

Chapter IV

Protection of fashion designs under the Copyright Act, 1957

4.1 Introduction

Copyright Law protects original artistic works that are fixed on a tangible medium. The sine qua non to obtain copyright is originality, unlike novelty for patents. Originality under copyright law would imply that the work is not a substantial copy of other works. In other words, as long as the work is not copied, it is considered original for the purpose of granting copyright. A fashion design that is original and fixed on a tangible medium is protected under the Copyright Act 1957 if they are fixed on a tangible medium. Fashion designs are granted copyright protection by considering them as ‘artistic works’. Artistic work includes sketches, drawings, engravings, artistic craftsmanship etc.⁸³ A sketch or a drawing of a fashion designer can be protected under the Act irrespective of its aesthetic quality. However, a work that is functional in nature is not protected under the Law of Copyright. A fashion design that is purely artistic can be protected under copyright law, but fashion designs usually are both artistic and functional in nature. The problem in India is that there are no guidelines or tests laid down to determine the eligibility for copyright when a work is both functional and artistic. Fashion designs that are functional can obtain patents provided they fulfil the NUN test along with the subject matter test under the Patents Act 1970. However, patents do not help fashion designs much because a patent requires an invention to be new and non-obvious. Fashion designers usually draw inspiration from already existing designs or the culture. So, the fashion designs are original but not always new and non-obvious.

The second part of the chapter deals with section 15 of the Copyright Act 1956 which creates confusion in protecting fashion designs. Section 15(1) explicitly

⁸³ The Copyright Act, 1957, § 2 (c).

excludes copyright protection under the Copyright Act 1956 if such designs are registered under the Designs Act 2000. Furthermore, clause (2) of section 15 states that copyright shall subsist in a work that is capable of registration under the Designs Act 2000 as long as such work is manufactured for only fifty units. After producing the fifty-first article, there is no copyright protection under the Copyright Act 1957. But copyright protection can be claimed provided the design is registered under the Designs Act 2000. The registration of a design under the Designs Act 2000 is so time-consuming that a fashion design might not even be in the trend as the trend changes every three months by the time the design is registered.

4.2 Separating artistic and functional elements in a fashion design

On a sliding scale, an artistic element and a functional element in a fashion design are on two extremes. Artistic works are protected by copyright and functional elements are protected by patent. Ornamental elements in a fashion design are protected under design law as long as they are not functional in nature. In India, the Copyright Act, 1957 and the Designs Act 2000 protect artistic works and designs respectively as long as they are not functional in nature. In the U.S. artistic works with functional features can claim copyright protection as long as they fulfil either physical separability or conceptual separability.⁸⁴ A work that is both functional and artistic, like fashion designs, is difficult to be protected under the Copyright Act 1957, provided that the word functional has not been defined under the Act. However, in the U.S. the word 'useful article' finds its place under the 17 U.S. Code § 101. Indian Courts have not set a precedent to separate functional elements from the artistic elements in a work. But the U.S. has a wide range of cases in which the courts have distinguished between the artistic and functional elements in a fashion design, but such guidelines are absent in India. The U.K., like in India, lists the artistic works in which the copyright subsists, and fashion design has to fall within a pre-existing category of artistic works to obtain

⁸⁴ Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT Soc'y U.S.A. 339, 345(1990).

a copyright and has to be devoid of functional elements. Fashion design can claim protection as a work of artistic craftsmanship. However, in both the U.K. and India, the words ‘works of artistic craftsmanship’ has not been defined. Even if it is defined, such work of artistic craftsmanship should be devoid of functional elements. Artistic works other than a ‘work of artistic craftsmanship’ are protected irrespective of their aesthetic quality, but a ‘work of artistic craftsmanship’ must have an aesthetic or artistic element. But artistic works, including any type of artistic work prescribed under Section 2(c) or the work of artistic craftsmanship do not protect the work that has both artistic and functional elements.

4.3 Concept of Conceptual Separation in the US

In the US copyright Law ‘pictorial, graphic and sculptural works include both two- and three-dimensional works of fine, graphic, and applied art. Such works are inclusive of the works of artistic craftsmanship but exclude their mechanical and utilitarian aspects. Work shall be considered for copyright protection only if a pictorial, graphic, or sculptural work could exist independently of the article of utility.⁸⁵ The issue faced by the US courts are twofold; firstly, the difficulty of determining the difference between ‘work of art’ and ‘articles for manufacture’ and secondly, determining when the ‘work of art’ would be considered to be existing independently from the article of utility. These confusions gave rise to the doctrine of separability.

4.3.1 *Mazer v. Stein* - Physical Separability

The first case in the U.S. that drew the line between artistic work with functional elements is *Mazer v. Stein*. The subject of the case was Balinese statues that were used as bases for electric lamps. These Balinese statuettes were registered before the Copyright Office as ‘works of art’. Mazer, without authorisation, copied the statuettes and manufactured lamps. Thus, a copyright infringement case was filed

⁸⁵ 17 U.S.C. § 101.

by Stein against Mazer before the District Court of Maryland.⁸⁶ The defendant refuted the case of copyright infringement invoking functionality doctrine. According to Mazer, there was no valid copyright in the work as the lamps are functional commodities and not artistic works. Defendant contended that the intended use of the statuettes was to fit them on lamps and mass produce them. Thus the ‘work of art’ became an ‘article of manufacture’ for utilitarian purposes. Furthermore, they claimed these statuettes could be protected as design patents, not as copyright. The District Court of Maryland dismissed the case and held that there was no valid copyright in the Balinese statuettes. The District Court reasoned that the Congress has passed two separate laws to protect ‘works of art’ and ‘articles of manufacture’. The former is protected under the copyright law and the latter is protected under the patent law; in this case design patent. Thus, applying the reasoning of the court, the apt form of IP that the plaintiffs could have sought was design patents and not copyright. The plaintiff appealed the case before the Court of Appeals.⁸⁷

The Court of Appeals reversed the decision of the District Court and held that the copyright in the Balinese statuette is valid. The Court noted that the defendant had meticulously copied every element in the plaintiff’s work. The Court proceeded to draw the distinction between copyright and design patents. The criteria for obtaining design patents are higher than the criteria for obtaining a copyright. To claim a design patent, the design must be new, original ornamental design for an article of manufacture".⁸⁸ The term of protection for a subject matter under the copyright law is longer than the design patents. With these differences made, the Court went ahead to interpret the copyright law and the design patents. Firstly, the Court considers the definition of the ‘work of art’, Class G under the Copyright Law.⁸⁹ Work of art includes works of artistic craftsmanship for their form but not their mechanical or utilitarian elements. Work of art includes artistic jewellery, enamels, glassware, and tapestries, as well as all, works belonging to

⁸⁶ Stein v. Mazer, 111 F. Supp. 359 (1953).

⁸⁷ Stein v Mazer, 204 F.2d 472 (4th Cir. 1953).

⁸⁸ 35 U.S.C.A. § 171.

⁸⁹ 17 U.S.C.A. (1952).

the fine arts, such as paintings, drawings and sculpture. For the purpose of interpreting this provision, then Mr Arthur Fisher, Register of Copyrights, was called upon. Mr Fisher stated that any work could be considered a work of art even if such work to some extent has mechanical or utilitarian elements attached to it. He clarified that the Copyright Office shall grant copyright if the work has an artistic aspect in it and they do not consider mechanical and utilitarian aspects of the work. In other words, works that are artistic get copyright protection irrespective of mechanical or utilitarian aspects attached to the work. The copyright protection shall be determined by the character of the 'work of art' and not the intention and future use of the work of art. It is immaterial to probe whether the author intends to commercially exploit the art or not. The ratio of this case is that the subsequent use of the 'work of art' is immaterial while claiming copyright protection. The work, as long as considered a 'work of art' can be protected under Copyright Law irrespective of the intention of the author to commercialise his art in the near future. The intention to manufacture the 'work of art' does not preclude copyright protection. Thus, the Court held that there was valid copyright in the Balinese statuettes that formed the base for electric lamps.

Aggrieved by the decision, Mazer filed a review application before the SCOTUS (Supreme Court of the US).⁹⁰ The Court clarified that the question is not about the manufacturer's right to register the base of a lamp but the artist's right to claim copyright for a 'work of art' intended to be mass-produced for lamp bases. The court determined the entire case from the lens of an artist who created a 'work of art', rather than from the perspective of the manufacturer of such work of art. The Apex Court settled this dispute, stating there is no bar in the copyright law or any other law that a patentable thing cannot be copyrighted. The Court reaffirmed the Court of Appeals' decision and declared the copyright's validity. The Court held that Balinese statuettes were original expression ideas that are protected under Copyright Law. The continuous manufacturing of the lamps did not stop the respondent from claiming copyright infringement in the art itself. Furthermore, the Court declared nothing in the copyright laws to imply that the work of art

⁹⁰ Mazer v. Stein, 347 U.S. 201 (1954)

would lose its reputation as a ‘work of art’ if it’s put to mechanical or functional use.

Adding to this, there is also nothing in the design patent law that excludes copyright protection for the ‘work of art’ intended to commercialise subsequently. The mass reproduction of art does not render the copyright in the art invalid. The Court also considered the legislative intent behind the Copyright Act 1909 and stated that works of art and reproductions of the same were intended to be copyrightable subject matter by Congress. ‘Works of art’ and ‘reproductions of work of art’ were intended to be subject matter under the Copyright Law. The reasoning behind the decision of the Apex Court is twofold; firstly, the lamp bases are independently considered works of art and secondly, the intended use of Balinese statuettes to hold the lamp base did not deprive them of copyright protection.

Mazer v. Stein is still considered a landmark judgement in the evolution of the doctrine of physical separability. After the decision was passed, many fashion designers availed copyright protection for their fashion fabrics and jewellery designs.⁹¹ The doctrine of separability was conceptualised in *Mazer v. Stein*, but it underwent various changes until the recent *Star Athletica* case. The Copyright Office in 1959 amended its regulation to the extent that a work would qualify for copyright protection as a ‘work of art’ as long as such artistic sculpture, carving, or pictorial representation could be identified separately or independently of the article of utility. The ‘work of art’ shall be refused copyright protection only when the intrinsic function of the article is for utilitarian purposes, even if the article is unique and shaped attractively. Physical separability is where the utility elements can be sliced off from the artistic features physically. According to Compendium III, physical separability means that the pictorial, graphic or sculptural features could be physically separated from the article by ordinary means without affecting the utilitarian elements of the article.⁹² In contrast, conceptual separability is

⁹¹ Thomas Ehrlich, *Copyright of Textile Designs--Clarity and Confusion in the Second Circuit*, 59 MICH. L. REV. 1043 (1961).

⁹² Compendium III § 924.2(A).

conceiving of the process of whether the artistic features could be separated from the utility features.

4.3.2 *Kieselstein-Cord v. Accessories by Pearl* - Conceptual separability

The U.S. courts further, applied a primary-subsidary distinction approach to distinguish between artistic and functional elements in a two-buckle Winchester belt. The two buckles, Winchester and Vaquero, were made either of silver or other precious metals. The plaintiff is in the business of hand-craftsmanship in the fashion industry. He first sketched the first idea that he had conceived. So, the buckles are the expression of his ideas and not the ideas themselves. Both the buckles were sculptured designs and registered under the Copyright Law.⁹³ On the business side of the buckles, Winchester buckles gained huge success and reputation in the market and brought the plaintiff recognition in the fashion industry. Winchester buckles were also found to be worn on the neck and the waist by fashionistas. These belt buckles were sold only in high-end fashion retail stores, thus, the belt became a societal status symbol. The plaintiff alleged that the defendant had been selling the knockoffs of his belt, but manufactured using common metals unlike the original buckles which were made of gold, silver or other precious metals. The defendant contended that the buckles were not copyrightable subject matter as the belt buckles perform a solely utilitarian function. The artistic element of the buckle needed to be distinguished from its functional element, holding the pants on the waist securely. The District Court of New York held that there is no copyrightable subject matter in both the belt buckles.⁹⁴ Neither of the buckles has pictorial, graphic, or sculptural features that can be identified separately and are capable of independently existing from the utilitarian aspect of the buckle. The Court also distinguished the buckle case from *Mazer v Stein*. In doing so, the Court was of the opinion that the Balinese statues in the *Mazer* case exist independently of the lamps. But in this case, it was about the two buckles, although creative, they serve a utilitarian function. The Court in *Mazer v Stein* was able to physically separate the Balinese statuettes from the

⁹³ US Copyright No. VA-43-985, effective March 3, 1980.

⁹⁴ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 489 F. Supp. 732 (S.D.N.Y.1980).

electric lamps but the court in the current case cannot imagine the buckles separately of its utilitarian function. Giving necessary weightage to the history of the Copyright Law, the Court declared that separable artistic work from utilitarian work is copyrightable. The court while dealing with the plaintiff's argument that the belts are ornamental in nature, opined that although creative and different from all the other existing buckles, it still is a belt buckle performing its utilitarian function. Thus, the District Court ruled that belt buckles are not copyrightable subject matter and consequently, there is no case of copyright infringement.

The plaintiff appealed the case before the United States Court of Appeals, Second Circuit.⁹⁵ The Appellate Court first clarified that the legislative intent of the Congress was to consider either physical or conceptual separability to identify if the artistic work be separated from its utilitarian function.⁹⁶ The Appellate Court applied conceptual separability to the belt buckles and held that people used the buckles as ornamentation around the neck or any other body parts; thus, the artistic element in the belt can be separated from its functional element. The Appellate Court also agreed with the view of the Copyright Office that the belt buckles rose to the level of creative art and the validity of the copyright was upheld. The Courts considered that the buckle could be used for various purposes other than its basic utilitarian function, so applying a conceptual separability buckle could claim copyright protection.

Mazer v Stein involved physical separability; the Balinese statuettes were physically separable and had an independent existence from the electric lamps. But in the *Kieselstein-Cord* case, the Court applied conceptual separability to separate the artistic work from the utilitarian element. In this case, a primary-subsidary test was laid down to determine conceptual separability. The primary aspect is the work of art, and the subsidiary aspect is its utilitarian function. The primary aspect, in this case, was the ornamental element of the buckles, and the utilitarian function is the belt buckles holding the pants on the

⁹⁵ *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

⁹⁶ U.S House Report 55, at 5668 [1976].

waist. The Court applied the primary-subsidary test and ruled that the primary ornamental element of the buckles were conceptually separable from its subsidiary utilitarian function.

4.3.3 *Carol Barnhart Inc. v. Economy Cover Corp-* Objective test

The plaintiffs of this case were in the business of selling display torsos. There were four human torsos designed by the plaintiff. All the torsos were of lifesize but, without neck, arms or a back. There were two male and two female human torsos. Each one in male and female torsos was made with the intention of displaying shirts and sweaters. The other two were made with the intention of displaying sweaters and jackets. All the torsos were anatomically perfect with hollow backs. They started selling the torsos for men's shirts in March 1982 and by July, they had received \$18,000 worth of orders. All four torsos were exhibited in the trade show and as a result, they received orders worth \$35,000. Plaintiffs believed that they received extensive orders because they were not being purchased only for their utilitarian function, to display clothes but also for their artistic elements. The defendant learned about the plaintiff's human torsos and manufactured substantially similar human torsos as that of the plaintiff's work without authorisation. Plaintiff claimed copyright for human torsos and the Copyright Office granted the copyright. After registration, the plaintiff sent a notice to the defendant to stop advertising and selling the infringed copies of human torsos. As the defendant continued the act of infringement, the plaintiff filed a copyright infringement case before the United States District Court, E.D. New York.⁹⁷

The Court considered the language used in the statute, the intent of the Congress, legislative history and recent precedents and held that they all point at one thing, i.e., a useful article may obtain copyright protection only when the artistic element is separated from the functional element either by applying physical separability or conceptual separability. The Court by applying these tests held that the

⁹⁷ *Carol Barnhart, Inc. v. Economy Cover Corp.*, 603 F. Supp. 432 (E.D.N.Y. 1985)

plaintiff's torsos had no artistic features or aesthetic element separate from the torsos. Thus, the court rejected the copyright claim of the plaintiff over his human torsos. Aggrieved by this decision, the plaintiff approached the United States Court of Appeals, Second Circuit.⁹⁸

The Appellate Court rejected the contention of the plaintiff that the copyright certificate creates a presumption of its validity held that the copyright certificate creates a rebuttable presumption of the validity of the copyright. Thus, a ruling copyright certificate is merely prima facie evidence and not conclusive evidence of having a valid copyright. The Appellate Court, furthermore, interpreted the definition of 'useful article' as it is defined as an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. Although copyright protection is extended to "pictorial, graphic, and sculptural works", in a useful article, provided such work is capable of being separated from and existing independently of the utilitarian element of the article.⁹⁹ Applying this definition, the Appellate Court held that the artistic and the aesthetic element in the human torsos are inseparable from its utilitarian function. The Appellate Court also rejected the contention of the plaintiff that low-level scrutiny should be allowed in determining the copyrightability in the case of useful articles and ruled that either the legislative history or the copyright law has no mention of lower scrutiny. The Appellate Court held that torsos could not be separated from its utilitarian function; to display articles of clothing. Torsos otherwise could be considered artistic work but the functional nature of having such a hollow torso is to display clothes. The artistic and functional elements in a torso are inextricably intertwined and hence devoid of copyright protection.

It is worth mentioning the dissenting judgement in this case as it provides a fresh perspective on conceptual separability. Jon. O. Newman disagreed with the majority judgement that ruled the artistic elements in the torsos was inseparable from their utilitarian elements. The dissenting judge was of the opinion that the

⁹⁸ Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985)

⁹⁹ 17 U.S.C. § 102(a)(5)

perspective of the beholder should be given paramount importance in determining separability. He opined that the beholder's mind should be stimulated by the fact that the article has artistic elements separate from its functional or utilitarian elements. What's occurring in the mind of the beholder with respect to the work should be considered. Work will be protected under copyright law if the beholder can separate the artistic elements from the functional elements. This test also came to be known as the temporal displacement test. However, applying the beholder's test or the common man's observer test to determine conceptual separability would result in subjectivity and biases. What is artistic to one beholder might be functional to another and vice versa. Rather than having to consider the beholder test, the courts should set guidelines to determine conceptual separability. To solve the issue of conceptual separability, Professor Robert C Denicola came up with a test famously known as the Denicola test.

4.3.4 *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co* - The Denicola test

The chief owner of the plaintiff company. David Levine created a 'Ribbon Rack', a bicycle rack inspired by a wire sculpture. The defendants manufactured a similar bicycle rack. The plaintiff sent a notice to the defendant of the copyright infringement. Subsequently, the plaintiff applied for copyright registration of his ribbon bicycle rack. Upon examination, the Copyright Registrar denied registration, holding that the artistic element in the ribbon rack was not separable from the utilitarian aspects. The plaintiff appealed before the Copyright Office but that was also denied. The plaintiff approached the United States District Court for the Southern District of New York. The Court favoured the defendants and held that the ribbon racks did not pass the test of conceptual separability and thus there can be no copyright infringement. Aggrieved by this decision, the plaintiff approached the United States Court of Appeals, Second Circuit.¹⁰⁰ The Appellate Court clarified that a clear line has to be drawn between copyrightable works of applied art and uncopyrighted works of industrial design.¹⁰¹ The Court, after discoursing the previous precedents on conceptual separability, felt that the

¹⁰⁰ *Brandir Intern., Inc. v. Cascade Pac. Lumber*, 834 F.2d 1142 (2d Cir. 1987)

¹⁰¹ U.S. Code Cong. Admin. News H.R.Rep. No. 1476, at 5668 (1976)

Denicola test could solve the issue of conceptual separability. Denicola test considers the intention of the creator of the work as opposed to Newman's temporal displacement test which considers the perception of the beholder. The Denicola test takes into consideration the process of creating work and states that if the process of creating the article is dedicated solely to the functional elements, then such work cannot claim copyright protection. On the other hand, if the work is created with the intention of creating an artistic work, then copyright can be claimed.

The Appellate Court stated that the Denicola test is consistent with previous cases like the Winchester Belt Buckle and Human Torsos cases. Applying the Denicola test to the former case, the Appellate Court opined that the belt buckles were created keeping in mind their artistic and aesthetic beauty and not their functional utility. In Torso's case, the Appellate Court stated that human torsos were created for a functional purpose; to display clothes. Although it had certain artistic elements to it, the creator intended the work to be functional and not artistic. As the Denicola test proves to align with the previous judgements, the Appellate Court applies the test to the case at hand. The Appellate Court ruled that the ribbon rack was outside the scope of the copyright subject matter. Though the rack was inspired by a sculpture, its utilitarian element is inseparable from its artistic features. The Appellate Court unambiguously stated that the artistic element in the ribbon rack is dictated by its utilitarian function. Thus, artistic work has no independent existence of its utilitarian function.

4.3.5 *Pivot Point v. Charlene Products, Inc* - Aesthetic Influence Test

The plaintiff of this case created a mannequin that possessed a hungry look and named it 'Mara'. He also enjoyed huge success in selling the mannequins. These mannequins were used to display clothes and learn make-up and hairstyles at fashion institutes etc. He sold Mara in different styles; long-haired, changed skin tone, variations in make-up, but at no point in time he changed its facial features. Charlene, the defendant, started selling mannequins under the name 'Liza' which

looked substantially similar to Mara. Thus, the plaintiff sent a notice to the defendant to stop copying his creation. However, Charlene did not pay any heed to the copyright infringement notice and continued to sell them in the market. Subsequently, the plaintiff filed a case before the U.S. District Court for the Northern District of Illinois.¹⁰² The District Court held that the mannequins did not exist independently of their utility functions and thus there was no copyright protection. The utility function is the students using the mannequin to perfect their make-up on Mara's lips, eyes and cheeks and hair styling techniques. Such utilitarian elements are primary in the mannequins and not their artistic features. Applying Goldstein's standalone test, the Court ruled that the mannequin would not be as useful if the artistic features in the mannequin are removed. The utilitarian value of the mannequin would be diminished by removing its artistic qualities from it. Thus, with this reasoning, the Court ruled in favour of the defendants that the plaintiff had no valid copyright; consequently, there can be no copyright infringement.

Aggrieved by this, the plaintiff appealed to the United States Court of Appeals, Seventh Circuit.¹⁰³ Rejecting Goldstein's test, the Appellate Court held that this test would protect very narrow works, which is not the intention of Congress. By applying the aesthetic influence test, the Appellate Court reversed the decision. The aesthetic influence test dictates that if the designer's artistic elements are exercised and implemented independently of the functional elements, it can be said that there exists conceptual separability. Applying this test to the case in hand, the Court held that the mannequins were created by the influence of the artistic elements, independently of their functional features. Thus, the hungry mannequin is capable of being protected under the Copyright Law.

4.3.6 *Galiano v. Harrah's Operating Co., Inc.* - Marketability test

The plaintiff is in the business of manufacturing professional attire and uniforms. The plaintiff and the defendant entered into an agreement according to which the

¹⁰² Pivot Point Intern., v. Charlene Products, 932 F. Supp. 220 (N.D. Ill. 1996).

¹⁰³ Pivot Point v. Charlene Products, Inc., 372 F.3d 913 (7th Cir. 2004).

plaintiff was to design uniforms for the defendant's casinos. The plaintiff, after approval of designs from the defendant, entered into an agreement with various manufacturers to produce the uniforms. The agreement between them expired in December 1995, and the agreement could not be renewed owing to various circumstances. However, even after the expiration of such an agreement, the defendant continued to procure uniforms designed by the plaintiff from the manufacturers. In 1999, the plaintiff obtained copyright over the uniforms, and the Copyright Office registered it as 'two-dimensional artwork for wearing apparel'. Subsequent to the registration, the plaintiff brought suit for copyright infringement against the defendant before the United States District Court for the Eastern District of Louisiana.¹⁰⁴ The Court ruled that the uniforms had few artistic elements, but those elements were part of the functional elements of wearing apparel. Furthermore, the Court stated that none of the artistic elements had any intrinsic value and independent existence to be protected as a work of art, and it was declared that there was no valid copyright. Aggrieved by this decision, the plaintiff approached the United States Court of Appeals, Fifth Circuit.¹⁰⁵

The Appellate Court acknowledged the fact that the case laws on conceptual separability, in the case of costume designs, are uneven across the courts. The Appellate Court applied Nimmer's marketability test and held that the artistic elements had no independent existence of their own apart from the functional elements. The artistic elements in the uniforms could not be separately marketable without their functional elements. Some scholars consider the marketability test to be suitable for fashion designs.¹⁰⁶ However, the test not only stipulates distinguishing between artistic elements and functional elements but also states that the artistic elements, so separated, should be marketable independent of their functional elements. What can be considered as marketable or when can it be considered marketable again breeds confusion, and subjectivity seeps in.

¹⁰⁴ *Galiano v. Harrah's Operating Co., Inc.*, Civil Action No. 00-0071, Section: E/5 (E.D. La. Apr. 10, 2002).

¹⁰⁵ *Galiano v. Harrah's Operating Co., Inc.*, 416 F.3d 411 (5th Cir. 2005).

¹⁰⁶ Brandon Scruggs, *Should Fashion Design Be Copyrightable?* 6 NW. J. TECH. & INTELL. PROP, 122 (2007).

4.4 Continued Criticism and Confusion on Conceptual Separability

Mazer v. Stein clarified physical separability. However, the tension of where to draw the line in the case of conceptual separability remained. Several tests to determine conceptual separability were laid down by various courts and scholars like the Marketability Test, Utility test and Aesthetic influence test.¹⁰⁷ Professor Paul Goldstein introduced the utility test or standalone test to determine conceptual separability. This test has two segments; firstly, a “pictorial, graphic or sculptural feature in a useful article is conceptually separable if it can independently be a standalone work of art, and secondly, the useful article is equally useful even if the artistic elements are removed from the design. In this test, we are not looking at the work of art alone but also at the independent existence of the functional element in the design. Considering whether the design is equally useful even when the artistic elements seem to be unnecessary to determine conceptual separability for copyright law. The second part of the test is meaningful and effective if conceptual separability is discussed in the light of design law. The marketability test was introduced by Professor David Nimmer. According to this test, conceptual separability exists when the article is marketable to a significant segment of consumers because of its artistic or aesthetic elements, even if it’s deprived of its utility. This test relies more on selling the work rather than its creation. Conceptual separability under copyright law should focus more on the creative process rather than on selling the utilitarian article. More focus is required on artistic creativity than on marketability. The evidence to determine whether there exists conceptual separability or not is depended solely on the substantial segment of the public. Thus, making the test difficult to apply practically.

Considering all the cases on conceptual separability, it can be stated that there is no one common test to draw the line between the creative works that can claim

¹⁰⁷Darren Hudson Hick, *Conceptual Problems of Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction*, 57 J. COPYRIGHT Soc'y U.S.A. 37, 45 (2009).

copyright protection from the design elements that cannot. Applying the literal rule of interpretation to the Copyright Act 1976 it can be stated that the language intended in the statute is intended to differentiate between the works that have copyright protection from the industrial design elements that have no copyright protection. The Copyright Act as amended in 1976 stipulates that useful articles can be protected under copyright law only if the artistic elements in a useful article could be separable from its utilitarian elements and such separated artistic element has its own independent existence from its utilitarian elements. But, the statute is silent on where the line should be drawn. The accountability to distinguish between applied art and industrial design is on the Copyright Office and the Courts.

4.5 The Doctrine of Conceptual Separability - Critiquing the Tests

The Courts have applied various tests on a case to case basis after *Mazer v Stein*. To determine conceptual separability, the primary and subsidiary test was applied in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, in *Carol Barnhart Inc. v. Economy Cover Corp* objectivity test was applied by the majority judgement and the temporal displacement test was formulated by the dissenting judge Newman in the same case, the Denicola test can be found applied in *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co*, the Aesthetic Influence test in *Pivot Point v. Charlene Products, Inc*. Along with these cases, few tests have been developed by scholars. Nimmer introduced the marketability test and the standalone utility test by Paul Goldstein. The Primary-Subsidiary test considers the work of art as primary and the utilitarian elements as a subsidiary. Belt buckles were considered a work of art primarily, and the utilitarian function became secondary. But, this test cannot be applied where both artistic and utilitarian elements are intertwined. This test offers less help in cases of garment designs and fabric patterns. Temporal displacement considers the opinion of the beholder or a reasonable observer. What's art to one person is not art to another person. This gives rise to individual choices and preferences, leading to subjectivity and bias. The Denicola test focuses on the process of creating the work. If the work was created with the intention of making

it a utilitarian article, then there can be no copyright protection. Conversely, if the design is created with the intention of making it an artistic work but has some utilitarian elements will not deprive them of claiming copyright protection. In the creation of fashion designs or toys, there always is a functional element imbibed along with the artistic element. It would not be fair to deprive such works of copyright protection. Thus, the Denicola test fails to cover fashion designs, toys and other articles. Marketability, the test introduced by Nimmer, leaves room and space for the judge to interpret whether the design, after removing its utilitarian function, could be marketable for its artistic features. Personal opinions, tastes and preferences will have a huge impact on the decisions on conceptual separability if the marketability test is applied. Goldstein introduced the standalone test, which states that there exists conceptual separability if the article can remain a standalone work of art and if it is as equally useful and functional before removing the artistic elements from the design. This test, again, is not suitable for fashion designs. If we remove a work of art from a fashion design or apparel, it might not be as useful as it was before. The aesthetic influence test dictates that the work should be created by exercising artistic elements independent of functional elements. When a work is being created, the creator of the work would consider selling those articles for some utility purposes. To some extent, creators keep in mind the functional or utility aspect of the article while creating them. A narrowed test like this would deprive protection for applied art under copyright law. With these tests in practice by the Courts, confusion persisted on which test could be applied to determine conceptual separability. The SCOTUS ended this confusion of determining conceptual separability in *Star Athletica, LLC v. Varsity Brands, Inc.*

4.6 *Star Athletica, LLC v. Varsity Brands, Inc* - Two prongs test

Varsity Brands Inc, was in the business of designing, manufacturing and selling cheerleading uniforms. They have around 200 copyright registrations over their two-dimensional designs that are incorporated on the surface of their uniforms. These designs are usually “combinations, positionings, and arrangements of

elements”. They also include “chevrons, lines, curves, stripes, angles, diagonals, inverted chevrons, colouring, and shapes.”. Star Athletica is also in the same business. In the process of manufacturing and selling the designs, Star Athletica was alleged to be infringing the copyright of Varsity Brands Inc. Thus, a copyright infringement suit was filed by Varsity Brands Inc against Star Athletica before the United States District Court for the Western District of Tennessee, Western Division.¹⁰⁸ The District ruled that there could be no copyright in the designs of the cheerleading uniforms as the designs served the utilitarian purpose of identifying the garments as cheerleading uniforms. There could be neither physical nor conceptual separation between the artistic work and utilitarian elements in the cheerleading uniforms. Aesthetic features merge with the utilitarian elements in cheerleading uniforms, and there could be no conceptual separation. Thus, the District Court ruled the case in favour of Star Athletica and invalidated the copyright held by Varsity Brands Inc. Aggrieved by this decision, Varsity Brands, Inc appealed before the United States Court of Appeals, Sixth Circuit.¹⁰⁹

The Appellate Court considered the intention of creating designs like chevrons, lines, curves and stripes. The Appellate Court stated that Varsity Brands had a choice to implement a design or not. The decision whether a functional garment or a cheerleading uniform would be manufactured using the designs so created by the designer was not in the hands of the designer but in the hands of Varsity Brands. Hence, the Court reached the conclusion that the designers created these designs without considering the functionality of the uniform. The Copyright Act 1976 protects the original works of authorship that are fixed on any tangible medium.¹¹⁰ Works of authorship include pictorial, graphic, and sculptural works' including two-dimensional and three-dimensional works of fine, graphic, and applied art etc. Furthermore, the design of a useful article would be considered pictorial, graphic, and sculptural work provided that such pictorial, graphic and sculptural work in a useful article could be identified separately from its utilitarian

¹⁰⁸ Varsity Brands, Inc. v. Star Athletica, LLC, Case No. 10-2508 (W.D. Tenn. Apr. 23, 2012)

¹⁰⁹ Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468 (2015)

¹¹⁰ U.S. Code, *supra* note 92.

elements and is capable of existing independently of the functional elements. Separability and independent existence are the two components that determine conceptual separability. Along these lines, the Appellate Court framed five issues: firstly, whether Varsity's designs are “pictorial, graphic, or sculptural works; secondly, are Varsity's designs useful articles?; thirdly, what are the “utilitarian aspects” of cheerleading uniform?; fourthly, could we identify pictorial, graphic, or sculptural features separately from the parts of the cheerleading-uniform design, which cover the body, permit free movement, and wick moisture?; and lastly, can the arrangement of stripes, chevrons, colour blocks, and zigzags exist independently of” the utilitarian aspects of a cheerleading uniform?.

The Appellate Court answered the first and second issues affirmatively. The Varsity Brands designs were pictorial, graphic, or sculptural works, and the cheerleading uniforms also had utilitarian functions. With respect to the third question, the Appellate Court answered that the utilitarian aspects of the cheerleading uniforms were to cover the body, permit free movement, withstand athlete movements and wick moisture away. Star Athletica argued that the artistic design elements in the cheerleading uniforms identify a particular person as a cheerleader and member of a particular cheerleading team. Such identification of a cheerleader is the utilitarian or functional aspect of a cheerleading uniform. Rejecting the said contention, the Appellate Court ruled that the useful article means having an intrinsic utilitarian function and does not include merely conveying information that the person is a cheerleader or he/she is a member of a particular cheerleading team. Answering the fourth question, the Appellate Court rejected the decision of the District Court and held that the pictorial or the graphical work in the cheerleading uniforms did not enhance the utilitarian function of the uniforms.¹¹¹ Irrespective of pictorial and graphical works, the cheerleading uniforms covered the body, permitted free movement, withstood athlete movements and acted as a sweat absorber. Continuing with the fifth issue, the Appellate Court ruled that there is an independent existence of the artistic work in the cheerleading uniforms separable from the utilitarian elements. The

¹¹¹ Peter S. Menell & Daniel Yablon, *Star Athletica's Fissure in the Intellectual Property Functionality Landscape*, 166 U. PA. L. REV. ONLINE 137 (2017).

designers designed the chevrons, lines, stripes or any other combinations which could be stitched on any type of garment or apparel. Thus, The Appellate Court, with this evidence, stated that the chevrons, inverted chevrons, lines and strips do have an independent existence of their own. The Appellate Court reversed the decision of the District Court and held that the copyright was valid. Aggrieved by this decision, Star Athletica approached SCOTUS.¹¹²

In 2015, the U.S. Court rejected all the previous tests on conceptual separability in *Varsity Brands v. Star Athletica, Inc.* It formulated a new test to determine what is artistic and what is functional in applied art. The Supreme Court settled the determination of conceptual separability by introducing a two-prong test. The useful article can claim copyright protection; firstly, if the work can be perceived as a two- or three-dimensional work of art separate from the useful article and secondly, if the work would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.¹¹³ The court, by applying this two-prong test, held that the chevron designs could be imagined independently of the cheerleading uniforms, and it would qualify for copyright protection as a pictorial, and graphical work when it's fixed on some tangible medium.¹¹⁴ The U.S. finally has a test to determine conceptual separability in useful articles and the confusion has been put to rest. It is now ideal to understand the implications and clarifications on the two-prong test on fashion designs.

In *Mazer v. Stein*, physical separability was adopted, where the utilitarian aspects of the article had to remain intact when the artistic features are physically removed by ordinary means. If such artistic elements are removed from a useful article without depriving the article of its utility, then we could call it physical separability. In *Star Athletica*, the SCOTUS clarifies that according to the literal

¹¹² *Star Athletica, L. L. C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017)

¹¹³ Rebecca Tushnet, *Shoveling a Path after Star Athletica*, 66 UCLA L. REV. 1216, 1225 (2019).

¹¹⁴ Angelo Marchesini, *Thin Separability: An Answer to Star Athletica*, 43 Seattle U. L. REV. 1087, 1102 (2020).

and statutory interpretation of the Copyright Act, 1976 the useful article need not remain intact after the removal of artistic features from a useful article. According to the SCOTUS, the separability test is directed towards the extracted feature i.e., separated pictorial, graphical and sculptural works. Furthermore, it has to be determined if such an extracted feature could stand as work of its own or be fixed on any other tangible medium. The SCOTUS unambiguously clarified that conceptual separability has nothing to do with the useful article that remains after the extraction. In other words, whether the useful article is equally and fully useful after extracting the artistic work is not material and need not to be considered while determining conceptual separability. The SCOTUS also further clarified that the intention of the designer or the process of creating a design or the marketability of the design are not the factors to be considered while determining conceptual separability because none of them are grounded in the Copyright Act 1976. In other words, what is material is how the article is perceived and not how it is designed or made. In the aftermath of *Star Athletica*, Courts have granted protection to fashion designs like banana costume and Triangl's swimsuit in *Silvertop Associates Inc. v. Kangaroo Manufacturing Inc.*,¹¹⁵ and *Triangl Group Ltd. v. Jiangmen City Xinhui District Lingzhi Garment Company*¹¹⁶ respectively.

4.7 Functional Design Protection under the Copyright Law in the European Union

The Berne Convention for the Protection of Literary and Artistic Works allows its member nations to discriminate between the work of pure art and the work of applied art.¹¹⁷ Article 2 (7) states that subject to the provisions of Article 7 (4) of the Convention, it shall be the discretion of the domestic legislation of the member country to determine the extent of application of the laws with respect to works of applied art and industrial designs and models. The conditions under

¹¹⁵ *Silvertop Assocs. v. Kangaroo Mfg., Inc.*, No. 1:17-cv-07919-NLH-KMW (D.N.J. Mar. 24, 2021)

¹¹⁶ *Triangl Grp. Ltd. v. Jiangmen City Xinhui Dist. Lingzhi Garment Co., Ltd.*, No. 16 Civ. 1498 PGG, 2017 WL 2829752, at 1 (S.D.N.Y. June 22, 2017).

¹¹⁷ Berne Convention 1886, Art. 2(7) read with 7 (4), Jan. 29, 1970, <https://www.law.cornell.edu/treaties/berne/2.html>

which such works are to be protected are also left as a matter to be decided by the member states. If in the origin country works are protected only as industrial designs and models, then the extent of protection in any member nation shall be according to their special laws. If such special laws to protect industrial designs and models are absent in any member country, then such works are to be protected as applied works. Article 7 (4) stipulates that the term of protection for applied art in so far as they are protected as artistic works shall not be less than twenty-five years from the date of making such work. It can be stated that the Berne Convention allows discrimination between artistic works and applied works with respect to conditions for protection and term of protection. It is left to the member countries to frame legislation to grant protection to the applied art and no criteria or protection is mandated by the Convention. In this light, it can be conceived that the U.S. distinguishes between the work of art and applied art under their copyright law and thus there was a need to formulate a test to determine when applied art could be protected. The European Union (EU) through various precedents has established a rule of thumb, that is, works of art and applied art cannot be discriminated against each other as long as they fulfil the Infosoc criteria. In the fashion industry the sketches, drawings, moulds, and graphics, be they two-dimensional or three-dimensional, are protected as works of art and on the other hand, mass-produced fashion designs would fall under applied art. The CJEU (Court of Justice European Union) is of the view that there can no discrimination between the work of art and applied art while determining whether there exists a valid copyright. The first case that dealt with copyrightability in the EU was the Infopaq case, following in the Flos case the relationship between the copyright and the designs was discussed, further in the Levola Hengelo case subject matter of copyright was discussed and lastly, in the Cofemel case it was declared that there could no discrimination made between the work of art and applied art as long as the work fulfils the criteria mentioned under the Infosoc directive.

Until the Infopaq case, the EU member states dealt with originality and copyrightability using their own formulas and domestic laws. The facts in the

Infopaq are not relevant to the current research as it dealt with whether clipping of news articles amounted to the reproduction of the work according to Article 2 of the Infosoc Directive.¹¹⁸ But the decision, in this case, has a wider impact on the EU copyright law with respect to works of art and applied art. With the decision of Infopaq, it was unambiguously clarified by the CJEU that the main criterion to claim copyright protection are; firstly, it must be original, that is to say, it should be the author's own creation and secondly, the content of creativity should be as a consequence of free and voluntary choices. The CJEU furthermore, rejected any additional criteria to be considered in granting copyright. Consequently, sketches, drawings, and graphics created by the fashion designer and the mass-produced industrial fashion designs have to fulfil the same criteria for originality to claim copyright protection in the EU. Thus, according to this decision, the applicable standard to claim copyright protection for both works of art and applied art are; originality and content of creativity. Over the years many precedents (Painer case, Flos case and Lavelo Hengelo) have fine-tuned the definition of originality in the EU. Currently, originality has three criteria; firstly, the work is the result of the author's free and creative choice that makes the work original (Infopaq case); secondly, the work should not be determined by technical constraints or by following rules, that is to say, the creativity should be a result of free and independent choices of the creator stamped with his personal touch (Painer case) and lastly, the work should be an expression of an idea that can be accurately and objectively identified (Levola Hengelo case). The Cofemel judgement passed in 2019 extended its originality criterion to the applied art.

4.7.1 *Cofemel v. G-Star Raw* – A Case Study

Cofemel copied the jeans design from G-Star Raw and sold it in the market. The Portuguese Court of First Instance passed the order favouring G-Star Raw and ordered Cofemel to stop infringing the copyright. The case was appealed to the Portuguese Supreme Court and the court referred the case to the CJEU to

¹¹⁸ Directive 2001/29/ EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, *OJ L* 167, 22.6.2001, p. 10–19.

determine the extent of originality in the works of applied art. The CJEU held that subject to the Infosoc directive, the works should be protected irrespective of them being works of applied art or pure art provided that the work has; firstly original subject matter and secondly, the subject matter is identifiable with sufficient precision and objectivity.¹¹⁹ Thus, the court made it clear that according to Infopaq originality has to be determined irrespective of whether the work is pure art or applied art. Currently, works of applied art and works of pure art are treated equally in the EU.¹²⁰ The CJEU, by passing the Cofemel case, meant to state that functional works are to be protected as long as the works are original. Fashion designs usually fall under the scope of ‘work of applied art.’¹²¹ Fashion designs are both aesthetic and functional in nature. Even when functionality in a fashion design affects the design to some extent, it cannot be said that the fashion isn’t protected under copyright law.¹²² When the designer has made free and creative choices, a functional element in a fashion design will not bar the design from claiming copyright protection.¹²³

The opinion on the Cofemel case by the Advocate General is of prime importance as he highlights the rationale behind the decision. He first agrees that the functional and utilitarian nature of the applied works are the reasons why copyright is not granted to applied art. In the case of applied work, one might not be able to find a personal link or the application of personhood theory between the creator and his work. Countries have refused to grant copyright protection for applied art for two main reasons; firstly, over-extension of the scope of copyright and secondly, over-protection of the applied art. Until the Cofemel case, Italy and Germany followed the doctrines ‘scindibilita’ and ‘stufentheorie’ respectively, in

¹¹⁹ Ritscher, Michael and Robert W. Landolt, *Shift of paradigm for copyright protection of the design of products*, *Gewerbl. Rechtsschutz Urh.r., Int. Teil* (53), 125, 134 (2019).

¹²⁰ Koray Güven, *Eliminating ‘Aesthetics’ from Copyright Law: The Aftermath of Cofemel*, *GRUR International*, 71 (3), 213, 220 (2022).

¹²¹ Eleonora Rosati, *CJEU rules that copyright protection for designs only requires sufficient originality*, *JIPLP*, 14 (12), 931–932, (2019).

¹²² Daniel Inguanez, *A Refined Approach to Originality in EU Copyright Law in Light of the ECJ’s Recent Copyright/Design Cumulation Case Law*, *Int. Rev. Intellect. Prop. Compet. Law* (2020).

¹²³ Tobias Endrich, *Little Guidance for the Application of Copyright Law to Designs in Cofemel*, *GRUR International*, 69(3), 264. 266 (2020).

their respective jurisdictions, which are similar to conceptual separability in the U.S. Also, the UK, under section 52 of the CDPA granted twenty-five years of protection for applied art. Applied art has always been discriminated against work of art either through the doctrine of conceptual separability or in the duration of protection. However, certain types of clothing like ‘haute couture’ are art in themselves irrespective of their functional character. There are a few types of works that are both works of art and have functional elements. The functional character of the work should not be a reason in itself to not grant copyright protection. With this backdrop in place, the implications of the Cofemel decision on the fashion industry have to be analysed.

Fashion keeps changing and the same fashion recurs after years. Fashion designers take inspiration from culture and already existing fashion to create their fashion designs. So, proving novelty to claim design protection is often a strenuous task for fashion designers. In this light, copyright protection for applied art is a welcoming move. As long as a fashion design is original and the work is identifiable with precision and objectivity, it can be protected under copyright law, irrespective of whether it is a work of art or applied art. Haute Couture fashion and luxury fashion are considered more as works of art rather than applied art. Haute Couture fashion pieces like ‘New Look’ by Christian Dior, ‘Little Black Dress’ by Chanel, ‘Le Smoking’ by Yves Saint Laurent, and Ralph Lauren Cashmere Scarf take months to create. A piece of haute couture embellished with intricate design and artistry costs around \$8000.¹²⁴ To be more precise, “the designing process of haute couture is analogous to creation of art.”¹²⁵ The sketches, drawings, graphics, and visual artworks related to the haute couture can be protected as artistic work, and the haute couture piece itself can be protected as applied art. The implication of the Cofemel case on the fashion industry of the EU is that both artistic works and applied art of haute couture and luxury fashion in the EU get protection under the copyright law.

¹²⁴ Loni Schutte, *Copyright for Couture*, 10 DUKE L. & TECH. REV. 1, 5 (2011-2012).

¹²⁵ Lynsey Blackmon, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107 (2007).

The US and the EU are on extremes in protecting works like fashion designs that have a functional element in them. The US protects those fashion designs as artistic work if they can exist independently and separate from the functional design elements. The US separates the wheat from the chaff. In other words, the functional element is removed from work by physical or conceptual separability.¹²⁶ Sketches, paintings, pictorials, and graphics made by the fashion designer are protected as artistic works, but works of applied art like clothing or apparel are protected under copyright law only after separating the functional elements from them. On the other hand, the EU protects both works of art and applied art without any discrimination after the Cofemel case. Be it a work of art or a work of applied art, originality is considered as the sine qua non to obtain copyright protection. Work of art and applied art are considered original creations if, firstly, it falls under the original subject matter and, secondly, the subject matter is identifiable with sufficient precision and objectivity. Thus, no discrimination is made between the works of art and the works of applied art.

4.8 The clash between the Copyright Act 1957 and the Designs Act 2000

The objectives of the Copyright Act 1957 and the Designs Act 2000 need to be understood to comprehend the intention of the legislature in passing the acts. The statement and the objectives of the Copyright Act 1957 acknowledge the fact that the Indian Copyright Act 1914 was based on the Copyright Act 1911 of the UK. However, with the changing times and with the new communication technologies, there was a need to enact self-contained and independent legislation. On the other hand, Designs Act 2000 was enacted in light of technological developments to ensure that designs are protected effectively. It protected the design element in the article of production. It also checks that there is no extended over-protection beyond what is required for design activity. The Copyright Act 1957 aims to protect literary, artistic, dramatic, and musical works, sound recording and

¹²⁶ Philip M. Duclos, *Three Cheers for Treconomics: The Future of Copyright Doctrine according to Star Athletica and Star Trek*, 27 CORNELL J. L. & PUBLIC POLICY 207 (2017).

cinematography. The Designs Act 2000 protects the look and appearance of the design element in an article. Copyright law protects works of art and design law protects applied art in India.

4.8.1 Judicial Interpretation of the Overlap under section of the Copyright Act 1957

Emphasising the interplay between the Copyright Act 1957 and the Designs Act 2000, the High Court of Delhi in the case of *SS Sarna Inc., v. Talwar and Khullar Private Limited* ruled that if an artistic work is meant for commercial exploitation, then such works should be excluded from the copyright protection under the Copyright Act 1957, and has to be provided protection under the Designs Act 2000. Furthermore, the Court also stated that the intention with which the arrangement to create the work should not be forgotten and be given equal importance. The objective of creating the work and the inability of the work to stand alone as a piece of art and that it has no independent existence has to be considered. If the objective of creating such a work is to be industrially manufactured, then protection has to be granted only under the Designs Act 2000. If the objective of creating a work is not commercial exploitation, then it has to be protected under the Copyright Act 1957. The clash between these statutes can be seen under section 15 of the Copyright Act 1957. Besides the clash between the statutes, the legislative intention behind having such a provision has to be understood.

The Delhi High Court was called upon to interpret Section 15(2) in a landmark case of *Microfibers Inc. v. Girdhar & Co. & Anr.*¹²⁷ The case was appealed before a three-judge bench of the Delhi High Court and the Court considered the differential factor between original artistic work and industrial or applied art. According to section 15(2), the copyright shall cease to exist in those designs if such designs are put to an industrial process more than 50 times unless registered under the Designs Act 2000. Applying this case law to a hypothetical situation in

¹²⁷ SCC OnLine Del 1647 (2009) (India).

a fashion industry where a fashion designer first creates a sketch or drawing of apparel, such sketch or drawing is protected as 'artistic work' under section 2(c) of the Copyright Act 1957. If such an artistic work is used to create a design, such designs are protected under the Copyright Act 1957, provided only till fifty units are manufactured. The design, that is, the applied art, shall have no copyright protection under the Copyright Act 1957 if a fifty-first unit is manufactured and is unregistered under the Designs Act 2000. However, the sketch and the drawing made by the fashion designer continue to enjoy copyright protection as 'artistic work' under the Copyright Act 1957. Section 15(1) and (2) is applicable to designs and not artistic works. Sketches and drawings, whether precede a design or succeed a design, shall continue to enjoy copyright protection under the Copyright Act 1957 as 'artistic works'.

In *Rajesh Masrani v. Tahiliani Designs*¹²⁸, the Delhi High Court considered the intention of the legislature in enacting both the laws and held that the legislature intended to distinguish between the works of art and applied art of commercialisation of art differently. Thus, the work of art is protected for a longer duration under the copyright law, whereas applied art or designs are protected for a shorter duration under the designs law. The Copyright Act protects the original artistic works for the life of the author plus sixty upon his death, whereas the Designs Act 2000 protects a design for ten years upon registration and five years upon renewal of the registration. The Court held that the respondent has copyright protection under the Copyright Act 1957, as he had not manufactured more than 50 units. The act of copying by the appellant was considered copyright infringement because the apparel in question was manufactured through the industrial process under the close supervision of the designer only for 20 times. The Court reiterated the judgement in the *Microfibers Inc. v. Girdhar & Co. & Anr* held that the sketches and drawings would continue to enjoy copyright protection under the Copyright Act 1957 without any restriction, whereas restriction is imposed solely on the designs that are created more than fifty times. Designs that are manufactured less than fifty times can claim exclusive protection

¹²⁸ 2008 SCC OnLine Del 1737

under the Copyright Act 1957 without any limitations. However, the restriction is on designs that are manufactured more than 50 times but not registered under the Designs Act 2000. Such unregistered designs manufactured more than fifty times lose copyright under both the Copyright Act 1957 and the Designs Act 2000. In the words of the Court, “ What the design would cease to enjoy is the copyright protection in its industrial application for production of an article if manufactured more than fifty times”.

In *Ritika Pvt Ltd v Biba Apparels Pvt Ltd*,¹²⁹ the defendant argued that copyright in the plaintiff's work ceased to exist because of Section 15(2). The plaintiff had manufactured her work more than 50 times but had not registered under the Designs Act 2000. By default, application of Section 15(2) would mean that the copyright had ceased to exist upon manufacture of the 51st unit as the designs were not registered under the Designs Act 2000. If registered, then the copyright under the Designs Act 2000 will subsist, and the copyright under the Copyright Act 1957 shall cease to subsist. Furthermore, the court discussed the hypothetical situation where the designs were created from artistic works and then applied to the dresses through an industrial process. In that case, copyright infringement could have been filed for the violation of artistic works. But, the facts of the case reflect that designs were not created by affixing an artistic work and had been manufactured more than fifty times but were not registered under the Designs Act 2000. Thus, there was no copyright infringement under the Copyright Act 1957 as there was no artistic work related to the design, and the design was manufactured more than fifty times but not registered under the Designs Act 2000. Consequently, there can be no copyright protection for unregistered designs under the Designs Act 2000.

Appraising the above case laws with respect to section 15 of the Copyright Act 1957, the following can be interpreted; firstly, copyright in an artistic work can exist independently of its application. In other words, applied art will not affect the copyright in the work of art. Secondly, upon manufacturing of designs more

¹²⁹ 2016 SCC OnLine Del 1979

than fifty times, the copyright under the Copyright Act 1957 is lost unless registered under the Designs Act 2000. Upon registration of a design under the Designs Act 2000, copyright under the Copyright Act 1957 shall cease to exist. Thirdly, if an artistic work precedes or succeeds a design, it can be protected as an ‘artistic work’ under the Copyright Act 1957, and if such design is registered under the Designs Act 2000, such design can claim copyright protection only under the Designs Act 2000. Fourthly, if an artistic work precedes or succeeds a design and the design is manufactured less than fifty times, then both the artistic work and the design are protected under the Copyright Act 1957.

4.8.2 India and the UK - Copyright and Design laws Overlap

India being a Commonwealth Nation, the UK had a significant influence on the statutes that were being enacted in India. The Copyright Act 1914 of India was greatly based on the UK Copyright Act 1911. After independence and due to technological advancements and public consciousness of their rights and duties, there was a need to amend the Copyright Act 1914. With respect to works of art and applied art, they are treated differently. The former is protected under the Copyright Law whereas the latter is protected under the Designs Law and such differential treatment is in consonance with the Berne Convention. The UK, till 2019 treated works of art and applied art differently and India still continues to do the same. So, it’s important to consider the design and copyright overlap in the UK to understand why the Indian Parliament has drafted section 15 under the Copyright Act 1957.

The elongated struggle for the UK to harmonise the copyright laws with the design laws is worth mentioning. Cutting the past history and coming to the relevant history of Copyright Law in the UK, it’s important to highlight the Gregory Committee Report (Committee) that resulted in the passing of the Copyright Act 1956 in the UK.¹³⁰ The Committee recommended the following;

¹³⁰ Lionel Bently, *The Design/Copyright Conflict in the United Kingdom: A History*, E. Derclaye (Ed.), *The Copyright/Design Interface: Past, Present and Future*, CIPIL, Cambridge University. 171-225 (2018).

- a. Copyright should subsist in all the original works irrespective of whether there is an intention to exploit or not commercially.
- b. The owner of the design should be allowed to register it under the Designs Act if he decides to exploit the design industrially.
- c. Upon registration under the Designs Act, protection under the Copyright Act should cease to exist.
- d. if the copyright owner of an artistic work applies for the work as an industrial design without registration, then the copyright in those articles manufactured using that design and associated designs should cease to exist. However, the copyright in the original artistic work should continue to subsist.¹³¹

The above-mentioned recommendations were, to a great extent, incorporated under section 10 of the Copyright Act 1956 of the UK. Section 10 granted fifteen years of monopoly over the registered designs. If the design is not registered, then the artistic work would be considered industrially applied if fifty units of articles are manufactured, all of which are different articles as under section 44 of the Registered Designs Act 1949; however, the definition of the industrial process stands repealed. Section 10 of the Copyright Act 1956 was modified and inserted as section 52 of the Copyright, Designs and Patents Act 1988 (CDPA, 1988), but section 52 stands currently repealed. Section 52 envisaged that the protection of artistic works manufactured as a design more than fifty times shall be protected for twenty five years, as opposed to the original artistic works protected for the lifetime of the author plus seventy years. In a nutshell, when more than fifty copies of artistic work are put to industrial manufacture, then such designs would be protected only for twenty five years. Such differential treatment is in harmony

¹³¹Australia. Committee to Consider What Alterations are Desirable in the Copyright Law of the Commonwealth. & Spicer, John Armstrong. 1960, *Report of the Committee Appointed by the Attorney General of the Commonwealth to Consider What Alterations are Desirable in the Copyright Law of the Commonwealth* A. J. Arthur, Commonwealth Govt. Printer Canberra.

with the Berne Convention. It stipulates a minimum of twenty-five years for the applied art and leaves the criteria for protection to the discretion of the member nations.

India has differentiated between the works of art and applied art by introducing section 15 in the Copyright Act 1957. Section 15(1) of the Act states that the copyright would cease to exist in those works that are registered as designs under Designs Act 2000. Section 15(2) says that any work that is capable of being registered under the Designs Act 2000 but is not duly registered would lose copyright protection under the Copyright Act 1957 as soon as any article is produced more than 50 times through the industrial process to which the design is applied. According to section 15(1), copyright would cease to exist under the Copyright Act 1957 if the work is registered as a design under the Designs Act 2000.

Interpreting section 15(2) would mean that copyright would cease to subsist in the works that are capable of being registered under the Designs Act 2000 after the manufacturing of the 51st article to which the design is applied. If the 51st article is manufactured and is not registered under the Designs Act 2000, such design cannot claim copyright either under the Copyright Act 1957 or under the Designs Act 2000.¹³² However, section 15 does not conform with Berne Convention. Berne Convention allows differential treatment for works of art and applied art, but intends to protect applied art for 25 years. In India, applied art i.e. an artistic work put to industrial process can claim copyright protection under the Copyright Act 1957 only up to fifty units. Manufacturing more than 50 units would denote that copyright shall cease to exist under the Copyright Act 1957, unless registered under the Designs Act 2000.

Comparing Section 52 of the CDPA and Section 15 of the Copyright Act 1957 unambiguously states that in the UK, applied art is protected for twenty five years if more than fifty units are manufactured, whereas Section 15 of the

¹³² The Copyright Act, 1957, § 15.

Copyright Act 1957 implies that applied art shall be protected only up to 50 units of manufacture and 51st article manufactured loses its copyright under the Copyright Act 1957, unless registered under the Designs Act 1957. The Berne Convention requires its member countries to protect applied art for twenty five years.¹³³ The UK protects applied art for twenty five years, whereas India grants feeble protection for applied art under the Copyright Act 1957. Though there is no legislative history to support this claim, it is possible that India has borrowed section 15 of the Copyright Act 1957 from the UK. Section 15 is merely a combination of section 10 of the Copyright of 1956 and section 44 of the Registered Designs Act 1949 of the UK. However, after the Cofemel judgement by the CJEU, section 52 of the CDPA 1988 was repealed in 2016. But, India still continues to acknowledge the overlap between the Copyright Act 1957 and the Designs Act 2000 and such differentiation between the work of art and applied art hampers growth in the fashion industry. The differentiation path chosen by India makes it more difficult for fashion designers to protect their fashion designs.

4.9 Observations

In the first part of the chapter, thorough research has been undertaken to understand the protection granted to fashion designs that have both artistic and functional elements. For this purpose, the stance of the U.S. and the EU was considered. The U.S. is the country that followed the piracy paradox or considered the fashion industry as an IP-negative space, but over the years; they seem to have realised the importance of protecting fashion designs. The U.S. has come a long way from physical separability (*Mazer v Stein*) to conceptual separability (*Star Athletica v Varsity Brands*). At present, the U.S. is following the two-prong test as laid down by the SCOTUS in *Star Athletica v Varsity Brands* to determine conceptual separability in a useful article. The U.S. is also looking at passing exclusive legislation to protect fashion designs. Innovative Design Protection and Piracy Prevention Act (IDPPPA). Though still not passed by Congress, it is

¹³³ Ndene Ndiaye, *The Berne Convention and Developing Countries*, 11 COLUM.-VLA J.L. & Arts 47 (1986).

commendable to witness the direction and the steps that the U.S. is taking to protect fashion designs. On the other hand, the EU protects both works of art and applied art at par with each other, without any discrimination. By appraising the CJEU judgements in the Infopaq case, Flos case, Lavelo Hengelo case and most importantly, the Cofemel case, the approach of the EU in protecting fashion designs is much better than the U.S., but not best suited for India. The Copyright Act 1957 protects an artistic work irrespective of its aesthetic value but does not protect an artistic work that has functional elements in them, as similar to the U.S. Neither the Indian Copyright Office or the judiciary have considered how a useful article that embeds artistic work could be protected. As fashion designs are both artistic and functional in nature, it is difficult to claim copyright protection in the absence of any regulations on separability. Since the Indian Courts have not formulated any test on how to separate artistic elements from the utility element, it is difficult to claim copyright protection for a fashion design that has both artistic and functional elements. The Bombay High Court in the case of *Hamilton Housewares Private Limited and Another v. Yogi Products*¹³⁴ and *Faber-Castell Aktiengesellschaft and Another v. Cello Pens Pvt. Ltd.*¹³⁵ and *Another*, the Delhi High Court in *J.C. Bamford Excavators Limited & Anr v. Bull Machines Pvt. Ltd.*¹³⁶, had opportunities to lay down the guidelines for separability. Still, the courts have not formulated a test to determine separability for the copyright law in India.

The second part of the chapter dealt with the overlap between the Copyright Act 1957 and the Designs Act 2000. The clash between these two statutes should be resolved to protect fashion designs adequately. India, being a Commonwealth country largely follows the UK laws. Section 15(1) and (2) of the Copyright Act 1957 seems to have been largely influenced by the UK laws; section 10 of the Copyright Act 1956 and section 44 of the Registered Designs Act 1949. The UK tried to clear the confusion created by the overlap between the Copyright Law and the Designs Law and, as a result, section 52 was introduced in the CDPA, 1988.

¹³⁴ 2016 SCC OnLine Bom 4293.

¹³⁵ 2015 SCC OnLine Bom 8762.

¹³⁶ 2016 SCC OnLine Del 11.

Furthermore, when the EU passed the Cofemel judgement, the member countries were directed to treat both works of art and applied art equally. Consequently, section 52 of the CDPA, 1988 was repealed in 2016. The U.K. has taken the step to eliminate the discriminatory treatment of applied art against the works of art, but India continues to follow the same. Fashion designs can be both works of art and applied art. Sketches, drawings and graphics of the fashion designers are protected as works of art or artistic work under the Copyright Act 1957 and commercialisation of such artistic work or applied art is protected as an industrial design under the Designs Act 2000. But the existence of sections 15 (1) and (2) creates confusion and difficulty in protecting fashion designs, as discussed extensively in this chapter. It's time also for India to consider resolving the overlap between the copyright law and the design law and treat both works of art and applied art and bring the provisions in accordance with the Berne Convention.