

NATURE OF INDUSTRIAL DESIGNS

Subject- Intellectual Property Rights (Paper 2)

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NATURE OF INDUSTRIAL DESIGNS

I. INTRODUCTION-

Consumers are influenced by the appearance of the article of their choice. Many people blindly choose the article which catches their eye by appearance. At the time of purchase, people are attracted by a design which has an artistic merit. Some articles with a particular design may attract the public and within a short period, the whole stock may be sold in the market. Hence, design of goods increases profits by attracting customers.¹

Producers hunt for an attractive design which will increase sales. Some intellectuals do hard work by putting much thought, time and expense to find a design for a particular article which will increase sales. The object of design registration is to see that the creator of a profitable design is not deprived of his reward by others applying it to their goods without his permission.²

Design according to the Indian Designs Act, 2000, means only the features of shape, configuration, pattern or ornament or composition of lines or color 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, but does not include any mode or principle or construction or anything which is in substance a mere mechanical device, and does not include any trade mark.³

¹ Law of Intellectual Property- Dr. S.R Myneni

² Ibid.

³ <http://www.ipcell.iisc.ernet.in> (visited on 28-10-2013)

II. LEGAL REGIME

Protection of Industrial Designs in India-

The Designs Act was passed in 1911 by the then British Government in India. Since then extensive amendments had been made in the Designs Act. Meanwhile, India made tremendous progress in the field of science and technology. There had been considerable increase in the registration of designs. To provide more effective protection to registered designs and to promote design activity in order to promote design element in an article of production, it had become necessary to make the legal system of providing protection to industrial designs more efficient. It was also intended to ensure that the law did not unnecessarily extend protection beyond what was necessary to create the required incentive for design activity while removing impediments to the free use of designs. To achieve these objectives and in order to repeal the Designs Act, 1911 which had been extensively amended, the Designs Bill, was introduced in the Parliament.⁴

Since the enactment of the Designs Act, 1911, considerable progress has been made in the field of science and technology. The legal system of the protection of industrial designs requires to be made more efficient in order to ensure effective protection to registered designs. It is also required to promote design activity in order to promote the design element in an article of production.⁵

An article is distinguished not only by its utility but also by its visual appeal which too usually play an important role in shaping the buyers preference for the article. Therefore, the design of an article and even design of its packaging is important from the commercial point of view.⁶

⁴ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁵ Ibid

⁶ Ibid.

The Designs Act, 2000, after repealing the Act of 1911 aims at protecting the designs which serve the purpose of visual appeal. A design to be registerable under the Designs Act, 2000, must be of some shape, configuration, pattern or ornamentation or composition of lines or colours applied to such article in any form by any industrial process or means but does not include any mode or principle of construction or anything which is in substance a mere mechanical device but does not include any Trade or Property mark or artistic work.⁷

In order to get statutory protection under the Designs Act, 2000 the design has to satisfy the definitional requirements of Section 2(d). As per the definition, design “does not include any mode or principle of construction or anything which is in substance a mere mechanical device.”⁸

The entities having unique and distinct pattern, appearance and design can register under Indian Design Act. The registered owner, under the act, gets the exclusive right to apply the design to any article in the class in which the design is registered. Apart from providing protection of design element of industrial protection, the law aims to promote innovative activity in the field of industries. From an intellectual property law perspective an industrial design is concerned only to the ornamental or aesthetic aspects of a product. As per Indian law protecting industrial design, ‘design’ constitutes only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in 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; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of

⁷ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁸ http://www.teriin.org/div/briefing_paper_industrial_designs.pdf- The Briefing Paper- prepared by Gaurang Meher Diljun, M V Shiju, and Nitya Nanda and published by TERI under the project, “Post-TRIPS IPR Regime in India” supported under the ProsperityFund of the Foreign and Commonwealth Office of the UK.

section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957.⁹

In the context of the act, an article implies any object of manufacture and any substance, artificial or partly natural and includes any part of an article capable of being made and sold separately. For the purpose of registration under the Act the design must be new or original, unpublished previously or in existence in any other country and the article must have its existence independent of the designs applied to it. So, the design as applied to an article should be integral with the article itself. Trademark and property mark, stamps, labels, tokens, cards, etc. are excluded from the registration under the act as these cannot be considered as an 'article'. Moreover, any mode or principle of construction or operation, which is in substance a mere mechanical device and it is required that the design should be visible on the finished article.¹⁰

III. INDUSTRIAL DESIGNS

A. Meaning and Content:-

Industrial designs belong to the aesthetic field, but are at the same time intended to serve as patterns for the manufacture of products of industry or handicraft. Generally speaking, an industrial design is the ornamental or aesthetic aspect of a useful article. The ornamental aspect may consist of the shape and/or pattern and/or colour of the article. The ornamental or aesthetic aspect must appeal to the sense of sight. The article must be reproducible by industrial means, which is why the design is called 'industrial'. If this latter element is missing, the creation may rather come under the category of a work of

⁹ http://www.teriin.org/div/briefing_paper_industrial_designs.pdf- The Briefing Paper- prepared by Gaurang Meher Diljun, M V Shiju, and Nitya Nanda and published by TERI under the project, "Post-TRIPS IPR Regime in India" supported under the ProsperityFund of the Foreign and Commonwealth Office of the UK.

¹⁰ Ibid.

art, the protection of which is assured by the copyright law rather than by a law on industrial property.¹¹

Industrial Design is the use of both applied art and applied science to improve the aesthetics, ergonomics, functionality, and/or usability of a product, and it may also be used to improve the product's marketability and even production. The role of an industrial designer is to create and execute design solutions for problems of form, usability, physical ergonomics, marketing, brand development, and sales. Industrial design studies function and form and the connection between product, user, and environment. Generally, industrial design professionals work in small scale design, rather than overall design of complex systems such as buildings or ships. Industrial designers don't usually design motors, electrical circuits, or gearing that make machines move, but they may affect technical aspects through usability design and form relationships. Usually, they work with other professionals such as marketers to identify and fulfill customer needs and expectations.¹²

Industrial design can overlap significantly with engineering design, and in different countries the boundaries of the two concepts can vary, but in general engineering focuses principally on functionality or utility of products whereas industrial design focuses principally on aesthetic and user-interface aspects of products. In many jurisdictions this distinction is effectively defined by credentials and/or licensure required to engage in the practice of engineering. Industrial design as such does not overlap much with the engineering sub-discipline of industrial engineering, except for the latter's sub-specialty of ergonomics.¹³

In order to be protectable an industrial design must according to other laws be new and/or original. Industrial designs are usually protected against unauthorized copying or

¹¹ Intellectual Property Rights and the Law- Dr. G.B Reddy

¹² http://en.wikipedia.org/wiki/Industrial_design (visited on 28-10-2013)

¹³ Ibid.

imitation. The protection usually lasts for five, ten or fifteen years.¹⁴ Novelty or originality is determined with respect to the existing design corpus. An industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied .¹⁵

The design refers to features of shape which appeal to the eye and should be judged solely to the eye and should be judged solely by the eye and not by any functional considerations. A design in order to be registered must be both new and original and not previously published. The words 'new' or 'original' involves the idea of novelty or originality evidence of experts in the trade is admissible. The design for registration should not be published previously. Publication may be of two types- i) publication in prior documents, and ii) publication by prior use.¹⁶

The document that certifies the protection of an industrial design may be called a registration certificate or a patent. If it is called a patent, one must, in order to distinguish it from a patent for invention, always specify that it is a patent for an industrial design.¹⁷

With the remarkable evolution in design art in recent years, consumers have become more and more interested in a combination of utility and pleasing aesthetic appearance in the articles they buy. This tendency results in an increasing investment by manufacturers in design development and in a corresponding necessity to protect the result of their creative work through the registration of the relevant designs.¹⁸

Industrial designs are applied to a wide variety of products of industry and handicraft: from technical and medical instruments to watches, jewelry, and other luxury items; from

¹⁴ Intellectual Property Rights and the Law- Dr. G.B Reddy

¹⁵ <http://www.wipo.int/designs/en/> (visited on 29-10-2013)

¹⁶ Intellectual Property Rights and the Law- Dr. G.B Reddy

¹⁷ Ibid.

¹⁸ Ibid.

housewares and electrical appliances to vehicles and architectural structures; and from textile to leisure goods.¹⁹

Only particular class of articles can be registered under the Designs Act, 2000. The design must be capable of being applied to an article in such a way that the article to which it is applied will appeal to and be judged solely by the eye. The particular shape, configuration, pattern or ornamentation must have only an appeal. Designs which are not new or original or have been disclosed to the public anywhere in India or in any other country by publication or not significantly distinguishable from known designs or combinations of known designs or comprise or contain scandalous or obscene matter are not registerable under the Designs Act.²⁰

B. *Why Protect Industrial Designs-*

Industrial designs are what make a product attractive and appealing. Hence, they add to the commercial value of a product and increase its marketability.²¹

When an industrial design is protected, this helps to ensure a fair return on investment. An effective system of protection also benefits consumers and the public at large, by promoting fair competition and honest trade practices.²²

Protecting industrial designs helps economic development, by encouraging creativity in the industrial and manufacturing sectors and contributes to the expansion of commercial activities and the export of national products.²³

¹⁹ <http://www.wipo.int/designs/en/> (visited on 29-10-2013)

²⁰ Law relating to Intellectual Property- Dr. B.L Wadehra

²¹ <http://www.wipo.int/designs/en.html> (visited on 29-10-2013)

²² *Ibid.*

²³ *Ibid.*

C. How Can Industrial Designs Be Protected-

In most countries, an industrial design must be registered in order to be protected under industrial design law. As a general rule, to be registrable, the design must be new or original. Different countries have varying definitions of such terms, as well as variations in the registration process itself. Generally, new means that no identical or very similar design is known to have existed before. Once a design is registered, the term of protection is generally five years, with the possibility of further periods of renewal up to, in most cases, 15 years.²⁴

Depending on the particular national law and the kind of design, an industrial design may also be protected as a work of art under copyright law. In some countries, industrial design and copyright protection can exist concurrently. In other countries, they are mutually exclusive: once the owner chooses one kind of protection, he can no longer invoke the other. Under certain circumstances an industrial design may also be protectable under unfair competition law, although the conditions of protection and the rights and remedies ensured can be significantly different.²⁵

D. What Cannot Be Protected By Industrial Design Rights-

Designs that are generally barred from registration in many territories include:

- a) Designs that do not meet the requirements of novelty, originality and/or individual character;
- b) Designs that are considered to be dictated exclusively by the technical function of a product; such technical or functional design features may be protected, depending on the facts of each case, by other IP rights (e.g. patents, utility models or trade secrets);

²⁴ <http://www.wipo.int/designs/en.html> (visited on 29-10-2013)

²⁵ *Ibid.*

c) Designs incorporating protected official symbols or emblems (such as the national flag);

d) Designs which are considered to be contrary to public order or morality.²⁶

Some countries exclude handicrafts from design protection, as industrial design law in these countries requires that the product to which an industrial design is applied is 'an article of manufacture' or that it can be replicated by 'industrial means'.²⁷

E. *What Rights Are Conferred By Industrial Design Protection-*

When an industrial design is registered, the holder receives the right to prevent unauthorized copying or imitation by third parties. This includes the right to prevent all unauthorized parties from making, selling or importing any product in which the design is incorporated or to which it is applied. Because industrial design rights are territorial in nature, this right is limited to the territory for which the design is registered.²⁸

F. *What Is The Grace Period For Filing Application-*

The existence of a grace period and the corresponding requirements can be provided by national or regional laws applicable in some countries. If so, the law can allow the filing of an application for registration of an industrial design after its disclosure, within a limited time period from the date of disclosure (generally six months or a year).²⁹

During the grace period, the product which constitutes the industrial design or in relation to which the industrial design is used could in particular be commercialized without destroying the novelty of the industrial design and it could still be possible to file an

²⁶ <http://www.wipo.int/designs/en.html> (visited on 29-10-2013)

²⁷ Ibid.

²⁸ Ibid.

²⁹ Ibid.

application for registration in the country concerned before the expiry of the grace period.³⁰

G. How Extensive Is Industrial Design Protection-

Generally, industrial design protection is limited to the country in which protection is granted. Under the Hague Agreement Concerning the International Registration of Industrial Designs, a WIPO-administered treaty, a procedure for an international registration is offered. An applicant can file a single international application with WIPO. The applicant can designate as many Contracting Parties as he wishes.³¹

H. How Can You Enforce Your Rights When Your Industrial Design Is Being Infringed-

In case of infringement, the holder of industrial design rights could, firstly, decide to send a cease or desist letter to the alleged infringer, informing him of a possible conflict between his industrial design rights and the alleged infringing product and asking him to cease said infringement. If the infringement persists, the holder of the industrial design rights could decide to take all appropriate legal measures against the infringer, as provided for by the applicable law.³²

The enforcement of industrial design rights may be a complex issue for which it is usually advisable to seek professional assistance from a lawyer who would in principle be the competent person to provide with advice on how to settle any dispute.³³

³⁰ <http://www.wipo.int/designs/en.html> (visited on 29-10-2013)

³¹ *Ibid.*

³² *Ibid.*

³³ *Ibid.*

I. *Conditions For A Registerable Design-*

A design can be registerable only when it is new or original and not previously published in India. A design would be registerable if the pattern though already known is applied to a new article, e.g, the shape of a teddy bear if applied to a school bag would be registerable. What is essential is that the design must be new with respect to the class of article to which it has been applied.³⁴

A combination of previously known designs can be registered if the combination produces a new visual appeal. Colour may form a part of design but the colour by itself cannot constitute a subject-matter of design. The novelty or originality is to be judged on the evidence of experts in the trade. An expert who is aware of what is common trade knowledge and usage in the class of goods to which the design is applied would be the one entitled to pass the verdict on the novelty and originality.³⁵

IV. **THE HAGUE CONVENTION-**

The Hague Agreement is an international registration system which offers the possibility of obtaining protection for industrial designs in a number of States and/or intergovernmental organizations (both referred to as Contracting Parties) by means of a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO). Thus, under the Hague Agreement, a single international application replaces a whole series of applications which, otherwise, should have been effected with different national (or regional) Offices. The Hague Agreement is constituted by three international treaties:

The Geneva Act of July 2, 1999 (the 1999 Act);

The Hague Act of November 28, 1960 (the 1960 Act);

³⁴ Law relating to Intellectual Property- Dr. B.L Wadehra

³⁵ Ibid.

The London Act of June 2, 1934 (the 1934 Act).³⁶

A. *Who May Use the Hague System-*

The possibility of filing an international application under the Hague Agreement is not open to everyone. To be entitled to file such an application, an applicant must satisfy one, at least, of the following conditions: (a) be a national of a Contracting Party or a member State of an intergovernmental organization which is a Contracting Party, such as the European Union or the African Intellectual Property Organization, or (b) have a domicile in the territory of a Contracting Party, or (c) have a real and effective industrial or commercial establishment in the territory of a Contracting Party.³⁷

In addition, but only under the 1999 Act, an international application may be filed on the basis of habitual residence in a Contracting Party.³⁸

The Contracting Party with respect to which the applicant fulfills the above condition is referred to as the State of origin under the 1960 Act and the applicant's Contracting Party under the 1999 Act.³⁹

A person who does not have the required entitlement in a Contracting Party is not in a position to file an international application under the Hague Agreement, and must necessarily, in order to obtain protection, file an application at the national (or regional) level, with the national (or regional) Office concerned.⁴⁰

³⁶ http://www.wipo.int/export/sites/www/freepublications/en/designs/911/wipo_pub_911.html (visited on 31-10-2013)

³⁷ *Ibid.*

³⁸ *Ibid.*

³⁹ *Ibid.*

⁴⁰ *Ibid.*

B. *Where Can Protection Be Obtained-*

Protection can be obtained only in those Contracting Parties which are party to the same Act as the Contracting Party through which the applicant has the necessary entitlement (i.e., nationality, domicile, habitual residence or establishment). For example, if an applicant has claimed entitlement through a Contracting Party bound exclusively by the 1999 Act, he may request protection in those Contracting Parties which are bound by the 1999 Act (whether or not they are also bound by the 1960 Act). On the other hand, such applicant is not entitled to request protection in respect of Contracting Parties bound only by the 1960 Act. Likewise, if an applicant has claimed entitlement through a Contracting Party bound by both the 1999 Act and the 1960 Act, he may obtain protection in all the Contracting Parties bound by the 1960 Act and/or the 1999 Act.⁴¹

The Hague system cannot be used to protect an industrial design in a country which is not party to the Hague Agreement, or which is not a member State of an intergovernmental organization party to the Hague Agreement. In order to protect a design in such a country, the applicant has no choice but to file a national (or regional) application. If protection is sought in the territory of an intergovernmental organization, the protection covers the territories of all its member States.⁴²

C. *What are the Effects of the International Registration-*

If no refusal is notified by a given designated Contracting Party within the prescribed time limit (or if such refusal has subsequently been withdrawn), the international registration has the effect as a grant of protection in that Contracting Party, under the law of that Contracting Party. This implies that in order to assess the scope of protection of an industrial design in a given designated Contracting Party, as well as to establish the competent authorities or the relevant sanctions in case of alleged infringement, the applicable law is that of the Contracting Party where protection has been obtained. For

⁴¹ http://www.wipo.int/export/sites/www/freepublications/en/designs/911/wipo_pub_911.html (visited on 31-10-2013)

⁴² *Ibid.*

example, if an international registration designates Contracting Parties A, B and C (and no refusal of protection has been issued by these Contracting Parties), the protection of the industrial designs concerned is governed in Contracting Party A by the law of Contracting Party A, in Contracting Party B by the law of Contracting Party B, and so on.⁴³

It must therefore be stressed that the Hague system is merely an agreement for international procedure. Any substantive aspect of the protection is entirely a matter for the domestic legislation of each designated Contracting Party.⁴⁴

D. Duration of Protection-

International registrations are effected for an initial period of five years. They may be renewed for an additional period of five years, in respect of each designated Contracting Party, up to the expiry of the total term of protection allowed by those Contracting Parties' respective laws.⁴⁵

Requests for renewals must be presented to the International Bureau of WIPO, along with the payment of the corresponding renewal fees. International registrations may be renewed electronically through the electronic renewal interface (E-renewal) available on the WIPO web site. Renewals may be made for all or some of the industrial designs included in the international registration and for all or some of the designated Contracting Parties.⁴⁶

E. The advantages of using the Hague System-

The Hague system of international registration of industrial designs arose from a need for simplicity and economy. In effect, it enables design owners from a Contracting Party to

⁴³ http://www.wipo.int/export/sites/www/freepublications/en/designs/911/wipo_pub_911.html (visited on 31-10-2013)

⁴⁴ Ibid.

⁴⁵ Ibid.

⁴⁶ Ibid.

obtain protection for their designs with a minimum of formalities and expense. In particular, they are relieved of the need to make a separate national application in each of the Contracting Parties in which they seek protection, thus avoiding the complications arising from procedures and languages which differ from one State to another.⁴⁷

The Hague system also avoids the need for constant monitoring of the deadline for renewal of a whole series of national registrations, varying from one State to the other. In addition, it avoids the need to pay a series of fees in various currencies.⁴⁸

In effect, under the Hague Agreement, the same result can be obtained by means of a single international registration, made in one language, on payment of a single set of fees, in one currency and with one Office (the International Bureau of WIPO). Moreover, by having a single international registration with effect in several Contracting Parties, the subsequent management of the international registration is considerably facilitated. For instance, a change in the name or address of the holder, or a change in ownership for only some or all of the designated Contracting Parties, can be recorded in the International Register and have effect by means of one simple procedural step carried out through the International Bureau of WIPO.⁴⁹

V. THE LOCARNO AGREEMENT-

A diplomatic conference, to which all the countries members of the Paris Convention for the Protection of Industrial Property were invited and which was held in Locarno (Switzerland), adopted, on October 8th, 1968, the Locarno Agreement Establishing an International Classification for Industrial Designs (Locarno Classification).⁵⁰

The Locarno Classification comprises:

⁴⁷ http://www.wipo.int/export/sites/www/freepublications/en/designs/911/wipo_pub_911.html (visited on 31-10-2013)

⁴⁸ *Ibid.*

⁴⁹ *Ibid.*

⁵⁰ <http://www.wipo.int/classifications/locarno/en/preface.html> (visited on 1-11-2013)

- (i) a list of classes and subclasses;
- (ii) an alphabetical list of goods in which industrial designs are incorporated, with an indication of the classes and subclasses into which they fall;
- (iii) explanatory notes.⁵¹

The original list of classes and subclasses was attached to the Locarno Agreement when it was adopted.⁵²

The Locarno Agreement set up a Committee of Experts, in which each country party to the Agreement is represented. The Agreement empowered the Committee to make amendments in or additions to the original list of classes and subclasses, to establish the alphabetical list and the explanatory notes (which were not established in the diplomatic conference), and to amend and supplement each and any of the three parts (list of classes and subclasses, alphabetical list of goods, explanatory notes) of the Classification.⁵³

The trademark offices of the contracting States of the Locarno Agreement are required to include in the official documents the registration of industrial designs the Locarno classes and subclasses into which the goods incorporating the designs belong. They must do the same in any publication which the offices issue regarding the deposit or registration.⁵⁴

The Locarno Classification comprises a list of 32 classes and 223 subclasses with explanatory notes and an alphabetical list of goods in which industrial designs are incorporated, with an indication of the classes and subclasses into which they fall. This list contains some 6,831 indications of different kinds of goods.⁵⁵

⁵¹ <http://www.wipo.int/classifications/locarno/en/preface.html> (visited on 1-11-2013)

⁵² *Ibid.*

⁵³ *Ibid.*

⁵⁴ *Ibid.*

⁵⁵ *Ibid.*

The existence and use of the Locarno Classification system brings with it the advantages of having an industrial design-specific classification system. This makes industrial design searches much simpler both on the national and international level. Also, since Locarno is an internationally recognized system, it prevents the need for reclassification when documents are exchanged internationally.⁵⁶

VI. THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (1883)-

The Convention applies to industrial property in the widest sense, including patents, marks, industrial designs, utility models (a kind of small patent provided for by the laws of some countries), trade names (designations under which an industrial or commercial activity is carried on), geographical indications (indications of source and appellations of origin) and the repression of unfair competition.⁵⁷

The substantive provisions of the Convention fall into three main categories: 1) national treatment, 2) right of priority & 3) common rules.⁵⁸

(1) Under the provisions on national treatment, the Convention provides that, as regards the protection of industrial property, each contracting State must grant the same protection to nationals of the other contracting States as it grants to its own nationals. Nationals of non-contracting States are also entitled to national treatment under the Convention if they are domiciled or have a real and effective industrial or commercial establishment in a contracting State.⁵⁹

⁵⁶ <http://www.wipo.int/classifications/locarno/en/preface.html> (visited on 1-11-2013)

⁵⁷ http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (visited on 2-11-2013)

⁵⁸ *Ibid.*

⁵⁹ *Ibid.*

(2) The Convention provides for the right of priority in the case of patents (and utility models, where they exist), marks and industrial designs. This right means that, on the basis of a regular first application filed in one of the contracting States, the applicant may, within a certain period of time (12 months for patents and utility models; 6 months for industrial designs and marks), apply for protection in any of the other contracting States; these later applications will then be regarded as if they had been filed on the same day as the first application. In other words, these later applications will have priority (hence the expression right of priority) over applications which may have been filed during the said period of time by other persons for the same invention, utility model, mark or industrial design. Moreover, these later applications, being based on the first application, will not be affected by any event that may have taken place in the interval, such as any publication of the invention or sale of articles bearing the mark or incorporating the industrial design. One of the great practical advantages of this provision is that, when an applicant desires protection in several countries, he is not required to present all his applications at the same time but has six or 12 months at his disposal to decide in which countries he wishes protection and to organize with due care the steps he must take to secure protection.⁶⁰

(3) The Convention lays down a few common rules which all the contracting States must follow. The more important are the following:

(a) As to Patents: Patents granted in different contracting States for the same invention are independent of each other: the granting of a patent in one contracting State does not oblige the other contracting States to grant a patent; a patent cannot be refused, annulled or terminated in any contracting State on the ground that it has been refused or annulled or has terminated in any other contracting State.⁶¹

The inventor has the right to be named as such in the patent.⁶²

⁶⁰ http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (visited on 2-11-2013)

⁶¹ Ibid.

⁶² Ibid.

The grant of a patent may not be refused, and a patent may not be invalidated, on the ground that the sale of the patented product, or of a product obtained by means of the patented process, is subject to restrictions or limitations resulting from the domestic law.⁶³

Each contracting State that takes legislative measures providing for the grant of compulsory licenses to prevent the abuses which might result from the exclusive rights conferred by a patent may do so only with certain limitations. Thus, a compulsory license (license not granted by the owner of the patent but by a public authority of the State concerned) based on failure to work the patented invention may only be granted pursuant to a request filed after three or four years of failure to work or insufficient working of the patented invention and it must be refused if the patentee gives legitimate reasons to justify his inaction. Furthermore, forfeiture of a patent may not be provided for, except in cases where the grant of a compulsory license would not have been sufficient to prevent the abuse. In the latter case, proceedings for forfeiture of a patent may be instituted, but only after the expiration of two years from the grant of the first compulsory license.⁶⁴

(b) As to Marks: The Paris Convention does not regulate the conditions for the filing and registration of marks which are therefore determined in each contracting State by the domestic law. Consequently, no application for the registration of a mark filed by a national of a contracting State may be refused, nor may a registration be invalidated, on the ground that filing, registration or renewal has not been effected in the country of origin. Once the registration of a mark is obtained in a contracting State, it is independent of its possible registration in any other country, including the country of origin; consequently, the lapse or annulment of the registration of a mark in one contracting State will not affect the validity of registration in other contracting States.⁶⁵

Where a mark has been duly registered in the country of origin, it must, on request, be accepted for filing and protected in its original form in the other contracting States. Nevertheless, registration may be refused in well-defined cases, such as when the mark

⁶³ http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (visited on 2-11-2013)

⁶⁴ *Ibid.*

⁶⁵ *Ibid.*

would infringe acquired rights of third parties, when it is devoid of distinctive character, when it is contrary to morality or public order, or when it is of such a nature as to be liable to deceive the public.⁶⁶

If, in any contracting State, the use of a registered mark is compulsory, the registration cannot be canceled until after a reasonable period, and only if the owner cannot justify his inaction.⁶⁷

Each contracting State must refuse registration and prohibit the use of marks which constitute a reproduction, imitation or translation, liable to create confusion, of a mark considered by the competent authority of that State to be well known in that State as being already the mark of a person entitled to the benefits of the Convention and used for identical or similar goods.⁶⁸

Each contracting State must likewise refuse registration and prohibit the use of marks which consist of or contain without authorization, armorial bearings, State emblems and official signs and hallmarks of contracting states, provided they have been communicated through the International Bureau of WIPO. The same provisions apply to armorial bearings, flags, other emblems, abbreviations and names of certain intergovernmental organizations.⁶⁹

Collective marks must be granted protection.⁷⁰

(c) As to Industrial Designs: Industrial designs must be protected in each contracting State, and protection may not be forfeited on the ground that the articles incorporating the design are not manufactured in that State.⁷¹

⁶⁶ http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (visited on 2-11-2013)

⁶⁷ Ibid.

⁶⁸ Ibid.

⁶⁹ Ibid.

⁷⁰ Ibid.

⁷¹ Ibid.

(d) As to Trade Names: Protection must be granted to trade names in each contracting State without the obligation of filing or registration.⁷²

(e) As to Indications of Source: Measures must be taken by each contracting State against direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer or trader.⁷³

(f) As to Unfair Competition: Each contracting State must provide for effective protection against unfair competition.⁷⁴

The Convention is open to all States. Instruments of ratification or accession must be deposited with the Director General of WIPO.⁷⁵

VII. PROCEDURE OF REGISTRATION OF A DESIGN UNDER THE DESIGNS ACT, 2000

Section 5 lays down that any person who claims to be the proprietor of any new or original design which is not previously published in India can apply for the registration of the design. As to foreigners, there is no express provisions in the Designs Act which bars foreigners from applying for registration. However, the convention followed is that if a country does not offer the identical registration right to Indian citizens for their designs in their country, its citizens would not be eligible to apply for registration of designs in India.⁷⁶

⁷² http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (visited on 2-11-2013)

⁷³ Ibid.

⁷⁴ Ibid.

⁷⁵ Ibid.

⁷⁶ Law relating to Intellectual Property- Dr. B.L. Wadehra

The procedure for registration of a design is comparatively simple when compared to procedure for registration of a patent or a trade mark. Briefly, the procedure consists of the following steps:-

- (1) Submission of application- The proprietor of the design has to file application for registration of the design. According to section 5(1), the Controller may on application made by any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order and morality, register the design under the Act. The application is to be accompanied by the prescribed fee and in prescribed form and manner.⁷⁷
- (2) Documents to be filed with the application- The application under section 5 shall be accompanied by four copies of the representation of the design and the applicant shall state the class in which the design is to be registered. The applicant is also to file a brief statement of novelty with the application.⁷⁸
- (3) Acceptance/Objection- on consideration of the application if the Controller finds that the applicant fulfills all the prescribed requirements, he shall register the designs. If on consideration of the application any objections appear to the Controller, a statement of these objections shall be sent to the applicant or his agent.⁷⁹
- (4) Removal of objection/appeal to the Central Government- The applicant has to remove the objection within one month of communication of the objections to him failing which the application shall be deemed to have been withdrawn. He may also apply to the Controller for being heard on the matter. When the Controller refuses the application after the submission, he may directly appeal to the Central Government whose decision is final.⁸⁰

⁷⁷ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁷⁸ Ibid.

⁷⁹ Ibid.

⁸⁰ Ibid.

- (5) Publication of particulars of registered design- On acceptance of design filed in respect of an application, the Controller shall direct the registration and publication of the particulars of the application and the representation of the article to which the design has been applied, in the Official Gazette. When publishing in the Gazette, the Controller may select one or more views of the representation of the design, which in his opinion would depict the best.⁸¹
- (6) Register of Designs- When the design is accepted, there shall be entered in the Register of Design, in addition to the particulars required by the Act, the number of the design, the class in which it is registered, the date of filing the application for registration in this country, if any, claim for the registration and such other matters as would affect the validity or proprietorship of design. When such Register of Designs is maintained wholly or partly on computer, under floppies or diskettes, such computer floppies or diskettes shall be maintained under superintendence and control of Controller and in case of any dispute or doubt with regard to information of designs, the information as contained in the back up file or master file shall be final.⁸²

A. Rights Granted And The Term Of Such Rights-

The exclusive right conferred on a design is termed as ‘copyright in design’. This should not be confused with exclusive right granted for literary and artistic work also termed a ‘copyright’ in the literary and artistic work. There may be certain designs which can qualify for registration both under the Designs Act and the Copyright Act. The industrial design and product design are covered by the Designs Act, 2000, if a design has been registered under this Act, it cannot be protected by the Copyright Act even though it may be an original artistic work.⁸³

⁸¹ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁸² Ibid.

⁸³ Ibid.

If a design qualifies for registration under the Designs Act but has not been so registered under the Designs Act, the exclusive right will subsist under the Copyright Act. If such a design is of an article which is commercially produced, the copyright over the design under the Copyright Act will cease to exist when the 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. There is an overlapping area of the applicability of the Designs Act and the Copyright Act but they cannot be applied at the same time for protection of the same subject matter.⁸⁴

The registration of a design excludes all persons from using the design including the Government. Section 20 provides that a registered design shall have for all intents the like effect as against Government as it has against any person.⁸⁵

This means even the Government is bound to honour the Copyright in the design. It can, however use the design or acquire it or even prohibit a person from using or misusing the design in certain circumstances, e.g, when the article is not made available to the public at reasonable prices.⁸⁶

B. Term Of The Copyright In Design-

Section 11 lays down that the term of the copyright in design is 10 years from registration which may be extended further for a second period of 5 years. Thus the maximum period of copyright in designs is 15 years.⁸⁷

⁸⁴ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁸⁵ Ibid.

⁸⁶ Ibid.

⁸⁷ Ibid.

VIII. PIRACY OF A REGISTERED DESIGN

Infringement of a copyright in design is termed as Piracy of a registered Design. It is not lawful for any person during the existence of copyright to do the following acts without consent or license of the registered proprietor of the design-

- (a) To publish or to have it published or expose for sale any article of the class in question on which either the design or any fraudulent or obvious imitation has been applied.
- (b) To either apply or cause to apply the design that is registered to any class of goods covered by the registration, the design or any imitation of it.
- (c) To import for the purpose of sale any article belonging to the class in which the design has been registered and to which the design or a fraudulent or obvious imitation thereof has been applied.⁸⁸

A distinction is made between fraudulent and obvious imitation. The only common factor between the two is that both should be imitations. Thus even in the case of fraudulent imitation the design applied must be an imitation of the registered design. In a fraud the imitation has been made with the intention to deceive another person with the knowledge that what is being done is a violation of the other persons right. Where, therefore, fraudulent imitation is established even if the imitation is rather clumsy and not obvious, the Court will declare it as an infringement of copyright in the design. There must be exact duplication, an imitation of the registered design. Nothing less than imitation is sufficient to establish piracy.⁸⁹

A. *Test to determine infringement-*

The court has to determine whether the alleged infringement has the same shape or pattern and must eliminate the claim of similarity due to similarity of functions, e.g, similarity of functions would result when two articles have same shape due to the inherent nature of

⁸⁸ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁸⁹ Ibid.

goods, two pens will necessarily be similar in having an ink tube, a cap and nib for writing. This element of functional similarity is to be eliminated. The Judge has to look at the two articles and check out their similarities and differences and through the eyes of person with average intelligence see whether the defendant's article is substantially different from that of the plaintiff.⁹⁰

B. Judicial remedy-

The judicial remedy for infringement of a registered design recommended in the Act is damages along with an injunction. Section 22(2) stipulates remedy in the form of payment of a certain sum of money by the person who pirates a registered design. A suit in the appropriate manner for seeking the relief in the form of an injunction is also recommended.⁹¹

C. Jurisdiction of the Court-

A suit under section 22 is to be instituted in a District Court or a High Court depending upon the quantum of damages claimed. The provisions of this section do not exclude action for passing off and for rendition of accounts. A person complaining infringement of his design can certainly ask for accounts from the defendant to show the profits earned by the defendant which would be the loss sustained by him which he could claim as damages. A suit for injunction restraining infringement of registered design and for rendition of account is, therefore, maintainable only when filed in the appropriate court.⁹²

D. Burden of proof-

The general principle of law is that the party making the charge, i.e accusing another party of an act has to establish the occurrence of such an act. The burden of proof is thus on the plaintiff who brings an action to establish the fact of piracy of his design.

⁹⁰ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁹¹ Ibid.

⁹² Ibid.

E. Defences which may be set up by the Defendant-

In a suit for infringement, a defendant may present evidence and argue the following defences-

- (a) The plaintiff has no title to sue. He may question whether the plaintiff is a registered proprietor of the design or his duly authorized agent or licensee.
- (b) The design is not entitled to protection. Disentitlement to protection can be pleaded on the grounds that the design has been previously registered in India; it has been published in India prior to the date of registration; the design is not a new or original design.
- (c) The plaintiff's own conduct is tainted in law. Law expects the party approaching its doors to approach with clean hands.
- (d) Delay and acquiescence- The institution of the suit within a reasonable time after the discovery of the infringement is expected of the plaintiff. The unreasonable delay in institution of the proceeding would amount to Acquiescence on the part of the plaintiff to such an infringement. Acquiescence of piracy is a reasonable ground to deny the plaintiff any of the reliefs prayed for.
- (e) The Copyright on a design is limited by time, the defendant on proving the expiry of period of registration is entitled to use the design and the plaintiff is not entitled to any relief.⁹³

IX. CASE LAWS ON VIOLATION OF DESIGNS-

A.C Footwear Co. vs Deiem (India) Pvt Ltd, (2006) 32 PTC 91

The subject matter of dispute was the design in respect of the sole of the shoe which had been registered with the Controller of Patents and Designs, Calcutta. It was the submission of the petitioner that design ought not to have been registered in view of the dual plea; firstly that the design had been previously registered in India and secondly, the design was not a new or an original design. The plea raised by the respondent was that the petitioner

⁹³ Law relating to Intellectual Property- Dr. B.L. Wadehra

was pirating the design of respondent no.1 which was original. Moreover, there was prior registration of design in favour of another company. Both the designs appeared to be practically identical. The direction was given for cancellation of registration of designs.⁹⁴

Britannia Industries vs Sara Lee Bakery, 2001 PTC 23 (Mad)

Britannia industries filed a suit for interim injunction restraining the respondent from committing the acts of piracy of the applicant's registered design of its biscuits by the manufacture of the impugned product 'Milk Wala' 'Milk cream biscuits' bearing the design which is identical with or similar to applicant's design. The Court held on facts, that the main features in both the biscuits are not substantially same in the eyes of the customer, namely, children. Therefore, there is no infringement by the respondent in respect of the Designs Act.⁹⁵

Texla Metals and Plastics Pvt. Ltd. Vs Anil K. Bhasin, 2001 PTC 146 (Del)

The court held that the concept of a new or an original type of design is relatable to the publication of such a design or its availability to the public in India. The court further held that if the contention that the defendant has received brochures from Malaysia, Korea and Japan with regard to such goods, the mere receipt of such brochures would amount to publication of such designs within India.⁹⁶

Escorts Construction Equipment Ltd Vs Action Construction Equipment Pvt Ltd, 1999 PTC 36(Del)

The Delhi High Court had occasion to interpret this part of the definition (as contained in the Designs Act, 1911). This case was concerning the alleged illegal copying of a design by the respondent of Pick-N-Carry Hydraulic Self Mobile Cranes manufactured by the

⁹⁴ Law relating to Intellectual Property- Dr. B.L. Wadehra

⁹⁵ Ibid.

⁹⁶ Ibid.

plaintiff. Though the case was not directly coming under the Designs Act, the Court examined whether the said design was capable of registration under the Designs Act. After examining the definition of design under the Act, the Court held that the design in question was incapable of registration. According to the Court the definition made it amply clear that the primary object of the Act was to protect shape and not function, or functional shape. “The expression ‘design’ does not include a method or principle of construction or features or shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.” Rejecting the contention of the plaintiff who claimed protection of certain specific parts of the crane, the Court held: “ The aforesaid parts of the crane are made in a particular shape so as to interrelate with others mechanically. These parts of the crane are not made to appeal to the eye but solely to make the crane work or function. Most of the key components or parts, unseen in the crane for which they were required, had only to pass the test of being able to perform their function. They would be judged by performance and not by appearance. Consequently, the aforesaid key components or parts are incapable of being registered as designs”.⁹⁷

X. CONCLUSION

A design is something that catches the eyes of the consumers. The design itself may not be of much use to the consumers yet the uniqueness or attractiveness may tempt them to purchase it. The more unique the design, the better are the chances of demand increasing. Manufacturers are ever willing to come up with something new that meets the eye in order to push their sales right up. The strong competition among various manufacturers benefits the consumers in the end as they enjoy a variety in products offered by different manufacturers.

⁹⁷ Law relating to Intellectual Property- Dr. B.L. Wadehra

However it cannot be forgotten that the creator of the design has spent a whole lot of time and money in preparing the design, and it is certainly unfair if the design is copied and put to use by others without the knowledge and permission of the creator. Companies invest large sums in research and development of products coming up with innovative and useful designs. Therefore the protection of the industrial designs becomes very important in today's times when such designs are prone to copying.

In India, the Designs Act, 2000, is a legislation meant to protect industrial designs. A design to be registerable under the Act, must be of some shape, configuration, pattern or ornamentation or composition of lines or colours applied to such article in any form by any industrial process or means. However it does not include any mode or principle of construction or anything which is in substance a mere mechanical device and does not include any Trade or Property mark or artistic work. In order to get statutory protection under the Designs Act, 2000, the design has to satisfy the definitional requirements of Section 2(d).

The products which have a unique appearance or a pattern or design can be registered under the Act. The main aim of law, hence, is to promote innovation. Design being intellectual property, what law is concerned when it comes to an industrial design is the ornamental or aesthetic aspect of a product.

In the International sphere the Hague Agreement is an international registration system which offers the possibility of obtaining protection for industrial designs in a number of States and/or intergovernmental organizations by means of a single international application filed with the International Bureau of the World Intellectual Property Organization. Hence under this agreement the need to have a series of applications in different countries is done away with. Under the The Locarno Classification a list of classes and subclasses along with an alphabetical list of goods in which industrial designs are incorporated, with an indication of the classes and subclasses into which they fall and

explanatory notes are prepared. The advantage of the Locarno Classification system is that there is an industrial design-specific classification system. Hence industrial design searches are much simpler both at the national and international level. The Paris Convention covers a wider aspect of industrial property like patents, marks, industrial designs, utility models, trade names, geographical indications and repression of unfair competition.

In case of any infringement of any designs registered under the Designs Act, 2000, the judicial remedy is damages along with an injunction. Section 22(2) stipulates remedy in the form of payment of a certain sum of money by the person who pirates a registered design. Thus a suit may be filed in the appropriate Court and appropriate manner.

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