

# **India's Designs Law & Practice**

**LEX ORBIS  
INTELLECTUAL PROPERTY PRACTICE**

**July 20, 2005**

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# The Law

- The Designs Act, 2000
- The Designs Rules, 2001

[Came into force on 11<sup>th</sup> May, 2001]

# “Design”

- “Design” means the features of:-
  - Shape;
  - Configuration;
  - Pattern;
  - Ornament;
  - Composition of Colors;
  - Composition of lines; or
  - Any combination of any of the above

# “Design” Defined

- Applied to any article;
- By any industrial process or means;
- Whether manual, mechanical or chemical or a combination thereof;
- Whether in 2 or 3 dimensional forms or in combination of both;

# Construing the definition

- The definition of the design as a whole can be construed in 3 ways:
  - What is registrable is that part of the shape and configuration which has an eye appeal, any purely functional feature being excluded from registration;
  - OR
  - Any design which includes any feature which is dictated solely by function is to be excluded from registration;
  - OR
  - A design which is *ex hypothesi* has eye appeal will be excluded from registration only if every feature of it is one solely dictated by function.

# What is the best possible construction?

- The first possible construction does not make sense. The design features are to be applied onto an article as a whole.
- As such the monopoly right subsists in the article as a whole on which the features of shape, configuration and pattern are applied. That means the article has to be considered as a whole.
- Therefore the effective choice is between interpretation (2) and (3).

# Construing the Definition of 'Design' continues...

- Choice is now between excluding the whole shape or configuration from registration because a part of it is purely functional;

OR

- Considering the whole shape or configuration as possible unless the whole of it is dictated solely by functional considerations.

# ‘Design’ & exclusion of functional features

- The latter construction is supported by:

*Interlego v. Tyco* [1988] RPC 343;

&

*Amp. V. Utilux* [1970] RPC 397

# **‘Article’**

- Any article of manufacture and any substance – artificial, or partly artificial and partly natural;
- Any ‘part of an article’ capable of being made & sold separately.

# **‘Registrability’**

- Only ‘New or Original’ Designs are registrable
- Which are not disclosed to public anywhere in India or in any other country prior to date of application or date of priority;
- Which are not significantly distinguishable from known designs or combination of known designs;
- Which do not comprises or contains scandalous or obscene matter

# **‘Original’**

- Originating from the author of the design (the designer)
- Includes cases which though old in themselves yet new in their application.

# “Design” prohibition of registration

- Which ‘features’ must appeal to and are solely judged by the eye;
- And must not include any mode or principle of construction;
- And must not in substance be a mere mechanical device;
- And must not be a Trade Mark;
- And must not be an Artistic Work under the Copyright Act

# What does the Regn. Entail

- The effect of registration of a design is that the Registrant will have “Copyright” in the design for (10+5) 15 years.
- “Copyright” is the exclusive right to apply a design to any article in any class in which the design is registered.

# What all can be registered?

- A variety of articles.
- India follows a Classification of Goods under the Third Schedule of the Designs Rules, 2001
- The Third Schedule contains 31 Classes and a Miscellaneous Class 99
- The Indian Design Classification conforms to the 7<sup>th</sup> Edition of Locarno Classification

# **Samples of published Designs (India)**

- The following are some of the recently published Indian Designs ([www.ipindia.nic.in/ipr/design/designs.htm](http://www.ipindia.nic.in/ipr/design/designs.htm))

# "Cup"

- Class. 07-01
- No.190921.
- M/s. S.K. Industries (p) Ltd.
- 7 January 2003.



# "FOOTWEAR",

- Class. 02-04
- NO.190506.
- Bata India Limited
- 22 November 2002.



# "FOOTWEAR",

- Class. 02-04
- NO.190507.
- Bata India Limited
- 22 November 2002.



# "FOOTWEAR",

- Class. 02-04
- No.190508.
- Bata India Limited
- 22 November 2002.



# "FOOTWEAR",

- Class. 02-04
- No. 190514
- Bata India Limited
- 22 November 2002.



# “PACKAGE”

- Class. 09-07
- No.190306.
- Sun Pharmaceutical Industries Ltd., ACME PLAZA,
- 29 October 2002.



# “TEXTILE FABRIC”,

- Class. 05-05
- No.191389
- The Rishabh Velvellen Limited
- 28 February 2003



# “TEXTILE FABRIC”,

- Class. 05-05
- NO.191318.
- The Rishabh Velvellen Limited
- 18 February 2003.



# “PAD PRINTING MACHINE”

- Class. 18-02
- NO.191567.
- Rahul Rai
- 19 March 2003.



# “PREMIUM OVAL DISPLAY RACK”

- Class. 20-02
- No.191568
- M/S. Arham Plastics Limited
- 19 MARCH 2003



# “FOOTWEAR”

- Class. 02-04
- No.191192
- Ajay Plastic Industries  
(Indian)
- 3 FEBRUARY 2003



# “GRILL”

- Class. 12-16
- No.190587
- Mahindra & Mahindra Limited
- 28 November 2002



# UK & OHIM

- In the Europe, there exists a Community Design Registration System managed by the Organization for the Harmonization of Internal Markets (OHIM) located at Alicante ([www.oami.eu.int](http://www.oami.eu.int))
- The following are some designs registered at the OHIM as European Community Designs

# Stylised Words

**Arsenal**

**Favourite**

# Screen Layouts & Icons

APPLY FOR YOUR TRADEMARK

SHOP - BASKET

Pick a zone... ▾

Pick a goods/service classification ▾

ADD TO BASKET

Your basket is empty.

Simply follow the 3 steps below to apply for your Trademark online...

Select the zone (country) you require...

Pick a zone ▾

Albania	▲
Andorra	
Argentina	
Australia	
Austria	
Azerbaijan	
Bahrain	
Bulgaria	▼

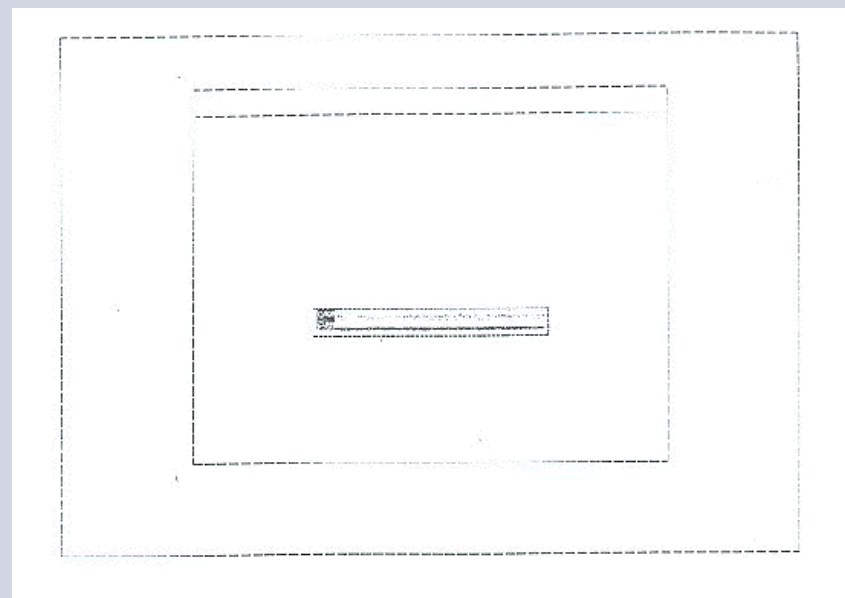
Select the classification (goods/service) you require...

Pick a classification ▾

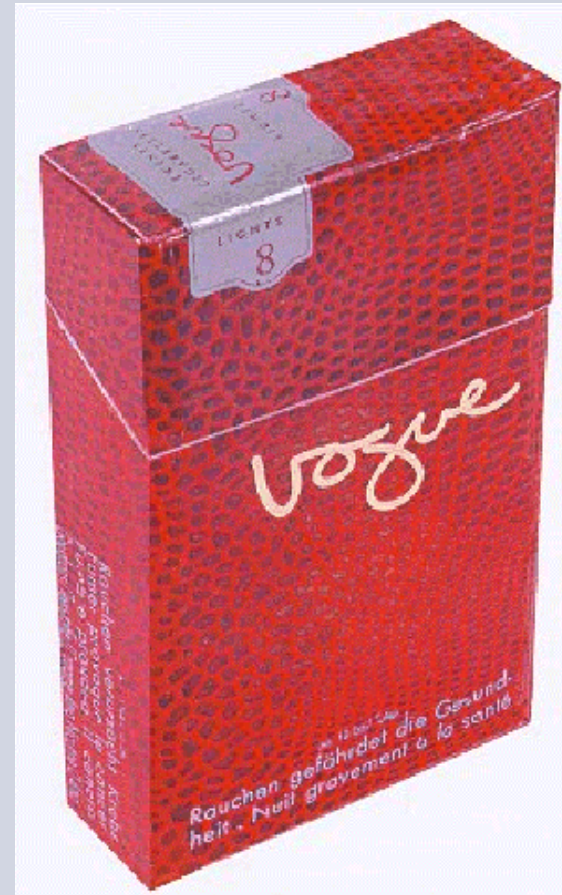
Class 1	▲
Class 2	
Class 3	
Class 4	
Class 5	
Class 6	
Class 7	
Class 8	▼

Click "add to basket"

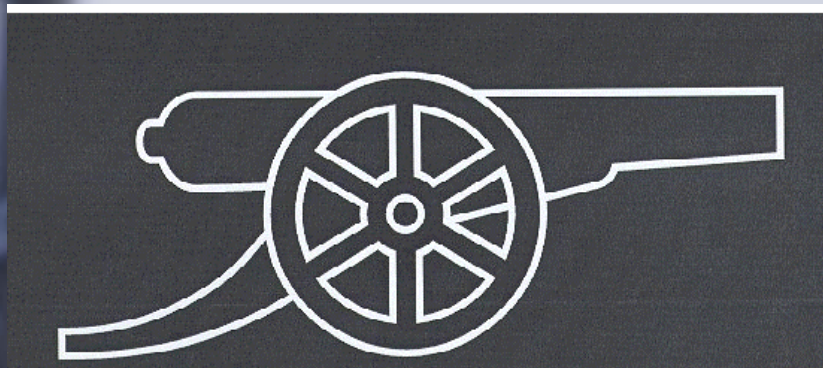
ADD TO BASKET



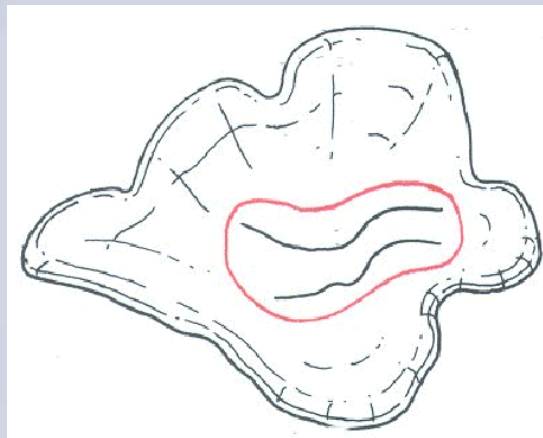
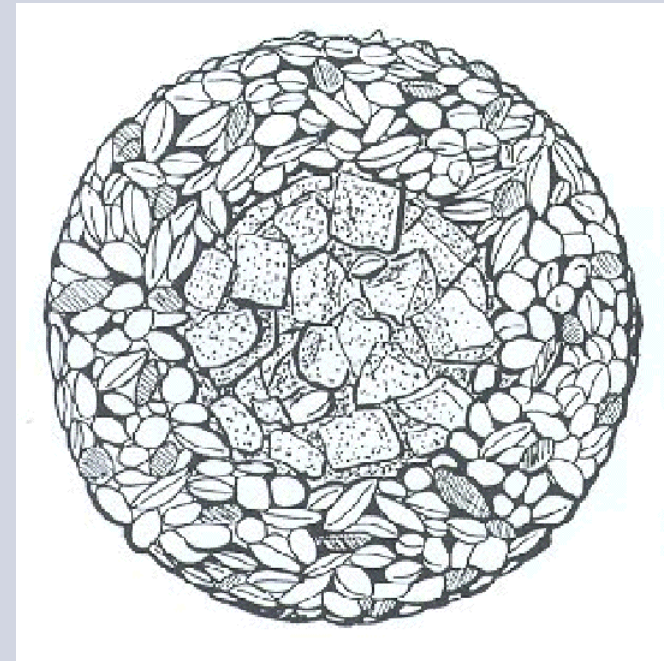
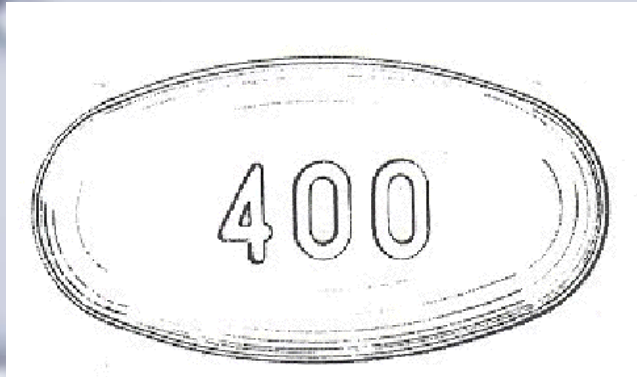
# Packaging



# Logos



# Pills and Foodstuffs

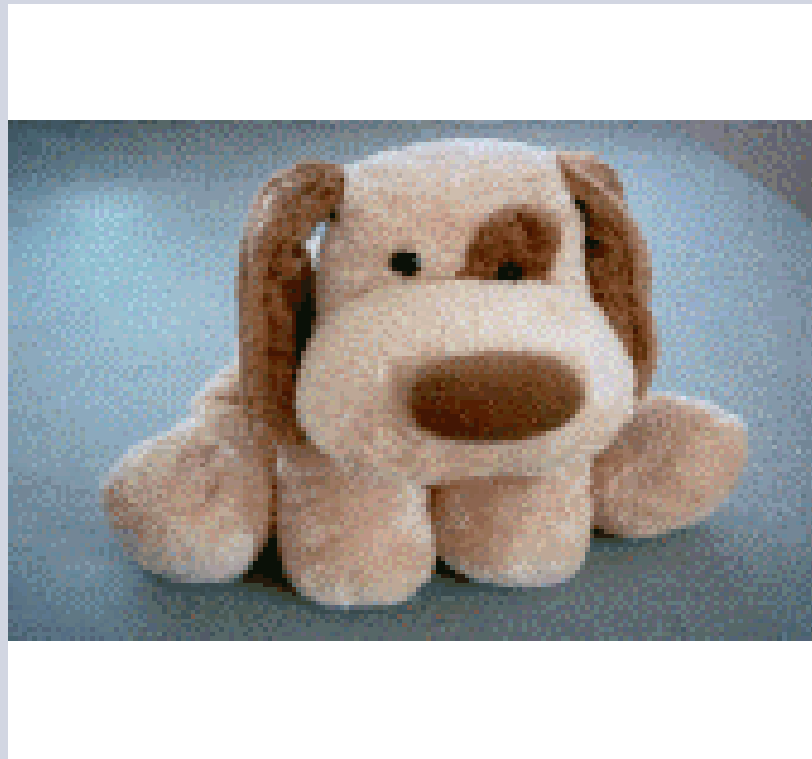


# A Hairstyle (!)



July 20, 2005

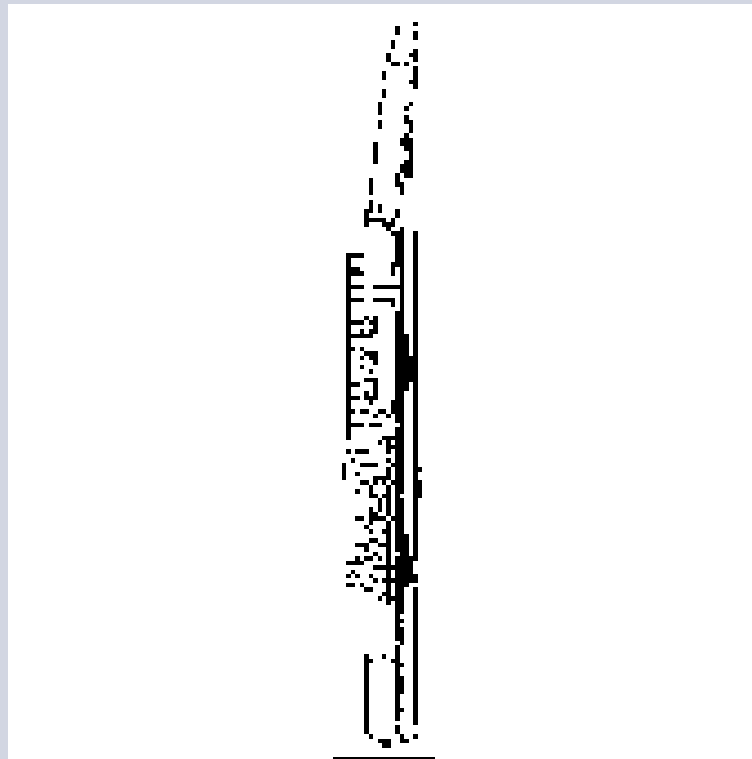
# Some more traditional Designs



# Some more traditional Designs



# Some more traditional Designs



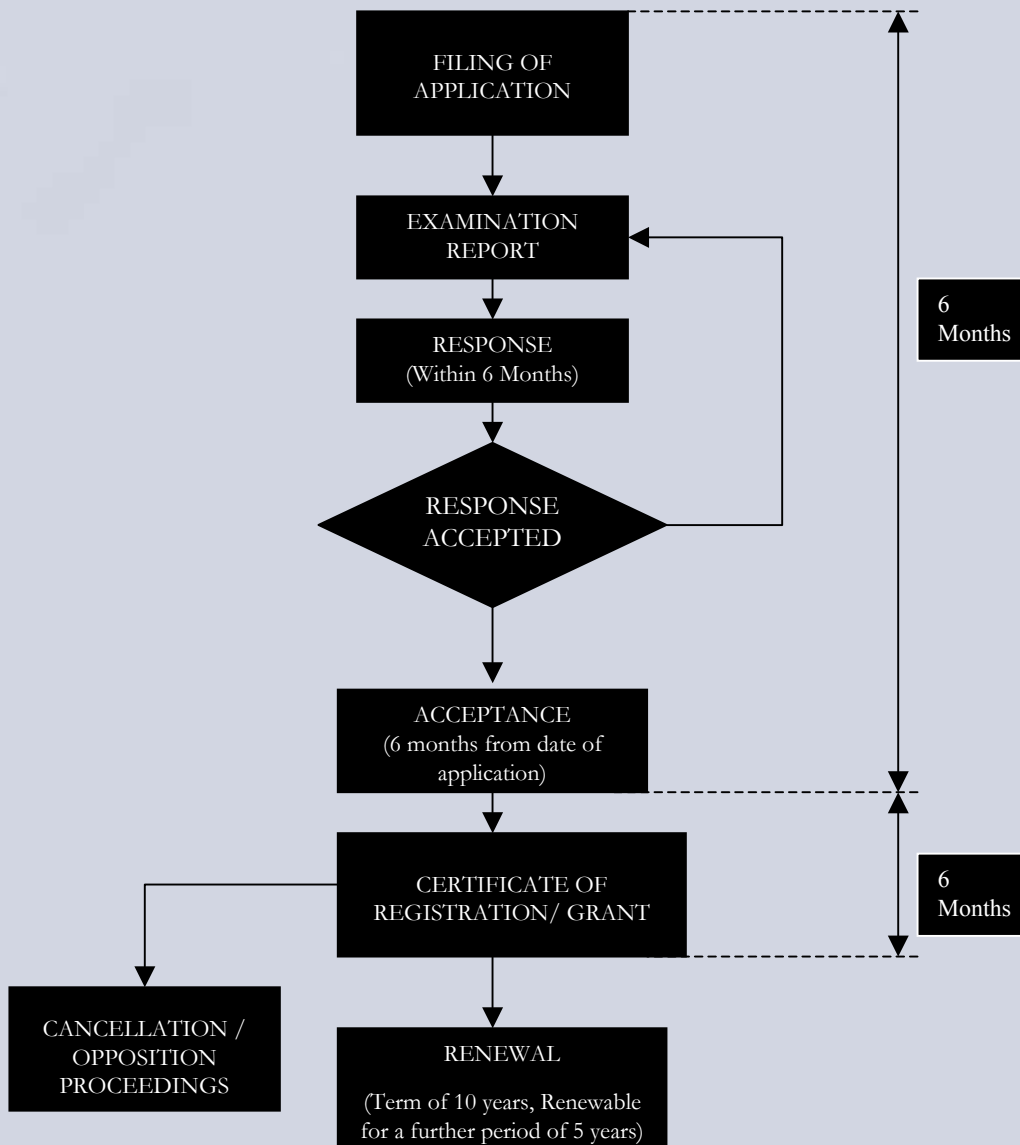
# It won't improve your average



# How & Where to Register

- India's Designs Office is located at Calcutta.
- Applications can be filed through any of the Patent Offices located in New Delhi, Mumbai & Chennai
- The Design Wing of the Patent Office Calcutta (as it is called) is pretty sophisticated (both in terms of its Ornamental and functional features!!).

## DESIGN PROSECUTION PROCEDURE – INDIA



# **‘Applicant’**

- Any person claiming to be the proprietor of a design may apply

# ‘Application Document’

- Form 1
  - *inter alia* must specify the name of the article & class
- Power of Attorney in Form 21
- Representation of the Design in quadruplicate on (A-4) Paper
- Priority Document (if relevant)
- 1000 INR fee

# ‘Design Representation’

- Rule 14 specifies how the Representations must be prepared;
- We typically call it a Design Specification
- The specification contain exactly similar drawings, photographs, tracings or other representation of the design
- Or the specification can be in the form of specimens of the design
- The Designs Office prefers photographic representations. Submitting photographs of a Design has its tricky consequences. People tend to over simplify design registration by using casually prepared photographs as the representations.
- When the Registered Design is infringed, it is easy to distinguish the infringing article by profiling unnecessary features covered in the photographs. If the Judge does not have an ‘instructed eye’, he/she may get carried away with the over profiling of the irrelevant features.

# How to make a Design Specification

- The figures must be placed in an upright position on the sheet;
- When there a plurality of figures is shown, each of such figure must be designated in terms of the views – as Perspective View, Front View, Rear View, Top view, Bottom View, Right Side View, Left Side View etc.
- Typically Indian Designs Office does not accept ‘Exploded Components View’

# **‘Extraneous Matter’**

- If ‘words’, ‘letters’ or ‘numerals’ are not of the essence of the design applied for, they must be removed.
- If ‘words’, ‘letters’ or ‘numerals’ are integral to the design applied for, the Controller of Design may ask the Applicant to make a disclaimer.

# ‘Statement of Novelty’

- Each Representation must contain a ‘Statement of Novelty’
- Suitable form of such ‘Statement of Novelty’ can be the following:
  - “The novelty resides in the features of shape and configuration of the \_\_\_\_\_ (mention the name of the article) as illustrated”

# Form of Statement of Novelty

- “Novelty resides in the composition of lines and colors of the \_\_\_\_\_ (say for example article of clothing, or carpet) as illustrated”
- “Novelty resides in the ornamental surface pattern of the \_\_\_\_\_ (say for example the mobile phone, or ash tray or flower vase) as illustrated

# ‘Disclaimers’

- Suitable Disclaimers can be as follows:
  - “No claim is made by virtue of this registration to any right to the use of the letters, words and numerals appearing in the design”
  - “No claim is made by virtue of this registration in respect of any mechanical or other action of the mechanism or in respect of any mode of principle or construction of the article”

# Upon Filing the Application

- The Designs Office will examine the Application and Issue an Office Action.
- Typically Office Actions look like this:

भारत सरकार  
पेटेंट कार्यालय  
डिजाइन कार्यालय

निजाम पैलेस

234/4 आचार्य जगदीश बोस मार्ग

द्वितीय बहुमंतीय कार्यालय भवन, (7<sup>th</sup> तल) कोलकाता-700 020.

दूरभाष : 2281-3419-20-21-22, फैक्स : 2281-2423

E-mail - designin@giaccl01.vsnl.net.in

Website No - www.ipindia.nic.in



GOVERNMENT OF INDIA  
THE PATENT OFFICE  
DESIGN OFFICE

Nizam Palace

234/4, A.J.C. Bose Road

2nd M.S.O. Building (7th Floor), Kolkata - 700 020.

Phones : 2281-3419-20-21-22, Fax No : 2281-2423

E-mail Address - designin@giaccl01.vsnl.net.in

Website No - www.ipindia.nic.in

संख्या/No. \_\_\_\_\_

दिनांक/Date 23-6-04

25 JUN 2001

**Re: Design Application(s) No.(s)**

An examination of the above design application(s) discloses the objections marked below. The following documents are enclosed herewith for amendment and the same should be returned to this office at an early date, together with any observation that you would like to offer in connection therewith. Superseded documents, if any, should also be returned after cancellation over the signature.

Application (each)

Representation(s) (each)

P/Attorney (s)

The last date for acceptance of this/these application(s) will expire on ..... if this/these application(s) is/are not accepted on or before that date it/they will be treated as abandoned under Rule 21 of the Design Rules, 2001.

**OBJECTIONS :**

- 1) The power of attorney/a copy of General Power of Attorney should be filed.
- 2) The Power of Attorney is not adequately stamped, it should bear the stamp value of Rs. 6/- according to the West Bengal (2<sup>nd</sup> Amendment) Act, 1977.
- 3) Names, address and nationality of the partners should be given in the power of Attorney/in the application form in case of partnership firm.
- 4) Application form and representation sheet should be on paper of prescribed size 33 × 20.5 Cms./should be dated and signed by applicant/authorised person.
- 5) Form 1 should be amended as indicated therein.
- 6) Number of representation sheets and serial number of each sheet should be endorsed on the right hand top corner of each sheet.
- 7) Address for service for future correspondence should be stated in the application form.
- 8) Class number should be stated/corrected in Application Form 1.
- 9) What is submitted for registration, does not appear to be an article falling in the class as stated in the application form.
- 10) Name of the article stated in paragraph 3 of the application form and the representation sheets should be amended as indicated therein.
- 11) Design application is not accompanied by 4 copies of the representation as required under Rule 11 of the Designs Rules, 2001.
- 12) Cellophane paper should be affixed on the photographs for the safe preservation of records.
- 12A) A specimen of the article should be sent so as to visualize the exact nature of the article and requisite postage should also be sent for returning the same after verification.
- 12B) Representation sheet should be ~~revised~~ amended as indicated therein.

- 13) Partial/Sectional view as given on the representation sheet No. \_\_\_\_\_ is not allowed.
- ✓ 13A) The nature of the article in the representation sheet is not clear. The Purpose for which the article is used should be specified in the application form alongwith the name of the article.
- ✓ 14) The representations filed do not clearly illustrate the design sought for registration, it should be replaced by four fresh clear representations preferably photographic representation. The superseded representations should be returned to this office duly cancelled over your signature.
- 15) Views illustrated in different figures in the representation sheet should be named below each figure.
- 16) What is sought to be registered falls under section 4 of the Designs Act, 2000 and therefore it cannot be registered.
- 17) What is sought to be registered is not a design as defined under Section 2(d) of Designs Act, 2000.
- 18) The article to which the design is to be applied appears to be part of an article and can not be registered under the Designs Act, 2000.
- ✓ 19) The designs *prime facie* appears to be lacking in novelty, as the article illustrated appears to be well known, ~~see for instance Regd Design No. \_\_\_\_\_~~ If there is any novel feature, the same should be pinpointed in the representation sheet and statement of novelty should be amended accordingly.
- 20) The design as applied to the article relates to a mere mechanical contrivance; the shape of each part thereto is solely dictated by the mechanical function which the article has to perform and it cannot be registered under the Designs Act, 2000.
- 21) A statement of novelty should be endorsed/amended on each representation or is not specific/as indicated.
- 22) Disclaimer in respect of the use the words, letter, number or trade marks should be endorsed on each representation sheet.
- 23) Disclaimer in respect of mechanical, principle action or operation of the article should be endorsed in all the representation sheets.
- 24) Top/bottom/side/back/perspective views(s) of the article should be furnished.
- 25) Status/Full name of the signatory to the Power of Attorney/application form/representation sheet should be stated beneath the signature.
- 26) Open view of the article/enlarged view of the article should be given/deleted.
- 27) The date in the representation sheet should be as of the date of application form.
- 28) Certified copy of the priority document should be filed for claiming priority date.
- 29) Form 18 with appropriate fee of \_\_\_\_\_ should be filed for belated submission of certified copy.
- ✓ 30) Views as shown in the representation sheets are not consistent with each other as indicated, ~~Views(s) is/are not correctly named and should be amended as indicated.~~ <sup>them</sup> Views(s) is/
- 31) Extraneous matter, which is not forming the integral part of the design, should be removed/disclaimed.
- ✓ 32) Engineering drawing/sketch should be replaced by photographic view after cancelling over your signature.
- ✓ 33) The design application No. \_\_\_\_\_ sought for registration is almost identical with Design application No \_\_\_\_\_ so one can be registered.
- 34) Power of Attorney/Form 1/and the representation sheet(s) should be signed by the applicant(s), printed or photocopy signature will not be allowed.
- ✓ 35) The amended documents must be submitted within 3 months from the date of issue of this letter as per the Design Rule 18(1).

**EXAMINER OF PATENTS & DESIGNS  
FOR CONTROLLER OF DESIGNS.**

# Putting the Application in condition for grant

- As said, in 6 months the application must be put in condition for grant;
- If the Controller rejects the application appeal, the applicant can appeal to the High Court (Sec.5(4) – why not to the IPAB;
- The date of registration shall be the date of application – the 15 years term will be computed from that date.

# **‘Publication’**

- The Design will be published in the Gazette of India (Part III, Section 2) as soon as it is Registered

# ‘Register of Designs’

- The register of designs shall be *prima facie* evidence of any matter entered therein.

# **‘Certificate of Registration’**

- An Indian design registration certificate looks like this:

# ‘Cancellation Action’

- Cancellation Action can be instituted at any time after grant of registration on any of the following grounds:
  - (a) prior registration in India;
  - (b) Prior publication in India or elsewhere prior to date of priority or date of application;
  - (c) design not novel or original;
  - (d) design not registrable under Indian law; and
  - (e) not a design under the Indian definition of ‘design’.

# ‘Cancellation Proceedings’

- Cancellation Petition must be filed in Form 8;
- Must accompany a Statement in duplicate setting out the nature of Applicant’s interests in the design (to prove he/she is an ‘interested person’) and the facts upon which the cancellation application is based;
- The Controller of Designs will transmit a copy of the Cancellation Petition to the Registrant;
- The Registrant within the time prescribed by the Controller can file a Counter-Statement, deliver a copy thereof to the Applicant (*read* applicant of Cancellation Petition);

# **Cancellation Proceeding is on...**

- The Applicant when receives the Counter Statement may adduce evidence in support of the Cancellation Application by way of Affidavits (again deliver copy to the Registrant);
- At this stage, the Registrant can adduce evidence in support of his case by way of Affidavits (deliver copy to the Applicant for Cancellation)

# **‘Evidence’**

- The Applicant is entitled to adduce Evidence – in – Reply by way of affidavits;
- No further statement of evidence;
- The time allowed for filing Counter Statement or for leaving evidence shall only be 1 month
- Extension of time is possible only by way of Special Orders of the Controller;
- No extension of time is possible beyond 3 months in any case;
- Upon completion of the Evidence, the Controller shall fix a hearing. Parties will be given a minimum of 10 days’ notice.

# **‘Appeals’**

- An appeal from the decision of the Controller of Designs respecting a Cancellation Petition shall lie to the High Court.

# In Conclusion..

- India has a well developed Design Registration System.
- Most of the Examiners are indeed competent, some of them PhDs in engineering.
- The Office acts fast and typically registration happens in 1 year from the date of application.
- A searchable electronic database of the Registered Design is something we are lacking.