

# FASHION

## Dossier

Vol. 1 2016

WHAT CAN  
YOU PROTECT?

DESIGN  
OR  
COPYRIGHT?

Examples of  
Design Protection

COPYRIGHTS



J Choo (Jersey) Limited  
Vs. Towerstone Limited and Others

BEST PRACTICES

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Enforced?



TRADEMARK

Red Sole of Christian Louboutin

Karen Millen Fashions Ltd.  
V. Dunnes Stores and Ors.



ANAND & ANAND

# WHAT CAN YOU PROTECT?

## Designs:

'Design' means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article by any industrial process

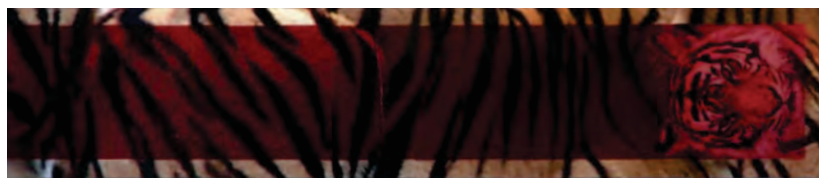
Industrial process could be manual or mechanical

whether two dimensional or three dimensional or in both forms

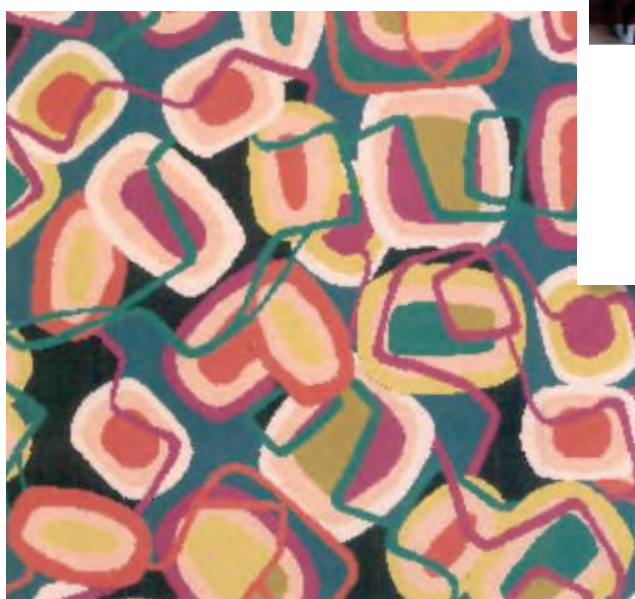
**Comments:** In order to apply for design protection for your work, the designer/artist must ensure:

- That the design is new or original
- The design should not have been previously published in India or any part of the world
- The design should relate to features of shape, configuration, pattern or ornamentation applied or applicable to an article. Drawings, layouts, illustrations cannot be protected under the Design law
- Design protection granted for a total period of 15 years (The initial period of registration of 10 years may be extended by further period of 5 years).
- This is the strongest form of protection for fashion designers. If you file for design protection prior to launch of your product, you acquire an exclusive right over the design for a period of 15 years and can easily prevent third parties from copying.





Genesis colors Pvt. Ltd  
Registered Design no 209100  
**Title: Textile Fabric**  
Date of Registration 26.03.2007



Genesis colors Pvt. Ltd  
Registered design no 216124  
**Title: Textile fabric**  
Date of registration 30.04.2004

# EXAMPLES OF DESIGN PROTECTION



Genesis colors Pvt. Ltd  
Registered Design no 209101  
**Title: Textile Fabric**  
Date of Registration 26.03.2007



Tahiliani Design Pvt. Ltd  
Registered Design no 208634  
**Title: Dress Material**  
Date of Registration 23.02.2007

# COPYRIGHTS

- **Copyright** is a right given by the law to creators of original artistic work

- **An artistic work means-**

*a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality or any other work of artistic craftsmanship;*

**Comments:** You may apply for and claim copyright protection in:

- Your sketches, drawings, art work
- Copyright in artistic work means the exclusive right to reproduce the work, communicate the work to the public, issue copies of the work to the public, include the work in any cinematograph film and make any adaptation of the work.
- Protection granted for life of author and 60 years from the date of demise of the author

# DESIGN OR COPYRIGHT?

DESIGN



COPYRIGHT

Need to register to claim protection

Subsists inherently

Need to file prior to any publication

Can be filed even post publication

Has to be "NEW"

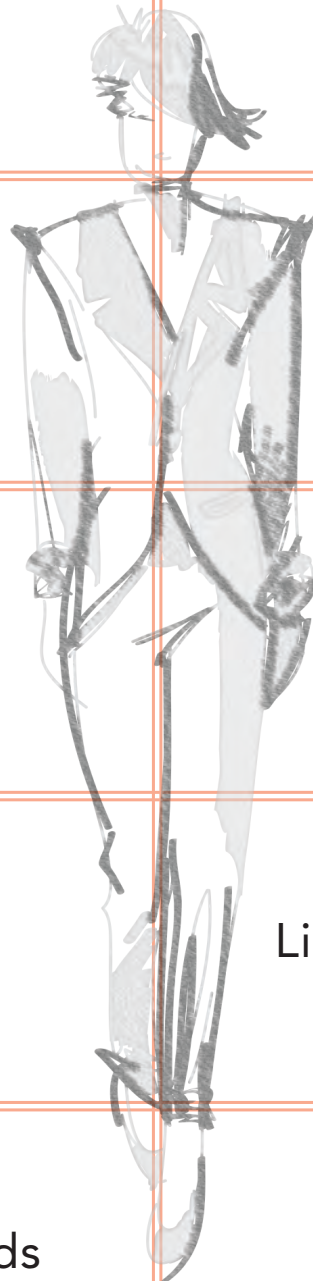
No requirement for novelty

Maximum 15 years

Life of author + 60 years

Only in respect of goods registered for

Is not goods specific





# TRADEMARK

- 'Trademark' means a mark capable of being represented graphically and is capable of distinguishing the goods or services of one person from those of others and includes a device, brand, heading, label, name, signature, word, letter, numeral, shape of goods, packaging or combination of colour
- The Red Sole of Christian Louboutin protected as a trademark in India:
- Epi Leather of Louis Vuitton



**Comments:** You may apply for and claim trademark protection in:

- Your name, collection name, trading style
- Initial registration for 10 years, can be renewed till perpetuity every 10 years
- You may claim trademark rights in an article or design if the same has acquired distinctiveness

Examples of trademark protection on the basis of acquired distinctiveness

- Shape of Birkin bag protected in India as a trademark:



# WHAT HAS BEEN ENFORCED THROUGH COURTS- TREND OUTSIDE INDIA

J Choo (Jersey) Limited Vs. Towerstone Limited and Others, England and Wales High Court (Chancery Division), Decided on January 16, 2008

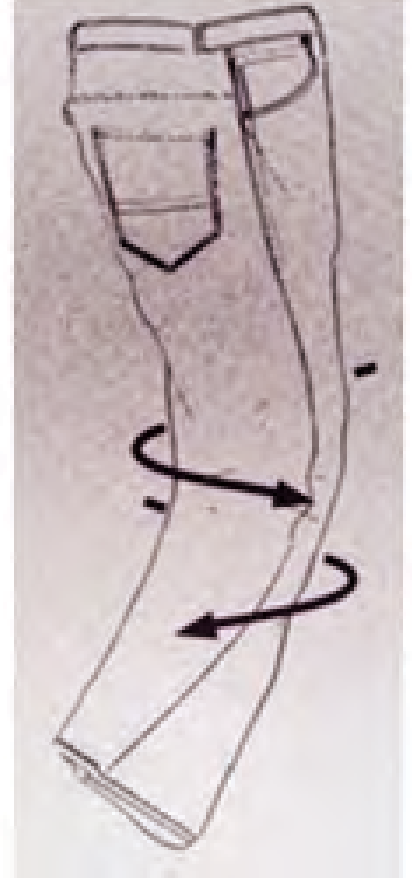
- **T**he case involved the sale of imitation of the Jimmy Choo 'Ramona' bag by the Defendant from its Oxford street store.
- Upon comparing the two bags under consideration, the court was of the opinion that a detailed inspection may reveal difference, however, the overall impression of an informed user was identical.
- Infringement of registered design was therefore confirmed.
- To prove infringement of the unregistered designs the claimant needed to demonstrate copying of the original design document for the handbag. Given the multiple similarities between the bags, the creative freedom of the designers, and noting the wide publicity the 'Ramona' had received, the court held that the inference of copying was "overwhelming".
- As explained in that case, the appropriate approach to determining infringement of a

registered design is to identify the informed user and determine what he would know about the design corpus, then to identify the overall impression given by the design, to do the same for the alleged infringement and to ask whether the impression given for the two are the same or different, rather than clearly different.



# G-STAR RAW CV Vs. RHODI LTD & ORS, ENGLAND AND WALES HIGH COURT (CHANCERY DIVISION) DECIDED ON FEBRUARY 6, 2015

- This was an action for infringement of unregistered UK Design right. The case relates to the claimant's 'Arc' jean design. The defendant, 'Voi' brand of jeans was accused of infringing the 'Arc' jean design of G-Star.
- The Judge held that all 9 of the Voi products were copied from and made substantially identical to all the 'Arc' designs of G-Star.
- The defendants in the instant case challenged the subsistence of design right in the 'Arc' jean design. They denied copying and any knowledge of the alleged infringements.
- The court held that, "This account was clear, compelling and supported by both contemporary documents, including original pattern pieces which were produced for inspection in court. On the basis of this evidence, and having regard to other undisputed facts which mean that the criteria contained in section 213(5) of the CDPA are satisfied in the present case, in my judgment it is plain that unregistered design rights subsist in the Arc Pant Designs (see section 213) and that G-Star is the owner of those rights (see section 215)."
- The judge found the similarities between the defendants' jeans and the claimant's as "striking".





## Vs. Dunnes Stores and Ors., [2014] WLR (D) 273

- Karen Millen, a fashion label developed a striped shirt. In 2005, Dunnes made copies of Karen Millen's garments and, in 2006, started selling them under its "Savida" label.
- Dunnes admitted copying the garments. However, Dunnes challenged the validity of Karen Millen's unregistered community design on the basis that it lacked "individual character".
- Dunnes contended that the shirt was only a combination of features drawn from a number of earlier designs, such as a grey Dolce & Gabbana knit top and a Paul Smith blue striped shirt.
- Dunnes alleged that it was for Karen Millen to prove that its unregistered community design had individual character.
- It was held that "Article 6 of Council Regulation ... 6/2002 ... on Community designs is to be interpreted as meaning that, 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".
- The court concluded that "Article 6 of Council Regulation ... 6/2002 ... on Community designs is to be interpreted as meaning that, 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".
- Held to be infringement.



# WHAT HAS BEEN ENFORCED THROUGH COURTS TREND IN INDIA

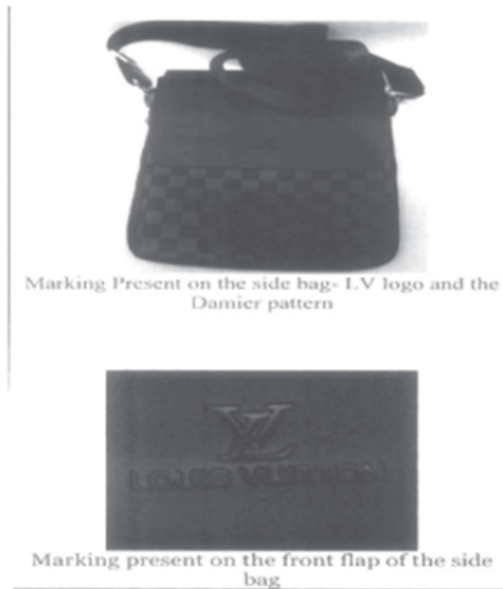
Pranda Jewelry Pvt. Ltd. And Ors. Vs. Aarya 24 kt and Ors.,  
Suit No. 2477 pf 2011 decided on April 1, 2015

- Plaintiffs alleged that their unregistered designs of gold sheets were copied and reproduced by the defendants thereby infringing their copyrights
- Held that, "From evidence on record that what was produced by Plaintiffs' with use of artistic work contained in original drawings is a reproduction in a particular material, namely, in gold plate and in a particular form, namely, a three dimensional form. What was produced was artistic work itself. This work, even if not registered, ought to enjoy a full protection under Copyright Act. Besides, images in gold plates were themselves artistic works in which Plaintiffs' have copyright, quite apparat from base drawings which were used to make them. Any imitation of these images in gold plates or indeed any material was clearly violative of Plaintiffs' copyright in them."
- Injunction granted.



# Louis Vuitton Malletier Vs. Manoj Khurana and Ors., CS (OS) No. 1668/2013; Decided On: 20.08.2015

## Counterfeit sold by the defendants


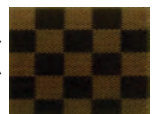


## Plaintiff's Registered Trademarks being infringed



- The Plaintiff filed a suit to restrain the Defendants from infringing its registered trademarks and from passing off the Defendants' products as those of the Plaintiff, and diluting and tarnishing the famous and well-

known marks of the Plaintiff as caused by the Defendants' misuse.

- The Defendants who were permanently restrained in this case were held to be selling counterfeit Louis Vuitton products bearing multiple registered trademarks of the Plaintiffs and the samples purchased from the Defendants bore such marks which infringed the Plaintiff's marks namely,
  - "Louis Vuitton", the LV logo (  ) and the LV "Damier pattern" (  ).
- It was also pertinently reckoned by the Hon'ble Court that since only the exclusive retail outlets of the Plaintiff are authorized to sell original Louis Vuitton goods, therefore where LV goods are found to be sold outside such exclusive stores, the same shall be considered as counterfeit.

# Hermes International and Anr Vs. Sahil Malik and Anr., CS (OS) 1859/2012

*"Wherein an injunction was granted on 20th June, 2012 "*

- The suit was filed by the Plaintiffs claiming trademark protection for its registered shape mark in the famous "Birkin" bag against its misuse by the Defendants for identical goods.



- It was observed that the "Birkin" bag is characterized by its unique shape, pattern and contouring which is widely recognized throughout the world including in India.

- Since the Defendants were selling handbags which were



nearly identical and deceptively similar to the Plaintiffs' registered three-dimensional shape trademark of a "Birkin" bag, the Defendants were restrained through an ex-parte injunction order from using or displaying on their website, the objectionable shape of the bags amounting to infringement of the registered trademark of the Plaintiffs and passing off the Defendants' goods as those of the Plaintiffs.

# DOMAIN NAMES

On the subject of Domain Names, Indian courts have repeatedly relied on the proposition of law as elucidated in the case of **Marks and Spencer Vs. One in a Million**, (1998) FSR 265.

In the said case, it was held that any person who deliberately registers a domain name on account of its similarity to the name, brand name or trademark of an unconnected commercial organization must expect to find himself on the receiving end of an injunction to restrain the threat of passing off.

Therefore, since the name and trademark MARKS & SPENCER could not have been chosen for any other reasons than to associate with the well known retailing group, it is to be assumed that the public is likely to be deceived by the Defendant's use of the domain name <http://marksandspencer.co.uk>. Someone seeking or coming upon a website called by the said name would naturally assume that it was that of the Plaintiff.

# BEST PRACTICES

- File an application for design registration prior to the launch of the collection or its publication in any form. Once the application for design registration is filed, the collection can be showcased.
- In case of a couture collection, where the designer is confident that more than 50 copies of the article will not be made, copyright registration can be sought in such collection.
- Though copyright subsists inherently, for any criminal action, a copyright registration is required. A civil copyright infringement action can be filed even though there is no copyright registration.
- Symbols such as ®, TM and © must always be used wherever applicable.
- It is of utmost importance to have strong employment contracts with your artists and designers. Clauses related to copyright assignment must be present in the employment contract in order to avoid any dispute related to the ownership of the work.
- Confidential information must be protected adequately in all vendor contracts. Protect trade secrets exhaustively through such contracts.
- Trademark your name, name of collection, unique packaging in order to create exclusivity.
- You may trademark a unique design or even a product if you have evidence to show acquired distinctiveness and exclusivity.
- Internet Domain Names in various forms must ideally be registered to ensure adequate protection.
- Be vigilant and take immediate action against copycats.

This edition of the Fashion Dossier focuses on the nature of protection you may seek for your designs, artistic work and the remedies that you have against unauthorized copying.

The reading should be treated as illustrative and a difference in facts could have different results.

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