The Overlap Between Copyright and Designs in India, EU and the UK – A Proposal for Possible Reforms to the Indian Legal System

RAJENDRA KUMAR
Founder, RKR & Partners

Why is there a cross-over between design and copyright?

It is generally recognized that an industrial design constitutes the ornamental and aesthetic appearance of an article whether in two (2D) or three-dimensional (3D) forms.

A few examples:

Novel Pattern on Pottery	Novel Shape of Iron Box	Novel Shape of a chair	Novel shape of an iron	Novel shape of a design for a car	Novel Shape of a Golf Stand
					

A 2D drawing for a 3D mass-produced article qualifies at once as an artistic work under copyright law with its longer 'life plus sixty years' term (in India) and a shorter-term design right. An artistic work is bought purely and simply for its artistic properties. However, an article to which a design has been applied is bought not simply because of the artistic qualities of the design but also because of its utility as well. In Interlego AG v Tyco Industries (1988)3 ALL ER 949, the Privy Council summed up the distinction between the two rights: '*the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact…and the monopoly provided for the proprietors is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as a design but the right, over a much more limited period to prevent the manufacture and sale of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufacture article.'*

The primary beneficiaries of design protection are fast moving short-lived fancy articles (such as toys, furniture, fashion designs, mock jewellery etc.) as well as longer-life articles (such as automobiles, designer watches, electronic products etc.). While those involved in mass-production of longer life articles may see much commercial sense in incurring the time, effort and money in securing design registration for these owing to its accruing certainty of legal protection and term, those concerned with short-lived articles find the rigours and expenses of long-term registration commercially unviable, given their myriad forms as ephemeral as the changing public tastes, fads and conventions.

Worldwide, efforts have been made both to prevent overlapping protection and to ensure strict time limits to the monopoly period granted. Unlike copyright protection which accrues automatically without any formalities such as registration, design protection in India as elsewhere in the world is based on registration under design legislation. Viewed in this light, it is based on the same premise as that underlying patent right, another form of statutory monopoly.

Copyright law in India

The Copyright Act 1957 governs the protection of copyright for various categories of works in India. Section 2 (c) defines "artistic works" to include both 2D and 3D works such as paintings, drawings, sculptures, photographs and engravings (irrespective of artistic quality), works of architecture as well as works of artistic craftsmanship. A copyright owner enjoys wide ranging exclusive rights including the basic right to reproduce his work in any material form including reproduction in different dimensions (conversion of 2D work into 3D form and vice versa).

The copyright term for 'artistic works' is the life of the author plus 60 years posthumous. The protection is automatic and not dependent on any formalities such as registration. Copyright infringement is actionable by way of civil and criminal remedies including injunction, rendition of accounts and/or damages.

Designs Law in India

Following India's accession to the WTO in January 1995, the Indian Parliament enacted a new TRIPs-compliant Designs Act that came into force in May 2001. It repealed the old Designs Act 1911 which had governed the protection of designs in India for over a century.

The Designs Act 2000 introduced several important changes including the following (shown in italics):

- design' means '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, 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 trade mark …or *any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957.*
- the test of novelty is world-wide (the repealed law restricted this to the territory of India only) and any disclosure of a design, in India or in any other country by way of publication

in tangible form or use or any other way, prior to an application disqualifies it from registration (Section 4(b)).

- A granted design has a maximum term of 15 years running from the date of the application (as was the case under the repealed law).

Untangling the overlapping copyright and design rights

Given a universal cross-over between the subject matter of artistic copyright and design rights, the law in India (as elsewhere in other parts of the world) has sought to create a mutually exclusive divide between the two. Section 15 of the Copyright Act is a special provision which seeks to demarcate the overlap between artistic copyright and design right by withdrawing copyright from any design registered or capable of registration under the Designs Act 2000. In the latter case, the copyright ceases if the article bearing the design has been multiplied in more than 50 copies.

In 2012, the Copyright Act underwent a batch of amendments primarily intended to create more equitable rights for composers of lyrics & music in cinematograph films and sound recordings. Somewhat eclipsed in the public limelight, there was one amendment apparently directed at the copyright/design overlap in the context of functional articles. It was in the form of a new 'fair dealing' exception to the exclusive rights of copyright owners (section 52(1)(w)), providing that '*the making of a three-dimensional object from a two-dimensional artistic work, such as a technical drawing, for the purposes of industrial application of any purely functional part of a useful device'* does not constitute infringement of copyright.

In **J.C. Bamford Excavators Limited v Bull Machines Pvt. Ltd. (MANU/DE/6489/2017 decided on 20 December 2017),** the High Court of Delhi found prima-facie merit in the defendant's defence in terms of this newly added provision in a suit for copyright infringement in industrial drawings for parts of a functional mechanical excavator manufactured by the plaintiff. However, the High Court refused to dismiss the suit on the ground that it raised triable issues of fact.

How the Indian courts have tried to prevent or restrict the overlap between copyright and design

In the absence of design registration for the qualifying subject matter, the courts in India have consistently interpreted and applied Section 15 of the Copyright Act to deny copyright protection to 2D or 3D articles. A few of these illustrative cases may be noted:

(i) S.S Sarna Inc. & Anr. Vs. Talwar & Khullar Pvt. Ltd., & Anr. (Suit No. 1481 of 1991 decided by Delhi High Court on 8 August 1991): the plaintiff's claim of copyright infringement in respect of fire boards, welcome wreaths, decorative hooks, wall hangings etc. was rejected.

(ii) Samsonite Corporation Vs. Vijay Sales and Anr. reported in FSR (2000) 463 (decided by the Delhi High Court on 30 May 1998) (73 (1998) DLT 732: the High Court of Delhi rejected Samsonite's claim of copyright protection in respect of a new range of suitcases.

(iii) Microfibres Inc. vs. Girdhar & Co., & Anr. (decided on 13 January 2006) (2009)40 PTC 519 (Delhi- DB): the High Court of Delhi (both single judge and appellate bench) rejected the plaintiff's claim of copyright infringement in respect of upholstery fabric designs, finding that:

(a) *The definition of 'artistic work' has a very wide connotation as it is not circumscribed by any limitation of the work possessing any artistic quality. Even*

an abstract work, such as a few lines or curves arbitrarily drawn would qualify as an artistic work. It may be two dimensional or three dimensional. The artistic work may or may not have visual appeal.

(b) *The rights to which a holder of an original artistic work is entitled are enumerated in Section 14(c) of the Copyright Act.*

(c) *It is the exclusive right of the holder of a copyright in an original artistic work to reproduce the work in any material form. For example, a drawing of an imaginary futuristic automobile, which is an original artistic work, may be reproduced in the three-dimensional material form using an element, such as a metal sheet.*

(d) *The design protection in case of registered works under the Designs Act cannot be extended to include the copyright protection to the works which were industrially produced.*

(e) *A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher protection to pure original artistic works such as paintings, sculptures etc and lesser protection to design activity which is commercial in nature. The legislative intent is, thus, clear that the protection accorded to a work which is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure art.*

(f) *The original paintings/artistic works which may be used to industrially produce the designed article would continue to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and would be entitled to the full period of copyright protection as evident from the definition of the design under Section 2(c) of the Designs Act. However, the intention of producing the artistic work is not relevant.*

(g) *This is precisely why the legislature not only limited the protection by mandating that the copyright shall cease under the Copyright Act in a registered design but in addition, also deprived copyright protection to designs capable of being registered under the Designs Act, but not so registered, as soon as the concerned design had been applied more than 50 times by industrial process by the owner of the copyright or his licensee.*

(h) *In the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work per se.*

(i) *If 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 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.*

Cryogas Equipment Private Limited v. Inox India Limited and Others (2025 INSC 483)

On 15th April 2025, the Supreme Court of India passed a detailed judgment in *Cryogas Equipment Private Limited v. Inox India Limited and Others,* laying down the relevant tests for judicial guidance to resolve the overlap between copyright and design rights. These tests are based on a number of judgments passed by the various High Courts including the Microfibres DB judgment of the Delhi High Court (supra) and include the following:

"We have thus formulated a two-pronged approach in order to crack open the conundrum caused by Section 15(2) of the Copyright Act so as to ascertain whether a work is qualified to be protected by the Designs Act. This test shall consider: (i) whether the work in question is purely an 'artistic work' entitled to protection under the Copyright Act or whether it is a 'design' derived from such original artistic work and subjected to an industrial process based upon the language in Section 15(2) of the Copyright Act; (ii) if such a work does not qualify for copyright protection, then the test of 'functional utility' will have to be applied so as to determine its dominant purpose, and then ascertain whether it would qualify for design protection under the Designs Act".

Though the Supreme Court did not consider the effect of Section 52(1)(w) of the CA 1957, the ratio of the judgment would require a judicial inquiry to exclude from copyright protection the purely functional products or the corresponding industrial drawings.

How the English legislations and the judicial responses have attempted to resolve the design/copyright interface

While the Indian legal framework has remained essentially static since the original l911 legislation, the English law, on the other hand, has been in a state of flux for a greater part of the twentieth century in search of an ideal legislative solution to the elusive boundaries of design/copyright interface. On their part, the English courts have been called upon to apply and interpret the legislation of the day not only in respect of non-functional products with eye appeal, but also purely functional products originating in industrial drawings. While the exclusion of 'artistic copyright' from ornamental design-registered or design-registrable subject matter under the earlier UK legislations did succeed to a great extent in managing the copyright/design interface, the anti-competitive challenges posed by purely functional and visually unappealing products exposed a paradox in the legislative balance: the corresponding industrial drawings for these functional products did not qualify for registration under the design legislation for lack of aesthetic appeal, but qualified as artistic works entitled to the life plus seventy-year term, in contrast to the shorter 15 years statutory term available to products with eye-appeal.

In the case of Ocular Sciences (see below), Justice Laddie so described the paradox: *'if the copyright work consisted of no more than a drawing of two concentric circles on a piece of paper and the alleged infringement consisted of a washer made indirectly from it, copyright could be invoked to take the competing product off the market'.*

It came to its most paradoxical climax in respect of motor spare parts in British Leyland Motor Corporation v Armstrong (1986) 1 ALL ER 850) where the erstwhile House of Lords through a 4:1 majority held that a design drawing for an exhaust system was deemed to have been

infringed by the defendant's manufacture of an identical exhaust system by reverse engineering. This paradoxical result came to be known as 'industrial copyright'.

The table below sets out the historical evolution of English legislative experiments in attempting to resolve the copyright/design interface with mixed results:

The (UK) Copyright Act 1911	**The Patents and Designs Act 1907 as amended by the Patents and Designs Act 1919**	**The Judicial Precedents**
Section 22 of the 1911 Act provided that:- "(1) This Act shall not apply to designs capable of being registered under the Patents and Designs Act, 1907, except designs which, though capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process. (2) General rules under section eighty-six of the Patents and Designs Act, 1907, may be made for determining the conditions under which a design shall be deemed to be used for such purposes as aforesaid." The 1911 Copyright Act thus sought to resolve the problem of dual protection by removing copyright from design-registered and design-registrable articles in more than 50 copies for a 15-year monopoly.	Section 53: The 1907 Act gave registered designs a maximum of 15 years' protection Section 19 provided that: 'Design' means only the features of shape, configuration, pattern, or ornament applied to any article 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'." Rule 89 of the 1920 Designs Rules made reproduction in more than 50 single articles as the test of whether there was multiplication by an industrial process.	(1) In *Pytram v Models (Leicester) [1930] 1 Ch 639* a model of a wolf-cub's head was produced from a papier-mâché mould in order to be used as a totem by the Boy Scouts Association. They failed to register it as a design under what at the time was the 1907 Act and sued for infringement of their copyright under the 1911 Act. Clauson J accepted that the item was an artistic work under the 1911 Act but held that it also fell within the definition of a "design" under the 1907 Act as amended by the 1919 Act. As a consequence of the amended definition of "design", it was excluded from protection under the 1911 Act and no protection existed for it under the 1907 Act because it had not been registered. The judge found as a fact that the wolf's head had been made with the intention of being reproduced in large quantities. There was, therefore, no room for disputing that it was outside the exception contained in s.22(1) of the 1911 Act.

		(2) In *King Features v. Kleeman [1941] AC 417,* the owners of copyright in drawings of "Popeye, the Sailor" brought proceedings for infringement of their copyright against the importers of "Popeye" dolls and other toys. The defendants contended that the copyright in the original work had been lost by the operation of s.22 of the 1911 Act because the designs were capable of registration under the 1907 Act (although not registered) and the plaintiffs had previously licensed other companies to manufacture dolls and other items based on those designs. The House of Lords rejected this argument (which had been accepted by the majority in the Court of Appeal) on the ground that the condition of use or intention to use for multiplication by an industrial process had to be satisfied at the date when the design first came into existence. If it was not satisfied at that time, then full copyright protection under the 1911 Act could not be lost by the grant of subsequent licences for the multiple reproduction of the design.
	The Registered Designs Act 1949 replaced the Patents and Designs Act 1919	The wording of Rule 26(1) was obviously taken from the exception in s.22(1) of the

	The Registered Designs Act 1949 added to the definition of a "design" in s.1(3) a further provision in s.1(4) empowering the Board of Trade to make rules for excluding from registration under the Act designs for articles which were primarily literary or artistic in character. 34. This power was exercised in the form of Rule 26 of the 1949 Designs Rules which provided that: - "26. There shall be excluded from registration under the Act designs to be applied to any of the following articles, namely: (1) works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process. (2) wall plaques and medals. (3) printed matter primarily of a literary or artistic character, including book-jackets, calendars, certificates, coupons, dressmaking patterns, greetings cards, leaflets, maps, plans, postcards, stamps, trade advertisements, trade forms, and cards, transfers, and the like." The combination of the 1949 Act and the Rules was therefore effective to exclude the articles specified in Rule 26 from registration as designs. The exclusion from full copyright protection contained in s.22(1) therefore no longer applied regardless of whether the	1911 Copyright Act and must therefore be given the meaning explained by the House of Lords in *King Features*, that is, a model or cast in respect of which the 50 plus test is satisfied would therefore only be eligible for registered design protection if the use or intention to use existed from the date of its creation.

	articles specified in Rule 26 were intended to be used as models for the multiple reproduction of the design. They remained for all purposes under the umbrella of the 1911 Copyright Act. As a result of the qualification contained in Rule 26(1), an intention to use models or casts for mass production purposes meant that they continued to attract Designs Act protection and so, to that extent, they continued to be excluded by s.22(1) from full copyright protection. The reference to multiplication by an industrial process in Rule 26(1) continued to be the 50 plus test.	
The Copyright Act 1956 replaced the Copyright Act 1911 Section 10 of the 1956 Act (Special exception in respect of industrial designs) sought to resolve the anomaly brought out in the Popeye precedent whereby Popeye dolls were conferred copyright protection for the lifetime of the original artist plus 50 years, while artistic works intended to be industrially applied were granted simply a 15-year monopoly. Section 10 abolished the intention test for loss of copyright and replaced it with a system under which copyright was removed from registered and registrable designs for a period of 15		Even though Section 10 had succeeded in resolving the illogicality of the copyright/design legal faultline inherent in the Popeye precedent, its statutory scheme left open and unaddressed a similar gap in respect of unregistrable designs for functional articles tracing their origin in the underlying drawings. The manufacturers of these industrial articles were able to rely upon the artistic copyright of an almost perpetual and lengthier duration in these drawings to block competition in the relevant sectors. This phenomenon in the legal regime came to be known as 'industrial copyright'.

years from the date of registration in the case of registered designs and from the date at which the design had first been applied industrially. Thereafter, copyright was restored in all respects except all those acts which fell within the ambit of design rights.		In *Dorling v Honnor Marine Ltd. (1965) Ch. 1)*, the Court of Appeal decided that there was nothing in Section 10 to deprive an artistic work of copyright simply because it happened to consist of a design capable of industrial application. On that basis it was held that plans for a dinghy kit- which were not registrable for want of eye appeal- attracted artistic copyright for the full period of life of the designer plus 50 years and that it was an infringement of that right for the defendant to sell kits and assembled dinghies.
The Design Copyright Act 1968 While the operation of Section 10, CA 1956 did succeed in resolving the anomaly thrown up by the Popeye precedent, its underlying lynchpin which comprised in the withdrawal of copyright from design-registered and design-registrable articles for a period of 15 years, stirred up serious discontent and objections in the short-lived "fancy and fast moving goods" markets such as toys, mock jewellery etc. flowing from the loss of copyright for registrable designs. Due to the numerous designs employed in these markets, the makers generally chose not to incur the costs and delays of registration. The loss of copyright underlying Section 10 meant that there was no protection available to these designs against acts of plagiarism.		*Sifam v Sangamo (1971) FSR 337*- Justice Graham held that the front of an ammeter with no aesthetic appeal was entitled to full copyright protection. *LB Plastics v Swish Products (1979) RPC 611*- the House of Lords held that the defendant had infringed the copyright in the plaintiff's drawings for a purely functional 'knock-down drawer system" by manufacturing a system by copying the plaintiff's model. *British Leyland Motor Corporation v Armstrong (1986) 1 ALL.E.R 850*- the House of Lords held that a design drawing for an exhaust system was deemed to have been infringed by the defendant's manufacture of an identical exhaust system by reverse engineering.

As a result of the vacuum left behind by the operation of Section 10, the Design Copyright Act 1968 was passed to amend the section. It operated simply by postponing the loss of copyright for registered and registrable designs until 15 years from the date at which goods bearing the design were first put into circulation. Thereafter, it was permissible for any person to do an act which would have fallen within the ambit of design right. Dual protection was thus restored.		

Effective August 1, 1989, the UK parliament enacted a comprehensive Copyright Designs and Patents Act of 1988 (CDPA 1988) with the objective among others to restate the law of copyright and its interface with designs. Replacing the Copyright Act 1956, amending the RDA 1949 and introducing "a new unregistered design right", the new law laid down a three-fold legislative framework:

(1) To limit the overbroad anti-competitive influence of artistic copyright in functional products such as motor spare parts and thus free up competition in the after-market for the manufacture of such functional articles, the CDPA 1988 introduced an exemption from copyright infringement in the form of Section 51 as follows:

It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work to make an article made to the design or to copy an article made to the design.

Section 51 applies where the end product of a design document or model is not an artistic work. It provides a more principled answer to the problem of 'industrial copyright' to which the earlier judicial precedents had provided unsatisfactory solutions.

Section 52 was introduced to apply where the end product is an artistic work, but that work has been exploited (with the consent of the copyright owner) by industrial production of copies to be marketed. The term of protection for such works was to expire 25 years from first marketing.

The following table sets out the interplay between artistic copyright and the exclusionary effect of Sections 51and 52:

Copyright			
Section 4(1): 'artistic work' means: • a graphic work, photograph,	The exclusive acts include: • reproducing the work in any material form	**Section 51** • where the end product of a design document or a model is not an artistic work and is	**Duration** • 15 years from the end of the year in which the design was first

sculpture or collage, irrespective of artistic quality, • a work of architecture being a building or a model for a building, • a work of artistic craftsmanship. "graphic work" includes— (a) any painting, drawing, diagram, map, chart or plan, and (b) any engraving, etching, lithograph, woodcut or similar work.	including the making of a copy in three dimensions of a two-dimensional work or of a copy in two dimensions of a three-dimensional work.	mass-produced in more than 50 copies, no copyright survives in such drawings or models and no action for copyright infringement lies against any direct or indirect copying/ reproductions of such design drawing into a model (Section 51(1)). • 'design' means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration. • 'design document' means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer otherwise. (Section 51(3)) ********** **Section 52** • where the end product of a design drawing or a model is an artistic work in its own right and is mass-produced in more than 50 copies, any unauthorized direct or indirect acts of reproduction thereof would constitute copyright infringement (Section 236). **(Note:** Only one action for copyright infringement permissible. This does not mean that UK unregistered design right ceases but only that it yields at the infringement stage, thereby avoiding cumulation). ********** Where an artistic work exists and there is no 3D mass-exploitation in more than 50 copies, the work is entitled to its full term and scope of protection.	recorded or made into an article. OR • 10 years from the end of the year in which the articles made to the design were first sold or leased anywhere in the world (subject to licenses of right in the last five years). ********** • 25 years following the end of the calendar year in which the copyright owner first marketed articles bearing the design (Section 52). • After the end of the period, the work may be copied by making articles of any description without copyright infringement. ********** Life of the author plus 70 years posthumous.

(2) A new unregistered design right was introduced with several exclusions designed to provide a short-term protection to products which might not pass the 'aesthetic appeal' threshold test for registration. The new right was enacted to protect original features of shape or configuration of an article, whether functional or not. The origin of this new quasi-copyright could be found in a European Directive (87/54) for the protection of the lay-out of the circuits in semiconductors.

New UK Unregistered Design Right (UKUDR) (Sections 213-251)				
Unregistered Design Right • 'Unregistered Design' means any aspect of the shape or configuration (whether internal or external) of the whole/part of an article (section 213). • **No protection to surface decoration** • Design' must be original (not copied) and not commonplace in the design field in question at the time of its creation. No distinction is drawn or intended between aesthetic and functional designs. Both are intended to be protected	**Scope of Protection** • The right arises automatically once a design has been recorded in a design document, or an article has been made to the design.	**Exceptions and Limitations** • Method or principle of construction. • "Must-fit or must-match exceptions of the kind involved in the spare parts market.	**Exclusive acts** To reproduce the design for commercial purposes by making either: • articles to that design; or • design document recording the design for the purpose of enabling such articles to be made.	**Duration** 15 years from the end of the year in which the design was first recorded or made into an article. OR 10 years from the end of the year in which the articles made to the design were first sold or leased anywhere in the world (subject to licenses of right in the last five years)

(3) The CDPA 1988 carried over the registration system under the Registered Designs Act 1949 (RDA 1949) covering 'original' 2D and 3D articles. A 'design' under the RDA no longer carried a requirement that it ought to be judged solely by the eye. It need only be new, not 'original' as well. The statutory duration was now enhanced for a longer term of 25 years from the application date.

Definition	**Requirement for registration**	**Exceptions and limitations**	**Exclusive acts**	**Duration**
For purposes of registration: "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.	• the design is new and has individual character. • a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date. • a design has individual character if the overall impression it produces on the informed user	No right in a registered design • in features of appearance of a product which are solely dictated by the product's technical function. • in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the	Making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied;	A maximum of 25 years: • in the first instance for a period of five years from the date of the registration of the design. • It may be extended for a second, third, fourth and fifth period of five years.

	differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.	design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.		

Leading Case Law under the CDPA 1988

(1) Ocular Sciences Ltd. & another v. Aspect Vision Care Ltd. & ors. (1997) RPC 289

The plaintiffs asserted unregistered design rights in certain designs for contact lenses. It was alleged that the defendants infringed the design rights by (a) having articles made to the said designs and (b) making design documents for the purpose of enabling such articles to be made. Justice Laddie for the court found in favour of the defendants, finding that the design features of the plaintiffs' lenses were meant to enable these to be connected to or placed in, or around or against the eye or the eyeball; that the word 'article' in the must-match and must-fit provisions need not be a manufactured article but could include living or formerly living things ('*there is no self-apparent policy consideration which justifies allowing, say, the features which enable a false hip to be fitted into the hip joint of a human to fall within the ambit of design right whereas the same features on a child's doll are excluded')*; that the combination of the essential features of the lenses was commonplace.

(2) BBC World Wide Ltd And Another v. Pally Screen Printing Ltd. And Another (FSR (1998) (665) (January 26, 1998)

BBC, producer of a popular TV programme, 'Teletubbies' and merchandiser of all associated rights in its central characters (life-sized puppets with a very spherical outline as depicted in the adjacent picture), complained of copyright infringement and passing-off against the defendants' printing of various items of clothing, namely, T-shirts bearing pictures of puppet-like characters in imitation of these Teletubbies characters. The defendants invoked a Section 51(1) defence.

It was not argued that the Teletubbies characters (3D puppets) were artistic works.

Justice Laddie accepted the defence, finding that copying by the defendants from the Teletubbies articles themselves through the medium of television and from an illustration on the front of a magazine, were acts of copying indirectly from an article made to the design and thus excluded from copyright infringement under Section 51(1). The judge based his conclusion on *"the assumed facts that the original drawings ... are 'design documents'- that is to say that they were created to depict a design "for" something other than an artistic work.*

If, for example, they had been created for use as prototypes for a cartoon series the same point would not be open to the defendants."[1]

(3) Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd and Next Retail PLC (2004) EWCA Civ 886 (15 July 2004)

In 2001, Lambretta sued Next and Teddy Smith for infringement of its claimed UK unregistered design right (UKUDR) in a conventional tracksuit top (as shown in the pictures above) with the only contribution of design consisting in the choice and layout of colours (particularly blue for the body, red for the arms and white for the zip, the white stripes, and the size and positioning of the "Lambretta" logo).

At first instance, the court dismissed the claim on the basis of a Section 51 defence. A further appeal to the Court of Appeal also failed on the basis that:

- merely colouring a pre-existing conventional article in a novel way did not amount to a protectible "shape or configuration" within the meaning of a UKUDR. Even though the red, blue and white components of the Lambretta top were "configured" together to produce the complete article, their colour had nothing to do with that configuration.

[1] In an illuminating paper by Dr. Eugene C Lim of Queen's University Belfast published in 2021 (2021) 43: E.I.P.R. 636) under the title "*The Teletubbies, aesthetic functionality and the section 51 paradox: on the Interplay of copyright, design and trademark principles in character merchandising*", the author has taken an exception to the way in which the section 51 defence was interpreted by the judge in the *Teletubbies* opinion, leaving open many unanswered questions. Noting that the wording of section 51(1) requires that the article be made to a design document or model, the author identifies the central difficulty in the *Teletubbies* opinion to the effect that it fails to satisfactorily distinguish between an article that is derived from a blue print and an image that is derived (or copied) from a finished model displayed via televised or digital media; it was an admitted position in the case that the defendants had simply reproduced pictures of the Teletubbies as surface decorations onto their clothing items, potentially triggering liability for copyright infringement; they had not manufactured costumes or action figures modelled on the shapes of the famous characters. Another concern raised by the author relates to the definition of "artistic" in section 4(1) and the uneven classification of works listed therein: the classification emphasizes the artistry or artistic character as a relevant consideration for certain categories only (works of artistic craftsmanship), but not in respect of the other categories (graphic works, photographs, sculptures and collages) which are protectable irrespective of artistic quality. Due to the lack of clear definition of "artistic work", the formal classification in section 4 (1) is of limited assistance in defining the scope of the defence under section 51. In conclusion, the author argues that, in assessing whether immunity from copyright infringement is available under the defence, more emphasis should be placed on the purpose of making the article rather than on the classification of the design document on which the article is based. Removing the reference to "artistic works" in section 51 and replacing it with a functionality criterion would enhance the internal coherence of the defence and place it in line with its underlying purpose, namely, to protect the manufacture of articles that are driven by utilitarian or functional considerations.
The full article can be accessed at:
https://pureadmin.qub.ac.uk/ws/portalfiles/portal/339881478/Aesthetic_Functionality.pdf#:~:text=13%20See%20BBC%20Worldwide%20v%20Pally%20Screen%20Printing%20%5B1998%5D&text=dismissed%20in%20the%20Teletubbies%20case&text=highlighted%20in%20the%20seminal%20decision%20of%20Flos%20SpA%20v%20Semararo%20Case%20e

- The choice and layout of the colourways merely amounted to "surface decoration" which was excluded from protection as an unregistered design right.
- the choice and layout of the colourways would not constitute 'artistic works' and thus not affected by the existence or otherwise of the unregistered design right because the colourways were not just colours in the abstract. They were colours applied to shapes. Neither physically nor conceptually could they exist apart from the shapes of the parts of the article. If artistic copyright were to be enforced here, it would be enforced in respect of the whole design drawing. This was impermissible under Section 51.

(4) Flashing Badge Company Ltd v Groves (t/a Flashing Badges By Virgo & Virgo Distribution) [2007] EWHC 1372 (Ch) (14 June 2007)

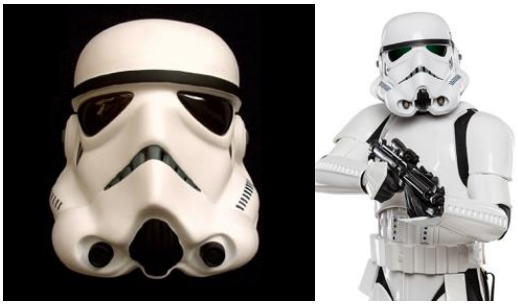
This action concerned a claim of copyright infringement in the design of the so-called flashing badges and the backing cards to which these badges were attached, the former being intended to be attached to a garment by magnets. A key feature of the design of the badge was that its outline shape followed, and was dictated by, the outline of the artistic design which formed the subject matter of the face of the badge.

The defendant's defence was based exclusively on Section 51(1). The plaintiff disputed this and illustrated its submission "*by a case in which the claimant has a design document for the shape of a mug ("the mug design"). He then produces a drawing of a cow which is to adorn the side of the mug ("the cow design") and applies it to the side of 1000 mugs made to the design. The defendant copies the mug design including the cow design. He is not liable for copyright infringement of the mug design (although he may be infringing design rights in the shape of the mug) because he has the protection of Section 51. He is, however, liable for copyright infringement of the cow design, which is an artistic work in respect of which he enjoys copyright: Section 51 will provide no defence."*

Agreeing with the plaintiff's submissions and distinguishing the court of appeal's judgment in Lambretta Clothing (supra), the court held that:

"the artistic work on the face of each badge was in the nature of a graphic design which is in no sense something which (unlike the Lambretta colourways) can only exist as part of the shape of the badge. It is a design which can be applied to any other substrate and which, if so applied, would enjoy copyright protection for the infringement of which section 51 would afford no defence."

(5) Lucas Film Ltd & Ors v Ainsworth & Anor [2011] UKSC 39 (Before the UK Supreme Court)



Lucas Film Ltd, producer of the popular Star Wars films and merchandiser of all the associated rights in the characters and equipment featuring therein, sued the defendant (the original artist commissioned by Lucas) for infringement of its English copyright under the

UKCDPA 1988 against the unauthorised manufacture and sale of the iconic Stormtrooper helmets (as shown in the pictures above) and other equipment.

On the issue of 'sculpture' copyright, both the trial court and the Court of Appeal had held that the helmets and the armour were three-dimensional reproductions in accordance with the relevant drawings which were design documents for purposes of Section 51 and were meant for use in the film and recognizable as such. These designs, therefore, had a utilitarian function within the confines of the film as the equipment of the stormtrooper and that the defendant had defences under Sections 51.

The UK Supreme Court agreed with the reasoning of the lower courts, holding that 'it was the Star Wars film that was the work of art that Mr. Lucas and his companies created. The helmet was utilitarian in the sense that it was an element in the process of production of the film.

EU law and its influence on the UK copyright/design law: the return of 'industrial copyright'

The above summary of the complex relationship underlying the three legal regimes under the CDPA 1988 and the manner in which the courts were able to effectively apply and interpret the legislative balance in aid of resolving the copyright/design interface, do show how the law had finally caught up with the spectre of 'industrial copyright'.

But this complex balance of rights started coming apart as a result of the UK's implementation of the relevant EU legislations and the binding interpretations by the Court of Justice of the EU (CJEU), bringing the spectre of 'industrial copyright' back into the English legal landscape with its familiar anti-competitive effects.

The interface of copyright and design rights in the EU is governed by the following instruments:

(1) Directive 98/71/EC of the European Parliament and the Council of 13 October 1988 on the legal protection of designs,
(2) Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society,
(3) EU Regulation No 6/2002 of 12 December 2001 on Community designs.

All the aforesaid EU legislations recognise the coexistence of copyright and design rights in the subject matter of design protection, but leave the member states free to determine the circumstances in which copyright would protect designs, the term of protection and exceptions to such protection.

EU Regulation No 6/2002 of 12 December 2001 on Community designs

The UK's implementation of the EU legislations with effect from December 9, 2001

UK-EU Unregistered Design Right

- 'design' means '*the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.'*
- 'design right' is available in two variants, one a short-term unregistered design right and the other a longer-term registered design.

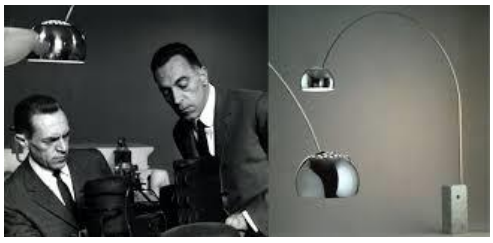
- a design must be new and have individual character. A design is considered to be new if no identical design (or near identical design differing only in immaterial details) has been made available to the public and it shall be considered to have individual character **if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public**:
  (a) in the case of an unregistered Community design, before the date on which the design seeking protection has first been made available to the public by way of publication, exhibition, use in trade etc.;
  (b) in the case of a registered Community design, before the date of filing of the application for registration of the design seeking protection, or if priority is claimed, the date of priority.
- Excluded from design protection are:
  - features of appearance of a product which are solely dictated by its technical function;
  - must-fit and must-match features of appearance of a product.
- There are, however, some important differences between the two forms of protection:
  (a) a registered design is protected for a maximum period of 25 years calculated from the date of filing of the application. It confers on its holder an exclusive right to use and to prevent any third party not having his consent from using it by way of making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.
  (b) an unregistered European Union/Community design, however, is protected for a period of three years as from the date on which the design was first made available to the public within the Community in the sense described above. It confers on its holder the right to prevent the acts referred to in (a) above **only if the contested use results from copying the protected design.**

The following cases illustrate how the CJEU has interpreted the aforesaid EU legislations and laid down binding rules of European law for the member countries without any room for national derogation

1) **Infopaq International A/S v Danske Dagblades Forening** (In Case C-5/08, CJEU, dated 16 July 2009)

In this case, CJEU reiterated as a settled autonomous notion of European law that **the test of 'author's own intellectual creation' lies at the core of copyright protection without any room for different national standards.** No member state can apply different standards of copyright protection for different categories of work.

2) **Flos SpA v Semeraro Casa e Famiglia SpA** (In Case C-168/09, CJEU dated 21 January 2011)



This case concerned a claim of copyright protection under Italian law in respect of the iconic 'Arco lamp' (as shown in the picture). It was designed in 1962 by Achille and Pier Giacomo Castiglioni.

Answering the question of law referred to it, the CJEU held that:

"it is clear from the wording of Article 17 of Directive 98/71" **an additional level of copyright protection with its full term (rather than the shorter term of design protection) must be conferred on all designs meeting the conditions for such protection without any deviation by member states.**

3) **Herbert Neuman & Andoni Galdeano del Sel v. Jose Manuel Baena Grupo, SA (joined cases C-101/11 P & C-102/11 P, CJEU, 18 October 2012)**

Baeno Grupo's Community Design No 426895-0002

(Image 1)

The earlier Community figurative mark no 1312651 relied upon by Newuman & Galdeano (Image 2)

This case originated as an action for invalidation of the plaintiff, Baena Grupa's Community design registration (*Image 1*) with effect from 7 November 2005 in Class 99-00 of the Locarno Agreement (ornamentation for T-shirts, caps, stickers etc.). The defendant, Neuman & Galdeano argued that the registered design lacked novelty and individual character in view of the earlier Community figurative trade mark (*as shown in image 2*) in respect of identical/allied goods in classes 25, 28 and 32.

Agreeing with the General Court's findings, the CJEU dismissed the defendants' appeals, holding that:

That the concept of 'informed user' must be understood as lying somewhere between that of the average consumer, applicable in trademark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trademarks at issue, and the sectoral expert, who is an expert with detailed technical expertise. In other words, the concept means a particularly observant user, either because of his personal experience or his extensive knowledge of the sector in question.

That the informed user for purposes of the present case comprised young people and children of the goods involved. Consequently, the difference in the facial expression produced by the two silhouettes would be clear to such young people and children: the leaning posture of the body in the earlier mark conveyed the impression of an angry character in a state of irritation, while that conveyed by the sign in the contested design was not characterised by any display of feeling.

What is the meaning of 'publication' for purposes of unregistered European Union design right

4) **H. Gautzsch Großhandel GmbH & Co. KG** v. **Münchener Boulevard Möbel Joseph Duna GmbH (Case C-479/12, CJEU, 13 February 2014**

H. Gautzsch Großhandel's Gazebo

This case originated as an action for unregistered design infringement under German law in respect of the plaintiff, MBH Joseph Duna's gazebo design (as shown in the picture). It asserted

that its new product's leaflets for the months of April and May 2005 had been distributed to the sector's largest furniture and garden furniture retailers and German furniture purchasing associations. It claimed that the defendant's 'Athen' design was a copy of its own design.

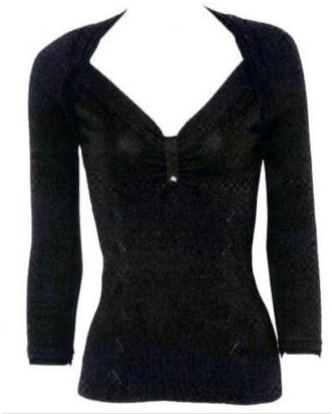
Answering the questions referred, the CJEU held that:

(i) It is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector. It is for the Community/EU design court to assess this in the facts and circumstances of each case.

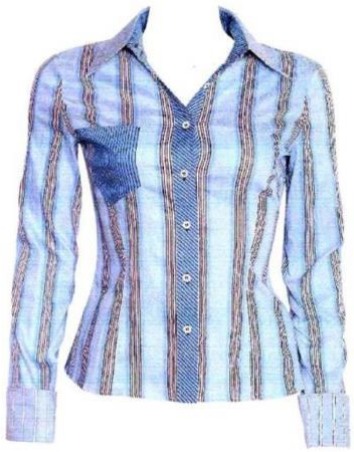
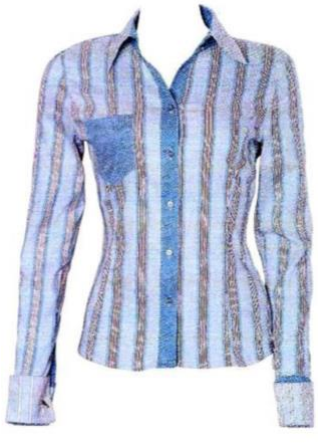
(ii) It is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union, if it is made available to only one undertaking in that sector or presented only in the showrooms outside the European Union. It is for the Community design court to assess this in the facts and circumstances of each case.

When an unregistered EU design to be considered to have individual character

5) Karen Millen Fashions Ltd v. Dunnes Stores, Dunnes Stores (Limerick) Ltd (Case C-345/13, CJEU, June 19, 2014)

Karen Millen Fashions Ltd	Dunnes Stores (Limerick) Ltd
	

A sweater designed by Karen Millen in 2005 (left) and another design which appeared on the shelves of Dunnes Stores outlets in 2006. Photograph: Handout/PA Wire

A shirt designed by Karen Millen in 2005 (left) and another design which appeared on the shelves of Dunnes Stores outlets in 2006. Photograph: Handout/PA Wire

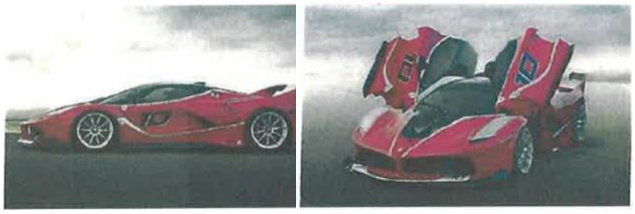
Karen Millen Fashions (KMF), a prominent English garment manufacturer and retailer, filed an action for infringement of its unregistered EU designs in the garments (*see the pictures above*). The defendant, Dunnes Stores acknowledged that it had copied the KMF garments; that KMF's claimed unregistered EU rights were new. However, it disputed KMF's claim in each of these garments on the ground that these garments did not have individual character within the meaning of Regulation No 6/2002 and that it required KMF to prove, as a matter of fact, that the garments had individual character.

Answering the questions framed, the CJEU ruled:

(i) For a design to be considered to have individual character, the overall impression produced by such design on the informed user must be different from that produced on such user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.

(ii) For a Community/EU design court to treat an unregistered Community design as valid, the right holder is not required to prove that it has individual character, but need only indicate what, in his view, are the element or elements of the design concerned which give it its individual character.

6) Ferrari SpA v. Mansory Design Holding GmbH, WH, (Case C-123/20, CJEU, 28 October, 2021)



Photographs of Ferrari FXX K (Model) displayed in the CJEU decision (extract of press release from Ferrari 2 December 2014)

Ferrari filed an action for infringement of its unregistered Community designs in the component parts including:

- the V-shaped element on the bonnet;
- the fin-like element protruding from the centre of the V-shaped element;
- the front lip spoiler integrated into the bumper; the vertical bridge in the centre connecting the spoiler to the bonnet.

Ferrari claimed that its unregistered Community design arose at the time of the publication of the press release of 12 December 2014 or in the alternative on the publication of the press release of 2 September 2014, featuring the appearance of the front lip spoiler or alternatively, on the release of a film on 3 April 2015 (Ferrari FXX K-The Making of).

Answering the questions, the CJEU held that:

1. The making available to the public of images of a product, such as the publication of photographs of a car, constitutes disclosure of a design of a part of that product/complex product within the meaning of Article 11(2) of the Regulation provided that the appearance of that part or component is clearly identifiable at the time the design is made available.
2. In order for a part or component of a product/complex product to satisfy the condition of individual character, it is necessary that the part or component in question constitute a visible section of the product or complex product, clearly defined by particular lines,

contours, colours, shapes or texture. The EU legislature did not intend that designers make available separately each of the parts of their products so as to benefit from unregistered Community design protection. That presupposes that the appearance of that part of the product or that component of a complex product is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole.

7) ***Response Clothing Ltd v The Edinburgh Woollen Mill Ltd*** **[2020] EWHC (decided on January 21, 2020)**

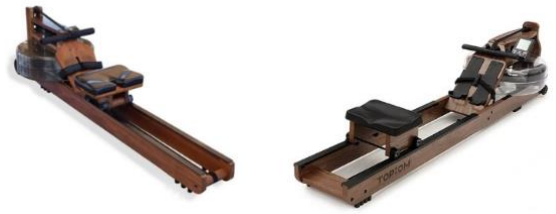
In this case, the UK's first instance court (EPEC) for the first time was required to consider whether the UK's requirement of artistic quality for certain categories of copyright works (a work of artistic craftsmanship) was compatible with EU law.

Response claimed copyright in its wave arrangement design applied to the ladies tops either as a graphic work or as a work of artistic craftsmanship.

Following a New Zealand precedent, the court accepted Response's claim that the fabric had an artistic value as a work of artistic craftsmanship in the sense that the author was both a craftsman and an artist- in the former role he was making something in a skilful way and taking pride in his workmanship and in the latter role exercising his creative ability to produce something which had aesthetic value.

However, taking note of the CJEU's rulings that national law could not impose a requirement of aesthetic or artistic value, the court took the view, subject to the Wave Fabric being original in the sense of the design being its author's own intellectual creation, that the said design qualified as a work within the meaning of Article 2 of the Directive and thus entitled to the full term of copyright as such.

8) **Waterrower (UK) Ltd v Liking Ltd (T/A Topiom (2024) EWHC 2806 (IPEC)**



The claimant, Waterrower (UK) Ltd, sells exercise equipment, including a water resistance rowing machine designed by Mr. John Duke between 1985 and 1987. The initial Waterrower prototype was hand-made by Mr. Duke. He had a lifelong interest in various forms of art, crafting with wood, and artistic design. Created by him with an aim to give the user "a welcoming emotional connection", he presented his hand-made version to a public boat show in 1987 and received his first orders following this public show.

The Waterrower rowing machine enjoyed a great amount of public recognition and accolades including:

- recognition as an "iconic design" in the UK and the USA.
- It had also featured in magazines, newspapers and on television, including in GQ, Men's Health, Playboy, Men's Fitness and House of Cards.

- It was on display in the Design Museum in London.

The Defendant, a Hong Kong-incorporated company had been selling its TOPIOM rowing machine at least since 2019. It was also a water resistance rowing machine and a replica of iteration 8 of the claimant's Waterrower rowing machine.

The claimant sued the defendant for copyright infringement under the CDPA 1988, arguing that its various iterations of the Waterrower rowing machine were protected by copyright under Section 4(1)(c) as "works of artistic craftsmanship".

The UK High Court did not agree. The Judge held that:

(1) Mr. Duke could be considered a craftsman in the context of his creation of the Prototype, but in his creation of the Prototype, he did not have the character of an artist craftsman.

(2) Mr. Duke used his skills to create the Prototype and that it had aesthetic appeal, but it failed to meet the test that, for a work to be one of artistic craftsmanship, it must have some artistic quality.

(3) The design of the Waterrower Prototype had considerable technical functional constraints in the choice of shape to fit the biomechanics of a human using the machine.

(4) The evidence in the record showed that the Prototype was not conceived with a desire "to produce something of beauty which would have an artistic justification for its existence.

(5) Mr. Duke's business goal in designing the Waterrower Prototype was driven by a desire to create a commercially successful rowing machine with a design of aspirational sensory impact, but not due to a creative desire to produce something which has aesthetic appeal.

The Judge also considered the binding effect of assimilated EU case law post-Brexit, in particular, as interpreted in Cofemel v G-Star Raw (C-683/17) which does not consider aesthetic effect necessary for copyright protection: that a "work" under EU law must be an original creation reflecting the creator's personality and creative choices. His finding on this point was that the Prototype was Mr Duke's own intellectual creation and an original work within the meaning of the InfoSoc Directive. Applying the test in Brompton Bicycle Ltd and another v Chedech/Get2Get (C-833/18), the Judge held that even if technical considerations influence a design, it can still qualify for copyright protection if it reflects the creator's personality and originality.

In the circumstances, the Judge held that Section 4(1)(c) CDPA cannot be reconciled with the InfoSoc Directive; that any UK law requirement that an original work, as construed under the InfoSoc Directive, must have "aesthetic appeal" would be inconsistent with the CJEU interpretation of that Directive.

****

The policy and law makers in the UK are currently engaged in a process of considering reforms in the legislative framework to find a way to exorcise it of the spectre of 'industrial copyright' unwittingly allowed back into the framework due to the binding EU law and caselaw.

Lessons for Indian policy and law makers

The foregoing overview of the relevant legislative and caselaw developments in the UK and Europe may serve as valuable signposts for policy and law makers in India to help them identify possible changes to the existing legal framework in India so as to achieve an equitable balance in the boundaries between artistic copyright with an automatic longer duration and a short-duration design protection.

As shown above, the evolving legislative responses, jurisprudence and industry experiences over the past many decades in the UK and Europe have yielded a rich repertoire of innovative legal tools to deal with the design-copyright interface.

Among the legal tools available today in European and English laws, the most innovative one is the "unregistered design right" in two variants. The English equivalent of this right owes its origin in the CDPA 1988 and is deservedly the pioneer and precursor as a form of intellectual property to the European equivalent in Regulation 06/2002 and other jurisdictions around the world.

While these two "unregistered design" variants share a number of similarities, there are certain marked differences between the two regarding their respective nature, scope and duration. The English variant extends automatic protection to original three-dimensional designs only (whether functional or not) subject to "must-fit" and "must-match" exceptions for functional parts, and it lasts for a period of 15 years calculated from the end of the calendar year in which the design was first recorded or if an article bearing the design was first put on the market, then ten years from the end of the calendar year in which that occurred (subject to licenses of right in the last five years)[2].

On the other hand, the European variant of "unregistered design right" extends protection to both 2D and 3D articles and has a short life of 3 years as from the date on which the design was first made available to the public within the European Union.

Under both the English and the EU variants, the unregistered design right confers on its holder the right to prevent acts of infringement only if the contested use results from copying the protected design.

There are, however, certain gaps in the European variant which are incompatible with the conceptual basis, history and jurisprudence underlying the Indian legal framework. One major gap relates to the scope of protection available under the European model in respect of designs which also meet the conditions for copyright protection, and its expansive reach as a result of the CJEU's binding precedents in Infopaq, Flos and Cofemel (supra).

In contrast, the English legal regime relating to "unregistered design right" as enacted in its original form under the CDPA 1988 (prior to the intervention of the aforesaid CJEU precedents and the resulting repeal of Section 52 in the UK) would appear to be compatible with the Indian legal framework, ethos and jurisprudence.

[2] Licenses-of-Right, a term of familiar meaning in patent law, refers to a regime of compulsory licenses without the need to prove non-exploitation or non-satisfaction of the market. These rights are available to anyone who demands one, subject to the terms and conditions to be settled by the Patent Office.

The Government of India is in the process of considering certain reforms to the Indian legal framework and has recently made available a Concept Note for public consultation. The Concept Note proceeds on the premise that the design-copyright interface has remained a subject matter of conflicting interpretations leading to frequent litigation and low predictability for businesses. However, the Note does not cite any data or statistics received from the relevant stakeholders to support its premise.

Section 15 of the Copyright Act is a special provision which seeks to demarcate the overlap between artistic copyright and design right by withdrawing copyright from any design registered or capable of registration under the Designs Act 2000. In the latter case, the copyright ceases if the article bearing the design has been multiplied in more than 50 copies. The Indian legal framework governing and mapping the demarcation boundary in the copyright/design interface under the two statutes has largely remained static since the 1911 Designs Act and its repealing 2000 Designs Act coupled with the Copyright Act 1957.

The Indian judicial precedents over the past decades leading up to the April 2025 Supreme Court's opinion in *Cryogas Equipment Private Limited v. Inox India Limited and Others* have consistently provided much clarity and certainty in the balance of rights under the Copyright Act and the Designs Act. It may be instructive to review and examine the body of available relevant judicial precedents in India to identify any possible gaps in the statutory scheme that may have been left unaddressed. In this connection, it may be pointed out that the English legal landscape on the copyright/design interface for over a century has been marked by a dynamic and creative tryst among law makers, judges and policy makers (such as the Swan and Gregory Committees), all engaged in an effort to map out the boundaries of the copyright/design interface to ensure free and fair competition and subserve the public interest.

While the Concept Note does not see any problem in the operation of the scheme underlying Section 15 (1) relating to withdrawal of copyright from the designs registered under the Designs Act, it notes certain ambiguity in the operation of Section 15(2) – that is, design-registrable subject matter which has been industrially multiplied in more than 50 copies.

To overcome this perceived ambiguity, the Note proposes to consider amending Section 15(2) in a way that allows copyright protection for such design-registrable and industrially multiplied subject matter, but limits its duration to 15 years only in sync with the lifespan of designs. It states that "*permitting the continued copyright protection but aligning the term of protection with commercial lifespan of designs, would help reconcile the two statutes. This would help prevent any attempts to claim long term copyright monopolies over the subject matter which is more appropriately regulated under design law".*

It is submitted that the premise underlying the proposed amendment is fundamentally flawed and, if implemented, would have the effect of introducing an inequality in the scope of protection for the two variants of design right, one registered under the Designs Act and the other qualifying as an unregistered design right of the kind envisaged in the Concept Note.

The proposal envisaged in the Concept Note will unwittingly lead to the following results:

(1) the owner of an unregistered design right of the kind envisaged would enjoy a larger bouquet of rights under the Copyright Act including the basic right to reproduce the design in any material form including conversion of it from a 2D to 3D version or vice versa.

(2) In contrast, the owner of a statutory design right under the Designs Act would enjoy only limited rights for the purposes of commerce to apply the registered design to the article covered by it.
(3) Since the unregistered design right would be governed by the Copyright Act, any infringement of the rights therein would attract both civil and criminal remedies with higher penalties attaching to repeat offenders. In contrast, the owner of a registered design would only be entitled to invoke civil remedies for infringement of his statutory rights.
(4) The uniform 15 years duration for both the variants, the unregistered design right arising automatically and the registered design flowing from the registration under the Designs Act would cause the claimants for design protection to shun the registration system with its attendant delays, costs and other limitations noted above and, instead, to opt for the automatic unregistered design right.

The suggested legal framework:

Given the aforesaid conceptual infirmities and limitations in the scope of rights under the two regimes, it is proposed to suggest the following amendments:

(1) The current Section 15 (2) may be amended to the following effect (the amendments shown in italics)[3]:

Section 15(2): *Copyright in any design, which is capable of being registered under the Designs Act 2000, 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 licence, by any other person.*

Provided when such designs have been industrially produced by multiplication in more than 50 reproductions, the owner of such designs will be entitled to a limited right to reproduce the design for commercial purposes by making either:

- *articles to that design; or*
- *design document recording the design for the purpose of enabling such articles to be made.*

Section 15(3): Such unregistered design right under Section 15(2) will last for a period of 15 years calculated from the end of the calendar year in which the design was first recorded or if an article bearing the design was first put on the market, then ten years from the end of the calendar year in which that occurred (subject to licenses of right in the last five years).

Section 15(4): Where a design covered under Subsections (1) or (2) originates in or made to a two-dimensional drawing or embodies a three-dimensional model which is itself a work of art, the withdrawal of copyright from industrially produced multiple copies of such design for the duration of 15 years granted in respect thereof, will not affect the copyright in the underlying work of art in all other respects. The withdrawal of copyright

[3] Per the ratio of the Microfibres DB judgment of the Delhi High Court and the Supreme Court in Cryogas Equipment Private Limited v. Inox India Limited and Others

will continue past the expiry of 15 years, and it would be permissible for any person to do an act which would otherwise have been an infringement of the registered or unregistered design right during its subsistence.

Illustration: if a drawing of an imaginary futuristic automobile or a painting by M.F. Hussain or a painting of Lord Ganesh, which may be considered original works of pure art, is commercially reproduced by industrial application to an automobile or a furnishing, copyright would continue to subsist in such works of art and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of such original artistic works per se. If anyone seeks to only reproduce the drawing/painting as a standalone work of art, it would violate the subsisting copyright of the author.[4]

For purposes of this section, the unregistered design right under Section 15(2) means '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 by the eye; but does not include any mode or principle of construction, and does not include any trademark or any artistic work when there is no industrial exploitation thereof in more than 50 copies.

(2) The current Section 52(1)(w) provides that "the making of a three-dimensional object from a two dimensional artistic work, such as a technical drawing, for the purposes of industrial application of any purely functional part of a useful article" does not constitute infringement of copyright.

The aforesaid Section may be amended to the following effect:

" Section 52(1)(w):

(i) *Functional use defence*: *The making of a functional and useful three-dimensional object from a two dimensional artistic work such as a drawing or blueprint or plans for the industrial manufacture of functional and useful articles or parts thereof does not constitute infringement of copyright in the drawing etc.*

(ii) *The making of a three-dimensional article from a two dimensional artistic work such as a drawing or a design document recording the design does not constitute infringement of copyright in relation to all such acts which fall within the ambit of unregistered design right available under Section 15(2), that is, the right to make the article to the design or the design document for the purposes of enabling such article to be made. However, in all other respects, the two-*

[4] It would be useful to recall the argument raised by the plaintiff in the Flashing Badges case (supra) "*by a case in which the claimant has a design document for the shape of a mug ("the mug design"). He then produces a drawing of a cow which is to adorn the side of the mug ("the cow design") and applies it to the side of 1000 mugs made to the design. The defendant copies the mug design including the cow design. He is not liable for copyright infringement of the mug design (although he may be infringing design rights in the shape of the mug) because he has the protection of Section 51. He is, however, liable for copyright infringement of the cow design, which is an artistic work in respect of which he enjoys copyright: Section 51 will provide no defence."* The judge accepted the submission and allowed the claim for copyright infringement.

dimensional artistic work or design document shall continue to enjoy copyright protection for purposes of this Act.

(3) The amendments proposed above would require consequential changes in the two statutes to ensure consistency and uniformity of treatment of "unregistered design right" and "the registered design right" for purposes of enforcement etc.

While the proposed legal framework has been structured on the UK UDR with its term of 15 years, it would be a matter for further consultation and discussions among all the relevant stakeholders whether the EU UDR term of three years would make better sense in view of the subject matter of such protection being meant for use by the makers of short lived mass-produced articles such as mock jewellery, toys, fashion designs etc.

***