

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **RFA (OS) NO.25/2006**

Reserved on : January 21, 2009

Date of Decision : May 28, 2009

Microfibres Inc.

.....Appellant

Through : Mr. Raju Ramachandran, Sr. Advocate, with
Ms.Ruchi Agnihotri and Ms.Anushree Tripathi,
Advocates.

Versus

Girdhar & Co. & Anr.

.....Respondents

Through : Mr. Prashanto Chandra Sen, Advocate, for the
respondent no.1.
Mr.Rajendra Kumar and Ms. Punita Bhargava,
Advocates, for respondent no.2.

AND

+ **FAO(OS) NO. 447/2008**

Mattel Inc & Ors.

.....Appellants

Through : Mr. Praveen Anand, Ms. Swathi Sukumar and
Ms. Tusha Malhotra, Advocates.

Versus

Jayant Aggarwalla & Ors.

.....Respondents

Through : Dr. A.M. Singhvi, Sr. Advocate, with
Mr. Sushant Singh, Advocate.

AND

+ **FAO(OS) NO. 326/2007**

Dart Industries Inc. & Anr.Appellants
Through : Mr. Arun Jaitley, Sr. Advocate, Ms. Jaspreet
Sareen, Mr. Angad Varma and Ms. Pragya Jha,
Advocates.

Versus

Techno Plast & Ors.Respondents
Through : Mr. Sanjay Jain, Sr. Advocate, with Mr.
Sushant Singh, Advocate.

CORAM:
HON'BLE MR. JUSTICE MUKUL MUDGAL
HON'BLE MR. JUSTICE VIPIN SANGHI

1. Whether the Reporters of local papers may be allowed to see the judgment? Yes
2. To be referred to the Reporter or not? Yes
3. Whether the judgment should be reported in the Digest? Yes

JUDGMENT
28.05.2009

: MUKUL MUDGAL,J.

1. This appeal bearing RFA (OS) No.25/2006 arises out of the judgment of the learned Single Judge dated 13th January, 2006 in Suit No. 1480/2002.
2. Since certain common issues arise in this appeal and the other two appeals i.e. FAO (OS) No. 326/2007 filed by Dart Industries Inc. and FAO (OS) No. 447/2008 filed by Mattel Inc., on the question of interpretation of

Section 2(c) of the Copyright Act read with Section 2(d) of the Designs Act and Section 15(2) of the Copyright Act and their interplay with each other, we have permitted the parties in the connected appeals also to make submissions on the common legal principles arising in these appeals. However, the aforesaid two appeals bearing FAO(OS) Nos. 326/2007 and 447/2008 will be taken up for hearing on facts and other pleas after the pronouncement of the judgment in the present appeal bearing RFA(OS) No. 25/2006 in the appeal titled *Microfibres v. Girdhar & Co. and Anr.*

3. The appellant manufactures and sells upholstery fabrics with designs derived from the original and unique artistic works either conceptualized or drawn by its employees or by assignation of the copyright in such artistic works to the appellant by the original artists.

4. The respondents are also manufacturers of upholstery fabrics and the learned Single Judge in the judgment challenged in this court has held that the upholstery fabrics of the respondent do incorporate/reflect the designs founded upon the appellant's artistic works or a substantial reproduction thereof.

5. The grievance of the appellant arises from the premise that the learned Single Judge held that the designs in question were capable of being registered under the Designs Act, 2000 and consequently the appellant was not entitled to seek protection under the copyright law as the designs had not been registered

under the Design's Act.

6. The learned Single Judge held as follows: -
 - a. In order for the work of the appellant to qualify as an artistic work, it must fall within the sub-section (c) of the Section 2 of the Copyright Act. A reading of the said provision shows that the attempt of the appellant can only be to bring it to the concept of 'painting'.
 - b. The comparison with the painting of M.F. Hussain, would be otiose, as the work in question in the present case, is not a piece of art by itself in the form of painting.
 - c. The originality is being claimed on the basis of the arrangement made. What cannot be lost sight of is the very object with which such arrangements or works had been made. The object is to put the artistic work into industrial use.
 - d. The two important aspects are the object with which it is made, which is industrial and its inability to stand by itself as a piece of art. In fact, it has no independent existence in itself.
 - e. In India, there are special legislations governing the protection of different nature of rights. In so far as the industrial designs are concerned, the protection is provided under the Designs Act, 2000.
 - f. Fabric designs on textile goods have been classified as proper subject

matter of design protection by inclusion as a specific class in the rules framed under the Designs Act. Such protection is provided under clause 05 of the New Design Rules, 2001.

- g. The exclusion of an 'artistic work' as defined in Section 2(c) of the Copyright Act from the definition of 'design' under Section 2(d) of the Designs Act, 2000 is only meant to exclude the original artistic works like paintings of M.F. Hussain. It is, thus, the original paintings, sculptors and such works of art which are sought to be specifically excluded from the definition of Design under the Designs Act, 2000.
- h. It is, thus, apparent that in the context of the Indian Law, it is the Design Act of 1911 or 2000, which would give protection to the appellant and not the Copyright Act.
- i. The application of mind and skill is not being denied nor the fact that the respondents have copied the same, but that would still not amount to the works in question being labeled as '*artistic work*' within the definition of Section 2(c) of the Copyright Act and, thus, the protection is not available under the Copyright Act.
- j. At the relevant stage of time, it was the Designs Act of 1911 which was in operation since the Designs Act, 2000 came into force only in May, 2001. The works of the appellant were capable of registration under the

Designs Act of 1911. The appellant, however, failed to register the same at that relevant stage of time. That the appellant itself has set out that it had registered the patterns under the Designs Act in England.

- k. Designs copyright was, thus, held to be distinguishable from artistic copyright. The rights under the Patent and Designs Act were much narrower than those given by the Copyright Act and in respect of such products, it was not intended that they should have cumulative protection both under the Copyright Act, the Patent Act and/or the Designs Act.
- l. What the appellant was actually required to do, was to register the designs, which the appellant has failed to do. The designs are older and, thus, would have been registrable under the Designs Act of 1911. The appellant failed to register the designs. Insofar as the Designs Act of 2000 is concerned, the appellant has also admittedly not registered the designs under the said Act.
- m. It would suffice to say that the patterns and designs of the appellant were capable of registration both under the old Act and the new Act and the appellant failed to do so with the result that the protection is not available to the appellant which would have arisen if they had been so registered.

- n. The appellant has failed to make out a case of having completed the requisite formalities in law so as to avail the benefit of the exclusive use of the patterns and designs in question.
7. It has been submitted on behalf of the appellant that the above finding of the learned Single Judge that the works of the appellant were not original artistic works within the definition of Section 2(c) of the Copyright Act proceeds on the misappreciation of law and seeks to draw an artificial distinction between those works which are pure artistic works and those which are not. In particular, he has questioned the finding of the learned Single Judge that the artistic work in question does not have the ability to stand by itself as a piece of art and in fact has no independent existence in itself. It has been contended that the exclusion of an ‘artistic work’ as defined in Section 2(c) of the Copyright Act from the definition of ‘design’ under Section 2(d) of the Designs Act, 2000 is meant to exclude the original artistic work.
8. The following three conclusions of the learned Single Judge have been questioned in this appeal:-
- (i) Re the works in question “...its inability to stand by itself as a piece of art. In fact, it has no independent existence in itself.”
(para 62 of the impugned judgment)
 - (ii) The exclusion of an ‘artistic work’ as defined in section 2(c) of the

Copyright Act from the definition of ‘design’ under Section 2(d) of the Designs Act, 2000 is only meant to exclude the nature of artistic works like painting of M.F. Hussain (para 65 of the impugned judgment).

- (iii) The application of mind and skill is not being denied nor the fact that the respondents have copied the same, but that would still not amount to the works in question being labeled as ‘artistic works’ within the definition of Section 2(c) of the Copyright Act and, thus, the protection is not available under the Copyright Act (para 62 of the impugned judgment).

9. The appellant through Senior Counsel Sh. Raju Ramachandran submitted as follows: -

- a. An erroneous and artificial distinction has been drawn by the learned Single Judge in between artistic works which are a piece of art by themselves and other works through the interpretation of Section 2(c) (i), whereas the subjective assessment of the artistic quality of a work is not required so as to qualify for the protection available under the Copyright Act, 1957. Reliance has been placed on the judgment in the case of *British Northrop vs. Texteam Blackburn Ltd. (1974)*

RPC 57 (ChD) to submit that the works must originate with the author and not being copies from another work as the only requirement, so as to qualify for copyright protection.

- b. The learned Single Judge found that the works in question were capable of being registered under the designs law as the Designs Act classification includes 'fabrics' as articles whose design can be registered. However, this finding fails to take note of the fact that it is the nature of the work which determines the intellectual property rights vested therein and not merely the fact that it falls under the classification of the Designs Act or the Trade Marks Act. Even the Trade Marks Act provided for registration of fabrics/textiles in Class 24. What was required to determine the capacity of being registered under the Designs Act was not whether the object fell into the classification within the Designs Act, but whether the work in question satisfied the substantive requirements for registration as a 'design'.
- c. The phrase 'capable of being registered' must be understood as referring to designs possessing, at the time of being made, such essential characteristics which qualify them as 'designs' under the Designs Act, 2000 i.e. being novel and original as opposed to merely

original as required under the Copyright Act, 1957. The Copyright Act requirement was merely the originality of the work. For a work to be within the meaning of ‘capable of being registered’, it must satisfy the definition of ‘design’ as well as the test of the work being novel or original and of it being sufficiently distinguishable from known designs or combination of known designs. While the learned Single Judge noted the respondents submission to the following effect “*..designs in use are built around permutations and combinations of a limited number of motifs/limitations from various sources and requiring very little by way of distinguishing variations to claim originality*”, yet he went on to hold that the said works are capable of being registered as designs and the two conclusions are incompatible. It is also found erroneously by the learned Single Judge that there is an element of labour and skill applied to a particular pattern of work in question which clearly required original artistic works and nevertheless a finding was made that the artistic works in question are not ‘original artistic works’.

- d. The operation of Section 15(2) of the Copyright Act, 1957 does not exclude from the ambit of copyright protection, the subject/underlying artistic works. Consequently, the original

underlying paintings created and acquired/owned by the appellant which were applied to the textiles with certain modifications do fall within the meaning of 'original artistic works' defined under Section 2(c) of the Copyright Act, 1957 and thus entitled to copyright protection. In fact, such works were clearly and expressly excluded from the definition of 'design' in Section 2(d) of the Designs Act.

- e. The paintings are either purchased from a third party or created inhouse by the appellant, and when an artistic work is purchased from a third party, a Certificate of Authenticity is obtained from the author of that painting, declaring that the copyright and the artistic work is assigned by the owner to the appellant. The original paintings undergo a series of processes and adaptations for them to be applied to fabrics, and each of these paintings and the modified drawings are separately and independently entitled to protection as an 'artistic work' under the Copyright Act, 1957. The intermediate paintings leading to the final product satisfy all the requisites of 'artistic works' and have independent existence by themselves as opposed to technical/engineering drawings solely created for the purposes of production of a corresponding product, which were no more than instructions for manufacturing applied to the product in question to

which they may have been applied. The application of adaptations and modifications to such artistic works on fabrics, may under Section 15(2) of the Copyright Act, extinguish the copyright protection therein after 50 productions, but does not affect the copyright protection afforded to the original work as ‘the artistic work’. It also does not affect the existence of separate copyright in any independent work which may have been used in the context of the creation of a particular product. The copyright in the underlying/original artistic work would continue to subsist and can be enforced by the copyright owner.

- f. The respondents’ fabrics being colorable imitations or substantially similar copies of the original underlying modified paintings of the appellant amounted to infringement of the artistic copyright therein. This is particularly so when in spite of the work of the respondent being claimed to be independent, no details of such original independent work were forthcoming. Reliance was placed on the judgment in the case of *Rajesh Masrani vs. Tahiliani Designs Pvt. Ltd.* [2009 (39) PTC 21 (Del.)] which held that Section 2(d) of the Designs Act, 2000 does not include any artistic work as defined in Section 2(c) of the Copyright Act. It was also held in the above

judgment that it is evident from the definition of ‘design’ under the Designs Act, 2000 that the artistic work as defined in Section 2(c) of the Copyright Act, 1957 is excluded if any party is able to bring his case within the framework of Section 2(c) of the Copyright Act, 1957 while claiming the copyright. In such a situation, the suit for infringement is maintainable.

g. Lastly, the plea of unfair competition which was evident from the almost identical product of the respondent was lost sight of. The finding of the learned Single Judge clearly demonstrated that the respondent having copied the artistic work of the appellant were not entitled to protection and such an interpretation has led to the blatant act of copying being permitted on account of mere technicalities. It has also been submitted that in the criminal proceedings instituted by the appellant under Section 63 of the Copyright Act, the Additional Chief Metropolitan Magistrate has rejected the report of the Investigating Officer stating that no case was made out on the following findings: -

“The investigating agency did not consider that the accused by counterfeiting the works of the complainant were intentionally and dishonestly deceiving innocent customers into believing that their products are made by

the complainant and thus dishonestly and fraudulently induced them to part with monies for such counterfeit and spurious products. The IO failed to examine the aspect that the accused have committed an offence of cheating and fraud within the meaning of Section 415 & 420 read with Section 120B IPC....”

10. The learned senior counsel summarized his arguments as follows:-
- a. The artistic works of the appellant were original “artistic works” within the meaning of Section 2(c) of the Copyright Act, 1957 and hence the appellant could claim exclusive rights in the same under Section 14(c) of the said Act.
 - b. The true import and content of the definition of Design under the Designs Act, 2000 specifically excludes “artistic works” as defined by Section 2(c) of the Copyright Act, 1957 from the definition of ‘Design’.
 - c. The artistic works in question being “artistic works” within the meaning of Section 2(c) of the Copyright Act, 1957, were squarely covered within the exceptions carved out under Section 2(d) of the Designs Act, 2000, and were hence “incapable of registration” under the Designs Act, 2000, rendering them protectable, solely under the Copyright Act, 1957.
 - d. Section 15(2) of the Copyright Act, 1957, cannot be said to apply to an “original artistic works “, such as those which were the subject matter of

the suit and the appeal, which are *incapable* of being registered as Designs.

- e. The exclusion in Section 15(2) applies only in respect of works which have been applied to an article and the said article has been reproduced more than fifty times.
- f. The copyright in the paintings are not extinguished by virtue of Section 15(2) of the Copyright Act, 1957.
- g. “Design” as defined by the Designs Act, 1911 as well as the Designs Act, 2000; means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means; and to be such must satisfy, inter alia, the test of “new” and “original” and not merely “originality” as under the Copyright Act, 1957.
- h. The analysis to be undertaken to determine whether a work is “capable of being registered” is not whether the same falls into a classification within the Designs Act, 2000 or not but rather whether the work in question satisfies the substantive requirements for registration as a “design”.

11 Mr. Arun Jaitley, Sr. Advocate, appeared on behalf of the appellants in FAO(OS) No. 326/2007 titled as Dart Industries Inc and Anr. vs. Techno Plast

and Ors. and FAO(OS) No. 447/2008 titled as Mattel Inc and Ors. vs. Jayant Aggarwalla and Ors. He addressed the arguments only on the question of interpretation of Section 15(2) of the Copyright Act as according to him the decision in the present case i.e. Microfibres Inc. vs. Girdhar and Co. and Anr. would also affect the appeals filed by his client.

12. He submitted that his client in the first case is a manufacturer of plastic utility products. The process involved is the preparation of the drawing which is called the first stage which then leads to the production of mould/engraving which is the second stage and from the said mould/engraving, the final product emerges, which is the third stage.

13. As far as the second case of Mattel is concerned, he submitted that the stage of mould/engraving is not there and straightaway from the drawing the product emerges. He further submitted that a design is related to aesthetics and visual features and utility part of the product relates to, at best, the patent and not the design law. He submitted that Section 14(c) of the Copyright Act defines the rights of an owner of a Copyright in an artistic work within the meaning of Copyright Act. By placing reliance on Section 14(c) (i), he submitted that such a copyright owner has a right to reproduce the work either in two-dimensional or three-dimensional products. Section 2(c) which defines 'artistic works' covered specifically both drawings and engravings. The

offending product of the respondent, was made by a process of reverse engineering which would involve the taking up of the product, creating a mould from it and finally a drawing. That the moulds and the drawings of the appellant are copyright protectable under the Copyright Act and could not be, and are incapable of forming part of the design registration. *Inter alia* he submitted that the mould and the drawing do not appeal to the eye as required under Section 2(d) of the Designs Act. Reliance was placed on Section 15(1) read with Section 2(c) of the Copyright Act to submit that upon the registration of a design the loss of copyright is restricted to the stage III i.e. the eventual product. Section 15(1) does not contemplate stages I and II, that is, the drawing and the mould not being protected under the Copyright Act. Section 15 of the Copyright Act in its entirety does not affect stages I and II and will apply to only those cases, which are design registrable and copyright registrable. That in so far as Section 15 (1) is concerned, the copyright is lost immediately upon the registration under the Designs Act and the exclusion under S.15(2) covers the cases which are registrable under the Designs Act and the product is produced 50 times. Reference was made to Section 2(d) of the Designs Act and reliance was placed upon a judgment in Ahuja Intellectual Property Cases Vol.3 NO.5, August 1998 **Smithkline Beecham Consumer Health Care vs. Eden Cosmetics Ltd.**

14. The learned counsel for the respondent no.2, Sh. Rajender Kumar submitted as under: -

A. The appellant's case was that the claim of artistic copyright in the fabric designs is not affected by the definition of 'design' in the new Designs Act, 2000 which specifically excludes 'artistic work' as defined in Section 2(c) of the Copyright Act, 1957. This plea of the appellant has been termed as incorrect in law and fact by the learned counsel for the respondent no.2. It is submitted that the interpretation negates the rationale underlying the copyright legislation and the design legislation and is not only anti-competitive but also would throttle and stagnate the industry. Reliance has been placed on the case of Interlego A.G. vs. Tyco Industries Inc. (1988) R.P.C. 343; Premier Hangers CC vs. Polyoak (PTY) Ltd. (1997) (1) SA 416 and S.S. Sarna Inc. and Anr. vs. Talwar and Khullar Pvt. Ltd. and Ors. I.A. Nos. 6597 and 6944 of 1991 in Suit No. 1481 of 1991 decided on August 08, 1991.

B. Reliance on the above judgments has been placed to show that the copyright protection relates to the image per se and design protection is for the manufactured article as a whole. While the protection of the image per se confers a very broad protection, the protection of the manufactured article confers only a limited monopoly.

C. The term 'artistic work' under the Copyright Act, 1957 include two

dimensional works such as drawings, paintings, photographs and engravings and three dimensional works such as sculptures, models and works of artistic craftsmanship. Under the Copyright Act, the copyright owners have wide range of rights including the basic right to reproduce their works in a material form including reproduction in different dimensions. The term of protection under the Copyright Act is far longer than that of a registered design (life of the author plus 60 years posthumous as against 15 years under the Designs Act) and there is no requirement of registration for protection. The copyright infringement remedies are far broader than those under the Designs Act. For this purpose, reliance has been placed on paragraphs 19 to 35 of the learned Single Judge's judgment.

D. The design does not stand on its own as an artistic work but is to be copied or applied in a commercially produced artifact object by an industrial process conferring protection on the manufactured article itself without any conceptual separation between the artistic work and the product on which it is applied. The statutory monopoly granted by the Designs Office is granted for a limited period of 10 years which is renewable by a further period of 5 years.

E. The crucial test is the industrial intent with which the object is made. It is submitted that the interpretation sought to be canvassed by the appellant would have the effect of rendering the design legislation in India redundant

because each design registered thereunder would be able to trace its origin to a diagram, chart, drawing etc. and thus, cease to be governed by the Designs Act. This would therefore enlarge the monopoly in industrial design from the current maximum term of 15 years to that available for a period of the age of the author plus 60 years available under the Copyright Act. Such an interpretation is anti-competitive and stagnates industrial innovativeness, the rationale underlying the statutory monopolies such as designs and patents. Reliance has been placed on paragraphs 51 and 64 of the learned Single Judge's judgment.

F. Reliance was placed on Section 15 of the Copyright Act, 1957 to emphasize the clear demarcation between the Copyright Act and the Designs Act.

G. Even assuming without admitting that the appellant's fabric designs fell within the definition of 'artistic works' so as to enable them to claim protection under the Copyright Act, the appellant still cannot rely upon any artistic copyright underlying designs and invoke the protection of the Copyright Act, 1957 in view of the clear mandate provided under Section 15(2) of the Act. The appellant's fabric designs not being registered and having been applied to by an industrial process more than 50 times, no artistic copyright protection can be claimed in view of the mandate of Section 15(2) of the Copyright Act, 1957.

For this purpose, reliance has been placed on paragraphs 67 of the learned Single Judge's judgment.

H. Even assuming without admitting that the exclusion of artistic work in the Designs Act, 2000 has the meaning ascribed to it by the appellant, such a meaning still does not support the case of the appellant. Section 15 of the Copyright Act is a limitation on the scope of the artistic works and contemplates such works which are aesthetic, eye-appealing and ornamental i.e. pure and simple works of fine arts. Section 15 withdraws the copyright from such works if such manifestation or features of shape, configuration, ornament etc. has been applied to an industrial product and multiplied more than 50 times. Section 15 of the Copyright Act interprets an important limitation on the scope of protection available to artistic works under the Act and exclusion of 'artistic work' from the definition of 'design' under Section 2(d) of the Designs Act, 2000, therefore, has to be read in view of the limitation imposed on copyright by virtue of Section 15 of the Copyright Act.

I. The rationale and philosophy underlying the design protection under the Designs Act, 1911 and its successor Designs Act, 2000 has remained the same and is evident from the following factors :-

a. The textile fabrics are registrable and in fact have been registered under both the Design Acts (1911 & 1999 Acts).

- b. Under the Designs Act, the fabric designs on textile goods have been classified under proper subject matter of design protection.
- c. The statement of objects and reasons, the notes on clauses accompanying the Designs Bill which lead to the enactment of the Designs Act, 2000.
- d. The proceedings from the parliamentary debate on the Bill.
- e. Hand-outs by the Designs Office for public information.
- f. Formal confirmation by the Registrar of Designs that the fabric design continues to be registrable under the Designs Act, 2000.

Reliance for the purpose has been placed upon paragraphs 65 and 66 of the learned Single Judge's judgment.

J. The appellant's case is not that the work in dispute was created as an artistic work, pure and simple and the plaintiff states that the appellant has been in the business of manufacturing and marketing of upholstery fabrics and in connection therewith has created original artistic works applied by it to such upholstery fabrics which is manufactured, marketed, sold and exported all over the world including India by it. The so-called artistic work thus, was always intended to be an industrial product for the production of a commercially produced fabric and marketed commercially. Reliance has thus been placed on the averments in paragraphs 3, 4, 6 and 13 of the plaintiff.

K. Even on facts, the appellant's case is founded on a few designs which in

fact had originated when the repealed Designs Act was in operation. It is also not in dispute that the subject matter ‘designs’ was created with an industrial intent for application to fabric or cloth and more than 50 reproductions have been made without registering them under the Designs Act.

L. Even the certificates relied upon by the appellant from the U.S. Copyright Officer refers to the subject matter as fabric designs and not artistic works.

M. The appellant was conscious of the fact that the registration was required for registration under the Designs Act and similar design was in fact registered under the U.K. Designs Act, 1949. Reliance was placed on paragraph 68 of the learned Single Judge’s judgment.

N. For the first time in the appeal, it has been averred by the appellant that the exception “capable of being registered” necessarily connotes and includes the element of novelty as a necessary requisite for design protection and thus, lack in novelty makes them incapable of registration under the Designs Act thereby granting them the protection under the Copyright Act. Such an interpretation by the appellant is not justified and has been rejected in the following two judgments i.e. *Interlego A.G. vs. Tyco Industries Inc.* (1988) ***R.P.C. 343*** and *Bayliner Marine Corp. vs. Doral Boats* (1987) ***FSR 497***.

15. Mr. Prashanto Chandra Sen, who appeared on behalf of the respondent

no.1 submitted as follows: -

- a. That the idea of applicability of work/painting/drawing to an article is central to the concept of design and for this purpose the learned counsel relied upon the definition of ‘design’ under Section 2(5) of the Designs Act, 1911 and Section 2(d) of the Designs Act, 2000. Reliance was placed on the judgment of *Dover LD case 1910 PRC Pg.498* and in particular the following passages:-

“...The explanation of this lies possibly in the fact that the novelty may consist not in the idea itself but in the way in which the idea is to be rendered applicable to some special subject matter. The word “original” contemplates that the person has originated something, that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it shall be applied. If that state of things be satisfied, then the Design will be original, although the actual picture or shape or whatever it is which is being considered is old in the sense that it has existed with reference to another article before. It is more easy by illustration in the concrete than by words in the abstract to explain what I mean. First, a few illustrations as to shape. The traditional figure of Falstaff is as old as Shakespeare, but if a person conceived for the first time the idea of making a wine beaker in the form of the figure of Falstaff that would be an original design for a wine beaker.....

....The words “new or original” involve the idea of novelty either in the pattern, shape or

ornament itself or the way in which an old pattern, shape, or ornament is to be applied to some special subject matter. There must be the exercise of intellectual activity so as to originate, that is to say, suggest for the first time, something which had not occurred to anyone before as to applying, by some manual, mechanical, or chemical means, some pattern, shape or ornament to some special subject matter to which it had not been applied before...”

- b. It was further submitted that the distinction between a ‘design’ and an ‘artistic work’ lies in the applicability of the former to an article. Reliance in this regard was placed on the quotation from Copinger’s Law of Copyright, 5th edition referred in *Con Planck Ltd. case 1923 KB 804* wherein it was held that the fundamental distinction between a design and a simple artistic work lies in the applicability of the former to some other article.
- c. Consequently, the test which was required to be applied was to consider the design and to see whether it is used or intended to be used as model of patterns to be multiplied by an industrial process.
- d. In respect of the present case, it was submitted that the patterns and designs were used industrially and commercially in India and abroad as per the case set up by the appellant in the plaint.
- e. The case set up by the appellant-plaintiff would result in every tracing,

drawing etc. being protected under the Copyright Act and also being industrially/commercially exploited, by being applied to articles which was not the intention of the Designs Act. Reliance was placed on the judgment of ***Pugh vs. Riley 1912 RPC 196*** which emphasizes the fact that a design necessarily requires something in the nature of a drawing or tracing. The following quotation from the above judgment was relied upon by the learned counsel for the respondent no.1:-

“A design to be registrable under the Act must be some conception or suggestion as to shape, configuration, pattern, or ornament. It must be capable of being applied to an article in such a way that the article, to which it has been applied, will show to the eye the particular shape, configuration, pattern or ornament, the conception or suggestion of which constitutes the Design. In general, any application for registration must be accompanied by a representation of the design; that is, something in the nature of a drawing or tracing, by means of which the conception or suggestion constituting the Design may be imparted to others. In fact, persons looking at the drawing ought to be able to form a mental picture of the shape, configuration, pattern, or ornament of the article to which the Design has been applied.”

- f. It was consequently submitted that what was capable of being registered as a design is the tracing, drawing etc. as applied to an article and not the tracing or drawing itself. The tracing, drawing etc. once applied to an

article becomes incapable of being registered as a design.

- g. The plea of the appellant was that even if the drawing or painting is applied to an article, it is still not being capable of being registered as a design because the original drawing/painting is protectable under copyright and artistic works protected by the copyright are excluded from the ambit of design. It is submitted that the above interpretation relied upon by the appellant is flawed as no tracing, drawing or painting which is applied to an article and commercially exploited can be registered as a design. In such an event the Designs Act would become otiose as every design necessarily traces its origin to a drawing or a painting.
- h. Different kinds of protection for an artistic work and commercially exploited work have been made available by the Legislature and, thus, the applicability of the drawing/tracing/mould being applied to articles is crucial to the concept of design as it is only the applicability of a tracing/drawing to an article which makes the work commercially exploitable.
- i. The copyright protection is available for the lifetime of the author or sixty years whereas such a long period of protection is not available under the Designs Act or the Patents Act. The legislative intent is

obvious as the products being commercially exploited cannot be granted a longer protection. Reliance was also placed on the judgments in *Interlego case (1988) RPC 343 at page 353, M/s. S.S. Sama, M/s. Samsonite case 73 (1998) DLT 732; M/s. Deepak Printary, Ahmedabad vs. The Forward Stationery Mart & Anr. (1976) XVII Gujarat R 338.*

We might notice that in the *Interlego case* the following position of law was laid down: -

“The definition of ‘design’ in section 1(3) of the Act of 1949 is hardly a model of Parliamentary draughtsmanship and this is by no means the first case in which its meaning and application have been called in question. In approaching the question of construction there has to be borne in mind that the purpose of the Act, as appears both from its terms and its legislative history, is to protect novel designs devised to be ‘applied to’ (or, in other words, to govern the shape and construction of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or inventions which, if protected at all, ought to be made the subject-matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. Indeed 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 artifact. Thus, the primary concern is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct

reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of articles of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.”

- j. He further submitted that the issue is academic in the present case as admittedly the designs of the appellant were made and sold much prior to 2000 and therefore, the definition of the Designs Act, 2000 would not be applicable in the present case.
- k. By placing reliance on Section 15(2) of the Copyright Act, 1957, it was submitted that the reproductions have been sold commercially in India and abroad by the appellant and the said reproduction are more than 50 in number and the appellants have modified their case only to overcome this and a plea has been raised that at first the original artistic works were sourced and thereafter they were considerably modified and applied to upholstery fabrics manufactured by the appellant company. Such a plea did not figure in the plaint.
- l. This is evident from the plea taken for the first time i.e. the underlying artistic works were not applied to any article and as such the extinguishment of the copyright under Section 15(2) of the Copyright Act does not apply to the said paintings.

16. Mr. Sanjay Jain, the learned Senior counsel appearing on behalf of the respondent no.1 in FAO (OS) No.326/2007 titled as DART Industries Inc. & Anr. v. Techno Plast & Ors., has made the following submissions in respect of the interplay of the Designs Act and the Copyright Act: -

- a. In so far as the 'artistic work' is concerned, it has a different connotation under the two Acts and enjoys different levels of copyright protection.
- b. Under Section 2(d) of the Designs Act, the exclusion of 'artistic work' is confined only to those artistic works governed by the Copyright Act. The above definition itself clearly stipulates that there are two categories of 'artistic works' – one governed by the Designs Act and the other by the Copyright Act. The artistic work governed by the Designs Act consequently receives copyright cover under Chapter III of the Designs Act and the residuary categories of artistic works receive protection under the Copyright Act.
- c. It is, therefore, necessary to determine the purpose for which the artistic work was created so as to determine which enactment applies. The creation of artistic work at the original stage/threshold level and then to assess if at all, at what stage it was decided to put it for industrial application, is also a relevant factor. Once the artistic work falls within

the category of Designs Act, it cannot revert back to the protection of the Copyright Act as once having been put to industrial use by replicating it 50 times, the protection under the Copyright Act is lost permanently. Consequently, once such artistic work is put to an industrial application, the intent of the author at the initial/conceptual stage becomes immaterial and copyright can only be preserved under the second category governed by the Copyright Act, even though the expression 'design' is not specifically used under Section 2(c) of the Copyright Act. The 'design' is certainly an artistic work at the initial stage and depending upon its application acquires protection of either the Copyright Act or the Designs Act if the industrial application is resorted to. This is evident from the exclusion embodied in Section 2(d) of the Designs Act.

- d. Since in the case of Microfibre Inc and Dart Industries Inc, it has been stated in the plaint that the artistic works in question were created/conceived by the in-house employees/promoters for the sole and pre-determined purpose of using the same as designs, meant for industrial application, the creation of the artistic work constitutes an integral part of a pre-programmed 'manufacturing process'. There is an industrial application and its segregation into two or three stages such as drawing/painting/moulding is not feasible under the regime of the

Copyright and/or the Designs Act.

- e. Section 2(j) of the Designs Act recognizes the existence of proprietary rights in a new or original design and as per Section 2(g) of the Designs Act, “originality” in relation to a design means as originating from the author of such design. Consequently, the expression ‘appeal to and judged solely by the eye’ occurring in Section 2(d) does not necessarily connote any aesthetic beauty in the classical sense but merely refer to such artistic works which have the capacity to enhance decorative value or visual appeal when applied to a finished article and can be distinctly perceived through human eye as various features described in Section 2(d) of the Designs Act i.e. (a) shape (b) configuration (c) ornament and/or (d) composition of lines or colours.
- f. The goods falling in all the above three categories fall under the classification of the Designs Act and in fact, in the Tupperware case, the plaintiffs had got a registration under the Designs Act.
- g. The learned counsel further submitted that the second of the two categories of artistic works are those works, which to begin with, were not put to industrial application and would be covered under the definition of Section 2(c) of the Copyright Act. Further, if such an artistic work is put to industrial use as defined in Section 15(2) by the

industrial application of 50 replications, it then loses its copyright protection and no protection is then available to such artistic work under the Copyright Act. Such extinguishment of copyright protection under Section 15(2) of the Copyright Act, once applied to final product as a design, whether through the conversion of a drawing into a two dimensional product or the conversion of drawing to moulding, eventually resulting in three-dimensional product, nevertheless, does not provide any copyright protection to the intermediate stages such as drawing/painting/moulding.

- h. Once an artistic work extinguishes, it loses the protective cover of the Copyright Act. As per application of Section 15(2) the protection under the Copyright Act ceases forever. The protection under Section 15(2) of the Copyright Act is not available at the initial stage of such artistic work, which at the threshold level are created for industrial application by obtaining registration under the Designs Act and such works stand covered by Section 15(1) of the Copyright Act. Such category of artistic work is completely excluded from the coverage under the Copyright Act at the threshold and even under the meaning of Section 2(c) of the Copyright Act, no protection is available to such works at any stage as the process of obtaining registration under the Designs Act is a clear

intention of abandoning the protection of the Copyright Act. Consequently, the two-stage theory for the underlying copyright coverage cannot apply as evident from perusal of Section 15(2) of the Copyright Act.

- i. Consequently, an artistic work falls in the basket of Designs Act by being created to be used as a design only; though not originally created to be used as design but subsequently relegated or pushed to be used as a design for being applied on a finished article after being produced more than 50 times.
- j. It is significant that the definition of artistic work in Section 2(c) of the Copyright Act does not use the expression 'design' as a variant or constituent of artistic work.
- k. Once the 'design' as a concept or as a variant is conspicuous by its absence from the definition of 'artistic work' under the Copyright Act, it is clear that a design cannot be de-structured or de-constructed by reverse engineering or otherwise to be an 'artistic work' within the meaning of Copyright Act.
- l. However, an artistic work can be lifted to the level of design under Section 15(2) of the Copyright Act. This is evident from the definition of 'design' under the Designs Act which removes all doubts and

possibilities of overlapping or an equivocal interpretation of the expression 'design' in the context of an 'artistic work' and excludes those artistic works from its ambit which has not been (a) created or (b) used as a design and then proceeds to confer copyright on such artistic works under Chapter III of the Designs Act.

17. Dr. Singhvi, the learned Senior counsel appearing on behalf of the respondents in FAO(OS) No.447/2008 titled as *Mattel Inc. v. Jayant Agarwalla & Ors.*, submitted as follows: -

I. Section 15 of the Copyright Act was retained for the purpose of statutory harmony between the Designs Act, 2000 and the Copyright Act, 1957. The scheme of the Designs Act of 1911 is the same and except the amendment in Section 2 (d) of the Designs Act, 2000 which excludes artistic work defined under Section 2(c) of the Copyright Act, 1957, the object was evident and was to prevent a very long-term or perennial monopoly of a person who was commercially exploiting something and yet enjoying long periods of copyright protection. The retention of Section 15 of the Copyright Act, 1957 inspite of the Designs Act, 2000 is relevant and shows that the legislature intended that Section 15 integrates the two Acts. The acceptance of the appellant's plea would render the need to register the design under the Designs Act nugatory as a design proponent would automatically get a larger period of copyright

protection under the Copyright Act. Such an interpretation would indeed render the Designs Act otiose.

Section 15(1) of the Copyright Act clearly notes the impact of the Designs Act, 2000 and promotes the mandate that the copyrightable designs shall not enjoy Copyright protection. Conversely, the Designs Act, 2000 excludes other copyrights not intended to be covered by the Designs Act.

An example of a painting of 'Ganesha' was given which would enjoy full copyright protection during the lifetime of the author plus 60 years. However, if the author applied the said painting of 'Ganesha' to a furnishing, to be commercially reproduced, such a painting when applied to a furnishing gets limited copyright protection under the Designs Act, 2000. The act of applying the painting to a furnishing, however, does not mean that the full copyright protection of the stand alone work of art/artistic work such as 'Ganesha' is lost. If anyone seeks to only reproduce the drawing/painting as a standalone work of art, it would violate copyright of the author.

Section 15(2) of the Copyright Act protects copyright in unregistered designs only till 50 reproductions are made. This clearly demonstrates the reciprocal statutory legislative intent which promotes harmony and not disharmony. On an assumption that Section 15 was not present in Copyright Act, the legislature could not have intended that the anomalous situation arises

allowing industrial designs to claim monopoly under the Copyright Act too. This rule out the applicability of the repugnant legislation which only applies in respect of interpretation of List III of the Constitution.

II. The mischief sought to be protected by the amendment in the Designs Act, 2000 is the larger protection period under the Copyright Act for a design which has been put into commercial production. Consequently, the mischief sought to be prevented is not the mischief of copying but of the larger monopoly claimed by the design proponent inspite of commercial production. The objects and reasons of the Designs Act clearly show that the legislature intended by virtue of Designs Act to promote design activity, competition and lessen the monopoly period. This is the finding in *Microfibres Inc. vs. Girdhar & Co* 2006 (32) PTC 157 in the following terms: -

“the mischief which is sought to be prevented by reading Section 15 is not copying by the respondent, but the mischief which is intended to be prevented by Section 15 is that a right holder cannot switch over the monopoly right and indirect claim right over a designable subject matter.”

In the case of *Indian Handicrafts Emporium and Others vs. Union of India and Others* (2003) 7 SCC 589 the mischief rule has been thus enunciated by the Supreme Court as under: -

“104. xxx

xxx

xxx

42. In *Jones vs. Wrotham Part Settled Estates, AC* at p.105, the law is stated in the following terms:

‘...I am not reluctant to adopt a purposive construction where to apply the literal meaning of the legislative language used would lead to results which would clearly defeat the purposes of the Act. But in doing so the task on which a court of justice is engaged remains one of construction, even where this involves reading into the Act words which are not expressly included in it. *Kammins Ballrooms Col. Ltd. vs. Zenith Investments (Torquay) Ltd.* provides an instance of this, but in that case the three conditions that must be fulfilled in order to justify this course were satisfied. First, it was possible to determine from a consideration of the provisions of the Act read as a whole precisely what the mischief was that it was the purpose of the Act to remedy

Similar view was taken in the case of *S.Gopal Reddy vs. State of A.P.*

(1996) 4 SCC 596 wherein it was held as under: -

“...He must set to work on the constructive task of finding the intention of the Parliament, and he must do this not only from the language of the statute, but also from a consideration of the social conditions which gave rise to it and of the mischief which it was passed to remedy, and then he must supplement the written word so as to give ‘force and life’ to the intention of the legislature.....”

III. The purpose of the Designs Act is that any aesthetic “not classical” value

as applied to an article and appealing to eye is protected. The protection is afforded to aesthetic and ornamental aspects of two dimensional and three dimensional products as well as the idea of applying such aesthetic and ornamental aspects to the product. The design registration giving protection of 15 years encourages commerce and if there was no Section 15 of the Copyright Act, the copyright protection would then be perpetual in effect rendering the Designs Act otiose.

The three levels of protection suggested by Mr. Jaitley, the learned Senior Counsel, i.e. the sketch, mould and product seeks to circumvent the legislative intent by achieving what is prohibited directly; that is enlarging the monopoly of commercial products.

Every design is traceable to a mould or a drawing and the only test which needs to be applied is the intent of creating the mould.

IV. It is evident that the intent of making the mould is not to sell the mould as a stand alone product on the article on which the mould or design would be applied. Thus, a drawing or mould eventually merges into an article and becomes part of the product and the copyright in the drawing or mould may remain as per the Copyright Act, 1957 but would stand reduced for the mould or drawing as applied to an article to 15 years, due to the commercial production and the emerging of the drawing and the mould into article. It is

also submitted that if any monopoly right over the article is lost, then the stages antecedent to the article has no value.

V. The design proponent once having elected to produce the article commercially cannot claim the larger period of copyright protection as once a right holder chooses to have patent/design right over an article then by virtue of operation of doctrine of election, the indirect right of copy over the drawings is abandoned/foregone by a right holder. This position was held in the case of *Catnic Components Ltd. vs. Hill & Smith Ltd. (1978) F.S.R. Vol.4 405.*

VI. Non-application of the doctrine of election would result in term of inconsistency that is the protection of design right for a period of more than 15 years. The claim of the appellant's in *Dart Industries Inc.* and *Mattel Inc.* are inconsistent with the copyright protection of 15 years by virtue of the Designs Act, 2000 and would amount to extending the copyright to the term of the lifetime of the author plus 60 years.

VII. The article is to be seen as a whole and the appeal of the article, subject matter of the design protection forms part of the article itself and hence cannot be protected as separate work of art.

18. In his rejoinder arguments Mr. Praveen Anand has argued that there is a vital difference between the subject matter of copyright and design protection.

I. He has tabulated the essential features of copyright and design protection

as follows:

S. No.	COPYRIGHT	DESIGN
1.	Creation based	Registration based
2.	Not destroyed by prior publication	Destroyed by prior publication
3.	Copying necessary	Grants monopoly
4.	Compromise of the work itself	Compromise of Article in addition to Design. That is the article is the different from the design that is applied to the article.

II. He submits that the election theory or intention test, as is propounded by the respondents is flawed. He submits that the election theory that the creator of an artistic work loses his copyright upon application of the work to an article or if the artistic work is created with the intention of being used as a design is improper and that it would lead to inequitable situations. The reasons for this submission of his are:

(a) The application of an artistic work to an article may not be in contemplation of the person creating the artistic work at the time of creation.

Illustration: For instance, if “A” creates an artistic work in the year 2001 and releases it in an art gallery. In 2003, the work is applied to an article.

Under the interpretations of the respondents, “A” will not be entitled to copyright protection under Section 15 (2) of the Copyright Act, 1957.

“A” will also not be entitled to design protection under Section 19(1) (b) of the Designs Act, 2000, as the “design” has been published by the exhibition of the artistic work in the art gallery in 2001

This will lead to an anomalous situation, where artists would be deprived of both rights.

(b) The application of the artistic work may be the thought of subsequent assignee and not the original artist; and

(c) The article to which the work is applied may itself come into existence in future (e.g. KINDLE by Amazon) and may not be in existence at the time the artistic work was created.

III. Mr. Anand submits that the extension of rights can arise only on the happening of two events which are as under:

A. Registration of a design is necessary. This is only possible if there is an

article, under the Designs Act (Section 15 (1) of the Copyright Act, 1957)

So the intention test is non-workable as it discloses the ambiguity and uncertainty of:-

- i. Whose intention is relevant?
- ii. When should the intention have existed; and
- iii. Intention to do what

B. Copyright in the design is capable of being registered and is reproduced over fifty times (Section 15 (2) of the Copyright Act, 1957). For this provision to apply, an 'article' has to exist, as defined under the Designs Act.

IV. Consequently, for Section 15 of the Copyright Act to get triggered it is not steps 1, 2 and 3 but steps 4 and 5 which trigger the section.

1. Creation of an artistic work
2. Formation of an intention by someone to apply the work to an article.
3. Creation of an article
4. Getting design for the article
5. Not getting a design registered but multiplying it fifty times

V. He submits that what stands extinguished is the copyright in the design and applied to an article and not the copyright in the artistic work itself. He

refers to Schedule 3 of the Designs Rules 2001 which deals with classification of goods for purpose of registration as a design to point out that the schedule uses expressions like equipment, apparatus, articles etc. but does not use the expression “Drawings”. He submits that the extent of extinction is copyright in the design for that article for which steps 4 and 5 above, namely registration or mass- multiplication have taken place. The copyright in the artistic work, as also the copyright in designs for non-registered and non-mass multiplied articles is preserved.

VI. He submits that he would make his submissions with regard to the meaning of an “article” and on the scope of Section 2 (d) on the Specific Reference to the facts of the Mattel Inc.’s case and submissions in that respect has not been made as at present.

19. The relevant statutory provisions are as follows: -

THE DESIGNS ACT, 2000	THE COPYRIGHT ACT, 1957
<p data-bbox="285 1655 753 1689">Section 2(d), The Designs Act, 2000</p> <p data-bbox="306 1777 802 2025">“design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by an industrial process or means, whether</p>	<p data-bbox="894 1655 1386 1689">Section 2(c), The Copyright Act, 1957</p> <p data-bbox="951 1731 1308 1765">(c) “artistic work” means,—</p> <p data-bbox="951 1806 1422 1958">(i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;</p> <p data-bbox="951 1995 1422 2025">(ii) a work of architecture;</p>

<p>manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957;</p> <p>Section 2(g) The Design Act, 2000</p> <p>“original”, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;</p> <p>Section 2(j) The Design Act, 2000 :</p> <p>“proprietor of a new or original design”,—</p> <p>(i) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed;</p> <p>(ii) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect</p>	<p>and</p> <p>(iii) any other work of artistic craftsmanship;</p> <p>Section 13 (2) (i) The Copyright Act, 1957</p> <p>13 (2) (i) in the case of a published work, the work is first published in India, or where the work is first published outside India, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of India;</p> <p>Section 15 The Copyright Act, 1967</p> <p>Special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 1911.</p> <p>(2) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 1911 (2 of 1911).</p> <p>(3) Copyright in any design, which is capable of being registered under the Designs Act, 1911 (2 of 1911), 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</p>
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<p>(iii) and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired;</p> <p>and in any other case, means the author of the design; and where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.</p> <p>Section 4. (The Design Act, 2000) :</p> <p>Prohibition of registration of certain designs.—A design which—</p> <p>(a) is not new or original; or</p> <p>(b) has been disclosed to the public any where in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or</p> <p>(c) is not significantly distinguishable from known designs or combination of known designs; or</p> <p>(d) comprises or contains scandalous or obscene matter,</p> <p>Section 12 (The Designs Act, 2000) :</p> <p>Restoration of lapsed designs.—(1) Where a design has ceased to have effect by reason of failure to pay the fee for the extension of copyright under sub-section (2) of Section 11, the proprietor of such design or his legal representative and where the design was held by two or more persons jointly, then, with the leave</p>	<p>copyright or, with his licence, by any other person.</p> <p>Section 16 (The Copyright Act, 1957)</p> <p>No copyright except as provided in this Act.—No person shall be entitled to copyright or any similar right in any work, whether published or unpublished, otherwise than under and in accordance with the provisions of this Act or of any other law for the time being in force, but nothing in this section shall be construed as abrogating any right or jurisdiction to restrain a breach of trust or confidence.</p> <p>Section 40 (a) (The Copyright Act, 1957)</p> <p>Power to extend copyright to foreign works.—</p> <p>40 (a) to work first published in any territory outside India to which the order relates in like manner as if they were first published within India;</p>
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of the Controller one or more of them without joining the others, may, within one year from the date on which the design ceased to have effect, make an application for the restoration of the design in the prescribed manner on payment of such fee as may be prescribed.

(2) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

Section 11. Copyright on registration—

(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.

Section 22. Piracy of registered design.

(1) During the existence of copyright in any design it shall not be lawful for any person—

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation

Section 22

Term of copyright in published literary, dramatic, musical and artistic works.— Except as otherwise hereinafter provided, copyright shall subsist in any literary, dramatic, musical or artistic work (other than a photograph) published within the lifetime of the author until [sixty years] from the beginning of the calendar year next following the year in which the author dies.

Section 67 Penalty for making false entries in register, etc., for producing or tendering false entries.—Any person who,—

(a) makes or causes to be made a false entry in the Register of Copyrights kept under this Act, or

<p>thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or</p> <p>(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or</p> <p>(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.</p>	<p>(b) makes or causes to be made a writing falsely purporting to be a copy of any entry in such register, or</p> <p>(c) produces or tenders or causes to be produced or tendered as evidence any such entry or writing, knowing the same to be false,</p> <p>shall be punishable with imprisonment which may extend to one year, or with fine, or with both.</p>
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20. After taking into account the above pleas, we are of the view that Section 2(c) of the Copyright Act defines “artistic work” to mean a painting, sculpture, a drawing (including a diagram, map, chart or plan), and engraving or photograph, whether or not any such work possesses artistic quality. It also includes a work of architecture and any other artistic craftsmanship. This definition 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.

21. The rights to which a holder of an original artistic work is entitled are enumerated in Section 14(c) of the Copyright act. These are, the right:

- (i) To reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;
- (ii) To communicate the work to the public;
- (iii) To issue copies of the work to the public not being copies already in circulation.
- (iv) To include the work in any cinematograph film;
- (v) To make any adaptation of the work;
- (vi) To do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv)

22. Therefore, 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. When the copyright holder of an original artistic work reproduces the same in another material form, he may, or may not

do so by employing an industrial process or means which may be manual, mechanical or chemical, separate or combined, on an article. If the reproduction of the original artistic work is done by employing an industrial process, as aforesaid, on an article, and the same results in a finished article which appeals to the eye as adjudged solely by the eye, then the features of shape, configuration, pattern, ornament or composition of lines or colours applied to the article by the industrial process constitutes a “design”, within the meaning of this expression as defined under the Designs Act.

23. There is, therefore, a clear distinction between an original artistic work, and the design derived from it for industrial application on an article. This position is clarified by the use of the expression “only” before the words “*the features of shape, configuration, pattern, ornament or composition of lines or colours*” in the definition of “design” in the Designs Act. Therefore, the original artistic work, which may have inspired the creation of a design, is not merely the feature of shape, configuration, pattern, ornament or composition of lines or colours which are created to apply to an article by an industrial process. The original artistic work is something different from the design. Secondly, the definition of “design” expressly excludes, inter alia, any artistic work defined in section 2(c) of the Copyright act, 1957.

24. It needs to be emphasized that it is not necessary that in every case a

design has to be preceded by an artistic work upon which it is founded. A craftsman may create a design without first creating a basic artistic work. This may best be illustrated by a weaver who may straightaway create a design while weaving a shawl, which product could be created even without the basic artistic work.

25. Whether or not a design is preceded by an original artistic work, a design would, in its own right qualify to be termed as an artistic work within the meaning of Section 2(c) of the Copyright Act. This is so because the expression ‘artistic work’ as defined in Section 2(c) of the Copyright Act bears a wide definition to mean a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality. However, the design may or may not enjoy a copyright protection under the Copyright Act, depending on whether it is an ‘original artistic work’ or not.

26. The expression “*copyright in any design*” used in Section 15(2) means the copyright as understood under the Copyright Act, and not under the Designs Act. This is evident from the expression “*copyright shall not subsist under this Act.....*” used in sub-section (1) of Section 15. However, copyright in an artistic work subsists provided it is an original artistic work. Therefore, there can be no claim for Copyright under the Copyright Act in an artistic work

which does not have the quality of possessing originality. The holder of a copy of an original artistic work cannot claim copyright protection. Therefore, to be entitled to protection under the Copyright Act, the design should have originality. That is not to say that if the design is not entitled to copyright protection under the Copyright Act, on account of it not possessing originality vis-à-vis the original artistic work, the design does not require, or cannot be granted registration under the Designs Act for it to be entitled to protection under the Designs Act.

27. Under the Designs Act, a copyright has a different connotation from a copyright under the Copyright Act. Under the Designs Act, copyright means the exclusive right to apply the design to any article in any class in which the design is registered.

28. The issue with regard to the extent of, and the conditions for the copyright protection to such an artistic work, as an artistic work under the Copyright Act, which is a design registered or capable of registration under the Designs Act, is what is dealt with, by section 15 of the Copyright Act. Once the distinction between the original artistic work and the design derived from it, and the distinction between Copyright in an original artistic work under the Copyright Act, and a copyright in a design under the Designs Act is appreciated, the meaning and purport of section 15 of the Copyright Act

becomes clear.

29. Section 15 of the Copyright Act is in two parts. The first part i.e. subsection (1) states that copyright shall not subsist under the Copyright Act in any design which is registered under the Designs Act. Consequently once the design is created and got registered under the Designs Act, whether or not the design is eventually applied to an article by an industrial process, the design loses its protection as an artistic work under the Copyright Act. Therefore, subject to whatever rights that are available under the Designs Act, the registered design holder cannot claim protection or complain of copyright infringement in respect of the registered Design under the Copyright Act.

30. Subsection (2) of section 15 deals with the situation where the design, which is capable of being registered under the Designs Act, is not so registered. It provides that copyright in such a design shall cease as soon as any article to which the design has been applied has been reproduced more than 50 times by an industrial process by the owner of the copyright or with his licence, by any other person. It is clear to us that the Parliament in Section 15 of the Copyright Act was dealing with the aspect of copyright in a registered/registrable design, as understood in the Copyright Act and not the Designs Act. Else, there was no need to deal with this aspect in the Copyright Act. The same would have been dealt with under the Designs Act. Therefore,

the law tolerates only a limited industrial, or shall we say commercial, exploitation of the original artistic work by the application/reproduction of the said work in any other form or reproduction of copies thereof in exercise of the rights under Section 14(c)(1) and 14(c)(iii) of the Copyright Act. Beyond the specified limit, if the design derived from the original artistic work is exploited (i.e. if the design is applied more than 50 times by an industrial process on an article) the copyright in the design ceases unless it is registered under the Designs Act.

31. We are also of the view that it is not correct on behalf of the appellant to urge that the intention of the creation of the work determines the Intellectual Property Rights contained therein, and not whether such work fell within the classification of “Designs” under the Designs Act or the Copyright Act. The Designs Act nowhere stipulates the intention of the creator of the work as a determinative criteria and the exhaustive definition given not only in the Designs Act but indeed the Copyright Act clearly rules out such interpretation as suggested by Shri Raju Ramachandran. In fact, the appropriate occasion to evaluate the registrability of a design would arise when the artistic work is translated into an object having features of shapes, configuration, pattern, ornament or composition of lines or colors whether two dimensional or three dimensional by employing an industrial process. Significantly, the appellant

themselves have registered their product under the Designs Act in U.K. Furthermore, as submitted by the appellant, even if there is very little variation between the original artistic work and the design which is industrially applied to an article to produce a product, nevertheless, such a design can claim registration under the Designs Act, provided such registration was sought. The interpretation suggested by the appellant would clearly afford not only the design protection in case of registered works but also in addition, the copyright protection to the works which were industrially produced, which interpretation does not reflect the legislative intent.

32. 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 period of protection to design activity commercial in nature. The period of copyright would be the author's life span plus 60 years. However, the legislature has allocated a lesser time span for the protection available to a registered design as only being 15 years. Thus, commerce and art have been treated differently by the Legislature and any activity which is commercial in nature has been granted lesser period of protection. On the other hand, pure artistic works *per se* have been granted a longer protection.

33. The Statement of Objects and Reasons of the Designs Act, 2000 reads as follows: -

“Since the enactment of the Designs Act, 1911 considerable progress has been made in the field of science and technology. The legal system of the protection of industrial designs requires to be made more efficient in order to ensure effective protection to registered designs. It is also required to promote design activity in order to promote the design element in an article of production. The proposed Designs Bill is essentially aimed to balance these interests. It is also intended to ensure that the law does not unnecessarily extend protection beyond what is necessary to create the required incentive for design activity while removing impediments to the free use of available designs.”

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.

34. Section 6 of the Designs Act, 2000 reads as follows:

“6. Registration to be in respect of particular article.—(1) A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.

(2) Any question arising as to the class within which any article falls shall be determined by the Controller whose decision in the matter shall be final.

(3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated—

(a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in India or in any other country, by reason only

that it has been applied to article in respect of which it was previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

(4) Where any person makes an application for the registration of a design in respect of any article and either—

(a) that design has been previously registered by another person in respect of some other article; or

(b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,

then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application, the applicant, had been the registered proprietor of that design.”

A perusal of the above Section 6 clearly indicates that once the design has been registered for a particular article comprised in a class of articles, the subsequent registration of other articles comprised in that class of articles shall not be refused but the subsequent registration shall not extend the period of copyright in the design beyond that arising from the previous registration. It is significant that the subsequent registration has statutorily been mandated not to extend the period of copyright registration beyond the period beginning from the original registration. This clearly shows the legislative intent of limiting the copyright protection in the design to the initial period of 10 years, extendable by further period of 5 years.

35. However, there can be no quarrel with the plea of Shri Ramachandran that the operation of Section 15(2) of the Copyright Act does not exclude from the ambit of Copyright protection either the original “artistic work” upon which the design is based or the design which by itself is an artistic work. It cannot be disputed that 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. This is also evident from the definition of the design under Section 2(d) of the Designs Act. This, in our view, in fact is a factor which would go against the appellants in construing the nature of protection to be given to the original artistic work such as a painting, as contrasted with the applied artistic work that is the design, which in the present case does not mean the intermediary medium such as a mould, engraving devised/produced only to enable industrial application of the painting to produce the furnishing products of the appellant. Thus, while the original painting would indeed be entitled to the copyright protection, the commercial/industrial manifestation of such paintings such as the design derived from and founded upon the original painting for the purpose of industrial production of furnishings would only be covered by the limitations placed in Section 15 of the Copyright Act and would get protection if

registered as a design under the Designs Act but would enjoy lesser period of protection in case of a registered design.

36. This clearly shows that the legislature intended that even if the artistic work such as a painting has been used as the basis for designing an industrially produced object for commerce, such as the furnishing in the present case, nevertheless the original painting would indeed enjoy full copyright protection, while the result of the industrial application of such painting, namely, the design used in the industrial production of the ultimate product shall enjoy lesser period of protection as stipulated under the Designs Act provided it is registered as a design under the Designs Act. *Thus, we are of the view that an original artistic work initially acquires protection under the Copyright Act as an 'artistic work' or else the protection under the Designs Act qua the product created from the artistic work when industrially applied.*

37. Dr. Abhishek Manu Singhvi, the learned Senior Counsel appearing for the respondent in FAO (OS) No.447/2008 had submitted, and in our view rightly so that the object of the two legislations was to prevent long term usage by the person who was commercially exploiting something and yet wanting to claim an exclusive monopoly through longer period of copyright protection afforded to an artistic work. Section 15 of the Copyright Act demonstrates the legislative intention of integrating the Copyright and Designs Acts and any

other interpretation would, as rightly submitted by Dr. Singhvi, render the registration under the Designs Act as meaningless as a design proponent will always get a longer period of copyright protection under the Copyright Act. In our view, the above plea would make a registration under the Designs Act meaningless, which the legislature could have never intended. In fact, the plea of Dr. Singhvi that a design which has been granted the protection under the Designs Act cannot be granted protection under the Copyright Act is correct and this is evident from Section 15(1) of the Act.

38. Thus, while it is not open to the respondent to reproduce such paintings *per se*, which formed the basis of the design that was applied to the fabric, nevertheless, such protection qua the design imprinted on the product through industrial application is available only under the Designs Act, provided there is a registration. 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. This clearly indicates that the legislature intended to provide industrial and commercial application of an artistic work for commerce lesser protection.

39. Shri Arun Jaitley, the learned Senior Counsel appearing for the appellant in FAO (OS) No.326/2007 titled as M/s Dart Industries Inc. & Anr. v. M/s Techno Plast & Ors. had only made submissions in the present appeal in respect of Section 15 of the Copyright Act to the extent it could affect the appeal filed by his clients. He had advanced a very attractive argument as to the three stages of processes leading to the eventual designed product. He submitted that the first stage is of the preparation of drawing or artistic work which leads to the production of mould/engraving which is the second stage and such mould/engraving leads to the final commercially marketable product, which is the third stage. He has also submitted that the products of the respondent were made by the process of reverse engineering starting from the final product leading to the second stage of creating a moulding, and from it a final drawing. His plea was based upon the premises that the mould and the drawing of the appellant are copyright protectable under the Copyright Act and cannot be or are incapable of forming part of the design registration regime. It is submitted that the product of the respondent involves the copying of the mould/drawing of the appellant.

40. While the argument is very attractive but nevertheless it is not legally sustainable because such a plea would enlarge the monopoly in industrial design from the current maximum time of 15 years to the longer period

available under the Copyright Act. While the original drawings of the appellant could be entitled to copyright protection under the Copyright Act as artistic works, the designs derived therefrom as moulds which are used for industrial application of the design on the articles would not qualify for protection as artistic works under the Copyright Act except in accordance with Section 15(2) of the Copyright Act. It is not the case of the appellant Microfibres or even that of Mr. Jaitley's clients that the design applied on the fabric (in the case of Microfibres) or the plastic (in the case of Mattel Inc.) has not been applied for more than 50 times. There designs have been used more than 50 times. The learned Single Judge in paragraph 51 of the impugned judgment held as follows:

“The plea of the plaintiff is also sought to be negated on the issue of definition of a ‘design’ under Section 2(d) of the Designs Act, 2000 whereby an ‘artistic work’ as defined in clause (c) of Section 2 of the Copyright Act has been specifically excluded. The submission was, thus, advanced that this would have the effect of rendering the law of designs redundant for the simple reason that each design registered thereunder would be able to trace its origin to a diagram, chart, drawing, etc. and, thus, cease to be governed by the Designs Act. The legislative intent could not have been this because the law of designs is based on the same principle as applicable to other monopolies and to fuel industrial innovativeness by granting limited time-limit to the monopolies and allow others to

make use of them after they have passed into the public domain. Thus, the plea of the plaintiff, if accepted, would be anti-competitive and would throttle and stagnate the industry. (Emphasis supplied)”

In our view the learned Single Judge has felicitously summed up the legislative intent that limited monopoly should be granted to fuel industrial inventiveness in the field of commerce. We fully approve and reiterate the aforesaid view.

41. As rightly submitted by Shri Rajender Kumar, the learned counsel for the respondent no.2 in the present appeal, the interpretations canvassed by the appellant would, render the design legislation *otiose*, because every registered design would then be able to trace its origin to a chart, drawing, diagram etc. and consequently also claim copyright protection under the Copyright Act in addition to the protection as a registered design under the Designs Act.

42. Shri Prashanto Chandra Sen, the learned counsel appearing on behalf of the respondent no.1, contended that the difference between a design and an artistic work lies in the applicability of the former to an article as evident from the decision in *Con Planck Ltd. case 1923 KB 804*, wherein it was held that the fundamental distinction between a design and a simple artistic work lies in the applicability of the former to some other article. In our view, the interpretation suggested by Shri Jaitley would result in every industrial tracing,

drawing or mould which may not be an original artistic work within the meaning of Section 2(c) read with Section 13 of the Copyright Act, and which lead to the designed product, being afforded protection under the Copyright Act as an original artistic work and also being at the same time industrially and commercially exploitable by being applied to marketable articles by claiming protection under the Designs Act, 2000.

In the case of *Interlego (1988) RPC 343*, the following position of law was laid down:

“The definition of ‘design’ in section 1(3) of the Act of 1949 is hardly a model of Parliamentary draughtsmanship and this is by no means the first case in which its meaning and application have been called in question. In approaching the question of construction there has to be borne in mind that the purpose of the Act, as appears both from its terms and its legislative history, is to protect novel designs devised to be ‘applied to’ (or, in other words, to govern the shape and construction of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or inventions which, if protected at all, ought to be made the subject-matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. Indeed 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 artifact. Thus, the primary concern is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to

prevent the manufacture and sale of articles of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.
(emphasis supplied)”

Thus, in the case of *Pugh v. Riley 1912 RPC 196* the general principle was laid down that any application for registration must be accompanied by a representation of the design which ought to be in the nature of a drawing or a tracing, by means of which the suggestion constituting the design may be imparted to others. A person looking at the drawing must be able to form a mental picture of the shape, configuration, pattern or ornament of the article to which the design has been applied. Further, in the case of *Interlego (supra)* it was laid down that the purpose of design is not to protect the principles of operations or inventions which, if protected at all, must be made the subject matter of the patent. This process of operation or invention such as a moulding/engraving could at best be granted patent protection and thus, Mr. Jaitley’s plea that such intermediary process be granted copyright protection cannot be accepted. Thus, what is granted is a right, over a lesser period, to prevent the manufacture and sale of articles of a design not substantially different from those industrially produced by the application of the registered design. The emphasis therefore, is upon the visual image conveyed by the manufactured article and thus the above judgment of *Interlego (supra)* also

supports the case of the respondent, that the intermediary process of creation of a design from an original artistic work cannot be afforded protection under the Copyright Act if it crosses the *lakshman rekha* of having been applied more than 50 times industrially to produce an article.

43. Undoubtedly, it is true as contended by Shri Jaitley that the artistic work defined under Section 2(c) of the Copyright Act need not possess artistic quality. His plea about the copyright protection available to moulding/engraving/drawing is postulated on the above premise. Nevertheless, we cannot lose sight of the fact that the design, based upon a moulding or an engraving derived from the original artistic work, which is used for industrial application on an article and which evolves during any process intermediate to the reproduction of the finally designed article, would not qualify as an artistic work. The case of *Dover LD (supra)* clearly requires the exercise of intellectual activity so as to originate some novel application and thus, this principle cannot be applied to a mould, or an engraving i.e. the intermediates which are mere derivatives of the original artistic work. In the case of *Pugh vs. Riley (supra)* also it was held that a design is preceded by a drawing or tracing which incorporates the design to be imparted to produce the designed article and upon being applied to an article become incapable of being registered as a design.

Thus, the interpretation as suggested by the appellant would have the effect of rendering the design legislation in India redundant as every design could have its origin to an intermediate product such as a engraving, mould, diagram etc. It is also anti-competitive and stagnates innovativeness beside in effect negating the legislative intent of giving lesser protection of 15 years to a 'design' under the Designs Act as compared to the larger protection of 60 years to an 'artistic work' under the Copyright Act.

44. We cannot accede to the plea of Shri Sanjay Jain that the intention of creating an artistic work would determine as to which enactment applies. The artist's intent at the time of creation of the artistic work is indecipherable at the best of times. Artists are governed more often than not by their emotions and moods and whatever be the intention at the time of the creation of the artistic work cannot, in our view, determine the nature of protection available to the artistic work. Indeed such a plea of Shri Ramachandran has already been rejected by us, as the stupendous and commercial success of a particular artistic work may spur on the artist to permit commercial utilization and exploitation of such a work of art. To this extent, we agree with Mr. Praveen Anand that an intention of creation is difficult to ascertain and cannot form the basis of determining the rights. Thus, even if the original painting was intended to be created only as a work of art, a latter intention may transform it

by its industrial application into a commercially viable object. To this extent, we agree with the plea of Shri Sanjay Jain that once the artistic work, by industrial application transforms into a commercially marketable artifact its design falls within the domain of the Designs Act and the protection to the design founded upon the artistic work is limited by section 15 of the Copyright Act and the provisions of the Designs Act.

45. Learned counsel Shri Praveen Anand, appearing on behalf of the appellant in FAO (OS) No.447/2008 has contended that there is a vital difference between the subject matter of copyright and design protection. In our view, while this plea is sustainable, nevertheless, it cannot be ignored that different kinds of protection for an artistic work, and the design founded upon the artistic work which is industrially and commercially exploited, has been intended by the Legislature. He has further submitted that what stands extinguished under Section 15 of the Copyright Act is the copyright in the design itself as applied to an article and not the copyright in the artistic work itself. There is no quarrel with this proposition. However, that does not advance the case of the appellant. We do hold that 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. Thus, for instance a famous painting will continue to enjoy the

protection available to an artistic work under the Copyright Act. A design created from such a painting for the purpose of industrial application on an article so as to produce an article which has features of shape, or configuration or pattern or ornament or composition of lines or colours and which appeals to the eye would also be entitled design protection in terms of the provisions of the Designs Act. Therefore, if the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act but not the original painting. 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, in our view, would harmonize the Copyright and the Designs Act in accordance with the legislative intent.

46. We thus summarize our findings as follows: -

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(d) 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.

47. Thus, we find no merit in this appeal and the same is dismissed but with no order as to costs.

48. List FAO (OS) No. 447/2008 and FAO (OS) No. 326/2008 for hearing on 7th August, 2009.

(MUKUL MUDGAL)
JUDGE

(VIPIN SANGHI)
JUDGE

May 28, 2009
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