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# Design Protection in Fashion Industry

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## ABSTRACT

*The intellectual property rights grant legal and exclusive rights to the creator of a product for its artistic work and such protection is further extended to designs in the fashion industry. the main objective of the design act is to provide protection to the three-dimensional features, patterns, aesthetics and appearance of the product. Since the inception of the fashion industry there have been many cases of infringement of the design of the product with made it essential to enforce legislation which was aimed towards the protection of the designs by the creator and this practice has been adopted by various high-end fashion brand. The author in this article has attempted to answer the question: The protection of Design in the fashion industry on the basis of analysis of laws and regulatory bodies established to protect them in various jurisdiction and the overlapping of other intellectual property rights which are adopted by these designers to protect their designs. In order to understand this question, it becomes essential to understand the regulatory framework established in order to protect these designs. This article focuses to prove the same by analysing the design legislations and various other intellectual property rights to protect the design, commercial aspects of the registered design and its scope in the fashion industry.*

## I. INTRODUCTION

Design adds value to a specific product and this aspect helps the product look more attractive and appealing to a consumer. Further, it also helps the product to be distinguished amongst other competitors and becomes an exclusive selling point. This characteristic makes it essential for the protection of design as it is valuable to the creator and becomes a vital part from the strategic point of business. Registration of such design helps provides exclusive rights to the design right holder giving an opportunity to compete with other competitors and commercialize such registered design and is an integral part of intellectual property protection, including other intellectual property rights. In the recent time aesthetics, creativity and the design play an important role for visual association with the consumers of the product. Due to the tremendous competition in the market, it becomes essential to protect the

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designs in order to monopolise or further commercialize the product in order to main the brand image and the interest of the designer of such product. Appearance plays an important role in order to attract consumers as it is due to its unique appearance which makes the product appealing for example the Kelly Bag from Hermes creating an identity in the market. Further, protecting the design of a product under design legislation protects it from being infringed from counterfeiting and other malpractices. It grants exclusive rights to the owner of such registered design which are new and original under the design legislation. The Hague System deals with the registration of design at an international level to the member countries who are signatory to the same. The protection of the design gives an opportunity to the creator to commercialize the product by licensing or assigning such products. As, the times are evolving it becomes essential to protect these designs from infringement and with this provide an opportunity and incentive to the designer to contributing such original products in the market.

## **II. THE FASHION INDUSTRY AND INTERNATIONAL REGISTRATION UNDER WIPO**

The fashion industry is one of the highest revenues generating industry this characteristic makes this one of the most integral modules in terms of global trade. The fashion industry thrives on the creativity of the content in comparison to other industries such as films, publishing etc. as it needs further innovation in order to attract the consumers and this aspect of the industry makes it essential to protect the intellectual property as it involves in the process as it is crucial for bringing in innovation in order to avoid the standardized products in the market. The Hague system of TRIPS agreement deals with the registration of design at an international level. Total of 91 countries are a part of this system however, India is not a signatory member. A total of 29 international designs were registered by WIPO in the year 2007, under the class 2 of the Locarno Classification which is specified under the Hauge System. In the European Union the registration of such designs was not limited to clothes but it also accessories such as watches, bags etc. which falls under the purview of Locarno classes of registration, this act becomes an integral role in terms of generating income for these high-end brands<sup>2</sup>. Most of the designers working in the industry are of the view that as the season of fashion is limited to a few months and this season constantly changes, they are of the opinion that the registration of such design for a period of five years does not work in their favour as the process is time and money cumbersome. Most of the designers only opt for protection after the designs have been counterfeited. But contrary to this opinion various

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<sup>2</sup> IP and Business: Intellectual Property in the Fashion industry, WIPO, (2009).

high-end labels have been benefitted from the protection granted to the design and further helped commercialize the brand<sup>3</sup>. The example of the famous Kelly Bag under the label of French Fashion House Hermes has a waiting period of over a year due to its unique appearance and based on this uniqueness the consumer is willing to wait for such a long period of time in order to avail the product which proved to be a success in terms of commercializing the product. Another example of a successful design registration is that of the Chanel suit which was designed by Coco Chanel in the year 1930 and till date no other fashion house has succeeded to create this classic design one of the key reasons being its strong IP protection. Considering these examples registration of industrial design is the most credential way to protect the design from being imitated successfully provided by the Hague System of industrial design protection in its relevant market.

### **III. DESIGN PROTECTION IN THE FASHION INDUSTRY: THE USA**

In the USA, in terms of granting protection particularly to the fashion industry there is no organization which is established pertaining to the same however, there are certain IP rights which grants protection to such fashion design which includes, design patents, copyright, trade dress and trademark. These forms of protection are only applicable to certain designs and only limited number of designs can avail its benefits. The US Copyright law has historically not provided any kind of protection to designs and was more directed towards granting protection to art, music, literature, etc. It only protected certain articles which was termed useful according to them. The reason for not providing protection to such items was because it didn't qualify to become a functional item but certain elements such as graphic, sculptures etc. were provided protection under the same<sup>4</sup>. The US Courts have further refused to extend the protection of copyright to items relating to the fashion industry as laid in the case of *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, stating that the aspects which are creative in clothing cannot be distinguished from that of functionality.

Further, the Trademark act grants IP protection to the logos and trade names which are distinguishable source of a product. As a word, symbol, logo may be granted protection under the act under the USPTO, most of the high-end labels depend on this in order to protect their logo as there is no specific provision which is extended to protect the designs, fashion designers usually rely upon the trademark protection under such circumstances for the packaging, color, etc of their product. Trade dress is granted protection under the trademark

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<sup>3</sup> William T. Fryer II., *International Industrial Design Law Developments*, 4 373 (1993).

<sup>4</sup> Casey L. Tripoli, *Fashion Forward: The Need for a Proactive Approach to the Counterfeit Epidemic*, 41 *Brook. J. International L.* 875 (2016).

law for a product representing visual attributes and not the functional aspect of the same. Further in the case of *Walmart Stores v. Samara brothers*<sup>5</sup>, the Supreme court in this case granted recognition to namely two categories of trade dress for the product design and product packaging, provided that the product package which has been granted protection must be of distinctive nature further stating that the main product will not be granted the protection as it is not inherently distinctive in nature. The condition for granting protection which was determined by the courts were that both the design and packaging must be identified by the consumers.

The main issue with trade dress is that a particular design or product seeking protection under the same may be granted if the same is associated by the public specifically in the fashion industry but this is rarely availed by them as it fails to achieve iconic recognition in the relevant market in order to acquire the status of trade dress. The signature lacquered red sole of Christian Louboutin has significantly acquired the protection of trade dress. In the case *of Christian Louboutin v. Yves Saint Laurent*<sup>6</sup>, the eminent distinctive red sole of Louboutin's shoes was successful in acquiring the secondary meaning under trade dress due to its association of the public adding it to be the feature of the brand making it eligible in acquiring protection under the trade dress which falls under the purview of trademark protection.

In terms of granting protection of the product the patent law provides significant protection to the functional aspect of the fashion design or the elements of the design which are an innovation further satisfying the criteria for patenting of an invention<sup>7</sup>. Under the US Patent Act, it provides protection to the design of shoes, jewellery, hand bags etc., under design patent for a period of fifteen years. Design patent grants protection to the conceptual aspect of the product and not the product provided that such product is novel and non-functional nature. Even though design patent may be granted to a product it does not provide protection to certain articles of the fashion.

#### **IV. DESIGN PROTECTION IN THE FASHION INDUSTRY: EU**

In comparison to the protection provided to the design in the fashion industry under the IP law in the U.S, EU grants protection to such design under the domestic and the European Union. The specific EU Design Protection Directive grants a monitoring framework to the

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<sup>5</sup> Walmart Stores v. Samara brothers, 529 US 205 (2000).

<sup>6</sup> Christian Louboutin v. Yves Saint Laurent, 778 F.S.D.N.Y. (2011).

<sup>7</sup> Emma Yao Xiao, The New Trend: Protecting American Fashion Designs through National Copyright Measures, 28 Cardozo Arts & ENT. L.J. 417 (2010).

registered designs in the European union. Under this directive design is defined on the basis of the appearance of the product which forms a specific feature of the product such as colours, shape, texture, contours, etc. In order to be eligible in securing protection for a design it is essential that such design in question must be new and have an individualistic characteristic which must be visible during the normal use of the product. In furtherance to this the EU Regulation grants protection to such registered design for a period of five years which may be renewable for the period of twenty-five years and the period of protection of an unregistered design is a period of 3 years. It further requires the member states to implement procedures and remedies which will be essential to enforce the IP protection granted under design protection in order to provide specific rights in case of infringement of such IP rights, with commerce of trade and take action against individual infringing such rights<sup>8</sup>. The successful protection of the same is provided to the eminent 'Kelly Bag', designed by Hermes.

The first case in the European Union where a designer applied the design rights under IP against a counterfeit was Yves Saint Laurent. In the case of *Yves Saint Laurent v. Ralph Lauren*<sup>9</sup>, for infringement of design, copyright and unfair competition and was awarded compensation for an amount of \$395,090.78. In the case of *John Kaldor Fabricmaker UK Ltd. v. Lee Ann Fashion Ltd*<sup>10</sup>, filed a suit for infringement of copyright and Unregistered Community Design infringement alleging that the defendant had made alteration to one of its design in order to create a fabric design for another designer. Even though the design shared a massive resemblance the court rejected this claim on the basis that the fabrics were a common area of design which clarifies the limited protection granted to the unregistered designs highlighting the importance of registration of designs in order to gain protection from infringement. There have been a significant number of cases where designers have implemented their design rights against infringers this depicts that the designers are aware of their rights and the protection which is granted for the registered designs. Further, it also clarifies the disadvantage and limited rights that are associated with unregistered designs, this could signify that the designers are satisfied with the limited rights which are granted to the same. This is also associated with the continuous change in the fashion industry with each season which discourages designers to acquire rights for the designs for a longer period of time through the process of registration as unregistered design under its limited rights can gain

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<sup>8</sup> Daryl Wander, Trendsetting: Emerging Opportunities for the Legal Protection of Fashion Designs, 42 Rutgers L.J. 247 (2010).

<sup>9</sup> Yves Saint Laurent v. Ralph Lauren, 696 Fd 206 (2012).

<sup>10</sup> John Kaldor Fabricmaker UK Ltd. v. Lee Ann Fashion Ltd, 3779 EWHC (2014).

protection from counterfeiting<sup>11</sup>. However, the long-term protection which is provided for the registered design would be more beneficial for the designers as it would help create a unique design and also giving the designers an opportunity to commercialize the design and generate revenue. But most of the designers do not prefer registration as designs constantly changes within a span of time and believe that the protection which is granted under unregistered design would suffice. Hence, the rate of registration of design in the European Territory is low in spite of the advantages of registration is because majority of the designers are satisfied by the protection which is granted for unregistered design for a period of six years<sup>12</sup>.

## **V. DESIGN PROTECTION IN THE INDIAN FASHION INDUSTRY**

In assessment with the protection granted to the design industry in the EU and the USA, India's position in granting this protect is not apar. In order to grant protection for the designs, the designers of such design have successfully established the Fashion Foundation of India studying various aspect of the industry. It further has legal department assisting the design houses to deal with matters pertaining to IPR, licensing etc, which is similar to the Fashion originator's guild in the USA. The legal framework under the same protects the creativity of such designers in the industry. The designers in the industry have been depended on the traditional and indigenious design and have continued to work with the same ideas understanding its importance in the international market and protecting their design in the market. These traditional designs were limited to the geographics of the region for its distinctive method of dyeing, embroidery for designs such as chikan kari, phulkari etc. which had a market presence due to its uniqueness and the existence of this ancient design made important to protect under the Intellectual property law<sup>13</sup>. The protection to such designs is granted under the Design act, 2000, the Geographical indication of Goods Act, 1999 and the Copyright Act, 1957. These distinctive legislations grant protection to various characteristics based on the apparel and accessory. For instance, the artistic work relating to the design is protected under the Copyright Act, 1957, as it is classified as the non-functional aspect of the product. Further, under the Design Rule of 2001 of schedule three it provides an exhaustive list of articles to be visited while application of such product, granting protection for a period of 10 years which can be extended additionally for 5 years. Further considering the diversity of India and the indigenious form of art, the current act of GI act, 1999 extends protection to

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<sup>11</sup> Matthew S. Miller, Piracy in our Backyard: A Comparative Analysis of the Implications of Fashion Copying in the United States for the International Copyright Community, 2 J. International Media & ENT. L. 133 (2008).

<sup>12</sup> Francesca Montalvo Witzburg, Protecting Fashion: A Comparative Analysis of Fashion Design Protection in the United States and the European Union, 107 Trademark. 1131 (2017).

<sup>13</sup> Pranjal Shirwaikar, Fashion Copying and Design of the Law, Journal of Intellectual Property Rights Vol 14, (2009).

the same under schedule four of the act depicting the protection extended to the apparel<sup>14</sup>. Under the design act it provides remedies against piracy of designs which are registered.

In the case of ***Ritika (Ritu Kumar) Private Limited v. Biba Apparels Private Ltd***<sup>15</sup>, both the companies are well distinguished in the ethnic apparel sector. The main contention in this case was that the defendant had infringed the copy right by printing, publishing, reproducing and selling the design and garments which were produced by the plaintiff. The defendant contended that these designs were not registered under the Design Act, 2000 and copyright ceased to exist as there were more than 50 copies for the product in question. The courts in the present case held that the plaintiff was not entitled to enforce both design act and copyright for its original drawing as there were more than 50 copies which were produced and hence laid that there was no infringement in the present case.

Further, in the case of ***Christian Louboutin v, Mr. Pawan Kumar & Ors***<sup>16</sup>, is an important case as Louboutin is one of the high-end brands for the unique designs of its shoes. The defendant in this case is accused of selling the counterfeited products of the brand at a cheaper rate which led to sabotaging the brand name and the investors of the company. Louboutin is globally distinctively recognized for its Red Sole shoes making it one of the most expensive products in the sector and is protected under the trademark laws. The defendant started selling the counterfeited product of the red sole shoes with different colour scheme. The plaintiff claimed for injunction and compensation from the defendant for the sale of such counterfeited product. The courts in the present case made the defendant liable to pay a sum of Rs. 10.72 lakhs and banned the further sale of such counterfeited product. The infringement in the case of Louboutin is a successful example which lays the importance of protection of designs in the fashion industry. As the investment involved in the fashion industry is higher in order to create a product and making it available in different market it becomes essential in order to protect the same under the IPR. Further in order to commercialize these designs it becomes important for the design to be registered under the design act, which would help the designer to marginalize the product by licensing or assigning these products to the third party.

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<sup>14</sup> William T. Fryer II., International Industrial Design Law Developments, 4 Fordman. Media and Entertainment L.J. 373 (1993).

<sup>15</sup> Ritika (Ritu Kumar) Private Limited v. Biba Apparels Private Ltd, 230 SCC (2016).

<sup>16</sup> Christian Louboutin v, Mr. Pawan Kumar & Ors, 403 SCC (2018).

## **VI. OVERLAP OF OTHER INTELLECTUAL PROPERTY RIGHTS FOR PROTECTION OF DESIGN IN THE FASHION INDUSTRY**

After analysing the protection of design in the Fashion industry in different countries namely the USA, EU and India it is pertinent to note that each territory has its domestic legislation established in order to grant protection to this creative product which further provides exclusive rights to the design right holder. It has been established is that the design protection is not limited under the Design Act, but it further extends to Copyright, Trademark, Patent and Geographical indication on the basis of the practice in the territory in question. The USA is well known for its fashion industry and is home to various high end fashion brands from Coco Chanel to Louis Vuitton. However, the Design Act has not been enforced by the USPTO and most of the designers and fashion industrialists seek protection under other intellectual property right namely, trademark, trade dress, copyright and patent to protect the design. The use of these rights has played a crucial role to grant exclusive protection to the design right holder. But the non-existence of design legislation creates a barrier in terms of recognition to the original design of the product and the protection which is granted under other IPRs have certain limitation in order to provide protection to the design of the product<sup>17</sup>. Further, EU has enforced Design Protection directives which grants protection to the specific feature of a product. Apart from the protection which is provided under the directives for registered designs it also grants protection to the unregistered design for a period of three years. In EU the majority of designers opt for non-registration of the designs are they are of the opinion that the protection granted under the same is satisfactory for their interests. In India the protection of such designs is granted under the Design Act, 2000 and it further extends to patent, copyright, trademark and geographical indication depending upon the choice and interest of such design innovators. It is studied that even though various territories which have specific Design legislations for the protection of designs, the innovators often seek protection under the other IPRs which clarifies that it is dependent on the interests and convenience of the designers which leads in IPRs overlapping in order to provide protection to the design product<sup>18</sup>. Therefore, in order to provide IPR protection to the design product not only under Design legislation but it also extends protection under other IP depending upon the interest of the Design innovator there is an overlap of intellectual property in the design industry.

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<sup>17</sup> Laura Fanelli, A Fashion forward Approach to Design Protection, 85 St. John's L. Review. 285 (2011).

<sup>18</sup> Jasmine Martinez, Intellectual Property Rights & Fashion Design: An Expansion of Copyright Protection, 53 U.S.F. L. REV. 369 (2019).

## **VII. 3-D PRINTINGS AND INTELLECTUAL PROPERTY RIGHTS IN THE FASHION INDUSTRY**

In the recent years there has been a surge in the use of 3-D printing in the fashion industry and one of the countries which is leading in this practise is Philippines, raises an issue of the legal aspect of intellectual property right protection of these designs and its infringement. As the functioning of the 3-D printing can produce an exact print of a design or a product without having to compensating the original creator or designer of such product. It is also capable of providing the exact replicas of the designs, products or materials which is distinguished for its unique feature. Further, the designs or products which have trademark of high-end brands which carry trademarks or which are patented can be replicated without the license being granted by the original creators of such products which will not provide the originator to commercialize their design. The concept of 3-D printing is based on the tangible expression in order to print the prior design or the use of CAD which was already created by the designer by scanning such design which involved human creativity. The Philippine Intellectual property law CAD can be determined as a literary from of work becoming eligible for protection under copyright on the basis of interpretation of the courts<sup>19</sup>. For instance, the dress designed by Alexander McQueen called Voss for the purpose of displaying it in the Metropolitan Museum of Art, made exclusively for display of art was produced by the help of 3-D painting this would not only lead to infringement but also have an impact on the artistic purpose of the dress. Fashion industry involves huge investment and if this practice of 3-D printing is further used at a large scale this would diminish the entire purpose of creating new designs and would not even provide the creators an opportunity to monopolize such design. This practice would complicate the entire functioning of the fashion industry strangling the economic and moral rights of the creators by infringing their intellectual property right. The only alternative to deal with this issue would be to allow the creators to commercialize the use of this source by licensing the design and enforcement of design protection act to protect the interest of the creators.

## **VIII. SUGGESTION**

The fashion industry is one of the highest revenues generating industry at a globally. The industry works on the basis of design, products, packing and the unique characteristics which is produced by the designers. It is essential for extending IP rights to apparels in order to

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<sup>19</sup> Noel G. Ramiscal, You Can 3D Print Your Dress and Wear It Too: A Seminal Look at the Possible Legal Issues of 3D Printing in the Philippine Fashion Industry, 60 *ATENELO L.J.* 1045 (2016).

promote innovation and novelty in the industry. With evolution of time, it becomes essential to take into consideration the current issues and implement the same in order to protect the interests of the creator. The rights provided under the IP gives the creator an opportunity to create monopoly of the product. Due to the nature of the industry, it is more prone to face issues regarding piracy, counterfeiting of the product, copyright infringement. In order to protect the industry, it is essential to make more stringent legislations for the infringer of the rights and the design. Even though the Hague system grants protection at an international level it still lacks to provide protection in countries which are not a part of the convention so there is a need to have a regulatory framework for maintaining the same. The industry replies on various IPR in order to avail protection for their design however, the protection which is granted under design act is not usually accepted or they do not have design legislation in their specific country for e.g., the USA. Further, it has been noted that even though there are design legislations available to protect the design it is not adopted by the designer as they feel it is time and cost consuming in the case of EU. There is a constant overlap between various rights which makes it essential to have a legislation to ensure and promote design laws in the industry is followed equally encouraging the designers to register their designs and giving them an opportunity to commercialize the product. With the evolving time and the period of 3-D printing it becomes essential to enforce various rights in order to protect the interest of the creator. The policies must be changed on the basis of the changing time and based on study not only at domestic but also at a global level implement policies protecting the rights of design and have a standardized platform for regulating the same.

## **IX. CONCLUSION**

Fashion industry has significantly evolved over the recent years with the onset of liberalization which is being strengthen by the enforcement of law. However, the designers are not interested in protecting their designs as they are of a view that such process will be time and cost consuming. This is also due to lack of a proper regulatory framework which will help protect their rights and meet their interest. There are many high-end fashion brands such as Christian Louboutin, Coco Chanel, Hermes etc have been successful in protecting their distinctive product and design from falling prey to counterfeiting and piracy of their product due to successful implementation of the IP rights in several cases they have been successful in obtaining permanent injunction in case of infringement. It is difficult to prevent the counterfeiting of the products but it is essential that there is stringent action and compensation to be provided under such circumstances. It is also important for the creators of such products be made aware of the protection granted under the law and encourage

registration of the product. As fashion industries operate at a global level it is essential for certain amendments in the international system of registration of such designs. Even though, the availability of design protection the designers opt for other mode of IP protection as they feel that those protect would help grant better protection to their design depending upon the interest. It is very important that the designer must be able to commercialize the design as it is novel and innovative. As this takes a lot of investment and further there are stakeholders in the industry it is essential that the policies help them earn generate the profits. There must be certain protection which must also be extended to unregistered design as it may be so that the designer may not have resources to register the same. With the changing times and innovation of new ways for e.g., 3-D printing it becomes crucial to implement new regulations in order to deal with infringement under the same. Therefore, in order to protect the interest of the designer and to avoid the overlap of IPR while dealing with issues regarding to design protect in the Fashion industry it becomes essential for implementation of regulatory framework in order to grant fair protection to the creators of such designs.

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