
SAFEGUARDING AESTHETICS: LEGAL REMEDIES AGAINST DESIGN PIRACY IN INDIA

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ABSTRACT

Industrial designs constitute a vital component of intellectual property, protecting the aesthetic and visual features of products that enhance consumer appeal and commercial value. However, with globalization and rapid market expansion, the piracy of registered designs has emerged as a serious challenge, undermining innovation and distorting fair competition. This paper examines the scope and significance of design protection within the intellectual property framework, focusing on the problem of design piracy, which involves unauthorized reproduction or imitation of registered designs. It also highlights the interface between design protection and copyright, which often complicates enforcement. The study evaluates the rights conferred on proprietors of registered designs, particularly their entitlement to restrain unauthorized use and seek remedies such as damages, monetary compensation, and injunctive relief. These remedies not only redress violations but also serve as deterrents against infringement. Attention is also given to jurisdictional complexities and defences commonly raised in design disputes, reflecting the practical challenges of enforcement. By analysing statutory provisions and judicial interpretations, the paper underscores the importance of a coherent and effective legal framework to safeguard industrial designs from piracy. The findings reveal that robust enforcement preserves economic interests, promotes creativity, and sustains healthy competition in the marketplace. Ultimately, the paper advocates for stricter regulatory mechanisms and dynamic judicial approaches to address emerging issues in design protection, ensuring that intellectual property law continues to balance innovation with public interest in an evolving commercial environment.

Keywords: Industrial Design, Design Piracy, Intellectual Property Rights (IPR), Remedies, Injunction, Damages, Jurisdiction and Enforcement

I. INTRODUCTION:

Intellectual property pertains to creativity and innovation of the human minds which have been classified into two parts; (i) copyrights and (ii) industrial property¹ (other than copyrights); thus, industrial design is an industrial property. The purpose of protection is that to safeguard the inventor/creator to acquire acknowledgement for his work and procure monetary advantages. Thus, Intellectual property aims at shaping the environment for the advancement and development of the growth of creativity and innovation. An Industrial Design means the physical appearance of the product by adding stylistic features to it in the form of configuration, ornamentation, shape or pattern to a finished article which is done through industrial process.²

Industrial design has been defined under section 2(d) of the Designs Act³ as “*only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device; and does not include any trademark or any copyright work*”

Examples:

Let's break down examples for each of the designs that have been mentioned:

- (a) Shape:** curved Coca-Cola bottle⁴, Gillette razor, parker pen etc.,
- (b) Pattern:** Louis Vuitton LV pattern, saree motifs, Floral patterns on fabric, zig-zag designs on tiles, or geometrical prints on wallpaper⁵.
- (c) Configuration:** The arrangement of pockets on jeans, button layout on a remote control, or knob placement on washing machines.⁶

¹ DR. G.B. REDDY'S, INTELLECTUAL PROPERTY RIGHTS AND THE LAW 15 (11th ed. 2021).

² V.K. AHUJA, LAW RELATING TO INTELLECTUAL PROPERTY RIGHTS 211 (3rd ed. 2022).

³ Designs Act, 2000, Section 2(d), No. 16 of 2000 (India).

⁴ Bharat Glass Tube Limited v. Gopal Glass Works Ltd., (2008) 10 SCC 657

⁵ S. S. Products of India v. Star Plastics, AIR 1987

⁶ Rotomac Pen Ltd. v. Milap Chand & Co., 1999 (19) PTC 757

(d) Ornament: Carvings on wooden furniture, embellishments on jewellery, or engraved motifs on steel utensils.⁷

(e) Colours applied to any article: The red sole of *Christian Louboutin shoes*, a tricolour packaging on goods, or dual-tone colouring of footwear⁸;

***Red Bull* cans – blue & silver colour combination⁹;**

***Coca-Cola* – red & white colour scheme¹⁰;**

***Cadbury Dairy Milk* – gold & purple packaging.**

Thus, each industrial design has special characteristics and value for protection of the design and recognition for the creator of that design.

II. RIGHTS GRANTED TO DESIGN HOLDER:

The registration of an industrial design confers upon its proprietor an exclusive legal right over the visual features of a product, such as shape, configuration, pattern, or ornamentation. These rights primarily aim to safeguard the aesthetic appeal of the article, thereby distinguishing it in the marketplace and enhancing its commercial value. Once registered, the design holder enjoys the sole authority to apply the design to the class of articles for which it is registered and to prevent unauthorized reproduction or imitation by others.

In essence, registration grants the design holder a monopoly right for a specified period, usually ten years (extendable under law), during which no other person may manufacture, sell, or import goods that embody the protected design without consent. This ensures that the proprietor can capitalize on the investment made in creativity and innovation. In addition to market exclusivity, the rights also empower the design holder to seek legal remedies, such as injunctions, damages, or accounts of profits, against infringers.

Thus, the legal rights of a design holder act both as a shield against piracy and as an incentive for creators, striking a balance between protecting individual innovation and promoting fair

⁷ Cello Household Products v. Modware India, 2017 (72) PTC 527

⁸ Relaxo Footwear Ltd. v. Aqualite Industries Pvt. Ltd., 2014 (60) PTC 113

⁹ Red Bull v. Rohidas Popat Kapadnis & Anr, CS(COMM) 512/2023

¹⁰ Colgate Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd., 2003 (27) PTC 478

competition in the marketplace.

The Law vests certain other rights in the proprietors of the Registered Designs which are as follows:

1. COPYRIGHT IN DESIGN:

One of the exclusive rights conferred on a design is called “Copyright in Design”. However, this should not be confused with the exclusive rights granted for literary, artistic or dramatic works which is also termed as “copyrights in such works”.

In simple words, an artistic sketch will fall under copyrights and applying that sketch in making an article like ornament for commercial sale will fall under copyrights in design.

But there is an overlapping area of the applicability of designs and Copyrights Act as both of them cannot be applied co-terminously (i.e.) at the same time, for protection of same subject matter.

2. PIRACY OF REGISTERED DESIGNS:

The piracy of registered design has become a common practice in the global landscape, posing a crucial threat not only to the economic growth of industries but also to the very essence of industrial design protection. Protecting unique design characteristics is pivotal, as these elements often define the visual attraction of products. This article delves into the criteria of protection, examining the consequences in the event of design piracy, and explores the ongoing challenges faced by design proprietors striving to safeguard their creations from unauthorised use and design violations. In a world where infringement of design is a persistent challenge, understanding the intricacies of this issue becomes imperative.

As per the Designs Act, 2000, **Section 22**¹¹ deals with the Piracy of Registered designs. According to this section, a piracy means;

Section 22(1)(a) - any obvious or fraudulent imitation of a design that is already registered without the consent of its proprietor is unlawful;

¹¹ Designs Act, 2000, Section 22, No. 16 of 2000 (India).

Section 22(1)(b) – it also prohibits the import of any material which closely resembles a registration design without the consent of its proprietor;

Section 22(1)(c) – publishing such articles or exposing terms for sale with knowledge of the unauthorized application of the design to them also involves piracy of design.

In *Kestors Ltd. v. Kempat Ltd.*¹², it was held that where a registration has been made in respect of a design which lacked novelty or originality on the ground that the design was a mode or principle of construction or a mechanical device or on other grounds, there cannot be any infringement of the copyright.

Thus, to remember this, let's break it down in several instances of piracy of design as under:¹³

- Unauthorized application of the registered design or other articles, for sale;
- Any fraudulent imitation of the design;
- Any obvious imitation of the design without consent of proprietor;
- Importing an article and selling it along with the registered design, without the consent of the registered proprietor;
- Publishing a pirated design as owned by an unauthorized person etc.

In *Whirlpool of India Ltd. V. Videocon Ltd.*,¹⁴ the court stated that the defendant by merely using some different colour scheme and putting some different lines or having some different ornamentation but imitating the basic shape and configuration of the plaintiff's design i.e. rectangular shape on one side and semi-circular shape on the other side with jettison panel for knobs for which the plaintiff had registered designs, had imitated the registered designs of the plaintiff and, as such, the plaintiff's rights were violated. The defendant had imitated the striking and novel factor of the plaintiff's designs, which factor could be referred as "capricious".

¹² *Kestors Ltd. v. Kempat Ltd.* (1936) 53 RPC 139

¹³ *PepsiCo Inc. vs. Hindustan Coca Cola Ltd.*, 2003 (27) PTC 305

¹⁴ *Whirlpool of India Ltd. V. Videocon Ltd.*, 2012 (52) PTC 209

In fact, any unauthorized application of the registered design or a fraudulent or obvious imitation thereof to any article covered by the registration for trade purpose or the import of such articles for sale is a piracy or infringement of the copyright in the design.

3. RIGHT TO PROTECT THE DESIGN FROM PIRACY:

- Misusing and infringing a design are “piracy of design”.
- Any person responsible for infringing the monopoly of the proprietor of a registered design is guilty of piracy and is liable to fine, apart from the liability to pay damages.
- The aggrieved proprietor may file a suit for recovery of damages or for injunction against the repetition of such piracy.

4. REMEDIES AGAINST THE PIRACY OF REGISTERED DESIGN:

The Designs Act provides two alternative remedies to the proprietor of registered Design under Section 22(2). The proprietor has to elect one of them:

(a) MONETARY COMPENSATION: Section 22(2)(a)¹⁵:

To pay the registered proprietor a sum not exceeding Rs. 25,000/- as a contract Debt; for every contravention recoverable. But the total sum recoverable in respect of any one design shall not exceed Rs. 50,000/-.

PENALTY PER CONTRAVENTION:

For each act of Infringement (unauthorized use of the design), the infringer may be liable to pay up to Rs. 25,000/-.

Maximum cap: For one Registered Design Rs. 50,000/- even if multiple infringement of the design.

Recoverable as a Contract Debt means the registered proprietor can directly file a suit for recovery of money, similar to recovering unpaid debt under contract law.

¹⁵ Designs Act, 2000, Section 22(2)(a), No. 16 of 2000 (India).

EXAMPLE: If someone copies your design of a chair & makes 10 chairs we can only claim Rs. 25,000/- (we can't claim Rs. 25,000 X 10 = Rs. 2,50,000/-). But maximum rupees per Design is capped at Rs. 50,000/-.

Thus, Section 22(2)(a) deals about fixed compensation (recoverable like a Debt, without needing to prove actual loss which is quick and easy to recover). If a proprietor wants more than Rs. 50,000/- they must proceed under Section 22(2)(b) for (i) injunction and damages/profits (civil suit), (ii) No fixed cap (claim actual damages), (iii) Regular Civil Procedure (longer & costlier).

(b) LEGAL ACTION FOR DAMAGES AND INJUNCTION: Section 22(2)(b)¹⁶:

The proprietor may bring a suit for the recovery of damages for any such contravention and for an injunction against the repetition thereof.

If he Succeeds, he will be entitled to recover such damages as may be awarded by the court and restrain the defendant in terms of the injunction granted by the court.

4.1 INJUNCTION AND DAMAGES:

4.1.1 INTERLOCUTORY INJUNCTION:

An interlocutory injunction (also called temporary injunction) is a court order granted at an interim stage of a case, preventing a party from doing certain acts until the case is finally decided. The main objective is to preserve the subject matter and prevent irreparable harm during the pendency of litigation.¹⁷

The Plaintiff may seek Interlocutory Injunction during the pendency of Suit under Rule 1 & 2 of Order 39 of the Civil Procedure Code (CPC), 1908¹⁸:

Order 39 deals with Temporary Injunctions and Interlocutory Injunctions

Rule 1 deals about “cases in which temporary injunction may be granted”;

¹⁶ Designs Act, 2000, Section 22(2)(b), No. 16 of 2000 (India).

¹⁷ Niki Tasha P. Ltd. V. Faridabad Gas Gadgets P. Ltd., AIR 1985

¹⁸ Code of Civil Procedure, 1908, Order XXXIX, Rule. 1 & 2, No. 5 of 1908 (India).

Rule 2 deals about “Injunction to restrain repetition or continuance of breach”.

The plaintiff must prove the following principle to claim Interlocutory Injunction:

- (i) **Prima Facie case:** the first principle is whether the plaintiff has made out *prima facie* case. In other words, the Plaintiff must show a strong case in their favour that deserves trial. In *Escorts Construction Equipment Ltd. V. Action Construction Equipment Pvt. Ltd.*,¹⁹ the court stated that to establish a prima facie case, the party seeking ad interim injunction should show that there is a credible dispute with respect to a right title which it seeks to protect and it has a real prospect of succeeding in its claim at the trial.
- (ii) **Balance of convenience:** the second principle is whether the balance of convenience is in favour of the plaintiff, that is to say whether, it would cause greater inconvenience to the plaintiff if the interim injunction is not granted than the inconvenience to which the defendant will be subjected if it is granted. In other words, the balance of hardship should favour the plaintiff, i.e., refusal to grant injunction would cause greater harm to the plaintiff than inconvenience to the defendant.
- (iii) **Irreparable loss or injury:** The third principle is to ascertain whether the plaintiff would suffer irreparable loss and injury if the prayer for grant of temporary injunction were refused, i.e. the plaintiff must show that damages (monetary compensation) would not be adequate, and harm would be irreparable without an injunction.

Interim Injunction was refused in *Britannia Industries Ltd. V. Sara Lee Bakery*,²⁰ as the applicant failed to make out a *prima facie* case against the respondent and the balance of convenience also lay in favour of respondent. The ability of respondents to pay damages in the event of a decree in favour of the applicant was also a factor which tilted the scales against the applicant.

¹⁹ Escorts Construction Equipment Ltd. V. Action Construction Equipment Pvt. Ltd., 1999 PTC 36

²⁰ Britannia Industries Ltd. V. Sara Lee Bakery, 2001 PTC 23

4.1.2 SUPPRESSION OF MATERIAL FACTS: NO INJUNCTION

Injunction is not to be granted where plaintiff does not go to the court with clean hands. Where the plaintiff suppresses the material facts, the court may refuse to exercise its discretionary power of grant of interim injunction.²¹ In *S.P. Chengalvaraya Naidu v. Jagannath*,²² the Supreme Court held: A litigant who approaches the court, is bound to produce all the documents executed by him which are relevant to the litigation. If he withholds a vital document in order to gain advantage on the other side than he would be guilty of playing fraud on the court as well as on the opposite party.

4.1.3 FINAL INJUNCTION:

If plaintiff succeeds at the trial in establishing infringement of registered design, the defendant will get permanent injunction to restrain future infringement because there is always a possibility of recurrence of such infringement²³. In exceptional cases, however, if it can be definitely shown that there is no such likelihood of any recurrence, then an injunction may be refused.²⁴

4.2 DAMAGES:

Damages refer to monetary compensation awarded by a court to a party who has suffered loss or injury due to the wrongful act of another²⁵.

The plaintiff in an infringement suit is entitled to recover damages where he establishes infringement. The measure of damages will be as followed by assessing:

- (i) Loss caused to the plaintiff by the defendant's wrongful conduct;
- (ii) A practical method of assessing damages is to assess them on the basis of reasonable royalty upon all infringing articles made and sold by the defendant.

Alternatively, damages may be assessed to compensate plaintiff for the loss of sales suffered by him on "account of the sale of infringing articles by the defendant," or other

²¹ M/s Seemax Construction (P) Ltd. V. State Bank of India, AIR 1992 Del 197.

²² S.P. Chengalvaraya Naidu v. Jagannath, (1994) 1 SCC 1

²³ Calico Printers Association Ltd. V. Savani & Co., AIR 1939

²⁴ Proctor v. Bayley & Son, (1889) 6 RPC 538

²⁵ Tobu Enterprises v. Johinder Metal Works, AIR 1985

damages caused to him through reduction in price etc. Thus, the plaintiff has to prove the mark is registered; and have to prove that the defendant knew/had received notice of existence of design (before infringing the plaintiffs design).

4.3 ACCOUNTS OF PROFITS:

A Remedy in design piracy remains relatively rare, the court tends prefer interim injunction/permanent injunction. Requires the infringer to disclose all documents of profits derived from sales involving the infringing design. This enables the court to order the defendant to forfeit unjust gains - not compensating for loss, but stripping away wrongful profits earned. This promotes justice by ensuring the infringer does not benefit from wrongdoing. Thus, the court can direct the defendants to maintain an account of profits during the pendency of the infringement suit. In *Three-N-Products Private Limited v. Manchanda Enterprises*,²⁶ the court directed the respondent to maintain the accounts in respect of its sale until the suit was decided.

III. JURISDICTION, PASSING-OFF AND DEFENCES IN INFRINGEMENT:

(i) JURISDICTION:

The suit or any other proceeding for relief under **Section 22 of the Designs Act, 2000**²⁷ is to be instituted in a District Court having Jurisdiction.²⁸ **Section 20 of the Civil Procedure Code (CPC)**,²⁹ a civil suit can be instituted at a place where the defendant resides or carries on business or where the cause of action arises.

However, where the defendant avails any of the grounds on which the registration of a design may be cancelled under Section 19, the court shall transfer the suit or such other proceeding to the high court for decision.³⁰

(ii) PASSING-OFF:

There is no remedy which is being saved either in the form of common law of passing off or

²⁶ Three – N – Products private limited vs. Machanda Enterprises, 2002 (25) PTC 607 (Cal)

²⁷ Designs Act, 2000, Section 22, No. 16 of 2000 (India).

²⁸ S.S. Products of India v. Star Plast, 2001 PTC 835

²⁹ Code of Civil Procedure, 1908, Section 20, No. 5 of 1908 (India).

³⁰ Designs Act, 2000, Section 22(4), No. 16 of 2000 (India).

otherwise on the basis of any equity which can be said to be legally enforceable right available to the party. The remedy is purely statutory in nature.³¹

In *Kemp and Company v. Prima Plastics Ltd.*,³² the court observed that it would be seen that in order to establish goodwill and distinctiveness in a particular get up, there must be something more than mere similarity between the goods themselves. Mere copying is not to pass off. If a person copies shape or configuration or get up of other person's goods or article, by itself it cannot be said that he has made false representation. No one is prevented from copying and selling an article in the market provided he does not make a false representation suggesting that the article which he is selling is in fact that of plaintiff.

(iii) DEFENCES IN INFRINGEMENT SUIT:

Defences available for Defendant are as follows:

- (a) The defendant can deny that there was nothing alleged by him;
- (b) That the design applied by him was materially different from the registered design;
- (c) That the defendant applied the design with the consent of the registered proprietor of the design;
- (d) That the plaintiff is not the proprietor of the design;
- (e) That the registration of the design is invalid as in fact there was no design as claimed within the definition under Section 2(d).
- (f) The design was design was not new original or had been previously published or registered in India;
- (g) The design was in an unlawful condition.

In *Mohammad Abdul Kareem v. Mohammad Yasin*,³³ the Allahabad High Court held that entry of a person's name in the register as the proprietor, did not conclusively make him the registered

³¹ Micolube India Limited v. Rakesh Kumar Trading as Saurabh Indus, 2012 (50) PTC 161

³² Kemp and Company v. Prima Plastics Ltd., 2000 PTC 96

³³ Mohammad Abdul Kareem v. Mohammad Yasin, AIR 1934 All 798.

proprietor. It was only prima facie evidence that he was the proprietor and this could be rebutted by adducing evidence to the contrary. This principle was confirmed in *Dwarkadas Dhanji Sha v. Chhotalal Ravicarandas and Co.*,³⁴ and *Niki Tasha P. Ltd. v. Faridabad Gas Gadgets P. Ltd.*³⁵

IV. RECENT CASES ON PIRACY OF A REGISTERED DESIGN:

(a) Crocs Inc USA Vs. Baba India Ltd. & Ors:³⁶

U.S. Company Crocs filed this case against Bata India, Liberty Shoes, Relaxo footwear and Action shoes. (for infringement of registered design). The Designs are related to perforated and non-perforated designs. The court examined prior publications and market availability of similar footwear. The plaintiff's design was already published worldwide before registration in India, thus lacked novelty at the time of registration which is a precondition for a valid design. Thus, the plaintiff's design could not be protected under the Act. Thus, the court cancelled crocs registered design in India. The Injunction sought by crocs were denied. The court favoured the defendant.

(b) Raghul Mishra's "Tigress" Motif Vs. John Doe:³⁷

Designer Raghul Mishra's sought legal action when machine-made copies of his hand-embroidered "Sundarbans tigress" pattern. The court granted injunction restraining unknown infringers from producing, distributing or advertising counterfeit dresses that replicate original designs of Raghul Mishra.

(c) Birkenstock IP GmbH Vs. John Doe:³⁸

The plaintiff sued four footwear traders, four factories and two individuals for alleging its footwear. The court appointed local commissioners to conduct search and seizure of infringed goods and ordered temporary Injunction.

³⁴ Dwarkadas Dhanji Sha v. Chhotalal Ravicarandas and Co., AIR 1941

³⁵ Niki Tasha P. Ltd. v. Faridabad Gas Gadgets P. Ltd, AIR 1985

³⁶ Crocs Inc. USA v. Bata India Ltd. & Ors., 2019 (77) PTC 1

³⁷ Rahul Mishra & Anr. v. John Doe & Anr., CS(COMM) 1194/2024

³⁸ Birkenstock IP GmbH v. Ashok Kumar (John Does) & Ors., CS (COMM) 531/2025

(d) Jayson Industries Vs. Crown Craft India Pvt. Ltd.:³⁹

The plaintiff has registered design for bucket, mug and tubs, the defendants was alleged for piracy. The court held plaintiff failed to show prima facie novelty and refused to grant injunction.

(e) Havells India Limited vs. Panasonic Life Solution India Pvt. Ltd.:⁴⁰

The plaintiff is the registered proprietor of **ENTICER/ENTICER** Art Series fans. The defendants launched the **VENICE PRIME**, allegedly copying essential design features of the plaintiff's design and stated that the plaintiffs design lacks novelty. But the alleged design of the defendant has been applied for registration so that they cannot say that the plaintiffs design lacked novelty. The court found a prima facie case and granted injunction restraining the defendant from manufacturing and selling disputed designs.

V. CONCLUSION:

The protection of industrial designs serves as a cornerstone of intellectual property law by safeguarding creativity, fostering innovation, and encouraging fair competition. Registration not only secures exclusive rights for proprietors but also strengthens economic growth by preventing unlawful imitation and ensuring recognition of original work. Although India is not a signatory to the Hague International Design Registration System, the Designs Act, 2000 provides comprehensive protection within the country while maintaining harmony with international principles. To ensure continued enforcement, proprietors must remain vigilant in reviewing and updating registrations in line with evolving markets and product categories. Ultimately, robust protection of designs not only empowers creators and traders but also contributes to industrial progress, consumer trust, and the overall development of a fair and competitive marketplace.

³⁹ Jayson Industries & Anr. v. Crown Craft (India) Pvt. Ltd., CS (COMM) 580/2022

⁴⁰ Havells India Ltd. v. Panasonic Life Solutions India Pvt. Ltd., CS(COMM) 261/2022