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COPYRIGHT IN REGISTERED DESIGN

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INTRODUCTION

This assignment will focus on what constitutes registered copyright in design, while keeping in mind the provisions of the Designs Act of 2000. In addition, this assignment will investigate the infringement or remedies available against the person who has infringed the design owner's rights, as well as cite some landmark case laws to support and analyse the purpose of this project.

The Designs Act of 2000 has an extremely tight and narrow definition that includes only the following: *"features of shape, configuration, pattern, ornament or composition of lines or colors 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".*[2]

The Designs Act, 2000 ("the Act"), is a complete code in itself, and protection under it is statutory. It protects the visual design of objects that are not purely utilitarian. ***Section 2(d)*** of the Act, defines a Design as:

"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 both forms, by any industrial process or means, whether manual, mechanical or chemical,

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[2] §2(d), Design Act, 2000.

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 does not include any trademark 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 (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).[3]

According to the Locarno Agreement, designs are classified into distinct classes. It is used to categorise things in order to register industrial designs, which aids in design searches. The majority of these classes are function oriented. The registered design's copyright lasts for a total of 15 years. The Copyright in Design is initially registered for ten years, but it can be extended for another five years by filing a renewal application.

HARMONIOUS CORELATION BETWEEN COPYRIGHT AND DESIGN LAW

Due to the inherent nature of intellectual property, there will always be an overlap between the sets of rights available to a single owner. Therefore, enforcement organizations are finding it challenging to maintain a healthy cohabitation between these rights while also creating a precedent that applies to everyone.

One such unclear boundary arises between copyright and design law, particularly with regards to artistic works. In India, however, the legislation governing copyright and designs distinguishes between the two types of intellectual property in a quite clear and straight forward manner. A cursory reading of the Copyright Act of 1957 (the "Copyright Act") demonstrates that every original work that confers exclusive rights on its creator is protected by copyright. The Designs Act of 2000 ("Designs Act") defines a design as an outside aspect applied to a product and evaluated solely visually. In India, copyright protection is awarded upon the creation of an original work. The Designs Act, on the other hand, only affords protection to the proprietor of a registered design. Copyright is therefore commonly referred to as an inherent right, whereas design is commonly referred to as a statutory right.[4]

Therefore, some essential criteria for design registration, as per Section 4 of the Act,[5]

[3] Id.
[4] Sanjana Kala, Interface between Copyright and Design Rights in India, Sujata Chaudhri Ip Attorneys (20th Feb. 2022, 4:05 pm), https://sc-ip.in/2019/03/01/interface-between-copyright-and-design-rights-in-india/.
[5] § 4, Design Act, 2000.

mandates a design to be:

- New or novel.
- Has not been anticipated by publication or use anywhere in the world, including in India or prior claimed in application elsewhere i.e., does not form a part of public domain or state of the art.
- Significantly distinguishable from known designs or combination of known designs; and
- Should not contain any scandalous or obscene matter
- The design should not include any Trademark or Copyright.

Examine the advantages and disadvantages of the Indian Design System.

Pros: For the protection of industrial designs, India has an established government and organization. Essential protection standards have been established, and they conform to international norms. The filing requirements for design applications are simple and time-sensitive. The applicants must thoroughly review the necessary procedures, as the majority of Indian design proposals are denied owing to procedural difficulties, with only a few rejections due to failure to meet substantive criteria. Therefore, it is essential that both the application form and the representation sheet adhere to the guidelines in order for design applications to be completed swiftly and effectively.

Cons: One of the reasons why designs are rarely protected is that many enterprises, such as jewellers and shoemakers, alter their patterns frequently to accommodate market changes. Most of these sectors are unable to meet the criteria that a design cannot be in the public domain prior to registration. Another issue with the design protection system is the duration of the protection. 15 years is far too short. To secure a longer period of protection, Depending on the object in question, a company or an individual would prefer to employ trademark or copyright protection.[6]

Design registration versus Copyright: Design and copyright constraints are both concerned with the aesthetic elements of the item. Section 15(1) of the Copyright Act of 1957 states explicitly:

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[6] Manoj K. Singh and Suchi Rai, India: An Overview Of Design Protection In India, Mondaq (20th Feb. 2022, 5:10 pm), https://www.mondaq.com/india/trademark/766748/an-overview-of-design-protection-in-india

1. Copyright is an automatic right that protects original literary, dramatic, musical, and creative works. A design right protects an objects or part of an object's aesthetic appearance.
2. According to the Copyright Act of 1957, a copyright exists in any original work that grants the creator an exclusive ownership over that work. A design, according to the Designs Act of 2000, is an exterior element applied to an article and judged only by the sight.
3. Copyright protection begins when the work takes on a tangible form, but it is only when the design is registered that it is protected.
4. The design is a statutory right, whereas the copyright is an inherent right.
5. Once a design has been awarded registration, the owner of the design will have to relinquish copyright protection.[7]

CASE LAWS

Ritika Private Limited v Biba Apparels Private Limited[8]- In a 2016 Delhi High Court ruling, the defendant successfully demonstrated that no copyright exists in a sketch of a dress because the sketch was used to create more than fifty gowns. In addition, because the plaintiff had not registered the dress's design, the court denied the plaintiff's claim of design infringement. Consequently, the plaintiff was unable to assert copyright and design protection for its original clothing design.

Even though the above ruling appears straightforward in its application to the facts of the case, it is troubling that an original artistic work can be denied copyright protection simply because it is depicted in three-dimensional or two-dimensional form and reproduced or distributed to the public (which is covered by the meaning of copyright under Section 14(c) of the Copyright Act).

Microfibres Inc v Girdhar& Co & Anr[9]- The Delhi High Court pointed to a 2009 decision that said the copyright to an original work of art, like a painting, would still exist even if a design made from that painting was used more than fifty times on different products. Only the copyright to the designs would end. But because the Copyright Act doesn't recognize a

[7] S. Subhashini, Difference between Copyright and Design Protection, Law Times Journal (21st Feb 2022, 6:03pm), https://lawtimesjournal.in/difference-between-copyright-and-design-protection/.

[9] *Microfibres Inc v Girdhar& Co & Anr*, MANU/DE/0647/2009.

separate copyright for a product's "design," this interpretation isn't the best one.

Nonetheless, in the aforementioned 2016 Delhi High Judge case, the court refused to allow the plaintiff to assert copyright infringement in its original artistic work, arguing that there was no copyright infringement because the defendant was producing gowns using an industrial technique.

Holland Company LP v S.P. Industries[10] – The plaintiff was denied the opportunity to enforce a copyright claim on its industrial designs for automatic twisting locks because, according to the Delhi High Court, they were registrable under the Designs Act. Moreover, this judgement brought to the forefront the extremely contentious question of "intention of the creator," in which the artists' intent at the time of production of the artistic work is deciphered to determine the type of protection provided to the artistic work.

Copyright in a topic will exist until it is put to industrial use, at which point it will fall under the jurisdiction of the Designs Act. This appears to be one of the recurring trends that has developed from these judgements. The necessity of keeping the Designs Act's exclusive protection distinct from the Copyright Act has been repeatedly emphasized by the courts. Foreign investors may not view India as a viable market for commercializing copyright table subjects if an interpretation that erodes copyright owners' perpetual rights in their original works is established as a precedent for India's intellectual property policy. The time has come to create a comprehensive law that addresses the problems, so that the courts are not forced to navigate the statute's vague and conflicting provisions.

INFRINGEMENT AND REMEDIES COPYRIGHT IN A DESIGN

Before we go into the remedies for Design Infringement, let's first define what Design Infringement is:

The registrant of design rights may only work with the registered design or a similar design. A design right infringement occurs when a third party manufactures or sells a registered design or a similar design for commercial purposes (i.e., private or home use is excluded) and

[10] *Holland Company LP v S.P. Industries*, MANU/DE/2126/2017.

the owner is unable to stop it.

After analyzing the two designs and discovering resemblances, it is typical for both designs to be regarded comparable when making an effective judgement of similarity:

- The feature (distinctive creation, exceptional part for the use of the article, etc.) of both designs;
- A common dominant in both designs;
- In both designs, the difference is not significant and simply a little different dominance; (i.e., the difference is a well-known constitution).

According to the Design Act 2000, The piracy of registered design, is subject to a design invasion. *Section 22 of the Design Act 2000*[11] *states that any fraudulent or evident copying, without the consent of registered owner or owner, of a design that was already registered, is illicit. The section also prohibits the import of any material or substance that is similar to a previously registered design.*

An infringement occurs when a person attempts to import or publish a design that has previously been registered for a fraudulent or imitation purpose without the express permission of the design's absolute owner.

The court works on the basis of a system in which the articles are not monitored but the decision is upheld by a layperson. The court believes it is necessary to separate the article so that consumers are not confused.

Remedies

The infringer's liabilities are mentioned in *Section 22(2) of the Design Act of 2000*.[12] This is the same area where the Design's registered owner can seek remedies.

Accordingly, in accordance with *Section 22(2)*, the infringing party's liability is as follows:

- In accordance with Section 22(2)(a) of the Design Act, the violator must pay Rs. 25,000/ (Rupees 25,000/) for each violation. The total cost is no more than Rs. 50,000. (Rupees Fifty thousand only). The amount listed above is a penalty for the infraction.
- In accordance with *Section 22(2)(b)*, a design owner has certain rights, in which he

[11] § 22, Design Act, 2000.
[12] Id.

can appeal for damages and hold the offender liable.

Let's Illustrate with an example, In Videocon Industries v. Whirlpool of India Limited, the Bombay High Court upheld Section 22 of the Act, which permits lawsuits against "any individual." Depending on the circumstances, a registered design may be abolished, its registration may be set aside, or a registered owner may be prohibited from using the design by an injunction granted by the High Court under Section 22 of the Design Act or by the Controller under Section 19 of the Design Act. Let's say a certified owner doesn't apply for their design to be used on a product for sale or affiliated with a sale. Another registered owner will not be able to use Section 22 of the Act in that case.

The scope of civil remedies available for the registered work of the proprietor is provided in *Section 55 of the Copyright Act of 1957*. It helps to seek remedies, claim damages or sue anyone who violates the registered article of the Act for an injunction. The applicant is also entitled to receive incomplete design together with the profits gained by the infringer. Any of the following may be remedies under design infringement by registered design owners, legal heirs, or joint owners.[13]

The registered owner is also entitled to obtain any profits made by the infringer during the time they used the registered owner's infringed design.

Section 63 criminalizes the infringement of copyright and other associated rights granted by the Copyright Act, with the exception of *section 53 A's* right to resale share in original copies. It stipulates imprisonment for a minimum of six months and a maximum of three years, as well as a minimum fine of fifty thousand rupees and a maximum fine of two lakh rupees.[14]

The intent of *Section 63A* is to discourage repeat offenses by convicted offenders. It prescribes a harsher punishment of imprisonment for a minimum of one year, which may extend up to three years, and a fine of one lakh rupees, which may extend up to two lakhs, for those who have previously been convicted under *section 63* and are subsequently convicted under *section 63* for a second or subsequent time.[15]

[13] § 55, Copyright act 1957.

[14] § 63, Copyright act 1957.

[15] § 63A, Copyright act 1957.

Section 63B criminalizes the use of an unauthorized copy of a computer program by anybody who is aware that the copy is infringing. For anyone who uses an infringing copy of a computer program on a computer with the knowledge that it is an infringing copy, the law imposes a minimum of seven days of imprisonment, which can be extended up to three years, and a minimum fine of fifty thousand rupees, which can be extended up to two lakh rupees.[16]

Section 64 authorizes police officers with the rank of inspector or higher to seize infringing copies of works or all plates used to make such copies without a warrant. This ability to seize has frequently been used as an evidence in favor of cognizability.[17]

Section 65 stipulates imprisonment of up to two years and a fine for anybody who intentionally creates or possesses a plate for making copies of a copy-protected work. The term "plates" refers to the plates used in offset printing to print books.[18]

The *Copyright (Amendment) Act of 2012* added *Section 65A,* which criminalizes anybody who, with the intent to infringe, circumvents an effective technological measure implemented for the purpose of preserving copyright and any other right given by the Copyright Act. This person will be sentenced to a prison term of up to two years and a fine.[19]

Regardless of whether the alleged offender is found guilty or not, *Section 66* of the Copyright Act, 1957 allows the court trying the case to order that all infringing copies of the copyrighted work or all plates used for the purpose of making the infringing copies be delivered to the owner of the copyright, or to make any other order it deems appropriate regarding the disposal of such infringing copies or plates.[20]

In accordance to *section 70*, offenses under the act are not to be tried by any court other than the metropolitan magistrate or a magistrate of the first class.[21]

CONCLUSION AND SUGGESTION

Although there have been effective regulations and precedents that have addressed the

[16] § 63B, Copyright act 1957.
[17] § 64, Copyright act 1957.
[18] § 65, Copyright act 1957.
[19] § 65A, Copyright act 1957.
[20] § 66, Copyright act 1957.
[21] § 70, Copyright act 1957.

occasional loopholes and problems that have developed in this area, India still requires more specific, cohesive, and clear-cut copyright and registered design legislation. The reason for this demand is because an increasing number of people are entering the field of business, and the trend of start-ups has increased the demand for and importance of intellectual property rights. Such a requirement will certainly lead to more complex difficulties that may or may not be foreseen at this time, but a well-structured and explicated regulation will assist people comprehend what rights and duties are associated with obtaining such rights on a more logical level.

The design sought to be protected must be fresh or original, that is, it must not have been previously published, used, or otherwise disclosed to the public in India or anywhere in the globe. The design must be distinct from other registered, pre-existing, or publicly available designs or combinations of designs. Furthermore, no scandalous or filthy matter, nor any merely functional feature, shall be included in the design.

As with any other intellectual property right, design registration gives the owner a monopoly right that makes it illegal for others to copy, make, sell, or trade the registered design without the owner's permission.

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