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THE BACKGROUND PERFORMER PARADOX IN INDIA**ROHAN CHERIAN THOMAS*****ABSTRACT**

The contributions made by performers such as dubbing artistes and stuntmen are intriguing because they satisfy the qualification of a performance as a form of intellectual property under Section 2(q) of The Copyright Act, 1957 but seem to get excluded with the application of the proviso to Section 2(qq). This paradox originates from the treatment meted out to these performers as people working on a system of wages with the perception that they are not worthy of being credited for their contributions along with a seemingly mischievous addition made by the 2012 amendment to the Act.

The industry term for a performer who provides minor contributions such as standing in a crowd is an 'extra' or a 'junior artiste' or a 'background performer'. The Proviso does not use any of these terms. Instead, it relies on industry practice to interpret a casual performer and exclude him from being a performer under the Act.

Considering power equations in the industry, performers face an uphill task for fair treatment. In such a situation, it is important that ambiguities at least do not arise from law. While the Amendment has brought many benefits to the Indian performer such as moral rights and the 'Right to Receive Royalty', these performers who provide sufficiently original performances are unable to exercise their rights due to the perceptions in the industry. There is a difference between a 'background performer' and a 'casual performer'. This paper seeks to identify the origins of this ambiguous position in The Proviso, analyses its effect on Indian performers and attempts to provide possible solutions.

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I. INTRODUCTION

The 2012 Amendment [“**Amendment**”] to the Copyright Act, 1957 [“**Act**”] has been nothing short of a watershed moment for Indian authors and performers. As Prashant Reddy points out, it is a landmark piece of legislation that marks a clear shift in the Indian stance from the adoption of the traditional Anglo-Saxon approach to the *droit d’auteur* approach based on human rights.¹ Performers in India awoke to their own moral rights and to a more nuanced economic rights structure, in tune with the developments in information technology.

The focus of this article will be on the addition of a proviso to the interpretation of performer provided under the Act in Section 2(qq) [“**Proviso**”]. At first glance, it seems harmless:

“Section 2(qq): Performer includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance:

Provided that in a cinematograph film a person whose performance is casual or incidental in nature and, in the normal course of the practice in the industry, is not acknowledged anywhere in the credits of the film shall not be treated as a performer except for the purpose of clause (b) of Section 38B;”

In fact, some may even say that by writing down the unwritten, this law now provides more certainty in identifying audio-visual performers. These perceptions and opinions take a bashing when we dig deeper and ask questions such as, who is a casual performer and what justifies basing its interpretation on the industrial practice of non-acknowledgement. Instead of bringing more clarity, the proviso makes the classification of performers dubious. The insidious effect of the proviso is such that it may exclude even qualified performers from protection under The Act. The industry-specific terms for this excluded category of performers are ‘extra’/ ‘junior artiste’/ ‘background performer’. According to Marnie Hill, who has extensively studied the Australian entertainment industry, an extra is known by various names. These could be a background actor, an atmosphere actor, a supernumerary or even a walk-on.² These individuals do not have

¹ Prashant Reddy, *The Background Score to the Copyright (Amendment) Act, 2012*, NUJSL REV.469–527 (2012).

² MARNIE HILL, *THE ACTORS’ HANDBOOK: A GUIDE TO THE AUSTRALIAN ENTERTAINMENT INDUSTRY* 270 (Dean Nottle, 2007).

dialogues and work *en-masse*. According to Hill, these individuals are directed by the 3rd assistant director and not by the principal. Extras can also be called in for providing voices, such as crowd noises.³ Featured extras are persons whose faces can be seen clearly and are directed individually, but don't speak. These types of featured extras get paid more.⁴

A 2013 film from the Philippines called 'Ekstra' captures the difficulties of the extras quite well. It is a poignant story familiar to so many who work as bit-part players in the industry. There is no comfort afforded to an extra on the film sets, they might work for unfixed hours, in harsh conditions, for a measly sum of money. The problems highlighted in the film are real and its blunt characterisation captures the travails of this community very well. Russell McConnell, a veteran extra had said that it is easy to take advantage of this group because they are the most vulnerable.⁵

A number of performers' organisations do not represent background or "extra" performers who may have few words to say or no dialogue, and literally do appear in the background.⁶ Katherine Sand explains that such performers get covered through agreements in the Television and Film industry or through Unions, but they don't get payment for secondary usage.⁷ For instance, in the US, The Screen Actors Guild, the American Federation of Television and Radio Artists AFTRA claim jurisdiction over such performers but they are not 'performers'.⁸ The definition of extras in the AFTRA Network Code is as follows:

"Walk-ons and extras are those performers who do not speak any lines whatsoever as individuals but who may be heard, singly or in concert, as part of a group or crowd."

In India, a good example is the Cine and Television Artistes Association ["**CINTAA**"], where a junior artiste explained to News18 that while membership to work as an extra or a junior artiste is compulsory, the pay can be as low as 750 Rupees for contributions in television shows such as

³ *Id.* at 270.

⁴ *Supra* note 2 at 271.

⁵ Richard Verrier, *Extras Are The Center Of Attention In Crackdown On Casting Company Fees*, L.A. TIMES (June 10, 2011), <https://www.latimes.com/business/la-xpm-2011-jun-10-la-fi-ct-extras-20110610-story.html>.

⁶ Katherine Sand, *WIPO Review of Contractual Considerations in the Audio-visual Sector*, at 13, https://www.wipo.int/edocs/pubdocs/en/copyright/1034/wipo_pub_1034.pdf.

⁷ Katherine M. Sand, *Ad Hoc Informal Meeting on the Protection of Audio-visual Performances: Study on Audio-visual Performers' Contracts and Remuneration Practices in Mexico, The United Kingdom and The United States of America*, at 10 (2003), https://www.wipo.int/edocs/mdocs/copyright/en/avp_im_03/avp_im_03_3a.pdf.

⁸ *Id.* at 26.

standing in a street scene.⁹ Such a person would be lucky to get a contract, forget secondary use remuneration.

The focus of this article is not on extras, but rather on the classes of performers who seem to be excluded by the drafting of the Proviso. Had this provision referred to extras, it would make sense because the contributions of the extra cannot be considered sufficiently creative to constitute originality and therefore be considered protected under the Act. Instead, the Proviso refers to an industry perception of a casual performer. While extras can be said to come wholly within the domain of labour law, artistes like stuntmen and dubbing artistes who also work on wages but contribute significant creative expressions can be said to fall within both labour law as well as intellectual property law. Stunt artistes under the Movie Stunt Artists Association, for instance, are paid 8,320 Rupees for a shift of work apart from other small allowances.¹⁰ Dubbing artistes were paid anything between 500 to 30,000 Rupees depending on the type of dubbing a decade back.¹¹ As per an agent's website, this range has increased from a few thousand to 1.5 lakh Rupees;¹² but commercial revenue for films has increased manifolds in the same time.

Lack of recognition is another major issue which has been voiced by many who are part of/familiar with the industry practices. Bollywood action stars like Akshay Kumar¹³ and Tiger Shroff¹⁴ have spoken out openly in support of recognition for stuntmen. Similarly, with respect to dubbing, actress Raveena Ravi¹⁵ and actor Sharad Kelkar¹⁶ have recently expressed their

⁹*Bollywood's "Extras": Story of Dreams Unfulfilled*, NEWS18 (June 13, 2011), <https://www.news18.com/news/india/bollywoods-extras-story-of-dreams-unfulfilled-375406.html>.

¹⁰ English Wages, <http://www.movies stuntartistsassociation.com/English-Wages.html> (last visited Nov 8, 2020).

¹¹ Kaveri Nandan, *If It Sounds Good, Lend Your Voice*, OUTLOOK INDIA (November 19, 2008), <https://www.outlookindia.com/outlookmoney/archive/if-it-sounds-good-lend-your-voice-91196> (last visited Nov 8, 2020).

¹² How Much Voice Over Artist Earns In India, , [WWW.VOICEOVERMEHAK.COM](http://www.voiceovermehak.com) (2020), <https://www.voiceovermehak.com/VoiceOverTalks/2020/05/28/how-much-voice-over-artist-earns-in-india/> (last visited Nov 8, 2020).

¹³ Medha Shri Dahiya, *Akshay Kumar Pens Open Letter To Stuntmen: I'm Alive Thanks To You*, HINDUSTAN TIMES (March 2, 2016), <https://www.hindustantimes.com/bollywood/akshay-kumar-pens-open-letter-to-stuntmen-i-m-alive-thanks-to-you/story-x6qgBRcWcwhUH6AWTHPgOL.html> (last visited Nov 8, 2020).

¹⁴ Tiger Shroff Wants Stuntmen To Get Due Recognition, MID-DAY (March 25, 2018), <https://www.mid-day.com/articles/tiger-shroff-wants-stuntmen-to-get-due-recognition/19237192> (last visited Nov 8, 2020).

¹⁵ Ashameera Aiyappan, *Dubbing As A Craft Deserves More Recognition: Raveena Ravi*, NEW INDIAN EXPRESS (May 6, 2020), <https://www.newindianexpress.com/entertainment/tamil/2020/may/06/dubbing-as-a-craft-deserves-more-recognition-raveena-ravi-2139633.html> (last visited Nov 8, 2020).

¹⁶ Yashika Mathur, *Sharad Kelkar: Dubbing Artists Are Not Promoted Enough In Bollywood*, HINDUSTAN TIMES (May 8, 2017), <https://www.hindustantimes.com/bollywood/sharad-kelkar-dubbing-artists-are-not-promoted-enough-in-bollywood/story-40INJ4aPflFpAerVlrtjLP.html> (last visited Nov 8, 2020).

anguish. These artistes perform in the ‘background’ in the literal sense of the word, as stuntmen perform stunts and dubbing artistes provide dubbing for other performers who stand in the foreground with respect to the audience. This article highlights the argument that being in the background is not the same as being a casual performer like an extra. The interpretation of the Proviso can lead to exclusion of background performers as per industry practice, posing a big problem considering that the Amendment intended to promote their interests as performers. This article first seeks to find the origin of this provision, then analyses its effects on Indian performers and provide possible solutions.

II. SCOPE OF THE TERM ‘PERFORMER’

A. The Rome Convention & WPPT

The International Convention for the Protection of Performers, 1961 [“**Rome Convention**”] brought performers into the domain of intellectual property protection and gave them rights over their performances. The phonogram industry benefitted much from the advancement in broadcasting technologies to disseminate recordings to various parts of the world and thereby increase revenue. It was considered essential that the contribution of the performer was rewarded, and that was precisely what the Convention tried to provide – which is also referred to as the classic justification.¹⁷

The Rome Convention is also a testament to a historical shift in the evolution of Performers’ Rights. Prior to this instrument, performers were considered merely as industrial workers. Their performances were seen as work tendered for the employer’s purposes and labour organisations bargained for their remuneration and recognition. Thus, the stature of classes of performers as significant contributors to the industry developed and they could now put forth their demands better. Therein grew the industrial practice of recognition and remuneration.

The performer’s inclusion in the fold of intellectual property considers rewarding the distinctive intellectual creative expressions of the performer. Every performer leaves an indelible mark on his performance. This mark is of his personality, clearly identifiable to him.

The Rome Convention defined a performer under Article 3(a) as:

¹⁷ *Standing Committee on Copyright and Related Rights: Summary of the Outcome of the National and Regional Seminars on the Protection of Audio-visual Performances and Stocktaking of Positions*, at 14(2008), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_17/sccr_17_3.pdf.

“Performers means actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works;”

This definition does not place any restriction on the inclusion of performers performing literary or artistic works. The World Intellectual Property Organisation’s [“WIPO”] guide to the Rome Convention gives us an understanding that there is a category of performers called ‘extras’, who may be people in a scene with an army or with a crowd.¹⁸ These are people with limited contributions and who cannot be said to act or play.¹⁹ It adds that unless interpreted very extensively, this definition does not cover these contributions.²⁰

An earlier guide to the Rome Convention also published by WIPO states that if the Convention includes in a single group, a wide category of persons who communicate works to the public, this does not mean that in practice their situations are identical.²¹ Some artists mark their personality within their performance of their work: the conductor of an orchestra completes the score by his personal annotations; the soloist plays his instrument in an individual way; the actor gives his own interpretation to a part.²² They are in a sense creators who are tied, in their performances, to the work itself but who, in practice are with difficulty distinguished since one cannot determine with precision who, by virtue of his inventiveness, must be judged artist.²³

But it is clear that he must “perform” and the words used in French in the Convention might tend to exclude more extras of theatre or cinema and those who assume a merely mechanical role (stagehands for example) since their part in the show bears no personal stamp and is marginal or secondary.²⁴ The French text uses, for the single word “performer,” “*artiste interprete ou executant*”.²⁵ The words “*artiste interprete*” are usually used for soloists and actors, whereas members of an orchestra, including the conductor, are usually “*artistes executants*.”²⁶ In order that there should be no doubt that conductors of instrumental and vocal groups were protected, both were

¹⁸ Dr. Mihaly Ficsor, *Guide to the Copyright and Related Rights Treaties Administered by WIPO And Glossary of Copyright and Related Rights Terms*, 140 (2003), https://www.wipo.int/edocs/pubdocs/en/copyright/891/wipo_pub_891.pdf.

¹⁹ *Id.* at 140.

²⁰ *Supra* note 19

²¹ Claude Masouye, *Guide to the Rome Convention and the Phonograms Convention*, 21 (1981), https://www.wipo.int/edocs/pubdocs/en/copyright/617/wipo_pub_617.pdf.

²² Masouye, *supra* note 21 at 22.

²³ Masouye, *supra* note 21 at 22.

²⁴ Masouye, *supra* note 21 at 22.

²⁵ Masouye, *supra* note 21 at 22.

²⁶ Masouye, *supra* note 21 at 21.

considered included in the expression “*artiste interprete ou executant*.”²⁷ It is a matter for the courts to interpret these terms.²⁸ The words, “*act, sing, deliver, declaim, play in or otherwise perform*” give them wide latitude.²⁹

The confinement of performers towards performing literary or artistic works rendered them as related to copyright. But in the same instrument under Article 9, Contracting States were allowed extending protection to variety performances not based on a literary or artistic work.

India signed this instrument but has not ratified it. The imposition of performers’ rights through The Agreement of Trade-Related Aspects of Intellectual Property Rights 1995 (“TRIPS”) has rendered this otiose. In the wake of international and national debates surrounding performers and their inclusion within the fold of intellectual property, India inserted the term ‘performers’ within the Act in 1994. The Indian interpretation of a performer did not tie him to the performance of a piece of work. For instance, what work would a snake charmer perform? The original Section 2(qq) has stood the test of time. It did not provide for any particular exclusion of a performer. If a performer could satisfy the criteria under Section 2(q) of the Act, he would be a performer:

“Section 2(q): Performance in relation to performer’s right, means any visual or acoustic presentation made live by one or more performers;”

While the TRIPS came into effect, WIPO provided a parallel forum for effective protection of performances in the digital era. The WIPO Performances and Phonograms Treaty, 1996 [“WPPT”] restricted its application to phonograms even though many parties such as the European Community [“EC”] wanted it to encompass both sound and audio-visual fixations.³⁰ This void was sought to be filled with a protocol within the WPPT which would cover audio-visual fixations. According to the EC, its principal objective would be to update and improve the protection of audio-visual performers and not audio-visual producers.³¹ But in India, it was

²⁷ Masouye, *supra* note 21 at 21.

²⁸ Masouye, *supra* note 21 at 22.

²⁹ Masouye, *supra* note 21 at 22.

³⁰ *Submission on Behalf of the European Community and Its Member States on the Protection of Performers’ Rights in their Audio-visual Performances to the WIPO Standing Committee on Copyright and Related Rights*, (2000), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_4/sccr_4_2.doc.

³¹ *Id.*

viewed that an independent treaty was required as the issues of the film industry were quite different from the phonographic industry.³²

The WPPT has the following definition for a performer in Article 2(a):

“Performer are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret, or otherwise perform literary or artistic works or expressions of folklore;”

Like the Rome Convention, there is no mechanism to exclude a class of performers in WPPT.

B. Discussions leading up to the Beijing Treaty

The WIPO discussions on the protection of audio-visual performers took place on two platforms – A Committee of Experts on A Protocol Concerning Audio-visual Performances [“**APCE**”] and the subsequent Standing Committee on Copyright and Related Rights [“**SCCR**”]. The WIPO Diplomatic Conference on Certain Copyright and Neighbouring Rights in December 1996 and the WPPT laid the foundations of the APCE,³³ which drew its conclusion in June 1998 handing the mantle to SCCR.³⁴

These discussions and deliberations are an eye-opener on how extras are perceived by the Member States in the context of audio-visual performances. To the APCE, Mexico provided that as per their law, the term performer would exclude ‘extras and understudies’.³⁵ However, the Mexican Federal Law on Copyright, 1997 does not explain who an extra or an understudy is. The Chinese referred to their definition in the Implementation Regulations of the Copyright Law of the People’s Republic of China, 1991 which did not specially exclude any class of performer:³⁶

“Performer refers to any actor or any other person who performs literary and artistic works;”

In the second session of the APCE, the delegation from USA initially submitted a proposal for a treaty to protect audio-visual performances, where it defined a performer in Article 2(a) as:

³²WIPO *Standing Committee on Copyright and Related Rights’ Report of Second Session*, at 6 (1999), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_2/sccr_2_11.pdf.

³³*Information Received From Members by The WIPO Committee of Experts on a Protocol Concerning Audio-visual Performances*, (1997), https://www.wipo.int/edocs/mdocs/copyright/en/ap_ce_i/ap_ce_i_3.pdf.

³⁴*Organizational and Procedural Matters and Overview of Substantive Issues of the WIPO Standing Committee on Copyright and Related Rights*, (1998), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_1/sccr_1_2.html.

³⁵*Supra* note 33 at 13.

³⁶*Supra* note 33 at 5.

*“Performers are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret, or otherwise perform literary or artistic works or expressions of folklore, but not including extra performers or background performers;”*³⁷

No interpretation of the meaning of these definitions was provided by the proposal. In the June session, it was explained that the exclusion of “extra performers” and “background performers” was an important addition in order not to upset industry practice.³⁸ Such performers had no speaking roles, but, for example, filled out crowds, were sitting at tables in restaurants as mere background to the acting, were marching soldiers and in other ways participated in filling out the picture without being listed in the credits normally given by the end of the film.³⁹ Having said that, the USA in their revised proposal at the first session of the SCCR in 1998 changed the definition of performer:

*“Performers are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret, or otherwise perform literary or artistic works or expressions of folklore, but not including ancillary performers considered such by professional practice;”*⁴⁰

The Delegation from the USA also commented that the earlier proposal was changed as a response to the concerns raised at the APCE about the scope of “extra performers” and “background performers”.⁴¹ The revised language, according to the delegation, comes directly from the WIPO’s English translation of the French copyright statute and it seeks to provide greater clarity.⁴² According to them, it is sufficient to cover the basic concept while providing flexibility for national interpretation.⁴³

The French Intellectual Property Code by Article L212-1 excludes ‘Ancillary Performers’ by stating:

³⁷*Proposal from the United States of America to The WIPO Committee of Experts on a Protocol Concerning Audio-visual Performances*, (1998), https://www.wipo.int/edocs/mdocs/copyright/en/ap_ce_2/ap_ce_2_4.pdf.

³⁸*Report of the Second Session of The Committee of Experts on a Protocol Concerning Audio-visual Performances*, at 11 (1998), https://www.wipo.int/edocs/mdocs/copyright/en/ap_ce_2/ap_ce_2_9.pdf.

³⁹*Id.* at 11.

⁴⁰*Submissions Received by The WIPO Standing Committee on Copyright and Related Rights*, at 4 (1998), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_1/sccr_1_4.html.

⁴¹*Id.*

⁴²*Supra* note 40.

⁴³*Supra* note 40.

“Save for ancillary performers, considered such by professional practice, performers shall be those persons who act, sing, deliver, declaim, play in or otherwise perform literary or artistic works, variety, circus or puppet acts.”

According to Dr. Lewinski, in France, extra performers can be excluded from protection (depending on the importance of the performance).⁴⁴

USA again revised the definition of a performer in their proposal submitted to the SCCR in their third session in 1999.⁴⁵ This definition in Article 2(a) read as:

“Performers are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret, or otherwise perform literary or artistic works or expressions of folklore with the exception of extras, the definition of the latter term being left to the legislation of each Contracting Party;”

USA, in this document, explained that it had made revisions based on the deliberations placed by other countries before the SCCR.⁴⁶

A Regional Consultation Meeting was held at New Delhi in May, 1998 for countries of the Asia and the Pacific concerning the protocol for audio-visual performances.⁴⁷ Apart from India, Bangladesh, Brunei Darussalam, Indonesia, Malaysia, Mongolia, Pakistan, Philippines, Qatar, Republic of Korea, Singapore, Thailand and the United Arab Emirates participated. Their report was submitted to the APEC. Two important points raised in this consultation were:

The context of extending performers' rights to audio-visual performances is not uniform. For example, it may differ in developing countries in view of the special industrial practices existing in the film industry. Administration of copyright and related rights needs to be developed much in these countries. In the absence of a well-developed collective administrative system, the provision of new rights to performers in their audio-visual performances may not help the performers. It is also necessary to wait for the results of the rights given to performers in their

⁴⁴Dr. Silke Von Lewinski, *Comparative Analysis of National Solutions in Protecting Audio-visual Performers' Rights – Germany and France*, at 7, https://www.wipo.int/edocs/mdocs/copyright/en/wipo_cr_tia_18/wipo_cr_tia_18_4.pdf.

⁴⁵*Submission of USA on a Treaty for Audio-visual Performances Submitted to The WIPO Standing Committee on Copyright and Related Rights*, (1999), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_3/sccr_3_7.html.

⁴⁶*Id.*

⁴⁷*Report of the Regional Consultation Meeting For Countries of the Asia and the Pacific on a Protocol Concerning Audio-visual Performances Submitted to The Committee of Experts on a Protocol Concerning Audio-visual Performances*, https://www.wipo.int/edocs/mdocs/copyright/en/ap_ce_2/ap_ce_2_8.html.

audio performances. In this scenario, several participants felt that it was necessary not to hasten with a new Protocol.⁴⁸

Considering the special nature of the audio-visual industry, the group expressed the need to consider exclusion of certain categories of performers, whose performances are casual or incidental, from the definition of performers, but felt it necessary to discuss the issue further.⁴⁹

This meeting marked the birth of the proviso to Section 2(qq). Interestingly, while India adopted this proviso raised in this consultation meeting with 9 other countries, none of the others did. In fact, the departure of most of these other countries can be seen from the regional consultation held in Shanghai in October 1998 for countries of Asia and the Pacific concerning the protocol for audio-visual performances. The participating nations included China, Bangladesh, Brunei Darussalam, Fiji, Indonesia, Malaysia, Mongolia, Nepal, Pakistan, Philippines, Republic of Korea, Singapore, Sri Lanka and Thailand. Their report was submitted to the SCCR. It did not contain any reference to an exclusion of casual or incidental performers.⁵⁰

At the second session of the APCE, the Delegations of South Africa (on behalf of the African Group), Singapore, Philippines, Senegal, Nigeria, Kenya, Morocco and India, along with the National Association of Broadcasters' ["**NAB**"] observer, supported the view that "extra performers" and "background performers" participating in audio-visual fixations should be excluded from the definition of the term "performer."⁵¹ The delegation of India also mentioned that dubbers, dummies and stunts should be excluded.⁵² The delegation of South Africa, speaking on behalf of the African Group, supported by the delegations of Kenya, Nigeria and Senegal, pointed out that the question of how possible exclusions should be done should be left to national legislation, and the delegation of Nigeria added that the remuneration of these participants should be dealt with in contracts.⁵³

⁴⁸ *Id.*

⁴⁹ *Supra* note 47.

⁵⁰ *Report of the Regional Consultation Meeting for Asia and the Pacific Concerning a Protocol on Audio-visual Performances Submitted to the WIPO Standing Committee on Copyright and Related Rights*, at 5 (1998), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_1/sccr_1_5.html.

⁵¹ *Supra* note 39 at 11.

⁵² *Supra* note 39 at 11.

⁵³ *Supra* note 39 at 11.

An observer from the International Federation of Actors [“**FIA**”] said that she supported the exclusion of extras, but not of background performers.⁵⁴ She further favoured the extension of the definition to circus and variety of artists.⁵⁵ The observer from the International Federation of Film Producers’ Associations [“**FIAPF**”] said that, whatever the wording of the exception for extras, background performers, dummies and the like, which were concepts determined by professional practice, the terms did not require a detailed definition in the Treaty; it added however that a certain minimum was necessary to qualify for the status of a performer.⁵⁶

At the second session of the SCCR, India submitted a proposal for a treaty to cover audio-visual performances. The definition India gave to performers under Article 2(a) was:

‘Performers are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret or otherwise perform literary or artistic works or expressions of folklore but does not include performers whose performances are casual or incidental in nature such as extras.’

This was in tune with the regional consultation held in New Delhi in 1998. The Indian delegation went on to explain to the SCCR in its second session in May 1998 that this proposal was in fact the result of a long consultation process and reflected concerns of the film industry, the performers and the Government.⁵⁷ The delegation went on to say that the primary aim of protecting the rights of performers better could not be pursued in a vacuum.⁵⁸ In line with this, India said that it had a strong interest in its important film industry, as well as the practices of relationships between performers and producers, had to be considered; these relations were based on mutual trust and not on written documents.⁵⁹ Therefore, according to the delegation, it was necessary to maintain the existing balance when granting new rights which should be meaningful.⁶⁰

In the same session, India also explained that it did not have a practice of remuneration rights as provided for in Article 15 of the WPPT.⁶¹ Again, India clarified to the SCCR in its third session in

⁵⁴ *Supra* note 39 at 11.

⁵⁵ *Supra* note 39 at 11.

⁵⁶ *Supra* note 39 at 12.

⁵⁷ *Supra* note 33 at 4.

⁵⁸ *Supra* note 33 at 4.

⁵⁹ *Supra* note 33 at 4.

⁶⁰ *Supra* note 33 at 4.

⁶¹ *Supra* note 33 at 10.

December 1999 where it referred to its proposal for a Treaty and said that the proposal has been discussed with many different government departments, private sector groups involved in the area, including the Film Federation of India.⁶²

In 2008, the SCCR released a document summarising the outcomes of the national and regional seminars on the protection of audio-visual performances.⁶³The following important points were noted by the SCCR:

Some national legislations contain provisions excluding ‘extras’ from the definition of performer on the basis that their contribution is casual or incidental in nature; and some States argue that ‘extras’ or ‘ancillary performers’ do not qualify as performers as they do not in the proper sense, perform literary or artistic or expressions of folklore. In consequence, the SCCR notes, national legislation often does not deem it necessary to incorporate an explicit provision excluding extras; each jurisdiction determines the threshold at which a person is entitled to protection. In doing so, it interprets national legislation in the light of the established industry practice and criteria such as whether a person has a speaking role or is rather in the background with regard to acting.

In the end, The Beijing Treaty on Audio-visual Performances, 2012 incorporated a definition that did not create any exclusion. Under Article 2(a), the Treaty states:

“Performers are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret, or otherwise perform literary or artistic works or expressions of folklore;”

At the WIPO Regional Workshop on Beijing and Marrakesh Treaties held in Georgia in 2015, Jean-Vincent explained that in the Beijing Treaty definition, extras, walk-on actors or figurants do not own performers’ rights.⁶⁴

III. PARLIAMENTARY DISCUSSIONS ON THE INCLUSION OF PROVISIO IN SECTION 2(qq)

As can be seen from the earlier section, although India has only recently acceded to the WPPT and has not signed The Beijing Treaty, it did play a big part in the discussion at the APCE and SCCR on the topic concerning inclusion or exclusion of extras from the definition of

⁶²The WIPO Standing Committee on Copyright and Related Rights’ Report of the Third Session, at 11 (1999), https://www.wipo.int/edocs/mdocs/copyright/en/sccr_3/sccr_3_11.html

⁶³Summary of the Outcome of National and Regional Seminars on Protection of Audio-visual Performances by The WIPO Standing Committee on Copyright and Related Rights, (2008), https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=142872.

⁶⁴Jean Vincent, *The Beijing Treaty: Performers’ Perspective Transfer of Rights and Remuneration Schemes*, 3 (2015), https://www.wipo.int/edocs/mdocs/copyright/en/wipo_cr_tbs_15/wipo_cr_tbs_15_t6a.pdf.

performers. The Indian proposal submitted to the SCCR included a definition of performer which would exclude casual or incidental performances such as those of extras from the scope of 'performer'. The implication of such exclusion is married to the industrial system, wherein such performers are not considered creative contributions.

But the provision proposed by India at WIPO is not the provision inserted by the Amendment. It removes a possible explanation into the construction of a threshold for the exclusion of a casual or incidental performance from the purview of cinematograph films. Having said that, the removal of a performance's dependency on works and the decision to keep the original provision intact is a welcome development. This is because the work of performers need not be based on works, as noted correctly by the Australian Copyright Law Review Committee.⁶⁵

Since the provision is now devoid of an accompanying explanation in the form of an example, it becomes fertile ground for misinterpretation. The industrial practice for instance is to hire dubbing artistes, voiceover artistes and stuntmen for a few days of work and pay them for the same. The industry also does not credit them for their performances. Therefore, all three categories would stand excluded from the purview of performers' rights in India.

Considering that this is not a small effect, one wonders why this example was dropped. The 227th Parliamentary Standing Committee on Human Resource Development Report on the Copyright (Amendment) Bill, 2010 submitted to the Rajya Sabha, suggested the insertion of this proviso. But curiously, no debate or discussion was done over this inclusion either in the Rajya Sabha or the Lok Sabha. The conclusion was that this proviso sailed into the Act in 2012 without any deliberation about the consequences it would have on scores of performers in India.

Let's look at the consequences. With the inclusion of a 'Right to Receive Royalties' provision in The Act through the 2012 Amendment, producers of cinematograph films are now bound to share their revenue with performers. It is perhaps keeping this in mind that some sense of clarity was sought to be made in the interpretation of a performer. This objective in itself would be admirable since the producer has to be able to classify people working in his film as performers and thus, it works in the best interests of both. If this was the objective, the Proviso has failed since it leaves the interpretation wide open for limiting performers.

⁶⁵*Report on Performer's Protection*, (1987), <http://www.austlii.edu.au/au/other/clrc/10/>.

This wide interpretation could well be the reason that performers are still being protected by their labour organisations. Some of these associations like the Association of Voice Artists (AVA) do not even have minimum pay, let alone a uniform rate card for its members. As noted by the WIPO, these labour associations can work along with collective management organisations to implement the collection of remuneration and distribution to its members.⁶⁶ In the absence of Performers' Societies, labour associations are burdened. The task of a performers' society is a complex one that cannot be taken up by disparate associations working in different regions and catering to different performers. The knowledge concerning rights provided by the Amendment continues to be shallow and is perhaps the reason why no active movement has been initiated to collect royalties except by singers.

IV. POSSIBLE SOLUTIONS

From the above discussion, it becomes clear that the proviso to Section 2(qq) does more harm than good. There are 3 ways that I propose this issue can be resolved:

- Remove the proviso completely; or
- Include the phrase 'such as extras'; or
- The Copyright Office can list out casual performers.

A. Removing the Proviso

This is the easiest of the 3 solutions and will prove to be thoroughly effective. This is so since performances like works are based on the concept of originality. If a person fulfils the criteria of having delivered a performance under the Act, it means his performance is sufficiently creative and is thus worthy of protection. Extras, who provide no distinctive contribution such as people in a crowd are easily excluded from the scope of 'performer'. This solution is more appropriate of the three as it is grounded in intellectual property and its justifications.

B. Include the Phrase 'Such as Extras'

This solution is more grounded in the industry and has little to do with intellectual property justifications. Leaning on the industry for interpretation can majorly backfire considering how the film industry in India operates. It heavily favours producers. The Indian delegation pointed to the SCCR that relations in the Indian film industry are based on mutual trust and not written agreements.⁶⁷ It is the author's view that this trust is forced and not based on any real choice.

⁶⁶*Supra* note 64 at 3.

⁶⁷*Supra* note 33.

C. Listing

This is at best a temporary solution but can prove very helpful. There is no study in India at the moment which attempts to segregate performers on the basis of contributions to cinematograph films. To simply say that a performance will be casual if in the normal course of the practice of the industry it is considered so, is to leave the issue wide open. Instead, the Copyright Office can initiate an in-depth study into the classes of performers engaged in cinematograph films. It can then proceed to make a list of such performers. This list can help performers and producers alike, in understanding the scope of the provision.

V. CONCLUSION

Extending the 'Right to Receive Royalties' to the Indian performer shows that the motivation of the legislators was to bring parity to the conditions of the Indian performer. Unfair remunerations for contributions rendered, dominate the Indian film landscape. A film earns crores in revenue, but the Indian performer sees only a small percentage of the same. The conditions of well-known artistes have no comparison to the majority of performers in India and it is this precise reason why the proviso to Section 2(qq) cannot afford to be so wide.

The audio-visual performers in India need to know that The Act covers them within its fold. Singers know all too well that they are performers and that is the reason why theirs is the only class of performer having a performers' society in the shape of the Indian Singers' Rights Association. Voice-over artistes, dubbing artistes and stuntmen to name a few have to depend on an interpretation of the proviso to Section 2(qq).

This lack of clarity goes against the purpose behind which the discussions on extending rights to audio-visual performances took place under WIPO. The Indian position was also correctly aligned to exclude only extras. But, when the proviso was finally introduced in the Act, it moved away from this understanding.

Performers form the struggling community in the Indian film industry. They are side-lined as they are made to feel that they are replaceable. It is time that the Indian performer realised the worth of his contribution and the State provided him with every support to attain his reward.

**IN THE BLINK OF AN EYE: NAVIGATING THE MURKY WATERS OF ORIGINALITY AND FIXATION OF
‘EPHEMERAL WORKS’**

BIPASHA SAIKIA*

ABSTRACT

In contemporary times, the term ‘work’ in the context of copyright has undergone tremendous evolution to make space for all kinds of work, irrespective of the medium used. Under the broader dimensions of literary, artistic, musical and dramatic works along with choreography and sound recording; works hitherto unheard of are seeking protection under copyright laws across jurisdictions. Even the Berne Convention, 1886 allows for a wide interpretation of what constitutes copyrightable material. The copyright lies in work only if it is “original” and fulfills the criteria of “fixation” as are statutorily mandated in multiple countries. Ephemeral Works like living art, food plating, landscape art, choreography etc. are works of a transitory nature. They are fleeting and may ultimately decay or perish. Even though these works qualify the subjective test of ‘originality’, such works come into collision with the requirement of “fixation” as a condition for copyright protection. Common law jurisdictions require works to be “fixed in a tangible medium/embodied in a form that can be perceived as a condition for copyright protection” which comes into conflict with the transitory nature of these works. But civil law countries like France, Germany and the Netherlands have a lower threshold for fixation and construe the term liberally to mean that “mere human perception” is enough. In such countries, fixation has an evidentiary purpose. The very relationship between originality and fixation is at odds, not only in the context of ephemeral works but even in general. The idea is to reconcile this conflict as both originality and fixation are important considerations for the copyright to subsist and have their own specific purposes in line with the ultimate aim of copyright protection, and the emergence of newer forms of art are only adding to the confusion.

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I. INTRODUCTION

Article 2(1) of the Berne Convention for The Protection of Literary and Artistic Works, 1886 (“Berne Convention”) enumerates the subject-matter of ‘Protected Works’, the scope of which is limited to *literary* and *artistic* works only. However, Section 2(y) of the *Copyright Act, 1957* (“1957 Act”) defines ‘work’ as follows:

“*Work*” means any of the following works, namely: —

- (i) a literary, dramatic, musical or artistic work;
- (ii) a cinematograph film;
- (iii) a sound recording.

The Berne Convention mandates minimum standards of protection for literary and artistic works which shall include “every production in the literary, scientific, and artistic domain, whatever may be the mode of its expression.” The term ‘every production’ would certainly include ephemeral works, the subject-matter of this paper. The phrase “whatever may be the mode of its expression” strengthens this interpretation. Thus, the Convention allows the broadest coverage known to artists, irrespective of the media used.¹

In contemporary times, the term ‘work’ has undergone tremendous evolution to make space for all kinds of work, irrespective of the medium used. Under the broader dimensions of literary, artistic, musical and dramatic works along with choreography and sound recording, works hitherto unheard of, are seeking protection under copyright laws. The copyright lies in work only if it is *original* and fulfils the criteria of *fixation*, as is statutorily mandated by many common law countries, including India, which make a specific mention of fixation for ‘dramatic works’² and of other works, through case law jurisprudence. However, this requirement of *fixation* is liberally construed in civil law countries.³ Especially in the domain of artistic works, the diversity as to

¹ Caroline M. Reeb, *Sweet or Sour: Extending Copyright Protection to Food Art*, 22 DEPAUL J. ART TECH. & INTELL. PROP. L. 41, 59 (2011)

² The Copyright Act, 1957, § 2(h), No. 27, Acts of Parliament, 1957 (India). [“Dramatic work” includes any piece for recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting, form of which is fixed in writing or otherwise but does not include a cinematograph film.]

³ Directive 2001/29/EC, of the European Parliament and the Council on the Harmonization of Certain Aspects of Copyright and Related Rights in the Information of Society, 2001 O.J. (L 167/10). [The Copyright Directive states that to be eligible for copyright protection, the creation in question must be able to be classified as a work. For it to be classified as a work there are two requirements: it must be an original intellectual creation, and there must be an expression of that creation.]

what constitutes the subject matter of copyright is expanding, with the emergence of newer art forms like conceptual arts; of which ephemeral works is a subset.

Ephemeral Works are works of a transitory nature, which are *fleeting*, that appear as installations and may ultimately, decay or perish. By and large, they fall under the domain of ‘artistic works’ and more specifically, the category of ‘any other work of artistic craftsmanship’ found under both the Indian and the UK law and interpreted by varied jurisdictions.⁴ Ephemeral works of art, like *living art*, use natural materials as their medium, such as flowers, leaves, ice, pine cones, twigs, rocks and stones, among other natural objects. Andy Goldsworthy, a world-famous British sculptor and photographer, explaining his living artwork, states, “I can’t edit the materials I work with. My remit is to work with nature as a whole,” and understands that his work shall eventually disappear. Ephemeral works have heralded a marked shift from traditional works of art that are permanently fixed, like works of art seen in museums. Even choreography or any live performance for that matter, by its very nature, is ephemeral and in reality, it doesn’t last longer than the duration for which the dancer/performer gives it life.⁵

Even though these works qualify for “originality”, as shall be discussed, they come into collision with the requirement of “fixation” as a condition for copyright protection in common law countries. The Berne Convention gives flexibility to the contracting states to determine the limits of fixation as a condition for copyright protection.⁶ Most jurisdictions (excluding mainly civil law countries) are focused on the necessity of the work being *fixed* in a tangible medium or embodied in a form that can be perceived. The transitory nature of many works has raised substantial questions over the grant of copyright protection to such works. They *inter alia* include, if at all copyright can subsist in such works? Or what recourse to remedy, if any, the creators have, should there be any infringement? Unlike the United States, which explicitly mandates fixation in any tangible medium of expression,⁷ the 1957 Act is relatively silent on this except in case of

⁴ The Copyright Act, 1957, § 2(c), No. 27, Acts of Parliament, 1957 (India). [Artistic work means, — a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality; a [work of architecture; and any other work of artistic craftsmanship; as provided under § 2(c) of the Copyright Act.]; See *George Hensher Ltd. v. Restawhile Upholstery (Lanes) Ltd* [1976] A.C. 64.

⁵ Pujita Krishna, *Can dance be protected from plagiarism?*, THE HINDU Feb. 11, 2018 <https://www.thehindu.com/entertainment/dance/can-dance-be-protected-from-plagiarism/article22825491.ece>.

⁶ Berne Convention For The Protection Of Literary And Artistic Works art. 2 (2), Sept. 9. 1886, 1161 U.N.T.S. 3.

⁷ 17 U.S.C. § 102 (2006)(U.S.). (Subject matter of copyright: In general- Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later

dramatic works (piece for recitation, choreographic work or entertainment in the dumb show) that necessitate the form of the work to be *fixed in writing or otherwise*. Much of the jurisprudence surrounding the element of fixation can be understood from the interpretation of the courts. Ephemeral art forms like food plating (the presentation and arrangement of food), sand art, living art, sonic arts (making visual art with sound waves and vibrations), choreography and even hairstyles and makeup etc. raise significant questions about fixation. The law surrounding the subsistence of copyright in works of choreography (under dramatic works) becomes ambiguous if the choreography is not reduced to fixation, except in the written format “or otherwise”. The format of fixation for different kinds of work is unclear. What do the words “or otherwise” mean in Section 2(h) of the 1957 Act?

In the case of food plating or other forms of ephemeral art for that matter, can it be said that taking a picture of the dish/the art concerned would fulfil the criteria of fixation since it amounts to reduction to a form that is tangible? Also, is fixation a precondition for copyright protection or proof of the same? The stand is different in civil and common law countries. Common law countries like the UK and New Zealand make a clear separation between the act of creation, known as authorship (discussed below) and the making/recording of the work. A work goes through two stages before it is complete- first, it exists in the mind of the author and then in a material form where it is considered complete and eligible for copyright protection.⁸ Thus existence happens before fixation, although not in the real sense. Both these stages must be completed for the copyright to subsist in the work. In common law countries like India, for instance, as shall be discussed subsequently, fixation in writing or by the notation system is mandatory for dramatic works like choreography⁹ but the law regarding other forms of ephemeral art is lacking in jurisprudence at present.

In civil law countries, fixation is not a precondition for copyright protection. The existence of the work, in such countries, is understood differently. The work is said to come into existence the moment it can be perceived. In two recent cases,¹⁰ a Dutch and a French court ruled that

developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.).

⁸ Elizabeth Adeney, *Authorship and Fixation in Copyright Law: A Comparative Comment*, 35 MELB. U. L. REV. 677, 681 (2011).

⁹ Krishna, *Supra* note 5.

¹⁰ *Kecofa v. Lancôme*, ECDR (26) 363 (2006) (Dutch); *Roberts A. D. et al. v. Chanel et al.*, French Court of Cassation, (2008).

copyright subsists in ‘scents’ on the ground that the work is “available for human perception” and “bears the signature of the maker” and is perceptually available. Can such a liberal approach be taken, only on the ground that the works can be *perceived* by the senses? If yes, can that logic be extended to food presentation or choreography, if the basis for protection is a mere human perception and not fixation in some tangible form?

Does such a narrow understanding of fixation pose a threat to the idea-expression dichotomy or the use of fixation for evidentiary purposes in copyright infringement matters, which are the very reasons for fixation as a ground of copyright to subsist? What would Indian Courts decide if such cases were to arise in their jurisdiction in the near future? That being said, the Indian jurisprudence in all these aspects is at a nascent stage. However, the emergence of newer forms of art is on the horizon and the ambiguity surrounding fixation in general, calls for a deeper understanding of this issue.

This article proceeds in three parts. Part I of the article makes an honest attempt to understand the first condition for the copyright to subsist in a work, namely ‘originality’ and how does one assess whether ephemeral works fulfil this criterion. Special focus would be on works that assemble unprotected elements and to understand how they meet this requirement for the expression itself to be transformed into something original. Part II deals with understanding fixation and the rationale behind its incorporation as a prerequisite for copyright protection. Part III is the epicentre of the article as it deals with understanding the problematic relationship between different kinds of ephemeral works and fixation and tries to determine if fixation functions as a stumbling block or is it useful in protecting the idea-expression dichotomy and concludes with a section that attempts to understand the jurisprudence in civil law countries that are flexible in their need for fixation. Part IV revolves around the understanding of fixation as mere perception, while Part V deals with understanding whether authorship and fixation are part of the same creative act.

II. THE ORIGINALITY DEBATE

“Originality”, a prerequisite for entrustment of copyright,¹¹ provides that copyright subsists in the “expression of an idea” and not in the idea itself. The standard of originality needed is encapsulated in two judicially-determined doctrines- the “sweat of the brow” and the “modicum

¹¹ 17 U.S.C, §102 (2006)(U.S.); Copyright, Designs and Patent Act 1988, c.48, § 1(1) (Eng.); The Copyright Act, 1957, § 13, No. 27, Acts of Parliament, 1957 (India).

of creativity” doctrines and the Indian law is positioned between the two. Originality is a *sine qua non* for copyrightability.¹² In a U.S. case,¹³ it was said that *industry* and *effort* in a work are sufficient to establish originality even when such work is devoid of imagination or judgment. The creator of the work gets copyright for the act of “due diligence” on his part. The focus lies on his “skill and labour” without caring much about the creative aspects of the work. It was further opined that “it is immaterial whether work is wise or foolish, accurate or inaccurate or whether it has or does not have any literary merit.”¹⁴ The law seeks originality in expression and demands that the work must not be copied from another work. The point of origin of the work must be from the author,¹⁵ and the work should be his own intellectual creation.¹⁶ This, in essence, is the “sweat of the brow” doctrine, not requiring anything beyond hard labour on the part of the creator of the work.

This understanding was adopted by the Supreme Court of India for a considerably long time when it provided that copyright law places no bar on an individual from taking what is useful from an original work with “additions and improvements”.¹⁷ The court made it clear that original thought and original research were not needed and even mundane compilations like dictionaries, gazettes, maps, encyclopaedias, etc. are worthy of having copyright protection.¹⁸ Aspects of “novelty” and “creativity” were discarded by the U.S. Supreme Court too in *Bleistein v. Donaldson Lithographing Co*¹⁹ where the Court ruled that a “distinguishable variation” from another work is the right yardstick to decide on originality. The quality is not of much concern since it is highly subjective. Here, Justice Holmes stated, “it would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits,”²⁰ thereby refusing to rule on artistic quality.

¹² Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 345 (1991).

¹³ Jeweler's Circular Publishing Co. v. Keystone Publishing Co, 281 F 83, 88 2d Cir (1922) (U.S.).

¹⁴ Walter v. Lane, [1900] AC 539 (1900); *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.*, 1 WLR 273 (1964) (U.K.).

¹⁵ University of London Press v. University Tutorial Press, 2 Ch. 601 (1916) (U.K.).

¹⁶ Infopaq International A/S v. Danske Dagblades Forening FSR 20 (2010).

¹⁷ Kartar Singh Giani v. Ladha Singh, A.I.R. Lahore 777 (1934).

¹⁸ Mishra Bandhu Karyalaya v. Shivratn Lal Koshal, AIR 1970 MP 261.

¹⁹ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

²⁰ *Id.* at 251 cited in Krishna Hariani & Anurudh Hariani, *Analyzing Originality in Copyright Law: Transcending Jurisdictional Disparity*, 51 IDEA 491, 496 (2011).

Departing from the “sweat of the brow doctrine”, the court in the case of *Feist Publications*,²¹ demanded a ‘minimum amount of creativity’ as a prerequisite to ask for copyright protection and the same was adopted by the Indian Supreme Court in *Burlington Home Shopping v. Rajnish Chibber*.²² Similarly, in the landmark case of *Eastern Book Company v. D.B. Modak*,²³ it was held that to gain copyright, the threshold of creativity is not in the line of being “novel or non-obvious” like patents, but a little bit of creativity in the work is required, thus establishing the doctrine of “modicum of creativity”. To summarise, the work must originate from the author (he must have created it independently) and not a mere copy but a substantial variation of the same with a “spark of distinctiveness” to clothe it with some creativity. Herein, the *de minimis*²⁴ rule is applied. As the U.S. Supreme Court stated, “copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.”²⁵

A. THE ORIGINALITY OF EPHEMERAL WORKS

Having established the understanding as to what *originality* entails, it must be examined as to whether ephemeral works fulfil this requisite for copyright protection. It is pertinent that works of a transitory nature must be “original works of authorship too”.²⁶ In the U.S., the phrase “works of authorship” is “deliberately undefined” as the Congress intended to mould a flexible definition of the same that would “neither freeze the scope of copyrightable technology nor allow unlimited expansion into areas completely outside the present congressional intent.”²⁷ In the U.S. and India, the threshold of originality for copyright protection is low, but not negligible.²⁸ A combination of elements that are unprotected on their own would get protection based on the originality of their selection and arrangement, so as to make the resultant work an original work of authorship. These lines fit perfectly well in the case of an artistic work like food

²¹ *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

²² *Burlington Home Shopping Pvt. Ltd. v. Rajnish Chibber & Anr.*, PTC (15) 278 (1995).

²³ *Eastern Book Company v. D.B. Modak*, PTC 641 (2002).

²⁴ United States Copyright Office, *Compendium of U.S. Copyright Office Practices*, § 101 (3d ed. 2017), (The term *de minimis* comes from the legal principle “*de minimis non curat lex*,” which means “the law does not take notice of very small or trifling matters.”).

²⁵ *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

²⁶ 17 U.S.C. § 102 (2006)(U.S.).

²⁷ H.R. Rep. No. 94-1476, at 51 (1976). [The history of copyright law has been one of gradual expansion in the types of works accorded protection...Authors are continually finding new ways of expressing themselves, but it is impossible to foresee the forms that these new expressive methods will take. The bill does not intend either to freeze the scope of copyrightable technology or to allow unlimited expansion into areas ... completely outside the present congressional intent].

²⁸ *Satava v. Lowry*, 323 F.3d 805, 810 9th Cir. (2003).

plating or living art or even a work of choreography which, although made up of really simple and basic steps may be original when assessed on a whole. In the *DB Modak* case, the Court stated that “even if the work is derived from data contained in pre-existing works, then by selection, co- ordination or arrangement of such data, the new work should be somewhat different from the pre-existing ones.” The condition here is that, if the raw materials used have utilitarian purposes, or if the work has any functional characteristics, it is precluded from being recognised as a work of art.²⁹ This is logical because the copyright law protects an artist’s original, creative expression and does not extend to protect merely utilitarian things. In the case of food plating, since food is a useful article, copyright law will apply only if the food plating incorporates highly creative features (maybe physical and conceptual) that are separable from the food’s utilitarian features.³⁰ In food plating, the data is food. A food presentation comprises elaborate artistic arrangements that are both aesthetic and utilitarian (food being a subject-matter of consumption and source of energy for the body to function). However, not all aspects of food plating need to be functional. Creativity in how he makes it can also be displayed in the use of colours and the display of the food, the case in point being the ‘Herb crusted scotch eggs baby greens’.³¹

The standard to be adopted is quite similar to that adopted in the regular subject-matter of copyright. For instance, in the process of food presentation, even though it is within the law to take ideas and derive inspiration from prior works to ensure the free flow of ideas and spur innovation, the question is whether the chef has taken a lot, and without consent, created a derivative work, or whether he/she has transformed the original into something new, and that is original by itself and not a derivative otherwise owing to “substantial similarity” between the prior work and the new work. The chef could be in trouble of copyright infringement claims in the former case.

²⁹ Reebbs, *supra* note 1, at 43.

³⁰ Natasha Reed, *Eat your art out: Intellectual Property for Food*, FOLEY HOAG LLP (Aug. 24, 2020, 10:00 PM), <https://www.trademarkandcopyrightlawblog.com/2016/06/eat-your-art-out-intellectual-property-protection-for-food>.

³¹ Suman Prasad, *Haute Indian Cuisine: The growing trend of creating Instagrammable dishes*, Architectural Digest Aug. 26, 2020, <https://www.architecturaldigest.in/content/indian-chefs-increasingly-thinking-like-designers>. [Prepared by Momin Faqi, Executive Chef at Kode, it is a dish comprising scotch eggs with a thin harissa-spiced minced chicken crust with a crispy golden exterior lying in a pool of smooth, creamy and pale yellow béarnaise sauce with a few flecks of green herbs and a few drops of red chili oil].

The same logic can be extended to living art like that of Andy Goldsworthy's, who in one of his artworks bound some leaves together with the help of thorns in a long serpentine shape and extended it like a serpent down a river, where the leaves came in contact with each other, the current of the water along with the rocks above as if conversing with nature. It is not impossible to conceive that not just a modicum, but there is a greater need of originality than the necessary aspect of originality in all of his works; even though the elements used maybe unprotectable, the resultant work is not mere sweat and brow and includes a high level of creative ingenuity. However, in the case of *Kelly v. Chicago Park District*,³² a U.S. court agreed that Wildflower Works satisfied the test of originality but did not satisfy the "authorship" requirement of copyright law. It found that Wildflower Works "plainly possessed more than a little creative spark," and thus was original. Although the court determined that the work was not copied and that the author's combination of elements was original, it nevertheless ruled that Wildflower Works was devoid of authorship. In *Burrow-Giles Lithographic Co. v. Sarony*,³³ defining the term "author", the Court declared "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature" to be an author. Justice Holmes in this case equates authorship to "inherent uniqueness of human personality" and further clarifies as to an author that "as long as he does not copy from another, a creator has done enough to merit copyrightable authorship merely by placing his pen upon the paper".³⁴ Thus, in the *Kelly case*, there seems to be an apparent inconsistency in the reasoning and the ruling of the court.³⁵ According to the court, a garden cannot be 'authored'. It originates in nature and is subject to natural forces. However, the reasoning seems illogical, as with precision, gardens can be made artistic by the gardener using his creativity and ingenuity.

In works of choreography too, the element of originality is bestowed on an assessment of the overall work and copyright can lie in the simple steps because they are the raw materials or the building blocks and are under the ownership of none. Thus, they are the property of all. They are like basic tools on which the choreography is based.³⁶

³² *Kelley v. Chicago Park Dist.*, 635 F. 3d 290 7th Cir. (2011).

³³ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, (1884)(U.S.).

³⁴ *Id.*

³⁵ Megan Carpenter & Steven Hetcher, *Function over Form: Bringing the Fixation Requirement into the Modern Era*, 82 *FORDHAM L. REV.* 2221, 2242 (2014).

³⁶ Krishna, *supra* note 5.

A choreographer can take inspiration from the veterans in his field and create his own version where copyright can lie. However, the situation is different for some signature postures. These works have a higher threshold of originality that makes them eligible for copyright protection.

In the words of Lord Pearce,³⁷ “In deciding ... whether a work in the nature of a compilation is original, it is wrong to start by considering individual parts of it apart from the whole...For many compilations have nothing original in their parts, yet the sum total of the compilation may be original.”

B. ORIGINALITY IN CIVIL LAW COUNTRIES

Coming to civil law countries, Article 1 of the Dutch Copyright Act, 1912 protects “works of literature, science or art.”³⁸ Under Article 10(2), the Act protects “every production in the domain of literature, science or art, whatever may be the mode or form of its expression.” No express mention of originality exists in the Act and as per the ruling of the Dutch Supreme Court (*Hoge Raad*) in the *Kecofa* decision; a work must possess an “individual character” and “bear the personal imprint of its creator”. The court has also clarified that even a combination of unprotected elements would qualify the criteria of originality. Under the Act, the list of the protected subjected matter is also not exhaustive. Anything would thus be eligible for copyright protection, provided it is “perceptible” and “original” and by extension of that logic, the “Wildflower Works” would have certainly been deemed original and also fixed. The smell of scent too would be a subject matter of copyright as the same can be perceived by human sensation and also qualifies as an expression of the work.³⁹ As for the taste of cheese spread, a Dutch Court in *Levola Hengelo BV v. Smilde Foods BV*⁴⁰ ruled that the taste of cheese spread is not work, but it did not decide whether taste by itself would qualify as a work by making a comparison with the *Kecofa* decision. Court of Justice of the European Union has a request pending with it on such a ruling regarding the possibility of copyright subsisting in taste. In the same case, Advocate General Wathelet rejected the idea and declared that flavours or tastes can be called “original expressions”, but for it to be called works, it must be “sufficiently accurately and objectively identifiable.”

³⁷ *Ladbroke (Football) Ltd v. William Hill (Football) Ltd.*, 1 W.L.R. 273 (1964).

³⁸ J M MEIJER-VAN DER AA ET. AL *Auteurswet 1912 : Wet Van 23 september 1912, Stb. 1912, 308*, (16th ed. 2005), (Copyright is the exclusive right of the author of a literary, scientific or artistic work, or of his assignees, to make such work public and to reproduce it, subject to the limitations provided in the Law.).

³⁹ *Kecofa v. Lancôme*, ECDR (26) 363 (2006) (Dutch).

⁴⁰ *Levola Hengelo BV v. Smilde Foods BV*, 2018 ECLI:EU:C:2018:899.

In France, the law of originality mandates the imprint of the author's personality in the work concerned. What separates one's work from others is the reflection of the mind of the author and is more like the author's "creative choice"- a choice made by the author but not based on the function of the work, or any other method applicable.⁴¹ Speaking of databases and other forms of compilations, courts have ruled that originality is more than mere labour. In the Swiss copyright scene, scholars Bannelet and Egloff put forth that originality comes from the choices made by the author that does not emanate from custom or good practice.⁴²

III. THE ISSUE OF FIXATION

The Berne Convention clearly states "it shall, however, be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form."⁴³ The U.S. Copyright Act defines a work as, "fixed in a tangible medium of expression when its embodiment in a copy . . . by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."⁴⁴ The 1957 Act, as already mentioned, has expressly stated the requirement of fixation for copyright protection only in the case of dramatic works and is totally silent on such a prerequisite in case of artistic works.⁴⁵ U.K.'s Copyright Design and Patent Act, 1988 provides that, "copyright in literary, dramatic or musical works does not subsist until the work is recorded in writing or otherwise."⁴⁶ The need to be fixed in a tangible medium is not explicitly given for artistic works.

The issue here is that there are many works of art (used in a broader context to denote all kinds of work) which by nature are unfixed because they are transient and incorporate elements that undergo changes like food, land, sand, ice etc. as their medium. In such forms of art, the spotlight is on the "process and the effect of constant change" than the final work and the

⁴¹ Daniel J. Gervais, *Feist Goes Global: A Comparative Analysis Of The Notion Of Originality In Copyright Law*, 49 J. OF THE COPYRIGHT SOCIETY OF THE U.S.A, 976, (2002).

⁴² *Id.*, at 969

⁴³ Berne Convention, art. 2(2).

⁴⁴ 17 U.S.C. § 101 (1976).

⁴⁵ The Copyright Act, 1957, §2(c), No. 27, Acts of Parliament, 1957 (India), (Artistic work means- a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality; a [work of architecture]; and any other work of artistic craftsmanship; as provided under Section 2(c) of the Copyright Act).

⁴⁶ Copyright, Designs and Patent Act, 1988, c.48, §3(3), (Eng).

aspects of art lie in the process than the final result work.⁴⁷ Improvisational works, for instance, improvisation to a work of choreography, also have this problem unless they are recorded, photographed or fixed some way. Even then, logic dictates that what receives protection in this manner is not the underlying improvisational work, but the secondary work that was captured or recorded. The same can be extended for live events.⁴⁸

In the landmark U.S. case of *Kelley*, the court held that landscape art failed to clear the fixation obstacle because it was “inherently changeable” and thus made it clear that the garden could not be considered fixed because of the flux it undergoes through exposure to nature’s variations which are not under the control of the creator. In consequence of this problem, fixation works as an illogical exclusion of copyright to ephemeral works of art.⁴⁹ However, the existing jurisprudence to a large extent is unclear and unlike civil law countries like Spain, France, Belgium, Netherlands, etc., common law countries have not done away with the necessity of fixation on the ground of its functional aspects and neither are they liberal in their approach. The rationale of fixation being, that it is an outcome of the Idea-Expression Dichotomy.

Civil law countries like France and Germany accord more importance to perception (by human or by machine). At the Stockholm Revision Conference of the Berne Convention in 1967, many Berne Union countries had asserted that fixation cannot be a precondition for the copyright to subsist and only possessed evidentiary value, which was also echoed by the civil law countries. This position is well-explained in the following words by the authors of Copinger and Skone James on Copyright-

Since fixation addresses the issue of the definition of the work, and proof as to its existence and content, there is no reason of principle why the person who creates the work and the person who fixes the work should be the same. The functions of creation and fixation are distinct ... Copyright protects the skill and labour of the author, and once he has created and expressed his work, it is immaterial how his work comes to be fixed.

These words outline the fact that since authorship and fixation is separate from each other; much emphasis need not be given to fixation in its varied forms possible.

⁴⁷ Carpenter & Hetcher, *supra* note 35, at 2228.

⁴⁸ *Trenton v. Infinity Broad. Corp.*, 865 F. Supp. 1416, 1425 (C.D. Cal. 1994). (finding that the live radio program, or primary work at issue, was not fixed, but the recording of it, that is, the secondary work, was fixed.).

⁴⁹ Z.K. Said, *Copyright’s Illogical Exclusion of Conceptual Art*, 39 COLUM. J.L. & ARTS. 335, 337 (2016).

In the UK, Andy Goldsworthy's ephemeral art is unfixed because of its transitory nature. Photography and visual recording are used to capture the work when it appears most alive, but still the digital image or recording is not the art itself. While such photographs and recordings operate as "fixing" the work, actually, the work itself stays unfixed as per the law. Thus, this form of fixation is not of the work itself but, a representation of the work and thus is called fixation by proxy.⁵⁰ Using the medium of light and space, James Turrell's installations in museums and galleries are unique to say the least. He makes solid objects seem like they are hanging or suspended in the air. However, these objects are actually made of light and only give an impression of being solid. He explains, "I like to use light as a material, but my medium is really perception."⁵¹ The Serbian performance artist Marina Abramovic, uses her body as a medium of art. Rejecting traditional art and bridging the distance between the artist and the audience, she desires her audiences to become collaborators in the process of art by inviting them to observe her. In fact, one of her art works is titled "I am the Object" where she invites visitors to use any object on her body however they may like, surrendering control.⁵² It would be quite an ordeal to decide on fixation in these matters where the medium itself is transient in nature and can never be permanently lodged in one place. In such instances, it is pertinent to revise the requirement of fixation for such works of art so that they become fit for copyright protection and the creators can defend themselves upon infringement of their works.

A. THE RATIONALE OF FIXATION

The strongest logic for the insistence of fixation is that it serves as an evidence of the very existence of the work. Fixation has an evidentiary role to play, in case, for instance, when a case of infringement comes up. It makes it possible to ascertain what the work actually is.⁵³ In the absence of fixation, "copyright law would forever be mired in disputes over the definition and boundaries of the works claiming copyright protection."⁵⁴ When art is fixed in a tangible form, it becomes easier for the courts to determine originality. It is not enough for an author to describe his creative process... rather, a court must be able to compare what the putative author has created to what came before to determine if the 'modicum of creativity' that the court has

⁵⁰ Carpenter & Hetcher, *supra* note 35, at 2229.

⁵¹ *Id.* at 2230.

⁵² *Id.* at 2231.

⁵³ Jane C. Ginsburg, *Overview of Copyright Law*, COLUM. PUB. L. RESEARCH PAPER NO. 14-518 (2016).

⁵⁴ Gregory S. Donat, *Fixing Fixation: A Copyright with Teeth for Improvisational Performers*, 97 COLUM. L. REV. 1363, 1400 (1997).

required exists.⁵⁵ Fixation helps in defining the contours of a copyrighted work. Thus, fixation accords a tangible boundary to the work, enabling others to make a decent interaction with it.

Also, fixation as a requirement exists to meet the principle that copyright should protect the expression and not the idea. Fixation stimulates creativity. In the absence of fixation, proof of the very foundation of the expression of the work falls apart. The principle that copyright protects only an expression of work and not the underlying ideas, and that the ideas are available for free appropriation is called the Idea-Expression Dichotomy and is another rationale for the insistence on the work being fixed. This long-standing principle of copyright law has been affirmed by the TRIPS Agreement as well under Article 9(2).⁵⁶ The leading U.S. case *Baker v. Selden*,⁵⁷ was further codified in Section 102 (b) of the U.S. Copyright Act.⁵⁸ In *R.G. Anand v. Deluxe Films*,⁵⁹ the Supreme Court of India held that even though the underlying idea behind the stories of both the plaintiff and defendant was the same, their expression was different. Therefore, it was not held to be copyright infringement.

IV. EPHEMERAL WORKS AND THEIR FIXATION

A. LANDSCAPE AND LIVING ART

In the *Kelly* case of 1984, Chapman Kelley, on account of a contract with the Chicago Park District had designed and installed an urban landscape work called Wildflower Works in Chicago's Grant Park, wherein he planted many seeds to optimize the blooms at specific times during the year. The design of the garden was planned keeping in mind the seasonal changes of nature and how as a result of that, his landscape art would evolve. The focus was on the process. The artistic merit laid in observing this beautiful process of change. The court in a related dispute ruled that no copyright subsisted in the work due to lack of fixation. As per the reasoning of the

⁵⁵ Laura A. Heymann, *How To Write a Life: Some Thoughts on Fixation and the Copyright/Privacy Divide*, 51 WM. & MARY L. REV. 825, 844 (2009).

⁵⁶ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299. (Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.)

⁵⁷ *Baker v. Selden*, 101 U.S. 99 (1879). (Bardley J.: "Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way. . . . Now whilst no one has a right to print or publish his book, or any material part thereof, as a book intended to convey instruction in the art, any person may practice and use the art itself which he has described and illustrated therein.").

⁵⁸ 17 U.S.C. § 102 (2006). (In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.)

⁵⁹ *R.G. Anand v. M/S. Delux Films & Ors.*, AIR 1978 SC 1613.

court, the constitutive elements of the garden are unfixed by nature despite the fact that the garden could clearly be “perceived for more than a transitory duration,”⁶⁰ as was the statutory need. The court based it on an inherently vague test called the “essence test” and underlined the fact that the essence of the concerned work was dynamic. The court declared that “the law must have some limits; not all conceptual art may be copyrighted.” In the U.S., the problem lies in the interpretation of the term “more than a transitory duration” which is sufficiently unclear. The essence test too seems highly subjective to even be set as a precedent.

However, the U.S. law is flexible enough to make space for any technological change that might give scope for new ways of fixing a work. If the way is such that the artistic expression remains intact, or at least is able to withstand any change of medium and if its persistence through time is without any loss of its intrinsic properties, then we can say that it has enough stability needed for copyright protection. Stability lies in fixation which lies in the control of the author.⁶¹

In the U.K., the Copyright, Designs and Patents Act, 1988 does not explicitly contain a fixation requirement; nevertheless, fixation still prevails in some form when we see the case jurisprudence. A general understanding is that the work in question must be in possession of certain attributes that enable it to be “experienced” and “reproduced”. In other words, it must be more than a sensory phenomenon. An assumption lies that it should have some extension i.e. the work must have some position in space and be viewed from varying angles. Is occupation in space equivalent to a material foundation of the sculptural work? The same is debatable as works can be seemingly occupying space and yet be non-material like a hologram.⁶² In U.K. law, the term artistic expression permeates each of the categories in Section 4,⁶³ but its reach does not

⁶⁰ 17 U.S.C § 101 (1976). (The work must be fixed in a copy or phonorecord “by or under the authority of the author” and the work must be “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”)

⁶¹ Sophie Arquette, *Observations on the Nature of Fixation in U.K. and Dutch Copyright Law*, 27 *YALE J.L. & HUMAN.* 335, 337 (2015).

⁶² *Id.* at 338.

⁶³ Copyright, Designs and Patent Act 1988, c.48, § 4, (Eng.). (1) In this Part “artistic work” means-

- (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
- (b) a work of architecture being a building or a model for a building, or
- (c) a work of artistic craftsmanship.

(2) In this Part-

“building” includes any fixed structure, and a part of a building or fixed structure;

“graphic work” includes—

- (a) any painting, drawing, diagram, map, chart or plan, and
- (b) any engraving, etching, lithograph, woodcut or similar work;

extend so as to cover borderline artworks such as sound sculptures or landscape art or olfactory art in its fold.⁶⁴ So there lies a limitation. Even without a specific fixation mandate, courts in the U.K. are reluctant to let go of it and the fixation of most ephemeral works (excluding live performances) is unclear. The U.K. copyright law does not offer any concrete guidance on this ambiguity.

Talking about his unusual art, Andy Goldsworthy says, “I enjoy the freedom of just using my hands and “found” tools—a sharp stone, the quill of a feather, thorns. I take the opportunities each day offers: if it is snowing, I work with snow, at leaf-fall it will be with leaves; a blown-over tree becomes a source of twigs and branches. I stop at a place or pick up a material because I feel that there is something to be discovered. Here is where I can learn.”⁶⁵ He describes that his art is “alert to nature” and that the transience in his work is a reflection of the transience in nature. These descriptions are enough to state that his artworks would have to wade through the murky waters of the U.K. copyright law to secure protection. His work is undoubtedly a work of high artistic craftsmanship and deserving of copyright protection as there is more than a minimum level of creativity and looking at the case jurisprudence, should extend to provide copyright protection to his artworks.

B. CHOREOGRAPHY

Copyright for choreographic work is still in a developing stage in India. Section 2(h) of the 1957 Act puts choreography under the larger category of dramatic works and needless to say, it is a work of expression. Choreography is defined as “the art of composing a dance or ballet” in the U.S. jurisprudence. But what is dance? It is definitely more than mere human movement and simple basic steps or routines. The Indian law offers no answer on this.

Fixation is a hurdle in the protection of choreography because movement cannot be fixed. Music also seems to have similar issues but recording dance is more difficult than recording music because of the movement factor in the former. Therefore, a performed but unfixed choreography will not be entitled to copyright or so it seems as the same disappears as soon as it is performed. Even the passing of the traditions orally is in an impermanent form.

“photograph” means a recording of light or other radiation on any medium on which an image is produced or from which an image may by any means be produced, and which is not part of a film; “sculpture” includes a cast or model made for purposes of sculpture.)

⁶⁴ Arkette, *supra* note 61, at 339.

⁶⁵ Carpenter & Hetcher, *supra* note 35, at 2268.

A U.S. Court in the 1986 case of *Horgan v. MacMillan, Inc.*⁶⁶ looked into many key points regarding the copyright of choreographic works. Citing the case *Martha Graham School v. Martha Graham Center*,⁶⁷ it stated that, “explicit federal copyright protection for choreography is a fairly recent development, and the scope of that protection is an uncharted area of the law.” The *Horgan* decision states that choreography “is the flow of steps” and “that the central characteristic of choreography is ‘movement’.

Choreographic works may be fixed by visual recording or by a notational system. An elaborate verbal description of a work can also be a notation, if the work could be reconstructed from the same. The choice of medium is relevant if an infringement claim arises on choreographic works. In India, written format is accepted as a mode of fixation that would include the notational system or even an elaborate verbal description from which the work could be reconstructed. However, no interpretation is given as to what constitutes other methods of fixation under the term “or otherwise”, as used in Section 2(h). Visual recording of the work as a mode of fixation has not been stated expressly. Choreographers complain about the fact that recorded or notated versions of choreographic works do not really capture the “soul” of the work and the same is unsatisfactory for them, although they accept that the fixation requirement is necessary to avoid unnecessary limitations on a natural right.⁶⁸

The art of dance is subjected to self-improvisation leading to individual interpretations/expressions. The dancer may perform the choreography of the choreographer but he/she may embellish it with his/her own interpretations.⁶⁹ Fixation of choreography through visual recording records only a specific performance of the choreography along with the interpretations of the dancers. Fixation in this way results in a copyrighted work that may be more detailed in some aspects than the written formats. The problem with the visual recording is that it captures only that specific performance of the choreography and might be different from the intent of the choreographer. However, it is too hyper technical an interpretation, to state that little interpretations by the performers, like style or expressions, would be a significant departure from the choreographer’s intent as the core aspect of the work generally remains unchanged. Thus, all

⁶⁶ 789 F.2d 162 (2d Cir. 1986).

⁶⁷ 380 F.3d 632 (2d Cir. 2004).

⁶⁸ Evie Whiting, *Square Dance: Fitting the Square Peg of Fixation into the Round Hole of Choreographic Works*, 65 VAND. L. REV. 1261 (2019).

⁶⁹ *Kecofa v. Lancôme*, ECDR (26) 363 (2006) (Dutch).

interpretative aspects fixed by visual recording must be protected since finding out the differences between the two is almost impossible. Thus, no question should arise in this regard as to who should be attributed as the author of the work. It is very clearly the choreographer. The interpretations/additions on the part of the performer/dancer are negligible compared to the choreographer's contribution; the very work originates from the latter.

What can be taken as a standard here is the comparative contribution between the choreographer and the performers and for reasons based on simplicity, the choreographer is presumed to be the author unless the challenger proves otherwise. The notation system has some inherent flaws as it is usually drawn from the audience's point of view and right and left need to be reversed by the dancer reading it; it cannot indicate the third dimension; and it gives a description of the position rather than movement and can only record positions and not movements in space and time.⁷⁰

The grave differences between the two possible forms of fixation i.e. written and visual recording, is problematic in a case of infringement. The recording might reveal some distinctive elements that might form the subject of the alleged substantial similarity and the same would not be reflected in the written format. In such a situation, it is unclear as to which method shall be given preference. Also, recording is done through certain angles that may not capture everything in its frame. In case a work has multiple revisions, each of those would be considered as work, provided they have been fixed. A question here is, can photography be enough fixation? Reconstructing from the photographs seems highly unlikely although not possible but it would be too frustrating an undertaking. Thus, still photographs would not be sufficient as a form of fixation.

Under German copyright law,⁷¹ protection begins the moment the work is created, prior to any fixation and fixation cannot be separated from the person of the author. As given, such low levels of fixation pose a huge problem in proving infringement claims. Some kind of fixation requirement must exist for copyright protection to come to aid in future infringement cases. The oral tradition of dancers performing dances and passing them to succeeding generations does not seem adequate enough for preservation of dances.

⁷⁰ Laurent Carrière, *Choreography and Copyright: Some comments on choreographic works as newly defined in the Canadian Copyright Act*, ROBIC Aug. 22, 2020, <https://www.robic.ca/wp-content/uploads/2017/05/105-LC.pdf>.

⁷¹ Urheberrechtsgesetz [UrhG] [Copyright Act], Sep. 9, 1965, BGBL. I at 1273 (Ger.).

It must be noted that choreography is radically different from other forms of art and raises unique problems. It shares some similarities with musical and dramatic works but is not really the same and thus a separate discussion on this issue is warranted. In the following words the court illustrated this point in the *Horgan* case, “the single instant” of a photograph of a movement, it said, “communicates far more than a single chord of a Beethoven symphony.”⁷²

V. PERCEPTION: A LIBERAL CONSTRUCTION OF FIXATION

The Dutch Copyright Act mandates no fixation requirement but that does not mean that anything under the sun is deserving of such protection. However, the precedent set by the *Kecofa* case, that scent of a perfume is eligible for copyright protection is unsettling as it is a matter for experts to decide whether a certain smell is distinguishable from another; even though civil law countries do not function based on precedents. But the court made a point in its favour that copyright law is used to handling software infringement cases that rely heavily on expert opinions.⁷³ This broad interpretation of ‘work’ can be due to the overarching domain of literature, science, and art. But even if that were the case, it would not answer the charge as to why works such as chemical formulae, tastes, or perfume scent would fit within this domain.⁷⁴ In the *Kecofa* case, three things were looked into on the basis of which the copyright protection was given; (i) whether the product is open to human perception? (ii) whether it has an original character of its own and (iii) whether it bears the personal stamp of the maker? On point (ii), it is clear that the original character of the work must not be utilitarian i.e. it should be non-functional and must not be to achieve some technical effect and the court ruled that perfume scent has no technical effect. The court paid no heed to the limited abilities of humans to distinguish different kinds of scents. Upon stating this, the court might be entering the difficult terrain of establishing that fixation extends to a work’s constitutive properties, going to the molecular level stability that though largely durable are prone to changes that may be subjective, like the enzymes in the nose. The court distinguished the scent from its underlying recipe or the liquid that holds it, comparing the liquid to a paper of a book, which is not subject matter of copyright, but the content of the book is.⁷⁵

⁷² 789 F.2d 163 (2d Cir. 1986).

⁷³ *Carpenter & Hetcher*, *supra* note 35, at 2268.

⁷⁴ *Arkette*, *supra* note 61, at 339.

⁷⁵ Kamiel Koelman, *Copyright in the Courts: Perfume as an Artistic Expression?*, WORLD INTELLECTUAL PROPERTY ORGANIZATION MAGAZINE, ISSUE 5/2006, Aug. 25, 2020, https://www.wipo.int/wipo_magazine/en/2006/05/article_0001.html.

The court, however, ruled in the *Levola case* that works like the taste of cheese spread is highly subjective and in that specific case was not given protection, although it did not clarify if taste, in general, is exempt from protection. However, Article (1) and Article 10(1) of the Dutch Copyright Act, 1912 give no hint of a purely sensory phenomenon as work, even though the work is expressed in a form that is perceptual in one or more of the senses. Thus, civil law countries like France, Germany, Netherlands, Spain and Switzerland generally meet the Idea-Expression dichotomy by giving credence to the term “expression” in a literal sense. They interpret expression to mean “something that is perceivable” and hence, this problem does not arise and that is why, for them, perfume scents are not mere ideas.

Article L. 112-1 of the French Code of Intellectual Property provides that, “the provisions of this Code shall protect the rights of authors in all works of the mind, whatever their kind, form of expression, merit or purpose.” Therefore, the form of the work is of no consequence as the same could be visual, auditory, olfactory, or have any other form. In the French case of *Roberts*, the court reasoned that the “purpose for fixation is merely to serve as evidence in an infringement suit and is not a precondition for the copyright to exist.” Thus, copyright accrues in a work the very moment it is expressed in a perceivable form. Such a lenient approach would be difficult to conceive in a closed copyright regime like that in India. Going by this approach, food plating or for that matter, all forms of ephemeral art could be considered an “expression” by being “sufficiently perceivable”. Even though it may perish eventually, the work would exist, even for a transient nature till consumption happens.⁷⁶ Taking that approach, even hairstyles and makeup would be considered work, worthy of copyright protection. In the case of ephemeral works, endurance (appearance in space) is understood as a solid proof of fixation. Space is preferred over time. Civil law countries seem to be stressing the point that artistic expression can be realised in sensory modes other than vision, thus focusing more on perception and not on the requirement of being fixed in a solid tangible medium. The Indian law is unclear as to what comprises fixation. It is clear that copyright subsists on the expression of an idea but what exactly is that expression? Are expression and perception taken to be the same? That is what the civil law regimes seem to hold.

⁷⁶ Aatmik Jain, *Does Copyright Law Protect Presentation of Gastronomic Creations?*, SPICYIP Aug. 25, 2020, <https://spicyip.com/2020/08/does-copyright-law-protect-presentation-of-gastronomic-creations.html>.

VI. NEXUS BETWEEN AUTHORSHIP AND FIXATION

A pertinent question arises on the nexus between authorship and fixation i.e. whether fixation and authorship are parts of the same creative act, to be carried out by the same person,⁷⁷ and this assumes significance in case of choreography. If they are different, is it possible for a person, independent of the author, to reduce the work to a material form for purposes of copyright? Is consent necessary for that? Different jurisdictions hold differently. For instance, can copyright subsist if a visual recording is taken by a member of the audience or it should happen from the author himself? This is possible only if fixation is viewed separately from authorship.

In an Australian case, the court decided that the word ‘author’ means the person who ‘created’ the work and that this person was the “person who brings the copyright work into existence in its material form”⁷⁸ and it is the authors who “who select, order and arrange the fixation of the work in its material form.”⁷⁹

However, English law divulges significantly when it provides that a work can be fixed for copyright purposes by a person independent of the author⁸⁰ to imply that the recording of the work is not an element in the act of authorship since it can be done by a person who may not be the author and who may be acting without the author’s permission. In the English law, ‘author’ is the person who ‘created’ the work and not a person who either ‘made’ or ‘recorded’ it. In 1967, U.K. took a stand that “fixation of a work by a third person created a copyright in favour of its author” implying that the recording/fixation of a work, though has evidentiary value, is not a condition for copyright subsistence. Even the U.S. law requires the work to be recorded “by or under the authority of the author”.⁸¹

This position is of civil law countries. For example, copyright protection in Germany is given to unfixed speeches and unfixed musical works expressed only in the form of sound, the precondition being perception. This is extended for the recording of extempore speeches by a third party too. Seeing authorship and fixation separately is problematic in civil law countries because lines are blurred between the acts of creation/authorship and

⁷⁷ Adeney, *supra* note 8.

⁷⁸ Ice T.V. Pty. Ltd. v. Nine Network Australia Pty. Ltd., 239 CLR 458 (2009).

⁷⁹ Telstra Corporation Ltd. v. Phone Directories Co. Pty. Ltd., 264 ALR 617, 624 (2010).

⁸⁰ Copyright, Designs and Patent Act 1988, c.48, § 3(3), (Eng.).

⁸¹ 17 U.S.C § 101 (1976) (U.S.). (A work is “fixed” in a tangible medium of expression when its embodiment in a copy in a copy or to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.).

expression/perception/fixation and their position that existence is possible even without fixation. Since both creation and expression/fixation occur simultaneously, these acts cannot be construed separately and thus, no question arises of these acts being carried by two different individuals. Creation/expression and expression/fixation of the work fuse in a way that demarcation of these acts and the very question of two individuals executing them does not arise. Such a demarcation is only needed for closed copyright regimes like the U.S, U.K. and by that extension, India.

VII. CONCLUSION

Authors are constantly seeking new ways of expressing themselves, and many new forms of expression are emerging. Copyright, patent and trademark law have some inherent limitations. The Berne Convention allows for a wide interpretation of the subject matter of copyright protection as a result of which we are witnessing an expansion in the very notion of what constitutes 'work'.

Coming to fixation, it is generally, strictly a requirement only for copyright protection in the common law countries; its main purpose being evidence in infringement claims and differentiating idea from expression. Furthermore, a tangible embodiment produces a 'copy' that is easier to engage in commerce with. However, this reasoning applies more for commercial creators and not for artists who are just passionate about their work. Nevertheless, even they are to be shielded from blatant copying, on account of their moral rights and Locke's theory of intellectual property that a man is entitled to the sweet rewards of his hard work. Otherwise, such a creator might lose the incentive to create more even if he does not commercialise his work. Such artistic works embody the Personality Theory of Immanuel Kant and are definitely emanating from the author itself. The question might arise that whether works that are not commercialised but created out of pure passion are of use to society. The answer to this is a resounding yes because the progress of a society can also happen on the basis of ideas which are always available in the public domain for appropriation and inspiration. The ideas behind such ephemeral works can always be used freely and in the right spirit in the manner of inspiration. For these reasons, the copyright law surrounding ephemeral works needs more clarity.

At the moment, the very relationship between originality and fixation is at odds because a very broad interpretation exists for originality and a cabined interpretation exists for fixation in common law countries. As a consequence of which, works having low creativity get protection just because they happen to be fixed while works possessing a high level of creativity go

unprotected on account of being transitory in nature and not adequately meeting the statutory level of fixation. A balance between the two is definitely needed. The need of fixation need not be stretched unnecessarily to altogether deny protection to such works. Maybe common law nations can look at the precedents set by the civil law countries albeit, without stretching loose the requirement of fixation too much that say that perception meets the need of perceiving, reproducing and communicating the work to the public, which is the aim of copyright law.

As discussed above, the Berne Convention allows for a wide interpretation of what constitutes copyrightable material. India, even though a signatory to the Berne Convention, follows a closed copyright regime. But with time and technological advancements, we can hope for changes in the copyright regime and a sufficiently detailed and clear law on originality and fixation of ephemeral works in the near future.

DIRECTOR'S AUTHORSHIP UNDER INDIAN COPYRIGHT LAW: AN (UN) INDIAN APPROACH?

LOKESH VYAS* AND AKSHAT AGARWAL**

ABSTRACT

A movie is an expression of its author's idea and an indubitable reflection of society. However, the authorship of a movie is a nebulous concept and varies from country to country. In India, the producer is the author of a movie whereas, in the UK, both the principal director and the producer are authors. The recent rift over the remaking of the movie Mr. India has kindled the debate over the director's right on a film when the original director expressed his disappointment over the news of a remake of the movie by director Ali Abbas Zafar. The present essay is an attempt to discuss cinematic authorship and to highlight the legislative flaw in granting the authorship of the movie, to the producer. The author has also accentuated the inconceivable extension of authorship to non-human entities which further stretches the concept of a moral right to non-human entities. In conclusion, the author has argued that the present cinematic setting is a relic of the British' Copyright Act, 1956 and needs to be amended now.

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I. EXORDIUM: DIRECTOR AND THE INNOMINATE WORK?

A movie is a collaborative work of various efforts and entails a bundle of copyrights. It involves many stakeholders such as screenwriters, producers, performers, editors, directors, cameramen, etc.¹ These stakeholders get independent copyright for their work yet the ultimate authorship vests with the producer in India.² Therefore, the director of a movie remains out of the purview of the authorship and his rights remain at stake with the producer. The authorship of the producer is rationalised under Section 2(uu) which defines a producer as “a person who takes the initiative and responsibility for making the work.”³ The same is also applicable for sound recordings, however, the present article is only limited to the issue of cinematic authorship.

Interestingly, the authorship of the director is not a recent debate in India and has also arisen in the legislative phase of Copyright Amendment 2010 wherein Sections 2(d), 2(z), and 17 were sought to be amended. The said amendment endorsed the joint authorship of the movie and espoused to make the principal director an author of the movie. The amendment was not accepted owing to its inherent flaws. It is noteworthy that the Parliamentary Standing Committee only discussed it from the perspective of producer authorship dilution and never heeded to the creative contribution of the director.⁴

It becomes essential herein, to briefly touch upon the justifications of copyright and whether this idea of a producer being equated to the concept of an author, within the principles of copyright, aligns with those justifications. Copyright, which initially in its consequentialist sense was introduced as a conscious interference into free markets,⁵ was reasoned on the basis of it providing essential incentives for authors to create, or for creations to come into existence in the first place. Later justifications for copyright also include the idea of personhood, in the sense of extending the idea of copyrights to being an engine of expression⁶ and an imperative autonomous tool therein, to be able to seek rights over a certain expression which originates out

¹C Paul Sellors, *Collective Authorship in Film*, 65 J.A.A.C. 263, 265 (2007).

²The Copyright Act, No. 14 of 1957, Gazette of India, Extra pt. II sec. 3 (Jan. 21, 1958), § 2(d) (India).

³The Copyright Act, § 2(uu) (India).

⁴PARLIAMENT OF RAJYASABHA, DEPARTMENT-RELATED PARLIAMENTARY STANDING COMMITTEE ON HUMAN RESOURCE DEVELOPMENT, 227TH REPORT (2010).

⁵Mark A. Lemley, *Faith-Based Intellectual Property*, 62 UCLA L. Rev. 1328 (2015).

⁶Harper & Row Publrs. v Nation Enters., 471 U.S. 539, 558 (1985).

of one's personality.⁷ These justifications have always focused on fostering creation, and giving certain rights and protections to the creators - to recognise their autonomy, incentivise more creation and most importantly, help them survive.

Copyright was largely justified as a personal right⁸ and never justified on the grounds that such exclusionary rights may become tools of an impersonal corporation⁹ or that of the rich investors. However, in the contemporary sense, giving the status of an "author" to a production company/producer, who merely invests (monetarily) in acts of creation, has become a statutory norm and this can be seen in the Indian Act,¹⁰ as well as in various copyright statutes in the world, especially because of concepts such as the work-for-hire doctrine.¹¹ Maybe this is why it has been asserted that copyright has got a bad name for itself.¹²

Coming back to the idea of a director as an author, the original debate surrounding the authorship of the director arose in the 1940s, in France by Andrew Austruc, where he analogised a director with a novelist.¹³ He argued that the way a novelist uses a pen to create his work, a director uses a camera to create a movie. The theory was further developed by François Truffaut, a French director in 1954 who called a director as the true author of a film.¹⁴ The rationale behind the same was that a director was the central authority of a film whose vision is portrayed through the film. Finally, the idea was crystalised and Americanised by Andrew Sarris as '*Auteur Theory*' through his essay named Notes on Auteur Theory.¹⁵

In the essay, the issue of director's authorship was elaborately argued and the theory regarded a movie as an expression of its director's personality. He justified it on the grounds of personality theory and regarded a movie as an expression of a director's personality. Appositely, he gave a

⁷Lemley, *supra* note 5.

⁸JOANNA KOSTYLO, COMMENTARY, VENETIAN DECREE ON AUTHOR-PRINTER RELATIONS OF 1545 REGARDING AUTHOR/PRINTER RELATIONS (L. Bently & M. Kretschmer eds., 2008).

⁹Jane C. Ginsburg, *Essay – How Copyright Got a Bad Name for Itself*, 26 COLUM. J. OF L. & ARTS, 61(2002); COLUM. PUB. L. RES. PAPER NO. 02-46 (2002).

¹⁰The Copyright Act, § 2(f) (India).

¹¹Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063 (2003).

¹²Ginsburg, *supra* note 9.

¹³Alexander Astruc, *The Birth of a New Avant-Garde: La Camera-Stylo*, originally printed in L'ECRAN FRANCAISE Mar. 30, 1948, <http://www.newwavefilm.com/about/camera-stylo-astruc.shtml>.

¹⁴John Hess, *La Politique des Auteurs (part one)*, 1 JUMP CUT, 19 (1974).

¹⁵ANDREW SARRIS, NOTES ON AUTEUR THEORY IN 1962, in LEO BRAUDY & MARSHALL COHEN, FILM THEORY AND CRITICISM: INTRODUCTORY READINGS 451 (7th ed. 2009).

three-pronged test to determine an auteur.¹⁶ The first premise of the auteur theory is the technical competence of a director, focusing on elementary skills in craft and technique. The second premise of the theory espouses consistency in the work of a director exhibiting his distinguishable personality. The third limb of the test endorses an interior meaning which is extrapolated from the tension between the director's personality and the material he has to work with. Simply, he emphasised the independence of the director in the creation of a movie. The primary criticism which the authors have with Sarris's theory is that it only provided for singular authorship for a movie and disregarded the efforts of other creators. The theory acted as an instrument to valorise certain directors such as Ophuls, Renoir, Hitchcock etc. by naming them auteurs with no legal implications. Sarris's theory espoused a very selective approach of director's authorship, he called some selective directors as the pantheon of directors and lionized them as auteurs while disregarding other directors and their works.

While the theory played a pivotal role in shaping the cinematic debates and culture,¹⁷ it was not powerful enough to justify the director's authorship in every country. This can be seen from the varied interpretation of cinematic authorship in countries. For instance, EU and Nordic countries which support the author-centric approach, regard the director as the author¹⁸ whereas India and the USA¹⁹ do not subscribe to this approach. The theory promotes an objective test of cinematic authorship and comprehends the author only from the pre-given tests. Such objectivity dwindles the artistic nature of cinema which necessarily involves a subjective concept. It also coincides with the concept of aesthetic neutrality which regards art as a subject phenomenon and posits that what is aesthetic art for one may not necessarily have the same aesthetic reverence for the other.²⁰ Interestingly, an idea can have multiple expressions and those multiple expressions may have infinite interpretations. Therefore, subjectivity for the art depends upon the person experiencing the art and the creator of the said art. Illustratively, the interpretation of art by an Indian may not be the same as that of a rustic American. Such difference of opinion about the art discomforts the applicability of Sarris's auteur tests. Irrespective of these inherent loopholes

¹⁶*Id.*

¹⁷Sarris, *supra* note 15.

¹⁸Adolf Dietz, *The Moral Right of the Author: Moral Rights and the Civil Law Countries*, 19 V.L.A J.L. & ARTS 199, 203 (1995).

¹⁹Samuel Jacobs, *The Effect of the 1886 Berne Convention on the U.S. Copyright System's Treatment of Moral Rights and Copyright Term, and Where That Leaves Us Today*, 23 MICH. TELECOMM. & TECH. L. REV. 169, 173 (2016).

²⁰*Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249–51 (1903).

of theory, the underlying idea of the theory in question is that the personality should be given authorship and this provides a strong basis for the authorship of the director.

II. 'PERSONHOOD' JUSTIFICATION OF DIRECTORS' WORK

A movie is a *mélange* of various other arts including songs, drama, dance, acting, music etc. therefore, there are many personalities involved in movie making. From the creativity and copyright perspective, moviemaking has three stages namely, pre-production, production, post-production.²¹ In every stage, the creative authority lies with certain stakeholders namely, the directors, screenwriters, producers, and actors to an extent. The pre-production stage is a planning stage where the director sits with the scriptwriter and the producer to decide the production stage. At this stage, casting, budgeting, scouting and selection of shooting locations, drafting of essays and script preparation (subject to final redaction) are decided.²² This is a crucial stage of filmmaking as it is the stage where a director develops the visual conception of a movie and plans to eventuate it in an envisaged manner. Interestingly, this visual conception is merely a personal idea of the director which has to pass from several phases to get externalised into a movie.

In the production stage, the planning comes into action and the 'filmmaking' begins.²³ At this stage, the director guides the technical crew and controls all the creative and dramatic aspects of the movie. This control is directly connected with the visual conception developed in the previous stage. Undeniably, this vision may change at this stage however, the end result would still be the directors' vision but with some changes. It is to be noted that a director's role is not only limited to managing the creative efforts of various individuals but also includes the harmonisation of various works to create a cohesive whole i.e. a movie.²⁴

This also coincides with Aristotle's famous quote "a whole is greater than the sum of its parts", as also dictated by the Court in the case of *MRF Ltd. v. Metro Tyres Ltd.*²⁵ Notably, a movie is more than its various parts. Merely positioning different works does not gain it a title of the movie, it has to be done creatively and consciously. In the words of Justice V.R. Krishna Iyer, "*Cinema is more than long strips of celluloid, more than miracles in photography, more than song, dance and*

²¹Eileen Morley & Andrew Silver, *A Film Director's Approach to Managing Creativity*, 55 HAR. BUSS. REV. 59, 61 (1977).

²²JIM OWENS & GERALD MILLERSON, VIDEO PRODUCTION HANDBOOK (5th ed. 2012).

²³Morley & Silver, *supra* note 21.

²⁴*Supra* note 21.

²⁵*MRF Ltd. v. Metro Tyres Ltd.*, 79 PTC (Del.) 368 (2019) (India).

dialogues, and, indeed, more than a dramatic story, exciting plot, gripping situations and marvelous acting. But it is that ensemble which is the finished product of orchestrated performance by each of the several participants, although the components may, sometimes, in themselves be elegant entities."²⁶ Thus, a director is not merely a manager or an administrative agent of the producer, rather he/she is the one responsible for all the coordination and management of works in the line of visual conception or aesthetic vision of the movie as developed in the pre-production stage.

Finally, in the post-production stage,²⁷ all the works produced and shot during the production are synchronised as per pre-conceived vision. This process involves several activities including picture-editing, sound-editing, sound-mixing, visual effects, music scoring, and sound synchronisation, colour correction titles, credits, and editing graphics, gathering distribution materials and making the trailer for the movie etc.²⁸In practice, a producer acquires a decisive authority at this stage, which is often cited as the justification of their authorship disregarding the basic essentialists of authorship.²⁹ Notably, it is heavily influenced by market needs and the investors' view. Thus, capitalistic cannons become the guiding principles here.

All these stages are interdependent and carry the personality of the director. For example, directors such as Alfred Hitchcock, who focuses more on planning and on a well-organised shooting, pay more heed to the pre-production stage.³⁰Conversely, directors such as Ingmar Bergman³¹ and Arthur Penn³²who prefer spontaneity and responsiveness, pay special attention to the production stage of a movie. This highlights that all directors have a unique personality which they imbibe in a movie. In India Cinema, Imtiaz Ali an apposite example to illustrate the impact of personality and the consistency in the themes though in a broad manner. He works on the idea of 'Ekko ek kahani, bas badle zamana' (a dialogue from his movie Love Aaj Kal) which literally means that "stories are generally the same, just the time period changes."

²⁶Indian Performing Right Society Ltd. v Eastern Indian Motion Pictures Ass. & Ors., PTC (Suppl) (1) 877 (SC)(India).

²⁷*Supra* note 21.

²⁸*Supra* note 21.

²⁹*Supra* note 21.

³⁰ROBERT KOLKER, ALFRED HITCHCOCK'S PSYCHO: A CASEBOOK 97 (1st ed. 2004).

³¹ROBIN WOOD & RICHARD LIPPE, ARTHUR PENN: CONTEMPORARY APPROACHES TO FILM AND MEDIA SERIES (Barry Keith Grant ed., 2014).

³²Gavin Extence, *Cinematic Thought: The Representation of Subjective Processes in the Films of Bergman, Resnais and Kubrick* (Sept. 2008) (Ph.D. Thesis, University of Sheffield).

Like an auteur, he predominantly follows two themes in his movies namely journey and storytelling which majorly encapsulates a love story. Much like his love for mountains, Imtiaz imbibes the pine for love, fascination for mountains, escape from home, the realisation of love after some sort of separation. His characters Aditya and Geet (Jab we Met), Harry and Sejal (Jab Harry Met Sejal), Ved and Taara (Tamasha), Janardhan Jakhar aka Jordan and Heer Kaul (Rockstar), Veera (Highway) share the above characteristics. In his interview, he has expressed the presence of his life experiences in his movies. His movies depict his love for stories which developed in his childhood where he had access to cinema, movies and theatres. This in turn ingrained in him the idea of understanding lives through mirrors and stories.³³Such imbuing of personality in the cinema provides a strong justification for giving copyright protection.

Given this genealogy, the personhood theory provides a strong justification for the director's authorship. As per the personalists, especially Hegel, an intellectual property ["IP"] is an expression of one's personality.³⁴ Hegel vehemently argued that when a person externalises his ideas using his mental faculties, he actually expresses his will.³⁵ Such expression should be regarded as his property and given protection by the state.³⁶ Pertinently, per David C Funder, "*Personality refers to an individual's characteristic patterns of thought, emotion, and behaviour, together with the psychological mechanisms -hidden or not-behind those patterns*".³⁷ This definition is important in the current context as the decisions of the directors while making a movie directly emanate from their personality and get externalised in the movie. Therefore, such a deliberate effort of the director to externalise his personality deserves protection.

Further, it also coincides with the theory of J.G. Fichte, who provided strong arguments for literary authorship.³⁸ He argues that a work has two parts; namely physical form and ideational part. The former can be alienated however, the latter remains inseparable once it is created.³⁹ Therefore, in the case of a movie, the economic rights over the movie including distribution and reproduction might lie with the producer, but as the personality and unique aspects of the

³³Netflix, *Imtiaz Ali On Growing Up With Movies*, YouTube, (Jan. 04, 2021), https://www.youtube.com/watch?v=tKOqZYqzcE&ab_channel=NetflixIndia.

³⁴Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 290 (1988).

³⁵Kanu Priya, *Intellectual Property and Hegelian Justification*, 1 NUJSL REV. 359, 361 (2008).

³⁶*Id.*

³⁷DAVID C FUNDER, *THE PERSONALITY PUZZLE* 2 (7th ed. 2015).

³⁸Mario Biagioli, *Genius against Copyright: Revisiting Fichte's Proof of the Illegality of Reprinting*, 86 NOTRE DAME L. REV. 1847 (2011).

³⁹*Id.*

director imbued in a movie cannot be separated from him, the director is entitled to some form of protection. It is worth noting that the creation of a movie by a director demonstrates a director's autonomy of expression of his personality in the movie and if this is not protected, then this would defy the idea of copyright as an engine of free expression.⁴⁰ Illustratively, a movie directed by X can be owned by Y Production, but it does not erase the involvement of X with the movie as his personality is deeply embedded in its creation. Thus, it is imperative for the law to differentiate the author and owner of the movie. The contract that usually is entered between a director and the producer suggests the transfer of ownership however this does not necessarily transfer the authorship of the work and disqualify the director from being an author. Such understanding is negated by highlighting the monies paid to the director for the direction of the movie, thus making it appear like a general service agreement where one person sells her creativity to others for a monetary consideration. Such contracting is undoubtedly important for the smooth functioning of the work in an arranged manner and pre-empting the potential conflicts of interests but giving excessive importance to the contractual arrangement sans any statutory gives is very likely to give an impetus to mismatched bargaining power among parties. The same can be fathomed from the Copyright Amendment 2012 which removed the contractual asymmetry between musicians and producers by mandating the equal sharing of royalties among such authors.⁴¹

The fortunate yet contrasting aspect in the case of musical works was that their creators are statutorily recognised authors so they already had some statutory benefit pre-2012 amendment such as moral rights protection. Such statutory recognition brings them (authors of musical works) under the purview of section 17 of the Act, thus, merely shifting the ownership over the work to the employer without any impact on the authorship. This is absent for directors who have to completely rely on the contractual arrangement with the producer without any recourse under the Copyright Act. In India, directors do not have any collective bodies or copyright societies like IPRS and PPL which are constituted under Section 33 of the Act by authors and owners of the works. These bodies not only represent the interests of authors but also hold strong power in lobbying. These collective bodies are incorporated under the Act through the

⁴⁰*Supra* note 21.

⁴¹Abhai Pandey, *Development In Indian IP Law: The Copyright (Amendment) Act 2012*, SPICYIP(Jan.22, 2013),<https://www.ip-watch.org/2013/01/22/development-in-indian-ip-law-the-copyright-amendment-act-2012/>.

2012 amendment focusing on the interests of authors extant in the act which excludes film directors.⁴²

The U.S.A. also does not recognise directors as the authors of a movie, however, the Directors Guild of America [“DGA”] is a guild which represents the interest of directors of films and television and this guild holds a strong lobbying power for protecting the legal interests of directors. The adoption of the pseudonym Alan Smithee is an appropriate example of DGA to protect the directors from the undesirable movie version of studios.⁴³ Interestingly, it was a tool for the directors to dissociate themselves from the work when they did not find the edited movies up to the mark and were afraid of affecting their reputation. Moreover, the Guild proposed certain legislations for the protection of the interests of director rights including the Film Integrity Act of 1987, National Film Preservation Act of 1988, Film Disclosure Act of 1992, The Theatrical Motion Picture Authorship Act of 1995, though not all efforts were fructified.⁴⁴ DGA has also tried to safeguard the artistic and creative interests of directors by DGA basic agreement by incorporating a clause of ‘Consultation after Assignment’ under Article 7 in the DGA Basic Agreement.⁴⁵ In this way, besides statutory silence on the authorship of directors, there also exists a structural impediment (absence of a body to represent the interests of directors) for directors to not be able to claim authorship through contract.

III. PRE-DEFINED AUTHORSHIP: A LEGISLATIVE INFELICITY?

Filmmaking is an art and a filmmaker is an artist. However, ‘who is a filmmaker’ and ‘what is required of a person to become a filmmaker’ are two nebulous but regularly debated questions in copyright law. Countries like the USA, which endorses an economic centric copyright law and underpins a capitalistic concept of authorship, regards the financier as the author of the movie. Similarly, India’s copyright law synonymises a filmmaker with the producer who is actually the financier/risk-taker. These two approaches appear to be similar but are fundamentally different. The USA does not give a pre-defined authorship for the work⁴⁶ whereas India fixes the authorship to the producer.⁴⁷ In principle, both the countries surmise financing as the ultimate

⁴²Zakir Thomas, *Overview of Changes to the Indian Copyright Law*, 17 J. INTELL. PROP. RTS. 324, 329 (2012).

⁴³Peter Decherney, *Auteurism on Trial: Moral Rights and Films on Television*, 2011 WIS. L. REV. 273, 299 (2011).

⁴⁴Leslie A. Pettenati, *Moral Rights of Artists in an International Marketplace*, 12 PACE INT’L L. REV. 425, 447 (2000).

⁴⁵DIRECTORS GUILD OF AMERICA, SUMMARY OF DIRECTORS’ CREATIVE RIGHTS UNDER THE DIRECTORS GUILD OF AMERICA BASIC AGREEMENT OF 2017 - FEATURES & LONG-FORM TELEVISION (2017).

⁴⁶Copyright Act of 1976, 17 U.S.C. § 201 (2012).

⁴⁷The Copyright Act, § 2(d) (India).

yardstick for a movie and overlook the element of creativity. Such financial indulgence being the sole target of copyright authorship is fundamentally a flawed concept as it not only deviates from the general notion of authorship but also obfuscates the philosophical foundations of copyright law.

Interestingly, the term author is derived from the Latin word *auctor*, which is developed from the verb *augere* which means “to increase, augment, strengthen that which is already in existence”.⁴⁸ The modern meaning as given in Black’s law dictionary defines an author as “one who produces, by his own intellectual labour applied to the materials of his composition, an arrangement or compilation new in itself.”⁴⁹ Similarly, in the *Burrow Gils* case, the court defined an author as “he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.”⁵⁰ In the *Jefri Aalmuhammed* case, the author was defined as a person who really represents, creates, or gives an effect to the idea.⁵¹

In India, there are no specific cases for the meaning of authorship per se. However, in *Najma Heptulla v. Orient Longman Ltd. & Ors.*, Justice BN Kirpal remarked that, “To me it appears that if there is an intellectual contribution by two or more persons pursuant to a reconverted joint design, to the composition of a literary work then those persons have to be regarded as joint authors.”⁵² In simple words, to be called an author of a work, the intellectual contribution is requisite. It can also be deciphered from cases discussing originality. Illustratively, in the case of *MRF v. Metro Tyres*⁵³ and *Yashraj Films*⁵⁴, it has been settled that a movie is an ‘original’ work of authorship. Here, the expression original requires the deployment of skill and judgment coupled with flavour of minimal creativity. Thus, an author is a person who employs his skill and judgment to create work (though minimally creative). However, the current legal cinematic authorship framework replaces it with risk-taking i.e. financing. In *MRF v. Metro Tyres*, all authorship privileges and rights that are provided for an original work of authorship under Section 14 of the Copyright Act, were extended to the author of a cinematographic film. Interestingly, the author of a cinematographic

⁴⁸ AUTHORITY MATTERS: RETHINKING THE THEORY AND PRACTICE OF AUTHORSHIP (Stephen Donovan et. al. eds., 1st ed. 2015).

⁴⁹ BRYAN A. GARNER, BLACK’S LAW DICTIONARY (6th ed. 1990).

⁵⁰ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

⁵¹ *Aalmuhammed v. Lee* 202 F.3d 1227 (9th Cir. 2000).

⁵² *Najma Heptulla v. Orient Longman Ltd. & Ors.* 63 AIR 1989 (Del.) (India).

⁵³ *MRF Ltd. v. Metro Tyres Ltd.*, 79 PTC (Del.) 368 (2019) (India).

⁵⁴ *Yash Raj Films Pvt. Ltd. v. Sri Sai Ganesh Productions & Ors.*, 80 PTC (Del.) 200(2019) (India).

film, as per section 2(d) of the Copyright Act, is the producer/financier. Therefore, as a distinct feature of the Indian Copyright Act, this decision establishes that the equivalent privileges as accorded to someone who inputs skill and judgment in a work, are provided to someone who merely finances a film.⁵⁵

Further, Section 17 and Section 18 of the Copyright Act play a significant role in the ascertainment of the ownership and authorship of the work. In case of movies, these provisions provide a conceptual framework for the author-owner divide and settle issues of the economic exploitation of the work. These provisions expatiate the determination of IP rights through the contractual relationships among various authors thereby suggesting the pivotal role of 'contract of service' and 'contract for service'. However, they decipher the author as per Section 2(d) of the Copyright Act which does not include the director anywhere. Thus, the director always remains out of the purview of copyright law.

Such an anomalous arrangement owns its origin to the British era as it has always remained a guiding cannon for the Indian copyright regime.⁵⁶ Before the independence, Copyright Act, 1847 and Indian Copyright Act, 1914 were epitomes of the UK's Copyright Act, 1842 and the Imperial Copyright Act, 1911 respectively.⁵⁷ In that time, movies were not regarded as a separate copyrightable work. Rather, they were given a dual treatment of dramatic work and artistic work.⁵⁸ Such consideration created a conceptual flummox in the law and blurred the ownership of the work, e.g. in *Fenning Film Source v. Wolverhampton Co Cinemas*,⁵⁹ the producer was regarded as an owner whereas in *Falcon v. Famous Players Film Co*,⁶⁰ it was held that the screenwriter was the owner of the work. After independence, India enacted Copyright Act, 1957 by relying on U.K.'s Copyright Act, 1956 which regarded a movie as a separate work and bestowed the authorship to

⁵⁵ Akshat Agarwal, *AI – Generated Work Of Art: Who Deserves The Authorial Credit?*, IPR MENT LAW (Jan. 5, 2019), <https://iprmentlaw.com/2019/01/05/ai-generated-work-of-art-who-deserves-the-authorial-credit>

⁵⁶ Shubha Ghosh, *A roadmap for TRIPS: copyright and film in Colonial and Independent India*, 1 QUEEN MARY J. INTELL. PROP. 146, 153 (2011).

⁵⁷ *Supra* note 56.

⁵⁸ *Supra* note 56.

⁵⁹ *Fenning Film Source v. Wolverhampton Co. Cinemas*, [1914] 3 K.B. 1171; *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

⁶⁰ *Falcon v. Famous Players Film Co*, [1926] 2 K.B. 474.

the producer.⁶¹ In 1988, the U.K. made changes in its copyright law and gave the director the joint authorship of the movie.⁶² However, India still suffers the same legislative infelicity.

Before, the Copyright Act, 1956 regarded a movie as a dramatic work or a series of photographs, however, post-1956 Act movies have been given a separate status of copyrightable work.⁶³ The 1956 Act was completed and replaced by the Copyright, Designs and Patents Act 1988 [“CDPA”] with major changes. Under CDPA, the concept of moral rights was formalised and the creator of the work is made the author of the work.⁶⁴ However, it also did not give statutory recognition to Directors as authors but merely protected moral rights. Directors got the authorship recognition through the Copyright and Related Rights Regulations 1996 which ascribed them the status of work of the joint author to the movie. Such authorship was given to the principal director (though it was not defined in the act) and producer.⁶⁵ Nevertheless, it doesn’t make UK’s copyright law the perfect legislation to develop the concept of authorship. Prima facie, it follows a dualistic approach of copyright wherein economic rights and moral rights stand differently and the absence of one does not necessarily affect the presence of other unlike US copyright law which follows a monist approach regarding both economic rights and moral rights existing in the same person. However, going deeper in the act shows a contrast, as on one hand, it classifies economic rights and moral rights highlighting the artistic individuality and inalienability of works. On the other hand, it allows an author to waive off her moral rights, thus undermining the individuality of the artistic expressions.⁶⁶

IV. REVISITING IDEA-EXPRESSION DICHOTOMY

In the simplest words, the copyright is given to the person who expresses an idea and not to the one who finances the author to express the idea.⁶⁷ Learned Hand in *Nichols v Universal Pictures Corp.*⁶⁸ had held that abstractions that level to the concept of an “idea” apart from how they are expressed are not protected as property, however, the boundary is vague, and nobody will ever

⁶¹Upendra Baxi, *Copyright Law and Justice in India*, 28(4) J.INDIA L.INST.497, 506 (1986).

⁶²Copyright, Design and Patents Act 1988, C. 48, § 11 (Eng.).

⁶³PASCAL KAMINA, *FILM COPYRIGHT IN THE EUROPEAN UNION* (2nd ed. 2016).

⁶⁴ Copyright, Design and Patents Act 1988, C. 48, § 9(1) (Eng.).

⁶⁵*Id.* § 11.

⁶⁶*I Supra* note 64 § 87.

⁶⁷The Copyright Act, § 2(d) (India). [Author is always the first owner of the work unless an agreement to the contrary].

⁶⁸*Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

be able to fix that boundary. A way to think about the context of what constitutes an expression is to invoke the Nietzschean idea of “*Perspectivism*.”⁶⁹

An idea itself is not copyrightable but its expression is.⁷⁰ The copyright is not concerned with the process of expressing an idea. Even a photograph created through a mechanical process can get copyright if it originates from the photographer’s creative choices and distinct perspective. Thus, as held in the *Feist case*, even original selection and arrangement of the material can get copyright if it is original and involves making creative choices.⁷¹ Unfortunately, this is not generally applied to a director’s work which is often regarded as a managerial task, in spite of the input of a distinct perspective being involved in showcasing the script, in the finest possible way.

Pertinently, Indian copyright law endorses two tests for giving rights in a cinema: firstly, the final screening of the movie, and secondly the risk-taking factor. In the former, copyright takes the appearance of the person/work into consideration. Simply, anyone whose contribution can be noticed in a movie gets some rights. For example, performers, singers, lyricists etc. Whereas, the latter is contextualised as the financing and economic risk-taking. For instance, an investor and a producer who bears the risk if the movie fails. Such a scenario highlights the preference of noticeability and suggests a restricted understanding of the idea-expression dichotomy.

Further, moral rights are defined as the special rights of ‘Authors’ where the author is the one who is mentioned under Section 2(d) and this excludes the director. Thus, the contractual relationship between a director and an author becomes the ultimate governing law irrespective of the creation or the contribution of the director which the copyright law aims to safeguard. The 2015 *Sartaj Singh Pannu*⁷² case is a prime example to demonstrate the plight of directors where the judge expressed his incapacity to protect the moral right of a director in the absence of such a right in the act.

In the *Ramesh Sippy case*,⁷³ the court denied the right to the director and held that unlike literary and artistic work which requires a natural person to be the author, in cinematography, a legal person can be the author. The court held that the “cinematography is not an original work of

⁶⁹FRIEDRICH NIETZSCHE, STANFORD ENCYCLOPAEDIA OF PHILOSOPHY (Edward N. Zalta ed., Spring ed. 2020); see also Pietro Gori & Paolo Stellino, *Introductory Study: Nietzsche on Culture and Subjectivity*, 2 QUADERNS DE FILOSOFIA 11-23, (2015).

⁷⁰Eastern Book Co. v. D.B. Modak, AIR SC 809 (2008) (India).

⁷¹ Feist Publications, Inc. v Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

⁷²Sartaj Singh Pannu v. Gurbani Media Pvt. Ltd. & Anr., 63 PTC (Del.) 590(2015) (India).

⁷³ Ramesh Sippy v. Shaan Ranjeet Uttamsingh & Ors., AIR Bom. 228 (2013) (India).

composition” of one person. Rather, it is a work of collective efforts that are joined by the “entrepreneurship thread’ of the producer. This is problematic at multiple levels as it not only overshadows the creativity of the director with the producer’s entrepreneurship but also dilutes the concept of authorship to non-human entities and extends the moral right to corporates. Such metaphoric justification by the court highlights the relevance of ‘control’ and ‘veto’ power of the producer which is not always the appreciable factor in comprehending authorship as held in *Community for Creative Non-Violence case*⁷⁴ and *Kogan Case*.⁷⁵

It blatantly contravenes the personhood and fairness theories of IP which seek to protect the individual values of authorship and bolster the bond between the author and work. Hence, such an anomalous arrangement not only deprives directors of the economic benefits of authorship but also disables them from claiming the benefit of moral rights. Such melancholy can also be illustrated by *16 Casa Duse LLC v. Merkin (2015)*,⁷⁶ where the USA Court refused to grant the authorship rights to the director irrespective of his creative contribution in the movie. The court reasoned that a director’s work is not separable from a movie hence, cannot be considered as the joint authors of the work. The reasoning was based on the test of joint authorship which includes two factors namely i.) the intention of the parties, and ii.) inseparability of the work. The facts of the case made it apparent that neither party had an intention to come together to create a work of joint authorship over the work. The work of both (director and the producer) was also not separable. Notably, relying on the inseparability of work the court gave an upper hand to the rights of the producer, thus creating an inconceivable hierarchy of the producer and the director.⁷⁷ Using a producer as the dominant author yardstick, the Court overshadowed the creative and artistic decision-making by the overall decision making of the producer which includes the selection of cast, crew and director, coordination of the production of the film, management of the film’s publicity and release.

In absence of the explicit protection under the copyright law, the Courts have to rely on the other branches of laws as done by the US Courts which have gone beyond the contractual clauses and codified canons of copyright laws and provided remedies under tort law, privacy rights, publicity rights, trademark law, contract, defamation, etc. to protect the interest of

⁷⁴Commentary for *Creative Non-Violence v. Reid*, 490 U.S. 730, 109 S. Ct. 2166 (1989).

⁷⁵ *Kogan v. Martin*, EWCA Civ. 1645 (2019) (United Kingdom).

⁷⁶ *16 Casa Duse, LLC v. Merkin*, No. 13-3865 (2d Cir. 2015).

⁷⁷*Id.*

authors. In *Vegas v. Esquire*,⁷⁸ irrespective of the silence of contract, the Court permitted the author to claim the right of attribution. In *Granz v. Harris*,⁷⁹ the defendant deleted some part of the work performance and presented it with the name of the plaintiff which was stipulated in the agreement. The court clarified that such credit is only limited to the work stipulated and the modified work (with some deletions of performances) does not attract the application of the contract as it unfairly associates the work with the author.

Similarly, in the case of *Edison v. Viva International Ltd.*,⁸⁰ the Court recognised the author's moral right as a part of the contract law. Similar rulings were also followed in *Clevenger v. Baker, Voorhis & Co.*,⁸¹ and *Archbold v. Sweet*,⁸² wherein the Courts acted as a saviour of the moral rights of the authors and denigrated the defendant's act of wrongful attribution of the plaintiff's authorship. Also, in *Beatty v. Paramount Pictures Corporation*, the director was given the right to final cut when the defendant's network distributor cut approximately six and a half minutes from the film. The director argued his absolute right of final cut over the movie which includes television broadcasts, on the other hand, Paramount Pictures relied on the language of the contract which signifies right over the final cut. However, the Court favoured the director and gave the right of the final cut. In this way, the rights of the director can be protected but the Courts cannot be expected to follow uniformity in protecting such rights and ultimately the facts of the case especially the contractual arrangements become the dominating criteria to resolve the issues.

V. CONCLUSION

Externalisation of an idea through intellectual labour should be the primary yardstick for determining authorship and noticeability should be merely used to comprehend and appreciate the art. In copyright law, authors, disseminators and the audience are three major stakeholders and are imperative for the smooth functioning of copyright law. The role of the financier is undoubtedly important for the creation of a work owing to the inseparable cost in IP creation, especially movie making. Undoubtedly, movie-making involves a huge cost and requires the financier for both, creation and dissemination. For the sake of understanding, the creation of a work can be divided into three stages, namely pre-creation, creation, post-creation. Mainly, the

⁷⁸ *Vargas v. Esquire*, 164 F.2d 522, 526 (7th Cir. 1947).

⁷⁹ *Granz v. Harris et al.*, 198 F.2d 585 (2d Cir. 1952).

⁸⁰ *Edison v. Viva International Ltd.*, 421 N.Y.S.2d 203, 206 (N.Y. Sup. Ct. 1979).

⁸¹ *Clevenger v. Baker Voorhis Co.*, 8 N.Y.2d 187 (1960).

⁸² *Archbold v. Sweet*, (1832) 172 Eng. Rep. 947.

financier is required at the pre-creation (hiring actors, selecting places, the requirement of a pen, paper etc.) and post-creation (publication, performance, dissemination, etc.) stages. The middle stage i.e. the creation stage, where all the creative work is done, is done by the director, authors, and other artistic people who play an active role in this stage. Thus, financing becomes an inescapable part of copyright law. However, regardless of its inalienability in the creation of work, it can in no way be replaced with the authorship. Thus, a producer is important for the creation of a cinematography work and can own the work but it doesn't make a producer the author of the movie. The equation of financing with creativity under Section 2(d) is a colonially coloured legislative infelicity. Keeping this in the act means synonymising creativity with economic prowess. It is high time that the Indian copyright law distinguishes between an author and the owner of a cinematographic film and realise that paying for the creation of a work does in no way mean creating the work. The former requires financing and economic capability whereas the latter requires intellectual labour and efforts. It is very quintessential for the copyright law to balance this dichotomous relationship otherwise it defeats the objective of copyright law.

Keeping the spirit of India's copyright law in mind and relying on the abovementioned argumentation, the authors suggest the following changes Section 2 (d):

*(v) in relation to a cinematograph film or *****, the principal director;*

As specified in the above chapter, this is specifically limited to the authorship of a movie and therefore, the authors have not made any comment for the sound recording. Additionally, the definition of principal director should also be added as the director whose creative decision supersedes the decisions of other directors. Also, the following two clauses should be added in Section 17 of the Copyright Act which pertains to the ownership of copyrighted works.

*(f) in the case of cinematograph film produced on or after the commencement of the Copyright (Amendment) Act, *****, the principal director shall be treated as the first owner of copyright.*

This provision would be used prospectively in order to avoid potential conflicts among the producers and directors arose before the amendment of act (if ever). Amendment is also required in Section 18 wherein the royalty of directors can be mandated like the authors of the literary or musical works.

It is high time that India and countries which don't recognise director's authorship, change their laws. Such changes might invite certain unwanted issues at the beginning such as resentment from many producers and studios, and it may also affect the film industry in the time being,

however, it is to be noted that “speculation about future harms is no basis for [courts] to shrink authorial rights.” as voiced in the Supreme Court in *N.Y. Times Co. v. Tasini*.⁸³

⁸³*N.Y. Times Co. v. Tasini*, 533 U.S. 483, 505 (2001).

ENABLEMENT AND PLAUSIBILITY IN BIOTECH PATENTS

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ABSTRACT

The entire patent system revolves around the concept of the grant of monopoly over the sufficient disclosure of an invention. Enablement and plausibility are extended branches to the test of sufficiency, particularly when dealing with biotech patents. The concept of plausibility got its origin from EPO and later got flourished to various jurisdictions through well-established case laws. The quantum of experimental evidence needed is one of the most important considerations on patent filing decisions in the biotech sector, which in turn points to the prominence of plausibility and enablement in the sector. Patentees must be capable of striking a balance between the fact that trial studies can take an extensive stretch of time against the first to file criteria of patents and thereby self-analyse how early to file a patent application. It's a challenge for the patentee to sufficiently describe the inventions so that the issue of plausibility does not arise, knowing the fact that deficiency in enablement cannot be resolved after the effective filing date. Further limiting the undue broadness of claims, passing the threshold test for plausibility is a major issue in biotechnology patents. In this context, this paper covers issues related to enablement and plausibility in biotech patents by analysing case laws evolved across various jurisdictions over the years.

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I. INTRODUCTION

A monopoly over the exclusive rights of a patent in lieu demands for a sufficient and complete disclosure of the invention. Enablement and plausibility are intended to guarantee that the patentee sufficiently discloses the invention in exchange for the patent granted. A patent must depict the invention clearly enough so that a person skilled in the field can reproduce the innovation without performing tests to decide how to make and utilise the development. This is called “enablement” of the patent application. In the field of “unpredictable” arts mainly for biology and chemistry, enablement is particularly important. A deposit in such a field shall encourage or ensure performing ability or a plausible disclosure. The need for such a ‘deposit’ is mandated by the Budapest Treaty to strengthen and support the patent specification. For example, India is a member country of the Budapest Treaty which requires an applicant to deposit the biological material used in the invention with an International Depository Authority [“**IDA**”]. Thus, for the completion of the patent specification, deposition is important.

‘Plausibility’ is an intriguing issue which emerges frequently in case of both enablement and sufficiency, especially in the life sciences sector. Plausibility is one of the factors judging the sufficiency of a biotech patent rather than a separate test for striking patent validity. ‘Plausibility’ got its origin from the European Patent Office [“**EPO**”] in reaction to excessively broad claims and to forestall speculative claiming. It isn’t central that the specification contains trial information or results, given that the nature of the innovation is with the end goal that it depends on a technical impact which is either plainly obvious or predictable or dependent on a decisive theoretical idea, i.e. plausible.

In the biotech sector, there is a dilemma between the quantum of experimental evidence required and the first to file requirement. Plausibility ought to be viewed based on the specification as on the patent filing date. Deficiency in enablement can’t be rectified later by post filed information. Also, the advent of plausibility tackles patents of broad and speculative claims and those patents which lack strong experimental proof that the technical effect claimed is achieved.¹ The emerging numbers of second medical use patents leave more space for plausibility and enablement. Generally, in second medical use, patents claim patentability over a new use of an already known compound. Such patents provide the holder with an extended life of the claimed compound with

¹ Dr. Sven J.R Bostyn, *Plausibility in Life Science Patents*, GENOME EDITING - CRISPR ALS HERAUSFORDERUNG FÜR DAS LIFE SCIENCES-RECHT (2018), https://ius.unibas.ch/fileadmin/user_upload/ius/09_Upload_Personenprofile-/01_Professoren/Zech_Herbert/Konferenzmaterial/Plausibility_in_Life_Sciences_Patents_Bostyn.pdf.

an additional protection and thereby preventing the entry of generic drugs. Several jurisdictions enable such patenting, one of them being Europe. Article 54(5)² of European Patent Convention calls for the kind. The threshold of plausibility differs with respect to jurisdictions. In this context, the present study aims to analyse the enablement and plausibility requirements in biotech patents in different jurisdictions like EU, US and India and highlights the recent development in this sector.

A. ENABLEMENT AND PLAUSIBILITY

‘Invention’ in the context of patent law must solve a technical issue and necessitates to be made plausible by the specification disclosure that the problem is solved. It is not the claims alone to be assessed for satisfying the test of enablement, but the description and claims together *i.e.* the patent application as a whole.³

‘Plausibility’ had its origin in the EPO *AgrEvo* decision.⁴ This decision didn’t explicitly allude to the term plausibility. *AgrEvo* set out that while testing the ‘inventive step’, the technical issue comprehended over the entire extent of the claim must be reasonable or credible. In this case, the court noted that the claim for a group of chemical compounds cannot be objected to solely on the ground that the description does not contain sufficient information in order to make it credible that an alleged technical effect is obtained by all the compounds so claimed. The term “plausibility” was coined in the case of *Johns Hopkins*.⁵ The decision sets out that a technical impact depended on to show inventive step must be made conceivable by the description.

The case of *Conor Medsystems Inc. v. Angiotech Pharmaceuticals Inc.*,⁶ concerned a patent asserting the utilisation of taxol-covered stents to forestall restenosis. The traditional method for stent implant will result in proliferation of muscle cells which block the artery, leading to the condition of ‘Restenosis’. An anti-angiogenic agent was claimed which can be used to prevent tissue growth in the said condition. The court analysed the case and cited that there was no dispute

²Convention on the Grant of European Patents (European Patent Convention) art. 54(5), Oct. 5, 1973, 1065 U.N.T.S. 199. (“Paragraphs 2 and 3 shall also not exclude the patentability of any substance or composition referred to in paragraph 4 for any specific use in a method referred to in Article 53(c), provided that such use is not comprised in the state of the art.”) [hereinafter “**European Patent Convention**”]

³*European Patent Convention*, art.83. (“The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.”)

⁴Case T-0939/92, AGREVO/Triazole herbicides, 1995, ECLI:EP:BA:1995:T093992.19950912.

⁵Case T-1329/04, Factor-9/John Hopkins, 2005, ECLI:EP:BA:2005:T132904.20050628.

⁶Conor Medsystems Inc v. Angiotech Pharmaceuticals Inc., [2008] RPC28.

about the expert's way of teaching the patent and the claims can be substantiated even in the absence of experimental data. The case put forward the term 'plausibility' before the UK courts. The court validated the patent as the specification didn't need to contain data to support this invention if it made the invention plausible, which it did. The decision led to a two-stage test: (i) first the court will check if the plausibility test is satisfied, and then (ii) the court will proceed to determine whether the patent is obvious according to established UK law.

B. PLAUSIBILITY IN THE CONTEXT OF ENABLEMENT

The most interesting developments regarding plausibility in relation to pharmaceutical patents have been in the context of enablement. To meet the criteria of enablement, the specification must sufficiently disclose the invention for it to be performed by a person skilled in the field. The leading case on plausibility in context of enablement is the *Regeneron case*⁷ traced from England and Wales. In this case, the Court held that a patentee doesn't need to show that an invention works over the full extent of the claim; rather, it must be conceivable or plausible that it works considerably across the claim to the full extent. If it is possible to predict that the invention works across the claim by trying to club the products and methods claimed by a common principle, then the patentee need not demonstrate the working of the invention in every case. If such a forecast is not possible, then the claim will be insufficient.

The same was later summarised into a two-stage test by Mr. Justice Arnold⁸ as follows:

“The first stage is to determine whether the disclosure of the Patent, read in the light of the common general knowledge of the skilled team, makes it plausible that the invention will work across the scope of the claim. If the disclosure does make it plausible, the second stage is to consider whether the later evidence establishes that in fact the invention cannot be performed across the scope of the claim without undue burden. In some cases, it is convenient to divide the second stage into two, first considering whether the invention can be performed without undue burden at all and then whether the claim is of excessive breadth.”

Therefore, whether a specification makes the claimed invention plausible is a threshold test where it enables the person skilled to “make a reasonable prediction that the invention will work with substantially everything falling within the claim.”⁹

⁷Regeneron Pharmaceuticals Inc., Bayer Pharma AG v. Genentech Inc., [2013] EWCA (Civ) 93.

⁸Warner-Lambert Company LLC v. Generics (UK) Ltd and Ors., [2006] EWCA (Civ) 1006.

II. ENABLEMENT AND PLAUSIBILITY IN BIOTECH SECTOR

Enablement and Plausibility are topics that are frequently debated within the biotech sector. Some precedents in the pharma sector have built up the current status around how plausible the technical effect of an invention must be at the filing date of the patent application. In relation to medical use patents, the Technical Board of Appeal held in *Salk*¹⁰ that the claimed medical effect must be made plausible by the disclosure of the patent.

What level of disclosure satisfies the plausibility threshold is an important point to be considered. To this end, the threshold of plausibility might be fulfilled by the exposure of *in vitro* information, where such disclosure shows a clear and acknowledged connection between the impacts of the asserted compound and the target disease being referred to. The Court of Appeal agreed with the TBA and confirmed that a patentee must show, for example by appropriate experiments, that the product has an effect on a disease process so as to make the claimed therapeutic effect plausible.¹⁰ It would be a burden for the patentee to show that the referred compound has endorsement as a medication.

In the Regeneron case, the issue was concerned with the application of revocation of Genetech's patent and a declaration of non-infringement on the product of Regeneron i.e. VEGF Trap Eye, which was intended to treat age-related macular degeneration of eye. The patent was attacked on the basis of insufficiency in two ways: that the claims extended to a very wide class of diseases, namely all non-neoplastic neo-vascular diseases which made it impossible for a reasonable prediction that anti-VEGF therapy may be efficient in the full range of diseases (insufficiency for excessive claim breadth); and that the patent claimed all known VEGF antagonists which made it burdensome to identify which antagonist worked for which disease (classical insufficiency). When read in light of the basic general information, the patent was held to disclose a guideline of general application, which VEGF was important for neurotic angiogenesis, and it was sensible to foresee it. Therefore, the principle of general application disclosure made it plausible that the claimed VEGF inhibitors could be used to treat the wide range of non-neoplastic diseases referred to in the patent. As a result, the patent was held valid.

⁹Regeneron Pharmaceuticals Inc., *supra* note 7, p 100.

¹⁰Case T-0609/02, AP-1 Complex/ Salk Institute, 2004, ECLI:EP:BA:2004:T060902.20041027, p 9 ("The boards of appeal have accepted that for a sufficient disclosure of a therapeutic application, it is not always necessary that results of applying the claimed composition in clinical trials, or at least to animals are reported.")

III. COMPARISON OF ENABLEMENT AND PLAUSIBILITY REQUIREMENTS ACROSS DIFFERENT JURISDICTIONS

A. ENABLEMENT AND PLAUSIBILITY STANDARDS AT EUROPEAN PATENT OFFICE [“EPO”]

EPO sees the prerequisite of “plausibility” which arises during both the evaluation of ‘sufficient disclosure’ of the invention and ‘inventive step’ in proceedings before it, especially according to developments in the pharma and life sciences field. The requirements of sufficiency of disclosure may get invalidated if the invention claimed lacks reproducibility as per EPO guidelines. An innovation lacks reproducibility either in light of the fact that its ideal technical impact as communicated in the claim isn’t accomplished,¹¹ or if the technical effect isn’t expressed within the claim but is an element of the problem to be solved.¹²

EPO considered the requisite of ‘plausibility’ for sufficiency of disclosure in the case of *AgrEvo*. For this case, the Board held that the application gave information just for a few compounds to demonstrate the technical effect and that it was not plausible regardless of whether the technical effect was accomplished by all the compounds, and thus refused the application as not inventive. The EPO Board of Appeal additionally expressed that issue of plausibility when evaluating sufficiency emerges just when the technical effect is part of the claim.

In *John Hopkins*,¹³ the Board of Appeal stated that an invention should necessitate in any event, the technical problem is made conceivable by the disclosure that it’s instructing to be sure takes care of the problem it implies to solve. Without any information in the application, the Board of Appeal took the view that post-published proof to illustrate that the specific technical issue is tackled, can be taken into consideration only if it is made plausible from the original disclosure that the problem is indeed solved.

In this way, for post-published evidence to be considered, it is important to set up whether the declared invention has been made adequately conceivable at the effective date of filing the patent. The reason for this appraisal is the application as filed and the regular general

¹¹ European Patent Convention, art.83 (“The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.”)

¹²*Id.* at art 56 (“An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents shall not be considered in deciding whether there has been an inventive step.”)

¹³ *John Hopkins*, *supra* note 5.

information on the individual skilled in the art at the priority date. The various precedents reinstating this principle include *Pancreatic cells/IPSEN*,¹⁴ *Arch Development et al.*,¹⁵ *Conju Chem Biotechnologies Inc.*,¹⁶ *Dasatinib/ Bristol-Myers Squib.*¹⁷ It appears that regardless of whether a claim is non-obvious as for or without any prior art, the EPO could still reject a case on the off chance that it isn't conceivable at the date of filing that the invention does solve the problem it intends to solve.

The EPO gives off an impression of being more exacting with the prerequisite of plausibility and thus it is advisable to provide as much information as possible with respect to technical advantage, including any trial information, at the date of documenting.

B. ENABLEMENT AND PLAUSIBILITY STANDARDS AT UK PATENT OFFICE

Plausibility here pops in the context of sufficiency, inventive step, novelty, entitlement to priority and industrial applicability. Plausibility is especially pertinent to patents of medical use. Two flavours of insufficiency exist here: classical insufficiency and excess claim breadth insufficiency. The former crops up if the claimed invention cannot be performed without an excessive burden and the latter type of insufficiency relates to whether the specification enables the invention to be performed.¹⁸

In *Regeneron Pharmaceuticals Inc. and Bayer Pharma AG v. Genentech Inc.*,¹⁹ Kitchen LJ summarised that the assertion that the invention will work across the scope of the claim must be plausible or credible. If it is possible to predict that the invention works across the claim by trying to club the products and methods claimed by a common principle, then the patentee need not demonstrate the working of the invention in every case. If such a forecast is not possible, then the scope of the monopoly will exceed the technical contribution the patentee has made to the art and the claim will be insufficient.

¹⁴ Case T-0578/06, *Pancreatic Cells/IPSEN*, 2011, ECLI:EP:BA:2011:T057806.20110629.

¹⁵ Case T-1642/07, *Viral Enhancement Of Cell Killing/ Arch Development Corporation et al.*, 2010, ECLI:EP:BA:2010:T164207.20101202.

¹⁶ Case T-433/05, *Fusion Peptide Inhibitors/CONJUCHEM*, 2007, ECLI:EP:BA:2007:T043305.20070614.

¹⁷ Case T-0488/16, *Dasatinib/Bristol Myers Squib*, 2017, ECLI:EP:BA:2017:T048816.20170201.

¹⁸ Zack Mummery, *Plausibility in UK*, REDDIE & GROSE (June 16, 2016), <http://www.reddie.co.uk/2016/06/27/plausibility-in-the-uk>.

¹⁹ *Regeneron Pharmaceuticals Inc. v. Genentech Inc* [2012] EWHC (Pat) 657.

With respect to patents of second medical use, while thinking about plausibility and enablement, the specification must make it believable that a specific medication is viable for claimed condition's treatment.

In *Generics (UK) Ltd (t/a Mylan) v. Warner-Lambert Company*,²⁰ a claim pointed to Pregabalin for use in treating torment was inadequate in light of the fact that there was no premise that made it conceivable that Pregabalin can be used for a wide range of pain.

In *Actavis v. Eli Lilly*,²¹ plausibility was brought by Actavis in regard to adequacy and inventive step. Actavis contended that the test for credibility with regards to adequacy is equivalent to the test for 'reasonable expectation of success'. The court held that plausibility doesn't form a separate ground of issue with the legitimacy of patents. The same is restored in the case of *GlaxoSmithKline UK Ltd. v. Wyeth Holdings LLC*.²²In this case, plausibility was considered with respect to insufficiency and the test of credibility was reinstated.

C. ENABLEMENT AND PLAUSIBILITY STANDARDS AT US PATENT OFFICE

The enabling requirement of specification is set forth in 35 U.S.C. §112. The US patent office requires that an application must contain a written description of the invention and an enabling disclosure so that a person skilled in the art can carry out the invention without undue experimentation. It is also desirable that the applicant/inventor provides a disclosure of the best mode as contemplated by him at the time of filing.

The US jurisprudence shows many instances where the questions of enablement and plausibility have been raised in conjunction with robust written description requirements particularly in cases of patents from biopharmaceuticals and diagnostics sectors. In *Promega Corp. v. Life Technologies Corp.*,²³the court emphasised the fact that it must be sensible or conceivable for the individual of average skill in the pertinent zone of innovation to expect that the invention works depending on the data contained in the patent application. In *Amgen, Inc. v. Hoechst Marion Roussel Inc.*,²⁴ and *Regents of the University of California v. Eli Lilly*,²⁵it was held that an enabling disclosure of how to make a product must be sufficiently described in the complete specification. In the case of

²⁰Generics (UK) Ltd (t/a Mylan) v. Warner-Lambert Co., LLC [2015] EWHC (Pat) 2548.

²¹Actavis v. Eli Lilly, [2015] EWHC (Pat) 3294.

²²GlaxoSmithKline UK Ltd. v. Wyeth Holdings LLC [2016] EWHC (Ch) 1045.

²³Promega Corp. v. Life Techs. Corp., 875 F.3d 651 Fed. Cir. (2017).

²⁴Amgen, Inc. v. Hoechst Marion Roussel Inc., 314 F.3d 1313, 1330 (2003).

²⁵Regents of the University of California v. Eli Lilly, 119 F.3d 1559, 1568 Fed. Cir. (1997).

proteomics (the study of proteomes or proteins on a large scale) and genomics (the study of genomes or genes) inventions, the written description and enablement requirement has emerged as a major constraint. In a biopharmaceutical patent, the amino acid sequence for a protein corresponding to a gene and cloning procedure may satisfy the enabling requirement but not the written description standard. Similarly, patent applications with indefinite, undescribed or insufficiently described and non-enabling steps directed towards correlating the test results for establishing a basic scientific relationship is not allowed.²⁶ To address all those issues the USPTO has issued several guidelines and training manuals for examiners. For instance, the MPEP 2164 cites the enablement requirement, wherein 2164.04 particularly cites the role of the examiner. The said guidelines separately point out the case of unpredictable arts. The question of undue experimentation is one consideration where it states that it can be replaced by several factors in the case of unpredictable arts. The quantity of examples used to support the enablement is one such factor.²⁷

D. ENABLEMENT AND PLAUSIBILITY REQUIREMENTS AT INDIAN PATENT OFFICE

The Indian Patents Act, 1970 does not mention about plausibility requirement directly. However, there are certain aspects of the Indian Patent Law that indirectly hint the plausibility-related issues, such as sufficiency, industrial application and inventive step requirements as laid down in Section 2 of the Indian Patent Act.²⁸ Similarly, Section 10,²⁹ which describes the requirements of complete specifications and claims and Section 3(d)³⁰ have implicit effects on the concept of plausibility. In India, when a patent claims more than one form of compounds, all the compounds should have some technical relationship explicitly described in the specification. A claim directed towards a new form of known substance must be supported by experimental evidence and comparative studies proving its enhanced efficacy. In India, methods of treatment and second use of therapeutics are not allowed. So, while claiming any protein or modified gene not only the functional features but also their structural and technical features which confers the novelty and non-obviousness to the invention becomes important. There are many instances

²⁶Laboratory Corporation of America Holdings v. Metabolite Laboratories Inc, 548 U.S 124 (2006).

²⁷In Re Wands, 858 F.2d 731, 737 Fed. Cir. (1988). (In this case, the court concluded that undue experimentation would not be required to practice the claimed immunoassay using monoclonal antibodies to detect hepatitis B-surface antigen as the invention seemed plausible.)

²⁸§2, Patents Act, No. 39 of 1970, INDIA CODE (1970), Act ID 197039, <https://www.indiacode.nic.in/handle/123456789/1392?locale=en>.

²⁹*Id.* §10.

³⁰*Id.* §3(d).

where Indian patent office has rejected patent applications as the technical and structural effect of the claimed sequences are not described in the specifications (Forexample, in Application nos. 3411/DELNP/2006, 6845/CHENP/2010, 1161/KOLNP/2011).

In order to simplify the process of examining biotech patents, the extent of disclosure and clarity in claims the IPO had issued guidelines for examining biotech patents.³¹ As per Indian patent examining practice, the claims and disclosure should be mutually supportive. While evaluating the sufficiency of disclosure, the examiner checks the presence of at least one complete disclosure for enabling the invention as portrayed in the claims, and not just a piece of it. The disclosure should enable a skilled individual in the pertinent art to work out the same invention without the undue burden of experimentation or the utilisation of innovative inventiveness. On the off chance, the disclosure is insufficient if the skilled person going by the specification needs to discover something new to enable the innovation. An inventor cannot claim an array of unrelated diseases/ailments as potential future diagnostic targets against a claimed gene or protein without experimenting or characterising that protein against the diseases. Even if the gene's association with one disease is ascertained, it is unlikely that that gene will have a role in all other claimed diseases. In absence of proper evidence to support the use of the gene in the other unrelated diseases claimed, the specification would be treated as insufficient. When claims seek to protect things that are in the scope of potential future discoveries and not yet into being at the time of filing, such claims are not patentable on the ground of insufficiency. There can be innumerable variants of polynucleotides or polypeptide sequences, in the form of additions, substitutions or deletions. A claim towards polynucleotides must be restricted to variant sharing common specificity as described in the specification. For DNA sequences hybridising with a particular probe and possessing certain activity, the specification must disclose the hybridisation conditions. The absence of the conditions may render the application to be cancelled.

In *Raj Prakash v. Mangatram Chowdhury*,³² it was observed that a complete specification must describe 'an embodiment' of the invention claimed in each of the claims and the description must be sufficient to enable those in the industry concerned to carry it into effect without their

³¹ Office Of The Controller General Of Patent, Design And, Trade Marks, *Guidelines for Examination of Biotechnology Applications of Patents* (Mar. 2013), available at: http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_38_1_4-biotech-guidelines.pdf.

³² *Raj Prakash v. Mangatram Chowdhury*, AIR 1978 Del 1 (India).

making further inventions “and the description must be fair, i.e. it must not be unnecessarily difficult to follow.”³³

The IPO has also issued guidelines for the examination of pharmaceutical patents where the scope or ambit of claims is generally broader than the other fields of technology.³⁴ In pharmaceutical patents, the specification ought to contain at least one model covering the whole scope of the invention as claimed which empowers the skilled individual in the pertinent art to perform the innovation. In the event that the invention is related to the product per se, portrayal will be upheld with models for all the compounds claimed techniques for planning or trial information incorporated. Test boundaries, method of medication conveyance, results with clarification and derivation can be given. On the off chance of more than one pharmaceutical use for an application, the significant test ought to be supplemented.

Plausibility *per se* a requirement has not been considered by Indian courts. However, in other jurisdictions, it is a matter of contention in many cases. Some of the major cases and the plausibility definitions given in those are listed below.

IV. EVOLUTION THROUGH CASES

In the case of *Human Genome Sciences, Inc. v. Eli Lilly & Co.*,³⁵ it was held that the patent must uncover a practical application for the asserted item and that a conceivable or sensibly dependable claimed use or even an educated guess as to such a utilisation could be adequate for that reason. A separating line between “plausibility” and “educated guess” as against “speculation” attracted the case.

The case emphasised the need of a plausible disclosure in terms of industrial applicability. The degree of plausibility varies with regard to the facts and circumstances of each case. The case foresees the problems with respect to speculative or upstream patenting. This case is an apt guide of the “don’ts” to patentees who put forward speculative claims as of the compound’s future use. The case cited that if the patentee fails to give plausible disclosure of industrial application, then the patent may be invalidated.

³³*Id.* at 9.

³⁴ Office of the Controller General of Patent, Design and, Trade Marks, *Guidelines for Examination of Patent Applications in the field of Pharmaceuticals* (Oct., 2014), http://www.ipindia.nic.in/writereaddata/Portal-IPOGuidelinesManuals/1_37_1_3-guidelines-for-examination-of-patent-applications-pharmaceutical.pdf.

³⁵*Human Genome Sciences Inc. v. Eli Lilly & Co.* [2010] EWCA Civ. 33.

In the case of *Warner-Lambert Company LLC v. Generics (UK) Ltd. (trading as Mylan) and Ors.*,³⁶ it was established that the requirement of plausibility is a low threshold test, which is intended to prohibit speculative claiming. The patentee should illustrate that the claimed efficacy is credible with help of scientific reasons rather than mere assertions. This calls for the need to support second medical use claims with adequate disclosure. Unless a reasonable amount of plausibility is proved with respect to the new use, the patentee cannot claim a monopoly over it.

The Court, in *Merck v. Shionogi*,³⁷ laid a two-phase enquiry. The principal step is to decide if the specification, read in the light of the common general information of a skilled person, makes it conceivable that the creation will work over the extent of the claim. At this stage, it is not permissible for the patentee nor the opponent to depend upon proof which post-dates the patent. On the off chance that the disclosure makes it plausible, the subsequent stage is to consider whether the proof sets up that in certainty the innovation can't be performed over the extent of the claim without undue burden. At times, it is advantageous to isolate the second stage into two sections, first thinking about whether the innovation can be performed without unnecessary burden at all and afterward whether the claim is of exorbitant broadness. At this stage, proof which postdates the patent is permissible.

It was observed in the case of *Salk*,³⁸ that it is necessary that the patent gives some information as to the profit that the asserted compound directly affects a metabolic instrument explicitly engaged with the disease. When this proof is accessible from the patent application, at that point post-published expert evidence might be considered. However, it can't be only looked into the 'adequacy of disclosure' test, but as to back-up the discoveries in the patent application in relation to the use of the ingredient as a pharmaceutical.

In the *John Hopkins* case,³⁹ the term 'plausibility' was in the limelight. Here, plausibility was seen as a threshold for the test of both, the inventive step and sufficiency. It was viewed in the context of technical contribution and had set a standard to plausibility. The emerging standard in the case is that the application must make it at least plausible that it's teaching indeed solves the technical problem it purports to solve. The court in this case emphasised the importance of post published evidence to support the claimed subject matter. Such evidence can serve valid only in

³⁶Warner-Lambert Company LLC v. Generics (UK) Ltd. (trading as Mylan) and Ors. [2016] EWCA (Civ)1006.

³⁷ Merck v. Shionogi [2016] EWHC (Pat) 2989.

³⁸ Salk Institute, *supra* note 10.

³⁹ John Hopkins, *supra* note 5.

the absence of any supporting data demonstrating the technical effect and if it is already credible from the original disclosure that the problem is indeed solved. In such cases, it may still be possible to demonstrate plausibility based on prior art or common general knowledge.

In *Regeneron Pharmaceuticals Inc. and Anr. v. Genentech Inc.*,⁴⁰ it was held that it must be conceivable to make a reasonable expectation the invention will work with considerably everything falling inside the extent of the claim. If it is possible to predict that the invention works across the claim by trying to club the products and methods claimed by a common principle, then the patentee need not demonstrate the working of the invention in every case. If such a forecast is not possible, then the scope of the monopoly will exceed the technical contribution the patentee has made to the art and the claim will be insufficient.

The Court, in *Actavis v. Eli Lilly*,⁴¹ held that plausibility is a threshold test that is fulfilled by a disclosure which is “credible” as opposed to speculative. A conceivable invention may in any case be demonstrated to be inadequate. The norm for appraisal of plausibility isn’t the equivalent to the norm for evaluation of expectation of success in the context of obviousness. The case laid the standard that, the test of plausibility is different from the test of sufficiency and inventive step and can be used in aid for the test of the latter two.

V. CONCLUSION

Plausibility is not a new requirement. It is a test that assists granting/judicial instances to evaluate whether and to what extent the patent applicant/holder is in possession of the invention. It is something different from the written description requirement. It seems to have become a useful instrument to tackle patents that are unduly broad, speculative, lack experimental support for effects allegedly achieved. It seems to discourage “armchair patents”. It is likely to force patent applicants to provide more detail and evidence in patent applications for scope and effects claimed. It is a useful instrument to make the scope of the patent commensurate with what is disclosed. It is likely to cast doubt over practices where one relies heavily on post-published evidence without much more in the application as filed.

Even though for active substances per se, less evidence needs to be provided, if it is not plausible that the compound has the purported therapeutic activity, the objective technical problem to be solved may have to be redefined. But in doing that, there is a risk of falling into the lack of

⁴⁰ *Regeneron Pharmaceuticals Inc., supra* note 7.

⁴¹ *Actavis v. Eli Lilly* [2015] EWHC (Pat) 3294.

inventive step trap. It can present difficulties for some early-stage patents, where there is not yet a lot of experimental evidence, but it is equally not warranted to wait longer with patent filing. The concept of plausibility is seemingly being developed as a separate test, be it or not as part and parcel of already existing patentability requirements, or as an emerging separate patentability requirement.

With increasingly more patents of second medical use currently being disputed, plausibility will stay a popular assault for claiming insufficiency or lack of inventive step. Recent decisions have perhaps begun to get control over the degree to which plausibility can be utilised to assault patentability. Further advancements are probably going to follow, so watch this space. It would also appear that the hurdle for plausibility is not as high as many feared it had become. The authors hope that a relatively low or justifiable threshold test for plausibility continues to be applied by the court going forward. A balance must be struck between plausibility and enablement requirements given that new research, particularly new medical uses of existing pharmaceuticals need to be encouraged in light of the difficulties that currently the pharmaceutical industry faces in the identification of new (bio)chemical compounds suitable for drug development .

THE LEGAL DIALECT OF NLP: BHARAT NLP & AIFORALL

SHARAN A. BHAVNANI*

ABSTRACT

Information & Communications Technologies (ICT) have displayed the potential to act as an agent for social and economic development. There are two aspects to enabling such development. The first, access to ICT; second, access through ICT. Thus, to empower the poor and help alleviate poverty, ICT must not only be easily available but also make accessible other existing information and knowledge. Recognising this, NITI Aayog released the National Strategy Paper on Artificial Intelligence which lays out the Bharat Natural Language Processing Program. This program accounts for the vibrant and pluralistic nature of India and establishes a rudimentary framework of access to and through ICT by the use of various vernacular languages. This framework is assessed by first, exploring the Indian legal framework, and second, the international framework to unpack India's international obligations. The domestic legal architecture of intellectual property rights has gaps in accounting for software that deploys Machine Learning and Natural Language Processing requiring vast corpora of datasets. The paper makes the case for viewing the use of such datasets within the "fair dealing" exception enumerated in the Indian Copyright Act, 1957. It also highlights the limitations of the Indian legal framework and makes policy recommendations for the commercial use these vernacular corpora of data for the Bharat NLP Program, to overcome these limitations in the short and long term.

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I. INTRODUCTION

More than mere material deprivation, poverty is a product of one's exclusion from the access to information and knowledge.¹ With the exponential growth of Information & Communication Technologies ["ICTs"], an undeniable nexus with alleviating poverty has emerged.² It has the potential to foster "broader developmental impact, empowerment and income generation, and increase access to education and other social services."³ In recognition of the same, the Hon'ble Prime Minister of India Shri. Narendra Modi has expressed that "technology empowers the less empowered. If there is a strong force that brings a change in the lives of those on the margins, it is technology."⁴ There are then two aspects of access to information and knowledge. The first, access *to* ICT; Second, the access *through* ICT. Thus, to empower the poor and help alleviate poverty, ICT must not only be easily available but also make accessible other existing information and knowledge.

The National Strategy Paper on Artificial Intelligence by NITI Aayog displays data which finds that:

*"Indian language internet users are projected to account for nearly 75% of India's internet user base by the year 2021. However, the amount of digital content available in Indic regional languages is meagre compared to the expected demand: only 0.1% of internet content is in Indic languages vastly in Hindi, and the figure is far lower for dynamic contents and non-recreational resources such as news or education-oriented applications."*⁵

To further the agenda of a Digital India and use of technology to empower those who "live on the margins" of society, the NITI Aayog ["NITIP"] is tasked with designing an Artificial Intelligence ["AI"] framework, which is accessible to all Indians, irrespective of the language they speak. It seeks to achieve a part of this through the Bharat Natural Language Processing

¹Caroline M. Figuères, & Eugelink, Hilde, *The Role of ICTs in Poverty Eradication: More Than 15 Years' Experience from the Field*, http://doi-org-443.webvpn.fjmu.edu.cn/10.1007/978-1-4899-7439-6_12.

²J. May, *The ICT/Poverty Nexus*, THE UN CHRONICLE (Vol. XLVIII) (3) (2011) <https://www.un.org/en/chronicle/article/ictpoverty-nexus>.

³*Id.*

⁴ Press Release, Narendra Modi, Prime Minister, *Digital Dialogue with PM Narendra Modi*, PM-INDIA WEBSITE July 5, 2015, http://www.pmindia.gov.in/en/news_updates/digital-dialogue-with-pm-narendra-modi/?tag_term=digital-india&comment=disable.

⁵ NITI Aayog, *National Strategy for Artificial Intelligence*, INTERNATIONAL INNOVATION CORPS AND UNIVERSITY OF CHICAGO (2018), http://niti.gov.in/writereaddata/files/document_publication/NationalStrategy-for-AI-Discussion-Paper.pdf.

[“NLP”] and Machine Learning [“ML”].⁶ The Bharat NLP intends to acquire and process numerous datasets in Indic languages to bridge the increasing asymmetry between usage of Indic languages, and the availability of the same in software and technology. To form this framework, NITI intends to make indigenous and regional languages accessible to tech-based start-ups, computer science and linguistics researchers, and larger technology companies through NLP tools. In its pursuit of the same, NITI would require vast corpora of text and information to create effective NLP tools.

There are three “building blocks”⁷ of the Bharat NLP, namely, *first*, the web portal or repository that will work as a one-stop-shop for NLP resources for Indic languages; *second* a set of NLP tools to enable researchers and developers to provide digital resources in regional languages, and *third*, the language corpora datasets necessary to develop such NLP tools.

This article explores the social impact and legality of procuring and using these vast corpora of data sets by looking at successful pilot programmes, the relationship between rights and accessibility of rights, the legal position in India concerning Intellectual Property Rights, and policy recommendations to achieve the goal of a Digital India which is accessible to all.

II. ICT, ACCESSIBILITY AND SOCIAL GROWTH

The Indian Constitution expresses the aspirations of the people through the language of directive principles. The *first section* of this part explores these in the context of accessibility to and through ICT. The *second section* seeks to explore how these aspirations translate into governmental and social action. The *third section* delves into similar actions in other parts of the globe and emergent successes of using ICT for social growth.

A. CONSTITUTIONAL ASPIRATIONS AND RECOGNITIONS

The ever-growing borderless technologies have the potential to cause vast social inequalities and entrench inequities. Highlighting emerging challenges to the Right to Privacy in a globalised and technologically woven world, Hon’ble Dr. Justice D.Y. Chandrachud opined that,

⁶Li Deng, *et al.*, DEEP LEARNING IN NATURAL LANGUAGE PROCESSING (Deng, Li, Liu, Yang eds., 2018), (“Natural language processing (NLP) investigates the use of computers to process or to understand human (i.e., natural) languages for the purpose of performing useful tasks. NLP is an interdisciplinary field that combines computational linguistics, computing science, cognitive science, and artificial intelligence...NLP aims to model cognitive mechanisms underlying the understanding and production of human languages.”); See also, Ian Good fellow *et al.*, DEEP LEARNING, 2 (2016), (“The difficulties faced by systems relying on hard-coded knowledge suggest that AI systems need the ability to acquire their own knowledge, by extracting patterns from raw data. This capability is known as machine learning.”)

⁷ NITI Aayog, *supra* note 5.

*“The overarching presence of state and non-state entities regulates aspects of social existence which bear upon the freedom of the individual. The preservation of constitutional liberty is, so to speak, work in progress. Challenges have to be addressed to existing problems. Equally, new challenges have to be dealt with in terms of a constitutional understanding of where liberty places an individual in the context of social order. The emergence of new challenges is exemplified by this case, where the debate on privacy is being analysed in the context of a global information-based society. In an age where information technology governs virtually every aspect of our lives, the task before the Court is to impart constitutional meaning to individual liberty in an interconnected world.”*⁸

However, the use of ICT as a tool, by the State for social development rather than letting it be a medium for the same, causes inequality and this is guided by the Directive Principles of State Policy, where the State,

*“shall strive to promote the welfare of the people by securing and protecting as effectively as it may a social order in which justice, social, economic and political, shall inform all the institutions of the national life. In particular, strive to minimise the inequalities in income, and endeavour to eliminate inequalities in status, facilities and opportunities, not only amongst individuals but amongst groups of people residing in different areas or engaged in different vocations.”*⁹ (emphasis added)

Harold Laski in his notable work, ‘The Grammar of Politics’, states that “the freedoms I must possess to enjoy a general liberty are those which, in their sum, will constitute the path through which my best self is capable of attainment.”¹⁰ The path to the “best self” may only be attained when the path is paved with general liberties and rights; but more importantly, this path must be accessible to all to exercise these general liberties. This is only possible when one has the accessibility to mechanisms that enhance rights and social growth.

B. TRANSLATING CONSTITUTIONAL ASPIRATIONS INTO POLICIES AND ACTION

⁸ Justice K.S. Puttaswamy (Retd.) v. Union of India, (2014) 6 SCC 433, Opinion of Justice D.Y. Chandrachud.

⁹ Constitution of India, art. 38 (1950).

¹⁰ HAROLD J. LASKI, A GRAMMAR OF POLITICS, 144 (1925).

In 1995, Heads of States and Government from 117 nations emphasised the role of new information technologies in poverty alleviation and realisation of social developmental goals in Copenhagen; recognising the need for countries to facilitate access to such technologies.¹¹

With the leaps made in information technology since 1995, the Government of India in 2014 conceived the broad goal of creating a Digital India. The Government – guided by Article 38 of the Indian Constitution and its recognition of the role of ICT in social growth– has initiated the linking of various subsidies through the implementation of the Aadhar programme at the very grassroots.¹²

This has made the system of the Government efficient and ensures the timely and effective use of provisions of social benefits through the use of ICTs. Within this broader agenda of a Digital India is the Government’s concentration on emergent technologies such as AI, which can make ground-breaking changes at the grassroots level in ensuring social growth in several aspects.¹³

Uncontestably, the use of ICT in a broad gamut of languages, which are accessible to all, can lead to the vast social and educational development of marginalised communities.¹⁴ Where “recent developments in Information and Communications Technologies (ICTs) can make to the management of multilingualism and how local languages can be used to make education a lever of development”¹⁵ is only one of the ways to use ICTs to fillip development, including educational development.

That being said, most information available and/or programmes developed through ICT for education and socio-economic growth is available only in English.¹⁶ India being linguistically diverse must necessarily make access to existing and new technologies through a multilingual

¹¹ Rep. of the World Summit for Soc. Dev., UN DOC A/CONF.166/9 (1995), (“States in their Copenhagen Declaration on Social Development and Programme of Action of the World Summit for Social Development went on to, “Recognize that the new information technologies and new approaches to access to and use of technologies by people living in poverty can help in fulfilling social development goals; and therefore recognize the need to facilitate access to such technologies”).

¹² Ministry Of Consumer Affairs, Food & Public Distribution, *Linking of Aadhaar with PDS*, PRESS INFORMATION BUREAU, Feb. 4, 2020, <https://pib.gov.in/PressReleasePage.aspx?PRID=1601866>.

¹³ Michael Chui *et al.*, *Applying artificial intelligence for social purposes: Discussion Paper*, MCKINSEY GLOB. INST., (2018), <https://www.mckinsey.com/featured-insights/artificial-intelligence/applying-artificial-intelligence-for-social-good>.

¹⁴ Paulin. G. Djité, *The nexus between education, learning, and language*, UNESCO CONFERENCE ON “GLOBALIZATION AND LANGUAGES: BUILDING ON OUR RICH HERITAGE” (2008), http://archive.unu.edu/globalization/2008/files/UNU-UNESCO_Dijite.pdf.

¹⁵ *Id.*

¹⁶ KPMG India & Google, *Indian Languages- Defining India’s Internet*, (2017) <https://assets.kpmg/content/dam/kpmg/in/pdf/2017/04/Indian-languages-Defining-Indias-Internet.pdf>.

platform. This has been recognised by the Government with the Hon'ble Minister of Electronics and Information Technology Shri. Ravi Shankar Prasad stating "the language of the internet cannot be English and English alone. It must have linkages with the local and local means local languages. I appeal to make local languages available for more Internet users."¹⁷

The Government has recognised the need for ICT tools for seamless translation from English to vernacular languages. This can be seen in the establishment of the MANTRA software by the Department of Language, which allows the accurate translation of English documents into Hindi using NLP. This NLP programme is used by "various departments and ministries of the government to procure quick and standard Hindi translations of English documents."¹⁸ The contextual nature of the translation has made these documents available to a large segment of Hindi speakers across the nation, let alone the institutions of the Government thereby increasing efficiency in Government functioning.

Another such instance in India is the use of NLP and Optical Character Recognition to provide the visually challenged with audio descriptions of their immediate surroundings.¹⁹ The programme, DRISHTI, pioneered by Accenture and the National Association of Blind in India, makes accessibility to the visually challenged easier, which is a right guaranteed under the Constitution of India and various legislations.²⁰ This programme is also being developed in Spanish for its use in Argentina.²¹ The use of such technology in India has also been deployed by inter-governmental agencies like the World Bank.

For inclusive growth through deliberation and participation by women in forums of local decision-making, the World Bank conducted a study in 2017, in Indian villages using NLP to assess the quality of participative democracy. The purpose of the study was to explore "whether and to what extent...forms of dominance — of men over women... affect deliberative institutions in practice" In order to assess this on a large scale, the study used "Natural Language Processing (NLP, or text-as-data) methods to an original corpus of village assembly transcripts

¹⁷ P. Hegde, *Protecting Language Diversity in India*, PRESS INFORMATION BUREAU, Govt. of India, (2017), <http://pib.nic.in/newsite/mbErel.aspx?relid=158532>.

¹⁸Centre for Development and Advanced Computing MANTRA Rajbhasha, available at: https://www.cdac.in/index.aspx?id=mc_mat_mantra_rajbhasha.

¹⁹*Defying Limits*, ACCENTURE LABS ANNUAL REPORT (2017) https://www.accenture.com/t20180221T1937-48Z__w_/us-en/_acnmedia/PDF-70/Accenture-Labs-2017Report-Digital.pdf.

²⁰Convention on the Rights of Persons with Disabilities, Dec.13,2006, UNITED NATIONS A/RES/61/106 (2006).

²¹ Accenture News Release, *Accenture Develops Artificial Intelligence-Powered Solution to Help Improve How Visually Impaired People Live and Work* July 28, 2017, <https://newsroom.accenture.com/news/accenture-develops-artificial-intelligence-powered-solution-to-help-improve-how-visually-impaired-people-live-and-work.htm>.

from rural India to systematically examine variation in the quality of deliberation [and] examine the relationship between deliberative influence and the gender or position (citizen versus official) of a speaker.” Using NLP methods, the study could “quantitatively examine not only the relative floor time enjoyed by different types of speakers but also their ability to influence the topic of conversation (agenda-selling power) and to make claims on state officials (responsiveness of the state).” With these ICT methods emerged a clear depiction of the challenges faced in the grassroots governance. The study found that despite the high rates of attendance of women in village-assemblies, they were “*indeed the silent sex.*” This was seen through the disparity between their average attendance (58%) and the available floor time (33%). It also found that “when women do speak on a particular topic, they are significantly less likely than men to elicit a topical or relevant response from state officials — suggesting a meaningful inequality in deliberative influence across the sexes....for any given topic, a man is more likely to get a response from an official than a woman.”²² These findings provide valuable insight into the efficacy of democratic institutions and the extent of women’s participation in a participatory democracy.²³

C. ENCOURAGING GLOBAL DEVELOPMENTS

The use of ML and NLP has shown encouraging results, not only in Indian Governmental institutions (to a limited extent) but also across different parts of the globe.

For instance, students from the Jomo Kenyatta University of Agriculture and Technology (JKUAT) in Kenya developed the “SophieBot”.²⁴ This application bridges the information asymmetry by translating information on women’s sexual and reproductive health, from English to Swahili. This also helped in further disseminating vital information about health and reproductive rights in Kenya, thereby promoting a favourable environment for the protection of human rights and the realisation of Sustainable Developmental Goals.²⁵

²² Ramya Parthasarthy et al., *Deliberative Inequality: A Text-As-Data Study of Tamil Nadu’s Village Assemblies*, 2-3, WORLD BANK GROUP POL’Y RES. WORKING PAPER NO. 8119, (2017), <http://documents.worldbank.org/curated/en/582551498568606865/pdf/WPS8119.pdf>.

²³ The Convention on the Elimination of all Forms of Discrimination Against Women (CEDAW), UNITED NATIONS A/RES/34/180 (1981).

²⁴ Department of Information Technology, *Sophie Bot Sexual Reproductive Health app*, JOMO KENYATTA UNIVERSITY OF AGRICULTURE AND TECHNOLOGY, <http://www.jkuat.ac.ke/departments/it/sophie-bot-sexual-reproductive-health-app/>.

²⁵ UNFPA Announces Winners of Innovation Accelerator Focused On Promoting Youth Sexual Reproductive Health and Rights, UNITED NATIONS POPULATION FUND AGENCY (UNFPA), AUG. 12, 2016, <https://kenya.unfpa.org/en/news/unfpa-announces-winners-innovation-accelerator-focused-promoting-youth-sexual-reproductive>.

In Nigeria, a start-up using ML and NLP developed software called “Kudi.AI” which makes e-banking and digital payments accessible to many people in English and to an extent in Pidgin (the native language) through the use of NLP to contextualise the queries and actions by users.²⁶ This comes in the wake of Governmental support along with the Presidential approval for the creation of an AI and Robotics Authority.²⁷ This entrepreneurial drive along with the broad framework provided by the Government makes for inclusive and equitable growth of a country.

These are only a few examples of the use of ML and NLP, which have enhanced access to various socio-economic and civil rights. Various other avenues can be traversed with the use of AI to achieve numerous Sustainable Developmental Goals.²⁸

In the implementation of AI such as ML and NLP in India, especially the acquisition of vast swathes of data and text could lead to certain domestic legal challenges. This shall be explored in the next section through analysing the intersection of rights and accessibility of rights – within the India and International frameworks. Further, this section shall analyse the specific copyright issues within India and ultimately make policy recommendations.

III. RIGHTS AND ACCESSIBILITY

People have the right to hold aspirations and to acquire information and knowledge. Given the culturally vibrant and pluralistic nature of India, it is important to assess the efficacy of access to and through ICT via the use of various vernacular languages. This shall be assessed by *first*, exploring the Indian legal framework which makes clear these aspirations, and *second*, the international framework to unpack the kinds of obligations a State must follow.

A. INDIAN FRAMEWORK

The Preamble to the Indian Constitution secures unto the citizens of India- Justice, Liberty, Equality and Fraternity to ultimately ensure social, economic, political, personal, and collective growth.²⁹ The conception of justice, equality of opportunity and fraternity ensuring the unity and integrity of the nation can only be attained when there is unfettered access to the rights and ideals guaranteed under our Constitution. One aspect is accessibility to institutions of the State to

²⁶KUDI WEBSITE, available at: <https://kudi.co/>.

²⁷ Nnamdi Akpa and Abakaliki, *Buhari approves artificial intelligence agency for South East*, THE GUARDIAN Aug. 6, 2018, <https://guardian.ng/news/buhari-approves-artificial-intelligence-agency-for-south-east/>.

²⁸ Chui, *supra* note 13.

²⁹Constitution of India, Preamble (1950), (“The Constitution guarantees unto citizens, Justice, Social, Economic & Political; Liberty of thoughts, expression, belief, faith and worship; Equality of status and of opportunity and promote among them all; Fraternity, assuring the dignity of individual and the unity and integrity of the nation.”).

secure justice and enforce rights for a dignified life.³⁰ Another aspect is the right to information and freedoms of speech and expression, which is accessible to all. In addition to the nexus between ICT and social development, there lies a nexus between the accessibility of rights and language.³¹

The Supreme Court of India, in interpreting Article 19(1)(a) observed that the provision aims at “promoting the dissemination of ideas, information and knowledge to the masses so that there may be an informed debate and decision making on public issues.”³² Naturally, this dissemination is only effective when it is available to all, irrespective of the language they speak in. A step towards the creation of this accessibility through various means and languages can be seen in the multitude of legislative and policy measures undertaken by the state. For instance, the Right to Information Act, 2005 specifies in Section 4 that “All materials shall be disseminated taking into consideration the local language”

Another instance is the development of the National Policy on Universal Electronic Accessibility by the Ministry of Electronics and Information and Technology, in 2007.³³ The policy is based on barriers which differently-abled individuals face. This policy, grounded in the Constitution of India and guided by several International covenants,³⁴ created enough traction to lead to an Amendment in the Copyright Act, 1957 in the year 2012.³⁵ The amendment created an exception for braille or any other format, which would help the visually impaired in accessing any work with copyright.³⁶ We see that the National Language Policy seeks to be “pluralistic in its scope” and intends to “help all languages to develop into fit vehicles of communication at their

³⁰ Anita Kushwaha and Ors. v. Pushap Sudan, AIR 2016 SC 3506 (India).

³¹ T. Skutnabb-Kangas, *Role of Linguistic Human Rights in Language Policy and Planning*, THE ENCYCLOPAEDIA OF APPLIED LINGUISTICS (C. Chapelle ed., 2012), DOI: 10.1002/9781405198431.wbeal1026.

³² Union of India v. Motion Pictures Association, (1999) AIR 1999 SC 2334 (India).

³³ Ministry of Electronics and Information Technology, *National Policy on Universal Electronic Accessibility*, (2007), <https://meity.gov.in/writereaddata/files/National%20Policy%20on%20Universal%20Electronics%281%29.pdf>.

³⁴ *Id.* at 2 (“The United Nations Convention for the Rights of Persons with Disabilities ratified by India on October 01, 2007 (UNCRP D - Article 9 and others). (iii) Persons with Disabilities (Equal Opportunities, Protection of Rights and Full Participation) Act, 1995. (iv) The Proclamation on the Full Participation and Equality of People with Disabilities in the Asia Pacific Region, 1993. (v) The Biwako Millennium Framework for action towards an inclusive, barrier free and rights based society, 2002. (vi) National Policy for Persons with Disabilities of the Government of India (2006).”).

³⁵ Copyright (Amendment) Act, 2012, No. 27, Acts of Parliament, 2012 (India).

³⁶ Copyright Act, No. 14 of 1957, §52(zb), (India).

designated areas of use, irrespective of their nature or status like major, minor, or tribal languages.”³⁷

The role of languages as a facilitator rather than a barrier helps in achieving Constitutional guarantees and socio-economic growth, and is also visible within the Constitutional framework. All persons are entitled to make a representation to any authority or officer of the Union or State in “any language used in the Union or State”³⁸ to have their grievances redressed. Further, regarding linguistic minorities, all States and local authorities shall endeavour to “provide adequate facilities for instruction in the mother-tongue at the primary stage of education to children belonging to linguistic minority groups”³⁹ and the President appoints a Special Officer for Linguistic Minorities who is tasked with the safeguarding of such minorities.⁴⁰

With 22 Official Languages, and one Associate Official Language in Schedule VIII of the Indian Constitution, the plurality and linguistic diversity make up a truly federal India, the legal and policy framework makes it clear that the language is essential for access to rights and enforcement of the same. India, like many nations with linguistic diversity, is a party to various international covenants and declarations which reinforces this link.

B. INTERNATIONAL FRAMEWORK

This sub-section shall delve into, *first*, India’s obligations within the International legal framework; and *second*, the case for protection and promotion of the rights guaranteed under various treaties or customary norms.

India is a party to various treaties, which guarantees non-discrimination based on language. Further, there are various other treaties which guarantees a broad gamut of human rights. These rights may only be enjoyed if and when the rights are accessible, notwithstanding the barriers of language. For instance, as a part of Customary International law,⁴¹ the Universal Declaration on Human Rights [“**UDHR**”] expresses shared values of states in the protection and promotion of Human Rights. These rights should not be limited by discrimination on the basis of “language”.⁴² Another instance is that India is a signatory to the Declaration on the Right to

³⁷ Ministry of Human Resource Development, *Overview: Language Policy of India*, GOVERNMENT OF INDIA <http://mhrd.gov.in/language-education>.

³⁸ Constitution of India, art. 350 (1950).

³⁹ *Id.* at art. 350A.

⁴⁰ *Id.* at art. 350B.

⁴¹ A. D'AMATO, *INTERNATIONAL LAW: PROCESS AND PROSPECT* 123-147 (1987).

⁴² *Id.* at art. 2.

Development, 1986 DRD), and cannot derogate from its core principles,⁴³ especially “the primary responsibility for the creation of national...conditions favourable to the realisation of the right to development.”⁴⁴

Given that these rights and principles are imperative for the delivery of essential human rights; they are to be read broadly in so far as the obligation they impose on the state. The International Law Commission, which drafted the Responsibility of States for Internationally Wrongful Acts [“**ARISWA**”]⁴⁵ lays down the meaning of “breach”⁴⁶ and the nature of the obligation.⁴⁷ A breach takes place when a state is not in conformity with what is required by it. In his Commentary of the ARISWA, (now Judge) James Crawford notes that the “phrase “not in conformity with” is flexible enough to cover the many different ways in which an obligation can be expressed, as well as the various forms which a breach may take.”⁴⁸ To meet the intended effectiveness of human rights obligations, when construed broadly, their nature is that of result, unless the obligation explicitly provides otherwise. The language of DRD, several human treaties and customary law make clear that it is not only the mere obligation to create a law or mechanism to protect rights, but also to promote an environment which ensures these rights are effective and accessible.

It is through the State’s intervention that a bulk of human rights obligations can be achieved. When viewed from the lens of the obligation of result, i.e. obligations which truly seek to

⁴³DECLARATION ON THE RIGHT TO DEVELOPMENT (DRD), UNITED NATIONS A/RES/41/128 (1986). [hereinafter “Declaration, 1986”], <https://www.un.org/en/events/righttodevelopment/declaration.shtml>.

[Art. 1 (1) states “*The right to development is an inalienable human right by virtue of which every human person and all peoples are entitled to participate in, contribute to, and enjoy economic, social, cultural and political development, in which all human rights and fundamental freedoms can be fully realized...*”

(Art. 3 (1) states, “*States have the primary responsibility for the creation of national and international conditions favourable to the realization of the right to development.*”

Art. 6 states, “*1. All States should co-operate with a view to promoting, encouraging and strengthening universal respect for and observance of all human rights and fundamental freedoms for all without any distinction as to race, sex, language or religion. 2. All human rights and fundamental freedoms are indivisible and interdependent; equal attention and urgent consideration should be given to the implementation, promotion and protection of civil, political, economic, social and cultural rights. 3. States should take steps to eliminate obstacles to development resulting from failure to observe civil and political rights, as well as economic social and cultural rights.*”

Art. 8 (1) states, “*States should undertake, at the national level, all necessary measures for the realization of the right to development and shall ensure, inter alia, equality of opportunity for all in their access to basic resources, education, health services, food, housing, employment and the fair distribution of income.*”).

⁴⁴ Declaration, 1986, *Id.*, art. 1.

⁴⁵RESPONSIBILITY OF STATES FOR INTERNATIONALLY WRONGFUL ACTS (ARSIWA), UNITED NATIONS A/RES/56/83 (2001). [hereinafter “**ARSIWA, 2001**”]

⁴⁶ *Supra* note 45 art. 12.

⁴⁷ *Supra* note 45 art. 21.

⁴⁸*Commentary to the ARSIWA*, U.N. DOC. A/CN.4/SER.A/2001/Add.1 (Part 2) [2001] Y.B. INT’L L. COMM’N Vol. II (2) 55), https://legal.un.org/ilc/publications/yearbooks/english/ilc_2001_v2_p2.pdf.

empower the marginalised (socially, economically, politically, and culturally), the state must create a conducive environment to achieve this. Its non-conduct of the creation of such an environment would lead to a breach of these norms.⁴⁹ Undeniably, there is a link between human rights, their accessibility, and the use of ICT in ensuring this conducive environment so that India may meet its obligations under International law.

IV. DATASETS & COPYRIGHT

The creation of software that deploys ML and NLP requires vast corpora of datasets. Unfortunately, the availability of the same in Indic languages may be difficult for two reasons. *First*, there is a paucity of text available in Indic languages online, and *second*, that the available data is protected by copyright. This section shows how the use of such datasets falls within the “fair dealing” exception enumerated in the Indian Copyright Act, 1957. This section shall also highlight the limitations of the Indian legal framework, and make policy recommendations for the use of such text for the Bharat NLP programme.

A. DATASETS AVAILABLE

To ensure that the NLP and ML programmes function to begin with and attain their optimum level of contextual accuracy, they need to be fed with vast corpora of data in Indic languages.

At present, there are various stakeholders within and outside the Government that possess textual data in various Indic languages.⁵⁰ This textual data helps AI and algorithms with

⁴⁹Colozza v. Italy, (1985) Eur. Court H.R., 89 (ser. A), art28 (European Court of Human Rights); United Nations, *Chapter III: Breach of International Obligation*, MATERIALS ON THE RESPONSIBILITY OF STATES FOR INTERNATIONALLY WRONGFUL ACTS, UNITED NATIONS 102 (2012) (“...it (the ECtHR) did not simply compare the result required (the opportunity for a trial in the accused’s presence) with the result practically achieved (the lack of that opportunity in the particular case). Rather, it examined what more Italy could have done to make the applicant’s right “effective”...Here the Court looked at steps towards effectiveness of the implementation of a right as the standard.”), https://legal.un.org/legislativeseries/pdfs/chapters/book25/book25_part1_ch3.pdf.

⁵⁰ The following is only an indicative list of these stakeholders: Department of Official Language, Ministry of Home Affairs (with various Hindi eTools, which include the NLP programme MANTRA and eMahashabdakhosh, the copyright for which is held jointly by the Department of Language and Centre for Development of Advanced Computing); Central Board of Secondary Education (CBSE) (with various literature books in Sanskrit, Urdu, Hindi, etc., the copyright for which is held by the CBSE Research & Development Unit and NCERT); Andhra Pradesh Board of Intermediate Education and the Andhra Pradesh Open School Society (with literature books in Telugu, the copyright for which is held by the Andhra Pradesh State Council for Education and Training); Assam Higher Secondary Education Council (with literature books in Assamese, Bodo and Bengali, the copyright of which is held by the Assam State Council for Education and Training); Council for Indian School Certificate Examinations (ISC) (with various texts in Hindi, Arabic, Sanskrit, Persian, Lepcha, Urdu, Telugu, Tamil, Punjabi, Odia, Marathi, Manipuri, Nepali, Khasi, Malayalam, Mizo, Kannada, Dzongkha, Gujrati, Bengali and Assamese, the copyright of which is held by ISC); The Federation of Indian Publishers (FIP) (They represent approximately 80% of the Indian publishers across India which publish in English, Hindi, and regional Languages. The copyright is held by

understanding and learning the rules of language and establishing context. The more the data, the better trained the algorithms would be. Acquisition of this data would be key in training the algorithms, which when made available to start-ups can be deployed for various purposes in industries like health, education, social empowerment, etc. and eventually increase access to basic Constitutional guarantees and human rights. There are broadly two types of datasets which may be acquired, those in and out of the public domain.

C. LEGAL OPTIONS AVAILABLE TO NITI AAYOG

This sub-section shall engage with the legality of obtaining and using these datasets using provisions of the Indian Copyright Act, 1957 and judicial interpretation of the same. Two primary arguments are made, *first*, there is no copyright infringement in instances where the data is in the public domain, and *second*, the use of data-sets not in the public domain is covered by the exception of “fair dealing”. The third sub-section will address the limitations to the law as it stands.

1. NO INFRINGEMENT WHEN DATA IS IN THE PUBLIC DOMAIN

When a work is said to enter the public domain, it means that no copyright over it exists and can be used by anyone. Three key provisions of the Act lay down the period for the subsistence of a copyright over a literary work.⁵¹ For literary works, the copyright subsists for 60 years after the death of the author (in the case of joint work, it is 60 years from the death of the author who dies last), for pseudonymous works it is 60 years from publication (unless the identity of the author comes to light, then it is the same number of years from the coming to light of the identity), and for posthumous works it is 60 years from the date of publication.

2. DATA NOT IN THE PUBLIC DOMAIN IS COVERED BY THE EXCEPTION OF FAIR DEALING

The copyright over various literary works is protected by section 14, Indian Copyright Act, 1957 as,

individuals, but hold deliberations within its own ‘Copyright Council’, which could be engaged for Bharat NLP); Data held by IITs (by individual IITs and some held with consortiums. Some of the data includes Neural POS Tagger (Neural NER) (IIT Bombay), Hindi English Parallel Corpus (IIT Bombay), Indic TTS (IIT Madras), Datasets for FIRE 2013 Track on Transliterated Search – consists of corpora with Hindi, English, Bengali, Gujarati (IIT Kharagpur), Bengali ASR Speech Corpus (IIT Kharagpur), Speech Database of Language Identification (IIT Kharagpur), Telugu Emotional Speech Corpus (IIT Kharagpur), Hindi Emotional Speech Corpus (IIT Kharagpur), and Speech Database for unsupervised clustering (IIT Kharagpur).

⁵¹ Copyright Act, *supra* note 36, § 22, 23 & 24.

“copyright” means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:

(a) in the case of a literary...work

(i) to reproduce the work in any material form including the storing of it in any medium by electronic means;⁵²

When NITI stores this data within its corpora for ML and NLP, the aforementioned section covers it.

The Act, however, carves out exceptions and broadly classifies the same as “fair dealing”.⁵³ Reasonable restrictions within the Constitutional framework which manifests as exceptions within Section 52 of the Act are “keeping with the utilitarian public benefit theory of copyright law so that public access to content and its necessary dissemination is not curtailed by the rights granted to the author... thus, fair dealing is a right granted to the public under the Copyright Act”⁵⁴ The relevant part of the section reads as follows:

“Section 52. Certain acts not to be infringement of copyright.—

(1) The following acts shall not constitute an infringement of copyright, namely,—

(a) a fair dealing with any work, not being a computer programme, for the purposes of—

(i) private or personal use, including research;”

The High Court of Madras has interpreted the word “research” to mean, “an investigation directed to the discovery of some fact by careful study of a subject; investigation, inquiry into things.”⁵⁵ The NITI with its Bharat NLP seeks to conduct a thorough investigation and inquiry to discover the nature and rules of various Indic languages by having the software analyse the data corpora it acquires. Further, technology has grown exponentially since the inception of the Act and the Supreme Court of India has propounded a broad reading of the language in the law by opining that, “interpretation of every statutory provision must keep pace with the changing

⁵²*Id.* §14(a)(i).

⁵³*Id.* §52.

⁵⁴ R. Matthan *et al.*, *Fair Dealing of Computer Programs in India*, 7 INDIAN J. L. TECH. 93-94 (2011).

⁵⁵ Blackwood and Sons Ltd. v. A.N. Parasuraman, AIR 1959 Mad HC 410 (India).

concepts and it must, to the extent to which its language permits, or rather does not prohibit, suffer adjustments so as to accord with the requirements of fast-growing society.”⁵⁶

Natural Language Processing is an outcome of this “fast-growing society”, and tools such as these, by learning the rules of various Indic languages, ultimately encourage the dissemination of various kinds of information through the creation of the Bharat NLP software.⁵⁷ Recognising the role of technology in the betterment of society, the Supreme Court of India has noted that “no law can be interpreted so as to result in any regression of the evolution of the human being for the better.”⁵⁸

With such a focus from the Government, Indian society only moves forward as the growing need for Indic languages (many of which are otherwise on the verge of extinction) in upcoming technologies would be met through such focus. This would further enable accessibility to a mass of people who are excluded from availing the benefits of technological applications, which help in the awareness of basic rights. A restrictive reading would amount to “lowering the aspirations of public at the behest of publishers (also in the name of authors) by legislature or courts and would be the greatest disservice to the nation and the constitutional guarantees.”⁵⁹ Therefore, the utilisation of data corpora of Indic literary works would come within the exception of “fair dealing” in the Act.

A counter-argument to the “fair dealing” exception may be based on the reliance on Section 51 of the Act which *deems* infringement in certain cases. The relevant part of the section reads as follows,

“51. *When copyright infringed.*— *Copyright in a work shall be deemed to be infringed—*

(b) when any person—

(ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright,

⁵⁶ S.P. Gupta v Union of India, (1982) AIR 1982 SC 149, Opinion of J. Bhagwati on p. 62 (India); The Chancellor, Masters and Scholars of the University of Oxford v. Rameshwari Photocopy Services p. 11 (2016) 233 DLT 279 (India).

⁵⁷ Matthan, *supra* note 58 at 94 reads “...the various exemptions and doctrines implicit in copyright law, whether statutorily embedded or judicially innovated, recognizing the equally compelling need to promote creative activity and ensure that the privileges granted by copyright do not stifle dissemination of information...”; The Chancellor Masters and Scholars of the University of Oxford v. Narendera Publishing House, (2008) 106 D.R.J. 482, p. 32 (India).

⁵⁸ The Chancellor, Masters and Scholars of the University of Oxford v. Rameshwari Photocopy Services p. 87 (2016) 233 DLT 279 (India).

⁵⁹ A. K. Bansal, *Public Interest in Intellectual Property Laws*, 55(4) J. INDIAN L. INST. (2013).

any infringing copies of the work.”

Since NITI Aayog would make its software available to start-ups, who may commercially deploy the software, one could argue that the aforementioned provision would be attracted and the same would be deemed to be an infringement. However, what this argument does not account for is the transformative nature⁶⁰ of the software. The same is, arguably, entitled to its own copyright. An enquiry into the transformative nature of the software would require an analysis of the law as it stands.

Indian Courts through various judgements have laid down that “to claim copyright there must be some substantive variation and not just a trivial variation, not the variation of the type where limited ways of expression are available and the author selects one of them.”⁶¹ The standard of transformation, in its essence, is a “modicum of creativity.”⁶² The Supreme Court has held that “the creativity in a derivative work in which the final position will depend upon the amount and value of the corrections and improvements, the independent skill & labour, and the creativity in the end-product is such as to create a new copyright work to make the creator of the derivative work the author of it”.⁶³

The High Court of Delhi has also established a *de minimis* threshold for not considering violations as fair dealing within the Act. This threshold essentially means a minor violation, where the Court does not consider trifles. In *India TV Independent News Service Pvt. Ltd. v. Yashraj Films Pvt. Ltd.*, a bench consisting of Justices Nandrajog and Singh laid down the “way forward”.⁶⁴

“51. The Rule of Law loses its meaning if it does not run close to the Rule of Life. Trivial prima facie violations of copyright are commonplace ...

53. It is not in society's best interest to adjudicate these copyright disputes because ultimate compensation paid would not justify public expenditure in the adjudicatory process.

⁶⁰ RG Anand v. Delux Films, AIR 1978 SC 1613 (India).

⁶¹ Syndicate of the Press of the University of Cambridge and v. B.D. Bhandari RFA (OS) No.21 of 2009 and FAO (OS) No.458 of 2008 (High Court of Delhi).

⁶² Eastern Book Company v. DB Modak, (2008) 1 SCC 1, 31 (India).

⁶³*Id.* at 14.

⁶⁴ India TV Independent News Service Pvt. Ltd. v. Yashraj Films Pvt. Ltd. (2012) 192 DLT 502 (India).

54. Secondly, new technologies are emerging which increase the importance of amateur creative production and mix and match creativity. Today amateurs produce creative works of the highest professional quality. Creativity has to be encouraged and this would be in the interest of the society.

55. In our opinion, the use of *de minimis*, as applied in other areas of the law, without any modification or without having any marriage of convenience, has three significant advantages in the field of Copyright Law. Firstly, the Fair Use concept would be a bad theoretical fit for trivial violations. Secondly, *de minimis* analysis is much easier. Thirdly, a *de minimis* determination, is the least time consuming, and needless to state it is in the interest of the parties as also the society that litigation reaches its destination in the shortest possible time.

56. After all, the factors commonly considered by Courts in applying *de minimis* are well listed. They are five in number: (i) the size and type of the harm, (ii) the cost of adjudication, (iii) the purpose of the violated legal obligation, (iv) the effect on the legal rights of third parties, and (v) the intent of the wrongdoer.”

Using Bharat NLP, start-ups who are entrepreneurial amateurs must be encouraged to bring in creativity in technology for the greater interest of society. When tested against the touchstone of the factors for a *de minimis* standard, we see that when a start-up uses the Bharat NLP for a socially relevant purpose, but at the same time making profits, the size and type of harm is negligible and since NITI through this software or end-point would *only* research the nature, context and rules of various Indic languages, the output would be a complete transformation from the data it acquires.

This is akin to a human reading several books and articles in a particular Indic language to further his understanding of the language and ultimately publish and sell a book on an unrelated topic. This would allow the software to further process Indic language contextually and could be licenced to start-ups which use it for various purposes. The cost of adjudication would be exceptionally high due to the vast corpora of data and there is a possibility of numerous trifles adding to the already overburdened adjudicatory system in India. Also, the purpose of the law will not be vitiated since there is no reproduction or substantive reproduction of the literary work. Additionally, it will not have an impact on the rights of third parties due to the transformative nature of the programme and its deployment, and the intent here is not to plagiarise or infringe upon the copyright but to learn the contextual nature of various Indic languages.

Furthermore, it will not amount to “affect prejudicially the owner of the copyright”. The framers must also keep in mind the intersection between technology (NLP), and the regime of copyright law. In India, this intellectual property right does not protect ideas or disembodied information.⁶⁵ It is submitted that informational analysis or data mining for the stated technological purpose shall not affect the rights of the copyright holder. The technology merely has insight and does not reproduce the work to the prejudice of the copyright holder. It is important to note that the Courts have devised what would constitute prejudicial. NITI must also reiterate this judicial stance regarding ‘unfairness’ or ‘prejudice’ when devising a policy or recommending an amendment to the Copyright Act, 1957. Where the High Court of Lahore, in 1934, held that:

“in fair dealing (1) that in order to constitute unfairness there must be an intention to compete and to derive profit from such competition and (2) that unless the motive of the infringer were unfair in the sense of being improper the dealing would be fair.”⁶⁶

In cases where this end-point is used by start-ups, there would be no intention to “compete and to derive profit from such competition” since the outputs are non-substitutable. Where on the one hand, there is a literary work, which provides Bharat NLP to process the text to understand the context of an Indic language. On the other hand, hypothetically, there is a software developed by a start-up which provides information on reproductive health and rights in various Indic languages. There is no malafide intention of the start-up to compete with the literary work. Furthermore, it cannot compete with the work because of the sheer transformed nature of the data.

Therefore, the argument of deemed infringement would also not hold well in court, further NITI may even claim its own copyright over the NLP end-point it develops.

D. LIMITATIONS TO THE LAW

Though the aforementioned argument of fair use may be used for ensuring that the Bharat NLP is available for use by NITI, the law by itself is not robust enough to support the fast-growing nature of technology. This can be seen in the fact that the legislation itself does not explicitly lay

⁶⁵ Eastern Book Company, *supra* note 61.

⁶⁶ Kartar Singh Giani v. Ladha Singh, AIR 1934 Lah. 777 (High Court of Lahore).

down ‘informational analysis’ or ‘text and data mining’⁶⁷ as part of “research” within the exception contained in Section 52 of the Act.

One must keep in mind that these methods do “not use the content itself of the data it analysed. Rather, it relies on the information contained in those documents to be able to draw patterns, conclusions or trends.”⁶⁸ Further, there are no judicial decisions to analyse the role of AI, Machine Learning, and Natural Language Processing. There, moreover, remains ambiguity regarding liability (if, any at all) when such informational analysis is used for economic gains. That gap in the law needs to be bridged through various changes to the legal architecture.

V. POLICY RECOMMENDATIONS AND CONSIDERATIONS

NITI Aayog should develop its policy on a two-pronged approach. The first, which deals with short term considerations such as the smooth rollout of the Bharat NLP programme. The second, which deals with long- term implications vis-à-vis a liberal framework for AI, NLP and ML.

A. SHORT TERM BASIS

Where NITI can acquire datasets, which are in the public domain, it shall not be infringing on any entity’s copyright. Therefore, the first recommendation is that it collates information on which all works are in the public domain. Once this information is collated, it may use the same without any fetters to develop Bharat NLP. This data unlike other copyrighted data may be provided freely to start-ups to possibly train their own systems.

Second, given that there is a strong case that such analytics through the ML and NLP would constitute “fair dealing”, the NITI Aayog may proceed with acquiring such data in processing Bharat NLP. That being said, there are the aforementioned ambiguities in the law, and NITI Aayog must prevent any legal challenges to this programme and broader road-blocks to the roll-out of the Digital India programme.

Therefore, it should, *first*, call for the Licensing Policies from all stakeholders since many of the texts they hold will be protected by copyrights. In calling for public data held by governmental or statutory bodies, some may have reserved some rights unto themselves which may act as an impediment to the success of the Bharat NLP programme. Thus making it important to assess

⁶⁷ Parliamentary Standing Committee on Industry, Science and Technology, *Evidence: Submission by Element AI*, HOUSE OF COMMONS OF CANADA (2018), available at: <https://www.ourcommons.ca/DocumentViewer/en/42-1/INDU/meeting-130/evidence>.

⁶⁸*Id.*

the Licencing Policies of these stakeholders to begin with; and subsequently, *second*, license the data to create the Bharat NLP. This would ensure that the rights and obligations under the Act as it stands are met, and there is an avoidance of any unnecessary litigation.

B. LONG TERM BASIS

On a long-term basis, NITI Aayog should *first*, conduct a detailed study of legislation and judicial decisions from various jurisdictions and nations on exceptions created for ‘informational analysis’. The eco-system must be made conducive for many start-ups and other technology companies to utilise upcoming technologies for the betterment of society at large.

There are two broad approaches, *first*, it is restricted towards certain kinds of use. For instance, the European Union creates a mandatory exception for data mining for certain purposes pertaining to scientific research, education and culture. This is also for a non-profit basis, and only by organisations working for the public interest.⁶⁹ In furtherance to this, there is an optional exception which may permit any person to mine data as long as the user has access which is lawful to such data, and the owner of the copyright owner of the data has no reservations for the same.⁷⁰

This, arguably, allows for commercial usage of such data. The United Kingdom also has an exception to informational analysis.⁷¹ This, much like the European Union, is only restricted towards the purposes of research. *Secondly*, Japan has a broad definition of data mining and liberalised usage, even for commercial proposes.⁷²

In coming up with a policy, NITI must keep in mind the larger goals of Digital India, 2014,⁷³ Policy on Adoption of Open Source Software for Government of India, 2012,⁷⁴ and National Intellectual Property Rights Policy, 2016.⁷⁵

⁶⁹European Parliament, Amended EU Directive on art. 31 (Amendment8) [https://www.europarl.europa.eu/sides-getDoc.do?pubRef=-//EP//NONSGML+TA+P8-TA-2018-0337+0+DOC+PDF+V0//EN](https://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//NONSGML+TA+P8-TA-2018-0337+0+DOC+PDF+V0//EN).

⁷⁰*Id.*

⁷¹ Copyright, Designs and Patents Act, 1988, section 29A (Eng).

⁷²Art. 47, Copyright Act of Japan, COPYRIGHT RESEARCH AND INFORMATION CENTER http://www.cric.or.jp/english/clj/cl2.html#cl2_1+A47septies.

⁷³ Ministry of Electronics and Information Technology, *Digital India*, GOVERNMENT OF INDIA (2014) https://meity.gov.in/sites/upload_files/dit/files/Digital%20India.pdf.

⁷⁴ Ministry of Electronics and Information Technology, *Policy on Adoption of Open Source Software for Government of India*, GOVERNMENT OF INDIA (2012) https://meity.gov.in/writereaddata/files/policy_on_adoption_of_oss.pdf.

⁷⁵ Ministry of Commerce and Industry, *National Intellectual Property Rights Policy*, GOVERNMENT OF INDIA (2016) https://dipp.gov.in/sites/default/files/National_IPR_Policy_English.pdf. (This policy states its goals, which includes to, “12. Promote use of Free and Open Source Software along with adoption of open standards; possibility

NITI must also keep in mind the evolved jurisprudence of the United States of America where a distinction has been made between expressive and non-expressive use of copyrighted works, in understanding “fair use”. Fair use in the US, unlike as interpreted in India, is non-exhaustive and grounded in the principles of fairness and equity. A broader understanding of what may be fair will benefit start-ups, Micro, Small and Medium Enterprises and innovative individuals who may use such AI for the larger benefit of society.

VI. CONCLUSION

A young and ambitious India, on the eve of its seventy-fifth year of existence, faces multiple challenges. A core challenge is the redistribution of resources and access to opportunities. Progress in ICT has demonstrated its usefulness in key development areas like health, education, and governance. To unlock the true potential ICT and its outcomes may hold, it is imperative to improve the access to and through ICT. With the diversity in India, one way to improve this access is to ensure Indic languages are relied on to ensure robust technological development. The access to vast amounts of data in these languages can act as a fillip for new and comprehensive technological development. Ultimately, the purpose of the State should be to seek the larger benefit of the people, which lies in creating an exception to the Copyright Act, 1957, or defining informational analysis within the ambit of “research” within the Act. This would enable the legal framework to keep pace with various technologies which can benefit all persons of India by increasing accessibility to these technologies and various rights made available of facilitated therefrom.

of creating Indian standard operating environments will be examined...Legal, technological, economic and socio-cultural issues arise in different fields of IP which intersect with each other and need to be addressed and resolved by consensus in the best public interest... The present IP Policy aims to integrate IP as a policy and strategic tool in national development plans.”).

PATENT PROSECUTION HIGHWAY: AN OVERVIEW AND A CRITICAL STUDY OF INDO-JAPAN PPH AGREEMENT

SOURAV KUMAR* AND JYOTSHNA YASHASWI**

ABSTRACT

This article has been written with a focus on India's Patent Prosecution Highway agreement with Japan, which happens to be India's first-ever PPH program. A PPH Program is a work-sharing agreement, where two patent offices share their work while examining the same patent claim filed in two jurisdictions resulting in expedited and efficient patent prosecution. This agreement has been analysed specifically while examining the needs and importance of PPH in general. A PPH program is claimed to pose a threat of harmonisation of patent regimes and thereby dilute the strict patentability threshold of countries such as India. There are various other concerns that surround the program, the impacts of which are yet to be known. India is one of the biggest markets globally and one of the first developing nations to sign such an agreement. The India-Japan PPH program will be the first among many such programs to follow. An analysis of the India-Japan agreement has been undertaken to predict its outcome on the Indian patent regime and the economy. The Patent Rules 2003 has been amended in a way to accommodate all such future programs. Therefore, it has been suggested that a comprehensive policy be prepared that may guide such future programs to prevent harmonisation and dilution of the patentability threshold. Lastly, the biggest concern arising out of this program was that pharmaceutical companies may use this arrangement to garner exclusivity, thereby threatening the availability of cheap medicines in India. Drawing upon this argument a case has been made to exclude the pharmaceutical sector from future PPH arrangements.

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I. INTRODUCTION

Globalisation has resulted in making the world more and more interconnected, and commerce is the most significant element of such interconnected development. Commerce is driven by constantly improving technology through research & development. To get ahead of its competitors, enterprises put a lot of effort and investment into research & development. New developments are protected by patent rights, to ensure that the developer can enjoy the benefits of their effort and investment. However, the patent rights are granted by the patent office of that particular country or the region and have a territorial limit. This is known as the principle of territoriality.

In a globalised world, all the big enterprises and MNCs seek to make commercial use of its research and development in several jurisdictions. However, as patent right is a territorial right, it is not enough to get a patent only in one country. The developer needs to obtain such patent rights in all those countries where it aims to make commercial use and protect its rights. The process of obtaining a patent is time and resource consuming. Going through this tedious process several times is difficult for the applicant and it is wastage of effort of the patent office. In such a scenario, the Patent Prosecution Highway [“**PPH**”] has proved to be of great help.

In this paper, the authors study the evolution of the PPH framework and the reasons that propelled the rise of this work-sharing arrangement. Since India has signed its first pilot PPH agreement with Japan, an analysis of the agreement and its impact on the Indian patent regime shall be undertaken. The authors shall also argue that PPH agreements are a better option than global harmonisation treaties such as TRIPS, especially for developing economies like India as it may result in boosting the manufacturing sector without diluting Indian patent laws. However, the authors shall conclude by making a case for exclusion of the pharmaceutical sector from such future PPH agreements. It is to be noted that India has signed its first PPH agreement, whose impact cannot be predicted and hence, the trends and results from the USA and Japan have been used to analyse its impact on the Indian patent regime.

II. PATENT PROSECUTION HIGHWAY: NEED AND IMPORTANCE

The process of filing a patent application before a patent office indicating the claims and its examination by a patent examiner is called patent prosecution. The role of a patent examiner can be seen as a gatekeeper who rejects the scope of the claims made by the applicant repeatedly so that the applicant concedes the claims, which are already in existence.¹ The work of a patent examiner involves research on relevant databases for prior arts, which is a highly tedious and

¹ John M. Carson *et al.*, *A Practical Guide to the Patent Prosecution Highway*, 188 *MANAGING INTELL. PROP.* 24 (2009).

time-consuming task. In case, an applicant makes an application before two offices, the patent examiner of both the offices will have to do the same work resulting in duplication of work. In such a case, if there is a mechanism of work and information sharing between the two offices, then the repetition and duplication of work can be avoided.

PPH is a mechanism to share work generated by one office with the other. It aims to accelerate the process of prosecution by sharing of information among different patent offices. Under a PPH framework, an application for patent approved by Office of Earlier Examination [“**OEE**”] is eligible for an expedited examination in another Office of Later Examination [“**OLE**”], if requested by the applicant.

It is well known that different jurisdictions have different standards of patentability, and therefore one patent office cannot rely on the decision of other patent offices with full credit and faith. Therefore, PPH mechanism is not complete reliance on the work of other office but it is a mechanism where OLE can use the search result of OEE as a jumping-off point for its patentability search and thus reduce the duplication of work by the examiners.²

With increasing globalisation, the number of patent applications filed across the globe is also significantly increasing. Predictably, the number of applications for the same claim being filed before multiple patent offices is also increasing. At the beginning of the previous decade, the number of patent applications filed globally was 89.6 million, which rose to 122.9 million patent applications at the end of the decade.³ In such a scenario, it can be concluded that the patent office faces a huge backlog of applications. This situation is also problematic from the perspective of applicants as in today’s globalised world the technology keeps changing day by day and an applicant may face severe losses during the pendency of the patent application. Therefore, a need for expedited examination of the patent applications was being felt. PPH is a result of this need for expedited examination to help the patent offices as well as the applicants.

The first-ever PPH program was started in 2006 between the United States Patent Office [“**USPTO**”] and the Japan Patent Office [“**JPO**”] on a pilot basis.⁴ The purpose of the pilot project was stated to expedite the examination process of a patent application before the OLE, if

²*Id.*

³Japan Patent Office, *Introduction to Patent Prosecution Highway*, WORLD INTELLECTUAL PROPERTY ORGANIZATION (last visited Dec. 31, 2020), https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip_ryd_13/wipo_ip_ryd_1-3_www_258896.pdf.

⁴ Christopher A. Potts, *The Patent Prosecution Highway: A Global Superhighway to Changing Validity Standards*, WORLD INTELLECTUAL PROPERTY ORGANISATION (May 23, 2011), https://www.wipo.int/edocs/mdocs/mdocs-en/wipo_ipr_ge_11/wipo_ipr_ge_11_topic15.pdf.

certain corresponding claims were allowed by the OEE, by using the search and examination result produced by the Office of First Filing [“**OFF**”].⁵ The efforts put in by the OFF are thus not repeated and redundancy is reduced to result in expedited examinations.

There were certain major takeaways from the pilot project, which proved to be very beneficial to applicants in getting applications approved and for the patent offices in clearing the application backlog. In the USA, of all the applications filed through the PPH route, 94% of the applications were approved, while the allowance rate for non-PPH applications was less than half of that. In the non-PPH route, an average of 3.2 to 3.4 substantive actions was required to dispose of an application. However, for PPH applications it took an average of only 1.7 substantive actions in disposing of an application⁶, mostly resulting in allowing the claim. The PPH route doubled the chances of a claim being accepted and reduced the number of substantive action by half. Substantive action or office action is a refusal of the application by the trademark office on certain grounds, allowing the applicants to respond to the objections. The time taken for a claim to be allowed in a PPH route application was 2-3 months instead of an average of 27 months.⁷ The benefits of a PPH mechanism were quite visible and therefore several bilateral, as well as multilateral PPH agreements have been signed. Global PPH and IP5 are the most important examples of such a multilateral PPH mechanism signed by major patent offices of the world.

III. WORKING MECHANISM OF PPH

PPH is a work-sharing agreement and such work-sharing agreements are a result of the pursuit of patent offices to reduce the backlog. Backlogs in patent offices are a result of an ever-increasing number of applications and reduced budgetary allotment.⁸ Globally, since the 1990s the numbers of patent applications have increased at a rate of 20-30% per annum. In 2003, in the US, the average total pendency was of 26.7 months, which increased to 34.6 months in 2009.⁹ These trends during that time were not limited to the USA but were reflected globally and thus, pressurised the patent offices to take actions to ameliorate this condition. As a result, inter alia, USA and Japan formalised the first-ever PPH pilot program in 2006.

In the traditional approach, all the offices examine the application in isolation and vacuum of information, apart from what is furnished by the applicants. The work done by other offices in

⁵ Alicia Pitts & Joshua Kim, *The Patent Prosecution Highway: Is Life in the Fast Lane Worth the Cost*, 1(2) HASTINGS SCI. & TECH. L.J. 127, 129 (2009).

⁶John M. Carson, *supra* note 1, at 26.

⁷Pitts, *supra* note 5, at 130.

⁸Potts, *supra* note 4, at 3.

⁹*Id.*

examining the patentability of the same invention is not formally recognised and this aspect of traditional patent examination has been changed by a PPH arrangement.

Under PPH arrangement, a member office will use the search and examination results of the priority application filed before the other agreeing office to expedite the review of the same application. Whether OLE will utilise only search results or both search and an examination result of the OEE depends on the specific agreement between the two offices. This factor has a significant implication on the outcomes of patent examination. If the OLE relies on the examination result and there is a substantive difference in the patentability criteria, standard, and law of the two offices, then there is a concern that the jurisdiction with higher patentability threshold and standard will suffer dilution in its standards.

Under this arrangement, if an applicant gets at least one claim approved by the OEE, then a request for expedited examination can be made before the OLE for the corresponding claim. OLE will then utilise the search and examination result produced by OEE to examine the claim in an expedited manner by avoiding duplication of work.

Post the USPTO-JPO pilot program, various offices have initiated several other PPH programs. PCT PPH, Global PPH, IP5 PPH are some significant multilateral PPH arrangements apart from numerous bilateral PPH arrangements. Although different PPH arrangements have different specific requirements, there are certain general principles and requirements in most of the PPH arrangements, such as valid filing of the application of priority before OEE, approval of at least one of the claims by the OFF, and the non-commencement of the substantive examination at the OLE.¹⁰

IV. PPH: A TRADE-OFF AND NOT A SHORTCUT

It is sometimes perceived that a PPH route application guarantees success in the OLE and thus, PPH is criticised for diluting the patent law and standard of the jurisdiction of the office of second filing. However, this notion is misconceived, as PPH does not guarantee the success of the application.

If we look at the data from the pilot project between USPTO and JPO, it is known that 6% of the applications were rejected. A PPH is a trade-off undertaken by the applicant,¹¹ where the applicant gives up a chance on carefully re-drafting the claim and the larger scope of the claim, as the office of the first examination has already denied it. In exchange for this, the applicant gets an earlier and expedited examination of application resulting in early disposal and decreased cost.

¹⁰ Potts, *supra* note 4, at 5.

¹¹ Carson, *supra* note 1, at 27.

Given the nature of trade-off involved in a PPH mechanism, it is of more relevance to certain big companies that indulge in fast-changing technologies.

As PPH is a trade-off for the applicant and not all gain, the applicant should look to derive the most benefit out of it. This can be done by identifying certain directions of the PPH, which favours the applicant. In the case of the USPTO-EPO highway, the preferred direction is US1-EU2. Here, the USPTO is preferred as the OFF, while EPO, which is by default the office of second filing is approached through the PPH application.¹²

The direction of a preferable route can be identified by deciding the OFF based on two factors - first, the amount of time generally taken to complete the prosecution and second, the tendency of the office to limit the scope of the claim. An office, which takes lesser time to decide on the claim should be allowed and has a lesser backlog, should be preferred as the OFF. This will result in patent getting approved in the least possible cumulative time in both offices. In respect to the second factor, the office, which has lower and liberal standards to allow a claim should be preferred. This will mean that the applicant will approach the office of second filing with the maximum scope of the claim. A carefully selected PPH route can immensely help an applicant in the process.

Given the nature of the procedure, it can be said that beneficiaries of PPH arrangement tend to be predominantly larger companies engaged in fast-moving technologies. According to the data provided by USPTO, the most number of PPH applications were filed for the Computers and Electronics sector, followed by Biotechnology and Chemical Engineering.¹³

V. CONCERNS EMERGING FROM PPH

A concern inherent to the patents allowed through PPH is that such patents have weakened validity. It is often claimed that work-sharing arrangements, especially a PPH may result in a situation where the OLE, by relying on the search and examination result of the OEE often lose control over the examination process.¹⁴ This loss of control over the required standard and criteria by the OLE may result in producing a highly compromised patent regime. The bigger concern is that, since PPH is a bi-directional mechanism, both the offices cede the control over the examination to each other. This may lead to the harmonisation of patent laws, which is far from the ideal situation.

¹²*Id.* at 24.

¹³*Id.* at 25.

¹⁴Potts, *supra* note 4 at 6.

A PPH arrangement may also lead to constitutional challenges to the validity of such programs. The reliance of the OLE on the search and examination result of the OEE may result in the patent examination process of the OLE becoming bifurcated. This may in effect result in two separate patent regimes- first, for the patents granted through PPH with lower standards and requirement and second, for the patents granted through the non-PPH route with higher requirements and standards. This situation will be created by the backing of the law. Thus, a challenge may arise against such a mechanism for being discriminatory.

Most of the modern constitutions invariably enunciate the principle of equality and provide equal protection of law to people. The Equal Protection Clause of the American Constitution, which reads, “[no state shall] deny to any person within its jurisdiction the equal protection of the laws.”¹⁵ Similarly, the fundamental right to equality of the Indian Constitution reads, “the State shall not deny to any person equality before the law or the equal protection of the laws within the territory of India.”¹⁶ Most of the Constitutions in the world provide similar protection to the citizens.

Such a challenge has not arisen in the US till now, but with changing jurisprudence the possibility of such a challenge cannot be denied. However, after the IPO-JPO pilot patent program, such a challenge is more likely to arise in India. The reason for this is that historically the US constitutional jurisprudence has accorded a higher pedestal to liberty than equality,¹⁷ but the Indian Supreme Court has accorded higher respect to equality.¹⁸ Therefore, the pilot PPH program in India may need to pass a very strong Constitutional test.

The concerns emanating from a PPH arrangement discussed above are based on the sole premise that while examining an application in an expedited manner, the office of second filing cedes its control over the examination process to the office of first filing. This is possible only when, the OLE completely relies on the examination result of OEE without any scrutiny on its own. As of now, no major patent office has issued such guidelines. However, as discussed in the previous parts, a lot of applications filed through PPH route are rejected as well, which indicates that the actual practice of examination corresponds with this argument.

This premise seems to be misguided as when the OLE examines an application under PPH, it uses OFF’s examination and searches result merely for reference for the reduced scope of the

¹⁵U.S. CONST, amend. XIV, § 1.

¹⁶INDIA CONST. art. 14.

¹⁷ Herman Belz, *Liberty and Equality for Whom? How to Think Inclusively about the Constitution and the Bill of Rights*, 25(3) THE HISTORY TEACHER 263, 266 (1992).

¹⁸ Uday S. Mehta, *Constitutionalism*, THE OXFORD COMPANION TO POLITICS IN INDIA 15 (Niraja Gopal Jayal & Pratap Bhanu Mehta eds., 2010).

claim. Therefore, a PPH arrangement between two offices results in the harmonisation of the procedure and not the substantive law. However, this does not mean that there is no possibility of harmonisation of substantive law by reduced validity standards. The argument is based on the will and skills of the examiner at OLE, and will not stand correct if the examiner decides to completely rely on the examination and search result of the OEE. Thus, it is suggested that binding guidelines must be provided by any office entering a PPH arrangement to pre-empt complete reliance by any examiner on the search and examination result of OEE.

Further, a legal challenge that has arisen in many countries out of PPH is of reduced validity presumption. This was also one of the questions before the US Supreme Court in *Microsoft Corp. v. i4i Ltd. Partnership*.¹⁹ The concept of presumption of validity of patents means that in case a patent is challenged, the court shall presume it to be valid once it is granted by the patent office. The onus to prove the invalidity of the patent is on the person claiming so. US Patent regime provides for such presumption in favour of validity. Consequently, US courts require 'clear and convincing' standard of evidence to invalidate a patent. This standard flows from the presumption that the patent office has done its job properly.²⁰ A patent granted through a PPH route might appear to not fit well within this presumption. In *Microsoft Corp. v. i4i Ltd. Partnership*, Microsoft argued to change this 'clear and convincing' to 'preponderance of probabilities' standard. However, the US Supreme Court rejected this argument and upheld the 'clear and convincing' standard for invalidating a patent.

However, there won't be any such impact on the Indian law as there is no presumption of validity of a patent in India as decided by the Supreme Court in *Biswanath Prasad Radhey Shyam vs. Hindustan Metal Industries*²¹ and also codified in the Patents Act.²² Therefore, this pilot program will not impact Indian law on this aspect.

VI. INDIA- JAPAN PPH: THE INTRICACIES

¹⁹Microsoft Corp. v. i4i Ltd. Partnership, 564 U.S. 91 (2011).

²⁰Rajiv Kr. Chaudhri, *Presumption of validity of a (an Indian) Patent*, SPICY IP (June 25, 2011), <https://spicyip.com/2011/06/presumption-of-validity-of-an-indian.html>.

²¹Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 (India).

²² Patents Act, 1970, No. 39, Acts of Parliament, 1970, § 13(4) (India).

The Indian Patent Office signed its first Patent Prosecution Highway program with Japan Patent Office in 2019 on a pilot basis.²³ This program may prove to be a boost to 'Make in India', emerging start-ups, and MSMEs of India. Japanese entities will also benefit from the scheme.

Given the new emerging geo-economic order of the world in light of the COVID-19, this PPH may help India in becoming a major manufacturing hub. The Japanese government has asked its companies to move out of China, and thus companies such as Sony are looking for alternate countries.²⁴ India is one of the preferred countries with adequate and cheap manpower, and the PPH will further reduce the entry barrier by expedited patent examination.

There are certain claims that this PPH will prove to be disastrous for the Indian patent regime. It is claimed that it will lead to dilution of the strict patentability criteria provided by the Indian Patent Act. It is feared that it would result in harmonisation of India's patent law with those of Japan's.²⁵ This notion is misconceived as PPH is just a route for expedited examination and not a route for guaranteed approval. As it has been discussed previously, applications coming through the PPH route can be rejected also. The office of second filing merely relies on the search and examination result of the earlier office and it examines the scope of claim allowed again. Therefore, the claim that it would dilute the patentability criteria is misguided.

The critics of this PPH are particularly concerned with the dilution of criteria for drug and medicine patenting as foreign drug companies' ploys for patenting medicine in India has constantly been rejected by the Indian patent criteria.²⁶ Once again, this scepticism is misguided, as, under the current arrangement, IPO will not be receiving PPH application for drug patents. The procedure guidelines released by IPO states that "*IPO will receive Patent applications only in the technical fields of Electrical, Electronics, Computer Science, Information Technology, Physics, Civil, Mechanical, Textiles, Automobiles, and Metallurgy.*"²⁷ Therefore, the fear and criticism of the pilot program are completely misguided. However, a strategic selection of the PPH route as discussed previously

²³ Office of Controller General of Patents Designs and Trademarks (DIPP), *Notice: Patent Prosecution Highway*, DEPARTMENT FOR PROMOTION OF INDUSTRY AND INTERNAL TRADE (Dec.04, 2019), available at: <http://www.ipindia.nic.in/newsdetail.htm? 593>.

²⁴Nandini Oza, *Gujarat looks to make hay as Japan plans to move businesses out of China*, THE WEEK (Apr. 16, 2020),<https://www.theweek.in/news/biz-tech/2020/04/16/gujarat-looks-to-make-hay-as-japan-plans-to-move-businesses-out-of-china.html>.

²⁵LathaJishnu, *Patent Prosecution Highway: The fast track to disaster*, DOWN TO EARTH (Feb.17, 2019),<https://www.downtoearth.org.in/blog/economy/patent-prosecution-highway-the-fast-track-to-disaster-63088>.

²⁶ *Id.*

²⁷INDIAN PATENT OFFICE, PROCEDURE GUIDELINES FOR PATENT PROSECUTION HIGHWAY, at 8 (2019).

may result in Japan-India being the preferable route as Japanese patent criteria are liberal in comparison to India.

VII. RULES AND PROCEDURES FOR IPO-JPO & IMPACT ON INDIAN LAW

The pilot PPH arrangement signed with Japan consists of both Normal PPH as well as PPH MOTTAINAI.²⁸ PPH MOTTAINAI is a specialised Japanese PPH program started in 2011, which aims to reduce the wastage of time and resource.²⁹ Under the Normal PPH scheme, the OFF, has to provide the outcomes of its examination, before any of the offices approve a PPH request. Such a necessity bars the other offices from efficiently utilising the search and examination conducted in other offices. This is a situation of “MOTTAINAI” or “waste”, which is aimed to be reduced by PPH MOTTAINAI.

In India, the patent regime is controlled and regulated by the Patent Rules 2003. The Patent Rules, 2003 was amended in 2016 to include a provision for expedited examination. However, the option of expedited examination was available only on two grounds- firstly, if the applicant has indicated India as the competent International Searching Authority or as an International Preliminary Examining Authority in the corresponding international application³⁰ and secondly, if the application is by a start-up.³¹ However, the rules were suitably amended in September 2019. The Patent (Amendment) Rule 2019, inter alia stated new rules where applicants are eligible for the expedited examination provided that they are eligible under an arrangement between IPO and the patent offices of other countries or regions.³² The amendment was brought about to accommodate expedited examination under the Indo-Japan PPH. It can be said with conviction that the PPH has not brought about any substantial change in the Patent Rules but merely procedural change. Therefore, there will be no harmonisation of substantial law, which is feared by many but only of procedural aspects. The changed rules also indicate that India might be entering into more PPHs in the future.

Both offices started accepting PPH requests from 5th December 2019. The number of PPH requests in both the offices has been capped at 100 cases per year.³³ This seems to be a well thought out strategy. It needs to be considered that as we are witnessing reduced time for PPH

²⁸*Id.* at 3.

²⁹MOTTAINAI is a Japanese term meaning “a sense of regret concerning waste when the intrinsic value of an object or resource is not properly utilized”.

³⁰The Patent Rules, 2003, Gazette of India, pt. II sec. 3 (Sept. 20, 2002), rule 24C (1)(a).

³¹*Id.* at rule 24C (1)(b).

³²Astha, *Availing India Japan Patent Prosecution Highway for Faster Patent Prosecution*, MONDAQ (Jan. 29, 2020), <https://www.mondq.com/india/patent/888154/availing-india-japan-patent-prosecution-highway-for-faster-patent-prosecution>.

³³Indian Patent Office, *supra* note 27 at 4.

cases, the average pendency time for non-PPH cases is ever increasing.³⁴ This is because the PPH cases are consuming a significant time resulting in neglect of the non-PPH application.³⁵ An upper cap of 100 cases per year will ensure that the non-PPH cases are not neglected.

The results of the first set of PPH applications before the IPO may come soon in near future. The application process started on 5th December 2019 and the review of all 100 applications was completed in less than 3 months. IPO, through a notice dated 25th February 2020 informed that the review of applications has been completed and 56 applicants were allowed to file a request for expedited examination on Form 18A. Applications for rest 44 spots were called again.³⁶ The researcher attempted to find out the details of applicants to understand the nature of companies making use of the pilot program. However, IPO has not published any such detail.

VIII. PATH AHEAD FOR INDIA

India-Japan pilot program of PPH will surely be the first among many such programs that will follow. As argued earlier, there are various advantages of such PPH programs for the manufacturing sector and the Indian economy. However, there may be certain disadvantages that may follow if these PPH Programs are not well thought and crafted.

The biggest advantage of a bilateral PPH over a global treaty such as TRIPS is that two countries can prepare a tailor-made PPH framework that suits their needs and aspiration. The needs and aspirations from a patent law are very different for developing jurisdictions like India and developed nation, as clarified by the Supreme Court in *Novartis v. Union of India*.³⁷ Keeping in mind these aspirations, India needs to prepare a well-crafted policy that guides the future PPH agreements that India undertakes.

This policy must seek to prevent the dilution of local patent law. This may be done by expediting the patent granting process through PPH and by making suitable changes only to the procedural part of the patent law and not the substantive part. Special focus should be paid to design the policy in a way to boost domestic manufacturing without lowering the pre-existing threshold. On the same note, we argue that the pharmaceutical sector must be kept out of future PPH agreements. This is because the nature and implications of the pharmaceutical sector are much different from other sector and thus needs special protection.

³⁴U.S. PTO, 2010-2015 STRATEGIC PLAN, 10 (2010).

³⁵Potts, *supra* note 4 at 6.

³⁶Office of Controller General of Patents Designs and Trademarks (DIPP), *Notice: Patent Prosecution Highway*, DEPARTMENT FOR PROMOTION OF INDUSTRY AND INTERNAL TRADE (Feb. 25, 2020), <http://www.ipindia.nic.in/newsdetail.htm?662/Notice+Patent+Prosecution+Highway>.

³⁷*Novartis v. Union of India*, (2013) 6 SCC 1.

A. SPECIAL PROTECTION TO PHARMACEUTICAL SECTOR:

Pharmaceutical companies have always been attempting to secure exclusivity in the market. They have been engaging in practices such as rent-seeking, patent ever greening, patent layering, etc.³⁸ These acts have often resulted in a severe impact on the poor segment as they are denied access to affordable medicine.³⁹ Patent laws, especially for the Pharmaceutical sector have attempted to balance between the corporate incentives for innovation and the needs of the poor of a healthy life and access to medicines. This never-ending dichotomy has had varying impacts on various countries depending upon their economic status, and therefore we have divergent regimes of patent law across the world.⁴⁰

During the latter half of the twentieth century, the well-established industries from developed countries adopted a maximalist rights culture⁴¹ resulting in the explosion of patents in the Pharmaceutical sector.⁴² However, developing nations such as India were more focused on ensuring access to medicine resulting in the development of cheap generic drug industries.⁴³ Therefore, developing nations have always attempted to counter the effect of patent ever greening and patent layering.

The main reason for treating the pharmaceutical sector as a special case and keeping it out of any PPH arrangement for the near future is that there is a basic difference between medicine and other products. For other products, the need of it is a choice of the consumer, which depends upon the economic wellbeing of the concerned consumers. However, in the case of medicine, it is not a choice but a necessity or compulsion, which may be faced by the rich and poor equally. If this sector is protected in favour of pharmaceutical companies, it will result in the death of millions of impoverished populations of India. Therefore, a developing and welfare state like India should and must aspire to develop a patent regime that ensures access to cheap medicine

³⁸Saby Ghoshray, *3(d) View of India's Patent Law: Social Justice Aspiration Meets Property Rights in Novartis v. Union of India*, 13 J. MARSHALL REV. INTELL. PROP. L. 719, 721-722 (2013).

³⁹Greg Martin, Corinna Sorenson & Thomas Faunce, *Balancing intellectual monopoly privileges and the need for essential medicines*, GLOBALIZATION AND HEALTH (June 12, 2007), <https://globalizationandhealth.biomedcentral.com/articles/10.1186/1744-8603-3-4>.

⁴⁰Ghoshray, *supra* note 38, at 722.

⁴¹*Id.* at 723.

⁴²In the USA, the number of Patent granted in 1980 was 66,170 which has reached more than 3,91,000 in 2019. *See* Patent Technology Monitoring Team, *U.S. Patent Statistics Chart Calendar Years 1963 – 2019*, U.S. PATENT AND TRADEMARK OFFICE (last visited Dec. 31, 2020), https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm; a similar trend has been witnessed in the Europe.

⁴³Martin Khor, *Generics under Threat: Can India Still Supply Cheap Medicines for the World*, 259 THIRD WORLD RESURGENCE 4, 4-5 (2012).

affordable by all. This obligation of the state can be traced back to the Constitutional and International obligations.

Although the Indian Constitution does not provide for the right to health expressly, it provides for the right to life as a fundamental right.⁴⁴ The right to life is not just a negative but, a positive obligation on the state to ensure healthy life to all citizens. The Supreme Court of India has read the right to health inherent to the right to life in *Bandhua Mukti Morcha v. Union of India*.⁴⁵ The Supreme Court in *State of Punjab v. Mohinder Singh*⁴⁶ reaffirmed this position and stated that the government has the obligation to provide healthcare services to citizens. Keeping this in mind, the amendment to section 3(d) of the Patents Act, 1970 was introduced. This amendment mandated an increased threshold for pharmaceutical patents to be granted by subjecting such products to the test of increased efficacy.⁴⁷ The validity of this provision was challenged and was upheld by the Supreme Court.⁴⁸ This judgment made the aspirations of the Indian state for maintaining the availability of cheap drugs abundantly clear. Apart from the Constitution, various international treaties cast similar obligations.⁴⁹

The above discussion makes it clear that there is a need to treat the pharmaceutical sector with caution while preparing future PPH framework with other nations. Since billions of people across the world are dependent on India as ‘only’ source of cheap lifesaving drugs⁵⁰ it is necessary to maintain the status quo in the sector. Therefore, we submit that the pharmaceutical sector must be kept out of all future PPH agreements or any such arrangement, which may have the potential to dilute the patent regime.

IX. CONCLUSION AND SUGGESTIONS

Ever-increasing workload and backlog of applications, have forced various patent offices to look for alternative methods of fast-track disposal of patent applications. The USPTO was a pioneer in the pursuit and looked for various work-sharing arrangements. As a result, the PPH pilot program was started, which proved to be immensely successful in reducing backlogs and expediting the process, and was later emulated by various patent offices in the world. PPH

⁴⁴INDIA CONST. art. 21.

⁴⁵*Bandhua Mukti Morcha v. Union of India*, AIR 1984 SC 802 (India).

⁴⁶*State of Punjab v. Mohinder Singh*, (1997) 2 SCC 83 (India).

⁴⁷Patents Act, 1970, No. 39, Acts of Parliament, 1970, § 3(d) (India).

⁴⁸ *Novartis v. Union of India*, (2013) 6 SCC 1 (India).

⁴⁹G.A. Res. 217 (III) A, Universal Declaration on Human Rights (Dec. 10, 1948) art.25; International Covenant on Economic, Social and Cultural Rights art. 12, Dec. 16, 1966, 993 U.N.T.S. 3.

⁵⁰Randeep Ramesh, *Cheap Aids Drugs Under Threat*, THE GUARDIAN (Mar. 23, 2005), <https://www.theguardian.com/world/2005/mar/23/india.aids1>.

arrangement mainly aims at reducing the redundancy and duplication of work done by the patent examiners and thereby providing expedited examination to the applicants.

As opposed to common perception, a PPH is not a sure-shot guarantee to the success of a patent application, but instead, it is a trade-off undertaken by the applicant. Therefore, an applicant must aim at optimising the application process to get the application approved with the maximum scope of the claim and within the least cumulative time. This is done by selecting the preferred OFF strategically. The office that poses the lowest bar to patentability and has lesser backlog shall be selected as OFF. The indirect positive global impact of this strategy is that spreading out of examination workload results in efficient usage of global resources.

However, there are certain concerns regarding the PPH framework. The biggest concern is that in a PPH arrangement, the OLE cedes its control over the examination process to the OEE. This might lead to a bifurcated patent regime in a country. However, these concerns are based on a misguided premise that OLE will blindly follow the examination result of the OEE. It is to be kept in mind that a PPH is a work-sharing program and not a result-sharing program. However, to pre-empt any such situations, it is suggested that Patent Offices mandate the examiners to follow the local substantive law in the examination. Also, a mechanism should be developed by both the offices to review the working of each other.

Harmonisation of patent law is sought to be achieved by international agreements such as TRIPS. While harmonisation has its benefits, it poses various challenges to the developing nations. The rich and poor nations have been opposed to each other on this front. PPH might be a mechanism that can lead to indirect and gradual harmonisation while providing developing nations with an adequate amount of safeguards. In order to avoid harmonisation the patent office should issue binding guidelines for examiners and review the working of the two patent offices by each other. The biggest advantage of a PPH over any global agreement is that two or three nations can easily negotiate the agreement in a way to maximise their respective interests, which is not possible in a multilateral treaty.

India's recently entered PPH program will certainly help in boosting the Make in India program, especially in a post-COVID economic order when Japanese companies are moving out of China. However, currently, the number of PPH applications is capped at 100 per annum, it is expected that the number will go up in the coming years. India should also seek to enter PPH with other countries after considering the result of the pilot PPH with Japan.

India, being one of the biggest markets in the world, needs to tread carefully in the future while entering into PPH agreements. The aspirations and needs of patent law in India are significantly

different from that of developed nations. Therefore, a concrete and comprehensive policy needs to be formed to guide the future PPH frameworks, which provide an adequate safety net to the local companies and not let it dilute the patenting thresholds envisaged by the Patents Act.