

Legal Protection of Fashion Design in Apparels in India: A Dilemma under the Copyright and Design Law

SUNANDA BHARTI¹

Faculty of Law, University of Delhi

ABSTRACT

Fashion designs are protected by the copyright law in India if they qualify as artistic works that are original.² This is clear as the definition of 'artistic works' is very broad.³ The High Court of Delhi in 2006 via the *Microfiber case* have made a bifurcation in the understanding of the term--'purely artistic works' and artistic works intended to be industrially applied to articles.⁴ As the name suggests, one is inclined to understand that protection to fashion designs should be afforded by the Designs Act, 2000 as well. However, one needs to explore more particularly the underlying premise of formulating the Designs Act to the main logic behind industrial production in order to know if at all fashion designs are protected by the two laws—Copyright and Designs. The present paper seeks to provide an understanding of the extent to which works of fashion designers are protected by the Indian Legal System.

Keywords: Fashion Designs, Article, Applied to Article, Microfiber

1. INTRODUCTION

Fashion designs are protected by copyright if they qualify as artistic works that are original.⁵

¹ Faculty of Law, University of Delhi, Delhi-110007. Email: sunanda.bharti@gmail.com.

²Section 13 of the Copyright Act, 1957 states that works in which copyright subsists are as follows:

- (a) original literary, dramatic, musical and artistic works;
- (b) cinematograph films; and
- (c) sound recordings.

³Section 2(c) of the Act defines "artistic work" to mean

- (i) 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;
- (ii) work of architecture; and
- (iii) any other work of artistic craftsmanship.

⁴2006 (32) PTC 157 Del

⁵Section 13 of the Copyright Act, 1957 states that works in which copyright subsists are as follows: (a) original

This can be comfortably understood for the definition of 'artistic works' is very broad.⁶ (Through here also, the DB of the Delhi HC in 2006 via the *Microfiber case* have made a bifurcation in the understanding of the term--'purely artistic works' and artistic works intended to be industrially applied to articles.⁷ As the name suggests, one is inclined to understand that protection to fashion designs should be afforded by the Designs Act, 2000 as well. However, one needs to explore more, particularly the underlying premise of formulating the Designs Act to the main logic behind industrial production.

The present paper seeks to provide an understanding of the extent to which works of fashion designers are protected by the Indian Legal System. It focuses on relevant provisions of two legislations—1. The Copyright Act, 1957 and the Designs Act, 2000.

2. RELEVANT LEGAL PROVISIONS

2.1 Section 15 of Copyright Act (CRA) 1957 and Meaning of 'Designs' under Section 2(d) of Designs Act, 2000

Section 15 of the Copyright Act is a special provision regarding copyright in designs which are registered or are capable of being registered under the Designs Act, 2000. It states that:

(1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 2000.

(2) Copyright in any design, which is capable of being registered under the Designs Act 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.

Section 2(d) of the Designs Act, 2000 defines designs to mean '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 appeals to and is judged solely by the eye.

literary, dramatic, musical and artistic works; (b) cinematograph films; and (c) sound recordings.

⁶Section 2(c) of the Copyright Act, 1957 defines 'artistic work' to mean (i) 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; (ii) work of architecture; and (iii) any other work of artistic craftsmanship.

⁷2006 (32) PTC 157 Del

It does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark or property mark or any artistic work (last one as defined in section 2(c) of the Copyright Act, 1957)

2.2 How Does the Law Pan Out in Reality?

Given the law as stated above, if a popular fashion designer with a fashion house producing a clothes line in her name creates a dress--an evening gown--for (say) Sonam Kapoor--because the latter commissioned her; what would be the nature of protection afforded to the toils of the fashion designer?

The paper seeks to examine this in detail and the surrounding aspects of legal protection to fashion designs in an attempt to highlight how the current corpus of the entire IP Law in India fails to provide adequate protection to the same.

To begin with, the design, once reduced from a mere imagination to some material form, which essentially translates into making drawings and sketches of the gown characteristic of the functioning methodology of any fashion designer, would qualify as an artistic work if it displays sufficient level of creativity and is 'original'. Copyright would automatically, without any further formality, vest in the subject matter per section 13 of the CRA, 1957. Section 15(2) may apply to them resulting in loss of copyright upon more than 50 industrial productions. Industrial production, hence should be taken as the moment when the copyright owner takes his work out of the purely artistic genre and into the industrial, thus losing his copyright.⁸

The designer may decide to materialise her imagination directly in three dimension and straightaway sew the gown. In that case, the three dimensional creation--the gown would also be an artistic work, a subject matter of copyright.

It is submitted that such a one off gown which is produced directly, that is to say without relying on any design document, nor is it meant to be a prototype for future productions should not be taken as a design but an artistic work. There is no question of application of section 15(2) here.

2.3 Problems with Interpretation-'Article' to Exist Independent of Design?

Probing the intricacies reveals that the gown that is produced straightaway cannot be

⁸Garnet Kevin, Davies Gillian and Harbottle Gwilym (ed). (2011). *Copinger and Skone James on Copyright*. Thompson Reuters Ltd.

protected as a design. This is because the definition of design under section 2(d) does clearly indicate on the presence of two things/two requirements--design is something that is *applied* to an article. The design and the article are two separate entities. In case of a gown stitched with reference to some 2D design drawings, both requirements can be said to have been fulfilled; but in case of a gown stitched just by relying on some ideas that are in mind and not reduced to any physical form, the requirements are not fulfilled. The latter is not a protectable design. It may qualify as an original artistic work though because the gown would be an embodiment of the designers idea --a 3D fixation or manifestation of the same.

Microfibres case, dealt with in detail in the later paras, differs in this respect—para 24 of the judgement seems to indicate that even straightaway production of the gown would make the latter eligible to be protected by the Designs Act, 2000 as a design, provided it is registered and as visual appeal. To reproduce,

[I]t needs to be emphasized that it is not necessary that in every case a design has to be preceded by an artistic work upon which it is founded. A craftsman may create a design without first creating a basic artistic work. This may best be illustrated by a weaver who may straightaway create a design while weaving a shawl, which product could be created even without the basic artistic work.⁹

Though the basic premise of the above is correct, it, in my opinion does not reflect a proper understanding of the definition of design under section 2(d) of the Designs Act, 2000 which speaks of patterns, shape or line as applied to an article.

The author however submits that there is nothing to stop the legislature from treating the directly stitched gown as a design. For that to happen, relevant changes and clarity needs to be brought to the definition of designs under section 2(d) of the Act. In the present shape, it is vague and hence subject to diverse interpretations.

3. EXTENT AND SCOPE OF PROTECTION UNDER COPYRIGHT LAW

The Designer would have an exclusive right over the copyrighted matter which is drawings (design document henceforth) or dress or both. No one else can reproduce the same, save with the permission of the designer.

If such a design is copied by reproducing in any material form --that includes depiction in three dimensions of a two dimensional work (to give an instance, someone

⁹2006 (32) PTC 157 Del [24].

unauthorisedly using the design drawings to reproduce the gown or directly reproducing without relying on design drawings). or reproducing in two dimensions of a three dimensional work (say, making drawings and sketches of the gown) it may amount to infringement.

Additionally, the designer would have the exclusive right to store it in any medium, electronically or otherwise. So, taking pictures of the design drawings/gown, or making a video of the same is the exclusive prerogative of the creator author/artist.¹⁰

The designer artist has the exclusive right to communicate the work to the public and to issue copies of the same. However, once sold, the designer does not have any control over the movement of the gown. Meaning, if Sonam Kapoor decides to sell it or otherwise dispose it off to someone, for a higher, lower or no price, the designer would not have any say in it. This is because it would be taken as a work/copy already in circulation and the Doctrine of Exhaustion should apply in full swing.¹¹

All these exclusive rights are indirectly contained in section 51 of the Copyright Act, 1957 which defines infringement. Even if the designer decides to licence out the rights in the fashion design to some person A, the licensee is under a legal obligation to operate only within the confines of the licence agreement. Any defiance on his part would be infringement.¹²

It must be emphasised however that the above said disposal on part of Sonam Kapoor in the previous example has to remain within the folds of respectability; for the artist designer retains the special right to restrain the actor or claim damages for any mutilation, distortion, modification or other act in relation to the gown, if such act is prejudicial to the honour and repute of the designer.¹³ These are the moral rights of the authors of all works which have been recognised by Copyright Law almost globally and operate independently of the author's

¹⁰See Copyright Act, 1957, s 14(c)(i)(A)

¹¹See Copyright Act, 1957, ss 14(c)(i)(B) and (C)

¹²See Copyright Act, 1957, s 51--Copyright in a work shall be deemed to be infringed — (a) when any person, without a licence granted by the owner of the copyright or the Registrar of Copyrights under this Act or in contravention of the conditions of a licence so granted or of any condition imposed by a competent authority under this Act — (i) does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or (ii) permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or (b) when any person — (i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or (ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or (iii) by way of trade exhibits in public, or (iv) imports into India, any infringing copies of the work

¹³See Copyright Act, 1957, s 57(1)(b)

copyright. They exist in the author even after the work has been assigned or licensed.¹⁴

Further, if anyone wants to include the work in any cine film, he must do so with the permission of the designer. Any adaptation of the design drawings, gown which typically would involve rearranging or altering the design by tweaking the same here and there, is also the exclusive domain of the designer.¹⁵

Cases of close or colourable imitations where the later designer is 'inspired' by the former may fall within the category of infringement, of course upon adequate proof.

The scope of the exclusive right enjoyed by the designer is so vast that if someone, say Sonam Kapoor herself, adapts the dress design (for instance by adding frills or lace to the gown) to suit ones taste with the permission of the designer or the latter does it herself, no one is permitted to do in relation to even the adapted version any of the acts previously specified.¹⁶

One may note that any addition by Sonam Kapoor herself to the gown may not be taken as violation of the exclusive right of the designer as it may fall within the broad purview of the Doctrine of Fair Dealing-for the purposes of private or personal use, including research.¹⁷ The author opines that any such dealing has to be read as subservient to the moral rights of the designer.

It is relevant to reiterate that the designer of the concerned gown would get protection in regard to his creation--design drawings or gown, in India, under the CRA 1956 only if the same has been first published in India or the author, at the time of making them was a citizen of India. Publication essentially means making the work available to the public by issue of copies or by communicating the work to the public.¹⁸

In case of design drawings, showing the design drawings or showcasing the stitched gown in fashion shows, exclusive exhibitions or something more discreet may be some of the ways of publishing the work or communicating it to the public. This means, if the designer commissioned by Sonam Kapoor in the given example is say Roberto Cavalli who created the gown and/or its sketches outside India, copyright shall not subsist in them in India.

However, it is not that his creations become open to random copying here in India.

¹⁴See Copyright Act, 1957, s 57(1)

¹⁵See Copyright Act, 1957, s 14(c)(v)

¹⁶See Copyright Act, 1957, s 14(a)(vi)

¹⁷See Copyright Act, 1957, s 52(1)(a)(i)

¹⁸See Copyright Act, 1957, s 13(2)(i)

Post the passing of the International Copyright Order, subject to some exceptions, all the provisions of the CRA 1957 shall apply to a work, even if it is not first published in India and even if the creator is not Indian citizen provided the country in which the work was first published or the citizenship of the author as the case may be, is the one/belongs to one mentioned in Part I, II, III, IV or VI of the Schedule appended to the Order.

4. STATUS OF KNOCKOFFS

Fashion knockoffs are imitations or copies of the original designs using usually the same material but offering to sell at a cheaper price tag. Producing such knockoffs is very easy these days because of technological advance and globalisation related exposure available to copycat designers.

The ones associated with the knockoff economy for their bread and butter literally hound the fashion shows to produce strikingly similar, mass-market versions of the latest designer outfits which become available in the showrooms for mass consumption – at a comparably nominal price.

Gone are the days of the past era when fashion magazines were rare and whatever images from fashion shows appeared in magazines were covered in thick black lines to prevent the designs being copied. Additionally, the shows were couture affairs with only a few privileged invitees getting a glimpse of the expected next season fashion trends.

In the present times, technology and consumerism rule the events with photographers and specialist correspondents going berserk with taking images and splashing them across all forms of mass and social media within seconds of release/publication.

Needless to say that knockoffs represent not only a failure on part of the law implementation agencies but also the Legislature and the Judiciary in understanding the true nature of the work and protection that it mandates. Such copying comes easy, in the first place because there is lack of clarity in the laws and also a lack of clarity with the creator on which law would apply to his work.

On the issue of vagueness surrounding fashion designs, section 15 of the CR Act, 1957 takes the lead. As reproduced above, it is a special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 2000.¹⁹

Transposing the example of gown design drawings on to the said provision, it appears

¹⁹See Copyright Act, 1957, s 15(2)

that if the design drawings are registered as a design under the Designs Act, 2000, copyright shall not subsist in the same. It needs to be questioned whether fashion designs at all qualify for protection by the Design Law. Section 2(d) of the Act states that design means something which is '*applied*' to an article by a process. Additionally, it also mentions that designs protected by the Act do not include 1) trademarks, 2) property marks and 3) artistic works of the CRA 1957.

Taking the latter first, an artistic work is not to be protected by the Designs Act because in the entire scheme of IP protection there is hardly any provision for dual protection for any work. Whether fashion designs qualify as *the* type of artistic works that are excluded from the purview of the Designs Act does not become immediately clear from the statute. One explanation has however been offered by the DB of the Delhi HC in *-microfibres case*.²⁰

5. MICROFIBRES V GIRDHAR

In the much popular case of *Microfibres v Girdhar*, both parties were engaged in the business of upholstery fabrics. The single judge held that the designs of Girdhar were a substantial reproduction of the Microfibres' artistic works. However, the Copyright protection to the same had ceased because of the applicability of section 15(2) of the CRA, 1957. They had been reproduced more than 50 times through an industrial process by Microfibre. And since, Microfibres had not sought registration under the Designs Act, the designs were unprotected by the IP regime.

Two issues that get resolved from the judgement are as follows:

1) The artistic works of section 2(c) of the Copyright Act that defines 'artistic work' has wide connotation and even extend to artistic works without any visual appeal. Only those artistic works that have a visual appeal may qualify as designs eligible for registration and protection under the Designs Act.²¹

2) A Design would qualify as an artistic work only if it is original. Hence artistic works of the Copyright Act and 'designs' mentioned in section 15(2) of the same Act (having a bearing on what can be protected under the Designs Act) are not synonymous terms. They have their own scope and relevance.

3) If a painting is the original artistic work in question and the same is applied to an

²⁰2006 (32) PTC 157 Del

²¹As already reproduced via the definition of designs under section 2(d) of the Designs Act, 2000

apparel, some modification is normally required while creating or reproducing it to be used as a printable design onto an article wherein the final output should have visual appeal. Here, while the painting being an original artistic work falls under Copyright protection, its derivative that is applied on an article produced industrially remains under copyright protection as an independent artistic work only till 50 units production. The moment 51st unit is produced, it (the derivative) loses Copyright protection and if the same has not been registered under the Designs Act, it becomes a 'free' design, not protected--neither under Copyright Law nor under the Designs Law.

4) Section 15 of the Copyright Act, 1957 excludes from the ambit of Copyright protection not the original artistic work --the painting upon which the design is based but the reproduced/mostly tweaked version of that original work which was created for the sole purpose of making it compatible for industrial application. That design by itself may be an artistic work provided it satisfies originality. This protection however is short lived and ceases the moment 50 articles with that design have been produced.

[W]hen the copyright holder of an original artistic work reproduces the same in another material form, he may, or may not do so by employing an industrial process or means which may be manual mechanical or chemical separate or combined, on an article. If the reproduction of the original artistic work is done by employing an industrial process, as aforesaid, on an article, and the same results in a finished article which appeals to the eye as adjudged solely by the eye, then the features of shape, configuration, pattern, ornament or composition of lines or colours applied to the article by the industrial process constitutes a 'design', within the meaning of this expression as defined under the Designs Act.²²

There is, therefore, a clear distinction between an original artistic work, and the design derived from it for industrial application on an article.^{23]}

The original painting which was used to industrially produce the designed article-apparel in this case, continues to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and be entitled to the full period of copyright protection. However, the design derived therefrom for the purposes of industrial production faces the hindrance posed by sec 15 of the Copyright Act. It faces the threat of going totally

²²2006 (32) PTC 157 Del [22]

²³2006 (32) PTC 157 Del [23]

unprotected, unless it is registered as a Design under the Designs Act, 2000.

6. JUDICIAL INTERPRETATION AND POSSIBILITY OF PROTECTION UNDER DESIGN LAW

In relation to artistic works, the law is unclear but the judicial take on the same evidences that the adaptation of the concerned artistic work --painting, for industrial application robs it of its identity and hence, if the adapted version was at all an artistic work, the same gets metamorphed into a design. The law tolerates only a limited industrial, or shall we say commercial, exploitation of the original artistic work by the application/reproduction of the said work in any other form or reproduction of copies thereof in exercise of the rights under Section 14 of the Copyright Act.²⁴

This being the case, the design drawings of our gown do appear to be protected by the Designs Act, 2000 assuming that the application of the said features of the 2D design drawings grant a visual appeal to the gown/article and that the drawings or design document is not meant for one off production and the same is actually registered as a design under the Designs Act, 2000. The design law does not offer any protection without registration.

In such a situation, section 22 of the Designs Act would apply to the fashion knockoffs that are produced using registered design drawings. Section 22 explains piracy of registered designs²⁵ and it shall be a legal duty of the infringer to pay the registered proprietor compensation to the tune of Rs 25000 per infringement payable as contract debt.²⁶

The requirement of design being applied to an article through a process is important. An 'article' is a manufactured object and may be of any substance – artificial or a mixture of

²⁴2006 (32) PTC 157 Del [30]

²⁵Section 22 (1) of the Designs Act, 2000 provides that 'during the existence of copyright in any design it shall not be lawful for any person to-(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof, or (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.'

²⁶Section 22(2)(i) states that 'if any person acts in contravention of this section, he shall be liable for every contravention-(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or (b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly: Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees: Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.'

artificial and natural—and include any part that is capable of being made and sold separately.²⁷

Design refers to any pattern or ornament 'applied' to such article.

The expression 'applied to an article'²⁸ has been explained by Copinger as follows:

*“Conventionally, and on a normal reading, the terms ‘pattern’ and ‘ornament’ refer to external and mostly decorative elements applied to an article. the expressions are used for two as opposed to 3 dimensions.”*²⁹

In case of a shape design, this is not possible because it is the 'shape' and the 'configuration' itself that result in or have a direct bearing on the article's structure or its 3D existence. In such cases, it is questionable if creating a gown out of design drawings would amount to 'applying' the design to the article (evening gown). This is because it is impossible to prise the two apart and to distinguish between the design and the article.

For section 2(d) of the Designs Act, 2000 to be applicable, it appears that the article must have an existence independent of the design. The gown in the instant case comes into existence for the first time when the cloth is cut and stitched into that form. It is the only 3D manifestation of that design. If one removes the design from the gown, then all that is left is not a gown but rags of cut fabric, which do not seem to qualify, in my understanding, as an article under the Design Law. Clearly, there is a vacuum in the way 'article' has been defined.

Also, the design drawings without being applied to any article have no use under the Industrial Designs Act 2000. They remain, at the most artistic works of the Copyright Act, 1957. They cannot be registered as a design under the 2000 Act.

7. OTHER CASES ON ISSUE

In *Rajesh Masrani v Tahliani Design*³⁰ the Division Bench of the Delhi High Court was provided with an opportunity to respond to some aspects highlighted above.

In the case, the Plaintiff alleged that the drawings which it made in the course of developing garments and accessories were artistic works under Section 2(i)(c) of the

²⁷The Designs Act, 2000 s 2(a)

²⁸Garnet Kevin, Davies Gillian and Harbottle Gwilym (ed). (2011). *Copinger and Skone James on Copyright*. Thompson Reuters Ltd. para 13-289

²⁹Garnet Kevin, Davies Gillian and Harbottle Gwilym (ed). (2011). *Copinger and Skone James on Copyright*. Thompson Reuters Ltd. para 13-288

³⁰*Rajesh Masrani v Tahliani Design* FAO (OS) No.393/2008

Copyright Act, 1957. The patterns printed and embroidered on the fabric were also alleged to be artistic works, as were the garments finally designed. The plaintiff also alleged infringement of copyright in these various artistic works, and a Single Judge issued an interim injunction in its favour.

7.1 'Artistic Works' Argument

Relying heavily on *Microfibres v Girdhar*, Masrani tried to convince the court on why protection to Tahilianis designs and garments should be denied under the CRA as an artistic work. In particular, the following para from *Microfibres* was used:

[W]hat 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.³¹ (Emphasis added)

Relying on this paragraph, the appellant Masrani argued that the drawings and patterns created by the plaintiff company were made with the object of putting them to commercial use. Thus, even if less than 50 copies were being made, (since it was a couture line, only 20 odd replications of the design drawings had been made by Tarun T), the works in question were still being industrially produced. Therefore, the defendant argued that copyright protection should be denied.

The Court however held that 1) the works of Tarun T were artistic works under the relevant section (which effectively means that the object behind creating a certain work need not be a criteria for determining the nature of it); 2) the works were capable of being registered under the Designs Act, 2000 but 3) the Copyright Act was still applicable on the said artistic works because the same had not been reproduced more than 50 times by an industrial process. The Single judge hence had rightfully concluded that it was a case of infringement by Masrani. To reproduce --

[I]f the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act. If it is a design registrable under the Designs Act but has not so been registered, the Design would continue to

³¹2006 (32) PTC 157 Del [62]

*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 would harmonize the Copyright and the Designs Act in accordance with the legislative intent.*³²

A recent case of Biba Apparels has again rocked the fashion industry and legal fraternity with similar issues.³³ Here, the plaintiff claimed copyright in various drawings and sketches which were created by the plaintiff for dresses being sold under the trade name/brand RITU KUMAR. The claim was that they were original, such as sleeves, front and back panels etc were delineated and coordinated with unique features.

The defendants, it was contended had been copying the same which amounted to infringement of the artistic work of Ritu Kumar. The defendant, it was alleged had been reproducing, printing, publishing, distributing, selling, offering etc prints or garments which were colourable imitation or substantial reproduction of the plaintiff's prints and garments. An injunction was hence prayed for.

The Defendants argued that since the case was covered by sec 15(2) of the Copyright Act, 1957, the said artistic works had removed themselves from the purview of the Copyright Act as they had been applied more than 50 times through an industrial process to produce apparel by the plaintiff. And since the designs were not registered under the Designs Act, 2000, they were in the public domain.

In para 26 of the judgement, the Court noted something that was already stated by the DB of Microfibres in 2006. The Court maintained that-

Lastly, I may note that in the facts of the present case it is not as if the copyright work in itself is reprinted so to say on the dresses which are created by the defendant. If the facts were that from the copyrighted works of the plaintiff prints were created and such prints which have protection under the copyright work are as it is lifted and printed upon the dresses of the defendant, may be in such a case without saying so finally on this aspect, an issue of violation of the copyright of the work of the plaintiff under Indian Copyright Act may have arisen. However, in the facts of the present case the defendant is creating dresses or

³²2006 (32) PTC 157 Del [46]

³³*Ritika Pvt Ltd v Biba Apparels Pvt Ltd* MANU/DE/0784/2016

creating articles by an industrial means and process by application of the design or drawing or sketch and the defendant is not as it is affixing a print taken from the copyrighted work of the plaintiff as a print on a dress created by the defendant. Issue in the present case therefore will not be a violation of a copyright of the plaintiff under the Indian Copyright Act.³⁴

What the court meant was that since the defendant was not lifting the prints as they were and was doing something to them to make them compatible to be industrially applied to the garment or apparel concerned, it could not be a case of copyright infringement on part of the defendant.

The author submits that this last para was totally erroneous as it contorts the only two understandings of the interplay of two laws that has till now developed through such cases. It is as follows:

Illustration I-where fashion design is created from an original artistic work by making the necessary modifications to make it compatible to industrial production.

'X' is an Original artistic work by A (X is a subject matter of copyright protection being an artistic work under section 2(1)(c)---->creatively adapted to be industrially applied to apparel by A himself resulting in 'Y'(Y may be an independent artistic work)---->articles produced more than 50 times by using this Y which is a derivative of X====>copyright extinguishes in Y and not X. This was sufficiently explained by Microfibres. This is what is meant by the Design Act, 2000 when it excludes artistic works from the definition of designs.

Illustration II-where fashion design drawings are created in the first place as suitably adapted to be applied to apparel but they are not registered under the Designs Act, 2000

'X' design is created by A (X is a subject matter of copyright protection being an artistic work under section 2(1)(c))---->industrially applied to apparel without any intermediate modification, by A himself and articles produced more than 50 times ====>copyright extinguishes in X.

If X is copied or modified by B, whether this amounts to infringement under the Copyright Act, 1957 would depend on 'when' X is copied or modified by B. If he does it

³⁴*Ritika Pvt Ltd v Biba Apparels Pvt Ltd* MANU/DE/0784/2016 [26]

before the limit of 50 productions is crossed by A then it would be infringement on part of B, otherwise not because of the operation of section 15(2).

Thus, the Court in *Biba Apparels case*, instead of stating what it did in para 26 above would have done better had it concentrated on just the core of section 15(2)--The design drawings/prints etc of Ritu Kumar had been applied to various fashion apparel through an industrial process more than 50 times. They were clearly out of any copyright protection. There being no copyright, there could not be a copyright infringement.

7.2 How Relevant is Intention?

Copinger Skone James has a different submission to make keeping 'intention' of the creator to be relevant. He maintains that design 'of' something is very different from design 'for' a thing. In the latter the design document or the model is produced as a part of producing something else--as a precursor to the article, rather than being the article itself. The question whether the design was 'for' anything other than an article depends upon the intention of the designer.³⁵

The section of the design law as well as copyright law does not mention this in explanation, but Copinger, in relation to an analogous provision of the UK Act maintains that the state of mind of the designer at the time when he created the design document or model must be ascertained. In other words, it is that what would decide the applicability of section 15(2) of the copyright act. If the concerned work started its life as an artistic work, the end product, copyright in it should not cease even upon 50 industrial reproductions.

The author submits that intention cannot be taken as a relevant factor because it defeats the very purpose of the Designs Act and the incorporation of section 15 in the Copyright Act. If intention is given such weightage in the world of commerce, it would end up in artistic creations getting avoidable and unfair protection for a prolonged period despite being commercially exploited. A version eulogising this very ethos is explained by *Microfibres*. Contrary to Copinger, the case explains it through practical realities rather than intention as seen above.

8. PROLOGUE: LIMITED EDITION CREATIONS

Since the law is only so much in favour of fashion designers, the author suggests the route

³⁵Garnet Kevin, Davies Gillian and HarbottleGwilym (ed). (2011). *Copinger and Skone James on Copyright*. Thompson Reuters Ltd. para 13-312

of extracting optimum monetary value out of a fashion design by choosing to create limited edition articles and choosing not to register to the designs drawings under the Design Act, 2000. They may reap the benefit of copyright protection for 60 years plus life for at least 49 articles.

Additionally, the fashion designer may choose to create two versions of works, one for creative satisfaction which would remain protected as artistic work under the Copyright Act, 1957 and the other a modified version suited to be adapted for industrial/mass production. The creator may get the latter registered as a design under the Designs Act, 2000 if novelty and prior publication hurdle can be passed. However, if the modified/adapted/derivative version of the work, meant to be applied to articles through industrial productions loses out on novelty³⁶ and is not registrable under the Designs Act, 2000, revenue in the same would stand milked through the initial 49 publications.

REFERENCE

Garnet, K., G. Davies, and G. Harbottle. (2011). *Copinger and Skone James on Copyright*. Thompson Reuters Ltd. U.K.: Sweet & Maxwell. Accessed from <http://www.carswell.com/product-detail/copinger-skone-james-on-copyright-17th-edition/>.

³⁶Section 4 of the Designs Act, 2000 states that 'a design which (a) is not new or original; or of certain designs. (b) has been disclosed to the public anywhere in India or in any other country by publication in tangible Form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or (c) is not significantly distinguishable from known designs or combination of known designs; or (d) comprises or contains scandalous or obscene matter shall not be registered.'