

Designs 2015

India
Omesh Puri
LexOrbis

World
Trademark
Review™

A Global Guide



Partners in progress

LexOrbis | INTELLECTUAL
PROPERTY
ATTORNEYS

709/ 710, Tolstoy House, 15-17 Tolstoy Marg
New Delhi - 110 001 India

| T 91 11 2371 6565
| F 91 11 2371 6556

| www.lexorbis.com
| mail@lexorbis.com

Identifying & Developing | Procurements | Transactions | Enforcement | Advisory & Consulting



Author
Omesh Puri

Legal framework

In India, the protection of industrial designs is governed by a dynamic legislative framework which is in sync with advances in technology and concomitant international developments. The Designs Act 2000, which repealed and replaced the Designs Act 1911, sets down the statutory framework for the protection of designs and has been in force since May 11 2001. The act not only provides for minimum standards of protection for industrial designs, as contemplated in the World Trade Organisation Agreement on Trade-Related Aspects of IP Rights (TRIPs), but also conforms to international trends in design administration. In conjunction with the Designs Rules 2001 (as amended in 2008), the act streamlines the procedural aspects of registering and processing design applications. India is also party to a number of international treaties which protect international designs, including the Paris Convention and TRIPs. Although India is not a signatory to the Locarno Agreement, the classification of articles to which a design is applied is based on the International

Classification of Industrial Designs as per the agreement.

Unregistered designs

An unregistered design is not enforceable under the law, so a design must be registered in order to enjoy protection. However, it may be possible to protect a design under other legislation (see “Related rights” below).

Registered designs

Traditionally, Indian design protection has been based on copyright rather than patents. A ‘design’ has been defined statutorily to mean “features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether 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”. This definition is exhaustive and all statutory requirements must be fulfilled by the feature in order to constitute a design under the act.

The key requirement is the feature's ability to appeal to the eye. This implies that the feature must be visible on the article and have aesthetic or artistic merit or visual appeal.

Often an article may have both aesthetic and functional features; in such cases, Indian legislation provides that "any mode or principle of construction or anything which is in substance a mere mechanical device" does not warrant design protection. Thus, if the features of the article are purely functional or the article's appearance enhances its functional features, design protection is not possible. In addition, the feature must be applied to an article by an industrial process or means. Once all of these requirements are fulfilled, the feature may be called a 'design' under the act and becomes eligible for registration, provided that:

- it is new or original;
- it has not been disclosed by prior publication or use or in any other way;
- it is sufficiently distinguishable from known designs or their combination; and
- it contains no scandalous or obscene matter and is not contrary to public order or morality.

Although the novelty requirement is absolute, the act provides an exception in the form of a six-month grace period in case of disclosure of the design before filing. The grace period is available only if:

- the design is disclosed, used or published in an exhibition notified by the government;
- the exhibitor exhibiting the design or article gives prior notice to the controller of designs; and
- the application for the design is filed within six months of the first exhibition of the design.

Procedures

While the Indian Patent Office has four offices (Chennai, Delhi, Kolkata and Mumbai), the Design Office is based solely in Kolkata. Accordingly, design applications filed in the other three offices are sent to Kolkata. At the time of writing, the electronic filing of design applications is not possible, but it is expected to be available shortly.

In order to file an application to register a design, the applicant must complete Form 1, which includes its full name, address, nationality, the name of the article, the class number and the address for service in India. The application may be signed by the applicant or its authorised agent. The following must accompany Form 1:

- a fee of Rs1,000 (approximately \$20);
- four copies of the design;
- a brief statement of novelty endorsed on each copy;
- in case of a convention application, the priority documents; and
- if the application is filed by an agent, a power of attorney.

Number of designs allowed

If a particular design is to be registered for articles in different classes, separate applications must be filed. Further, a design may be registered for different embodiments, provided that a separate application is filed in India for each embodiment. The filing of multiple embodiments of the same article in a single application is not permissible under Indian law. In order to protect part of an article, each part must meet the requisite condition of "capable of being made and sold separately". If part of the article is capable of being made and sold separately and can be judged solely by the eye, design protection can be obtained for such part. Design protection can also be claimed for a set of articles. Indian law defines a 'set' as "a number of articles of the same general character ordinarily sold together or intended to be used together, all bearing the same design, with or without modification insufficient to alter the character or substantially to affect the identity thereof". Examples include furniture sets, tea sets and dinner sets.

Representation requirements

There are no specific requirements regarding the number of drawings to be filed alongside an application. The rules provide that a design for which protection is sought should be represented exactly in drawings, photographs, tracings or other representations of the design. The representations should clearly show the details of elements of the design



Applicants should follow the procedural requirements carefully, as around 90% of Indian design applications are objected to on procedural issues

which are sought to be protected. In case of a claim for surface ornamentation, a photograph or computer graphic must be submitted. In order to claim the shape and configuration of an article, it is advisable to file all basic views of the article (ie, top and bottom, front and back, left and right side and perspective views).

Examination

The Indian Design Office conducts both procedural and substantive examinations. A novelty search is conducted in the database of earlier designs applied for, registered and published in India. The representations of the design are checked to ascertain whether they clearly exhibit the claimed features of the design. The examiners also examine the class of the article and whether the article to which the design is applied is capable of being sold separately. If the design, as applied for, does not comply with any legal requirement, an office action is issued. Under current practice, an office action is issued around two to three months after the date of filing and the applicant must file its response to the office action within six months of the date of filing. This period can be extended by three months, provided that a prior application seeking such an extension is filed with the controller of designs. In exceptional cases, where it is not possible to show the design by way of representation, the Designs Office may direct that a sample of the article be submitted.

The Design Office's procedural objections to design applications usually comprise requests for an assignment document, power of attorney and/or certified copies of the

priority documents. If the highlighted defects are not rectified, the applicant is heard in person. After the hearing, the controller decides whether the application should be accepted. The controller's decision is communicated in writing to the applicant or its agent, stating the reasons for the decision. The controller's decision to refuse a design registration may be appealed to the high court within three months of the controller's decision.

Once examined and accepted, the design is registered in the Register of Designs and a certificate of registration is issued within three months of acceptance. Thereafter, the registration is published in the *Official Journal*. The term of protection of a registered design is 10 years from the date of the application and can be extended for a further five years if the extension fee is paid.

Cancellation

There is no procedure to oppose registration of a design under Indian law. However, a cancellation procedure exists under which any interested person may file a petition for cancellation of a registered design at any time after registration of the design with the controller on one of the following grounds:

- The design has previously been registered in India;
- The design has been published in India or in any other country before the date of registration;
- The design is not a new or original design;
- The design is unregistrable under the act; or
- The design is not a 'design' as defined under Section 2(d) of the act.

On receipt of a petition for cancellation, the Design Office sends a copy of the petition and the evidence filed to the registered owner. Thereafter, the registered owner files a counterstatement and evidence at the Designs Office and delivers a copy to the petitioner. After receipt of the counterstatement and evidence, the petitioner may file its reply statement and evidence by way of affidavit. A hearing is fixed and, after hearing the parties, the controller rules on the petition and issues an order.

Enforcement

The registered owner of a design enjoys the exclusive right to apply a design to the article in the class in which the design has been registered. A registered owner can file an infringement suit. A registered design in India can be enforced by way of a civil action. The remedies against infringement include interim and permanent injunctions, damages and a fixed penalty of up to Rs50,000 (\$820).



Omesh Puri
Senior associate
omesh@lexorbis.com

Omesh Puri is a Senior Associate at LexOrbis with more than seven years' experience in IP practice. He has undertaken a wide array of work in the areas of trademarks, copyright and designs. In addition, Mr Puri has significant litigation experience before various Indian courts and the Intellectual Property Appellate Board. Mr Puri's current focus is trademark, copyright and design prosecution and contentious and transactional practice across other IP areas.

A civil action enforcing a registered design can be filed before the district court where the defendant resides or carries on business or the place where the infringement has taken place. In addition to using the defence of non-infringement, the infringer can use the defence of invalidity of the design on the grounds that the design lacks novelty, is undistinguishable from a known design or contains scandalous matter. If the defence of invalidity is used in a civil action, the district court no longer has jurisdiction and the suit is transferred to the high court with jurisdiction over that district court. Under the act, the registered owner of a design should mark the article with the word 'Regd' or 'Registered' and the registration number, except in cases of textile designs and articles made of charcoal dust. If the marking is missing, the owner is not entitled to claim damages. The Indian courts regularly deal with design infringement matters and a robust body of case law lays down the established legal principles.

Ownership changes and rights transfers

According to Indian design law, the right in a registered design can be transferred by way of assignment, agreement, transmission or licence. Registration of title based on assignment must be filed with the Design Office within six months of execution of the assignment instrument. A further extension of six months can be sought. There is no way to extend this period beyond one year after the effective date of the instrument. The law also provides for the recordal of a licence, which must be done within six months of issue. Only a registered licence or a registered assignment in respect of a registered design is admissible as evidence before the courts or in any other proceeding, and therefore such instrument must be registered with the Design Office.

Related rights

If an unregistered design has become distinctive due to long and continuous use, it may be protected under the common law tort of passing off. However, in order to claim passing off successfully, the design owner must establish that the design has become distinctive of the goods on which it is used

through continuous use. While no specific use period is required to satisfy the acquired distinctiveness requirement, the use should be continuous and should make the design distinctive. Accordingly, the owner must be able to establish factually that the concerned design is associated exclusively with its article, and that use of a similar design would create confusion among the public.

In addition, copyright protection for a design may be claimed under the Copyright Act 1957 if the design was capable of registration under the Designs Act, but was not registered. However, in such case protection is limited and expires once the design has been applied to more than 50 articles by an industrial process. Thereafter, the unregistered design has no statutory protection and is susceptible to copying. Thus, it is advisable to obtain design protection to ensure adequate and effective protection.

Comment

India has a well-defined and efficiently managed regulatory and institutional framework for the protection of industrial

designs. Substantive criteria for protection have been prescribed and are in line with international standards. The procedural formalities are simple, time constrained and cost effective. However, applicants should follow the procedural requirements carefully, as around 90% of Indian design applications are objected to on procedural issues, while few are objected to based on the substantive criteria. Thus, it is important to ensure that both the application form and representation sheet comply with the guidelines so that design applications are processed speedily and efficiently. **WTR**

LexOrbis | INTELLECTUAL
PROPERTY
ATTORNEYS

LexOrbis
709-710 Tolstoy House
15-17 Tolstoy Marg
New Delhi-110001
India
Tel +91 11 2371 6565
Fax +91 11 2371 6556
Web www.lexorbis.com