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ABOUT US

WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal providededicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

LEGAL DIMENSIONS OF INDUSTRIAL DESIGN PROTECTION

AUTHORED BY - DRISYA .P

INTRODUCTION

Consumers are influenced by the appearance of the article of their choice. Many people blindly choose the article which catches their eye by appearance. At the time of purchase, people are attracted by a design which has an artistic merit. Some articles with a particular design may attract the public and within a short period, the whole stock may be sold in the market. Hence, design of goods increases profits by attracting customers. Producers hunt for an attractive design which will increase sales. Some intellectuals do hard work by putting much thought, time and expense to find a design for a particular article which will increase sales. The object of design registration is to see that the creator of a profitable design is not deprived of his reward by others applying it to their goods without his permission.

Design according to the Indian Designs Act, 2000, means only the features of shape, configuration, pattern or ornament or composition of lines or color or combination thereof applied to any article whether 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 or construction or anything which is in substance a mere mechanical device, and does not include any trade.

INDUSTRIAL DESIGN: MEANING.

Industrial design protection is provided only for the aesthetic feature of a product, not for its functional design. Industrial design laws generally protect designs applied on industrial products which are aesthetic and non functional. Such designs merely enhance the aesthetic appeal of industrial products. Typically industrial designs are applied on products like furniture, packaging, watches, textiles and handicrafts. The economic value of these products lies in enhancing their aesthetic appeal to consumers. Designs which are functional are not registrable under the Designs Act, thus if a designer makes an article in certain shape not to

make it appeal to the eye of a consumer but solely to make the article perform a function, then it does not become registrable¹.

SEC 2(D) OF THE DESIGNS ACT, 2000.

Design is defined as “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 device and any trademark or property mark or any artistic work².

HISTORY AND EVOLUTION OF INDUSTRIAL DESIGN PROTECTION

Industrial design protection is a way to legally protect the look of a product—like its shape, color, texture, and decoration. This protection helps creators keep their designs safe from being copied by others.

1. Before the Industrial Revolution (Before the 18th Century)

Before factories and mass production, most products were handmade by craftsmen or artisans. Because of this, there wasn't much need for laws to protect designs, as products were often unique and made in small quantities. Designs were usually tied to the person making them.

2. Early Protection of Designs (18th Century)

- **England (1787):** As factories began to produce things in large quantities, England introduced one of the first laws to protect designs in 1787. The **Designs Act** allowed creators to register their designs and protect their looks for a set amount of time.
- **France (1791):** France also introduced design protection laws, recognizing the importance of protecting the decorative elements of products. In 1791, a law was passed that allowed designers to protect their designs from being copied.

¹ Lalit Som, Protection of Design in India, EPRA International Journal of Multidisciplinary Research (IJMR), Vol. 6, Issue 7, July 2020, available at <https://eprajournals.com/IJMR/article/2992>

² Designs Act, 2000, § 2(d).

3. 19th Century: Growth of Design Protection

- **Early Patents for Designs:** In the early 19th century, patents began to cover designs as part of broader intellectual property law. However, patents were primarily focused on inventions and functional innovations rather than purely aesthetic designs.
- **The United Kingdom and the 1800s:** The UK was one of the first countries to introduce formal protection for industrial designs. The **Designs Act of 1839** allowed the registration of designs, particularly for textiles, ceramics, and other mass-produced items. This was a crucial moment, as it introduced a legal framework to protect aesthetic aspects of products.³
- **United States (1842):** The U.S. followed in 1842 with a law that protected new and original designs. : In the United States, early industrial design protection came through **patent law**. . The Patent Act of 1842 allowed for the protection of ornamental designs of articles of manufacture. This law was separate from patents (which protect inventions) and trademarks (which protect logos or brand names).
- It initially protected designs for 3 years,
- **International Cooperation (1883):** As trade grew between countries, nations saw the need to create international rules to protect designs. The **Paris Convention** in 1883 was one of the first agreements that helped protect industrial designs across many countries⁴.

4. 20th Century: Global Design Protection

- **The Hague Agreement (1925):** The **Hague Agreement** for the International Registration of Industrial Designs, adopted in 1925, was a pivotal moment in the development of international design protection. It allowed creators to register their industrial designs in multiple countries through a single application. The agreement was instrumental in harmonizing the laws of various countries and encouraging cross-border protection to protect their designs internationally.⁵
- **World Intellectual Property Organization (WIPO):** WIPO started to play an important role in creating international rules and standards for intellectual property, including designs. WIPO established in 1967, began to play an important role in

³ W.R. Cornish, Intellectual Property, 3rd ed., London, Sweet & Maxwell, 1996, at 14-01 to 14-08.

⁴ Peter Brawley & Steven Kyffin, Understanding Industrial Design, O'Reilly Media, available at <https://www.oreilly.com/library/view/understanding-industrial-design/9781491920381/ch01.html>

⁵ N.S. Sreenivasulu, Law Relating to Intellectual Property, 2nd ed., Universal Law Publishing, at 443.

fostering international collaboration in intellectual property law. WIPO oversaw the expansion of design protection treaties, and in 1977, the **Locarno Agreement** was adopted, providing an international classification system for industrial designs.

- **The U.S. and Europe:** Both the U.S. and European countries improved their design protection laws throughout the 20th century. In 1930, the U.S. introduced the **Design Patent Act**, which helped protect ornamental designs. In the 1950s and 1960s, the United States strengthened its design protection system. The introduction of the **Design Patent Law of 1954** allowed for longer protection (14 years instead of 7 years previously), reflecting the growing value of aesthetic design in consumer goods.
- In 2002, the European Union introduced the **Community Design Regulation**, which allowed designers to protect their designs in all EU countries with one application⁶.

5. Late 20th and 21st Century: Digital Designs and New Challenges

- **Digital Design (1990s-2000s):** With the rise of computers and digital tools like **CAD** (computer-aided design), creating and sharing designs became easier. This created new challenges, such as piracy and design copying online. International treaties like the **TRIPS Agreement** (1994) started to address these issues.
- In 2020, the **Geneva Act of the Hague Agreement** was adopted, modernizing and expanding the scope of the agreement, including provisions for digital designs⁷
- **China's Role in Design Protection:** China emerged as a global manufacturing hub, and the country's laws on industrial design protection were strengthened significantly. In 2001, China joined the **World Trade Organization (WTO)** and started to align more closely with international standards. By 2006, China passed its own **Design Law** and introduced significant reforms in design protection and enforcement⁸.

INTERNATIONAL FRAMEWORKS FOR INDUSTRIAL DESIGN PROTECTION

- **The Hague Agreement (WIPO):** The Hague Agreement is the key international treaty that facilitates the registration of industrial designs in multiple countries with one application. This is crucial for global design protection, reducing administrative

⁶ Id

⁷ Challenges in Digital Design: Shaping AI, Data, and Tech's Future", Innovation & Tech Today, available at <https://innotechtoday.com/challenges-in-digital-design-shaping-ai-data-and-techs-future/>

⁸ Ibid

burden and encouraging international business.

- **TRIPS Agreement:** The **Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)**, signed by World Trade Organization (WTO) members in 1995, requires all signatories to provide protection for industrial designs, ensuring a minimum level of protection in line with global standards.
- **European Union Design Law:** The EU system has integrated industrial design protection into its single market, offering both **registered** and **unregistered** design protection. Registered designs are protected for up to 25 years, while unregistered designs are protected for 3 years⁹.

INDIA

In British India, the first legislation that governs a design was made as to the Patents and Designs Act, 1872. To give protection to inventions and designs. the Inventions and Designs Act, 1888 was made. The Indian Patents and Designs Act 1911 was enacted on the basis of the British Patents and Designs Act, 1907. The enactment of the new Patent Act, 1970 repealed the provisions of the patents from the Patents and Designs Act, 1911. Thereafter the designs in India are dealt with by the Designs Act, 1911 and Designs Rules, 1933. The Designs Act, 2000 which has come into force from 11.05.2001 has been enacted by repealing the Designs Act, 1911.

The new Act contains most of the provisions as were contained in the Designs Act, 1911, except some minor changes and contained some provisions that are based on the TRIPS Agreement and other International Conventions. Designs Rules, 2001 have been made as per the provisions of the Designs Act, 2000¹⁰.

Conclusion

The protection of industrial designs has evolved from local protection for handmade products to a global system that helps designers safeguard their creations across countries. As technology continues to advance, the laws will keep changing to protect new forms of design,

⁹ Dr. Mohamed Fouad Elhariry, The Requirements for Industrial Designs Protection: The International Overview and National Application, Legislative and Legal Opinion Commission, available at <https://www.lloc.gov.bh/QTopics/Q02T08.pdf>

¹⁰ N.S. Sreenivasulu, Law Relating to Intellectual Property, 2nd ed., Universal Law Publishing, at 447. And Suvrashis Sarkar, History and Evolution of Industrial Designs in India, Global Journal for Research Analysis (GJRA), available at https://www.worldwidejournals.com/global-journal-for-research-analysis-GJRA/recent_issues_pdf/2016/November/November_2016_1479535296

such as digital and 3D-printed products.

SALIENT FEATURES OF DESIGN ACT 2000

1. Under the Act of 2000, Locarno classification has been adopted international system used to classify industrial designs based on their appearance. It groups industrial designs into classes and subclasses based on their type (e.g., furniture, clothing, vehicles, etc.). For example, if a company designs a new chair, it would be classified under Class 6 (Furniture) in the Locarno system. In which the classification is based only on the subject matter of design. Under the previous provisions, the classification was made on the basis of the material which has been used to make that material.
2. The introduction of “Absolute Novelty” makes it possible to judge a novelty on the basis of prior publication of any article. This is applicable in other countries also.
3. As per the new law, a design can be restored which was absent in the previous enactment. Now, the registration of a design can be restored.
4. The Act allows the district courts to transfer cases to the high courts where the jurisdiction is present. It is possible only in cases where a person is challenging the validity of any registration.
5. Laws regarding the delegation of powers of the controllers to other controllers and the duty of examiner are also mentioned in the new Act.
6. The quantum of punishment is also enhanced under the Act in case of any infringement.
7. Whenever a license is brought within the domain of public records and that too publicly, the registration is likely to be taken into consideration. Anyone can get a certified copy of it in order to inspect the same.
8. The laws regarding the substitution of the application before registering a design are also mentioned in the new enactment¹¹.

ESSENTIAL REQUIREMENT FOR THE REGISTRATION OF DESIGN

There are some prior requirements which are needed to be fulfilled in order to get the registration of the design. They are as follows-

¹¹ Lalit Som, Protection of Design in India, EPRA International Journal of Multidisciplinary Research (IJMR), Vol. 6, Issue 7, July 2020, at [page number], available at <https://eprajournals.com/IJMR/article/2992>

1. It should be novel and original

The design in order to be registered must be both novel and original which means it should be produced for the first time. It can be considered for the registration only if that particular design is unique. A combination of two or more previously published designs can be registered only if the combination produces new visuals or designs.

2. It should not be published previously

The design which is intended for registration should not be published previously. If a copy of the publication is already available in the public library that may be sufficient to constitute publication. So in order to get the registration, the design should not be publicly accessible.

3. Design should not be contrary to order and morality

The design must not be contrary to morality and order or prohibited by the Government of India or any authorized institution. The design which can cause disturbance or breach of public order and peace cannot be considered for registration¹².

APPLICATION FOR REGISTRATION OF DESIGNS

- Section 5 of the Design Act, 2000 deals with the application for registration of designs. As per the section, if any person who claims to be the proprietor of any new or original design not previously published anywhere and is not against any public policy or morality makes an application for registration of the design, the controller may register the design after the examination by the examiner.
- Every application which is made for the registration of a design shall be made in the prescribed form along with the prescribed fees before the patent office. A design that is intended to be registered should be registered in not more than one class. If the application for registration of any design is rejected by the controller the aggrieved person may appeal to the High Court.
- The application which is not made within the prescribed time limit shall be deemed to be abandoned. A design when registered shall be registered as of the date of the application for registration. A design may be registered in respect of any or all the articles comprised in a prescribed class of articles.

¹² P.Narayanan, Intellectual property law, Third edn, Eastern law house ,at129

- After the registration of a design, the controller shall cause publication of the prescribed particulars of the design to be published in such manner as may be prescribed. After the publication of the design, it shall be open to public inspection.¹³

PROCEDURE FOR REGISTRATION OF DESIGN IN INDIA

1. Filing an application

- The first step in the process of registration of the design in India is to file an application made in the prescribed form along with the prescribed fees before the patent office. The application shall specify the class in which the design is to be registered must and the articles to which it is to be applied. There shall be a separate application that shall be filed for each class of articles.

2. Examination

- After receiving the application for the registration of the design the controller will send the application for an examination so as to check whether the design is capable of registration or not. After receiving the green signal from the examiner the controller will accept the application and proceed further.

3. Communication of objections

- After the examination of the application made by the applicant, if the examiner finds any defects in the application, the same has to be notified to the applicant. After the defects are communicated to the applicant, the applicant is required to remove all the objections and shall is required to remove all the objections and shall resubmit the application to the Patent Office for the acceptance of the application within six months from the official date of the application. If all the objections are not removed within 3 months after communication the same to the applicant, the application will be withdrawn.

➤ 4. Publication

Once the application for the registration of the design is accepted by the patent office the controller shall cause publication of the prescribed particulars of the design to be published in such manner as may be prescribed. After the publication of the design, it

¹³ Id

shall be open to public inspection. The controller shall also grant a certificate of registration to the proprietor of the design when registered¹⁴.

DESIGN RIGHTS

- When the design gets registered, the proprietor of the design shall have copyright in the design for 10 years which can be further extended for 5 more years by filing an application for it along with the prescribed fees to the controller. But the application for the extension of the copyright in the design shall be made before the expiration of the original date of the 10 years.
- In a case copyright in the design ceased to have effect by reason of failure to pay the of the prescribed fees for the extension of copyright in the design, the proprietor of such design may within one year from the date on which the design ceased to have an effect, make an application for the restoration of the design in the prescribed manner on payment of such fees as may be prescribed along with the reason which led to the failure to pay the fees and if the controller is satisfied that the failure to pay the fee for extension was not intentional, he shall upon the payment of any unpaid fee for extension restore the registration of the design¹⁵.

PIRACY OF REGISTERED DESIGN

The provision of piracy of registered designs is made under section 22 of the Designs Act, 2000. Piracy of registered design is the same as an infringement of the Copyright in the design. Section 22(1) of the Designs Act, 2000 ("the Act") provides that during the existence of copyright in the design, without a license or written consent of the registered proprietor, the following acts would be considered piracy of registered design:

- who for the purpose of sale to apply or cause to be applied, to any article in any ¹⁶class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, or to do anything with a view to enabling the design to be so applied;
- to import such article for the purposes of sale;
- to publish or expose or cause to be published or exposed for sale, such article. Any of the aforesaid acts shall constitute piracy only if they have been done in course of

¹⁴ Dr.Jayanta Lahiri,Intellectual property laws,First edn,R,cambray &co.private Ltd,at 223

¹⁵ Ibid

¹⁶ Ibid

commerce and not merely for personal use. It is further necessary that the prohibited acts have been committed in relation to articles falling in the class in which the design has been registered.

REMEDIES AGAINST THE PIRACY OF REGISTERED DESIGNS

Section 22(2) of the Designs Act, 2001 ("the Act") provides the remedies against piracy of registered designs. There are only civil remedies available against infringement of copyright in a design. There is no provision for criminal proceedings against the piracy of registered designs.

The Act provides for two alternative remedies for the proprietor of registered design under Section 22(2) (a) and (b). The proprietor has to elect one of the following remedies:

1. Section 22(2)(a) provides that if any person acts in contravention of Section 22, he shall be liable to pay to the registered proprietor of the design a sum not exceeding INR 25,000 rupees for every contravention recoverable as a contract debt. Provided the total amount recoverable in respect of any one design shall not be more than INR 50,000.
2. Section 22(2)(b) provides that the proprietor may bring a suit for the recovery of damages of any such contravention, and for an injunction against the repetition thereof. If he succeeds, he will be entitled to recover such damages as may be awarded by the court and restrain the defendant in terms of the injunction granted by the Court.¹⁷

It has been provided further that no suit or any other proceedings for the relief under Section 22(2) of the Act is to be instituted in a District Court having jurisdiction. However, where the defendant avails any of the grounds on which registration of a design may be canceled under Section 19, the Court shall transfer the suit or such other proceeding to the High Court for decision.

1. Gopal Glass Works Ltd., v. IAG Company Ltd¹⁸

Plaintiff has registered his design named 'Diamond Square' prior to registration of another 'Kohinoor'. The defendant claimed that its design was not a fraudulent imitation of the plaintiff's design. Both designers were found to be similar after an examination. It was held that the plaintiff is entitled to interim protection from piracy and an interim injunction was granted.

¹⁷ Lalit Som, Protection of Design in India, EPRA International Journal of Multidisciplinary Research (IJMR), Vol. 6, Issue 7, July 2020, at [page number], available at <https://eprajournals.com/IJMR/article/2992>

¹⁸ 2006(33)PTC 434(Guj)

2. Whirlpool of India Ltd. v. Videocon Industries Limited¹⁹

Defendant Videocon also got the registration of the design with the same features, configuration, shape as the Plaintiff. The design of the Videocon was the replica of the plaintiff's design. The court in this case held that the design of the Videocon is similar to the design which is registered by Whirlpool. Videocon was held liable for the infringement and passing off of the plaintiff's design.

COPYRIGHT v. DESIGN LAW

Copyrights and Design are often confused on the basis of their application. there are certain basic differences between the two which are A design right only protects the aesthetic features of an invention, whereas, a copyright protects the underlying expression of ideas. Any expression of ideas, as long as it is the author's own work is qualified for protection under copyrights. Computer games for example, are created by coding using a computer language. Copyright would protect only the code, but would not necessarily prohibit somebody from arriving independently at a similar work. Design right could be used to protect the characters and certain other graphics, giving protection to the 'look and feel' of the game.

Copyrights are ever available to the creator of a work from the minute the work is put in a tangible form making this right an inherent right. And design rights are provided only when the design is registered according to the statutes hence is a statutory right.

In a case where an expression of an idea is granted copyrights, in order to get a design rights over the same work, the owner must have to forego the protection under the copyrights law and have his work protected only under the design law.

In India, Copyright protection is granted for a period of the lifetime of the author and an additional sixty years from the death of the author. This period can in no way be extended. In the case of "*films, sound recordings, photographs, posthumous publications, anonymous and pseudonymous publications, works of government and works of international organizations*", the protection lasts for **sixty years** starting from the date of publication²⁰.

¹⁹ 2014(60)PTC 155(Bom)

²⁰ P.Narayanan, Law of copy right and Industrial design, fourth edn, Eastern law house And
Ibid

OVERLAP BETWEEN COPYRIGHT AND DESIGN LAW

Copyright and design, both try to safeguard the same facet in a property, which is the originality. The difference is that in case of design, the protection is claimed for the works applied for protection and in case of copyright, the protection is claimed for the work as is. The conflict arises here, since both the copyright and designs depend on the same criteria of originality As per **Section 15 (1)** of the Copyrights Act, 1957, “*Copyright shall not subsist in any design which is registered under the Designs Act, 1911*”. This means, in case a work is registered under the Designs Act, the copyright attached to such work will cease to exist.

As per **Section 15 (2)** of the Copyrights Act, 1957, if an expression of an idea, which has automatically gained its copyright is then registered under the Design Act, the copyrights on such work ceases to exist; and another scenario is in a case where in a copyrighted article which can be registered and used as a design is not registered, the copyright of such work ceases to exist when the work is reproduced more than fifty times by an industrial process. For example, an apparel (dress design) design gets a copyright as soon as the design is put on paper. Now, if the apparel is made and is registered under the Designs Act, the apparel now loses its copyrights. Further, if the made apparel is not registered under the Designs Act, and the number of copies of the apparel exceeds fifty, the apparel again, loses its copyright.

In ***Ritika Private Limited V. Biba Apparels Private Ltd***²¹, the plaintiff, had not registered her sketches under the Designs Act and the same was reproduced more than 50 times. The court denied any protection against infringement by under both the Copyright Act and the Designs Act.

Whereas, in the case of ***Rajesh Masrani V. Tahiliani Design Pvt Ltd***²², the reproduced copies had not crossed the required number of 50, and hence, the plaintiff was granted protection against infringement.

In ***Pranda Jewelry Pvt. Ltd. And Ors V. Aarya and Ors***²³, the court on deciding what could constitute as artistic work made clear that if the work falls under the ambit of **section 2(c)** of

²¹ 230(2016) DLT109

²² (2009)107 DRJ 484 (DB)

²³ AIR 2015 Bombay 157, 2015(3)ABR 447

the Copyright Act, 1957, it is considered as an artistic work. But when that artistic work is put to industrial use, it would be qualified for protection under Design Act, 2000. And if protection under Design Act is not taken, the article ceases to be protected once it is reproduced more than 50 times.

A slightly different approach was given in *Microfibres Inc V. Girdhar & Co & Anr*²⁴, it was held that if there is a design created out of an original painting, and the design is not registered leading a reproduction of 50 times or more, the copyrights of the design will be waived and not the copyrights of the original painting. In this case, an element of intention was brought fourth for the deciding cases of this nature. According to this, if the intention with which the design was made was to obtain a copyright, then such design is considered as an artistic work and copyright protection is granted and if the intention was to obtain design protection then the work is not considered as an artistic work making it eligible for design protection. Proving said intention is challenging to the courts.

In *Dart Industries Inc. And Anr. V Techno Plast and Ors.*²⁵, it was held that in case of a 3 dimensional work derived from a drawing which is a 2-dimensional work, the 2D work (the drawing) gets a copyright protection and the 3D work (the mold) gets a design protection. In case of copying of the 3D work, indirect infringement of copyrights may be claimed.

CONCLUSION

A design is something that catches the eyes of the consumers. The design itself may not be of much use to the consumers yet the uniqueness or attractiveness may tempt them to purchase it. The more unique the design, the better are the chances of demand increasing. Manufacturers are ever willing to come up with something new that meets the eye in order to push their sales right up. The strong competition among various manufacturers benefits the consumers in the end as they enjoy a variety in products offered by different manufacturers.

However it cannot be forgotten that the creator of the design has spent a whole lot of time and money in preparing the design, and it is certainly unfair if the design is copied and put to use by others without the knowledge and permission of the creator. Companies invest large

²⁴ 2009 SCC OnLine Del 1647

²⁵ 252016 SCC OnLine Del 4126

sums in research and development of products coming up with innovative and useful designs. Therefore the protection of the industrial designs becomes very important in today's times when such designs are prone to copying.

In India, the Designs Act, 2000, is a legislation meant to protect industrial designs. A design to be registerable under the Act, must be of some shape, configuration, pattern or ornamentation or composition of lines or colours applied to such article in any form by any industrial process or means. However 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 or Property mark or artistic work.

In order to get statutory protection under the Designs Act, 2000, the design has to satisfy the definitional requirements of Section 2(d). The products which have a unique appearance or a pattern or design can be registered under the Act. The main aim of law, hence, is to promote innovation. Design being intellectual property, what law is concerned when it comes to an industrial design is the ornamental or aesthetic aspect of a product.



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