

## Legal Issue in ‘Joint Ownership of IP’

Issue: Can a Joint Author of a Copyrighted Work Independently  
Exploit Rights in it?

## Introduction

- ❖ Authorship is at the heart of Copyright Law. Without original authorship, copyright cannot exist.
- ❖ The “Post-Print” culture demands a change in the notions of author’s rights under the Copyright regime.
- ❖ Large scale collaborations have become more prominent as the digital space makes it easier for content creators to work together.
- ❖ While collaborative creativity is not a new concept, however, collective authorship or large-scale collaborations pose new challenges to copyright law.

## Relevant Provisions of the Copyright Act, 1957

- ❖ **Section 2(z):** “*Work of joint authorship means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors*”; [Emphasis supplied]
- ❖ **Explanation to Section 13(2):** “*...In the case of a work of joint authorship, the conditions conferring copyright specified in this sub-section shall be satisfied by all the authors of the work*”; [Emphasis supplied]
- ❖ **Section 17:** “*First owner of copyright— Subject to the provisions of this Act, the author of a work shall be the first owner of the copyright therein...*”; [Emphasis supplied]
- ❖ **Section 18:** “*Assignment of copyright.— (1) **The owner of the copyright** in an existing work or the prospective owner of the copyright in a future work **may assign** to any person the copyright either wholly or partially and either generally or subject to limitations and either for the whole term of the copyright or any part thereof...*”; [Emphasis supplied]

## Relevant Provisions of the Copyright Act, 1957 (Contd.)

- ❖ **Section 19:** *“Mode of assignment.— (1) No assignment of the copyright in any work shall be valid unless it is in writing signed by the assignor or by his duly authorised agent”;*
- ❖ **Section 30:** *“Licenses by owners of copyright— The owner of the copyright in any existing work or the prospective owner of the copyright in any future work may grant any interest in the right by license in [writing by him] or by his duly authorised agent...” [Emphasis supplied]*

## Comparison between the Copyright Act, 1957 and the Trade Marks Act, 1999

Copyright Act, 1957	Trade Marks Act, 1999
<p><b>Section 2(z)</b> : “<i>work of joint authorship means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors</i>” [Emphasis supplied]</p>	<p><b>Section 24 : Jointly owned trade marks.—</b></p> <p>“...Where the <u>relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it</u> except—</p> <p>(a) on behalf of both or all of them; or</p> <p>(b) in relation to an article or service with which both or all of them are connected in the course of trade,</p> <p>those persons may be registered as joint proprietors of the trade mark, and this <u>Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.</u>” [Emphasis supplied]</p>

## *Najma Heptullah v. M/s Orient Longman Ltd., [AIR 1989 DEL 63]*

- “ ...Levy v. Rutley, 1871 Vol. Vi, Law Reports, C.P. Vi, 523...it may not be necessary that each should contribute the same amount of labour, there must be a joint labouring in furtherance of a common design...if two persons undertake jointly to write a play, agreeing in the general outline and design, and sharing the labour of working it out, each would be contributing to the whole production, and they might be said to be joint authors of it. But, to constitute joint authorship, there must be a common design.”
- “...if two persons collaborate with each other and, with a common design, produce a literary work then they have to be regarded as joint authors...if there is 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.”
- “...There was a reconverted joint design between the two in the writing of the book...it is not possible for me to come to the conclusion that Prof. Kabir was the sole author of the aforesaid work. As at present advised, it appears tone that Maulana Azad and Prof. Kabir have to be regarded as the joint authors of the Said work. Prof. Kabir was more than a mere scribe of the thoughts of Maulana Azad. Both of them actively and intellectually collaborated in the compositions of the literary work...” [Emphasis supplied]

## *Nav Sahitya Prakash and Ors. v. Anand Kumar and Ors. [AIR 1981 All 200]*

- ❖ **Issue 1: Whether a co-owner has a right to sue third-parties for infringement?**
- ❖ **Issue 2: Whether a co-owner can be sued for copyright infringement?**
- **Held:** “ *The right in the copyright having not been divided each one of them was entitled to the same right as the other*...being a co-owner, had no right without the consent of others to give a license and since he had indulged into an illegal (dealing) and by indulging into it committed an infringement, he was guilty of infringement.....In *Halsbury’s Laws of England 3rd Edition, Vol, III, para 738*, the law laid down is as follows :-

*One joint author cannot reproduce the work himself, or grant license to others to reproduce it, without the consent of other author or authors, but may by himself take proceedings for infringement against third party...*” [Emphasis supplied]

## *Angath Arts Private Limited v. Century Communications Ltd. & Ors.* [2008(4) MhLJ 926]

- ❖ **Issue:** Whether a co-owner can exhibit the copyrighted work without consent of others?
  - **Placing reliance on:** *Power Control Appliances and Ors. v. Sumeet Machines Pvt. Ltd.* [1994 SCC (2) 448]-

*“It is a settled principle of law relating to trade mark that there can be only one mark, one source and one proprietor. It cannot have two origins. Where, therefore, the first defendant/respondent has proclaimed himself as a rival of the plaintiffs and as joint owner it is impermissible in law. Even then, the joint proprietors must use the trade mark jointly for the benefit of all. It cannot be used in rivalry and in competition with each other...”*
  - **Held:** “...the respondents cannot exploit the copyright singly or individually. The exploitation of the copyright must be jointly made by the petitioner and respondents as they are the joint owner. The respondents are not entitled to grant license for exploitation of the film "Victoria No. 203" without the concurrence of the petitioner...” [Emphasis supplied]



## Issues with the Requirement of Consent

- ❖ It is clear from the judicial precedents that, a joint-author under the Act, cannot exploit rights in the copyrighted work individually, seriously impeding commercialization of work.
- ❖ An obvious corollary is that a co-author cannot create a follow-on work based upon the copyrighted work without consent of the other author(s). Neither can a such co-author grant permission to a third party to create a follow-on work based upon it.
- ❖ On the flip-side, a person willing to create derivate work requires permission from all co-authors of the copyrighted works.
- ❖ Requiring permission from all joint authors before an existing work can be borrowed from and built upon, expands the copyright monopolies of the initial creators and curtails the future creative endeavors.

## Is there a Solution?

### ❖ The American Approach:

- Each author is the owner of not only the part he or she created but of the whole work. Every author can freely use the work and license it out for others to use it.
- A co-owner of a work of joint authorship does not require other authors' permission to use the work himself, and the other authors can't object to such a use.
- If the license has been granted by one of the joint authors unilaterally, then the license fee collected, if any, must be shared appropriately with other joint authors.
- In the absence of an agreement determining how the license fee is to be shared, every joint author must receive an equal share irrespective of the amount of their individual contribution to the joint work.

**THANK YOU!**  
**Questions?**

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