

## The interplay between copyright and designs in India

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**In India, it has never been easy deciding on cases involving an overlap in IP rights, but it is hoped the courts will soon clear up the ambiguity, says Shivam Vikram Singh of Remfry & Sagar.**

Indian copyright and design laws have a curious and blurry overlap, the effect of which is most obvious in the applied art industry. A work created as a design for a commercial product can lead to all types of legal queries including questions on the intent with which the work was created or whether one's design's reproduction is limited to 50 copies or has exceeded that threshold.

If you're looking for intellectual property protection in this realm, a good place to start is the Designs Act, 2000. The definition of a design specifically excludes an artistic work, which is capable of acquiring copyright protection. Protection under copyright law lasts much longer than design law and some judges have reasoned that if a piece of art purely translates an artist's vision to canvas, then it is an artistic work and merits longer (copyright) protection.

However, if one creates art with the aim of mass commercialisation, it is no longer an artistic work but a design entitled to a shorter 15-year monopoly maximum. If your work falls in the latter category, then protection must be sought by registering the design under the Designs Act. But notably, if you miss out on statutory design protection, the copyright statute (the Copyright Act, 1957) offers a respite, albeit a limited one—section 15(2) protects copyright in such a design until 50 reproductions of the design are made by an industrial process. Upon the making of the 51st reproduction, copyright ceases.

### **Case study**

Company 'A' creates some original, artistic patterns and uses these as prints for upholstery fabrics. Company 'B', also in the business of manufacturing and selling upholstery, comes out with similar prints on its fabrics. This leads 'A' to allege copyright infringement and passing off; 'B' counters that the works of 'A' are not artistic works worthy of copyright protection, but rather designs it ought to have registered under the Designs Act. These were the exact facts in the case of *Microfibres v Girdhar & Co* in 2009.

The Delhi High Court agreed that the fabrics of 'B' did incorporate designs founded on artistic patterns belonging to 'A'. However, the drawings of 'A' were meant for commercial exploitation and therefore qualified not for copyright, but design protection. Absent a design registration, 'A' was not entitled to any relief.

The court reasoned that artistic works created for independent existence could be differentiated from works created for application on another article by an industrial process. The object of making a work was significant for determining the nature of protection applicable to it. A painting by a well-known painter had independent existence and was copyrightable. Drawings created only for application to fabric had no reason for independent existence and were allotted as designs.

On appeal, the division bench (comprising two judges) held that an artist's objective at the time of creating an artistic work was indecipherable and need not be considered. Copyright would remain in an original artistic work (say an Andy Warhol painting) for its entire term and a derivative of such work for the purpose of industrial application (say an image optimised for printing the Warhol image on coasters) would qualify for independent IP protection—in this case, as a design under the Designs Act.

But could it be argued that despite thousands of coasters with the Warhol image being printed, since there was only one derived Warhol image (optimised as a print template), it qualified for copyright protection in the absence of being registered as a design? No, said the court—commercial objects usually stem from 'moulds', and to grant moulds (in this case, the derived image) means extended copyright protection would defeat the very purpose of design legislation.

The *Microfibres* judgment was viewed as "harmonising the Copyright and the Designs Act in accordance with the legislative intent" and reiterated soon after by the same court in *Vishvajeet Sharma v State*.

In May 2014, in *Jagdamba Impex v Tristar Products*, also before the Delhi court, Tristar claimed copyright over 2D industrial drawings used commercially for manufacturing 3D equipment to make combs.

Jagdamba began manufacturing combs using identical machines that were later revealed as based on Tristar's industrial drawings. In the first instance, Tristar succeeded in restraining Jagdamba from its copyright infringing acts, but on appeal the court observed that industrial drawings used to produce combs had no independent existence and therefore did not qualify as artistic works under the copyright statute.

Tristar's entitlement to copyright protection under section 15(2) was lost once its drawings were used to produce more than 50 combs by an industrial process, and since the drawings were not registered as designs, no cause of action remained against Jagdamba.

Yet when Tristar filed a special leave petition before the Indian Supreme Court, the high court's observation on exhaustion of copyright protection vis-à-vis drawings used to manufacture more than 50 articles was set aside. The trial court was directed to independently examine the issue and that decision is still awaited.

Almost concurrently, the Bombay High Court expressed having "gravest misgivings" about the applicability of the Jagdamba decision and took a divergent view in *Photoquip India v Delhi Photo Store*. Here the plaintiff created machine drawings used to make pilot moulds from which flash lights were manufactured and asserted copyright in both the drawings and moulds.

It alleged that the defendant's flash lights infringed the copyright in its drawings, and the court agreed. The plaintiff's drawings were upheld as artistic works capable of copyright protection. It was impossible for the defendant to reproduce the articles without reverse-engineering them and preparing illicit drawings; these infringed the plaintiff's copyright.

In a related development, a writ petition challenging section 15(2) of the Copyright Act is pending before the Delhi High Court (*Mukul Goyal v Union of India*). Although its full details are not in the public domain, the challenge is reportedly based on article 14 of the Constitution, which guarantees citizens the right to equality. This petition urges that section 15(2) arbitrarily singles out the applied art industry (as opposed to other creative industries) and the threshold on reproductions, ie, 50, is arbitrary for it is based on no logical consideration.

Deciding on cases involving overlaps in IP has never been easy. But the particular issue discussed has remained ambiguous for far too long and it is hoped clear directions will emerge from the courts in the near term.

**Shivam Vikram Singh** is a managing associate at [Remfry & Sagar](#). He has been in the IP profession for more than ten years and specialises in contentious trademark and copyright work, particularly oppositions, cancellations and appeals. He has counselled an array of clients across a diverse spectrum of industries. He can be contacted at: [shivam.singh@remfry.com](mailto:shivam.singh@remfry.com)