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“INTELLECTUAL PROPERTY RIGHTS OVER JEWELLERY FROM THE INDIAN PERSPECTIVE”

INTRODUCTION

India is home to one of the largest Gems and Jewellery industry in the world. The Gems and Jewellery Industry plays a significant role in the Indian economy as it contributes about seven percent of the country's GDP and about fifteen percent of the total export merchandise. It employs almost 4.6 million people in this Industry and owing to its labour intensive and export-oriented nature it's been on a steady rise. The industry is expected to employ almost 8.23 million people by 2020 in order to meet the demand as India is deemed to be the hub of the global Jewellery market, because of its low costs and highly skilled labour¹.

The manner in which Indians shop for Jewellery has changed over the years. From discreetly picking up jewellery by making cash payments to purchasing jewellery from e commerce jewellery portals for the latest visually appealing designs. The manner in which people buy their jewellery has become more digital and user friendly. This has increased the competition in the market and in order to succeed in this proactive scenario, Indian Jewelers need to act proactively in order to protect their intellectual property rights. The Intellectual property rights over jewellery are very fragile and if lost once would be extremely difficult to, if not impossible to recover these Intellectual property rights. Thus, in the Indian context the jewelers use a variety of trademarks, copyrights, designs and trade secrets in order to protect

¹ Indian Brand Equity Foundation. “Gems and Jewellery Industry in India.” *IBEF.org*, July 2019, <https://www.ibef.org/industry/gems-jewellery-india.aspx>.

their rights. IP rights and registrations help protect the efforts of the original inventor from the illegal use of the creation by third parties.

JEWELLERY TRADEMARKS

Trademarks are important in the Indian context, as they protect the logo, product names, the certification marks, etc., which in most cases denotes the quality and the trustworthiness of the jeweller. In a country like India, where people buy their jewellery on the basis of the goodwill of the jeweller who's selling the product, since they associate the quality of the product with the seller. Trademarks help in establishing a distinct identity of the jeweller in the Jewellery industry and thus easier for the customers of that jeweller to identify their products, based on the trademarked logos, product names and even designs.

The International Classification of Goods and Services classifies different products and services into 45 Trademark Classes². These Trademark classes are also used by the Indian Trademark registry to classify different products under different Trademark classes.

Trademark class 14 includes precious metals and their alloys and their products or those products coated with these precious metals, not included in other classes, jewellery, and in general clocks and watches³. Thus, by registering the trademark of their products under Class 14 of the Trademark classes, the jewellers will get protected from infringers of the creation.

One form of trademarks that can be used by Jewellers to protect their logos and product names through a new procedure that allows certain trademarks to be proclaimed as "well known" trademarks. The Trademarks Act, 1999, defines a well-known trademark as, a mark which has become so substantial to the segment of the public that uses such goods or services that the use of such a mark in relation to other goods and services is bound to confuse the public regarding a connection between those good and services and a person using these marks in relation to the first mentioned goods and services⁴. Marks of famous jewellers like Tanishq, Kalyan Jewellers, Joy Alukas owing to extensive advertising are known to the public that wants to purchase jewellery and hence if they see such a trademark on another

² Venture Care. "TRADEMARK CLASS 14: PRECIOUS METALS | TRADEMARK REGISTRATION." *A Medium Corporation*, Nov. 2017, <https://medium.com/@venturecare110716/trademark-class-14-precious-metals-trademark-registration-c20a6f40b01d>.

³ "Trademark Class 14: Jewellery, Precious Metals and Stones." *Indiafilings.com*, <https://www.indiafilings.com/learn/trademark-class-14-jewellery-precious-metals-and-stones/>.

⁴ Section 2 (1) (zg), The Trademarks Act, 1999.

product are bound to make a connection between these jewellers and the other product having the mark. Unlike other Trademarks, “well known” trademarks have its reputation and goodwill protected across the nation and across categories of goods and services. Thus, the use of the Trademarks of Joy Alukas, which has majority of its business in South India for a product for the North Indian markets would be violative of the Trademarks Act, 1999 and the infringer would have to deal with both punitive and compensatory remedies.

In the *Rolex Sa v Alex Jewellery Pvt Ltd.* case, the defendants were using the brand name of Rolex of the plaintiff while dealing in the business of artificial jewellery⁵. The Court ruled that the plaintiff’s business dealt with watches and the section of the people using watches recognizes the Trade name of Rolex and hence it could be classified as a well-known trademark. If the same section of people encounters the artificial jewellery, they might assume that the artificial jewellery is made by the same Company that makes the watches. Hence the court placed an injunction on the use of the Brand name by the jewellers as Rolex was classified as a “well known” trademark⁶.

Through Trademarks even designs of certain jewellers can be protected. If the Jeweller is continuously using the same design in order to show that the jewellery is coming from his brand, then that design can be protected under trademark as people associate that brand with the design. Juicy Couture is one such brand that uses J charms on their bracelets, thus giving the bracelets the identification of their source. Most Jewellers engrave their names on a small part of the jewellery or add a small coin to the jewellery set as an identification of their brand. Thus, trademarks can help the jewellers protect their logo, product name, product description and design. India must thus make it mandatory for the jewellers to leave a maker’s mark on the jewellery, so that the jewellery can be tracked back to the jeweller if necessary. The mandatory maker’s mark would act like the personal trademark of the jeweller and would help in knowing the creator of the jewellery.

JEWELLERY DESIGN – AN INTELLECTUAL PROPERTY ASSET

⁵ *Rolex Sa vs. Alex Jewellery Pvt. Ltd. & Ors.* (2014) 215 DLT 6.

⁶ Sonal Sodhani. “All You Need to Know About ‘Well-Known Trademarks.’” *IP and Legal Filings*, 11 May 2019, https://www.ipandlegalfilings.com/Blog/185/All-You-Need-to-Know-About-Well-Known-Trademarks-?utm_source=Mondaq&utm_medium=syndication&utm_campaign=View-Original.

The growing demand in the fashion, gems and jewellery industry has led to an increased similarity in the designs that are to be sold. Owing to the increased convenience in purchasing jewellery, there has been a greater replication and copying of jewellery designs by third parties. Thus, there is a growing need to protect this valuable asset due to the growing demand in the market for jewellery designs.

While the brand name and logo of the Jeweller and the Jewellery line can be protected under Trademark, the original design of a jewellery product is protected under the Copyrights Act, 1957 and the Designs Act, 2000. Although the two statutes provide protection of the jewellery designs of the Jewellers, there are some fundamental differences between copyright and design.

- Copyright will protect the sketches of the design as artistic work and the Design law would instead protect the actual look and the patterns of design used in the product.
- Copyright protection of a commodity extends till the life of the designer and continues for 60 years after the death of the designer, whereas the design protection lasts for ten years that can be extended by a period of five years.
- It is not mandatory to register Copyrights, but in order to seek protection under the Design Act, 2000, the designs must be registered under the Act⁷.

Since the two laws overlap when it comes to jewellery, in order to prevent any misuse of the Copyright Act states that if the product can be registered as a design, then the Copyright protection will not be available to it. If the product can be registered as a design but has not been registered and that design has been used more than 50 times, even in these cases the protection of the Copyright Act ceases. Thus, for jewellery designs that need protection and of which more than fifty copies will be made, it makes sense to register these designs under the Designs Act, 2000⁸. The distinction between the artistic work which has copy right protection and the design of a product was laid down by the Bombay High Court in the case of Pranda Jewellery Pvt. Ltd. & Ors versus Aarya 24K⁹. The Court held that artistic work which is reproducible in any form, which qualifies as artistic work would be protected under the Copyright Act, 1957. But in cases where the

⁷ Editorial Staff. "Protecting Jewellery Designs in India – Intellectual Property Simplified." *Selvam and Selvam*, 7 Sept. 2014, <https://selvams.com/blog/protecting-jewellery-designs-in-india-intellectual-property-simplified-2/>.

⁸ Hiral Chedha. "Guest Post – Solomon & Co. – 'Jewellery Design': An Intellectual Property Asset." *IPRMENTLAW.com*, 6 Aug. 2018, <https://iprmentlaw.com/2018/08/06/guest-post-solomon-co-jewellery-design-an-intellectual-property-asset/>.

⁹ Pranda Jewellery Pvt. Ltd. & Ors versus Aarya 24K, AIR 2015 Bom 157.

artistic work is used for application to an article which requires an industrial process in addition to the artistic work in order to give it the two or three dimensional form, can be protected under Section 11 of the Designs Act, 2000 , if it has been registered as a design, whereas if it has not been registered as a design and more than 50 applications of the artistic work have been used, then it would cease to hold Copyright protection, under Section 15(2) of the Copyright Act, 1957. Thus, the original artistic work would continue to hold protection under the Copyright Act, 1957 and solely the owner of the work has the right to reproduce the work in a two- or three-dimensional form. What it would cease to hold is the Copyright protection for industrial application of this work for production of a commodity. The Court used the example of a painting to explain the difference between the two forms of protection better. If a painting was to be reproduced on any medium like cloth, canvas, paper whether by an industrial process or not would still get protection under the Copyright Act, 1957. On the other hand, if the painting is used as design on a saree and the industrial application is to apply this design on the sarees, then the design would lose protection as a Copyright after more than 50 units of the saree have been produced. The difference between the two is that in the former use the artistic work is being reproduced as artistic work and, in the latter, use the artistic work is applied to some other commodity.

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THE REQUIREMENTS FOR PROTECTING THE JEWELLERY DESIGN IN INDIA

- The first requirement is that the design must be an original one
- The design must be judged on the basis of the naked eye sight and the distinct features of the design must be visible.
- The jewellery design must not include a feature of the design that is purely functional
- The jewellery design must not be disclosed to the public, either in India or globally through publication in any form.
- The jewellery design must not contain any obscene or scandalous matter¹⁰.

¹⁰ origiin. "Protecting the Intellectual Property of Jewelry Designs in India." *OriginIPSolutionsLLP.com*, <https://www.origiin.com/2019/02/09/title-protecting-the-intellectual-property-of-jewelry-designs-in-india/>.

The jeweller who seeks to get his jewellery design protected under the Designs Act, 2000 is required to register the design with the design office. The applicant must submit pictures of the design along with the class of designs (for jewellery 11-01). After this the design office will take into consideration the above-mentioned requirements and evaluate whether the design must be registered or not. If it deems fit, then the design is registered and entered into the design journal.

CONCLUSION

The advantages of protecting your Intellectual property like Jewellery designs are numerous. The registration of the jewellery designs guarantees monopoly over those designs. It enables the jewellery designers to restrain or claim damages from offenders who would replicate the design. It mainly recognizes the time, effort and money spent by a person in creating the Intellectual property related to Jewellery. It also helps in utilising the human creativity exponent used to create the Intellectual property to the fullest.

In the Indian jewellery market, people often purchase their jewellery on the basis of their relationship with the jeweller. If the jeweller's unique trademarks are infringed upon by, the brand name and the goodwill of the jeweller may get tarnished if the product is not of the same level as that of the jeweller.

Indian Jewellers must take a leaf out of the books of international jewellers, like Chopard, Tiffany, Theo funnel, Cartier, etc., who largely benefit from their intellectual property, by converting it into intellectual capital. Intellectual Capital is a business asset, that is subjective in nature and cannot be quantified exactly by the firm. This asset shows up as a part of the intangible assets of the firm. Intellectual Capital does contribute to the returns of the business, which even though is tough to quantify, it adds to many years' worth of business. Thus, in my opinion having an aggressive and proactive Intellectual Property approach would be the real crown jewel in the hands of the various jeweller firms.