



## COPYRIGHT PROTECTION IN FASHION INDUSTRY

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### 1. INTRODUCTION

Fashion industry has a wide ambit of intellectual rights relating to clothes, shoes, perfumes, accessories, jewelry etc. Fashion industry with regard to its specialty is growing and includes protection under intellectual property rights such as Copyright, Trademark, Patent, Design etc.

### PIRACY

Piracy in fashion design is the illegal copying of the original fashion design. It can be distinguished into two kinds:

- 1) Knockoffs: Knockoff is the copying of the original fashion design, but it is sold under a different label from the original design.
- 2) Counterfeits: Counterfeit involves piracy and fraud as there is attempt to deceive. It is a copy of the original design, its logo, label etc.

### SUBJECT MATTER OF PROTECTION

Articles of the fashion designers can be protected under the following IP categories:

- Colour combination under the Copyright Act, 1957
- Fabric of the article protected under the Design Act, 2000 or the Patents Act 1970 involving an inventive step.
- Sketch Design protected as artistic work under the Copyright Act, 1957
- Article Design protected under the Design Act, 2000

- Logo Design protected under the Trademark Act, 1999.

### LEGISLATIONS

From the Indian fashion industry perspective, the laws do not protect the entire garment, rather the particular features of the garment. There is a prohibition on the copyright protection if the same design is registered under the Design Act, 2000 according to Section 15(1) of the Copyright Act, 1957. Section 15(2) of the Copyright Act, 1957 states that if a design is capable of being registered under the Design Act, but the same has not been registered, such design will cease copyright protection as soon as the article which such design is applied is reproduced more than 50 times by an industrial process. Section 2(d) of the Design Act, 2000 excludes the artistic work defined under section 2(c) of the Copyright Act from the definition of design under the Design Act, 2000.

#### 1) Protection under the Design Act, 2000

The Design Act protects the non-functional aspects of the object such as colours, pattern, shape etc. applied to both 2D and 3D forms. The design is registered for a period of 10 years and can be extended upto 15 years.

In case of design piracy, According to Section 22 of the Act, the infringer shall pay Rs, 25000 to the proprietor of the design as contract debt. The proprietor can also obtain injunction and damages.

#### 2) Protection under the Copyright Act, 1957

There is overlapping of the Design Act and the Copyright Act on the design protection. Section 15, Copyright Act, 1957 provides that copyright is not available where a design is registered or capable of being registered



under the Design Act 2000. Also copyright in the design ceases as soon as the design is reproduced more than 50 times by the industrial process.

Original artistic work, contrary to the applied artistic work, i.e. design would fall under the category of artistic work under the Copyright Protection.

### 3) Protection under the Trademark Act, 1999

Fashion designers usually incorporate logos on the garment at the times of creation of clothing or accessory. In these circumstances logos become part of the design, trademark provides protection for design copying. Also the brand names is protected under the Trademark Act, 1999.

## 2. OVERLAP BETWEEN COPYRIGHT AND DESIGN LAWS IN INDIA

The exclusive right, known as “copyright in design” is recognized under the Act. This right is different from the exclusive right granted for literary and artistic work which is categorized as “copyright” under the Copyright Act, 1957. There arises situation where a design can be granted registration under both the legislations, i.e., Design Act 2000 and the Copyright Act, 1957. The industrial and product designs can be registered under the Design Act, 2000 and once a design is granted protection under the Design Act then it cannot be protection under the Copyright Act.<sup>1</sup>

In a case where a design is capable of being registered under the Design Act, but the same

has not been registered, copyright in such design will continue to subsist and can be registered under the Copyright Act, 1957. But the copyright will cease to exist once the article to which the design is applied is produced more than fifty times.<sup>2</sup> Thus, under the Copyright law if an article is an “artistic work”, then the same cannot be granted protection under the Design Act. And if the work is capable of registration under the Design Act, then it will cease to have copyright protection as soon as the work is reproduced more than 50 times by the industrial process.

The analogy behind the drafting of Section 15(2), Copyright Act, 1957 was as follows:

1. To prevent the overlapping of Intellectual Property Rights
2. Prohibition of enjoyment of copyright protection, once the design protection is granted.
3. To forbade a person from enjoying copyright protection which is reproduced 5- times by the industrial process

To distinguish between artistic work and design, there is a landmark judgment on the issue namely, *Microfibres v. Girdhar*<sup>3</sup>. In this case there was allegation of infringement of copyright in artistic work by the defendant. The plaintiff had copyright protection on an artistic work, i.e., floral designs and defendant infringed the copyright by using those design on a fabric produced by the defendant.

The argument made by the defendant’s side was that the plaintiff is not entitled to copyright protection as the artistic work is actually designs and are covered within the

<sup>1</sup> Section 15(1), Copyright Act 1957

<sup>2</sup> Section 15(2), Copyright Act 1957

<sup>3</sup> *Microfibres v. Girdhar*, 2006 (32) PTC 157 Del



ambit of Design Act, 2000. And as plaintiff failed to register his designs under the Design Act, 2000, therefore he was not left with any remedy under both the Copyright Act, 1957 and the Design Act, 2000.

The first issue before the court was that whether copyright protection will be granted for the artistic work stated in the case? To deal with this issue the court applied the “object test” for the determination of work. The court held that in order to decide whether the work is “artistic work” or “design”, the object behind such work will have to be given importance. In this case, the work was floral design and the object of the design was to apply it to the upholstery fabric, i.e. industrial use of the design. And thus, it has to independent importance, and thus this work will fall under the Design Act, 2000.

In the case of *Ritika Apparels Limited vs Biba Apparels Private Ltd.*<sup>4</sup>, the Delhi High Court held that following the language of Section 15(2) of the Copyright Act, 1957, copyright doesnot subsist for drawing, design used for creating dresses, once there is manufacture of more than 50 dresses.

In the case of *Holland Company LP and Ors vs SP Industries*<sup>5</sup>, the court held that if a design can be registered under Section 14 (c), Copyright Act, 1957, copyright can be claimed. If the design is used for production of articles more than 50 times by the industrial process, the copyright ceases in the design.

In the case of *Interlogo v. Tyco Industries*<sup>6</sup> held that the objective behind the design act was to grant protection to work which lacked artistic independence and there was assumption of significance only on the application to the article.

The court held that as the work falls under the Design Act, 2000 and has been produced more than 50 times, copyright protection cannot be granted for the said work. Also in the case, the plaintiff did not get the registration done for his work under the Design Act. Thus protection cannot be granted in favour of the plaintiff.

In the case of *Aga Medical Corporation vs Mr. Faisal Kapadi and Anr*<sup>7</sup>, the Delhi High Court held that if a work is can be registered under the Design Act, 2000 but is not registered under the same, then that work cannot be granted copyright protection.

In the case of *Pranda Jewellery Pvt. Ltd. v. Aarya 24 kt & Ors*<sup>8</sup>, the plaintiff was in a business of designing, marketing and selling religious articles made of gold sheets like deities and religious symbols by the name of “Prima Art”. The plaintiff filed a copyright infringement case against the defendant who produced similar religious gold sheet articles. The defendant challenged the plaintiff’s copyright over the artistic work. The defendant pleaded that the artistic work was capable of being registered under the Design Act, 2000 and after not being registered under the Design Act, the copyright ceased

<sup>4</sup> *Ritika Apparels Limited vs Biba Apparels Private Ltd.*, CS (OS) No. 182/2011

<sup>5</sup> *Holland Company LP and Ors vs SP Industries*, IA No. 1375/2014

<sup>6</sup> *Interlogo v. Tyco Industries* [1988] 3 WLR 678

<sup>7</sup> *Aga Medical Corporation vs Mr. Faisal Kapadi and Anr*, 2003 (26) PTC 349 Del

<sup>8</sup> *Pranda Jewellery Pvt. Ltd. v. Aarya 24 kt & Ors*, AIR 2015 BOM 157



after industrial application on the product for more than 50 times.

The court held that an “artistic work” after being reproduced in any form, if it can qualify as artistic work, it shall enjoy the copyright protection under the Copyright Act, 1957. But when it is used for designing an article by its industrial application.

In the case of *Smith Kline Beechan Consumer Healthcare Gmbh vs G.D. Rathore*<sup>9</sup>, there was multiplicity of proprietary claims by SmithKline for the zigzag neck of the toothbrush. They claimed trademark and design protection for the zigzag feature. The court invalidated the design registration of toothbrush as they were the subject matter of Design Act, 1911. Smith Kline then claimed copyright protection on the molds and drawing used for making the toothbrush. SmithKline was not allowed to claim proprietary right on flexible neck feature of tooth brush because once the design registration is invalidated, the design enters the public domain for free utilization.

In the case of *Jagdamba Impex vs Tristar*<sup>10</sup> Tristar claimed copyright protection over the industrial drawing used to make equipments for comb. Jagdamba started manufacture of combs using identical machines based on Tristar’s drawings. The court opined that industrial drawings were used to produce combs and hence it had no independent existence, and did not qualify as artistic work under the copyright law. Under section 15(2), copyright protection was lost once 50 combs were produced using an industrial process on the basis of the drawings. Since the drawings

were not registered as designs, there was no cause of action against Jagdamba.

In the case of *Photoquip India vs Delhi Photo Store*<sup>11</sup>, the plaintiff made machine drawings and pilot molds from which flash lights was produced, thus copyright protection was given to both the molds and the drawings. The defendant’s flash lights caused infringement of the copyright in drawings of the plaintiff. Plaintiff drawing was granted copyright protection as an artistic work. It was not possible for the defendant to reproduce the article without reverse-engineering and then he prepared illicit drawings which infringed plaintiff’s

### 3. INTERNATIONAL PERSPECTIVE

#### 3.1 COPYRIGHT AND FASHION IN UK

The term “creative economy” was adopted by the United Kingdom to denote the wide contribution of the creative industry in the economy and social life. Thus, there is recognition of the creative industries, in particular fashion for the generator of jobs and management of culture. Despite of its immense importance to the economy, fashion industry is not given the same level of copyright protection as given in other creative industries.

The question arises whether this industry needs to invoke copyright protection, because the fashion industry thrives on the seasonal product lifespans and fashion become obsolete in no time. If United

<sup>9</sup> *Smith Kline Beechan Consumer Healthcare Gmbh vs G.D. Rathore*, 125 (2005) DLT 725

<sup>10</sup> *Jagdamba Impex vs Tristar*, FAO No. 128/2014 & CM Nos. 7778-79/2014

<sup>11</sup> *Photoquip India vs Delhi Photo Store* 2014 (60) PTC 563



Kingdom's fashion industry is allowed to grow and prosper then copyright protection becomes of an immense importance. But in an age of technology where there is mobile cameras, 3-dimensional printers and online shopping websites which when combined can click pictures, recreate and sell their knock-off products in the same time when clothes are being displayed at the fashion show. Therefore, it becomes very difficult for the designers to protect their works of fashion from being copied and recreated.

**The question arises that why copyright law should protect the works of fashion industry when the appearance of the product can be protected by the design laws?**

Every original work is automatically given protection under the Copyright law. However, under Article 2(7) of the Berne Convention for International protection of Literary and Artistic Works gives some latitude to the countries to protect their works of fashion. To be granted copyright protection under the UK law, the work must fall under the eight categories given under section 3 of the Copyright, Designs and Patents Act, 1988. Work of fashion should be an original artistic work, but case laws are not in favour of this argument as garments do not exactly fall into the listed sub-categories of the artistic works. Whereas, the most appropriate category for the works of fashion would be artistic craftsmanship. Thus the works of fashion needs to be both artistic work and work of craftsmanship.

The meaning of "artistic" has been discussed in many cases. The word "artistic" can be

defined as the work aesthetically appealing to the general public. In the case of *Hensher v. Restawhile*<sup>12</sup>, the court held that a distinctive lounge suite which was designed with the intention for mass production is not artistic. Similarly, a baby's cape was not held to be artistic because the intention to create the artistic work was missing. Also a bedsheet with a patchwork was not deemed to be artistic because although the design was not sufficiently creative, although it was pleasing to the eye. Also, the sweaters and cardigans were not held to be artistic because although it was displayed in the Victoria and Albert Museum, they were displayed as developments in fashion rather than the artistic works. Recently in a case the High Court held that the helmets used in Star Wars films was not artistic because the purpose intended was not aesthetic. Later the Supreme Court held that helmets were not sculptures, thus they could not be protected in that way either. These cases show that judges are not willing to affirm that works of fashion can be artistic

Whereas "craftsmanship" can be demonstrated much easily. Knitting and tapestry making has been treated as craft. Works of fashion are most likely to be considered as works of craftsmanship if they are one-off pieces, whereas the position of the products that are mass produced is unclear. In the case of *Hensher v. Restawhile*, Lord Viscount Dilhorne held that a hand-made work is craftsmanship, whereas Lord Simon held that craftsmanship cannot be limited to handicraft; nor is artistic work incompatible with machine production.

<sup>12</sup> *Hensher v. Restawhile*, [1976] AC 64, [1975] RPC 31



Thus it can be inferred that there is a high threshold fixed for showing that the work is artistic craftsmanship. The garments are not protected by copyright in the United Kingdom. Other countries like US, Germany and France any work which is original can be protected by Copyright law. These countries have the open list copyright systems, because they donot have to categorise the work into a specific category for availing protection.

In France, originality of work includes the work which “bears the stamp of author’s personality”. In Germany copyright protects the “personal intellectual creations”. Whereas in EU the “intellectual creation” test is followed. The test was used for the first time in the case of literary works in *Infopaq*, copyright protection in the digital news reporting service.

### 3.2 COPYRIGHT PROTECTION IN THE US

In the United States of America, copyright protects the original work of the author. The test is that the work should contain “minimum of creativity”. The US copyright office has a voluntary registration system on the lines of Article 5(2) of the Berne Convention. The copyright registration system presumes the ownership and validity, and is a pre-requisite for filing an infringement action. Section 107 of the Copyright Act 1976 of the US provides for the fair use exception which is broader than the fair dealing exception of Europe. Fair use means that it must add value to the society or be “transformative”. Thus, the scope of protection of the works of fashion is greater in the UK. For the purpose of

registration, the designers have to publically stake a claim in their designs.

### FASHION BILL

The Innovative Design Protection Act, also known as the Fashion Bill was introduced in Congress in 2012. But the IDPA is yet to be passed by the Congress. U.S.A. gives protection to the designers, but copyright protection is not granted on clothes. According to the U.S. Copyright Office clothing is a functional and “useful article” is not entitled to copyright protection. Clothing designs usually are not granted copyright protection because they are inseparable to the clothes attached. The Supreme Court devised a test to determine whether a clothing design is useful article or not in the case of *Star Athletica vs. Varsity Brands*<sup>13</sup>. Even today the copyright protection is not freely given in fashion designs.

Thus, the IDPA covers clothes, foot wares, handbags etc. The Act provides for copyright protection to fashion designs for 3 years. Also, a design can be similar to an already copyrighted design and would be free from liability provided it is independently created without knowledge of such already existing design and was not copied)

Some people oppose the Fashion Bill and according to them copyright of fashion designs would kill the fashion industry. It is believed that copying is an integral for the development of the fashion industry. It is very natural for the product to be copied and produced on a large scale.

The retailers copy the latest season’s designs and sell it under their brand names. Copying

<sup>13</sup> *Star Athletica vs. Varsity Brands* 137 S. Ct. 1002



can be good for the fashion industry due to two reasons:

1. Increase in the sales of the retailers
2. There is an incentive attached to coming out with new designs as the fashion life cycle is short.

The landmark case of *Star Athletica, LLC vs Varsity Brands, Inc.* had an impact on the fashion industry in the United States. This case is related to the copyrightability of designs on the cheerleader's uniforms and the concept of "separability" which is a requirement for copyright protection in garments. US copyright law does not protect useful articles such as garments, dresses, shoes, bags are considered as useful items are not granted copyright protection. Only the design that by using the "separability" test can be separated from the garment or other useful items. This means that certain aspects of garments are protectable and not garment as a whole. Thus, there is greater reliance on design patent protection in U.S. among more established brands with deep pockets. In this way these brands protect their staple products, that will be sold more than one season. Thus, the design patent protection is seen as an investment.

### 3.3 DIFFERENCES BETWEEN THE INTELLECTUAL PROPERTY LAWS IN EUROPE UNION AND UNITED STATES

The European Union has design right protection that give garments and accessories protection as a whole. This does not exist in U.S. and this a big advantage for the European designers.

European fashion markets existed before the US fashion industry, that's the reason behind the of the pre-existence and expansive IP laws in Europe. Whereas the New York's

fashion industry started with the grant of license from the Paris designers for the production of low-cost garments and accessories. Now New York is a home for fashion licensing.

France was the first place in the world to produce original creative designs. Design has been protected in France since the 15<sup>th</sup> century, when the "fabrication of textiles" was granted protection. In France the Decree of the National Convention of July 19, 1793 granted the design protection.

The Christian Louboutin footwear designer case was regarding whether a single colour, i.e., red can be granted protection under the Intellectual Property Rights. Christian Louboutin was granted trademark protection in the U.S. over the red sole foot ware. The us trademark law also known as the Lanham Act registers trademark consisting of colour. There is a case in which a French fashion house named Yves Sanit Laurant released its foot wares in various colours, including red. Louboutin filed a case against the YSL for claiming trademark infringement for the red-soul trademark. In defense, YSL challenged the grant of trademark protection to Louboutin, whether it was justified and whether the Louboutin's red sole qualified as trademark as it lacked distinctiveness and was ornamental. The United States Court of Appeals for the second circuit held that the Louboutin's red sole trademark is limited in cases where red outsole contrasts the colour of the remainder of the shoe. These cases has led to a rise in litigation cases in various countries where Louboutin is seeking to protect its red-soled shoes.

### 4. PERFUMES AS AN ARTISTIC EXPRESSION

Perfume, a muti-billion-dollar industry and therefore it requires protection. Trademark



and passing off protects the perfume's name and packaging, whereas the scent of the perfume is not protected in UK.

Perfumes are already by copyright law in other jurisdictions. In the case of *Lancome Parfums v. Kecofa BV*<sup>14</sup>, the Dutch Supreme Court held that Tresor perfume by Lancome is under the purview of copyright protection. Dutch copyright law, similar to the French copyright law follows the civil law tradition and gives protection to the original work which bears the stamp of the author's personality. For the creation to be protected under the copyright law, it should be "perceptible to the senses". In this case, the Dutch Supreme court held that while the scent of perfume was "too fleeting and variable and dependent on the environment", the liquid making up the perfume was "sufficiently concrete and stable". Thus, the liquid satisfies the requirement of "perceptible to the senses" and as perfume is a creative work, it can be protected under the copyright law.

The French Cour de cassation in the case of *Bsiri-Barbir v. Haarman & Reimer*<sup>15</sup> held that perfumes will not be granted protection under the French copyright law because they "are a product of the application of purely technical knowledge and lack, therefore a discernible association with the individual personalities of their creators."

The court opined that the perfume makers were not artists, rather artisan or craftsmen. Cour de cassation in the case of *Beaute Prestige International v. Senteur*

*Mazal*<sup>16</sup> confirmed that perfumes are not within the ambit of copyright protection.

#### 4.1 DISPUTED TREASURES

Lancome, a French cosmetics company sells a perfume named Tresor (Treasure) exclusively. Kecofa, a Dutch firm sells its female perfume at one tenth price. Lancome tried to stop Kecofa by invoking trademark right to the word Tresor, but failed as courts held that consumers will not get confused between the two brands. After the passing of the Dutch Trademark Act, Lancome filed an infringement case again against Kecofa, the trademark failed, but Lancome succeeded in its copyright claim in the case of *Kecofa B.V. vs Lancome Parfums Et Beaute et Cie S.N.C.*<sup>17</sup>

The French Supreme Court linked perfumes to craftsmanship like carpentry, plumbing, rather than artistic work, and thus held perfumes are not eligible for copyright protection.<sup>18</sup>

#### 4.2 LICENSE TO SMELL

In the Dutch Copyright Act, there does not exist an exhaustive list of protected subject matters of copyright law. But copyright protection is extended to those subject matters that are original and perceptible. The Dutch High Court held that the perfume's smell fulfills these requirements and the smell can be perceptible through the nose. The court differentiated the perfume's smell from the liquid containing the smell. Thus, a perfume with different ingredients/recipe/liquid but the same smell

<sup>14</sup> *Kecofa B.V. vs Lancome Parfums Et Beaute et Cie S.N.C.*, LJN AU8940

<sup>15</sup> *Bsiri-Barbir v. Haarman & Reimer*, [2006] 28 E.C.D.R.380

<sup>16</sup> *Beaute Prestige International v. Senteur Mazal*, (2008) 39 IIC 113

<sup>18</sup> CdC, Arrêt No.1006, June 13, 2006, *Nejla X c. Soc. Haarmann & Reimer*.





is not infringing, whereas a perfume with similar formula but different smell will not be infringing.

There can be consequences in the protection of the smell. On one hand, copyright gives permission to the copyright holders to prevent the unauthorized making available to the public his work. This can be interpreted as a person wearing perfume in public, would require a license to avoid the copyright infringement of perfume. But the High Court held that a person cannot be denied an ordinary usage of perfume. Thus, there is a need of adding exceptions to the Dutch Copyright Act to address such problems, if the scents are copyrightable.

There is a copyright protection requirement, like any other expression that is original and perceptible to the senses. Here originality means that a perfume which replicates the smell of the roses cannot be granted protection. Similarly, if a smell resembles some classic perfume that cannot be granted protection. But if the maker of the perfume, gives his own twist to the smell then he will be granted protection.

#### 4.3 PROVING ORIGINALITY

Kecofa challenged the originality of Tresor, as similar to the pre-existing perfumes. The High Court held that originality requirement does not imply that the product has to be absolutely new, but rather the makers should put their own creativity into it. As Lancome provided reports talking about the development of Tresor, the onus of proof was on Kecofa to demonstrate that Lancome had copied the perfume and that it lacked originality.

Dutch copyright law gives protection only against direct imitation or infringement, but in cases where there is a high degree of similarity, the infringer is assumed to have

copied the original product and thus the burden of proof will be on the infringer that he created his product independently. This is known as the presumption of imitation.

Thus, it is advisable to document the development of the perfume. If there is a similar smell already in the market, the documentation can help to prove that the similarity is a mere coincidence.

#### 5. CONCLUSION

Just as an artist puts a great amount of energy and time into creating a painting which is unique, so does the fashion designer's hard work and creativity is invested in creating a unique apparel. It is a fair thing to do to protect that the product of hard work and creativity. The competition would be promoted and not stifled if the copyright protection will be extended to the fashion industry. The fashion designs have a short product life-cycle, therefore many a times fashion designers are reluctant in protecting their IP rights because of the time and the financial cost involved. Registration of design prevents others from counterfeiting of the design and also prevents to fight against the unscrupulous competitors. Fashion industry is based on creativity and protection of the intellectual capital in the form IP rights protection helps in boosting of the economy through commercialization of the products. Also the good management of the IP rights helps in the enhancing of the goodwill of the business reputation of the eye of others.

One consequence of copyright protection of perfume is that it can lead to undue monopolies. Humans do not possess very high developed sense of smell and can differentiate only a limited set of smells. Thus, many perfumes can be held to be alike, and infringement can be quickly discovered. Thus, the protection of perfumes can



undermine the competition, as only a few perfumes will be allowed to exist lawfully. Thus, the copyright protection of smell is meaningless as most manufactured scents would not be deemed to be original. In the Indian fashion industry, the entire garment is not given copyright protection, rather particular features of the garment. There is a prohibition on the copyright protection if the same design is registered under the Design Act, 2000 according to Section 15(1) of the Copyright Act, 1957. Section 15(2) of the Copyright Act, 1957 states that if a design is capable of being registered under the Design Act, but the same has not been registered, such design will cease copyright protection as soon as the article to which such design is applied is reproduced more than 50 times by an industrial process.

The European Union has design right protection that give garments and accessories protection as a whole. This does not exist in U.S. and this a big advantage for the European designers.

European fashion markets existed before the US fashion industry, that's the reason behind the of the pre-existence and expansive IP laws in Europe.

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