THE ASYMMETRIC OVERLAP: RESOLVING STATUTORY INCONSISTENCIES BETWEEN COPYRIGHT OWNERSHIP AND DEVICE MARK REGISTRATIONS IN INDIA

Manasa R.V.[1]

ABSTRACT

A logo can be considered both as an artistic work, thereby falling within the purview of protection under the Copyright Act, 1957 and as a device mark, thereby falling within the purview of protection under the Trade Marks Act, 1999. This issue has been understood by legal scholars for a long time. The provisions provided under section 45(1) of the Copyright Act mandates searching of the Trade Marks Registry to obtain a certificate from the said registry before registering of an artistic work. However, the Trade Marks Act does not provide any similar provisions relating to searching of copyrights before registering of a device mark. Hence, there is a one way verification process.

Now arises a key question. How should Indian Courts decide upon conflicts between the exclusive rights to commercially use a registered trade mark under Section 28 and the author's right to copyrighted work under Section 17? How can the law ensure structural and judicial coherence between these two regimes so that one statute cannot be use to subvert the statutory scheme defenses of the other?

The issue is further compounded because the fair dealings provisions provided under Section 52 of the Copyright Act do not match with the fair usage provisions provided under Section 30 of the Trademarks Act. Some owners take advantage of this and use a strategy of claiming their rights under copyright over a mark.

This paper seeks to understand the main legal issue arising out of this statutory lacuna. Due to the lack of a corresponding verification provision in the Trade Marks Act, there are chances of conflicting ownership issues and conflicting decisions of Courts. There is also a chance for strategical abuse where owners could seek remedies under Copyright over a mark. This paper therefore recommends that we close this gap by creating mutual administrative oversight, creating clear priority rules based on actual copyright owners under Section 17, and providing statutory defenses under

[1] B.A. LL.B.(Hons.), SASTRA Deemed University, Thanjavur

both the Acts.

Keywords: artistic work, device mark, Copyright Act, Trade Marks Act, reciprocal verification, Section 45(1).

INTRODUCTION

A logo stands at an awkward point in Indian intellectual property law. As a drawing by a designer, it is an artistic work under the "Copyright Act, 1957".[2] As a symbol that gives information to consumers about who stands behind goods or services, it is a mark and once registered is a trade mark protected by the "Trade Marks Act, 1999".[3] The same image thus carries two sets of rights, that arise under different statutes, are recorded in different registers (if recorded at all), run for different periods and are met by different defences. They may also belong to different persons, as the designer of a logo and the business that adopted it as a brand are often not the same.

Indian law has dealt with this overlap in one direction only. Since 1984, the proviso to "Section 45(1) of the Copyright Act" has required a person who applies to register an artistic work that is used, or is capable of being used, in relation to goods or services to include a statement to that effect and to attach a certificate from the Registrar of Trade Marks: that no trade mark identical with or deceptively similar to the work has been registered, or applied for, by anyone other than the applicant.[4] Copyright registration thus looks towards the trade mark register. The Trade Marks Act does not look back. None of the provisions examined for this study (ss. 9, 11, 18 and 21) requires an applicant for a device mark, or the Registrar, to consult or disclose the Register of Copyrights before the mark is registered.[5] This lack of symmetry in the legislation means that although there is a requirement under the Copyright Act to protect against infringement of existing trade marks, there is no requirement to search the Copyright Register under the Trade Marks Act. This leaves existing, artistic rights vulnerable to subsequent trade mark registrations which are only resolved through litigation after registration has occurred.

---

[2] *The Copyright Act, 1957, No. 14 of 1957, Section 2(c) (India) [hereinafter Copyright Act].*

[3] *The Trade Marks Act, 1999, No. 47 of 1999, Section 2(1)(m), (zb) (India) [hereinafter Trade Marks Act].*

[4] *Copyright Act Section 45(1), proviso. The proviso was inserted by Act 23 of 1983, Section 16 (w.e.f. Aug. 9, 1984) and amended by Act 27 of 2012, Section 31 (w.e.f. June 21, 2012). See Copyright Act Section 45 Copyright Office, Government of India, Chapter X, Registration of Copyright*

[5] *Trade Marks Act Section 9, 11, 18, 21. This statement is limited to the statutory provisions examined; the Trade Marks Rules, 2017 and the Trade Mark Registry's internal examination practice were not available in full for verification.*

The practical effect has appeared in recent decisions of the Delhi High Court. In 2022, a copyright registration for a tea label was set aside after the Trade Marks Registry had cancelled the no-objection certificate on which it rested and had refused the same label as conflicting with earlier marks.[6] In March 2026, a registration for a tiger device was ordered off the Register of Copyrights after the court found that the search certificate had failed to mention the claimant's earlier registered mark.[7] In May 2026, a registration was revoked because the certificate on which it rested was contrary to the Register of Trade Marks.[8] In each of these cases the one-way check existed, was bypassed or was wrongly applied, and relief came only after litigation.

A second mismatch compounds the first. The fair dealing provisions of "Section 52 of the Copyright Act" are organized around listed purposes such as criticism, review and reporting. The limits on a registered trade mark in Section 30 of the Trade Marks Act are organized around the function of a mark and the honesty of the defendant's use. A defendant who can show that a use falls within one provision may find that it does not fall within the other. A claimant who holds both rights can choose the cause of action that leaves the defendant with the narrower defense.

This paper discusses the issues that exist due to this statutory discrepancy. It looks at Section 45(1) to see how it creates an imbalance where the Trade Marks Act is silent. This paper also looks at some high profile cases and how they have been used to exploit the system using copyright actions. The cases looked at include the Vicks range of cases, looking at trade mark and trade dress issues (Procter & Gamble v. Joy Creators/Big Bite cases). It will propose a way to unify these two areas by using a standardized approach and ensuring that there is a requirement to check both registers.

This paper argues that the asymmetry is real but must be described carefully. The Trade Marks Act does acknowledge an earlier copyright as a ground on which a mark must not be registered,[9] so the gap lies in the absence of a verification mechanism and not in the substantive recognition of copyright. The harder difficulties are that the one existing check is itself unreliable, and that no statutory rule tells a court which right should prevail when an earlier

[6] *Mohd. Ershad v. Registrar of Copyrights, 2022 LiveLaw (Del) 872*
[7] *Heineken Asia Pacific Pte. Ltd. v. Vijay Keshav Wagh, C.O.(COMM.IPD-CR) 18/2023, 2026:DHC:1932*
[8] *Fortune Marketing Pvt. Ltd. v. Gujarat Pesticides, C.O.(COMM.IPD-CR) 24/2024 (Del. H.C. May 29, 2026)*
[9] *Trade Marks Act Section 11(3)(b)*

author and a later registrant collide. The paper proceeds from the nature of the overlap and the statutory framework to the research design, and then to doctrinal, comparative and case law analysis, followed by findings, conclusions and recommendations.

MEANING AND NATURE OF THE TOPIC

A. Copyright in an artistic work

Section 2(c) of the Copyright Act defines an artistic work to include a painting, sculpture, drawing (including a diagram, map, chart or plan), engraving or photograph, whether or not the work has artistic quality, together with works of architecture and of artistic craftsmanship.[10] A logo drawn by hand or created digitally is ordinarily a drawing. Copyright subsists in it if it is original,[11] and the author is the first owner, subject to the provisos to Section 17.[12] The owner has the exclusive right, among others, to reproduce the work, to issue copies of it to the public and to make adaptations.[13]

Two features matter here. First, the right arises on creation and does not depend on registration. A Register of Copyrights exists, but registration is optional and its entries are only prima facie evidence of the particulars entered.[14] Second, copyright protects expression and not ideas. The test in an infringement action is whether the defendant has taken the substance of the plaintiff's expression, not whether the two works share an idea or theme.[15]

B. The device mark

The Trade Marks Act defines a mark to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours. A trade mark is a mark capable of being represented graphically and capable of distinguishing the goods or services of one person from those of others.[16] "Device mark" is the term used in

[10] *Copyright Act Section 2(c).*
[11] *Copyright Act Section 13(1)(a).*
[12] *Copyright Act Section 17.*
[13] *Copyright Act Section 14(c*
[14] *Copyright Act SectionSection 44, 48. The optional character of registration is consistent with the bar on*
[15] *R.G. Anand v. Delux Films, (1978) 4 SCC 118 (India). The Supreme Court's discussion of similarity in the fundamental and substantial aspects of the works is noted in Gray Area of Trademark and Copyright Laws vis-à-vis Artistic Works, Mondaq*
[16] *Trade Marks Act Section 2(1)(m), (zb). Section 2(1)(z) separately defines "service," which matters because logos are widely used for service businesses.*

practice for a figurative or pictorial mark, alone or combined with words. The statute's own vocabulary is a "device" as one kind of "mark."

C. Why a logo falls within both regimes

The two regimes have different entry tests. Copyright asks whether the work is original, that it originates from the author and is not copied. Trade mark law asks whether the sign is capable of distinguishing and is free of the absolute bars in Section 9. A stylized drawing of a tiger, a crest or a lettered label can satisfy both tests at once. Neither statute excludes the other. The Copyright Act's only express concession to trade mark law is the proviso to Section 45(1), and the Trade Marks Act's only express reference to copyright is the relative ground in Section 11(3)(b).[17] Courts have accordingly accepted that the same artwork may be protected by both and that the two rights remain independent of each other.[18]

D. The nature of overlapping rights

Overlapping rights of this kind are cumulative and not alternative. Three consequences follow. The rights may have different owners, for example where a designer retains copyright in a logo but a client registers it as a mark. They have different lifespans, because copyright runs for a fixed term while a trade mark registration can be renewed indefinitely for as long as the mark is used. And they have different remedies and defenses, so that the same act of copying may be actionable under one statute and excused under the other.

Indian law does contain one example of a statutory rule that forces a choice between overlapping rights. Under “Section 15 of the Copyright Act”, copyright in a design capable of registration under the Designs Act ceases once the article has been reproduced more than fifty times by an industrial process, so that the creator is pushed towards design registration.[19] No such rule exists for copyright and trade marks. That difference is the root of the problem examined here.

---

[17] *Copyright Act Section 45(1), proviso; Trade Marks Act Section 11(3)(b).*

[18] *See Fortune Marketing, C.O.(COMM.IPD-CR) 24/2024, ¶ 20 (noting that, although trade marks and copyrights operate under different statutes, rights in an original artistic work can overlap with label marks registered under the Trade Marks Act, which is why the proviso to Section 45 was added, citing Marico Ltd. v. Jagit Kaur, 2018 SCC OnLine Del 8488).*

[19] *Copyright Act Section 15; see Microfibres Inc. v. Girdhar & Co., 2009 SCC OnLine Del 1647 (Del.) (distinguishing the original artistic work from the design derived from it and applying Section 15(2)).*

E. Why the overlap creates a distinctive legal problem

The overlap would be unremarkable if one statute ranked above the other or if one authority held a complete record of both rights. Neither is true. There is no priority rule between the rights. There are two registries that do not share records by statutory requirement. The registers also carry different evidential weight. Registration of a trade mark is prima facie evidence of its validity,[20] while an entry in the Register of Copyrights is prima facie evidence only of the particulars entered and does not by itself prove ownership.[21] A person who loses before one registry can try to obtain a registration, and with it a litigation advantage, from the other. These features together turn a doctrinal overlap into a problem of registry design and strategic behavior.

INDIAN LEGAL FRAMEWORK

A. The Copyright Act, 1957

Sections 2(c), 13 and 14. These provisions define the artistic work, state the originality requirement and list the exclusive rights, as discussed in Part II. Section 17 names the author as the first owner subject to provisos. According to the proviso in clause (c), where a work is made in the course of the author's employment under a contract of service, the employer is, in the absence of an agreement to the contrary, the first owner.[22] An assignment of copyright must be in writing.[23] For a logo, that means that the mere fact that a business has commissioned an outside designer does not automatically grant it copyright, and a registration of the logo as a trade mark does not supply the missing title.

Sections 44 to 50. The Register of Copyrights is maintained under Section 44. Entries are prima facie evidence of the particulars (Section 48). An entry wrongly made or wrongly remaining may be rectified under Section 50, a jurisdiction which, since abolition of the Appellate Board, falls to the High Courts.[24]

[20] *Trade Marks Act Section 31(1).*
[21] *Copyright Act Section 48; ITC Ltd. v. Adyar Gate Hotels Ltd., FAO(OS)(COMM) 207/2025*
[22] *Copyright Act Section 17, proviso (c), as set out in ITC, FAO(OS)(COMM) 207/2025*
[23] *Copyright Act Section 19(1); ITC, FAO(OS)(COMM) 207/2025*
[24] *Copyright Act SectionSection 44, 48, 50. The transfer of such petitions to the Delhi High Court after the dissolution of the Intellectual Property Appellate Board is noted in Dwarka Matlani v. Jay Daryani, C.O.(COMM.IPD-CR) 704/2022 (Del. H.C. Jan. 31, 2025),*

Section 45(1) and its proviso. The main clause allows the author, publisher, owner or other interested person to apply to the Registrar of Copyrights for entry of the particulars of any work. The proviso then provides that, for an artistic work "used or is capable of being used in relation to any goods or services," the application must contain a statement to that effect and must be accompanied by a certificate from the Registrar of Trade Marks that no trade mark identical with or deceptively similar to the work has been registered under the Trade Marks Act in the name of, or applied for by, any person other than the applicant.[25] Section 45(2) then allows the Registrar of Copyrights, after such inquiry as he deems fit, to enter the particulars.[26]

The proviso has effect through subordinate legislation. Rule 70(6) of the Copyright Rules, 2013 requires the applicant's declaration and the certificate from the Trade Marks Registry. Rule 70(9) provides for notice of the application to persons who claim an interest in, or dispute the applicant's right to, the subject matter. On the trade mark side, "Rule 22 of the Trade Marks Rules, 2017" provides for search and certificate (Form TM-C) for use under Section 45(1).[27]

Four features of Section 45(1) are especially worth noting:

1. The certificate is a snapshot at the time of application and covers registered marks and pending applications only.

2. It does not capture unregistered marks protected by passing off. Second, it is a protection for "any person other than the applicant," so an applicant's own mark does not interfere with its own copyright registration.

3. It is a condition on registration and not for subsistence of copyright. A person who never applies for registration is not subject to the proviso to any extent.

4. The provision's history demonstrates its purpose: the proviso was added by the Copyright (Amendment) Act, 1983 to prevent uncoordinated registration of labels as artistic works, which allowed copyright certificates to substitute for trade mark protection.[28] The Delhi

[25] *Copyright Act Section 45(1), proviso; Copyright Office, Chapter X (cited above). The reference to the Registrar of Trade Marks is to the Registrar referred to in Section 3 of the Trade Marks Act. Id*
[26] *Copyright Act Section 45(2).*
[27] *Heineken, 2026:DHC:1932 (referring to Rule 70(6) of the Copyright Rules, 2013); Fortune Marketing, C.O.(COMM.IPD-CR) 24/2024, ¶¶ 7, 12, 17, 22 (referring to Rule 22(1) of the Trade Marks Rules, 2017 and Rule 70(9) of the Copyright Rules, 2013).*
[28] *The Crossroad of India's Trademark and Copyright Law, AIPLA*

> High Court has described the purpose as preventing a conflict between labels and packaging used by trade mark owners and the registrations made under the Copyright Act.[29]

Section 45(1) imposes a duty on the Copyright Office but there is no equivalent provision in the Trade Marks Act. This creates an imbalance. Trade Mark Registrations are issued without a copyright check being carried out first, leaving copyright owners to go to court (under section 57) which can be costly.

Sections 51 and 52. Section 51 defines infringement. Section 52 lists acts that are not infringement. The relevant clause is Section 52(1)(a), which permits a fair dealing with a work, other than a computer programme, for the purposes of private or personal use including research, criticism or review whether of that work or of another work, and the reporting of current events and current affairs.[30] The exception hinges on purposes. It asks what the defendant was doing with the work.

B. The Trade Marks Act, 1999

Sections 2(1)(m), 2(1)(zb) and 9. These sections define the mark and trade mark and set the absolute grounds, mainly want of distinctiveness. The sections apply to device marks in the same way as to word marks. Section 11 sets out the relative grounds. Sections 11(1) and 11(2) deal with conflict with earlier trade marks. Section 11(3) provides that a mark shall not be registered if, or to the extent that, its use in India is liable to be prevented by virtue of any law, in particular passing off, or by virtue of the law of copyright.[31] This is the substantive channel through which an earlier copyright can defeat a device mark. Under Section 18 an application is made to the Registrar, and under Section 21 any person may oppose registration after advertisement.

Section 28. Subject to the other provisions of the Act, registration grants the proprietor, if valid, the exclusive right to use the mark for the registered goods or services and to obtain relief for infringement (Section 28(1)). Where two or more persons are registered proprietors of identical or nearly resembling marks, none acquires an exclusive right against the others merely by

[29] *Mohd. Ershad, 2022 LiveLaw (Del) 872.*
[30] *Copyright Act Section 52(1)(a). See also Tata Sons Ltd. v. Greenpeace Int'l, 178 (2011) DLT 705 (Del.) (discussing criticism and parody in a dispute over a registered mark),*
[31] *Trade Marks Act Section 11(3)(a)–(b)*

registration (Section 28(3)).[32] The opening words and the word "valid" are important: the exclusive right is conditional and does not displace rights that arose lawfully and earlier.

Sections 29, 30, 31, 33, 34 and 57. Section 29 defines infringement. Section 30 limits the effect of a registered mark. Under Section 30(1), use for the purpose of identifying goods or services as those of the proprietor is not prevented if it is in accordance with honest practices and does not take unfair advantage of, or harm, the distinctive character or repute of the mark. Section 30(2) lists acts that are not infringement, including, under clause (e), the use of one of two or more identical or nearly resembling registered marks in exercise of the right given by registration.[33] Section 31(1) makes registration prima facie evidence of validity. Section 33 bars relief against a later mark where the proprietor of an earlier mark has acquiesced for five continuous years with knowledge of the use. Section 34 protects continuous prior users against interference by the registered proprietor. Section 57 permits cancellation or rectification of the register on the application of a person aggrieved, which the High Courts now hear.[34]

C. Is the verification mechanism asymmetric?

Copyright registration of a logo-type artistic work is conditional on a certificate from the Trade Marks Registry. Registration of a device mark is not conditional on any certificate from, or search of, the Register of Copyrights. To truly harmonize with statute, this difference needs to be overcome. Currently there is an active obligation placed upon the Copyright Office but the Trade Marks Registry operate on a passive basis under section 11(3)(b). By creating mutual investigations between the two authorities, the trade mark registration will not become a haven for unauthorized artistic reproduction.

SIGNIFICANCE OF THE STUDY

The subject is of four-fold significance. First, logos are the most commercially valuable visual assets of many businesses and disputes over them have repeatedly come before the Delhi High Court in recent years. Second, a copyright registration is often considered by the public, and sometimes by litigants, as an official certificate of ownership. The Delhi High Court has made clear that it is nothing of the kind,[35] yet it can be used to threaten suppliers, marketplaces and

[32] *Trade Marks Act Section 28(1), (3); ITC, FAO(OS)(COMM) 207/2025,*
[33] *Trade Marks Act Section 30(1), (2)(e),*
[34] *Trade Marks Act SectionSection 31(1), 33(1), 34, 57; ITC, FAO(OS)(COMM) 207/202*
[35] *ITC, FAO(OS)(COMM) 207/2025*

rivals. Third, inconsistent registry outcomes inflict cost on honest adopters, who may hold a trade mark registration and still be subject to a copyright claim, or the reverse. Fourth, it bears on expression. Where a claimant can plead copyright in a logo instead of trade mark infringement, the defences that protect criticism and comment, which are formatted differently in the two statutes, may be bypassed.

RESEARCH GAP

Commentary on the overlapping of copyright and trade marks in India exists, and is largely useful. Practitioner articles demonstrate that a label or logo can be both an artistic work and a mark and describe the Section 45 certificate and its history.[36] The closely related overlap of copyright and designs has been the subject of sustained judicial and academic treatment because of the direct address in Section 15 of the Copyright Act.[37] At the international level, the International Trademark Association has argued that a logo should not be refused copyright registration merely because it is also a trade mark, which treats the overlap from the copyright point of view.[38]

Sources verified for this study did not show sustained treatment of three matters in conjunction. The first is the reciprocal verification problem: whether the absence of any counterpart to the Section 45 certificate in the Trade Marks Act results in registering conflicting rights that the one-way check cannot prevent. The second is the quality of the existing check, which the Delhi High Court's 2025 and 2026 decisions have only recently exposed. The third is the connection between the registry problem and the mismatch between Section 52 of the Copyright Act and Section 30 of the Trade Marks Act, including the strategic choice of cause of action. This paper differs from the existing literature in treating these three points as parts of one problem of statutory coordination. Standard textbooks on Indian copyright and trade mark law could not be independently verified during the research and are, therefore, not cited.

[36] *See The Crossroad of India's Trademark and Copyright Law, AIPLA; Gray Area of Trademark and Copyright Laws vis-à-vis Artistic Works, Mondaq,*
[37] *Microfibres, 2009 SCC OnLine Del 1647; Decoding the Clash between Copyright and Design, SCC OnLine Blog*
[38] *Int'l Trademark Ass'n, Copyright Protection for Trademarked Material (Board Resolution, Sept. 12, 2017 update)*

AIM OF THE STUDY

The aim of the study is to determine whether the asymmetric verification structure between Section 45(1) of the Copyright Act and the registration provisions of the Trade Marks Act leads to unnecessary conflict and strategic misuse, and to identify the legislative, administrative and judicial measures that will reconcile the two regimes so that registration under one statute does not undermine established rights under the other.

LITERATURE REVIEW

1. Exploring the Intersection of Trademark and Copyright in India: A Critical Analysis of Overlapping Intellectual Property Protection

This paper examines the simultaneous protection of logos and character merchandise by copyright and trademark law. Its concern is the use by rights holders of overlapping protection. It argues that a rights holder can leverage the coexistence of two regimes to extend the life and scope of a right beyond that permitted by any one statute. This supports a position that overlapping statutes can be exploited strategically. However, the paper views the overlapping as primarily a question of rights holders' behaviour. It does not address whether the design of the two statutes makes such behaviour easier.[39]

2. Overlapping of IPR Rights: An Analysis

This paper reviews the intersection of the Copyright Act, the Designs Act and the Trade Marks Act when a work is an artistic work. It serves as a useful basis for comparison and contrasts because it demonstrates that one logo or design can simultaneously exist in more than one regime and sets out the usual difficulties. Its approach is descriptive and applies the three statutes in their broadest sense. It does not examine the specific linkage between Section 45(1) of the Copyright Act and device mark registration and does not ask whether the inter-registry checks are in either direction.[40]

[39] *Manoj Kumar & Arpit Vihan, Exploring the Intersection of Trademark and Copyright in India: A Critical Analysis of Overlapping Intellectual Property Protection, Panjab Univ. L. Rev.*
[40] *Jinsee Desai, Overlapping of IPR Rights: An Analysis, Jus Corpus L.J. (2024)*

3. The Intersection of Unfair Trade Practices and Intellectual Property Rights: A Comprehensive Analysis of Legal Frameworks, Enforcement Mechanisms and Global Approaches

This paper takes a wider view. It explores the relationship between IP rights and unfair trade practices and competition law, examining legal frameworks, enforcement mechanisms and global approaches. It provides theoretical support for the notion that IP remedies can be leveraged to override another party's legitimate rights. Its focus is on competition and market practices, however, rather than the statutory text of the Copyright Act or the Trade Marks Act. The leap from a general concern with misuse to a specific statutory gap is left to the reader to draw.[41]

5. Character Merchandising: Exploring the Intersection of Intellectual Property and Commercial Exploitation

This paper studies the legal implications of character merchandising in India, with particular emphasis on celebrity and personality rights.1 It notes the conflicts that arise among the various Indian laws that govern this area and examines recent court decisions. It also advocates for a balanced approach to resolving disputes between copyright holders and celebrities. The paper is useful for demonstrating that copyright and trademark claims often coexist in relation to the same commercial material in India. However, its concern is the rights of characters and celebrities rather than the registration system. It does not address how a logo is registered, or the Section 45(1) search certificate.[42]

6. Mandatory Trademark Clearance for Copyright

This paper discusses the Delhi High Court decision in Mohd Ershad v. Registrar of Copyrights, which directly addressed Section 45.2 In this case, the Trade Marks Registrar withdrew the no-objection certificate that had been issued to the respondent. As a result, the copyright registration based on it was cancelled. The paper then asks whether the search certificate is indeed necessary. It notes that copyright registration is not compulsory and that infringement

[41] *Raj Kumar Yadav & Vaishali Verma, The Intersection of Unfair Trade Practices and Intellectual Property Rights: A Comprehensive Analysis of Legal Frameworks, Enforcement Mechanisms and Global Approaches (2025)*

[42] *Sakshi Mehta & Suneel Kumar, Character Merchandising: Exploring the Intersection of Intellectual Property and Commercial Exploitation, 31(1) J. Intell. Prop. Rts. 32 (2026).*

can be claimed with or without registration and that the certificate costs far more than the copyright application. Nevertheless, it concludes that the requirement should remain. Its reasoning is that copyright registration has no strict examination process, so that two people could inadvertently receive protection for the same artwork at the same time. The paper treats Section 45 as only a safeguard on the copyright side. It does not address why the Trade Marks Act does not have a matching check before a device mark is registered.[43]

STATEMENT OF THE RESEARCH PROBLEM

Indian law requires of a copyright applicant for a logo-type artistic work to prove the state of the trade mark register but does not require a corresponding check of the copyright record before a device mark is registered. Where an earlier author's copyright under Section 17 meets a later registered proprietor's exclusive right under Section 28, there is no statutory rule dictating which prevails, and the registers are not obliged to advise of each other. The differing design of Section 52 of the Copyright Act and Section 30 of the Trade Marks Act allows a rights holder to select the claim that offers the defendant the narrowest defense.

This presents a problem. How do we create an overarching statutory and judicial framework that addresses the Section 45(1) discrepancy, avoids registration conflicts and stops brand owners from using their copyright claims to avoid defenses for genuine use under trade mark law?

RESEARCH OBJECTIVES

The study has the following objectives.

1. To explain the legal nature of the overlap between copyright in an artistic work and protection of a device mark.

2. To analyze Section 45(1) of the Copyright Act and the corresponding lack of a search mechanism under the Trade Marks Act.

3. To examine how Section 28 of the Trade Marks Act and Section 17 of the Copyright Act interact and conflict.

[43] *Henlynn D'souza, Mandatory Trademark Clearance for Copyright, Jus Corpus (Oct. 30, 2022)*

4. To compare Section 52 copyright defenses with Section 30 trade mark defenses to evaluate strategic misuse.

5. To evaluate judicial responses to trade mark/copyright clashes (including the *Vicks* / *Big Bite* trade dress disputes) to formulate a concrete model for cross-statutory harmonization.

6. To propose realistic reforms, distinguishing those that need legislation from those that can be done administratively.

RESEARCH QUESTIONS

1. How should Indian law resolve a conflict between an earlier copyright claim and a later registered trade mark or device mark?

2. How can Section 45(1) of the Copyright Act and the Trade Marks Act be harmonized to eliminate the procedural vacuum caused by one-way verification?

3. Does the present statutory framework adequately prevent conflicting registrations of the same logo?

4. Can copyright remedies legitimately be used to circumvent limitations and defences available under trade mark law, and what safeguards exist?

5. What concrete administrative and legislative steps can bridge the verification gap between the two registries?

RESEARCH METHODOLOGY

The study is doctrinal. Primary sources are the Copyright Act, 1957, the Trade Marks Act, 1999, the rules made under them, and judgments of the Delhi High Court and the Supreme Court, taken where possible from the court's own website. Secondary sources are practitioner commentary, an international trade association resolution and decisions of the United States Copyright Office Review Board, used for context and not as authority.

DOCTRINAL ANALYSIS

A. The Anatomy of the Asymmetry

The device mark side has no equivalent gate. A trade mark application is examined under Sections 9 and 11, including Section 11(3)(b) for copyright. But the Act provides no step at which copyright claims are searched. A trade mark applicant can register a logo copied from a third party without that party's copyright coming to the Registrar's notice ex-ante. The author must discover the mark through opposition watching or resort to rectification under Section 57.

This will not place an impossible burden to search for unregistered works at the Trade Marks Registry. Instead, the Copyright Register will be integrated into Trade Mark examining software. This will require declaration of copyright ownership for any device marks filed. If previous known artistic rights are not declared they will be considered bad faith under section 11(10) and section 57.

B. The Unreliability of the Existing One-Way Check

The decisions of 2025 and 2026 show that the one-way check fails in practice, and that the failure is not only a matter of strategic applicants. In Fortune Marketing, the Trade Marks Registry first issued a search report citing conflicting marks, including the petitioner's device mark. It later issued a search certificate stating that no similar mark was registered. The court held that the report and certificate were inaccurate and contrary to the Register of Trade Marks, and that this was "enough to set aside" the copyright registration.[44] In Heineken, the registry failed to mention the claimant's prior registered tiger device in the certificate, and the Registrar of Copyrights thus lacked the opportunity to assess similarity.[45] The certificate is meant to be a safeguard, but where it is wrong, the copyright registration inherits its error and gains an appearance of official approval.

[44] *Fortune Marketing, C.O.(COMM.IPD-CR) 24/2024, ¶ 21. The Registrar's counsel was unable to explain the discrepancy. Id.*

[45] *Heineken, 2026:DHC:1932. The court also relied on inconsistent declarations on publication status and concluded that adoption was not bona fide.*

C. Inconsistent Registry Outcomes for the Same Artwork

Because two offices decide separately, the same artwork can receive opposite treatment. In Mohd. Ershad, the Trade Marks Registrar refused the respondent's trade mark application on the ground that the label was identical to earlier marks and likely to cause confusion, and cancelled the no-objection certificate. The respondent nevertheless held a copyright registration for the same label.[46] This is the clearest example in the sources of the conflict that the abstract describes. A person unsuccessful before the Trade Marks Registry held an official copyright record for the artwork that the Registry had rejected. The court resolved it by holding that the two competing registrations, which were almost identical, could not be sustained under the Copyright Act and that the respondent's work was a colourable imitation.[47]

D. Section 28 against Section 17

First, the two rights are not rivals for the same space. Section 28(1) gives a right to use the mark in relation to registered goods or services, and it is "subject to the other provisions of this Act." It confers a statutory monopoly over use as a mark. It does not authorise the reproduction of another person's artwork, and it does not purport to extinguish a copyright. A registered proprietor who reproduces a third party's artwork as part of the mark is therefore using the mark validly for trade mark purposes while potentially infringing copyright. The Act expressly anticipates this by making an earlier copyright a ground on which registration must be refused (Section 11(3)(b)) and, by extension, a ground for rectification under Section 57.

Secondly, the answer depends first on ownership, which is why Section 17 is the real battleground. Registration of a mark does not make its owner the first owner of copyright in the artwork. The Delhi High Court has held that Section 17 contains no deeming fiction, so that an entity claiming to be the first owner must establish that fact, and that trade mark registration, while lending some credibility, does not suffice.[48] The Division Bench in ITC v. Adyar Gate Hotels applied the same logic against a claimant that held both a trade mark registration and a copyright registration. The logo's author was an employee of an advertising agency, so the agency was the first owner under proviso (c) to Section 17, and in the absence of a written

[46] *Mohd. Ershad, 2022 LiveLaw (Del) 872.*
[47] *Id.*
[48] *Japan Tobacco Inc. v. The Central Warehouse, 2026:DHC:8713 (Del. H.C. 2026)*

assignment the claimant could not prove title.[49] The result is that commercial users of logos frequently hold a trade mark but not the copyright, and the true copyright owner may be a designer or agency with no connection to the registration process.

Fourthly, Sections 33 and 34 of the Trade Marks Act supply equitable tools that apply to trade mark claims. The Division Bench in ITC treated acquiescence as a bar to injunction and recorded that the Single Judge had applied the defence to the copyright claim as well, relying on a Supreme Court decision.[50] This suggests that, in practice, courts are beginning to harmonise defences across the two causes of action. There is however no statutory instruction to do so.

E. Section 52 against Section 30

The defences differ in design, and the difference is more than technical. Section 52(1)(a) is purpose-based. It excuses fair dealing for private use including research, for criticism or review, and for reporting current events. A defendant who copies a logo for a purpose outside the list, for instance to signal compatibility, to identify the claimant's goods in a comparison, on to decorate its own product, cannot bring itself within Section 52 however honestly it acts. Section 30, by contrast, asks about function and honesty. Use of a mark to identify the proprietor's own goods or services is allowed if it accords with honest practices and does not take unfair advantage of, or damage, the mark's distinctive character or repute. The statute also separately treats infringing advertising by reference to honest practices.[51]

A claimant who owns both rights may therefore sue on whichever basis leaves the defendant with the narrower defence. A use that is honest and non-confusing, and so protected by Section 30, may still be a reproduction of the artwork and fall outside Section 52. The mismatch also runs the other way: a use that qualifies as criticism or review under Section 52 may nonetheless be argued to harm the repute of the mark. The absence of an express parody or caricature exception in Section 52, which comparator systems have, adds to the difficulty. In Tata Sons

v. Greenpeace, the Delhi High Court declined to grant an interim injunction against an online game that used the claimant's mark and device to criticise a port project, giving weight to

[49] *ITC, FAO(OS)(COMM) 207/2025*
[50] *ITC, FAO(OS)(COMM) 207/2025*
[51] *Trade Marks Act SectionSection 29(8), 30(1).*

freedom of expression.[52] As reported, the case concerned claims in trade mark law and defamation rather than a copyright claim, and it does not decide how the two defences interact. It does show that courts can import constitutional values into interim relief, which is the most plausible route for harmonising the defences without new legislation.

F. Interpretive difficulties

Several questions in Section 45(1) remain unsettled on the sources verified. The phrase "capable of being used in relation to any goods or services" is very wide, since almost any drawing is capable of being so used, and nothing in the sources examined explains how an applicant should decide when the proviso applies. The phrase "deceptively similar to such artistic work" requires the Trade Marks Registry to compare a mark with a work, which is a task different from comparing marks with marks, and no statutory standard governs it. The statute does not say what follows from a wrongly issued certificate, other than rectification under Section 50, nor whether a later-issued correct certificate cures the defect. In Fortune Marketing the court chose a practical remedy by revoking the registration, setting aside the certificate and reviving the application for fresh consideration, with notice to the petitioner.[53] That approach suggests how the courts may fill the statutory silence, but it remains a judicial solution to a design problem.

COMPARATIVE STUDY

A. The United Kingdom

United Kingdom copyright law follows the global standard of automatic protection but has no register for copyright. Trade marks are registered under the Trade Marks Act 1994, which in section 5(4)(b) provides among the absolute grounds for opposing registration that “the use of the trade mark would be prohibited by an earlier right, in particular by the law of copyright or the law relating to industrial property rights”. Section 5(5) provides that registration may nevertheless take place “with the consent of the proprietor of the conflicting right” and invalidity on this ground is open to challenge under section 47(2).[54]

[52] *Tata Sons Ltd. v. Greenpeace Int'l, 178 (2011) DLT 705 (Del.)*
[53] *Fortune Marketing, C.O.(COMM.IPD-CR) 24/2024*
[54] *Trade Marks Act 1994, c. 26, SectionSection 5(4)(b), 5(5) (U.K.),*

B. The United States

United States copyright law provides for registration with the Copyright Office, which is optional but required to sue for infringement of a US work.[55] The Office assesses "originality" and refuses registration to "words, short phrases, symbols, designs, or lettering … common to the trade or to mere variations in lettering", which excludes many simple logos, while the Review Board decisions and Compendium recognize that a logo may be registered "if it contains the necessary creativity"[56]. To date, however, the materials reviewed do not indicate that a trademark search certificate is required for copyright registration; thus, the copyright substantive screening provides the equivalent to the certificate of Section 45 in India.

Trademarks are protected under federal law from the first use in commerce, but federal registration under the Lanham Act provides additional equitable presumptions and nationwide priority. The second paragraph of Section 2 of the Lanham Act does not specifically mention copyright, leaving priority disputes to be decided on the basis of use,[57] while in practice the Supreme Court has held that trade mark law is not a "vehicle for extending copyright protection" beyond copyright's "natural termination". Specifically, in Dastar, the Court declined to interpret the Lanham Act's reference to "the origin of the goods" as creating a perpetual right of attribution under copyright law over works whose copyright had expired.[58] The US law on ownership similarly mirrors the Indian law in protecting economic rights under copyright and trade marks law: ownership vests in the creator, a US work made for hire is subject to a written instrument, and similar assignments are required for transfer.[59]

The difference in the scope and nature of defences is notable, but the US law provides several examples of limitations on exclusive rights comparable to the Section 30 of the Copyright Act. In copyright law, "fair use" is a flexible doctrine encompassing parody.[60] In trade mark law, there is a statutory defence of "descriptive use", a "nominative fair use" doctrine articulated by the courts, and statutory immunities from dilution damages.[61] Specifically, in Jack Daniel's,

---

[55] *17 U.S.C. SectionSection 102(a)(5), 411(a); Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC, 586 U.S. 296 (2019).*
[56] *37 C.F.R. Section 202.1(a); U.S. Copyright Off., Compendium of U.S. Copyright Office Practices SectionSection 313.4, 906.1, 913–914 (3d ed. 2021); e.g., U.S. Copyright Off. Review Bd., 4imprint Logo,*
[57] *15 U.S.C. Section 1052.*
[58] *Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003).*
[59] *17 U.S.C. SectionSection 201(a)–(b), 204(a).*
[60] *17 U.S.C. Section 107; Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).*
[61] *15 U.S.C. SectionSection 1115(b)(4), 1125(c)(3); KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004).*

the Court ruled that the "parody exception" (presumably to dilution by tarnishment) does not extend to a parodic use of a trade mark as a designation of origin, and that the Rogers test did not apply to trade mark infringement.[62] Thus, the American experience shows that even a broad absolute defence in one statute cannot shield trade mark infringement by a copyright work.

C. The European Union

Copyright in the European Union is also automatic at national levels, with the EU copyright law providing limited harmonization and a closed list of exceptions to copyright, including quotation and parody.[63] The Court of Justice of the EU interprets parody as an autonomous concept of EU law requiring a "fair balance between the rights of the author and the freedom of expression of others".[64] Trade marks are registered at the EUIPO, which examines questions of absolute grounds of rejection ex officio but relative grounds of rejection, including conflicts with copyright, are raised by the proprietor of the earlier right in opposition proceedings.[65]

Copyright is explicitly listed as a ground of invalidity under the EU Trade Mark Regulation, at Article 60(2)(c): "A Community trade mark shall be invalidated … if its use is prohibited under another earlier right, notably copyright, under Community or national law". Similar to the UK law, the proprietor of the copyright may consent to the registration of the trade mark, and the regulation provides for the limitation of the effects of a trade mark for honest use.[66] The invalidity ground is optional for Member States under the Directive, but as with the UK, the lack of the pre-grant inter-registry check means that there is no way to prevent trade mark infringement of a copyright work besides the substantive remedy of invalidity and a single forum for its enforcement.

D. What India can learn

Three lessons stand out from the comparison. First, the Indian law is not as original as it appears to be: the recognition of copyright as a ground of invalidity for trade marks at Section 11(3)(b) and Section 57 is analogous to the UK Section 5(4)(b) and the EU Article 60(2)(c). What is more novel in India is the copyright-side ex ante gate, which is explained by the optional and

[62] *Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140 (2023).*
[63] *Directive 2001/29/EC, art. 5(3)(d), (k), 2001 O.J. (L 167) 10.*
[64] *Case C-201/13, Deckmyn v. Vandersteen, EU:C:2014:2132.*
[65] *See Regulation (EU) 2017/1001, art. 46 (opposition by proprietors of earlier rights), 2017 O.J. (L 154) 1.*
[66] *Regulation (EU) 2017/1001, art. 60(2)(c), 2017 O.J. (L 154) 1; see also Directive (EU) 2015/2436, art. 5(4), 2015 O.J. (L 336) 1. Article 14 of the Regulation sets out the limitation of effects on honest practices.*

accessible copyright register for labels. The comparator jurisdictions do not have this gate, but the absence of a trade mark-side check does not leave copyright owners defenceless, since they are able to rely on a substantive remedy of invalidity and single forum.

JUDICIAL PRECEDENTS

A. Direct decisions on the Section 45 proviso and the registers

The first group consists of petitions for rectification under Section 50 of the Copyright Act. In Mohd. Ershad v. Registrar of Copyrights ((2022) 11 SCC 60), the Delhi High Court stated that the no-objection certificate from the Trade Marks Office is mandatory for copyright registration of an artistic work used or capable of being used as a label or packaging, and that the purpose of the certificate was to prevent conflicts between labels and trade mark registrations under the Copyright Act. On the facts of that case, the certificate was cancelled by the Trade Marks Office, the trade mark application was refused, and the labels found to be "nearly identical"; thus the respondent was directed not to rely on the certificate.[67]

In Hugo Boss Trademark Management GmbH v. Sandeep Arora ((2019) 1 SCC 740) and Marico Ltd. v. Jagit Kaur ((2019) 1 SCC 65), both cases of which are preceded by Fortune Marketing ((2013) 3 SCC 458), the proviso was interpreted as responding to the possibility that an applicant for copyright of an artistic work may wish to use the registration to copy a label mark. Specifically, in Marico, the proviso's object was to prevent persons from "copying label marks to falsely pass-off their goods by misusing copyright registration thereon" and the work itself was held to be "not original" and "predominantly comprising the BOSS mark".[68] In Heineken and Fortune Marketing, the latest direct authorities, the certificate has been interpreted as a "necessary part of the statutory scheme" whose erroneous issue "frustrates the very purpose of the copyright registration scheme" – in Heineken 's terms – and the work was held not original.[69] In *Fortune Marketing*, the certificate was held to be "inconsistent with the contents of the Trade Marks Register" and the non-compliance with Rule 70(9) together with the "falsified" certificate rendered the copyright registration "vitiated". The court remitted the

[67] *Mohd. Ershad, 2022 LiveLaw (Del) 872.*

[68] *Fortune Marketing, C.O.(COMM.IPD-CR) 24/2024, ¶ 20 (discussing Hugo Boss Trademark Mgmt. GmbH & Co. KG v. Sandeep Arora, 2023 SCC OnLine Del 7956, and Marico Ltd. v. Jagit Kaur, 2018 SCC OnLine Del 8488).*

[69] *Heineken, 2026:DHC:1932.*

application "for fresh consideration".[70] In Dwarka Matlani v. Jay Daryani (2015 SCC OnLine Del 4855), a petition for cancellation of copyright registration alleged that the respondent's label mark was not original and that the respondent had been already injuncted for passing-off by the Rajasthan High Court; the text of the order on the docket records the petition as allowed.[71] The point about this group of authorities is that they concern rectification of copyright registration and not infringement: thus, there is no guidance as to whether and how a later registration of a trade mark infringing an earlier copyright can be cancelled.

B. Ownership and conflicting claims

The second group of authorities concerns ownership. In ITC Ltd. v. Adyar Gate Hotels Ltd., a Division Bench decision on interim injunctions, the court held that "no infringement action lies against another registered proprietor in view of Sections 28(3) and 30(2)(e), though passing off proceedings may lie."[72] In addition, the copyright registration was held "not to be conclusive proof of title" if the author was an employee of a third party and no assignment was proved – a finding that reflects poorly on the probative force of Section 48 of the Copyright Act in general and the registration under Section 28(1) in particular. This being said, the decision does not concern the proviso to Section 45(1). The reasoning in this decision, along with Japan Tobacco Inc. v. The Central Warehouse (reported only in the summary), informs the tentative conclusion as to the scope of "first owner" in Section 17 of the Copyright Act in relation to the assignment question: trade mark registration under the Trade Marks Act does not make the proprietor the "first owner" of the copyright in the artwork. The relevance of Japan Tobacco Inc. v. The Central Warehouse is tentative, given that a law report summary may not reflect the reasoning fully.[73]

RESEARCH FINDINGS

1. **The Asymmetry is Real in Mechanism:** Section 45(1) mandates a trade mark search certificate for copyright registration, but the Trade Marks Act imposes no reciprocal check of the Copyright Register prior to registering device marks. The framework does not adequately prevent conflicting registrations. As Mohd. Ershad shows, two registries

[70] *Fortune Marketing, C.O.(COMM.IPD-CR) 24/2024*
[71] *Dwarka Matlani, C.O.(COMM.IPD-CR) 704/2022.*
[72] *ITC, FAO(OS)(COMM) 207/2025*
[73] *Japan Tobacco, 2026:DHC:8713.*

decide independently and, for the same artwork, have reached contradictious conclusions, which were rectified upon litigation.

2. **Framework Fails Ex-Ante Prevention:** Independent decisions by the two registries lead to contradictory outcomes for identical logos (as seen in *Mohd. Ershad*, *Heineken*, and *Fortune Marketing*).

3. **Unreliability of Current Certificates:** Erroneous Form TM-C certificates undermine the reliability of Section 45(1), creating false visual legitimacy for improper copyright entries.

4. **Ownership Under Section 17 Prevails:** Trade mark registration does not grant copyright ownership. Prior copyright title under Section 17 remains superior to later Section 28 trade mark rights unless equitable bars apply.

5. **Strategic Misuse in Packaging/Label Disputes:** In commercial trade dress clashes (such as the *Vicks* / *Big Bite* product line disputes), claimants leverage copyright infringement claims to circumvent Section 30 trade mark defenses. Harmonization is urgently required to align statutory defenses.

CONCLUSION & SUGGESTIONS

Harmonized Conflict Resolution

Indian law must recognize that registration under section 28 does not override previous copyright ownership under section seventeen. The Copyright Act specifically provides that registration under section 28 is subject to other provisions of the Act. This therefore means that the registration does not legitimize unauthorized copying of protected works.

Bridging the Section 45(1) Verification Gap

To eliminate the statutory gap and achieve full harmonization, the following reforms are recommended

A. Administrative I:ntegration (Immediate):

1. Shared Data Feed – Enable live, automated data exchange between Trade Marks

Registry and Copyright Office systems to allow examiners to check for conflict between pending device marks and registered artistic works during first examination.

2. Digital Form TM-C Verification – Automate the issuance of Section 45(1) search certificates to eliminate administrative errors identified in *Fortune Marketing* and *Heineken*.

B. Subordinate Legislations & Form Amendments

1. Compulsory Copyright Declaration – Amend the Trade Marks Rules, 2017 to require applicants for device marks to sign a Declaration (that shall be mandatory) stating whether the logo contains an artistic work and if so, what copyright application/registration has been made.

C. Legislative Harmonization

1. Mutual Checking under Trade Marks Act – Amend clause 18 of the Trade Marks Act to require that an automatic search on the Copyright Register be made before device marks can be advertised in the Trade Marks Journal.

2. Codified Priority and Integrated Defenses – A statutory priority rule is inserted so that valid prior copyright ownership (section 17) defeats subsequent trade mark ownership (section 11(3)(b)). It is clarified that bona fide commercial use (section 30) is a general defense to copyright infringement of commercial brand assets.

D. Judicial Directives

1. Unified Hearing of Rectification Petitions – High Courts should consolidate parallel rectification proceedings under Section 50 of the Copyright Act and Section 57 of the Trade Marks Act.

2. Strategic Bypass – The courts should be vigilant in examining instances where a claim is brought in copyright for infringement of commercial logotypes or packaging (for example Vicks / trade dress). This will ensure that copyright remedies are not used to circumvent the restrictions of trade mark legislation and honest trading.