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Overlapping of Trademarks with Patents in India

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ABSTRACT

The dynamic shifts in Intellectual Property Rights (IPRs) in India necessitates a closer examination of the legal complexities arising from the intersection of trademarks and patents. This research paper explores the subtle conflict that arises when inventions patented are later asserted under trademark law. The market benefits from patents which grant exclusive rights to promote development and trademarks ensure brand recognition and protection of reputation. The union of patents with trademarks consistently works against the core purposes established by IPR legislation. The paper conducts an extensive examination of features in the Trade Marks Act of 1999, Patents Act of 1970 and TRIPS Agreement to identify foundational principles of functionality, distinctiveness, and secondary meaning. The study examines worldwide legal practices with focus on American and European Union approaches to identify global benchmarks and best practices. Lastly, it suggests pragmatic reforms so that trademark law is not exploited to maintain post-patent exclusivity thereby sustaining the balance between innovation alongside competitive fairness and consumer welfare in India.

Keywords: Trademark-Patent Overlap, Functionality Doctrine, Secondary Meaning, Patent Law, Trademark Law.

I. INTRODUCTION

Intellectual Property Rights (IPR) constitute a fundamental aspect of legal protection in the modern economy, providing exclusive rights to creators and innovators over their intellectual assets. The recognition and enforcement of these rights ensure a balance between encouraging innovation and safeguarding public interest. The IPR is broadly categorized into various forms wherein each IP serves a different and unique function within the scope of legal protection.

The broad categories of IPR are patents, trademarks, copyrights, industrial designs etc. Out of these, trademark is important as it increases the economic growth by protecting the brand identity, defending consumer trust and enabling the companies to differentiate their products and services from the one of the same competitors which widespread in the identical or similar

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market.

The evolution of IPR may go back to past centuries wherein there were arrangements that protected inventions and trade identification prevailing in earliest or rudimentary phases without their strong legal sanction.³ Intellectual property's idea remained a significant theme from the industrial era with proper judicial recognition. There was initiation of technological innovation, and it initiated commercial improvement within the whole world. This evolution required that there be a formal legal framework to safeguard intellectual property from any unauthorized use or access.

II. CONCEPT OF OVERLAPPING IN INTELLECTUAL PROPERTY RIGHTS

Intellectual Property Rights (IPRs) create a legal framework to protect the rights of creators and innovators over their intangible property. Each form of IPR is intended to serve a different purpose but the overlaps exist frequently because of the multi-faceted nature of intellectual property.⁴ This means that a single subject matter may qualify for multiple legal protection under different frameworks. Overlapping IPRs occur when an innovation or creation may be protected by two or more IPs, thereby making it difficult to understand and address the problems related to enforcement, ownership and potential conflicts.

III. BASIC INTRODUCTION TO TRADEMARKS

(A) Evolution and Development of Trademark Law

Trademark law has also changed markedly over time according to the needs of industry, business, and consumer protection. A trademark is a term, symbol, mark, or a combination of words or symbols, which identifies and distinguishes one's products or services from another's.⁵ The prime aims of protecting a trademark are the protection of goodwill of the company, the avoidance of customer confusion, and maintenance of brand identification.

Traditionally, trademark law has evolved a lot at the global level, with international conventions influencing national laws. Legislative enactments and common law formed the basis for the evolution of trademark law in India. Trademarks were initially protected by the passing-off theory.⁶ Due to the necessity of a formal legal framework, various trademark laws were enacted.

³ Andrew Beckerman-Rodau, 'The Problem with Intellectual Property Rights: Subject Matter Expansion' (September 10, 2010), *Yale Journal of Law & Technology*, vol. 13, no. 35, Suffolk University Law School Research Paper No. 11-14, available at SSRN: <https://ssrn.com/abstract=1754781>.

⁴ Prathiba M Singh, 'Contours of IP Legislations: The Overlaps' (Workshop for High Court Justices on Intellectual Property Rights, National Judicial Academy, Delhi, 2015).

⁵ Richa Kumar, "Recent Developments in Trademark Laws in India", *Journal of Legal Research and Juridical Sciences*, Volume 2, Issue 1, ISSN: 2583-0066.

⁶ Mathias Strasser, "The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine Into Context," (2000) 10 *Fordham Intellectual Property, Media and Entertainment Law Journal*.

India's trademark legislation has, in recent years, been shaped to fit into international intellectual property frameworks like the Madrid Protocol (1989), Paris Convention (1883), and Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement (1995).

According to Section 2(zb) of the Trademarks Act, 1999, 'Trademark' is defined as "a mark capable of being represented graphically to distinguish goods or services of one person from those of other persons. It also includes the shape of goods, packaging of goods, and combination of colours."⁷ In its simplest form a trademark may be any sign, word, phrase, design, or any combination thereof⁸ that identifies and distinguishes the goods or services of a company.

(B) Key Elements of a Trademark

The fundamental elements of a trademark lie at its heart, which are all critical to defining and protecting the identity of goods or services in the market place. There are two fundamental elements that distinguish a trademark: capability of representation, and distinctiveness. Together, these elements establish the foundation of how trademarks are registered, acknowledged, and protected against infringement. The fundamental elements of a trademark are:

- 1) **Capability of Representation:** Critical to the essence of a trademark is capability of representation, which necessitates a graphical depiction. A trademark can take on many forms; word mark, logo, symbol, and increasingly non-traditional marks like sound, or smell. The capability for a mark to be represented visually is required for the purposes of registration and enforcement,⁹ it is required to ensure clarity and disclosure in determining the source of goods or services.
- 2) **Distinctiveness:** Distinctiveness is an essential element of trademark protection requiring marks to be sufficiently distinctive to uniquely identify the source of a business's goods or services and distinguish them from the goods or services of other sellers.¹⁰ This means that generic and/or descriptive terms do not qualify as trademarkable. Distinctiveness is about being unique and original and allows trademarks to achieve value to their owners categorizing them as exclusive source identifiers to build

⁷ Trade Marks Act 1999 (India).

⁸ Gideon Parchomovsky and Peter Siegelman, "Towards an Integrated Theory of Intellectual Property," (2002) 88 *Virginia Law Review*.

⁹ Chakraborty Atish, "Graphical Representation and Indian Trademark Law", *Legis Sententia*, available at: <<https://medium.com/legis-sententia/graphical-representation-and-indian-trademark-law-bbaa610ef401>> (accessed on 16 April, 2025)

¹⁰ Neil Wilkof, Shamnad Basheer, and Irene Calboli (eds), *Overlapping Intellectual Property Rights* (2nd edn, Oxford University Press 2023).

trust and loyalty with consumers.

A trademark is an important business asset to differentiate a business's products or services, and build recognition and loyalty among its consumers. A trademark is an important asset that provides legal protection, establishes a variety of functions, and ultimately provides value to the commercial success and reputation of a business entity.¹¹ A complete knowledge of the importance and extent of protection afforded by trademarks is critical in allowing businesses to maximize and protect their intellectual property rights in a competitive marketplace.

IV. PATENT LAW IN INDIA: LEGISLATIVE FRAMEWORK AND TRIPS COMPLIANCE

(A) Introduction to Patent Law in India

Patent law is one of the most key parts of the intellectual property rights (IPR) regime in India, which plays an imperative part in contributing to economic growth and innovation. Patents enable inventors to prevent any individual from producing, using, selling, or offering their concepts without permission, and they bestow on them an exclusive monopoly on their innovations for a limited 20-year time. In promoting technological development, the Indian Patents Act of 1970 aims to maintain the balance of interests among inventors, entrepreneurs, and the public while maintaining crucial innovations available to the public for use after the patent duration.

The patent system promotes research and development (R&D) in a number of areas, including manufacturing, biotechnology, electronics, and pharmaceuticals, by acting as a time-limited monopoly. As long as they satisfy the legal criteria of originality, innovative step, and industrial usefulness, patents can be applied to new innovations, including methods, goods, and material compositions.

However, there is one important challenge: when some attributes of patented products—product forms, shapes, or trade dress—gain secondary meaning and ultimately are asserted as trademarks.¹² Herein lies an intersection between patent and trademark rights, which imposes critical legal inquiries into the limit of monopoly powers, the domain public, and honest competition.

(B) Impact of the TRIPS Agreement on Indian Patent Law

Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement, to which India

¹¹ Wadehra B. L, "Law Relating to Intellectual Property", 5th ed., Universal Law Publishing (2016)

¹² Julie E. Cohen and Mark A. Lemley, "Patent Scope and Innovation in the Software Industry," (2001) 89 California Law Review.

became a signatory under its World Trade Organization (WTO) commitment in 1995, has had a profound influence on the patent law of the country. TRIPS sets minimum standards of protection for patents among member countries and obliges them to provide protection for patents in all technology areas on a non-discriminatory basis.

As per TRIPS, India made significant changes to the Patents Act, 1970, by the Patents (Amendment) Act, 2005. The most significant was the shift from a regime of process patents to one of product patents, specifically for pharmaceuticals and agrochemicals.¹³ The amendment provided for stronger patent protection in India and also added public interest provisions, including compulsory licensing under Section 84 and pre-grant opposition under Section 25 to curb monopolistic misuse.

As much as TRIPS enhanced patent protection, it has also resulted in more conflicts concerning trademark-patent overlaps, especially when companies sought to take advantage of trademark law to lengthen expired patent protections, a move that evoked monopolization and unfair competition concerns.

V. TRADEMARKED DESIGNS VS. PATENTED INVENTIONS

(A) Understanding the Conflict Between Trademarks and Patents

The core difference between trademarks and patents is their legal purpose. Patents safeguard inventions by providing exclusive rights over utilitarian innovations, while trademarks safeguard brand identity to guarantee market recognition and consumer confidence. The intersection happens when businesses try to acquire trademark protection for product design, form, or functional features that are already patented.

The problem begins when a company first patents an operational design or shape and, after the patent has lapsed, attempts to register it for trademark so as to keep exclusive rights on the aspect.¹⁴ This technique, often employed in luxury products, drugs, and industrial products, can block competition and reduce consumer options.

For example, the Coca-Cola bottle's shape was first patented as a functional design to provide improved grip and longevity. After the patent lapsed, Coca-Cola sought trademark protection on the grounds that the shape of the bottle had gained distinctiveness and was used as a brand identifier. Courts needed to decide whether the shape of the bottle was functional or related to

¹³ Darden, "Overlapping and Sequential Copyright, Patent, and Trademark Protections," *Columbia Journal of Law & the Arts*, Vol. 44 Issue 2 (2021)

¹⁴ Julie E. Cohen and Mark A. Lemley, "Patent Scope and Innovation in the Software Industry," (2001) 89 *California Law Review*.

the goodwill of the brand, underlining the difficulty of demarcating the lines between patent and trademark law.

VI. INDIAN CASE LAWS ON TRADEMARK-PATENT OVERLAP

1. Coca-Cola's Bottle Shape Protection Case¹⁵

The most widely recognized case of trademark-patent conflict is Coca-Cola's contour bottle shape. The initial shape of the bottle was safeguarded through design patents, accorded Coca-Cola sole authority over its functional and manufacturing design features. Upon the termination of the patent, however, Coca-Cola filed for trademark registration of the shape of the bottle, maintaining that it had obtained secondary meaning and was an integral component of the identity of the brand.

In India, Coca-Cola's bid to trademark the contour bottle shape was faced with judicial challenge. Courts evaluated whether the design's distinctiveness was primarily functional or whether it had acquired trademark significance. The case underscored the fine balance between functionality and distinctiveness, preventing companies from misusing trademark law to extend monopolies on expired patents.

2. F. Hoffmann-La Roche Ltd v. Cipla Ltd (2009) – Patent vs. Brand Identity Protection

A significant Indian case addressing the conflict between patents and trademarks in the pharmaceutical industry is *F. Hoffmann-La Roche Ltd v. Cipla Ltd (2009)*¹⁶. Roche, a global pharmaceutical company, had a patent for the anti-cancer drug¹⁷ 'Tarceva' and also sought to enforce its trademark rights over the brand name. Cipla, an Indian pharmaceutical company, manufactured a generic version of the drug,¹⁸ challenging Roche's monopoly.

The Delhi High Court held that the existence of a valid patent does not automatically grant a trademark right over the product's name or design. The ruling reinforced that patent protection pertains to the chemical composition and functional utility, whereas trademarks protect brand identity and consumer association. The judgment was a landmark in balancing intellectual property rights, ensuring that patent law is not used as a backdoor method to monopolize drug markets beyond patent expiration.

¹⁵ *The Coca Cola Company and Ors. Vs. Narsing Rao and Ors*, MANU/DE/0699/2014

¹⁶ (2009) 40 PTC 125 (Del)

¹⁷ Shamnad Basheer, 'Intellectual Property Overlaps: An Indian Perspective' in Neil Wilkof, Shamnad Basheer and Irene Calboli (eds), *Overlapping Intellectual Property Rights* (Oxford University Press 2012), <https://ssrn.com/abstract=2436430> (accessed on 25th April, 2025).

¹⁸ *Ibid.*

VII. JUDICIAL APPROACHES IN INDIA & COMPARATIVE ANALYSIS

(A) Indian Judicial Approach

Indian courts have consistently upheld the doctrine of functionality, preventing companies from using trademarks to monopolize functional product features beyond the life of a patent. Courts assess whether a product's design has acquired secondary meaning and whether it serves as a brand identifier rather than a functional element.

(B) Comparative Analysis with International Jurisdictions

- **United States:** The U.S. Supreme Court in *Traffix Devices, Inc. v. Marketing Displays, Inc.* (2001)¹⁹ ruled that once a utility patent expires, the functional elements disclosed in the patent cannot be protected as trade dress, unless secondary meaning is established.
- **European Union:** The EU Intellectual Property Office (EUIPO) has taken a stricter approach, denying trademark protection for any design element that provides a functional advantage, regardless of consumer perception.
- **India:** Indian jurisprudence follows a middle-ground approach, allowing shape marks and product designs to be registered as trademarks only if they have distinctiveness and secondary meaning,²⁰ but preventing protection if functionality is evident.

VIII. RESOLVING TRADEMARK-PATENT DISPUTES IN INDIA

(A) The Three-Pronged Test for Trademark-Patent Conflicts

Indian courts use a structured test to resolve disputes where patents and trademarks overlap:

1. **Functionality Test:** If a design or shape is essential for the functioning of a product, it cannot be monopolized under trademark law.
2. **Distinctiveness Requirement:** The design must have acquired secondary meaning beyond its functional use.
3. **Consumer Perception Test:** Courts assess whether consumers associate the design with the brand or the product's function.

(B) Policy Recommendations and Legal Reforms

- Amendments to the Trade Marks Act, 1999, to include stricter provisions preventing functional registrations.

¹⁹ 532 U.S. 23 (2001)

²⁰ Madhumitha Dharmapuri Selvakumar, 'Overlap of Trademarks with Other Intellectual Property Rights: The Strategies of Global Brands' (2022) 13 *Beijing Law Review* 429-448 <https://www.scirp.org/journal/blr> DOI: 10.4236/blr.2022.132027.

- Strengthening opposition mechanisms during trademark registration to scrutinize functional elements more rigorously.
- Introducing a clearer framework within Indian patent law to guide post-patent protections, ensuring balance between innovation and fair market competition.

IX. CONCLUSION

In India, the interaction of patents and trademarks is a contested legal issue to be addressed in a cautious approach. The protection of brand identification is granted by trademarks and technological innovation assured by patents.²¹ The meeting point of both results in contests over monopoly increases. Although accepting the registrability of distinctive marks of shape under certain conditions, Indian courts have applied the law of functionality to bar corporations from utilizing trademarks to prolong patent protection already expired.

The future of Indian patent and trademark law has to be centred on a single legal framework to ensure that companies compete on an even keel while having strong intellectual property protection, considering the fast pace of product development, digital branding, and AI-driven innovation. A balanced system is needed to promote innovation, healthy competition and consumer protection, so that Indian intellectual property law remains updated with international best practices.

²¹ Viva R. Moffat, "Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection", *Berkeley Technology Law Journal*, Volume 19, Issue 4, Fall 2004, pp. 1473-1532