

The logo for iclg, with a small orange dot above the 'i' and the letters in a bold, lowercase sans-serif font.

iclg

Designs **2025**

Fifth Edition

Contributing Editor:

Ewan Grist

Bird & Bird LLP

glg Global Legal Group

Expert Analysis Chapter

- 1** Lookalike products in the UK: a game of (copy)cat & mouse?
Ewan Grist, Bird & Bird LLP

Q&A Chapters

- 5** **Brazil**
Alexander Rodrigues, Alexandre M. Altberg & Saulo Calazans, magellan IP
- 13** **Canada**
Jean-Charles Grégoire, Amrita V. Singh, Kevin Shipley & Paul Horbal, Marks & Clerk
- 21** **Chile**
Trinidad Rojas & Felipe Claro, Claro & Cia.
- 28** **Czech Republic**
Dominik Bajger, Čermák a spol.
- 35** **France**
Catherine Mateu, Armengaud Guerlain
- 43** **Germany**
Alexandra Dellmeier, Freia Andrea Schreiber & Elisabeth Sandmair, LexDellmeier Intellectual Property Law Firm
- 51** **Ghana**
Abena Ntrakwah-Mensah, Alberta Kyeremeh, Courtney Heather Awotwi & James McKeown Debrah, Ntrakwah & Co.
- 59** **Greece**
Eleni Kokkini, PPT Legal
- 67** **India**
Abhai Pandey & Swati Pathania, LexOrbis
- 76** **Israel**
Ena Pugatsch, Rakefet Peled & Helena Kushmaro, Reinhold Cohn Group
- 84** **Japan**
Yoshikazu Iwase, Yuta Komatsu, Eriko Kinoshita & Yuka Maeda, Anderson Mōri & Tomotsune
- 92** **Mexico**
Juan Rodrigo Pimentel Esquivel & Jorge Mier y Concha, Arochi & Lindner
- 99** **Philippines**
Rogelio Nicandro & Juan Carlos Novero, ROMULO
- 109** **Spain**
Marina Gómez Calvo, Arochi & Lindner
- 122** **Switzerland**
Anne-Virginie La Spada, BMG Avocats
- 130** **Taiwan**
Clarice Chen, Simon Hsiao & Yih-Feng Chen, Sigma IPR
- 139** **Ukraine**
Oleg Zhukhevych, Olga Kreshchenko & Olga Danish, ADVANCE PARTNERS
- 150** **United Kingdom**
Ewan Grist & Louise Sargeant, Bird & Bird LLP
- 158** **USA**
Christopher V. Carani, Dunstan H. Barnes, Sarine R. Hagopian & William E. Danziger, McAndrews, Held & Malloy

India



Abhai Pandey



Swati Pathania

LexOrbis

1 Relevant Authorities and Legislation

1.1 What is the relevant Design authority in your jurisdiction?

The relevant design authority in India for granting registration to designs is the Office of the Controller General of Patents, Designs and Trade Marks, which regulates the Indian Design Office. The Design Office is headquartered in Kolkata, with the facility to file design applications at the other branches of the Indian IP Offices located in Chennai, Delhi and Mumbai. However, all design applications filed at any of the IP Offices are processed at the Design Office at Kolkata, where registered designs are maintained.

1.2 What is the relevant Design legislation in your jurisdiction?

The relevant pieces of design legislation in force in India are the Designs Act, 2000 and the Designs Rules, 2001 made thereunder.

2 Application for a Design

2.1 What can be registered as a Design?

“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” are protectable subject matter under designs law in India. A “design”, however, does not include any mode or principle of construction or anything that is, in substance, a mere mechanical device. Designs law also exclude from registrability any trademark or property mark or any artistic work under copyright law.

For protection, a design must be new and original. “New” in this context means that the subject design must not have been previously published anywhere in India or any other country in a tangible form or by use or in any other way. “Original” implies that the design should originate from the author of the design, but as a matter of fact, old designs that are new in terms of application are also considered “original”.

Indian designs law protects any new and original design that is capable of being applied to an article. The feature becomes eligible for registration, provided that it:

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

2.2 What cannot be registered as a Design?

A design cannot be registered if it:

- is not new or original, i.e. it has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date or, where applicable, the priority date of the application for registration;
- is not significantly distinguishable from any known designs or a combination of known designs;
- comprises or contains scandalous or obscene matter;
- includes any mode or principle of construction or operation or anything that is, in substance, a mere mechanical device; or
- is a trademark, property mark or artistic work.

2.3 What information is needed to register a Design?

The following information is required to register a design:

- the name, address and nationality of the applicant;
- the title and nature of the article;
- the class and subclass under the Locarno Classification;
- priority details and a certified copy of the priority document, along with an English translation, in case the priority is claimed, or WIPO Digital Access Service (DAS) code; and
- a simply signed Power of Attorney in an original form signed by the authorised signatory of the applicant (no notarisation and legalisation is required).

2.4 What is the general procedure for Design registration?

Once a design application is filed, it is examined and if no objections are found, the design will be accepted and a certificate of registration will be issued within two to three months. In case of objection, a First Examination Report is issued within one month from the date of filing. A response to the Examination Report should be filed within six months from the filing date.

An extension period of three months is available on a request filed with the Design Office and on payment of an official fee prior to the expiry of the said due date. In case any objection is outstanding after the filing of a response, the Design Office may call for a hearing to discuss and comply with the pending issues, if any. If all the objections are addressed in the response to the Examination Report to the satisfaction of the Controller of Designs/Examiner, the application is accepted within six months from the date of filing and a certificate of registration is issued within six to 10 months from the date of filing.

2.5 How is a Design adequately represented?

A design is adequately represented by seven photographic views of the article on which the design is applied, namely the: perspective; front; back; top; bottom; left; and right view. The representation can also be filed as drawings in clear solid lines with no extraneous matter in the background.

2.6 Are Designs registered for specific goods or products?

Yes, designs are registered for specific products. A design may be registered in respect of any or all of the articles prescribed in the class of articles under the Locarno Classification.

2.7 Is there a "grace period" in your jurisdiction, and if so, how long is it?

Yes, a six-month grace period is available, limited to the disclosure made in a notified exhibition or trade show and where prior notice of such public disclosure is given to the Controller of Designs. Prior publication without notification to the Controller of Designs disqualifies a claim for a grace period.

2.8 What territories (including dependents, colonies, etc.) are or can be covered by a Design in your jurisdiction?

The statutory rights of a design registered in India extend throughout the territory of India.

2.9 Who can own a Design in your jurisdiction?

Any person claiming to be the proprietor of any new or original design may apply for design registration and that person can be a natural or legal person, such as any company, association or body of individuals, whether incorporated or not, or society or partnership firm.

2.10 How long on average does registration take?

Registration of a design in India generally takes about four to five months from the date of filing the application, if no objections are found. In case an Examination Report is issued in the application, then registration of the design can take eight to 10 months from the date of filing the application.

2.11 What is the average cost of obtaining a Design in your jurisdiction?

The average cost of obtaining a design registration in India is

between USD 500 and USD 1,000, depending on factors such as issuance of Examination Report or hearing, etc.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, as of now in India there is only one route to register a design, i.e. by filing a national application.

2.13 Is a Power of Attorney needed?

Yes, a Power of Attorney is required if the application is filed through an attorney/agent.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, there is no need for legalisation or notarisation of the Power of Attorney. The Power of Attorney, however, should be hand/ink signed by the authorised signatory of the applicant and the original signed Power of Attorney is required to be filed with the Design Office.

2.15 How is priority claimed?

Priority can be claimed under the Paris Convention. To claim such priority, the applicant should file an Indian design application within six months from the date of filing the priority application. Indian applications must include filing details of the basic priority application, and the applicant is required to submit the certified copy of the priority document along with its verified English translation if the priority is not in the English language. The priority document can be filed at the time of filing the Indian application or within a period of three months from the date of Indian filing with additional fees.

2.16 Can you defer publication of Design applications in your jurisdiction? If so, for how long?

No, as of now there is no provision in Indian designs law to defer the publication of an application.

3 Grounds for Refusal

3.1 What are the grounds for refusal of registration?

The grounds for refusal of a design registration are the following:

- a) it is not new or original;
- b) it has been disclosed by prior publication, use or in any other way;
- c) it is not sufficiently distinguishable from known designs or their combination;
- d) it is not a design under the Designs Act; and
- e) it contains scandalous or obscene matter and is contrary to public order or morality.

3.2 What are the ways to overcome a grounds objection?

The applicants should follow the procedural requirements

carefully, as most Indian design applications are objected to on procedural issues, such as late filing of priority documents, Power of Attorney, unclear representation sheets, etc. Therefore, it is important to ensure that both the application form and the representation sheet fully comply with the provisions of the Designs Act and Designs Rules.

The substantive grounds of refusal, such as prior publication, can be overcome by highlighting the difference between prior designs and designs applied for registration. For other objections, the applicant must file a specific reply depending on the facts and merits of each objection.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision for refusal of registration of a design application can be appealed before the High Court of Calcutta within three months from the date of such order.

3.4 What is the route of appeal?

An appeal against the decision of the Design Office can be filed with the High Court.

4 Opposition

4.1 Can a Design application be opposed, and if so, on what grounds?

No, there is no provision for opposing a design application. However, once registered, any person interested in said design can file a rectification/cancellation application.

4.2 Who can oppose the registration of a Design in your jurisdiction?

There is no provision for opposition under Indian designs law. However, a cancellation action can be filed by any person interested in the design.

4.3 What is the procedure for opposition?

Please see question 4.2 above.

5 Registration

5.1 What happens when a Design is granted registration?

When an application is accepted and registered, a certificate of registration is issued to the applicant. It is advisable that the applicant must mark the articles on which the design is applied with a sign "REGD." or "REGISTERED", with or without the registration number to notify the public that the design is registered. The registration of a design confers upon the registered proprietor "exclusive copyright" on the design for the period of registration. It allows the proprietor of the design to prevent others from producing, importing, selling, or distributing products that have an identical appearance to, or are a fraudulent or obvious imitation of, their registered design.

5.2 From which date following application do an applicant's Design rights commence?

The rights originate from the date of filing of the design application or the priority date, as the case may be.

5.3 What is the term of a registered Design right?

The term of protection of a design is 15 years, subject to renewal before the expiry of an initial period of 10 years from the date of filing/priority date.

5.4 How is a Design renewed?

An application for extension of copyright (Form-3), along with prescribed fees, should be filed with the Design Office before the expiry of the original period of 10 years.

6 Registrable Transactions

6.1 Can an individual register the assignment of a Design?

Yes, an individual can register the assignment of a design.

6.2 Are there different types of assignment?

According to Indian designs law, the right in a registered design can be transferred by way of assignment. There are no different types of assignment. An application in Form-10, with prescribed fees in respect of one design and appropriate fees for each additional design, for registration of the transfer documents, is required to be made by the beneficiary to the Controller of Designs within six months from the date of execution of the instruments or within a further period not exceeding six months in aggregate. An original/notarised copy of the assignment deed is required to be enclosed with the application.

6.3 Can an individual register the licensing of a Design?

Yes, an individual can file to register the licensing of a design. Only a registered licence in respect of a registered design is admissible as evidence before the courts or in any other proceeding; therefore, such an instrument must be registered with the Design Office.

6.4 Are there different types of licence?

Yes, a licence can be exclusive or non-exclusive. A licence is only valid if it is in the form of a written instrument containing detailed terms of the licensing arrangement.

6.5 Are there any laws that limit the terms upon which parties may agree a licence?

No, there are no laws that limit the terms upon which parties may agree a licence.

6.6 Can Designs be the subject of a compulsory licence (or licences of right), and if so, in what circumstances does this arise and how are the terms settled?

No, designs cannot be the subject of a compulsory licence.

6.7 Can a Design licensee sue for infringement?

No, only the registered proprietor may institute proceedings for design infringement.

6.8 Are quality control clauses necessary in a licence?

A licence agreement needs to be in the form of a written instrument containing all the terms and conditions governing a party's rights and obligations; therefore, quality control clauses are advisable.

6.9 Can an individual register a security interest under a Design?

Yes, an individual can register a security interest including interest of any kind whatsoever on a registered design. This includes any mortgage, charge, hypothecation or assignment.

6.10 Are there different types of security interest?

Yes, a security interest can include the right, title and interest of any kind whatsoever upon property (which includes designs) created in the favour of a secured creditor, and includes any mortgage, charge, hypothecation or assignment.

7 Invalidity

7.1 What are the grounds for invalidity of a Design?

Any interested person may file a petition for cancellation of a registered design at any time after the registration with the Controller of Designs if the design:

- has been previously registered in India;
- has been published in India or another country before the date of registration;
- is not a new or original design;
- is unregistrable under the Designs Act; or
- is not a "design" as defined under Section 2(d) of the Designs Act.

7.2 What is the procedure for invalidation of a Design?

A registered design can be cancelled at any time after the registration of the design by filing a petition for cancellation in Form-8 with prescribed fees to the Controller of Designs. 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 counter-statement 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 of Designs rules on the petition and issues an order.

7.3 Who can commence invalidation proceedings?

Only an aggrieved person can institute invalidation proceedings.

7.4 What grounds of defence can be raised to an invalidation action?

The ground of prior publication and lack of novelty can be overcome by highlighting the difference between prior designs and registered designs. For other grounds, the registered proprietor may prepare for its defence depending upon the facts and merits of each ground.

7.5 What is the route of appeal from a decision of invalidity?

Any person aggrieved by the order of the Controller of Designs may file an appeal to the High Court of Calcutta within three months of the date of the order.

8 Design Enforcement

8.1 How and before what tribunals can a Design be enforced against an infringer?

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 and 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.

8.2 Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

In addition to using the defence of non-infringement, the infringer can challenge the validity 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 having jurisdiction over that District Court where the suit was filed. However, the registered design can only be cancelled by filing a cancellation petition with the Design Office.

8.3 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial procedure in a civil suit comprises several stages that are preceded by the filing of the suit (plaint) before the appropriate court. This court could be the District Court or High Court (having original jurisdiction). The stages of a civil suit until trial are explained below:

- **Stage 1:** Admission of suit and a hearing on the interim injunction application, if the suit is accompanied with an interim injunction application under Order 39 Rules 1 and 2 seeking interim relief.

On the first hearing, the court reviews the grounds of injunction pleaded in the plaint and in the interim injunction application. If the court decides that the Plaintiff has made a suitable case for the grant of an interim injunction and the balance of convenience is in favour of the Plaintiff, it passes an interim injunction order and simultaneously issues summons to the Defendant for appearance in further hearings and to file its written statement within 30 days of issuance of summons extendable up to 120 days, on showing reasonable cause.

- **Stage 2:** Service of court summons on the Defendants by the Plaintiff in case of issuance of an *ex parte* interim injunction and by the court's Registry in other cases.
- **Stage 3:** Appearance of the Defendant and filing of its written statement. The Defendant is allowed a period of 30 days upon service of a court summons to file a written statement and enter appearance on the date of hearing indicated in the summons. In cases where an *ex parte* injunction order has been passed against the Defendant, the Defendant is at liberty to file an application seeking vacation of the interim injunction order under Order 39 Rule 4 and reply to the Plaintiff's interim injunction application.
- **Stage 4:** Filing of reply, rejoinder and replication by parties involved. Both sides have the opportunity to file responses to the applications filed by the other side. For example, the Plaintiff can file replication to the written statement filed by the Defendant, file a reply to the Defendant's application seeking vacation of the interim injunction, and file a rejoinder to the reply filed by the Defendant in the Plaintiff's interim injunction application.
- **Stage 5:** The court decides the Plaintiff's application for a confirmation of grant of an interim injunction based on contentions put forth by both sides.
- **Stage 6:** Admission/denial of documents filed by both sides.
- **Stage 7:** Framing of issues by the court.
- **Stage 8:** The parties' witnesses lead their respective evidence under affidavits and witnesses are examined and cross-examined. Thereafter, the final arguments take place in the suit followed by the court's judgment.

It generally takes anywhere between 18 to 24 months in disposal of the suit, post-trial.

8.4 Are (i) preliminary, and (ii) final injunctions available, and if so, on what basis in each case?

Both preliminary/interim and final injunctions are available. The preliminary injunctions are issued on the basis of three factors: a *prima facie* case; balance of convenience; and irreparable injury.

8.5 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary, and if so, how?

Yes, a party to the suit can file an application to demand any document or information or material in possession of the other party, after seeking leave of the court.

8.6 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The submissions and evidence are presented in writing as well as orally during the court proceedings. The cross-examination of witnesses is a standard practice in civil suits in India.

8.7 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The invalidity of a design registration can only be decided by the Design Office, and there is no provision for a stay of infringement proceedings pending resolution of the invalidity of the design. However, it is important to note that in a civil suit, every ground on which the registration of a design may be cancelled shall be available as a ground of defence.

8.8 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

A registered design in India can only be enforced by way of a civil action, and there are no alternative procedures available to enforce such rights in India. However, before approaching the courts, the rights holders may explore sending a cease-and-desist notice to infringers, and it is more frequent that the infringers do decide to comply with the demands of rights holders.

8.9 Who is permitted to represent parties to a Design dispute in court?

Any Advocate registered with Bar Councils can only represent parties in a design dispute in court.

8.10 After what period is a claim for Design infringement time-barred?

A claim for design infringement becomes time-barred three years after the act of infringement.

8.11 Are there criminal liabilities for Design infringement?

No, the registered design can be enforced by way of civil actions only. There are no criminal liabilities.

8.12 If so, who can pursue a criminal prosecution?

Criminal prosecution is not available in design infringement.

8.13 What, if any, are the provisions for unauthorised threats of Design infringement?

There are statutory provisions under Indian designs law that deal with remedies in cases of groundless threats of legal proceedings. The court has the power to grant relief in cases of groundless threats of design infringement proceedings.

The person aggrieved by a groundless threat may bring a suit praying for the following relief:

- a) a declaration to the effect that the threats are unjustifiable;
- b) an injunction against the continuance of the threats; and
- c) such damages, if any, as he has sustained thereby.

9 Defences to Infringement

9.1 What grounds of defence can be raised by way of non-infringement to a claim of Design infringement? For example, are there "must match" and/or "must fit" defences or equivalent available in the jurisdiction?

A suit for infringement may be defended on the grounds that the Defendant's design is not similar to the Plaintiff's design and/or it was used prior to the Plaintiff's design. In deciding whether there is any similarity between the Plaintiff's and Defendant's designs, the legal test is to check for "fraudulent or obvious imitation" in the accused design *vis-à-vis* the registered design. This means that the infringing design need not necessarily be identical to the registered design; even some variation that is not substantial enough to differentiate the accused design from the registered design can amount to infringement. Every resemblance does not seem to be the action of infringement or imitation. An obvious imitation is one where it is immediately obvious that another design is so similar to the original registered design that it is almost impossible to differentiate. The two products need not be placed side by side, but rather examined from the point of view of a customer with average knowledge and imperfect recollection.

9.2 What grounds of defence can be raised in addition to non-infringement?

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 Plaintiff's design lacks novelty, is indistinguishable from a known design, or contains scandalous matter. The following defences are available:

- 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 Designs Act; or
- the design is not a "design" as defined under Section 2(d) of the Designs Act.

9.3 How does your jurisdiction deal with Design protection for spare parts?

According to the Designs Act, a part of an article is registrable provided that it is capable of being made and sold separately. If the spare part has aesthetic appeal and is capable of being made and sold separately, it can be registered as a design in India.

10 Relief

10.1 What remedies are available for Design infringement?

The remedies against infringement include interim and permanent injunctions, damages and costs.

10.2 Are damages or an account of profits assessed with the issues of infringement/validity or separately?

The damages in a civil action, or the account of profits, are assessed along with any infringement issues. Damages suffered by the Plaintiff as a result of infringement are recoverable.

10.3 On what basis are damages or an account of profits assessed?

The damages are assessed depending on the loss assessed to have been suffered by the Plaintiff due to the infringement and/or the flagrancy of the Defendant's conduct. In case of piracy of a registered design, a suit for injunction and/or recovery of damages may be instituted against the accused in any court not below the Court of the District Judge. Any of the remedies as prescribed below can be sought against the accused:

- a) paying to the registered proprietor of the design a sum not exceeding INR 25,000, recoverable as a contract debt, provided that the total sum recoverable in respect of any one design shall not exceed INR 50,000; or
- b) recovery of damages for any such contravention, and an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly.

10.4 Are punitive damages available?

Yes, punitive damages are available depending upon the flagrancy of the conduct of the Defendant and the nature of the violation and/or whether the Defendant is a habitual/repeat offender.

10.5 Are costs recoverable from the losing party, and if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, the costs are recoverable from the losing party. The court examines such prayers. However, actual recovery of costs depends upon several factors, such as intention of the parties, *quantum* of loss, merits of the case, evidence submitted before the court, etc.

11 Appeal

11.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Yes, generally an appeal is maintainable on a point of law; however, an appeal may be based on a mixed question of facts and law. An appeal shall lie with the High Court and if the suit has been tried by the District Court. However, if the suit is tried by the Single Judge Bench of the High Court, then an appeal can be filed before the Two Judges Bench (Division Bench) of that High Court.

11.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be adduced in the following situations:

- a) if the court or tribunal from whose order the appeal is preferred has refused to admit evidence that it ought to have admitted;

- b) if the party seeking to adduce the evidence establishes that such evidence was not within its knowledge or could not be obtained despite due diligence and efforts; or
- c) if the appellate court requires any document to be produced or any witness to be examined to enable it to pronounce the judgment.

12 Border Control Measures

12.1 Is there a mechanism for seizing or preventing the importation of infringing articles, and if so, how quickly are such measures resolved?

The Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, notified under the Customs Act, 1962, provide a comprehensive executive and legal framework for the purpose of preventing importation of infringing goods in India. Under these Rules, an IP rights holder may give notice to the Customs Commissioner, in the prescribed format and containing all requisite information, requesting for the suspension of clearance of goods suspected to be infringing in nature. Such notice is generally registered or rejected within 30 working days from the date of receipt of the notice. In cases where the notice is registered, the minimum validity period shall be one year, unless the rights holder requests for a shorter period of Customs assistance or action. If the Customs Department, based on the notice given by the IP rights holder, has a reason to believe that the imported goods are suspected to be infringing in nature, it shall suspend the clearance of such goods. The Customs Department may even, *ex officio*, suspend the clearance of the alleged infringing articles if the department has *prima facie* evidence or reasonable grounds to believe that the imported goods are counterfeit/pirated/infringing in nature. The IP rights holder is also required to issue a bank guarantee and furnish a bond. The Customs Department is under a duty to inform the rights holder and importer immediately about the suspension of clearance of goods, along with the reasons for such suspension. Goods for which clearance is suspended are to be released on notice 10 days from the date of suspension (extendable by a further period of 10 days) when the rights holder fails to join proceedings within the said period, or, on the department's own initiative of suspension, five days from when the rights holder fails to give notice or fails to fulfil its obligations under the aforesaid Rules.

The Customs Department is authorised to seize and confiscate goods where it has reason to believe that the goods are infringing IP rights and are thus liable to be confiscated under the Customs Act. In case the Customs Department determines that the goods detained or seized have infringed IP rights and have been rightly confiscated under Section 111(d) of the Customs Act and no legal proceedings are pending in relation to such determination, the department shall destroy such goods under official supervision or dispose of them outside the normal channels of commerce after obtaining "no objection" or concurrence from the rights holder.

13 Other Related Rights

13.1 To what extent are unregistered Design rights enforceable in your jurisdiction?

Unregistered designs are not enforceable in India under designs law.

13.2 What is the term of unregistered Design rights enforceable in your jurisdiction?

Please see question 13.1 above.

13.3 What, if any, are the key differences between unregistered and registered Design rights in your jurisdiction?

An unregistered design does not enjoy statutory design protection, and a registered design owner gets the right to file an infringement suit and protect its rights against any third-party use.

13.4 If unregistered Design protection is available in your jurisdiction, is protection cumulative or mutually exclusive?

In unregistered designs, copyright protection is mutually exclusive and would exist as long as the article to which the design is applied is not reproduced more than 50 times by an industrial process.

13.5 Is copyright available to protect industrial Designs?

As per the provisions of Section 15(2) of the Copyright Act, "copyright in any design, which is capable of being registered under the Designs Act, but which has not been so registered, shall cease as soon as any article to which the design has been applied, has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his licence, by any other person".

14 Current Developments

14.1 What have been the significant developments in relation to Designs in the last year?

The significant developments in relation to designs in the last year are as follows:

- A notable increase in the number of filings of design applications in India.
- The pendency in examination of new applications has been brought down to one month from the filing date.
- Submission of physical forms and documents is no longer required, except for an assignment, attested/notarised copy of the original Power of Attorney, and original affidavit (if any) for e-filed applications.
- The forms and documents as prescribed in the Designs Rules (as amended) are required to be filed online and digitally signed in accordance with Sections 3 and 4 of the Information Technology Act, 2000.
- For reciprocity applications, the applicants are required to provide a DAS code for priority documents in accordance with Rule 15 of the Designs Rules (as amended).
- The Office of the Controller General of Patents, Designs and Trade Marks has initiated open house discussions in line with directions received from the Hon'ble Union Minister of Commerce and Industry for seamless and direct communication with stakeholders. This has proved helpful in addressing grievances and receiving valuable feedback and suggestions.

14.2 What do you think are the current challenges or trends in relation to Designs?

The current challenges and trends in relation to designs in India are as follows:

- In the public search portal, all the views of designs are not available except one perspective view. As a result, we have to file certified copy requests with the Design Office.
- In regard to general services, certified copies of an application and registered designs are not provided electronically, instead a physical copy is issued. Also, an official search report from the Design Office is not provided electronically, which delays the process.

- There is no provision for filing a response to official communication electronically for the objections received related to recordal of assignment/name change/address change/renewals. Currently, hard copies of the response to official communications are submitted.

14.3 Are there any significant developments expected in the next year?

The Design Office aims to take measures to remove the backlog and bring down the pendency of amended applications, thereby expediting the registration process.



Abhai Pandey is a Senior Partner and Head of the Litigation and Enforcement Team at LexOrbis. He focuses on IP litigations, criminal enforcement and contested proceedings at the Trademark and Patent Offices. He advises clients on brand protection strategies for social media, the Internet, and advertisements. He has successfully run several anti-counterfeiting campaigns in India for various clients ranging from Fortune 500 companies to individual entrepreneurs. Mr Pandey has made momentous contributions to the industry through his counselling and execution of intellectual property rights (IPR) protection strategies covering all forms of IPR, including Patents, Trademarks, Designs and Copyright and leading Anti-Piracy and Anti-Counterfeiting campaigns for brand and copyright owners while actively undertaking assignments on patent contentious matters including patent oppositions, revocation, and infringement actions. He represents various businesses and industries, including fashion, media and entertainment, publishing, fast-moving consumer goods, pharmaceuticals, biotechnology, electronics, automobiles and information and communication technologies.

Mr Pandey played a prominent role in the first ever anti-piracy campaign initiated by the Global Publishing Industry Association. This pan-India anti-piracy campaign resulted in criminal raid actions of over 500 pirate businesses. The campaign trained the enforcement agencies on multiple aspects of copyright law and enforcement in India.

LexOrbis
709/710, Tolstoy House
15-17, Tolstoy Marg
New Delhi 110001
India

Tel: +91 98 9919 7254
Email: abhai@lexorbis.com
LinkedIn: www.linkedin.com/in/abhai-pandey-5064bb52



Swati Pathania is Associate Partner in Designs. She draws strength from her overall experience of 15 years in practising intellectual property law with emphasis on Indian and foreign design portfolio management. She has significant experience of how to get the best for clients. She works closely and represents a vast portfolio of clients from various industries including the automotive, aerospace, medical devices, fashion, electrical devices and technological fields, consumer products, toy and game industries and cosmetics. She appears for hearings before the Design Office and her practice includes design searching, drafting, filing, prosecution of Indian and foreign applications and maintenance. She has considerable experience in international design portfolio management, IP Strategy and IP due diligence. She has assisted various leading Indian and overseas clients, including large multinational companies, start-ups, medium-sized companies, universities and individuals in design protection and in rendering legal advice. Apart from this, she is involved in preparing and analysing freedom-to-operate assessments and non-infringing opinions, proposing strategies for mitigating risks associated with third-party IP rights and preparing opinion letters to support growth initiatives. This corporate experience on the other side of the client/attorney relationship allows her to quickly recognise what design owners want and how to effectively deliver it. She works directly and closely with clients to ensure their design portfolios make a beneficial return on the investment they make in them. By understanding her clients' business objectives and risk tolerance, she provides clients with advice on freedom-to-operate studies, risk assessment and enforcement of IP rights.

LexOrbis
709/710, Tolstoy House
15-17, Tolstoy Marg
New Delhi 110001
India

Tel: +91 98 9176 3460
Email: swati.pathania@lexorbis.com
LinkedIn: www.linkedin.com/in/swati-pathania-bisht-a8676241

LexOrbis is a premier full-service IP law firm with over 320 personnel, including 180+ attorneys at its five Indian offices in Ahmedabad, Bengaluru, Chennai, Mumbai and New Delhi. The firm provides client-oriented and cost-effective solutions for the protection, enforcement, transaction and commercialisation of all forms of IP in India and globally. The firm has been consistently ranked amongst the Top 5 IP firms in India over the past decade and is well known for managing global patent, designs and trademark portfolios of many technology companies and brand owners. The firm has dedicated teams to cater to the IP lifecycle, including attorneys, engineers, scientists and specialists to deal with patent, trademark and copyright filing, research, portfolio building and management, enforcement, protection, spotting, transacting, procurement and consultation. The trademark practice group at the firm has over 40 attorneys experienced in partnering with brand owners and advising on the entire IP lifecycle from selection to enforcement. The team provides risk assessment by conducting trademark searches in over 120 trademark registers across the world and common law searches using advanced internet-based tools. The firm manages large and complex trademark portfolios of many global

companies, small and medium enterprises and start-ups expanding businesses in India and overseas. The team works closely with investigators and IP litigators for conducting online and offline use, investigations and handling contentious trademark cases such as oppositions, cancellation, infringement and passing-off actions. The group also has expert attorneys in related practice areas such as legal metrology, drugs & cosmetics, food safety, media & entertainment, fashion, sports, e-commerce, data protection, privacy and persona rights, advertisement, consumer protection, etc.

www.lexorbis.com

LexOrbis | Intellectual
Property Attorneys
& Advocates

The **International Comparative Legal Guides**

(ICLG) series brings key cross-border insights to legal practitioners worldwide, covering 58 practice areas.

Designs 2025 features one expert analysis chapter and 19 Q&A jurisdiction chapters covering key issues, including:

- Relevant Authorities and Legislation
- Application for a Design
- Grounds for Refusal
- Opposition
- Registration
- Registrable Transactions
- Invalidity
- Design Enforcement
- Defences to Infringement
- Relief
- Appeal
- Border Control Measures
- Other Related Rights
- Current Developments