

Designs

2020

A Global Guide

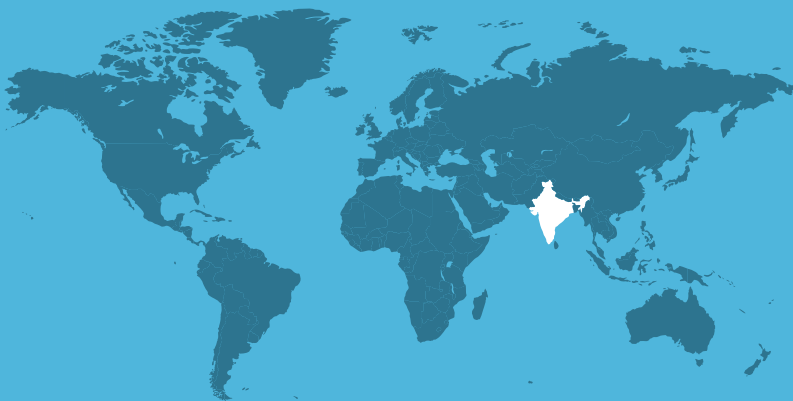
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India

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WTR



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Legal framework

The protection of industrial designs in India is governed by a dynamic legislative framework which is aligned 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 The Designs Act 2000, which repealed and replaced the Designs Act 1911, sets down the statutory framework for the protection of designs and has been in force since 11 May 2001.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 and 2014), the act streamlines the procedural aspects of registering and processing design applications. The 2014 amendment to the Designs Rules brings in 'small entity' as a new category of applicant in addition to natural persons. India is also party to various international treaties which protect international designs, including the Paris Convention and TRIPs. In 2019 India

acceded to the Locarno Agreement, which will help the Indian Design Office to harmonise the classification systems in line with those followed globally.

Unregistered designs

An unregistered design is not enforceable under the law, so a design must therefore be registered in order to enjoy protection. However, it may be possible to protect a design under other legislation.

Registered designs

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



In order to protect part of an article, each part must meet the requisite condition of being ‘capable of being made and sold separately’

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.

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 branches (in Chennai, Delhi, Kolkata and Mumbai), there is only one branch of the Design Office, which is found in Kolkata. Accordingly, design applications filed in the other three offices are sent to Kolkata. An electronic filing facility has also been introduced for the filing of new applications to register a design. All applicants or stakeholders can now file design applications online through the official portal of the Office of the Controller General of Patents, Designs and Trademarks (at www.ipindia.nic.in). The e-filing facility includes a comprehensive payment gateway which accepts electronic banking, as well as debit and credit cards. The Design Application Search Utility also enables applicants to search for published design applications through a number of search inputs (eg, an application number, applicant’s name, state and country, date of filing, publication date and name of article). 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 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:
 - Rs1,000 (approximately \$16) for natural persons;
 - Rs2,000 (approximately \$32) for small entities; or
 - Rs4,000 (approximately \$64) for any other type of entity;
- two copies of the design;
- a brief statement of novelty endorsed on each representation sheet;
- the priority documents, in case of a convention application; and
- a power of attorney, if the application is filed by an agent.

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 being “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 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 and drawing 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 representation should clearly show the details of elements of the design 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). Dotted lines are not acceptable.

Examination

The 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 to which the design is applied and whether it 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 one to two 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 Design Office may request the submission of a sample of the article. The Design Office's procedural objections to design applications usually comprise requests for a power of attorney, clear drawings and certified copies of the priority documents. If the highlighted defects are not rectified, the applicant will be heard in person.



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Omesh Puri has more than 10 years' IP experience and is a partner and head of the LexOrbis trademarks, copyright and designs practice. He has undertaken a wide array of assignments in the prosecution, litigation and enforcement of IP rights and has significant experience in handling domain name disputes before the National Internet Exchange of India and WIPO, as well as in commercial agreements, advertising, privacy and IT issues. He regularly advises on complex commercial and IP transactions and has significant experience in litigation at various Indian courts and the Intellectual Property Appellate Board. He is responsible for large IP portfolios from various industries, including pharmaceuticals, food and beverages, computer software, fashion, automobiles and liquor.

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 generally issued within three months of acceptance. Thereafter, the registration is published in the *Official Journal*. The term of protection for a registered design is 10 years from the date of the application



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

and can be extended for a further five years on payment of an extension fee.

Cancellation

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

- the design has been previously 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 Design 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, as well as

damages. A civil action enforcing a registered design can be filed before the district court where the defendant resides or conducts business or where 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 indistinguishable 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 mark is missing, the owner is not entitled to claim damages. 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 and licensing. 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 time 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 as a result of continuous use. While no specific use period is necessary to satisfy the acquired distinctiveness requirement, the use should be continuous and 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 being registered under the Designs Act but was not registered. However, in such cases protection is limited and expires once the design has been applied to more than 50 articles by an industrial process. The judgment of a division bench of Delhi High Court in *Microfibres Inc v Girdhar & Co* (2009) provided much needed clarity with respect to the conflict between 'original artistic work' as defined under the Copyright Act and 'design' as defined in the Designs Act. It was held that copyright would exist in the original work of art and the author or copyright holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work. The court held that the legislative intent was to grant greater protection to original, purely artistic works (eg, paintings and sculptures) and lesser protection to design activity which is commercial in nature. The protection accorded to a work

which is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure art.

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 most Indian design applications are rejected on procedural issues, while very few rejections are due to a lack of fulfilment of substantive criteria. Thus, it is important to ensure that both the application form and the representation sheet comply with the guidelines so that design applications are processed speedily and efficiently. **WTR**

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