

How to decide whether to register a design under Designs Act, 2000 or under Copyright Act, 1957 or under Trademarks Act, 1999

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2403 Views



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Introduction

If there is any fashion designer who can define royalty and elegance in its true essence through his work, it has to be Sabyasachi Mukherjee. The latest collection ‘*Kesribai Pannalal*’ is a treat to the eye, having hues of different colors, intricate embroidery, patterns, textures, etc.

If a designer like Sabyasachi Mukherjee wishes to seek protection of law for his design and collection, registration of the design becomes important. There are different provisions and statutes under the law wherein a design can be registered, namely-

1. Designs Act, 2000;
2. Registration as *Artistic work* under Copyright Act;

3. Registration as *Trade Dress* under Trademarks Act, 1999.

Each statute mentioned above varies in various aspects when compared with the other, thereby creating confusion. Let us have a look at the provisions and analyze which one would suit the needs of a designer better.



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Meaning of design

1. *The Designs Act, 2000* defines a 'Design' under [Section 2\(d\)](#) of the Act. The term 'design' means only the features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article by industrial process or means; which in the finished article appeal to and are judged solely by the eye.
2. *The Copyright Act, 1957* includes 'design' under the bracket of 'Artistic work' in [Section 2\(c\) \(i\)](#) which includes a painting, a sculpture, a drawing, an engraving or a photograph are included; regardless of the work's artistic/aesthetic quality. The term 'Artistic work' also includes any other work of artistic craftsmanship and a work of architecture.
3. *The Trade Marks Act, 1999* protects the designs and collections of a designer by way of a 'Trade Dress'. A trade dress refers to the visual appearance of a product, including its shape, combination of colors and packaging. It thus protects the product as a whole and helps a customer compare and distinguish it from other products. Although the Trademark Act, 1999 does not categorically mention trade dress, [Section 2\(zb\)](#) of the Act includes within itself the '*shape of goods, their packaging and combination of colours*'. Thus, it can be inferred that trade dress is recognized within the definition of trademark.

Purpose of registration of design

1. The purpose of registration of a design is to ensure that the creator exercises sole monopolistic power over the design.
2. Registering a design also ensures that there is no undesired and unwanted exploitation of the idea, concept, design and the product.
3. Thus, registration of a design becomes imperative to safeguard the elegance and the appealing factor of a product.

Registration of design under Designs Act, 2000

Designs which cannot be registered under the Act:

[Section 4](#) of the Act provides certain conditions which if present in a design disqualify it from being registered. The conditions are as follows-

1. If the design is *not a new or original design*; or
2. If a design has been *disclosed to the public anywhere in India* through publication in tangible form/by use/in any other way, *prior to the date of filing* of the design; or
3. If the *design cannot be distinguished from other known designs*; or
4. If the design *contains anything obscene or scandalous* in nature.

Protection offered to the design upon registration:

A [Proprietor](#) who registers his design under this Act is entitled to a copyright protection in the design for an initial period of **10 years**, from the day the design is registered. The same has been provided in [Section 11](#) of the Act.

The copyright period of 10 years in the design can be extended for another period of **5 years**. For the said purpose, the proprietor needs to make an application to the [Controller of Designs](#) before the expiry of the above-mentioned 10 years; in a prescribed manner and upon payment of the prescribed fee.

Is Registration mandatory under the Act?

The protection under the Act is provided only to the designs which are registered. Section 11 of the Act states that on the event the design is registered, the registered proprietor of the design shall be entitled to copyright protection of ten years. Thus, it means that registration of a design under the Act is mandatory and is a pre-requisite for seeking protection.

Registration of design as artistic work under the Copyright Act, 1957

Design which can be registered under the Act:

A design or a creation of a designer which is an *original artistic work* under the ambit of the Copyright Act, 1957 can be registered herein.

Further, a design which is capable of being registered under the Designs Act, 2000 but is not so registered under the said Act will also be protected under the Copyright Act, 1954.



If a designer wishes to register his design (capable of being registered under Designs Act, 2000) under the Copyright Act, 1957, [Rule 70\(7\) of Copyright Rules 2013](#) mandates the submission of an affidavit stating that-

1. the design has not been registered or is not applied for registration under the Designs Act, 2000; and
2. the work has not been reproduced more than 50 times.

Protection offered by the Act:

1. If a fashion design is registered as an *Original Artistic work* under the Act, the copyright in the design subsists for the ***Lifetime of creator and sixty years after the death of the creator*** as provided under [Section 22](#) of the Act.

2. If a design is capable of being registered as *Design* under the Designs Act, 2000 but is not so registered, the Design gets protection under the Copyright Act, 1957. Such copyright protection subsists till the **50th reproduction** of the article. The same is provided under [Section 15](#) of the Copyright Act.

Is Registration mandatory under the Copyright Act?

Registration is not mandatory under the Copyright Act unlike the Designs Act, 2000 wherein protection is given to a design only when it is registered under the Act.

There are many case laws stating that registration is not mandatory under the Act. Let us have a look at some of them.

[*Sanjay Soya Pvt. Ltd. v. Narayani Trading Company*](#)

- In this recent judgement dated March 15, 2021, the Hon'ble Bombay High Court held that registration of copyright is not compulsory under the Copyright Act, 1957.
- It was observed by the judge that “Copyright Act gives a range of rights and privileges to the first owner of copyright without requiring prior registration.”
- The Single Judge Bench of Justice GS Patel herein observed that [Section 45\(1\)](#) provides that the copyright owner ‘may’ make an application for registration. Further, [Section 51](#) which revolves around infringement of copyright, does not contain anything in respect to registration of a copyright. There has been no mention about registration anywhere in the provision.

Justice GS Patel in the above-mentioned case referred to the case of [*Burroughs Wellcome \(India\) Ltd v. Uni-Sole Pvt Ltd & Anr.*](#) wherein it was held that there is no provision in the Copyright Act according to which an author/creator gets deprived of his rights merely due to non-registration of copyright.

[*Asian Paints \(I\) Ltd v. M/s Jaikishan Paints & Allied Products*](#)

Here in this case, registration of copyright under the Act was held to be optional and not compulsory. The court ruled that “*Registration is not necessary to claim a copyright. Copyright subsists as soon as the work is created and given a material form even if it is not registered.*“

Even though the Copyright Act does not make registration necessary, it is however advised that a fashion design should be registered under the Act. As per [Section 48](#) of the Act

that a fashion design should be registered under the Act. As per [Section 48](#) of the Act, registration of a design is prima facie evidence and is admissible as an evidence in all courts of law without the need of any other proof of originality.

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Why is design registration important? | Bhavpreet Singh So...



Registration of design as *trade dress* under the Trademarks Act, 1999

A fashion design can be protected under the Trade Marks Act as a *Trade Dress*. Though not specifically mentioned in the Act, [Section 2\(zb\)](#) recognizes the concept by including within itself ‘*shape of goods, its packaging and combination of colors*’.

Essentials of a Trade Dress

The shape, size, color, texture of a product are the primary essentials of a trade dress. The unique packaging of the product is also considered an essential of a trade dress. Further, the product’s color scheme also gives it a distinct identity.

Thus, trade dress can be considered as the spectacle of a customer because the features like shape, color scheme and the overall look of a fashion design are recognized by a customer initially and easily.

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Requirements for registration of a Trade Dress

The registration of a Trade dress has the following requirements:

1. The product must be graphically represented.
2. The product must be distinct in character when compared with others.
3. The trade dress must be in a printed form.

Protection to a Trade Dress

The Judiciary in India has given protection to a trade dress through the Common law remedy called “*Passing off*”.

This remedy is built on the principle “A man may not sell his own goods under the pretense that they are the goods of another man.”

Two things which are absolutely necessary to protect a trade dress are goodwill and reputation. A designer/brand is required to prove that:

1. the trademark and the works have acquired goodwill and reputation; and

2. the public associates the works with its right holder.

Is Registration mandatory for a Trade Dress?

Registration of a Trade dress is not necessary for the purpose of a passing off action. The same has been observed in the case of [Kishore Zarda Factory \(P\) Ltd. vs JP. Tobacco.](#)

In the fashion industry we see changes in styles and trends very often. Every brand and designer introduce new collection after every few months. As the shelf life of a trade dress is short, the right holders usually do not register a trade dress and instead bank on their goodwill and reputation.

Is registration as Trade Dress beneficial for the rights holder?

Registration of design as a Trade Dress can be beneficial for the rights holder.

In a passing-off action, other than proving the reputation and goodwill of the work, the plaintiff has to prove either of the following-

1. The defendant is deceptively passing off his goods as those of the plaintiff;
2. The defendant's acts have the capacity to create confusion in the minds of the customers.

In [Kirloskar Proprietary Ltd. vs Kirloskar Dimensions Pvt. Ltd](#) it was held that in the action of passing off, the defendant's motive does not carry any importance. The plaintiff has to establish only his reputation and no further proof of the defendant's fraudulent intention needs to be established.

Industry practice for registration of design

Fashion designers find it better to term their collections as an *Artistic work* because an artistic work enjoys greater protection.

DESIGNS ACT, 2000

Protection to a design–

Maximum 15 years

Registration–

COPYRIGHT ACT, 1957

Protection to an Artistic Work–

Lifetime of the creator + 60 years after his death.

Registration–

registration-

Not Mandatory.

Mandatory under the Act
for getting protection

Design capable of being registered under Designs Act but not so registered, also gets protection under Copyright Act.

There are a few other things in the Designs Act which make registration under the Designs Act not that great for a fashion designer.

1. Lengthy process of Registration under Designs Act-

Registration of a design is a prerequisite for availing protection under the Act. The registration process under the Act is time consuming and complicated. It takes approximately 10-12 months for a design to get registered; whereas considering the changing trends in the industry, a garment lasts in store for about 3-4 months. This leaves the designer with the only option of applying for registration way in advance from the date of release.

Even if a designer engages in the registration process and subsequently if the design is not appreciated in the market, the registration process doesn't solve its purpose and becomes a mere formality.

2. Inadequacy of damages for piracy-

Although the Designs Act talks about the damages in the event of piracy of a design, the Act puts a cap on the same. A designer can pray for a maximum of fifty thousand as damages. This does not seem to provide justice to a designer who puts in considerable time and effort in every couture collection worth lakhs of rupees.

Conclusion

The term '*design*' under the Designs Act, 2000 is restricted to only the features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article through and industrial process or means. The Copyright Act, 1957 under the term '*Artistic work*' considers a fashion design as a whole, regardless of its aesthetic quality. A '*Trade dress*' recognized under Section 2(zb) of the Trade Marks Act, 1999 includes *shape of goods, their packaging and combination of colors*.

The Designs Act provides for a mandatory registration whereas registration of an artistic work and trade dress is not mandatory under the Copyright Act and the Trade Marks act respectively. An *Artistic work* is protected for the lifetime of the creator and 60 years after his death. A design capable of being registered under Designs Act, but not so registered is also protected under the Copyright Act till its 50th reproduction.

A *registered design* is protected under the Designs Act for a maximum term of 15 years whereas passing off is the only protection available to a *trade dress*. Moreover, the process of registration under the Designs act is tedious and lengthy which is usually not appreciated by fashion designers. Whereas Copyright Act does not provide an upper limit to the damages in the event of infringement, the Designs Act limits the damages to Rupees Fifty Thousand only.

Considering all these things, registration of a design as an *Artistic Work* under the Copyright Act, 1957 seems to be a better option as the protection granted is for a considerable long period of time along with no mandatory requirement of registration and no ceiling limit to damages in the event of infringement of copyright.

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