹ 860 F. Supp. 113 (1994).

³⁰ *Ibid.*

activity permitted under trademark law even when it is unrelated to the purpose of copyright law³¹."

In *IPC Media Ltd v. News Group Newspaper Ltd*³², the court observed:

*"The virtue is said to be that the defendant is merely using the copyrighted work for the purpose of identifying the claimant's product and not because it wishes to make unfair use of the copyrighted work itself. But this, it seems to me, ignores the fact that the essential, or at least the principal function of the copyrighted work in the claimant's trade is to identify the claimant's product and to do so for the benefit of the claimant. The claimant has devoted his skill and labour in the production of literary and artistic work for the very purpose of identifying its product for its own commercial purposes. In copying the work to advance its own competing commercial purposes at the expense of the claimant's, the defendant was taking advantage of the fact that the claimant's work has created that literary/artistic identity for its product"*³³.

In this instance, the court utterly failed to grasp the function and goal of copyright law. Public freedom may suffer as a result of such an interpretation. The court's remark and the case's facts are at odds with one another; copyright is meant to foster creativity, yet in this instance, it plays no role at all.

3.3 ARTIFICIAL EXTENSION OF COPYRIGHTED WORK USING TRADEMARK

A work's copyright is only granted temporarily³⁴. As long as the mark is utilized, and often even longer, common law trademark rights are protected³⁵. The US Supreme Court has recently shown skepticism against attempts to use trademark rights to stop the use of works that are no longer protected by copyright, citing the US constitution as justification for the short duration of copyright in the country³⁶.

³¹ Robert Tomkowicz, *Intellectual Property Overlaps Theory, Strategies, and Solutions* (Routledge 2012)

³² [2005] EWHC 317 (Ch)

³³ *Ibid.*

³⁴ P. Narayanan, *Law of Trade Marks and Passing Off* (7th edn, Eastern Law House 2017) 29.

³⁵ Mark P McKenna, 'Trademark Law's Overexpansion' (2022) 98 *Notre Dame Law Review* 641.

³⁶ Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (Indian Edition, Oxford University Press 2017) 155

In *CCH Canadian Ltd v Law Society of Upper Canada*³⁷ the court observed that ‘extending copyright protection beyond its statutory limits would inevitably constraint public’s rights shifting the balance in copyright too far in favour of the owner’s rights and unnecessarily interfering with the proper use of copyrighted works for the good of society as a whole’.

The foregoing discussion demonstrates that the overlap between trademark and copyright is capable of producing both beneficial and adverse consequences. In light of these competing considerations, certain conclusions and recommendations may be drawn to ensure a balanced approach towards the protection of intellectual property rights.

Table 3: BENEFITS AND CHALLENGES OF OVERLAPPING PROTECTION

Benefits	Challenges
Enhanced protection	Artificial extension of copyright
Protection of brand identity	Parallel import disputes
Safeguarding software displays	Comparative advertising issues
Commercial advantage	Uncertainty in duration of rights
Multiple remedies against infringement	Risk of monopolization

4. CONCLUSION AND RECOMMENDATIONS

4.1 CONCLUSION

The intersection of trademark and copyright law highlights significant complexities in the protection of intellectual property rights, particularly in the modern commercial and digital landscape. This overlap has the potential to create ambiguity in ownership, scope, and enforcement, leading to both legal conflicts and unnecessary litigation. While trademark and copyright law serve distinct purposes—one protecting the identity of goods and services, and the other safeguarding creative expressions—the convergence of these regimes is increasingly evident, particularly in areas like logos, character designs, and digital content.

³⁷ *CCH Canadian Ltd v. Law Society of Upper Canada* [2004] 1 SCR 339, 2004 SCC 13

Through a critical analysis of relevant legal frameworks and case law, this paper underscores the need for clarity in the application of these overlapping protections. The examination reveals that while dual protection may provide enhanced safeguards for some intellectual property assets, it also creates challenges for creators, businesses, and courts in determining the appropriate legal recourse in instances of infringement. This issue is further compounded by differences in the duration, scope, and territorial reach of copyright and trademark protections.

In conclusion, the overlap between trademark and copyright law is both a reflection of the evolving nature of commerce and a challenge for legal systems worldwide. It is crucial to strike a balance that ensures adequate protection for intellectual property without overextending the reach of these regimes or creating legal uncertainties.

4.2 RECOMMENDATIONS:

1. **Legislative Clarification:** There is a pressing need for lawmakers to provide clearer guidelines regarding the boundaries between copyright and trademark protections. This can include statutory provisions that delineate the scope of each form of protection, particularly in areas prone to overlap, such as logos, product designs, and multimedia content.
2. **Harmonization of Legal Standards:** National and international intellectual property laws should work towards greater harmonization in terms of how overlapping protections are addressed. Aligning the principles of trademark and copyright law through international treaties and agreements could help reduce inconsistencies and cross-border legal conflicts.
3. **Judicial Guidelines:** Courts should develop more refined criteria for determining when a work qualifies for both trademark and copyright protection. Judicial guidelines on how to assess the primary function of the intellectual property in question—whether as a commercial identifier or a creative expression—can help streamline litigation and avoid conflicting rulings.
4. **Enhanced Education and Awareness:** Intellectual property rights holders, particularly in industries such as entertainment, fashion, and technology, should be educated on the risks and benefits of dual protection. This would enable businesses and creators to make informed decisions about the most suitable form of protection for their intellectual property assets.

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