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Protecting Your Industrial Design

INTRODUCTION

Globalization & liberalization has flooded the Indian markets with a large variety of products. Consumers are offered numerous choices for a single product and, increasingly, the appearance of an article counts more than its utility or quality. In order to catch the attention of buyers, the producers invest huge capital in developing innovative & attractive designs which enhances the appearance of their products. Therefore, it became necessary to protect designs in order to reward the designer's creativity and to encourage future contributions. Under the Indian legal regime, designs are given protection under the Designs Act, 2000 ("Act"). The purpose of the Act is to protect novel designs applied to particular articles manufactured and marketed commercially.

This newsletter discusses the relevant provisions of the Act dealing with design registration and its protection in India. It also provides an insight of the importance of protected designs in the present modern consumerist market.

1.0 What is a Design

Under section 2(d) of the Act, design means the features of shape, configuration, pattern or ornament or composition of lines or colours or combination thereof which is applied to any article¹ whether in two dimensional or three dimensional (*like shape of a bottle, vase*) or in both forms. Further, the design must be applied by any industrial process or

¹ "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.

means, whether manual, mechanical or chemical, separate or combined which in the finished article appeals to and is judged solely by the eye. For instance, a combination of lines or colors could be made very appealing to the eye and will constitute a good design.

The definition of design excludes any mode or principle of construction or any thing which is in substance a mere mechanical device. A mode or principle of construction cannot be registered as a design as no monopoly can be granted merely for a method or principle of construction. If a person produces an article for performing particular function, that person may obtain protection for that article as an invention under the Patents Act, but he cannot obtain a monopoly of that article by registration of a design.

2.0 Design vs. trademark, patent and copyright

2.1 Design and a trademark - Design does not include any trade mark, as defined in section 2²(i)(v) of the Trade and Merchandise Marks Act, or property mark³ as defined in section 479 of the Indian Penal Code or any artistic work⁴ as defined in section 2(c)

² Under this Act, trade mark is defined as a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark.

³ A mark used for denoting that movable property belongs to a particular person is called a property mark.

⁴ It means (i) 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, (ii) an

of the Copyright Act (“**Copyright Act**”). A design is a part and parcel of the article manufactured, while a trademark is usually not so. For instance, a label on a container of goods is not integral to the goods and it is not a design.

2.2 Design and a patent - A registered design applies to the appearance of a product or part of a product. It is not concerned with the aspects of how a design is made, how it is assembled, or how it functions. It deals with the external appearance, which is judged by the naked eye. On the other hand, a patent is concerned with the function, operation, manufacture or material of an item. A patent is granted for some new and useful functional aspects, new constructional features of a product, or a novel manufacturing process to obtain the product.

2.3 Design and a copyright - There is also a clear distinction between a copyright and a design. The copyright is an inherent right which comes into existence along with the work under protection. In contrast, design is a statutory right granted to the owner of the design. Indian jurisprudence⁵ supports the proposition where the work must be protected under the Act but it is not done so, the automatic protection of copyright extended to it will cease after 50 industrial reproductions.⁶

3.0 Getting a design registered

3.1 Essential requirements for registration

In order to be eligible for registration under the Act, a design:

(i) Must be new and original - The word “new” means a design which is created for the first time and is unknown. Similarly, “original” means a new application of an existing or known design to a new subject matter, provided that the same design has not been applied to an article in the same class or to an article in the different class which is similar in character or purpose,

- (ii) Must not have been disclosed to the public anywhere in the world by publication in tangible form prior to the filing date, or where applicable, the priority date of the application for registration,
- (iii) Must be significantly distinguishable from a known design or a combination of known designs; for instance, colour may form an element in a design, but colour or coloring as such does not constitute a design, unless the change of colour creates a new pattern or ornament,
- (iv) Should not contain scandalous or obscene matter,
- (v) Must be applied to an article and should appeal to the eye,
- (vi) Should not be contrary to public order or morality,
- (vii) Should not include any trade mark or property mark or artistic works.

3.2 Who can apply for registration

Under section 2(j) of the Act, any person claiming to be the proprietor of any new and original design not previously published in any country may apply for registration of the design.

Designs are required to be categorized in separate classes in order to provide for systematic registration. An internationally accepted classification of industrial designs according to the Locarno Agreement⁷ which is followed in India has been provided in Designs (Amendment) Rules, 2008 based upon the function of the article. There are 32 classes of articles and most of the classes are further divided into sub-classes. These classes and sub-classes are mainly function oriented. For example, if the article relates to a chair or a sofa cum-bed, the name should be provided accordingly, and should be classified under class 06 and sub-class-01 where it is stated as Beds and Seats since it is classified in function/purpose oriented manner.

architectural work of art and, (iii) any other work of artistic craftsmanship.

⁵ Rajesh Masrani vs. Tahliani Design 2009 MIPR (1) 252.

⁶ Section 15(2) of the Copyright Act. It is sufficient if 51 articles, bearing the design are produced by an industrial process, it is not necessary that anyone of them should be sold.

⁷ The Locarno Classification is based on a multilateral treaty administered by WIPO. This treaty is called the Locarno Agreement establishing an international classification for industrial designs, which was concluded in 1968. The Agreement is open to states party to the Paris Convention for the protection of industrial property.

3.3 Procedure for registration of design

The step-wise process⁸ for registration of design is discussed in brief below:-

(i) **Submission of the Application** - An application for registration of a design has to be accompanied by four signed copies of the representation⁹ of the design by the applicant or his agent to the Controller of Designs. All applications have to be submitted to the Patent Office, Kolkata, in the name of the Controller of Patents, Designs & Trademarks.

(ii) **Acceptance/Refusal of the application** - On receipt of the application the Controller shall send it to the examiner appointed under the Act, to determine whether the design is capable of being registered or not. Thereafter, Controller shall consider the report of the examiner, and, if satisfied, that the design complies with all requirements for registration shall register it. The Controller can also refuse to register the design. In such a case, the applicant aggrieved by such refusal may appeal to the High Court. The Act does not prescribe any time-limit in which a design can be registered. However, if a design fulfills all the necessities of a registration, it is likely to be granted within six months from the date of the application.

(iii) **Objection/Removal of Objection** - If on consideration of the application any objections appear to the Controller, a statement of these objections shall be sent to the applicant or his agent. The applicant has to remove the objection within one month of communication of the objections to him failing which the application shall be deemed to have been withdrawn. He may also apply to the Controller for being heard on the matter.

(iv) **Publication of particulars of registered design and certificate of registration** - On acceptance of the design filed in respect of the application, the Controller shall direct the registration and publication of the particulars of the application

and the representation of the article to which the design has been applied, in the official gazette.

(v) **Cancellation of registration** - At any time after the registration of the design, any person may make a petition to the Controller for the cancellation of the registered design on various grounds such as existence of prior registration, design is not new or original etc.

3.4 Duration of registration

The duration of the registration is initially ten years from the actual date of filing of the application. Section 18 of the Act prescribes the procedure to verify whether the design has been previously registered or not.¹⁰ However, this initial period of registration i.e. 10 years may be extended by a further period of 5 years on an application¹¹ to the Controller before the expiry of the said initial period of copyright. Thus, designs are protected for a maximum period of 15 years. After the expiry of the aforesaid period, the design becomes a public property.

3.5 Benefits of a design registration

The registration of a design provides the registered proprietor various benefits namely

- (i) Exclusive right to apply a design to the article in the class in which it has been registered,
- (ii) Better protection of intellectual property,
- (iii) Right to license or sell design as legal property for a consideration or royalty,
- (iv) Right to sue for infringement.

The registration of a design enhances its competitive advantage. Further, it allows the registered proprietor an edge in the marketplace as it differentiates design of his product from others. Once registered, it prevent others from commercially using a design identical or very similar to the registered design.

⁸ Section 5 and Rule 11 of the Act.

⁹ A representation is the exact representation of the article on which the design has been applied. It should be prepared on white A4 sheet.

¹⁰ The applicant has to file Form-6 along with the prescribed fees of INR 500 (US \$ 10) to request the Designs office to initiate this search.

¹¹ Application in Form-3 accompanied by a fee of INR 2,000 (US \$ 40).

3.6 Infringement of Copyright in design – Piracy

Piracy of a design means the application of a design or its imitation to any article for the purpose of sale or importation of such articles without the license and written consent of the registered proprietor.¹²

The Act provides punishments for the infringement of a registered design. An infringer will be liable for every contravention and will have to pay INR 25,000 (*US \$500 approx*). The registered proprietor is also entitled to institute a suit for the recovery of damages for any contravention and can seek an injunction preventing further misuse and restrain the infringer from abusing the design. Additionally, the damages are capped to INR 50,000 (*US \$ 1000 approx*) per design.¹³

CONCLUSION

Given the benefits of registration of a design discussed above, it would always be advantageous for the artisans, creators, manufactures who create new and uniquely shaped designs to seek legal protection under this Act. The registration of a design ensures that they are not deprived of their bonafide reward by unscrupulous people who tend to infringe their designs by copying the same and applying it to their goods. *(Sunaina Kapoor)*

¹² Section 22(1) of the Act.

¹³ Section 22(2) of the Act.

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