

INTELLECTUAL PROPERTY: COPYRIGHT

Microfibres Inc. v. Girdhar & Co. & Anr.

The Division Bench of the Hon'ble Delhi High Court recently passed a judgment in an appeal titled Microfibres Inc. v. Girdhar & Co. & Anr.¹ filed against the judgment dated January 13, 2006 of the Single Judge of the Delhi High Court² laying down significant principles with regard to interpretation of Section 2(c) of the Copyright Act, 1957, read with Section 2(d) of the Designs Act, 2000 and Section 15(2) of the Copyright Act, 1957 and their interplay with each other.

¹ RFA (OS) No. 25/2006. For more information please refer to judgment dated May 28, 2009 of Hon'ble Mr. Justice Mukul Mudgal in RFA (OS) No. 25/2006 at <http://lobis.nic.in/dhc/>

² Suit No. CS (OS) 1480/2002

Parties in the connected appeal Nos. FAO (OS) No. 326/2007³ and FAO (OS) No. 447/2008⁴ were also permitted to make submissions on the common legal principles arising in these appeals. However the judgment is made only with respect to the appeal titled Microfibres Inc., v. Girdhar & Co. & Anr.

Facts-

- 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.
- The Respondents are also manufacturers of upholstery fabrics and it is the contention of the Appellant that the Respondents infringed

³ Dart Industries Inc. & Anr. v. Techno Plast & Ors.

⁴ Mattel Inc. & Ors. v. Jayant Aggarwalla & Ors.

the copyright in artistic work of the Appellant. The Respondents were alleged to copy the designs and artistic work from the work of the Appellant on upholstery fabrics.

- The Single Judge held, inter alia, that the works of the Appellant were not original artistic works within the definition of Section 2(c) of the Copyright Act, 1957, 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 Section 15 of the Copyright Act, 1957.

The relevant statutory provisions under Section 2(c) and Section 15 of the Copyright act, 1957 are as under:

Section 2(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

Section 15-Special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 1911.

(1) Copyright shall not subsist under this Act in any Design which is registered under the Designs Act, 1911 (2 of 1911)⁵.

(2) Copyright in any design, which is capable of being registered under the Designs Act, 1911 (2 of 1911)⁶, 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 license, by any other person.

Section 2(d) of the Designs Act, 2000 states:

"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 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

⁵ See now the Designs Act, 2000 (16 of 2000)

⁶ See now the Designs Act, 2000 (16 of 2000)

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).

Issue-

Interpretation of Section 2(c) of the Copyright Act, 1957 read with Section 2(d) of the Designs Act, 2000 and Section 15 of the Copyright Act, 1957 and their interplay with each other.

Held-

- The definition of 'artistic work' has a very wide connotation. 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.
- 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. 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.

- 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.
- 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 (test) of having been applied more than 50 times industrially to produce an article.
- 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, such as 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.

- Thus, 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.
- 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.
- 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.

- 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.
- Appeal dismissed.

Comments-

The Hon'ble Court rightly says that no tracing, drawing or painting, which is applied to an article and commercially exploited, can be an artistic work protected by the Copyright Act, as in such an event, the Designs Act would become otiose as every design necessarily traces its origin to a drawing or a painting. The Court suggests that the moment a work of art is applied industrially to an article, it ceases to enjoy copyright protection and is entitled to a lesser term of design protection.

DSK Legal Knowledge Center

Contact Details: dsklegal.knowledgecenter@dsklegal.com

Mumbai Office
4th Floor, Express Towers,
Nariman Point,
Mumbai 400 021
India
Tel: (91 - 22) 6658 8000
Fax: (91 - 22) 6658 8001

Delhi Office
46, Aradhana, Chanakyapuri,
New Delhi 110 066
India
Phone: (91 - 11) 2687 1122; 2687 1133;
2687 1144
Fax: (91 - 11) 2687 1155

Disclaimer

The update is intended for your general information only. The information and opinions contained in this document are derived from public sources which we believe to be reliable and accurate but which, without further investigation, cannot be warranted as to their accuracy, completeness or

correctness. It is not intended to be nor should be regarded as legal advice and no one should act on such information without appropriate professional advice. DSK Legal accepts no responsibility for any loss arising from any action taken or not taken by anyone using this material.