LEGAL MECHANISM FOR PROTECTING FASHION DESIGNS: COMPARATIVE STUDY OF COPYRIGHT AND DESIGN LAW IN USA, EUROPEAN UNION AND INDIA

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Abstract

Creativity is essence of fashion industry. Fashion in its highest form is derived from inspiration and creativity. Clothing has always been one of life's necessities and this business of fashion apparels has evolved into a thriving market which has led to one of the important issues in fashion industry that is copying of designs. This article analyses role of Intellectual Property Rights (IPR) focusing on Copyright and Design law protection for fashion apparels as there is conflicting literature on this issue. Some say fashion industry can survive without intellectual property protection and some say intellectual property (IP) protection is necessary in fashion industry. Another aspect is to analyse the useful articles doctrine of Copyright separability which is applied on fashion apparels. This doctrine and its relation to fashion apparels can be gauged from the point that an article of clothing, is denied copyright protection because it has "utilitarian" function. This useful aspect of clothing is the main strike against protecting the fashion apparels via copyright. This issue is analysed in light of giving protection to fashion designs. So, the present protection given to fashion designs through copyright and design law is analysed in the three jurisdictions, USA, European Union and India.

Keywords: Copyright, Design law, Fashion Apparel, Counterfeiting, Separability Doctrine, Knockoff Goods, Useful Article.

1. Introduction

Clothes are a walking art form.[1]

Fashion industry is a booming industry with high production of counterfeit and knockoff goods. So, a comparative study would be done to know what changes in the regulatory framework can be done to protect fashion designs. Further how copyright's separability doctrine affects protection for fashion apparels/designs through copyright is

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[1] Elise Ruff, "If the Shoe Fits: The Effects of a Uniform Copyright Design Test on Local Fashion Designers" 17 *The John Marshall Review of Intellectual Property Law* 263, 277 (2017).

analysed. It is a doctrinal study where statutes and case laws are studied as a primary source and journal articles, books are used as a secondary source.

The IP law in United States of America (USA) provide fashion designs less degree of protection[2] as designs do not have a separate protection in the USA.[3] By contrast, the European Union have given protection to fashion designs.[4] In India also there is *sui generis* protection for designs.[5] One of the reasons for less protection in USA to fashion apparels is the utilitarian purpose which clothing serves for which they are denied protection.[6] By a comparative study of the three jurisdictions, it is examined that what each jurisdiction can learn from each other with respect to protecting fashion apparels/designs through Copyright and Design law.

The present article has been written with potential limitation. Recently a major breakthrough was achieved by adoption of the Riyadh Design Law Treaty by which it would be faster, easier and more affordable for designers to protect their designs both at home country and abroad.[7] This article analyses the need of such a treaty in light of challenges faced by designers while protecting their designs and what changes can be done in the regulatory framework for design protection. With respect to European Union, the recent amendments[8] in the EU Design Regulation and Directive is not included in this study as some provisions will apply from 01st May, 2025 and some 01st July, 2026.[9] The present article does not cover these amendments. The article gives a structure of the design law as it is there in EU.

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2 Laura C. Marshall, "Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act" 14 *Journal of Intellectual Property Law* 305, 309 (2007) - stating that the laws of copyright, patent, trademark, and trade dress do not provide "complete protection" for fashion designs.

3 Elizabeth Ferrill and Tina Tanhehco, "Protecting the Material World: The Role of Design Patents in the Fashion Industry" 12 *North Carolina Journal of law and Technology* 251, 270 (2011).

4 *Id.* at 252.

5 The Designs Act, 2000 (Act 16 of 2000).

6 Kal Wong, "To Copy or Not to Copy, That Is the Question: The Game Theory Approach to Protecting Fashion Designs" 160 *University of Pennsylvania Law Review* 1139, 1193 (2012).

7 WIPO, *available at*: https://www.wipo.int/pressroom/en/articles/2024/article_0017.html (last visited on 29 November, 2024).

8 Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002, 2024; Directive (EU) 2024/2823 of the European Parliament and of the Council of 23 October 2024 on the legal protection of designs (recast) (Text with EEA relevance), 2024.

9 Mishcon de Reya, "Revamping designs: changes to the EU design framework", *available at*: https://www.mishcon.com/news/revamping-designs-changes-to-the-eu-design-framework (last visited on 29 November 2024).

2. International Framework

The international framework regarding the industrial design and copyright pertaining to fashion industry is given below;

2.1. Industrial design

This branch of IP focusses on visual appeal of the article. The first international convention on industrial property mentions that – "Designs shall be protected in all the countries of the Union and the extent of the protection is to be defined in the industrial design law of each country."[10] Industrial designs comes under industrial property, but no guidance is provided with regard to what form of protection is to be given.[11] So, industrial designs can be given separate design or copyright protection or with separate design protection, a quasi-copyright protection can be provided.[12]

Further under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)[13] industrial designs that are new or original are protected.[14] It uses the word "May" while talking about the useful aspect of an article, which means not giving design protection to functional elements is an optional requirement, so designs having both aesthetic and functional feature can also be provided protection if the Member state wants. This is an important aspect with regard to utilitarian designs and its impact on industrial design protection for such designs.

Article 26(1) entails protection against copying in fashion industry. It provides rights against infringement of industrial designs.[15]

2.2. Copyright

Copyright protection is for creative forms of expression. The Berne Convention, 1886 recognizes works in which copyright subsists and gives protection to them. Under Article 2(1) of this Convention works in which copyright subsists is defined which includes applied art, drawing, sketches etc. Fashion designs, that is sketches of clothes could be included in this. Further similar to Paris Convention, under Berne convention

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[10] Paris Convention for the Protection of Industrial Property, 1883, art. 5quinquies.
[11] *Id.*, art. 1(2).
[12] G.H.C. Bodenhausen, *Guide to The Application of the Paris Convention for The Protection of Industrial Property* 86 (United International Bureaux for the Protection of Intellectual Property, Geneva, 1968).
[13] Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994.
[14] *Ibid.*
[15] UNCTAD-ICTSD, *Resource Book on Trips and Development* 336 (Cambridge University Press, 2004).

also Members can choose between design or copyright protection for industrial design.[16] Further members of TRIPs[17] has to comply with Berne convention.[18]

3. Copyright and Design Law Protection for Fashion Apparels - Barrier or Incentive

The expression "fashion design" is the term applied to art dedicated to the design of clothing and lifestyle accessories, created with the cultural and social influences of a specific time.[19]

There are two divergent views with regard to protecting fashion designs and apparels by copyright and industrial design regime. One view supports that fashion apparels need Copyright and Design protection and others view says that for fashion designs and apparels IPR protection does not play much role. These divergent views are analysed to study the need of IP protection in fashion industry with focus on copyright and industrial designs protection.

3.1. Proponents Who Are Against Copyright and Design Law Protection for Fashion Apparels

Professor Raustiala and Sprigman[20] refer to a concept called "negative spaces" which defy traditional justification for IP law. On this backdrop we would see what proponents who are against copyright protection for fashion apparels says.

3.1.1. Piracy Paradox

In an influential article, Kal Raustiala and Chris Sprigman have advanced the argument that in the fashion industry, piracy is paradoxically beneficial to the fashion industry in the long run.[21] This theory says that, when there is low level of IP protection for fashion apparels, it reduces the status of new designs, by which they could have meant that if a design is protected under IPR, its status is more among consumer and copyists, *i.e.*, copyists know they cannot copy such design, and so when there is no IP protection

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16 Berne Convention for the Protection of Literary and Artistic Works,1886, as revised at Paris on July 24, 1971 and amended in 1979, art. 2(7).
17 *Supra* note 13.
18 *Id.*, art. 9(1) - Members shall comply with Articles 1 through 21 of the Berne Convention except Article 6bis.
19 Victoria R. Watkins, "Copyright and the Fashion Industry" 3 *Landslide* 53 (2011).
20 Kal Raustiala and Christopher Sprigman, "The Piracy Paradox: Innovation and Intellectual Property in Fashion Design" 92 *Virginia Law Review* 1687, 1728 (2006).
21 *Id.* at 1722.

for fashion apparels, their status is reduced in mind of copyists and consumers and so therefore consumers demand new innovative designs at a constant rate. So according to this view, if IPR were put in place to keep a check on copying, clothing would not lose its status as quickly, consumer demand would decrease, and designers would ultimately lose incentive to innovate.[22]

This point can be clarified by the argument that the multiplication of copies of a design reduces the value of the design and renders it outdated, which, in turn, leads to consumers and hence producers tend to go for new designs and trends.[23] this is called "induced obsolescence."[24] Then this selling of new fashion apparels is profitable because of fashion cycle, and also leads to innovation, so it is argued that copying benefits designers which leads to innovation and hence the "piracy paradox."

So copying promotes innovation, as the original designers must continuously and rapidly generate new designs to remain ahead of copyists.[25] In light of this benefit, they conclude it is a bad idea to protect designers from piracy.[26] Another point put forward is that the fashion industry for its working needs continued investment and innovation even without an IPR protection.[27] The inapplicability of copyright law to the fashion industry has not adversely affected the incentive to innovate and create in the fashion industry.[28]

3.1.2. Recycling in Fashion Industry and Copyright

Here the point is that copyright protection could do more harm than good in an industry that continues to build and reinvent itself largely through recycling. It could, in fact, hurt the industry's bottom line.[29] Throughout the last 100-plus years, the fashion

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22 Whitney Potter Comment, "Intellectual Property's Fashion Faux Pas: A Critical Look at the Lack of Protection Afforded Apparel Design Under the Current Legal Regime" 16 *Intellectual Property Law Bulletin* 69, 83 (2011).

23 *Supra* note 20 at 1722.

24 The practical importance of "induced obsolescence" is uncertain because obsolescence has causes other than copying, including the passage of the seasons, a change in the spirit of the times that made the item salient, desire for the new, and the innovative product of other designers. These effects may be more important sources of obsolescence of fashion designs than the proliferation of copies.

25 Daily Beast, available at: http://www.thedailybeast.com/newsweek/2010/08/20/copycats-versus-copyrights.htm (last visited on 30 August 2024).

26 *Supra* note 20 - Growth and creativity in the fashion industry depend upon copying.

27 Pranjal Shirwaikar, "Fashion Copying and Design of the Law" 14 *Journal of Intellectual Property Rights* 113, 115 (2009).

28 *Id.*

29 *Id.*

market has evolved constantly but has continued to go back to past design trends.[30] This ongoing practice of reverting back suggests that the industry does not need formal copyright protection.[31] The lifecycle of a fashion apparel and design in the market is quite less, because of new trends which keep on coming, so the point is this aspect of the fashion industry does not go well with the long duration copyright law provides, that is if copyright protection granted to such fashion designs and apparels it would lead to an over protection, giving a strong monopoly to the designer, which would lead to stifling innovation, and limiting the free competition on the market.[32]

The majority of fashion designers believe that, with fashion seasons lasting only a few months, the protection period offered by the registration systems is not appropriate for often ephemeral fashion designs, and that their time and money would therefore be better spent on creating new designs than on registration.[33] With this natural cycle in the industry, fashion has no time for copyright protection and the exclusive rights it offers. The trade is self-governing.[34]

3.1.3. Role of Business Methods in Fashion and Its Impact on Need of IPR Protection

The fashion industry relies primarily on trademark and trade dress law to protect its brands, but these laws offer little protection to the clothing designs themselves, other than to fabrics employing logo patterns. So due to limited legal protection, the fashion industry relies more on business methods, such as strong brand marketing. Thus fashion fosters a thriving and powerful business that operates outside of traditional IPR.[35] Fashion runs efficiently without copyright legislation.[36]

3.2. Proponents View Who Support Copyright and Design Law Protection for Fashion Apparels

Proponents who support copyright and design protection for fashion apparels says that the work of fashion artists aligns perfectly with the purpose of the Copyright

[30] *Id.*
[31] *Id.*
[32] Lucrezia Palandri, "Fashion as Art: Rights and Remedies in the Age of Social Media" 9 *MDPI* 12 (2020).
[33] *Supra* note 20.
[34] *Id.* at 55.
[35] *Id.*
[36] *Id.*

law.[37] Designs once created can be the source of inspiration for later creations, promoting the progress of the art form.[38] Just because the fashion industry remains innovative and successful, despite a lack of IP protection does not automatically undermine the need to protect this industry through IPR.[39] If imitation were truly the sincerest form of flattery, then high-end fashion houses and designers such as Versace, Celine, Gucci, Alexander Wang, and Christian Dior would welcome the praise rather than sue retailers who copy their original designs.[40]

3.2.1. The Threat to Innovation- Harmful Copying

In the fashion world, knockoffs and counterfeits of fashion designs are common.[41] A counterfeit is an exact duplicate/replica of original.[42] However a knockoff is a close copy of the original design.[43] Copying in fashion is not a new problem. As a result of the counterfeit and knockoff industry in 2004 alone including all goods such as fashion, accessories, and multimedia, New York lost $1 billion tax revenue with the comptroller estimating over $23 billion worth of knockoff goods sold. This failure to take advantage of the existing IP protections, however, likely harms emerging fashion designers.[44]

To attack the piracy paradox theory, the point made here is that copying undermines the market for original designs. Copying of original designs affects profitability of original designs as people buy the cheap version of the original designs, thus reducing the prospective incentive to develop new designs.[45] Copyists target designs that are technically and legally easy to copy.

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37 *Supra* note 20 at 53.
38 *Id.*
39 Cassandra Elrod, "The Domino Effect: How Inadequate Intellectual Property Rights in the Fashion Industry Affect Global Sustainability" 24, *Indiana Journal of Global Legal Studies* 575, 593 (2017).
40 The Fashion Law, *available at*: http://www.thefashionlaw.com/home/13-of-nasty-gals-most-blatantknockoff (last visited on 30 August, 2024).
41 Elizabeth Ferrill and Tina Tanhehco, "Protecting the Material World: The Role of Design Patents in the Fashion Industry" 12 *North Carolina Journal of Law and Technology* 251, 254 (2011).
42 Merriam-Webster, "Counterfeit", *available at*: http://www.merriamwebster.com/dictionary/counterfeit (last visited on 19 August 2024).
43 *Id.*
44 Christina Binkley ''The Problem with Being a Trendsetter'' *The Wall Street Journal*, April 29, 2010, *available at*: https://www.wsj.com/articles/SB10001424052748704423504575212201552288996 (last visited on 19 August 2024).
45 C. Scott Hemphill and Jean Suk, "The Law Culture and Economics of Fashion" 61 *Stanford Law Review* 1147, 1174 (2009).

In addition to replacing sales, the cheaper copies also may reduce demand for the original design.[46] This in turn would lead to less profits for designer of original fashion apparel and thus would have a negative effect on the amount of innovation.[47] Close copies make matters worse, reducing designer profits in the meantime by reducing sales. In fact, many designers are vocal advocates against copying.[48] Another example of copying of designs is of James Soares. He accused the fashion giant Urban Outfitters of stealing his graphic printing design and selling the design as its own.[49]

3.2.2. Fast Fashion

Designer fashions are repeatedly copied and sold to consumers at discounted prices, a process known as fast fashion.[50] Fast fashion retailers have very little fear of producing copied works, because the products of fast fashion clothing chains disappear from the store shelves before a lawsuit can even be filed against them.[51] Fast Fashion affects the emerging designers, as shown here.

Source: https://www.businessinsider.com/designer-says-forever-21-copied-her-shirt-design-2020-9

Fast fashion threatens innovation in fashion. The most striking consequence of fast fashion phenomenon is the ability to wait and see which designs succeed, and copying only those.[52] Such copyists can reach market

46 *Id.* at 1176.
47 *Id.*
48 *Id.* at 1183.
49 *Supra* note 1.
50 Annamma Joy, John F. Sherry, *et. al.*, "Fast Fashion, Sustainability, and the Ethical Appeal of Luxury Brands" 16 *Fashion Theory* 273 (2012) - discussing the idea of "fast fashion" as a process that mimics luxury fashion trends and then selling similar "low-cost" collections in retail stores.
51 *Supra* note 32.
52 *Supra* note 45 at 1171.

well before the relevant trend has ended.[53] In India an example of this is Chandni Chowk where Original replica or fake replica of a high-profile designer like Manish Malhotra designer lehanga for example is sold depending on customer budget. A seller from chandni chowk accepted that they buy original designer lehangas to replicate them.[54]

Design piracy threatens the U.S. fashion industry, especially small designers as these designers do not have strong protection through trademark law as people are not aware about these designers and hence they do not have strong logos.[55] For establishing themselves in the fashion industry, they need time but before they can do that, infringers could copy their work.

3.2.3. Protection for Haute Couture Through Copyright and Design Law

Though our everyday fashions can survive just fine without protection, there is something to be said for copyrighting a design that takes clothing beyond day-to-day wear.[56] Failing to provide fashion designers with an IPR in their designs prevents them from "knocking off their own designs and widening their consumer base" with respect to haute couture and red carpet designs. Copyright protection advantage is that it subsists from the time of creation.[57] So for Haute Couture dresses copyright protection would be advantageous as in Haute Couture dresses the fashion cycle does not apply as it is for ready to wear dresses, as Haute Couture dresses are exclusive custom made clothing which are not dependent on trends mostly.

4. Current Protection to Fashion Apparels in The Three Jurisdictions

The current position pertaining to protection of fashion apparel in three different countries are discussed below.

4.1. USA

The underlying basis of U.S. copyright law is to be found in the Constitution's Article 1, Clause 8, s. 8 which gives government the power "to promote the Progress of

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53 *Id.* at 1172.

54 Niharika Lal, "From the ramp to Chandni Chowk: The story of 'original replica' lehengas" *The Times of India*, January 18, 2019, *available at*: https://timesofindia.indiatimes.com/city/delhi/from-the-ramp-to-chandni-chowk-the-story-of-original-replica-lehengas/articleshow/67571002.cms (last visited on 29 August 2024).

55 Katherine M. Olson, "The Innovative Design Protection and Piracy Prevention Act: Re-Fashioning U.S. Intellectual Property Law" 61 *DePaul Law Review* 742 (2012).

56 *Supra* note 19 at 57.

57 The United States code- title 17, 2018, s. 302(a).

science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries".[58]

Theoretically, Copyright can apply to fashion designs because its subject matter includes original works of authorship fixed in any tangible medium of expression.[59] Further copyright protection exists for pictorial, graphic subject matter[60] which can be related to fashion design.[61] However practically the utilitarian function of clothes acts as a roadblock in giving copyright protection to fashion designs.[62] That is why it is said that the legal remedies currently available are insufficient to grant fashion designs adequate intellectual property protection.[63] Lack of protection for fashion designs in the U.S. has made the young designers vulnerable towards the issue of piracy as these designers lose revenue due to copying of their designs by companies whose business model thrive on piracy of clothes.[64]

4.1.1. Understanding whether Design Patent is a viable alternative for Fashion Designs and Apparels

Design patents provide legal protection to inventors of new, original, and ornamental design for an article of manufacture.[65] In other words, a design patent protects the way an article looks.[66] Further, in order for a design to qualify for design patent protection, it should be aesthetically pleasing and that visual appearance should not do any utilitarian function, that is the design should function aesthetically only and not for any technical function of the article[67] and it must satisfy the general criteria of

58 The United States Constitution, 1789, art.1, s.8, cl 8.
59 *Id.*, s. 102(a).
60 *Id.*, s. 102(a)(5).
61 *Id., s.* 101 – Pictorial, graphic, and sculptural works include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.
62 Silvia Beltrametti, "Evaluation of the Design Piracy Prohibition Act: Is the Cure Worse than the Disease? An Analogy with Counterfeiting and a Comparison with the Protection Available in the European Community" 8 *Northwestern Journal of Technology and Intellectual Property* 150 (2010).
63 *Id.*
64 *Supra* note 62 at 162.
65 The United States code- title 35, 2018, s.171.
66 U.S. Patent And Trademark Office, Manual of Patent Examining Procedure (M.P.E.P.) s 1502.01 Revision 5, Aug. 2006, *available at*: http://www.uspto.gov/web/offices/pac/mpep/mpep-e8r5 1500.pdf (last visited on 10 August 2024).
67 *Supra* note 65.

patentability *i.e.*, novelty and non-obviousness.[68] In brief, the law does not give protection to only new designs or original designs, but to designs which satisfy both requirements.[69]

Presently design patents are given a fifteen-year term of protection from the date of grant of the patent.[70] Design patents protect the shape of an article, the surface designs on the article or the blend of the two.[71] The owner of the design patent has right against infringement[72] and additional remedy for infringement of design patent is also given.[73] The application for the design patent is filed with the USPTO.[74]

4.1.2. Drawbacks of Design Patent

The drawback relating to design patent are as follows:

i. The cost of getting it is very high;[75]
ii. The application process takes a very long time and by the time the design is granted design patent it would have lost its value in the market due to trend cycle in fashion industry,[76] that is why brands invest in design patents for products with high longetivity like handbags, shoes *etc.*;[77] and
iii. Also term of protection of design patents is too long for fashion designs as they would not benefit with such long protection due to trend cycle, that is new designs come in the market and old designs lose their value, so such long term of protection is not required for fashion designs;[78]
iv. A higher threshold of protection required for design patents including non-obviousness, ornamentation and novelty.[79]

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68 35 U.S.C. §102, 103 & 171.
69 *Supra* note 12 at 332.
70 *Supra* note 66, s.173.
71 U.S. Patent and Trademark Office, A Guide to Filing a Design Patent Application, *available at*: http://www.uspto.gov/patents/resources/types/designapp.jsp#def (last visited on 10 August 2024).
72 *Supra* note 66; *Egyptian Goddess, Inc*. v. *Swisa, Inc*., 543 F.3d 665 (Fed. Cir. 2008).
73 *Id*. at s. 289.
74 The ornamental design for a [insert the type of product (e.g., handbag, belt buckle, hat)].
75 Anya Jenkins Ferris, "Real Art Calls for Real Legislation: An Argument Against Adoption of the Design Piracy Prohibition Act" 26 *Cardozo Arts and Entertainment Law Journal* 567 (2008).
76 Kristin L. Black, "Crimes of Fashion: is imitation Truly the Sincerest Form of Flattery?" 19 *Kansas Journal of Law and Public Policy* 507 (2010).
77 Keyon Lo, "Stop Glorifying Fashion Piracy: It is time to Enact the Innovative Design Protection Act" 21 *Chicago-Kent Journal of Intellectual Property* 159 (2021).
78 Lisa J. Hedrick, "Tearing Fashion Design Protection Apart at the Seams" 65 *Washington and Lee Law Review* 222-224 (2008).
79 Uma Suthersanen, *Design Law: European Union and United States of America* 155 (Sweet and Maxwell, UK, 2nd edn., 2012).

With regard to novelty it is said that it is not every mere difference of cut, every change in outline, every change of length or breadth of configuration in a simple and familiar article of dress that constitutes novelty in design. There must not be a mere novelty in outline, but a substantial novelty in design having regard to the nature of the article. It cannot be said that there is a new design every time a coat or waistcoat is made with a different slope or different number of button; to hold that would be to paralyze the industry.[80]

People who support design patent for fashion apparels contends that it is better to protect the design through a design patent than to lose the design to the knockoff industry.[81] Further the knockoff manufacturers might continue to sell the old designs even when new designs come in the market, so trend cycle might not have a huge impact on selling of the old designs.[82] So a design patent protection of 15 years is useful. Further to assess infringement, the U.S. Supreme Court held that if in the eye of an ordinary observer, two designs are substantially the same, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.[83]

4.2. European Union

In EU, design is treated as a significant aspect of modern culture which is essential for the aesthetic needs of society.[84] If no sufficiently similar design existed before it was created, it must have been the expression of the author's free and creative choices.[85] So, in EU design is considered reflecting author personality.

4.2.1. The EU design framework

[80] *Le May* v. *Welch*, (1884) 28. Ch. D.
[81] S*upra* note 41 at 296.
[82] *Id.* at 297.
[83] *Gorham Co.* v. *White* 81, U.S. 511 (1872).
[84] European Commission, "Legal review on industrial design protection in Europe" 24 (15 April 2016).
[85] *Response Clothing Limited* v. *The Edinburgh Woolen Mill Limited*, [2020] EWHC 148 (IPEC).

In European Union, the design framework is governed by: Directive 98/71/EC on the legal protection of designs, known as the Design Directive[86] and the Council Regulation (EC) No 6/2002 on Community Designs,[87] known as the Design Regulation.[88]

The above stated documents mention the requirements for protection of industrial designs.[89] It defines the term design as – "the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation."[90] Designs which are "novel"[91] and have "individual character"[92] are given protection.[93] Designs are offered a five-year term of protection which can be renewed for a maximum of twenty-five years.[94] To check novelty of designs, design under consideration is compared to all the previous designs which is available in the public domain.[95]

For individual character, in a case where the issue was of copying of a design of a shirt protected by Design Rights, the Court of Justice of the EU held that the combination of all the different parts whose idea is taken from different people, designs gave the shirt a distinctive and individual character which set it apart from all designs that inspired the creation of the shirt. Here we see application of idea-expression dichotomy in interpreting individual character. [96]

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86 Design Directive 98/71/EC of the European Parliament and Council of 13 October 1998 on the legal protection of design, 1998 O.J. (L289) 28 (EC).

87 A Community design is directly applicable in each Member State whose aim is the protection of one design right for one area encompassing all the Member States.

88 Design Regulation (EC) No 6/2002 of the European Parliament and Council of 12 December 2001 on Community designs, 2002 O.J. (L003) 5 (EC).

89 *Supra* note. 86 art. 3; *Supra* note. 88 art. 4.

90 *Id. Design Directive* art. 1(a); Design Regulation art. 3(a) contains an identical provision.

91 *Supra* note. 86 at art. 4 - A design shall be considered to be new if no identical design has been made available to the public. Designs shall be deemed to be identical if their features differ only in immaterial details.

92 *Id.* at art. 5, A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public; Design Regulation art. 6(1) contains similar provision; *Karen Millen Fashions Ltd*. v. *Dunnes Stores* C-345/13[EU], in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.

93 *Id.* at art. 3(2) - A design shall be protected by a design right to the extent that it is new and has individual character.

94 *Id. at* art. 10.

95 *Easy Sanitaire Solutions Group Nivelles* v. *Office for Harmonisation in the Internal Market*, Case T15/13, 2015 [EU].

96 *Karen Millen Fashions Ltd.* v. *Dunnes Stores*, Case C-345/13, 2014 (EU).

In context of individual character, the meaning of informed user is provided by the UK Court in *Samsung* v. *Apple*,[97] which summarised the Court of Justice of the European Union's (CJEU) stand on it as:

i. He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller;[98]
ii. However, unlike the average consumer of trade mark law, he is particularly observant;
iii. He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned;[99]
iv. He is interested in the products concerned and shows a relatively high degree of attention when he uses them;
v. He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so;
vi. The informed user neither (a)merely perceives the designs as a whole and does not analyze details, nor (b)observes in detail minimal differences which may exist.

Thus, the concept of informed user must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.[100]

Shortly after issuing the EU Directive, the European Council adopted a Council Regulation on Community Designs.[101] Most significantly, the Council Regulation affords design protection to two distinct types of designs:

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97 *Samsung* v. *Apple UK Court of Appeal*, (2012) EWCA 133, paras 39-51.
98 *PepsiCo Inc.* v. *GrupoPromer*, C-281/10P, 2011 [EU] para 54.
99 *J. Choo (Jersey) Ltd*. v. *Towerstone Ltd.*, EWHC (Ch) 346.
100 *Id.*
101 *Supra* note 87.

i. The Registered Community Design Right,[102] an exclusive right for up to 25 years (based on 5 year renewable periods.[103]

ii. The Unregistered Community Design Right,[104] which is granted only a three year term of protection.[105]

4.2.2. Difference between the Registered Community Design Right (RCD) and the Unregistered Community Design Right (UCD)

While both enable the holder the ability to protect their design throughout the EU, the UCD is of a shorter duration (3 years) and offers only limited protection against duplication, whereas the RCD offers protection for a period of 5 years from the date of filing and can be renewed every 5 years for a maximum of 25 years of protection. The other main difference between RCD and UCD is that RCD aims to protect against both deliberate copying and the independent development of a similar design[106] while UCD only prevents intentional copying[107] that is if a second designer can demonstrate that she or he had no prior awareness of the existence of the protected design and had created the design independently, there are no grounds of infringement.

Advocate General in *PepsiCo Inc.*, said that the protection of designs under the Design Regulation "takes into account only the visual impression which the designs produce on the informed user."[108] The definition of a design set out in both the Design Regulation and the Design Directive refers to the appearance of a product, resulting from certain features. In the definition of design under Article 3 of the Design Regulation, the resultant effect is that protection is clearly restricted to visible elements, the product's appearance, and the visible parts of the products or parts of products.[109]

4.3. India

The Designs Act 2000 governs the registration and protection of industrial designs. The design right due to the aesthetic and ornamental features is called as

[102] *Id.* art. 1(2)(b).
[103] *Id.* art. 12.
[104] *Id.* art. 1(2)(a) provides that a design will be protected by an unregistered Community design if made available to the public in the manner provided for in the Design Regulation.
[105] *Id.* art. 11(1).
[106] *Id.* art. 19(1).
[107] *Id.* art. 19(2) The Council Design Regulation further narrows protection granted to unregistered designs by exempting subconscious copying as a contested use under Article 19.
[108] *Supra* note. 99 at para. 73.
[109] *Biscuits Poult SAS* v. *OHIM*, Case T-494/12, 2014 [EU] Para. 20.

copyright in the Design.[110] The statement of objects and reasons of Designs Act, 2000 indicate legislative intent to maintain balance between the interests of the proprietor to protect their designs of articles and the public interest to use the available shapes in commerce for further development and promote design element in the article of production.[111] So a limited time period for design protection is given, that is the copyright on a registered design is in total for 15 years. (10+5 years).[112] Beyond this period the designs cannot be protected. This keeps a check on monopoly.

The industrial design recognizes the creation of new and original features of new shape, configuration, surface pattern, ornamentations and composition of lines or colors applied to articles which in the finished state appeal to and are judged solely by the eye.[113] So a design contains aesthetics of the article which include different features.[114] These are applied to any article which should be produced by an industrial process of different methods (mechanical, manual, chemical). It tends to be a blend of these processes or the after effect of an individual one. The product which is finished should appeal to the eye. The design sought for protection must be new or original.[115] Remedies for piracy of registered design provided.[116] The term "new or original" appearing in Section 4 of the Designs Act which means that with respect to novelty of a design, a design which is copy of the previous published design lacks novelty. Mere variations/modifications that do not substantially alter a previously published shape or design, are not sufficient to bring novelty to the design.[117]

Designs must be seen as a whole, from the perspective of common consumer. Test is of visual appeal, and task is to see if essentials of that which makes it visually appealing have been substantially, but not necessarily exactly, copied. Novelty and

[110] *Micolube India Limited and Ors*. v. *Rakesh Kumar* MANU/DE/1251/2013.
[111] *Id.*
[112] *Supra* note 5, s. 11.
[113] *Id.* s. 2(d).
[114] Shape, Configuration, Pattern, Ornament, Compositions of lines or shadings.
[115] *Supra* note 5, s. 4(a).
[116] *Id.*, s. 22(2) and (1) - If any person acts in contravention of this section, he shall be liable for every contravention: (a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt (maximum up to fifty thousand rupees - Proviso), or (b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly.
[117] *Tarun Sethi & Ors*. v. *Vikas Budhiraja* 192(2012) DLT163.

originality are to be tested in context of aesthetic or visual appeal.[118] Here we see application of qualitative similarity in determination of design infringement.

Court laid guidelines to decide when there is imitation in a registered design. First, it is not necessary that there should be exact duplication of registered design, here we can take knockoff dresses as an example. Second, if the rival design has copied the qualitative aspect of the registered design which is the novelty of the registered design, essential features needs to be copied for design infringement. Third, if there is any similarity between the two designs, it has to be judged through the eye of the purchaser. Fourth, Court has to analyse if there are substantial differences between the registered design and rival design. If it is there it would not be design infringement. What needs to be seen if the visual features like pattern, shape are strikingly similar or not.[119] The design has to be looked as a whole and not minute details while deciding infringement. [120] The overall appearance is to be seen for deciding design infringement.[121] Further Court also gave design protection even when the design in itself was not novel but its application on the object was novel.[122] In a case the defendant had reproduced and replicated the clothes designed by Sabyasachi. Here defendant made liable for infringement of design for making copies of the plaintiff's designs.[123] In a similar case[124] defendant held liable for replicating plaintiff original designs.

5. Utilitarian Function of Fashion Apparel and Its Implication On Separability Doctrine of Copyright

Copyright separability doctrine and its relation to fashion apparels can be gauged from the point that an article of clothing, is denied copyright protection because it is utilitarian in its function.[125] The useful article doctrine applies to works that have features

[118] *Cello Household Products* v. *M/S Modware India*, AIR 2017 Bom. 162.
[119] *Kemp & Co.* v. *Prima Plastics Limited*, MANU/MH/0027/1999.
[120] *Castro India Ltd.* v. *Tide Water Oil*, (1996) 16 PTC 202.
[121] *Whirlpool of India Ltd.* v. *Videocon Industries Ltd., Appeal*, (L) No. 554/2012**;** *Havells India Limited* v. *Panasonic Life Solutions India*, CS(COMM) 261/2022; *Bulgari SPA* v. *Prerna Rajpal Trading* CS, (COMM) 341/2024 - Defendant had copied the artistic design of plaintiff jewellery and hence made liable for copyright infringement.
[122] *Troikaa Pharmaceuticals* v. *Pro Laboratories*, (2008) 49 (3) GLR 2635 - A tablet made in the shape of 'D' was given design protection.
[123] *M/S Sabyasachi Couture* v. *Anil Kumar Batra & Ors., CS(COMM) 1543/2016.*
[124] *M/S Reflect Sculpt Private Ltd. & Anr.* v. *Abdus Salam Khan*, CS(COMM) 278/2024.
[125] Tedmond Wong, "To Copy or Not to Copy, That Is the Question: The Game Theory Approach to Protecting Fashion Designs" 160 *University of Pennsylvania Law Review* 1142 (2012).

of both expression and function.[126] Clothing is a useful article, its core function being to cover and warm the body. Because of this reason it is said that fabric design is copyrightable as they come under art but clothing designs do not.[127] This useful-article aspect of clothing is the main strike against protecting the fashion apparels via copyright.

An interesting aspect under the utilitarian nature of fashion clothing is the aspect when the sole purpose of the design is to give a certain appearance or impression of the wearer. That is to make the wearer look attractive.[128] Designers can affect the perception of the shape of body parts through design choices, as shown below:

Source: http://www.marieclaire.co.uk/news/fashion/532781/kate-winslet-wows-in-another-body-con stella-mccartney-dress.html#index=1

In the above picture we see how by choice of design of the fashion apparel, features of human visual perception is exploited to influence the way in which the wearer's body is perceived.[129]

To draw attention to, a particular body part, the garment design is such that it includes a dominant design element over the body part that it covers when the associated garment is worn.[130] Now the question is would such a fashion apparel whose main purpose is to enhance certain features of the body, could such a clothing meet the creativity threshold or be a functional unprotected object?

It is suggested that a garment should not be treated functional only when it covers the body but also it should be treated as fulfilling a function when there is no design on

[126] Christopher Buccafusco and Jeanne C. Fromer, "Fashion's Function in Intellectual Property Law" 93 *Notre Dame Law Review* 68 (2017).
[127] *Supra* note 62.
[128] *Supra* note 126 at 55.
[129] *Supra* note 126 at 56.
[130] *Id.* at 59.

the dress per se as shown in the above picture but it is cut in such a way that it amplifies a particular body part of the person who is wearing that dress.[131] This clearly removes fashion apparels whose cut is only attractive on the body from scope of copyright protection. The doctrine use/explanation distinction[132] can be applied here. This doctrine distinguishes on the basis of usage of a work, that is when the expressive features of the work is used, then that would be protected by Copyright, but when the work is used for functional aspect, without regard to the expressive features of it, then no copyright protection to it.[133]

Now, let's see applicability of the separability doctrine in context of fashion designs in the three jurisdictions.

5.1. United States of America

Under the Copyright regime, the sketch of a garment is protected as a pictorial or graphic work, however the final product made out of the sketch itself is not given protection because it is treated as a useful article.[134] But when the final product design is such which makes it attractive or distinctive in appearance, then such design could be protected.[135] So the aesthetics of the design is protected by Copyright law.

A "useful article" is an article having essentially utilitarian function which is used not only for the visual appeal of the article.[136] Further Copyright protects those features of a useful article that can be identified separately from and are capable of existing independently of, the utilitarian aspects of the article.[137] This was applied by Court also.[138] The landmark case on separability doctrine was *Star Athletica, L.L.C.* v. *Varsity Brands, Inc*.[139] This case discussed copyrightability of graphics when applied on

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131 *Id.* at 70.
132 Ruth L. Okediji (ed.), *Copyright Law in an Age of Limitations and Exceptions* 380 (Cambridge University Press, New York, 2017).
133 *Id.*
134 *Supra* note 58, s.101; *Supra* note 57; *Baker* v. *Selden* 101 U.S. 99 (1880) - When the object is to 'use' merely, it is not granted copyright protection.
135 *Supra* note 58, s.130(1).
136 *Supra* note 58, s.101.
137 *Id.* at s. 101.
138 *International Inc*. v. *Collezione Europa USA, Inc*., 2010 U.S. App. LEXIS 17421 (4th Cir. 2010) - Universal sued Collezione for copyright infringement of Universal's furniture designs. Court determined that the designs of Universal's furniture designs were sufficiently original and showed original skill and labor and also the copyrights covered decorative elements that were separate from the shape of the furniture and, thus, eligible for copyright protection.
139 137 S. Ct. 1002 (2017).

a garment. It was held that the surface decorations that is the graphics on the cheerleading uniforms, had pictorial qualities. Second, the graphics which included colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms could be applied in another medium and so removing the surface decorations from the uniforms and applying them in another medium would not affect the utility of the uniform itself. So the decorations are therefore separable from the uniforms and eligible for copyright protection. So the graphics on the cheerleading uniform were copyrightable.[140]

But components of a garment which gives a certain appearance to the wearer is not protectable under copyright. An example of this is when the costumes are not given copyright protection as it was found they were coming under useful articles. The costumes utility was to portray the wearer as an animal and thus there was a useful function of the costume, so the artistic elements of the costumes are not separable on these facts from the costumes' utilitarian aspects. and thus no copyright protection for the costume design.[141] The fact that a useful article is attractively shaped does not render it eligible for copyright protection; only some non-useful features, which can be identified separately, might qualify for protection.[142] When the object is to 'use' merely, it is not granted copyright protection.

5.2. European Union

Article 7 of the Design Directive[143] and Article 8 of Council Regulation[144] talk about Designs dictated by their technical function and protection over them. Both the directive and regulation have similar provision with regard to this where it is said that: a design right and a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function. There are three main interpretative approaches to Article 7 of the Design Directive/Article 8 of the Design Regulation:

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[140] *Star Athletica, L.L.C.* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002, 1006 (2017).
[141] *Whimsicality Inc*. v. *Maison Joseph Battat*, 27 F. Supp. 2d 456 (S.D.N.Y. 1998); *Galiano* v. *Harrah's Operating Co.*, 416 F.3d 411, 414 (5th Cir. 2005) - It was held that casino uniforms could not be copyrighted because the aesthetic value of clothing cannot conceptually be separated from its utilitarian function, namely the necessity of wearing it to perform one's job adequately.
[142] *Supra* note 140; *Supra* note 62.
[143] *Supra* note 86.
[144] *Supra* note 88.

i. Pre-directive Amp approach/Functional approach: The first approach was adopted by the UK House of Lords in the decision of *Amp Inc*. v. *Utilux Pty Ltd*.[145] which excluded features which were solely for the function of the article.

ii. EUIPO's and General Court's multiplicity of forms approach: The level of functionality must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must not only be necessary but essential in order to achieve a particular technical result: form follows function. This means that a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.[146] But in TrekStor case[147] the EUIPO Board of Appeal rejected the multiplicity of forms approach and instead re-cast the functionality test as follows: "Article 8(1) of the Design Regulation denies protection to those features of a product's appearance that were chosen exclusively for the purpose of a product's function, as opposed to enhancing its visual appearance."[148]

iii. The EUIPO's designer freedom approach: Here focus on whether the designer has any creative freedom in making the design, and if the answer is in the affirmative, the design cannot be dictated solely by technical function.[149]

Application of this approach can be seen where Court said when the realisation of a subject matter has been dictated by technical considerations, rules or other constraints, which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work[150]

Recently the CJEU clarified its view on how to assess if a product appearance is solely dictated by its technical function.[151] It is held that the technical function should be the only factor which determine the design incorporated in the article, and if that is the case then no design protection over such feature. The CJEU confirms that the correct approach is one of "no aesthetic consideration"[152] instead of the "multiplicity of forms" test as

[145] *Amp* v. *Utilux*, (1972) RPC 103.
[146] *Koninklijke Philips Electronics NV* v. *Remington Consumer Products Ltd.*, C-299/99,2002 [EU].
[147] *TrekStor GmbH* v. *EUIPO ZAGG Inc*., Case T-564/20, 2020 [EU].
[148] *Ibid*.
[149] *International Edge, Inc*. v. *Blue Gentian, LLC*, FILE NUMBER ICD 9231 decision of the Invalidity Division, of 30/04/2014, XX/xx/ (europa.eu), (last visited on 1 May 2024).
[150] *Football Dataco and Others* v. *Yahoo! UK Ltd. and Others*, C-604/10, 2012 [EU].
[151] *Doceram GmbH* v. *CeramTec GmbH*, Case C-395/16, 2018 [EU].
[152] It is decisive if only technical reasons were used to design the product.

The CJEU made the point that, in multiplicity of forms" test, An applicant could, register various designs which have different forms but solely dictated by technical function. So presently the functionality test is used in EU for determining the overlap between useful articles doctrine with copyright and industrial design.

5.3. India

Section 2(d) of Designs Act 2000 mentions that: "the finished article appeal to and are judged solely by the eye." This means under Indian design law also, design protection is given to such design which appeals to eye but this does not clear whether the functional aspect of an article[153] is protected or not. But what is clear is that if an article has only functional aspect and no appeal to eye, it is not a design and hence cannot be protected under designs Act 2000.[154] Though under Copyright Act, 1957 we see mention of the doctrine that copyright doesn't protect functionality.[155] When an 3D object is based on a 2D drawing, and there is industrial application of the 3D objects functional part, such object would not be protected by copyright. Fashion designers sometimes first make the drawings of the designs of fashion apparels and then make the fashion apparels, so first part of this clause is satisfied, but if it is shown that clothes only have a functional part and no aesthetic function, then this clause can be applied.

6. Analysis

Let us first analyse the view of the proponents who are against copyright and design protection for fashion designs. Piracy paradox argument is put forth which says copying helps in demand of new designs in market as existing ones are copied. So low IP protection helps in innovation in designs. According to us it is difficult to agree with this piracy paradox view because if there is low IP protection, there would be low incentive to designers to create new designs, and if somebody is copying the designs, how can that be an incentive for the designers to create more such designs which could eventually be copied! A design emanates from designer so it shows a designer's personality, why would a designer let anybody copy that. So we don't agree with Raustiala and Sprigman piracy

[153] *Supra* note 114, s.2(a) – "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.
[154] *Id.*, s. 19(e) - a design can be cancelled if it is not a design as defined under section 2(d).
[155] The Copyright Act, 1957 (Act 14 of 1957), s. 52(1)(w).

paradox. Incentive to create new design cannot work on making your previous design available for infringement.

Further it is said that high IP protection would kill trend cycle. This argument is not tenable as rather through IP protection, designers would get the incentive to create more original designs as they would know their skill, labour, investment and creativity gone into making that design is protected against copyists. Copying undermine market for copied good, this is especially bad for small designers as they because of copying of their designs do not get return for their hard work, like a copied article having the design can be sold at less price than the original one, this reduces sale of original one and thus affect small designers. Though for knockoff goods, IP protection might not be of much use because knockoff goods are made for people who cannot afford high price of original designs of big designers, so people buy this knockoff goods and people who can buy the original like celebrities, they buy original only, so revenue of big designers not affected by knockoffs of their designs in market. Example of this is lehanga designs sold in chandni chowk which are close copies of big designers.

Now in USA, under copyright the fashion apparel is not protected but only the design on it if it is separable from the dress. Further Design Patents can protect the designs but the process to register a design under design patent can take time which would not be in consonance with fashion cycle that is, if a design is registered after its demand in market is reduced, it won't be much beneficial then to protect it, as fashion cycle consists of trends which stays for a very short time, one design can be in demand at one time, then a new trend comes and the previous design becomes obsolete. In such case, the investment made in registering a design under design patent would be not of much help, as a copyist would not even copy a design which is not in demand in market. This is also a point made by people who are against design protection, but if this can be remedied, then a strong point can be made for giving design protection to fashion designs.

Now under Design Patent requirement of originality, novelty and non-obviousness needs to be satisfied. For originality the standard as it is for copyright can be applied, for novelty it is seen if the design is not known in public. These both criteria would not be tough to satisfy for fashion designs, but to assess non-obviousness for fashion designs would be problematic as how to know that a prior design was obvious, since in fashion industry inspiration is taken from past works, so because of this nature

of fashion industry, applying non-obviousness standard for fashion designs would be tough.

Now in EU there is a clear unified design protection system[156] for designs in EU unlike USA. The design directive and design regulation protects designs. Criteria for protection is novelty and individual character. Novelty criteria is same as it is in USA under design patent, *i.e.*, a design should not be in public domain. The individual character criteria is related with overall impression on informed user. This informed user is someone between expert and consumer.

To explain individual character, let us imagine a picture of a sun and tree placed together on a T-shirt that it looks like a design on that T-shirt. Now the informed user does not have to see the sun and tree design in isolation taken from lot of designs, but see the earlier design having tree and sun as a whole and does this earlier design gives same impression as the present design which have tree and sun to informed user? If the answer is negative, then there is individual character in present design. So if both designs placed on the fashion apparel gives same overall impression, individual character is affected. Since in USA it was difficult to apply the non-obviousness standard for fashion designs, USA can learn from EU and apply the standard of individual character which seems perfect for giving protection to fashion designs as it is not a high standard as non-obviousness and ensures that the design has originality that is which is coming from the designer personality.

In USA since there is no present law for protecting fashion designs specifically and so protection has to be sought under other branches of IP like copyright and design patent which have their own limitations as giving protection to designs through copyright law is affected by the functional use of clothes and for design patent the criteria for getting protection is high. But in EU there is independent protection of designs under Design Regulation and designers do not have to depend on other branches of IP for protection. In USA specific law on protecting fashion apparels is needed while balancing the utilitarian aspect of clothes[157], which is a major factor of denying copyright protection to fashion apparels.

[156] `*Supra* note 88.
[157] *Supra* note 62 at 168.

Further in EU there is option of protecting unregistered community design, which is not in USA. The unregistered design rights help the small designers who do not have enough resources to keep up with registrations.[158] Even in India unregistered design is given protection by copyright law subject to the exception that the production of such design does not cross the threshold of 50 articles incorporating that design.[159]

Designers of EU have an added advantage, if their designs are copied intentionally and the designs are not registered, like fast fashion, the EU designers can file an infringement suit even without registering design, this would help in fashion industry which is based on fashion cycles, so even if it takes time to register a design, one can still file infringement suit if intentional copying is there, thus the unregistered community design right would help in punishing the copyists against infringement of design. India can learn from EU in this respect and make changes in design law to protect the small designers.

Comparison criteria for protection of designs in the three jurisdictions as given-

Countries and the documents	**Characteristics**
USA - [Design Patent] 35 U.S. Code § 171	Original and Novel
EU - [Directive on legal protection of designs 1998, Article 3]	Novel (New) and individual character
India - [Designs Act, 2000, Section 4&5]	New or Original

USA has higher threshold for design protection in comparison with India as both originality and novelty character is required but in India either of the two criteria needs to be fulfilled. In EU there is middle ground taken and this can be a good criterion for design protection for the reasons as mentioned earlier. In EU, what is required is that the design should not be in public domain and public should perceive the design different from previous designs, so creativity is required in making a different design from previous design so that it satisfies individual character criteria. In case of USA, the reason that it

[158] *Id.* at 169.
[159] *Supra* note 155, s. 15(2).

has such higher threshold for design protection is probably due to the availability of the provision of design patent along with design protection which is not available in India and EU.

All the three jurisdictions in their definition of design has focused on appeal to eye. So all the three jurisdictions focus on aesthetic criteria for designs, which is correct as design is for visual appearance and hence fashion design comes under design definition of all the three jurisdictions. Now when we compare definition of design of the three jurisdictions, we see EU and India design definition is quite similar but in USA under design definition, lines, colour, shape etc. are not mentioned, so USA design definition is not as comprehensive as India and EU design definition.

Further different threshold with regard to perspective for infringement of design is presented below-

Name of the Countries	**Whose perspective is mentioned for infringement of design?**
USA	Perspective of ordinary observer[160]
EU	Perspective of informed user[161]
India	Perspective of common consumer[162]

EU has a higher threshold as it mentions informed user. An informed user is more aware then a common consumer and so it is a higher threshold, one advantage of using this perspective can be that an accurate design infringement would be gauged. Now in India and USA, the standard is same, that is of common consumer and ordinary observer. Just from the point of perspective to show design infringement, this is a better approach then EU informed user approach as a design when goes in market, the common consumer sees it and purchases it, so design infringement should be seen from perspective of common consumer.[163]

[160] *Gorham* v. *White,* 81 U.S. 511 (1871).
[161] *Supra* note 86 art. 5(1); *Supra* note 88 art. 6.
[162] *Cello Household Products* v. *M/S Modware India & Ors.,* AIR 2017 Bom162.
[163] *Amritdhara Pharmacy* v. *Satyadeo Gupta,* AIR 1963 SC 449 - Reasonable Man's Test was formulated which said that a consumer is with average intelligence and imperfect recollection.

With regard to applicability of separability doctrine to fashion apparels, in the three jurisdictions, USA has strict application of separability doctrine in copyright law, EU has a clear application of this doctrine for designs and a strict application like USA is not there in EU in the sense in EU it is made clear that designs solely made for a technical function is not protected but in USA a broader term utilitarian aspect is used which affects protection for fashion apparels as fashion apparels has a utilitarian aspect also but this is subject to the fact that if the design is separable from the dress, then such design is protected by copyright.[164] So some respite given to protecting fashion apparels under copyright when they are affected by separability doctrine. Lastly in India separability doctrine is not clearly mentioned in either copyright or design statute as it is in USA and EU.

6.1. Suggestions

The author intends to put forward the following suggestions keeping in mind the above study:

6.1.1. Knockoff and Counterfeits in Fashion Industry

Knockoffs reduce demand of small designers as close copy of their designs is now available at low prices. Same is the issue with counterfeits. Further, if the knockoff version of the original design enters the market before the original is placed by the designer, consumers can be also misleading whether they are buying original designer work or a knockoff or counterfeit of it. So solution for this could be to support stronger copyright and design law protection to deal with the issue of knockoffs and counterfeits of fashion apparels but allowing the designers to work on the ideas and express it in their own designs.[165] So designers can be protected against copies and close copies of their designs by industrial design and copyright protection but no protection can be given against taking ideas or inspiration from other designers work.[166]

Especially in context of India artisans, their work is sometimes copied by larger fashion houses. These indigenous local handlooms contribute to the fashion industry, so there is a need for a mechanism that these artisans can also take the benefits of an

[164] *Star Athletica LLC.* v. *Varsity Brands Inc.*, 137 S. Ct. 1002 (2017).
[165] Elizabeth Ferrill and Tina Tanhehco, "Protecting the Material World: The Role of Design Patents in the Fashion Industry" 12 *North Carolina Journal of Law & Technology* 270 (2011).
[166] *Supra* note 45 at 1184.

industrial design and copyright protection. A solution can be that the registration mechanism for designs of these kind of artisans is made separate from the usual one, that is an easy mechanism for registration of work of such artisans with some officers can be deployed to help such artisans for registration of their work under Designs Act, 2000.

Also another issue with respect to rise of knockoffs and counterfeits in fashion industry is the reason that designers do not protect their designs as they feel that a design is affected by the trend cycle and so instead of spending on registration of that design, it is better to spend that money on making new designs. The trend cycle gives a short life span to the fashion apparel, so registering the design which takes time would not be of help as by that time the design is registered, knockoffs and counterfeits of the design would have come in the market and the design might have lost its prominence in the market. In India solution for this could be that specifically for fashion apparels and their registration as a design, there could be expedited examination of such design which would allow fast registration of such a design and then more designers would register their designs under the Designs Act, 2000 and this would then keep a check on knockoffs and counterfeits.

In EU we saw that for designs registration a fast track procedure is there. In 2 working days a design could be registered in EU under accelerated procedure if conditions required for that procedure is met. This is helpful to EU designers as they can register their designs which is not affected by the trend cycle. In USA also expedited examination for design applications is provided.[167]

6.1.2. Declaration For Non-Infringement[168] Within the EU Design Framework

Community design courts[169] have been given exclusive jurisdiction for certain aspects, one of which is declaration for non-infringement of community designs which is

[167] 37 C.F.R. § 1.155

[168] The basic requirements for initiating a non-infringement declaration can be summarised as follows:
i. The right owner gives a warning of IP infringement to the alleged infringer.
ii. The party warned or an interested party of the party warned sends a written reply to the right owner, requesting it to withdraw the warning or initiate litigation.
iii. The right owner neither withdraws the warning nor files a litigation within a reasonable period.
iv. The party warned or an interested party of the party warned can file a litigation with the court requesting a confirmation of non-infringement of IP rights.

[169] *Supra* note 88, art. 80 - The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by this Regulation.

subject to "if they are permitted under national law."[170] This can affect the unitary character of community designs and may also lead to forum shopping.

Unitary character is affected as the community design right is protected in all member states, so if in one member state with respect to the design right a declaration for non-infringement is allowed and not in other member state, so parties would go to such Member States' Community Design Courts which allow declaration for non-infringement, and this would lead to forum shopping apart from affecting the unitary character of community designs, that is equal protection of community design in all member states jurisdiction. One solution for this is to review this jurisdictional rule for Community Design Courts, and for this it is suggested that amendment in the Article 81(b) of the Design Regulation could be done, the words "if they are permitted under national law" could be deleted so that declaration for non-infringement could be filed in any member states Court. The implication of this could be that declaration for non-infringement could be taken in any member state and so would deter forum shopping.

6.1.3. Strong IP Could Lead to Sustainable Fashion

Strong IPR could reshape global sustainability when we see it from lens of sustainable fashion. Knockoffs and counterfeit goods lead to more demand which leads to more production of clothes which in turn contributes to degradation of the environment and its resources. So if strong IP protection is there for fashion designs, this would lead to less demand of knockoffs and counterfeit apparels by retailers as shell life of original design would increase as now selling counterfeited apparels could lead to infringement action against such retailers and so the implication would be that less production of counterfeited designs would be there and hence contribute to sustainable environment.

6.1.4. Issue with Pecuniary Damages Under Designs Act,2000

Under Section 22(2)(a) proviso, it is said that any design infringer as a contract debt has to pay money to the registered owner of the design which should not exceed Rs. 50,000. Though there is no such limit when the registered owner of the design brings a suit for damages and injunction.[171] It is suggested that this bifurcation is not required in Section 22(2)(a) and 22(2)(b). This threshold of rupees 50,000 can be altered as it

[170] *Id.*, art. 81(b).
[171] *Supra* note 5, s. 22(2)(b).

undermines the value of designs which includes fashion apparels, especially Haute Couture fashion apparels whose value is much higher.

6.1.5. Term of Protection

Due to the fashion cycle, there is a limited shelf life of a fashion apparel and thus copyright protection long term protection to it is not of much help, rather it could create a monopoly over a design which could affect innovation in context of designs. Similarly, industrial design protection which is not long as copyright but is long enough for a fashion designs. Solution for this can be reduction in term of protection for fashion apparels specifically which can be added as an exception to term of protection given under copyright and industrial design in general, this can solve the issue of over protection of fashion apparels under IPR regime. For example in USA different bills[172] for protecting fashion designs are introduced but not yet passed, they talk about giving protection to fashion apparels for 3 years.

6.1.6. Design Protection by IPR and Its Implication On Securitization of IP

In respect of keeping one's IP as a security to get credit, it can be seen from design perspective. So third party who would issue credit to a right holder in a design, would not venture into giving credit for such an IP whose copying is possible and rampant like designs. So design protection through IPR become important so that for securitization of a design, the person giving credit can be assured that he would be able to generate revenue from that design if need arises, if there is no adequate IPR protection for the design, there would be rampant copying which would affect the revenue generating capacity of the design. So for securitization of a design, the solution is adequate IPR protection to such designs which is done through copyright and industrial design protection under IPR.

6.1.7. Limiting Applicability of Separability Doctrine On Works Focussing On Aesthetic Taste

Although the fashion apparels are made for aesthetic purpose but it also has functional aspect since they are wearable and can be protected by copyright. The looks we see on big fashion events like Met gala where dresses have long trails, three-dimensional designs which can include large flower embellishments *etc*., have aesthetic

[172] Design Piracy Prohibition Act 110th Cong. (2007).

and expressive features, they are not used for functional aspect *per se*, so such categories of dresses can be protected by copyright. These works have goal of serving aesthetic taste, and such works can be protected by copyright.[173]

7. Conclusion

Thus from the above discussion it can be concluded that the proponents who are against copyright and design protection for fashion apparels, put forth the theory of "piracy paradox" which according to these proponents promote new designs as status of existing designs reduced because of low level or no IP protection. Also a point is made that if the copy of the design reaches local public, then it can be assumed the design is a success. Also lifecycle of a fashion apparel or design is less, so long copyright or design protection would not be of much help. All these points made by proponents who are against IP protection of fashion apparels do not justify that IP protection is not needed for fashion apparels. This can be proved by the points put forth by the proponents who support copyright and design protection for fashion apparels.

Copying affects innovation in designs and this directly attacks the piracy paradox as this paradox says copying motivates designers to create more but they do not take account of the point that copying can undermine the market for original designs and thus affect profitability for that designer and this mostly affects small designers. Further for Haute Couture dresses, copyright and design protection would be helpful. So to conclude, according to our analysis copyright and industrial design protection is important for fashion apparels.

To analyse the applicability of the utilitarian doctrine of copyright on fashion apparels, first the protection given to fashion apparels and designs in the three jurisdictions was described under copyright and design regime where comparatively EU and India has a *sui generis* law for design protection which is not there in USA. It is surprising as New York is considered one of the fashion capital of the world!

One of the main differences is that the European Union has registered and unregistered community design rights that provide protection for garments and accessories as a whole. That simply does not exist in the United States and this is a big advantage that European designers have over US designers. This helps the small

[173] *Supra* note 138.

designers as they do not have to worry about registering their designs to protect it from infringement. This is something which both India and USA can learn.

With respect to application of copyright protection for fashion apparels, the issue of separability doctrine in light of utilitarian nature of clothes was analysed. The applicability of this doctrine specifically mentioned in USA and EU. Design protection for fashion apparels can be managed with utility function of clothing by giving sui generis protection to fashion designs as given in European Union, which USA can also adapt instead of depending on copyright and Design Patent law for protecting designs. Further application of such doctrine on clothes can be limited when the object of the design is seen. So when certain elements are added only for appearance perspective in the dress, even though such elements cannot be separated from the dress like a long trail, such dress should not be denied copyright protection just because it has utilitarian use.