

LEGAL PROTECTION FOR FASHION DESIGNS

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I. INTRODUCTION

The Indian Fashion Industry has been growing at a rate of 9.5 % annually and is expected to become a Rs. 750-crore industry by 2012.¹ Demand for clothes made by fashion designers has been constantly rising. As in the case of any social change, law has much catching up to do. Instances of copying of designs have been bothering designers for some time. Copying in the fashion industry is often referred to as “knocking off”.² The Indian legal framework for protection of fashion designs is complex and has been in need of greater clarity. Laws pertaining to trademarks³, designs and copyrights have all been used by designers, but that has not prevented them from being wary of the adequacy of our legal framework.⁴ It is in this context that two recent decisions of the High Court of Delhi assume great significance. While the first case denied the plaintiff-designers to sue for infringement under copyright law, the second case upheld the very same. However, a close reading of both the judgments is necessary to see if they lay down contradictory principles with regard to applicability of copyright law to fashion designs. We have thus attempted to cull out a coherent framework for protection of fashion designs under Indian Laws from the judgments.

Before we begin our discussion of the judgments, we believe it is necessary to discuss the legal position with regard to the issue in certain foreign jurisdictions. In particular, the United States (“U.S.”) and the European Union (“EU”) offer two sharply contrasting models for protection of fashion designs. In the U.S., protection is scarce and attempts to provide legislative protection have been made only as recently as 2006, whereas the position in the EU has seen exceptionally high levels of protection for fashion design.

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1. See <http://www.fashionenigma.com/articles/article168.asp>.

2. Teri Agins, *Copy Shops: Fashion Knockoffs Hit Stores before Originals As Designers Seethe*, *The Wall Street Journal*, August 8, 1994. Available at: <http://leda.law.harvard.edu/leda/data/36/MAGDO.html#fn1>.

3. At least in the U.S., the law of Trademarks is considered to give little protection against illegal copying of fashion designs as “for the vast majority of apparel goods the trademarks are either inside the garment or subtly displayed on small portions such as buttons.” See generally, Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1740 (2006).

4. *Wary of copycats, fashion designers rush to register designs*, See <http://www.expressindia.com/news/fullstory.php?newsid=50734>.

II. THE AMERICAN POSITION – CHANGING TIMES

In the U. S., there has been a history of debate between pro-protection and anti-protection lobbies both within and outside the fashion industry. The original Copyright Act enacted in 1870 granted protection to “*paintings, drawings... models or designs intended to be perfected as works of the fine arts....*”⁵ However, the term “fine arts” was never meant to include useful articles, but apparel designs were always considered to fall in to that category.⁶ The definition of “works of art” under the statute was revised in 1909⁷ and 1949⁸. However, the Act continued to label garments as utilitarian and failed to consider them protectable works.⁹ In 1935, a highly effective association called the ‘Fashion Originator’s Guild of America’ was formed by designers wherein they pledged to deal only in original creations. However the guild had to be closed because the Supreme Court found their practices to be in violation of the Sherman Anti-Trust Act.¹⁰

Under the current U.S. copyright statute, works of artistic craftsmanship are included “insofar as their form but not their mechanical or *utilitarian* aspects are concerned.”¹¹ The statute further provides “*the design of useful articles... shall be considered a pictorial, graphic or sculptural work (and thus afforded copyright protection) only if, and only to the extent that such design incorporates pictorial, graphic or sculptural features separately from, and are capable of existing independently of the utilitarian aspects of the article*”.¹²

The question as to whether design elements can be separated from the utilitarian aspects of clothing has been looked into in several cases.¹³ The much

5. Act of July 8, 1870, ch. 230, 86, 16 Stat. 198, 212 (repealed 1916). As cited in S.A. Nurbhai, *Style Piracy Revisited*, 10 J.L. & POL’Y 489 (2002).

6. *Ibid.* at p. 494.

7. “In 1909 the Copyright Act was revised, and the word ‘fine’ was dropped. It thus appeared that useful articles could gain protection. To the disappointment of fashion designers, however, although the new law did not differentiate between ‘fine arts’ and arts that have a useful function, a 1910 Copyright Office regulation did”, *Ibid* at p. 494. As cited in Stuart Jay Young, *Freebooters in Fashions: The Need for a Copyright in Textile and Garment Designs*, 9 COPYRIGHT L. SYMP. (ASCAP) 76, 103 N.10 (1958).

8. *Ibid* at p. 495

9. *Wm. Filene’s Sons Co. v. Fashion Originator’s Guild of Am.*, 14 F. Supp. 353, 354 (D. Mass. 1936), *aff’d*, 90 F.2d 556 (1st Cir. 1937).

10. *Fashion Originator’s Guild of Am v. Federal Trade Commission*, 312 U.S. 457 (1941).

11. H.R. Rep. No. 94-1476, at 55 (1976).

12. This provision is considered to be codification of the principle laid down in the landmark case *Mazer v. Stein*, 347 U.S. 201 (1954).

13. Such separation has been categorized into Conceptual and Physical. For a detailed discussion of the principles and cases. See Richard G. Frenkel, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-Trips Era*, 32 Loy. L.A. L.

discussed *Whimsicality* cases held that clothing, at least in the context of costumes, is inherently utilitarian and designs thereupon cannot be separated from its utilitarian character.¹⁴

However, there has been growing support to the perception that in the American fashion industry a fashion design has changed from its primarily utilitarian function. This has led it to its intertwining with the art industry more and more over time.¹⁵ Exhibits in renowned museums displaying art by fashion designers are often touted as evidence of this blend of fashion and art.¹⁶

Questions have also been raised within the industry about the desirability of copyright protection. Arguments have been advanced that the American fashion industry has only gained from copying. In fact, it is believed that the practice of the American fashion industry to ‘knock off’ European designs was the primary reason for its growth in the early 20th century. While some authors argue against strong protection for fashion designs on the basis that copying in the fashion industry makes trends saturate the market quickly and forces fashion designers to search for newer looks,¹⁷ others believe that there are several factors that would limit copying even in the absence of copyright law including inferior quality, duration of copying, contractual alternative, benefits beyond royalty etc.¹⁸ The former argument is commonly known as the ‘piracy paradox.’

In recent times, there has been a firm shift in the U.S. Congress’ attitude towards affording copyright protection for utilitarian goods. The Vessel Hull Design Protection Act, Title 17, Chapter 13 of the United States Code, was signed into law on October 28, 1998, providing for protection for original designs of vessel hulls.¹⁹

A section of the American fashion industry has been hoping that their produce would be added to the list of such utilitarian goods that are afforded copyright protection for their original expression. This hope was realised on

REV. 531, 541 (1999). See Also, Brandon Scruggs, *Should Fashion Design be Copyrightable*, 6 NW. J. OF TECH. & INTELL. PROP. 122 (FALL, 2007).

14. *Whimsicality, Inc v. Rubie’s Costume Co.*, 891 F. 2d 452 (2d Cir. 1989) (*Whimsicality I*).
15. Julie. P. Tsai, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK. L. REV. 447, 461 (2005).
16. *Ibid.*
17. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006).
18. William Landes & Richard Posner, *The Economic Structure of Intellectual Property Law* (2003). As cited in, Brandon Scruggs, *Supra* Note No. 13.
19. For a discussion in the context of fashion design, See Statement of the United States Copyright Office before the Subcommittee on Courts, the Internet, and Intellectual Property, Committee on the Judiciary, United States House of Representatives, 109th Congress, 2nd Session, July 27, 2006 available at <http://www.copyright.gov/docs/regstat072706.html>. (Hereinafter “Statement of the Copyright Office”).

May 30, 2006 when a bill titled House Resolution 5055 (“H.R.5055”). This Bill was introduced in the American House of Representatives - the Design Piracy Prohibition Act (S1957: The Schumer-Hutchison-Feinstein Bill) to afford protection to fashion designs under the scope of the Digital Millennium Copyright Protection Act.²⁰

The proposed legislation would “*prevent anyone from copying an original clothing design in the United States and give designers the exclusive right to make, import, distribute and sell clothes based on their designs.*”²¹

It is pertinent to note that the term ‘original’ is used in the legislation. The definition of originality is given as “*if it is the designers’ creative endeavour that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.*”²² Apart from requirement of originality, the legislation provides for an application process for registration to be completed before the copyright office. The copyright office is empowered to accept or deny the application against which decision the legislation provides for an appeal process and at the next level allows for judicial review.²³ Once a creation is ‘deemed original’ and is registered, the fashion design would enjoy protection for a stint of three years.²⁴ Although the term of three years is considerably shorter than the usual duration for protection under the general copyright law, it appears that the utilitarian nature of fashion designs has been an important consideration in not putting it in the same category as any other artistic work.²⁵ Infringement of a registered fashion design would lead to allowance of compensatory damages, recoupment of profits, attorney’s fees and destruction of all infringing articles.²⁶

The Bill is yet to be approved by the House and according to several authors and commentators it is likely that the resolution would be forced to undergo certain modifications. Nonetheless, it marks a major shift in American policy away from its long held disinclination towards granting protection to fashion designs.

20. See <http://thomas.loc.gov/cgi-bin/query/z?c109:H.R.5055>.

21. Emily. S. Day, *Double-Edged Scissor: Legal Protection for Fashion Design*, 86 N.C.L. REV. 237, at p. 268 (2007).

22. 17 U.S.C. § 1301 (b)(1) (2000).

23. For the requirements of the copyright application. See 17 U.S.C. § 1310 (b)(1) (2000). For the appeal process, See 17 U.S.C. § 1313 (b)(1) (2000).

24. H.R.5055 § 1(c) (2006).

25. The three year period is also considered to be the period of time during which fashion designs are most at risk. See Statement of the Copyright Office, *Supra* Note No. 21.

26. H.R.5055 § 1(g) (2006).

III. POSITION IN THE EU – THE LAND OF FASHION

While the American fashion industry has always been considered to be under-protected by intellectual property law, the European position, by contrast, is clearly one of abundant protection. National laws of most European countries offer high levels of protection for fashion designs.

France is considered to afford the most liberal copyright protection to the fashion industry under the ‘doctrine of unity of art’.²⁷ The product’s utilitarian function or the originality of its creation is immaterial. As an author summarizes,

*“In France, the Copyright Act of 1793 protects a fashion design as applied art and the Copyright Act of 1909 protects it as a nonfunctional design and pattern. Moreover, French law does not require the element of originality in the design; it provides copyright protection once the design becomes popular with the general public.”*²⁸

In addition to these strong national laws, the EU has introduced the ‘European Directive on Legal Protection’. This directive requires member countries to create a ‘design right’ which needs to display novelty, be registered and have individual character.²⁹ A designer who is granted such a right enjoys, firstly, an exclusive right to use his design and any design that produces the same overall impression and secondly, along with the right to prevent any third party from using it without his consent³⁰ both can be enjoyed for “one or more period of five years.... upto a total of 25 years.”³¹

IV. THE INDIAN POSITION-RECENT DEVELOPMENTS

The Delhi High Court (“Court”) in *Microfibres Inc. v. Girdhar & Co.*³² (“*Microfibres*”), attempted to postulate the Indian legal position on copyright protection for fashion designs. The decision of the Single Judge in the case was challenged before the Division Bench. We shall first deal with the judgment of the Learned Single Judge and its salient features. Briefly, the facts of the case entailed an American company which was engaged in the business of selling and exporting upholstery fabrics under the brand name ‘Microfibres’. It filed a suit for infringement against the defendant for manufacturing and selling

27. *Supra* Note No. 20, at p. 266.

28. Oliver Medenica, *Designers seek to prevent cheaper knockoffs*, Nat’l L J, Aug. 28, 2006, See <http://www.wrlawfirm.com/Blog/2006/10/fashion-copyright-bill-analysis-by-wm.html>.

29. Council Directive 98/71, 1998 O.J. (L 289)28 (EC). Article 3.

30. *Ibid.*, Article 12.

31. *Ibid.*, Article 10.

32. *Microfibres Inc. v. Girdhar & Co.*, 2006 (32) PTC 157 (Del).

upholstery fabric that bore the artistic works considered to be identical copies or colourable imitations of the artistic work of the plaintiff. Though there were several contentions raised by both sides, for the purpose of this comment, we shall be concerned with just one issue decided in the case – the plaintiffs’ claim that their work constituted original artistic work under the meaning of Section 2(c) of the Indian Copyright Act, 1957 which would entitle them to enjoy copyright protection under Section 40 of the Act.³³ The defense raised by the defendant was simply that the artistic works claimed by the plaintiff were actually designs relating to textile product and thus came within the scope of the Designs Act, 1911 and not the Copyright Act, 1957. The defendants claimed that under the Designs Act, the work on the plaintiffs’ fabric was not entitled to any protection as registration is a mandatory requirement under it.³⁴

The legislature has attempted to establish the relationship between copyrights and designs through two of the aforesaid provisions. Section 2(d) of the Designs Act, 2000 defines a design as expressly exclusive of any artistic work as defined in Section 2(c) of the Copyright Act.³⁵ It is noteworthy that the Designs Act, 1911 did not have this specific exception in relation to artistic work.³⁶ Similarly, Section 15(1) of the Copyright Act makes it clear that any design which is registered under the Designs Act shall not be copyrightable, the only exception being Section 15(2) which shall be dealt with later. Therefore, a design which has already been registered or is capable of being registered

33. *Ibid*, at ¶5.

34. It must be noted that unlike the provisions of the Copyright Act, the Designs Act, 2000 requires registration for extending its protection. Chapter II of the Act deals with registration of Designs. Section 11 reads: “Copyright on registration, (1) when a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration. (2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.”

35. The Designs Act, 2000, Section 2 (d), “design means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or Chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical devise, and does not include any trade mark as defined in clause (V) of Sub-Section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in Section 479 of the Indian Penal Code, 1860 (45 of 1860) or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957 (14 of 1957).”

36. The Designs Act, 2000 was enacted to provide a more effective protection to the registered designs. In terms of Section 48, the Designs Act, 1911 was repealed. However any notification, rule, etc., under the old Act, was to continue to be in force.

under the Designs Act³⁷ is not copyrightable and an artistic work as defined in the Copyright Act cannot be treated as a design.

As stated earlier, the Learned Judge denied the plaintiff's right to claim infringement under the Copyright Act, on the basis that the fabric designs fall within the definition of designs under the Designs Act. The reasons for such a conclusion, as given by the Learned Judge, can be arrayed as follows:

- 1) The Learned Judge was pleased to accept the contention of the Counsel for the Defendant that the only category in which such fabric designs can possibly fall in the definition of artistic work as under Section 2(c), would be 'painting'. The Court drew a distinction between paintings in the sense of the works of M.F. Hussain and designs on fabrics stating that only the former could be considered as 'painting' under the definition of artistic work.³⁸ It might be relevant to note that Section 2(c) specifically excludes the requirement of 'artistic quality' in paintings.³⁹ In view of this, it might not be entirely correct to state that only paintings of the nature of M.F. Hussain's work form part of artistic work under the Copyright Act. The Court also made reference to the definition of 'design' under Section 2(d) of the Designs Act to observe that "*in a design the features are merely ornamental and are applied to another article*" unlike an artistic painting which has independent existence.⁴⁰
- 2) The Learned Judge also referred to Classes 13 and 14 of the Fourth Schedule of the Designs Act, 1911 which specifically dealt with printed or woven designs on textile goods being checks or stripes or otherwise. Such protection is now said to be available under Class 5 of the New Design Rules, 2001. The Court termed this an 'important and relevant aspect' to determine that fashion designs should be treated as designs and not artistic work.⁴¹

37. The Designs Act, 2000, Section 15, "Special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 1911, 1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 1911 (2 of 1911) 2) Copyright in any designs, which is capable of being registered under the Designs Act, 1911 (2 of 1911), but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his license, by any other person."

38. *Supra* Note No. 31, ¶ 65.

39. Section 2 (c) "'artistic work' means, - i) a painting, a sculpture, a drawing (including a diagram, map, chart or plain), an engraving or a photograph, whether or not any such work possesses artistic quality;..."

40. *Supra* Note No. 31, ¶ 65

41. *Ibid*, at ¶ 62

- 3) The third and last leg of the Learned Judge's reasoning seems to be the most compelling. The term for protection of a work under the Copyright Act is sixty years as opposed to ten years extendable by five years in case of designs. The Court dwelled elaborately upon the rationale for such a distinction.

The Learned Judge seems to have accepted the defendant's argument that; if the plaintiff's plea were to be accepted then every design would be excluded from the purview of the Designs Act as each design would be able to trace its origin to a diagram, chart, drawing etc. This would have rendered the law of designs redundant and would have stifled competition and industrial innovativeness by granting sixty years monopoly to industrial and commercial designs.⁴² The decision of the *Privy Council in Interlego A.G. v. Tyco Industries Inc., (1988) R.P.C. 343* was referred to note the following;⁴³

“Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. Thus, the primary concern is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, *over a much more limited period*, to prevent the manufacture and sale of articles of a design not substantially different from the registered design”. (Emphasis supplied)

The Learned Judge also referred to a decision in *SS Sarna Inc., v. Talwar and Khullar Private Limited*⁴⁴ wherein it was observed that;

“Copyright Act in general protects the artistic work, but the idea behind excluding certain designs from the protection under the Copyright Act, although otherwise the same design might have been so entitled to protection, appears to be to avoid any hindrance being caused to the manufacture and sale of industrial articles which in the absence of a provision similar to Section 15 could not be achieved. The intention of the Legislature appears to be very clear that *wherever any artistic work has to be in a commercial exploitation by the owner of the copyright the same should be excluded from the protection under the Copyright Act* and should be provided protection under the Designs Act, 1911.” (Emphasis supplied)

42. *Ibid.*, at ¶ 51, 64

43. *Ibid.*, at ¶ 51

44. *Ibid.*, ¶ 52, 66

After referring to the above authorities as well as other cases, the Learned Judge concluded as follows⁴⁵ :

“In order for the work of the plaintiff to qualify as an ‘artistic work’, it must fall within the definition of sub-section (c) of Section 2 of the Copyright Act. A reading of the said provision would show that attempt of the plaintiff can only to bring it within the concept of ‘painting’. The comparison with the painting of M.F.Hussain would be otiose as the work in question, in the present case, is not a piece of art by itself in the form of a painting. There is no doubt that labour has been put and there is some innovativeness applied to put a particular configuration in place. Such configuration is of the motifs and designs which by themselves would not be original. The originality is being claimed on the basis of the arrangement made. What cannot be lost sight of is the very object with which such arrangements or works had been made. The object is to put them to industrial use. An industrial process has to be done to apply the work or configuration to the textile. It is not something which has to be framed and put on the wall or would have any utility by itself. The two important aspects are the object with which it is made which is industrial and its inability to stand by itself as a piece of art. In fact, it has no independent existence of itself”. (Emphasis supplied)

The Learned Judge categorized designs and patents as industrial works that warranted shorter duration of protection than copyrighted works. The commercial nature of fabric designs and their inability to possess independent utility seemingly weighed heavily on the Court’s mind. By implication the Court was of the opinion that fashion designs, *per se*, are not copyrightable. As discussed earlier, the position in the U.S. has been very similar. In particular, the American view that works of a commercial / utilitarian nature should not enjoy copyright protection has been impliedly accepted by the Court.

Therefore, it appears from judgment of the Single Judge that, fashion designs are eligible for protection only under the law of designs which, as noted earlier, mandates registration.

As stated, the decision of the Single Judge was appealed against and thus, a Division Bench had the occasion to consider afresh the question of the inter-relationship between the protections offered by the Copyright Act, 1957

45. *Ibid.*, ¶ 62

and the Designs Act, 2000.⁴⁶ It would be pertinent to note that the Division Bench clubbed the appeal in the *Microfibres case* with appeals from two other cases which essentially dealt with the same question but in non-fashion contexts.

For instance, in one of the appeals, Mattel Inc claimed a copyright in their “Scrabble” board, as well as a copyright in the underlying drawings which were used to create the board. Mattel’s case was essentially that the existence of a copyright upon the underlying drawings would confer upon it the exclusive right to apply these drawings upon any board. They contended that this right would continue to exist irrespective of the fact that Mattel might have lost its ‘copyright in the design’ of the Scrabble Board itself through the operation of Section 15(2) of the Copyrights Act, 1957 by reason of having failed to register the design under the Design Act 2000 and producing more than 50 copies of the Scrabble Board. This is similar to the contention in the fashion context that the underlying ‘painting’ prior to its application to an article of clothing is a copyrightable ‘artistic work’ within the meaning of Section 2(c) of the Copyrights Act. It may be usefully recalled that the Single Judge in *Microfibres* had explicitly rejected such an approach by holding that in the fashion context, the underlying ‘painting’ alleged to exist was in fact incapable of any independent existence prior to its application to an article of commerce, and that the underlying ‘painting’ was created with the sole intention of such industrial application. In the Scrabble context, while it is clear that the underlying image was undoubtedly capable of existing independently from the Board itself (in fact the Board can be considered simply as a 3-D depiction of the 2-D image underlying it), it was still the case that the underlying image was created solely with the intention of commercially producing Scrabble Boards.

The decision of the Division Bench, in this background, makes interesting reading and perhaps is best viewed as a highly nuanced attempt to give effect to a clearly intended but unhappily articulated legislative policy. Although the Division Bench finally dismisses the appeal in the *Microfibres* context as meritless, its judgment is certainly not to be viewed as a mere affirmation of the entire chain of reasoning adopted by the Single Judge. In fact, the Appellate Bench clearly repudiates some of the premises of the Single Judge and uses an alternative path in reaching an identical conclusion. The most important of these repudiations in our view, is in the assertion that the ‘artist’s commercial intent’ at the time of production of the work is irrelevant. We shall deal with this aspect in due course, prior to which we seek to briefly consider the various other underpinnings of the judgment.

46. *Microfibres Inc. v. Giridhar*, 2009 (40) PTC 519 (Del).

The Division Bench retains the premise of the Single Judge that the legislative policy behind the Designs Act was primarily to ‘water down’ the protection given by the Copyright Act, 1957 to artistic works which were being commercially exploited as distinct from works which were purely in the nature of the fine arts. The Division Bench justifies this reading of the legislative policy underlying the Designs Act by looking to the Act’s Preamble, its Statement of Objects and Reasons of the Act, as well as the scheme for registration as envisaged under Section 6 of the said Act. This is made abundantly clear from the following passage of the court’s decision:⁴⁷

“A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher protection to pure original artistic works such as paintings, sculptures etc and lesser period of protection to design activity commercial in nature. The period of copyright would be the author’s life span plus 60 years. However, the legislature has allocated a lesser time span for the protection available to a registered design as only being 15 years. Thus, commerce and art have been treated differently by the Legislature and any activity which is commercial in nature has been granted lesser period of protection. On the other hand, pure artistic works *per se* have been granted a longer protection.”

However, starting from this common ground, the Division Bench takes off in a completely different direction and seeks to harmonize the Copyright Act and the Designs Act through a fine reading of Section(s) 2(c) & 15 of the Copyright Act, and Section 2(d) of the Design Act, 2000. The Court firstly highlights the distinction between the design itself and the underlying/original⁴⁸ artistic work by giving an example of how an underlying drawing of a futuristic motor car can give rise to a ‘design’ when the same drawing is reproduced in another material form having appeal to the eye (for example, an actual car made of metal sheets resembling the car in the drawing), through an industrial process. The design would then be “*the features of shape, configuration, pattern, ornament or composition of lines or colours applied to the article*

47. *Ibid*, at ¶32.

48. Although the court uses the term ‘original artistic work’ the context seems to imply that the term ‘original’ is used in the sense of ‘underlying’ rather than in the copyright sense of ‘original’. The copyright sense of being ‘original’ requires that the work would have to ‘originate’ from an author and not be merely a copy of any previously existing work. I use the expression ‘underlying/original’ wherever necessary to draw out the distinction between the two senses.

by the industrial process.”⁴⁹ The distinction was emphasized by the courts as follows:

“There is, therefore, a clear distinction between an original artistic work, and the design derived from it for industrial application on an article. This position is clarified by the use of the expression ‘only’ before the words ‘the features of shape, configuration, pattern, ornament or composition of lines or colours in the definition of ‘design’ in the Designs Act. Therefore, the original artistic work, which may have inspired the creation of a design, is not merely the feature of shape, configuration, pattern, ornament or composition of lines or colours which are created to apply to an article by an industrial process. The original artistic work is something different from the design. Secondly, the definition of ‘design’ expressly excludes, inter alia, any artistic work defined in Section 2(c) of the Copyright act, 1957.”

Having highlighted this distinction as well as the fact that the definition of design excludes any artistic work, the Court then asserts rather bewilderingly that the resultant design would itself be an artistic work which would be copyrightable if it is ‘original’ so as to satisfy the requirement of originality under the Copyright Act.⁵⁰ This can be seen in the following passage of the court’s decision:

“Whether or not a design is preceded by an original artistic work, a design would, in its own right qualify to be termed as an artistic work within the meaning of Section 2(c) of the Copyright Act. This is so because the expression ‘artistic work’ as defined in Section 2(c) of the Copyright Act bears a wide definition to mean 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. However, the design may or may not enjoy a copyright protection under the Copyright Act, depending on whether it is an ‘original artistic work’ or not.”

49. *Supra* Note No. 48, ¶22; the court also acknowledges the possibility that a design may come into existence directly without the occurrence of transformation of any underlying/original artistic work in ¶24 of its judgment.

50. Here obviously the court uses the word original in the copyright sense and not to refer to any underlying artistic work which might have inspired the creation of the design.

As we shall see a similar conclusion was reached by the Delhi High Court in *Tahiliani Design* wherein the Court refused to rule out the possibility that the design itself maybe an artistic work worthy of securing copyright protection as long as it was not commercially applied more than fifty times as stipulated under Section 15 of the Copyright Act, 1956. The assertion that the design itself is an artistic work seems to contradict the almost immediately preceding observation by the Court that the Designs Act excludes from the definition of ‘design’ under Section 2(d) anything which qualifies as an artistic work under Section 2(c) of the Copyright Act. The question that begs to be asked – if the design itself is an artistic work, then does not Section 2(d) seem to exclude every ‘design’ itself from the purview of the definition of ‘design’. How then do we understand the Court’s reading of Section 2(d) so as to avoid this absurdity? The answer seems to be that the phrase “any artistic work as defined under S. 2(c) of the Copyright Act” as it appears under Section 2(d) of the Designs Act has been read by the court thus - “any ‘*underlying*’ artistic work as defined under Section 2(c) of the Copyright Act.” It appears that this minor deviation from what is arguably the plain meaning of Section 2(d) may well be justified in terms of the greater synergy which the Court has admirably managed to weave between the provisions of the Copyright Act and the Designs Act. The way the Division Bench achieves this will be dealt with in due course.

Prior to that analysis, it is interesting to note that the Single Judge tried to deal with the issue in quite a different way – it may be recalled here that the Single Judge clearly asserted that the ‘design’ itself would not be an ‘artistic work’ under Section 2(c) of the Copyright Act because (i) it was not capable of existing independently, like a painting by M.F. Hussain would be capable; and (ii) the intention of the creator was to commercially exploit the design. The problem with such an analysis is also two fold;

Firstly, it must be noted that this approach relies more on an interpretation of the term ‘artistic expression’ under the Copyright Act itself rather than the width of the exclusion clause under Section 2(d) of the Designs Act. While this is not strictly a problem it must be realized that this might have implications outside the arena of designs. For instance, is it not possible to conceive of works which are paintings, or sculptures etc. which are produced only because the artist is being paid for them (commercial in that sense) and which do not involve the application of an industrial process upon an article in the sense envisaged by the Designs Act i.e. ‘commercial’ artistic works not covered by the Designs Act? An instance might be that an artist may paint to order in a specified way a few similar paintings using nothing else but the normal tools of his trade only for the purpose. Would such works then be considered neither as designs nor artistic works and

not be given any protection at all? In contrast to such a situation, the approach of the Division Bench in curtailing the ambit of the exclusion clause under Section 2(d) of the Designs Act will not have any ancillary effects.

Secondly, and more importantly the focus of the Single Judge on the intention of the creator to commercially exploit the work raises some problems. The Division Bench, by repudiating the relevance of any ‘commercial’ intent of the author, the judgment eliminates these problems which ride on such a criterion’s back. The first of these problems is that there is no guarantee of transformation of the creator’s intent into reality. There exists is the very real possibility that the artist’s intention at the time he created the work in question could be totally irrelevant to what is in fact done with the work after its creation. The converse situation can also be envisaged where the commercial intent behind the creation of the work can be frustrated by circumstances after the creation that render such commercial production and exploitation non-viable. One can also envisage another situation where the creator did have a commercial intent, and the work is actually commercially exploited - but nonetheless in a way totally different from that envisaged by the creator. Here the problem is not one of a totally absent transformation of commercial intent but rather one of the forms that such transformation finally acquires. The second problem is one of attribution – whose intention is relevant? Is it the creator’s intent alone, or could it be the intent of a person who subsequently acquires title to the work. The third problem is one of ascertainability of the creator’s intent - how do we establish what the artist was thinking with even a reasonable degree of objectivity and certainty?

A reading of the Division Bench Judgment indicates that the Court indeed realized these problems inherent in the ‘intention’ test and consciously repudiated the same. This is evident from the following excerpt:⁵¹

“We are also of the view that it is not correct on behalf of the appellant to urge that the intention of the creation of the work determines the Intellectual Property Rights contained therein, and not whether such work fell within the classification of ‘Designs’ under the Designs Act or the Copyright Act. The Designs Act nowhere stipulates the intention of the creator of the work as a determinative criteria and the exhaustive definition given not only in the Designs Act but indeed the Copyright Act clearly rules out such interpretation as suggested by Shri Raju Ramachandran.”

51. *Supra* Note No. 46, ¶31

The court further adumbrated as follows:

“We cannot accede to the plea of Shri Sanjay Jain that the intention of creating an artistic work would determine as to which enactment applies. The artist’s intent at the time of creation of the artistic work is indecipherable at the best of times. Artists are governed more often than not by their emotions and moods and whatever be the intention at the time of the creation of the artistic work cannot, in our view, determine the nature of protection available to the artistic work. Indeed such a plea of Shri Ramachandran has already been rejected by us, as the stupendous and commercial success of a particular artistic work may spur on the artist to permit commercial utilization and exploitation of such a work of article. To this extent, we agree with Mr. Praveen Anand that an intention of creation is difficult to ascertain and cannot form the basis of determining the rights.”

The Division Bench finally addressed the issue of when the protection under the Copyright Act for a design which is also an original artistic work would cease and the requirement for its registration as a design under the Designs Act would arise. The Division Bench fits this last block in its reasoning in place by utilizing the exclusion from copyright protection enshrined under Section 15 of the Copyright Act for works which have been commercially applied more than fifty times. The court stated as follows in this regard:⁵²

“Thus, for instance, a famous painting will continue to enjoy the protection available to an artistic work under the Copyright Act. A design created from such a painting for the purpose of industrial application on an article so as to produce an article which has features or shape or configuration or pattern or ornament or composition of lines or colours and which appeals to the eye would also be entitled design protection in terms of the provisions of the Designs Act. Therefore, if the design is registered under the Designs Act, the design would lose its copyright protection under the Copyright Act but not the original painting. If it is a design registrable under the Designs Act but has not so been registered, the design would continue to enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process for more than 50 times is reached. But once that limit is crossed, it would lose its copyright protection under the Copyright Act. This interpretation, in our view, would harmonize the Copyright and the Designs Act in accordance with the legislative intent.”

52. *Id.*, at ¶45.

Moving on to the second case, that is, *Rajesh Masrani v. Tahiliani Design*⁵³. In this case, the plaintiff was a company headed by one of India's most famous fashion designers Mr. Tarun Tahiliani. The plaintiff's case was that the defendant infringed his copyright by colourable imitation or substantial reproduction of the plaintiff's fabric prints including the underlying drawings / sketches thereof. The plaintiff's case rested largely on the contention that his drawings were made in the course of developing of garments and accessories which are artistic works under Section 2 (c) of the Copyright Act. While there was no dispute as to the authorship, originality of the work and also of the fact that the defendant's works were substantial reproductions, the moot question as in the previous case, remained as to whether the plaintiff's designs would qualify the test of being 'artistic works' under the Copyright Act, thus not requiring registration. The Court accepted the plaintiff's averments "drawings which are artistic work under Section 2 (c) of the Copyright Act are made in the course of developing both the garments and accessories as such and of patterns for printing and / or embroidering on the fabric use. The garments or accessories themselves are works of artistic craftsmanship under Section 2 (c) (iii) of the Act, *while the patterns printed or embroidered on the fabric are artistic works in their own right.*"⁵⁴ (Emphasis supplied).

The Court, therefore, seems to have rejected the principle laid down in the *Microfibres case* with regard to inability of a fabric design to exist independently. While dealing with the issue of fashion designs' commercial nature, Court made use of Section 15 (2) of the Copyright Act. According to the Court, even if the Mr. Tahiliani's work was capable of registration as design, in view of the fact that not more than 20 pieces of the work have been produced by the plaintiff due to their exclusive nature, the subject matter of the work did not cease to subsist by virtue of Section 15 (2) of the Copyright Act⁵⁵. The Court has distinguished the dictum in *Microfibres* primarily by relying on Section 15(2). The Court's reasoning based on Section 15(2) appears to be correct as the plaintiff's works were not meant to be commercially exploited, unlike the situation in *Microfibres*.

53. *Rajesh Masrani v. Tahiliani Design* AIR 2009 Delhi 44.

54. *Ibid*, at ¶ 18, the Court extracts certain paragraphs in the Plaintiff and states in ¶ 22 "...it is clear that there is hardly any denial made by the defendant of alleged infringement of copyright by him and it appears that it is a flagrant case of piracy of copyrights."

55. *Supra* Note No. 36.

V. CONCLUSION

It can be seen that the Division Bench in *Microfibres* weaves a tenuous thread uniting the reasoning of the two judgments which had preceded it. On the one hand, it reiterated the premise of the Single Judge in the same case that the Designs Act intends to water down the protection granted to copyrightable artistic works capable of being registered as designs under the Designs Act upon their commercial exploitation. The crucial trigger for the watering down to take effect is the factum of commercial exploitation by industrial application of the work to an article in excess of fifty times. The trigger of creator's intent propounded by the Single Judge was considered and rejected and to this extent the Division Bench adopted the reasoning of the Single Judge in *Tahiliani Design*. In light of the fact that the garments of a particular design had been produced for more than fifty times in *Microfibres*, the Division Bench finally dismissed the appeals as without merit and upheld the finding of the Single Judge that any copyright in the designs was extinguished upon such commercial production of the articles to which the design had been applied.