Legal Issues in 'IP in Industrially Applied Works'

Issue: Are Industrial Drawings Capable of Being Protected as Copyrightable Works?

Introduction

- Industrial Designs are regarded as “applied works of art”, wherein there is a satisfaction of technical and non-technical (*i.e. aesthetic*) functions.
- There are provisions in the Copyright and Design Act which attempt to deal with this overlap and create harmony in the application of these laws over the same subject matter.
- Particularly, Section – 15 (2) of the Copyrights Act creates a distinction in the protections that can be offered to industrial designs.
- The interpretation of this provision has, however, been questioned quite often.

Relevant Legal Provisions

- **Section 2 (c), Copyright Act, 1957 –**

"(c) "artistic work" means,—

(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;*

(ii) a [work of architecture]; and

(iii) any other work of artistic craftsmanship;" (Emphasis supplied)

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Relevant Legal Provisions (contd.)

- **Section 2 (d), Designs Act, 2000 –**

> *""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 any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, 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 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or* ***any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957*** *(14 of 1957)."* (Emphasis supplied)

Relevant Legal Provisions (Contd.)

- **Section 15, Copyright Act, 1957 –**

"Special provision regarding Copyright in designs registered or capable of being registered under [Designs Act, 2000 (16 of 2000)].—

(1) Copyright shall not subsist under this Act in any design which is registered under the [Designs Act, 2000 (16 of 2000)].

(2) Copyright in any design, which is capable of being registered under the [Designs Act, 2000 (16 of 2000)] but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his licence, by any other person."

Relevant Judicial Decisions

- ***Microfibres Inc. v. Girdhar & Co.*** **[2009 (40) PTC 519 (Del)]**

"... 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."* (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

- ***Pranda Jewelery Pvt. Ltd. & 2 ors. v. Aarya 24K and 6 ors.*** **[Suit No. 2477 OF 2011, Bombay High Court]**

"15. ...An 'artistic work' so long as it can qualify as an artistic work reproduced in any form shall continue to enjoy the copyright available to it under the Copyright Act, 1957. But when it is used as the basis for designing an article by its application by an industrial process or means, meaning thereby an article other than the artistic work itself in a two or three dimensional form, it would enjoy a lesser period of protection of copyright under Section 11 of the Designs Act, 2000, if registered as a design under that Act, and if not so registered (despite being registrable), would cease to enjoy any copyright after more than fifty such applications, under Section 15(2) of the Copyright Act, 1957. Once again, ***as an original artistic work it would continue to enjoy the full copyright under the Copyright Act, 1957 and cannot be reproduced in any two or three dimensional form by anyone except the owner of the copyright.*** *What it would cease to enjoy is the copyright protection in its industrial application for production of an article."*

Relevant Judicial Decisions (contd.)

- ***Ritika Private Limited v. Biba Apparels Private Limited*** **[CS(OS) No.182/2011, Delhi High Court]**

"*46. ... 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.*

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."

Relevant Judicial Decisions [contd.]

- ***Holland Company & Anr. v. S.P. Industries*** **[CS(COMM) 1419/2016]**

"22. ...A conjoint reading of Section 2(d) of Designs Act, 2000, Section 14(c) and 15(2) of the Copyright Act, 1957, makes it amply clear that where a design of an article is prepared for the industrial production of an article, it is a design and registrable under Designs Act and under Section 14(c), the author of such design can claim copyright, however, since such a design is registrable under the Designs Act, and if such design has been used for production of articles by an industrial process for more than 50 times by the owner of the copyright, or, by any other person with his permission, then such person ceases to have copyright in such design."

Relevant Judicial Decisions (Contd.)

- ***Pandrol Limited & Anr. V. Patil Rail Infrastructure Pvt. Ltd. & Ors.*** **[CS(COMM) 602/2022]**

- *"17… The original drawings/ 'artistic work' can lead to a 'design'. In other words, a 'design' may be derived from the original drawings. Therefore, even if the original drawings/ 'artistic work' is used to industrially produce an article, the original drawing/ 'artistic work' 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."*

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Conclusion

- If a design is registrable under the Designs Act but has not 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. Once that limit is crossed, it would lose its copyright protection under the Copyright Act.
- Industrial drawings which are applied in design can fall within the ambit of ‘artistic works’ and therefore, qualify to be a subject matter of Copyright.
- Regardless of its industrial application, a drawing in 2D form could continue to enjoy full protection under the copyright law.

THANK YOU!

Any Questions?

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