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BY

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TOPIC:-

REMEDIES FOR

INFRINGEMENT OF

INDUSTRIAL

DESIGNS

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INTRODUCTION

Consumers are influenced by the appearance of the article in their choice. Many people blindly choose the article which catches their eyes 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, designs of goods increases profit by attracting customers. Producers hunt for an attractive design which will increase sales. Some intellectuals do hard work by putting thought, time and expense to find a design for a particular design which will increase sales. The object of design registration is to see that a creator of a profitable design is not deprived of his reward by other applying it to their goods without his permission.¹

What is a design?

A design is something which is applied to an article and is not the article itself. An article to which the design is to be applied must be something which is to be delivered to the purchaser as a finished good. The buildings and structures are not articles within the definition of design. But portable structure or models which are sold as finished articles may be subject matter for registration of design.

There are four features relevant to an industrial or product design. They are shape, configuration, pattern and ornament. The shape and configuration refer to the form of an article and is usually three dimensional in nature. Pattern and ornament are decorative features ordinarily applied to the surface of the article and they are in the nature of two dimensional.

The design refers to feature of shape which appeal to the eye and should be judged solely by the eye and not by any functional consideration. A design in order to be registered must be both new and original and not previously published. The words 'new' and 'original' involves the idea of novelty either in the pattern, shape or ornament itself.

The appearance of a product, in particular, the shape, texture, colour, materials used contours and ornamentation. To qualify as a new design, the overall impression should be different from any existing design.

Designs may be subject to three types of protection, copyright, unregistered design rights and may also be registered nationally as registered designs. The actual details of design rights will vary depending on national law.

Who owns the design right?

Typically the creator of the design owns any rights in it, except where the work was commissioned or created during the course of employment, in which case the rights belong to the employer or party that commissioned the work.

What is a registered design?

A design refers to the features of a shape, configuration, pattern or ornament applied to an article by any industrial process. If you register a design, you will be protecting the external appearance of the article. Registered Designs are used primarily to protect

¹ Dr. S. R. Myneni, Law Of Intellectual Property, 4th Edition, Asia Law House

designs for industrial use. It is the right given by the Government to the owner to control the use of your design.

When you apply for registration of designs in Singapore, you are required to classify the article or articles to which the design is applied. Classification is done in accordance with the Third Schedule of the Registered Designs Rules R1, which lists the headings of the 32 classes and their subclasses as presented in the 8th edition of the Locarno Classification for Industrial Designs.

To qualify for registration, a design must, in general, satisfy two key criteria:

a) The Design must be new:

The registered design must not have been registered in Singapore or elsewhere; or published anywhere in the world before the date of application of the first filing. Thus the owner of a design should be careful not to disclose the design to anyone, until a design application is filed.

If a design is the same as another that is registered in respect of the same or any other article, it is not new. Generally, a design is not new if it

- has been registered; or
- has been published anywhere in the world, in respect of the same or any other article; or
- differs only in immaterial details, or features, from other designs that are commonly found in trade.

b) The Design must be industrially applied onto an article:

The registered design has to be applied to an article by an industrial process i.e. more than 50 copies of the article have been or are intended to be produced for sale or hire.

Designs that cannot be registered

Under the Registered Designs Act and Rules, the following cannot be registered:

- Designs that are contrary to public order or morality.
- Computer programmes or layout designs of integrated circuits.
- Designs applied to certain articles; such as works of sculpture (other than casts used or intended for use as models or patterns to be multiplied by any industrial process); wall plaques, medals and medallions; and printed matter primarily of a literary or artistic character (including book jackets, calendars, certificates, coupons, dress-making patterns, greeting cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles).
- Methods or principles of construction.
- Designs that are solely functional.
- Designs that are dependent upon the appearance of another article, of which it is intended by the designer to form an integral part; or enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function.

The benefits of registering a design

By registering a design, you obtain a right to ownership and the right to prevent others from using the design without your permission. You can exploit your design in many

ways. You may use it to better protect your market share by barring copying by others, license it to third parties for commercial returns or sell the design for a sum of money.

Unregistered design rights.

Unregistered design rights protect the shape or configuration of a marketable (or potentially marketable) product, and are used to prevent unauthorised copying of an original design. Design rights can also be bought, sold or licensed in a similar manner to copyright.

Design rights exist independently of copyright, while copyright may protect documents detailing the design as well as any artistic or literary work incorporated within the finished product, the design right focuses more on the shape, configuration and construction of a product.

In the UK, unregistered design rights have been available since 1989, and have been available since March 2002 throughout the European Community.

Unregistered design rights are automatic and are treated in the similar manner as copyright. For this reason they may be registered with the UK Copyright Service in the same manner as copyright work in order to establish proof of the date and content of the work in case of any later dispute or legal claims.

UKCS registration provides international evidence of an unregistered design right, this is not the same as a registered design, which would be administered by governments at a territory/national level.²

Duration of unregistered design rights.

Within the European Community, unregistered design rights lasts for 3 years from the point the design is first disclosed or made available to the public in some manner.

In the UK rights the duration is 10 years from the end of the calendar year in which the design was first made into a marketable product. The original date the design was first fixed in a tangible form is also taken into account, and the duration should not exceed 15 years from the end of the calendar year in which the design was first recorded.

The UK 10 year duration is split into two 5 year periods: Exclusive rights are retained for the first 5 years, but during the last 5 years other parties are allowed to apply for licenses to the design (for which the owner may claim royalties). For UK designers, both the UK and EC rights can exist at the same time.

²oami.europa.eu/ows/rw/pages/RCD/FAQ/RCD1.en.do

LEGAL REGIME

The Industrial Designs Act 2001

Introduction

The Industrial Designs Act 2001 establishes a complete code governing the registration of industrial designs and completely replaces previous industrial designs legislation i.e. the Industrial and Commercial Property (Protection) Acts 1927 to 1958. Although, the Industrial Designs Act is essentially concerned with the protection of designs by registration, it does contain some tidy up provisions in respect of, for example, copyright and designs. The Industrial Designs Act implements the EU harmonizing Directive of the European Parliament and of the Council on the Legal Protection of Designs (Directive 98/71/EC of 13 October 1998). This Directive requires Member States to harmonise substantive provisions of their industrial designs law, notably the conditions for validly registering an industrial design and the rights conferred by registration. The Act also allows the Minister to make provision by regulations to give effect in Ireland to the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs and to certain provisions of the Agreement on Trade-Related aspects of Intellectual Property rights (TRIPS).

Authorship and Ownership of Designs

Section 17

- (1) In this Act, the “author” in relation to a design means the person who creates the design.
- (2) In the case of a design which is computer-generated, “author” means the person by whom the arrangements necessary for the creation of the design are undertaken.
- (3) In this Act, “computer-generated”, in relation to a design, means that the design is generated by computer in circumstances where the author of the design is not an individual.

Section 18

- (1) In this Act, “design of joint authorship” means a design produced by two or more authors in which the contribution of each author is not distinct from that of the other author or authors.
- (2) References in this Act to the author of a design shall, unless otherwise provided, be construed in relation to a design of joint authorship as references to all the authors of the design.
- (3) Where a right conferred by this Act (or any aspect of such right) is owned by more than one person jointly, references in this Act to registered proprietor are to all the

owners, and any requirement of the licence of the registered proprietor requires the license of all the owners.

Section 19

(1) The author of a design shall be treated as the first proprietor of the design unless the design is created by an employee in the course of employment, in which case the employer is the first proprietor of the design, subject to any agreement to the contrary.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the first proprietor either alone or jointly with the first proprietor, that other person, or as the case may be, the first proprietor and that other person shall be treated as the proprietor of the design.

(3) Where the first proprietor of a design is not the author of the design, the author shall have the right to be cited as the author in the application for registration and in the Register.

Proceedings for Registration

Section 20

(1) A person claiming to be the proprietor of a registrable design may apply in the prescribed form and manner to the Controller for registration of the design under this Act.

(2) An application under subsection (1) may be amended, at the request of the applicant and with the approval of the Controller, at any time prior to registration.

(3) An amendment to an application for registration of a design under this section shall not be approved of by the Controller if the amendment affects the identity of the design.

(4) Where an amendment to an application for the registration of a design under this section is made the filing date of the application shall be retained.

Section 21

(1) The Controller may refuse an application for the registration of a design

(a) Where the design is contrary to public policy or to accepted principles of morality,

(b) On the application of the copyright owner or on the initiative of the Controller, where the design constitutes an infringement of a copyright work or,

(c) On the application of the person concerned by the use or on the initiative of the Controller, where the design consists of or includes anything which would not be registered.

(2) Where an application for the registration of a design has been refused the Controller may register the design in an amended form, where that form complies with the requirements for registration under this Act and the identity of the design is retained.

(3) Where an amendment to an application for the registration of a design under this section is made the filing date of the application shall be retained.

Section 22

(1) An application for the registration of a design shall be personal property.

(2) The necessary modifications, in relation to an application for the registration of a design as they apply in relation to a design right.

(3) In section 41 insofar as it applies in relation to a transaction affecting an application for the registration of a design, the references to the entry of particulars in the Register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Controller of those particulars.

(4) The Minister shall prescribe a procedure to be followed subsequent to the giving of the notice.

Section 23

An application which, owing to any fault or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

Section 24

(1) A design shall be classified for the purposes of registration according to a prescribed system of classification.

(2) Any question arising as to the class within which a design falls shall be determined by the Controller, whose decision shall be final and not appealable.

Section 25

The filing date of an application for registration of a design shall be the date on which the applicant pays the prescribed filing fee and files at the Patents Office documents which contain in the prescribed form—

(a) A request for registration of the design,

(b) A representation of the design suitable for reproduction, and

(c) The name and address of the applicant.

Section 26

(1) A person or his or her successor in title who has filed an application for registration of a design in, or in respect of, a Convention country or a member of the World Trade Organisation shall enjoy, for the purpose of registering the same design under this Act, a

right of priority for the period of 6 months after the filing date of the first application, subject to compliance with any conditions as may be prescribed by the Minister.

(2) Every filing is equivalent to a regular national filing under the national law of the state, country, territory or area, where it was made (including the State), or under a bilateral or multilateral agreement to which the State and that state, country, territory or area is a party, shall be recognised as giving rise to a right of priority.

(3) “Regular national filing” means any filing of an application for registration of a design in, or in respect of, a Convention country or a member of the World Trade Organisation that establishes the date on which the application was filed, whatever the outcome of the application may be.

(4) An application for the registration of a design that was the subject of a previous application, and that is filed in or in respect of the same Convention country or member of the World Trade Organisation, shall be considered as the first application for the purpose of determining priority where, and only where, on the filing date of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority.

(5) Where the first filing has been made in a country, territory, state or area which is not a party to the Convention or is not a member of the World Trade Organisation, the Government makes an order to that effect under this subsection consequent upon bilateral or multilateral agreements under which the State grants, on the basis of a first filing made in or for that country, territory, state or area and subject to conditions equivalent to those laid down in the Convention or in the Agreement establishing the World Trade Organisation, a right of priority having equivalent effect.

(6) A right of priority arising as a result of an application under the Convention, the Agreement establishing the World Trade Organisation or under a bilateral or multilateral agreement referred to may be assigned or otherwise transmitted, either with the application or independently and the reference to the successor in title of the applicant shall be construed accordingly.

Section 27

(1) An applicant shall file a claim for right of priority in the prescribed manner.

(2) A right of priority shall only be granted to applicants who apply in accordance with regulations.

Section 28

(1) A right of priority shall have the effect that the filing date of the application shall be regarded as being the filing date of the application for registration.

(2) Where an application for the registration of a design is filed the priority of a previous application shall not be refused and the registration shall not be invalidated by reason

only of the fact that the previous application has been made available to the public at any time after the filing date of the previous application.

Section 29

A design shall be registered with effect from the filing date of the application for registration.

Register of Designs

Section 30

(1) The Controller may register designs and shall maintain, in the prescribed form, a register of designs, in this Act referred to as the ‘‘Register’’.

(2) There shall be entered in the Register

(a) The names and addresses of proprietors of registered designs;

(b) Notices of assignments and transmissions of registered designs; and

(c) Such other matters relating to registered designs as may be prescribed by the Minister or as the Controller may think fit.

(3) The Register shall be prima facie evidence of any matters required or authorised by this Act.

(4) No notice of any trust, whether express, implied or constructive, shall be entered in the Register, and the Controller shall not be affected by any such notice.

(5) A certificate purporting to be signed by the Controller and certifying that an entry which he or she is authorised to make in the Register has or has not been made, or that any other thing which he or she is so authorised to do has or has not been done, shall be prima facie evidence of the matters so certified.

(6) Nothing shall oblige the Controller to satisfy himself or herself of the matters referred to consider an application for registration.

Section 31

(1) On the registration of a design, the Controller shall issue to the registered proprietor a certificate of registration in the prescribed form.

(2) The Controller may, where he or she is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he or she thinks it expedient, furnish one or more copies of the certificate.

Section 32

(1) The Controller as soon as practicable after a design has been registered, publish in the prescribed form a notice of the registration in the Patents Office Journal.

(2) When filing an application for registration of a design an applicant may request that the publication of the registered design be deferred for such period as may be prescribed by the Minister and the Controller shall comply with such request.

Section 33

(1) An aggrieved person may apply to the High Court for an order for the rectification of the Register by the making of an entry in the Register or the variation or deletion of an entry in the Register.

(2) “A rectification of the Register” shall include—

(a) Entering any change in the name or address of a person who is entered on the Register, or

(b) Entering a disclaimer or memorandum on the Register relating to a registered design which does not in any way extend the rights given by the existing registration of such design.

(3) The High Court may, in proceedings, decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register.

(4) Notice of an application shall be given in the prescribed manner to the Controller and the Controller shall be entitled to appear and be heard by the High Court, and shall appear if so directed by the High Court in any hearing held for the purposes of this section.

(5) Unless otherwise directed by the High Court, the Controller may, in lieu of appearing and being heard by the High Court, submit to the High Court a statement in writing, signed by him or her, giving particulars of:

(a) The proceedings before him or her in relation to the matter in issue,

(b) The grounds of any decision given by him or her,

(c) The practice of the Patents Office in like cases, if any, and

(d) Such matters relevant to the issues and within his or her knowledge as Controller as he or she thinks fit, and that statement shall be deemed to form part of the evidence in the proceedings.

(6) An order made by the High Court for the rectification of the Register shall direct that notice of the order shall be served on the Controller in the prescribed manner, and on receipt of such notice the Controller shall rectify the Register in accordance with the terms of the order to which the notice relates.

(7) “Aggrieved person” shall include a person who is entitled to the design right in a registered design where that person would be entitled to apply for the invalidation of the registration of the design.

Section 34

(1) An application for an order for the rectification of the Register may, at the option of the applicant, be made in the first instance to the Controller.

(2) The Controller shall have all the powers of the High Court to decide the matter.

Section 35

A rectification of the Register shall have effect as follows—

(a) An entry made has effect from the date on which it should have been made,

(b) An entry varied has effect as if it had originally been made in its varied form, and

(c) An entry deleted shall be deemed never to have had effect, unless the High Court or, as the case may be, the Controller directs otherwise.

Section 36

(1) The Minister may make regulations authorising the Controller to do such things as the Controller considers necessary to implement any amended or substituted classification for the purposes of the registration of designs and, without prejudice to the generality of the aforesaid, the Minister may make regulations in respect of the amendment of existing entries on the Register so as to accord with the new classification.

(2) Any power of amendment effected under this section shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Controller that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

(3) Regulations made may empower the Controller—

(a) To require the registered proprietor of a registered design, within such time as may be prescribed, to file a proposal for the amendment of the Register, and

(b) To cancel or refuse to renew the registration of the design in the event of the proprietor failing to do so.

(4) A proposal shall be advertised and may be opposed, in such manner as may be prescribed.

Section 37

- (1) The Controller may, correct an error in an application for the registration or in the representation of a design, or any error in the Register.
- (2) A correction may be made upon a request in writing made by any person interested and accompanied by the prescribed fee, or on the initiative of the Controller.
- (3) Where the Controller is requested to correct an error in the Register, he or she shall determine the matter in the prescribed manner.
- (4) Where the Controller proposes to make a correction on his or her initiative, he or she shall give notice of the proposal to the registered proprietor or the applicant for registration of the design, as the case may be, and to any other person who appears to him or her to be concerned, and shall give them an opportunity to be heard before making the correction.
- (5) A correction of the Register shall have the effect that the error in question shall be deemed never to have been made.

Section 38

- (1) Public shall have a right to inspect the Register at such times and in such manner as may be prescribed by the Minister.
- (2) Where a request is made to the Controller for a certified or uncertified copy of, or extract from, an entry in the Register, other than an entry that is not open to public inspection by virtue.
- (3) The Controller shall issue a copy of the entry or extract to the person making the request on payment of the prescribed fee.
- (3) Where deferment of publication is requested, the Register shall not be open to public inspection, in relation to that design, until the expiry of that period of deferment.
- (4) In relation to any portion of the Register kept otherwise than in documentary form
 - (a) The right of inspection conferred is a right to inspect the material on the Register, and
 - (b) The right to a copy or extract conferred is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
- (5) Each of the following
 - (a) A copy of an entry in the Register or an extract from the Register which is supplied, or
 - (b) A copy of any representation or document kept in the Patents Office or an extract from any such document, which purports to be a certified copy or certified extract, shall be admitted in evidence in civil or criminal proceedings without further proof and without production of an original.

(6) “Certified copy” and “certified extract” means a copy and an extract certified by the Controller and sealed with the seal of the Controller.

Section 39

(1) After the registration of a design and upon the filing of a written request by any person in the prescribed manner, the Controller shall, subject to compliance with the prescribed conditions, give the person making the request such information, and permit him or her to inspect such documents, relating to the application for registration of the design concerned as may be specified in the request.

(2) Where deferment of publication is granted, no information or documents constituting or relating to the application shall, without the consent of the registered proprietor or the applicant be published or communicated to any other person by the Controller until the expiry of that period of deferment.

(3) Subsection (2) shall not prevent the Controller from publishing or communicating to others any prescribed information relating to an application for registration of a design.

(4) Where a person is notified that an application for registration of a design has been made and that the applicant shall, if the design is registered, bring proceedings against that person in the event of his or her doing an act specified in the notification, that person may make a request notwithstanding that the design has not been registered or that deferment of publication has been granted, and that subsection shall apply accordingly.

(5) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any other material or information filed in pursuance thereof shall at any time be open to inspection at the Patents Office or be published by the Controller.

Section 40

On the request of a person furnishing any information to enable the Controller to identify the design, and on payment of the prescribed fee, the Controller shall inform that person—

(a) Whether the design is registered and, if so, the class in which it is registered,

(b) Whether any disclaimers, memoranda or declarations of partial invalidity of the design right have been registered, and

(c) Whether an extension of the period for which the design right in the design shall subsist has been granted, and shall state the date of registration and name and address of the registered proprietor.

Section 41

(1) Where a person becomes entitled by assignment, transmission or operation of law to the design right in a design or to a share in that design right, or becomes entitled as mortgagee, licensee or otherwise to any other interest in the design right in a design, he or

she shall apply to the Controller in the prescribed manner for the registration of his or her title as proprietor or co-proprietor or, as the case may be, of notice of his or her interest, in the Register.

(2) Without prejudice an application for the registration of the title of a person becoming entitled by assignment to the design right in a design or a share in that design right, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in the design right in a design, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made the registration of the title of any person, the Controller shall, upon proof of title to his or her satisfaction

(a) Where that person is entitled to the design right in a design or a share in that design right, register him or her in the Register as proprietor or co-proprietor of the registered design, and enter in the Register particulars of the instrument or event by which he or she derives title, or

(b) Where that person is entitled to any other interest in the design right, enter in the Register notice of his or her interest, with particulars of the instrument (if any) creating it, and shall publish the entry in the prescribed manner.

(4) Except for the purposes of an application to rectify the Register a document in respect of which no entry has been made in the Register shall not be admitted in court as evidence of the title of a person to the design right in a design or share of or interest in the design right in a design unless the court otherwise directs.

Effect of Registration

Section 42

(1) There shall be a property right to be known and in this Act referred to as a design right, which shall subsist in a registered design.

(2) The registered proprietor of a design shall be the owner of the design right in the design.

(3) The design right in a registered design shall also apply to any design which does not produce on the informed user a different overall impression, taking into consideration the degree of freedom the author had in developing the design.

(4) The design right shall confer on its owner the exclusive right to use the design and to authorise others to use it, including the right to make, offer, put on the market, import, export or use a product in which the design is incorporated or to which it is applied, or to stock such a product for those purposes.

(5) The design right shall not apply to the use of a component part of a complex product for the purpose of repair of that product so as to restore its original appearance.

Section 43

- (1) The design right in a design shall expire 5 years after the date of registration.
- (2) The period for which the design right subsists may be renewed, for a second, third, fourth and fifth period of 5 years, by applying to the Controller for an extension in the prescribed manner and paying the prescribed renewal fee.
- (3) Where a period during which design right subsists expires without an application for renewal and payment of the prescribed fee being made, the design right shall expire, and the Controller shall notify the registered proprietor in the prescribed manner.
- (4) Where during the period of 6 months immediately following the end of a period of subsistence of the design right the renewal fee and any prescribed additional fee are paid, the design right shall be deemed not to have expired, and accordingly
 - (a) Anything undertaken under or in relation to the design right by or with the consent of the registered proprietor during that period shall be treated as valid,
 - (b) An act which would have constituted an infringement of the design right if it had not expired shall be treated as an infringement, and
 - (c) An act which would have constituted use for the service of the State the design right had remained in force during the period between expiry and restoration shall be deemed to constitute use for the service of the State.

Section 44

- (1) Where the design right has expired by reason of a failure to extend, in accordance, the period for which the right subsists, an application for the restoration of the right may be made in the prescribed manner to the Controller within the prescribed period.
- (2) The application may be made by the person who was the registered proprietor of the design or by any other person who would have been entitled to the design right if it had not expired and where the design right was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others.
- (3) Where the Controller is satisfied that the proprietor took reasonable care to see that the period for which the design right subsisted was extended in accordance with, the Controller shall, on payment of any unpaid renewal fee and any prescribed additional fee, order the restoration of the design right.
- (4) An order may be made subject to such conditions as the Controller thinks fit, and if the proprietor of the design does not comply with any condition the Controller may revoke the order and give such consequential directions as he or she thinks fit.
- (5) Notice of the restoration of a design right shall be published by the Controller in the prescribed manner.
- (6) The Minister may prescribe that the period prescribed may be altered, subject to any transitional provisions and savings as appear to the Minister to be necessary or expedient.

Section 45

(1) An act undertaken or authorisation given under or in relation to the design right in a design during the period between expiry and restoration of the design right shall be treated as valid.

(2) An act undertaken during the period between expiry and restoration of the design right which would have constituted an infringement if the design right had not expired shall be treated as an infringement—

(a) If undertaken at a time when it was possible for an application for extension to be made under section 43, or

(b) If it was a continuation or repetition of an earlier infringing act.

(3) Where it is no longer possible for an application for extension to be made and before publication of notice of the restoration, a person—

(a) Began in good faith which would have constituted an infringement of the design right if it had not expired, or

(b) Made in good faith effective and serious preparations to undertake such an act, he or she has the right to continue or, as the case may be, notwithstanding the restoration of the design right.

(4) Does not extend to granting a licence to another person to undertake the act.

(5) If the act referred to was undertaken, or preparations were made, in the course of a business, trade or profession, the person entitled to the right conferred by may—

(a) Authorise the undertaking of that act by any of his or her partners for the time being in that business, trade or profession, and

(b) (i) assign that right, or

(ii) transmit that right by testamentary disposition to any person who acquired that part of the business, trade or profession during the time when the act was being undertaken or the preparations were being made.

(6) Where a product is disposed of to another person in exercise of the rights conferred by that other person and any person claiming under him or her may use the product in the same way as if it had been disposed of by the registered proprietor of the design.

(7) An act referred to in this section which would have constituted use for service of the State of the design if the design right remained in force during the period between expiry and restoration shall be deemed to constitute use for the service of the State.

Section 46

(1) The design right in a design may be surrendered by the registered proprietor.

(2) The Minister may make regulations:

(a) As to the manner and effect of the surrender of a design right; and

(b) For protecting the interests of other persons having an interest in that design right.

Section 47

(1) At any time after a design has been registered, any person with an interest may apply to the Controller for the invalidation of the registration of the design—

(a) On the ground that the design was not, at the filing date of the application for registration or, where priority is claimed, at the date of priority, registrable in accordance with sections 11 to 14,

(b) On the ground that the design was not registrable in accordance with section 16, or

(c) On any ground on which the Controller could have refused to register the design under section 21(1)(b), and the Controller may make such order on the application as he or she thinks fit.

(2) At any time after a design has been registered, any person may apply to the Controller for invalidation of the registration on the ground that the design would be contrary to public policy or morality, and the Controller may make such order on the application as he or she thinks fit.

(3) The Controller may, on the application by a person so entitled for invalidation of the registration of a design on the ground that the person whose name is entered in the Register as the proprietor of the design is not entitled to be so registered, make such order as he or she thinks fit.

(4) The Controller may, on the application by a person so entitled, or on the initiative of the Controller, invalidate the registration of a design on the ground that the design is in conflict with a prior design.

(5) In this section, “prior design” has the meaning assigned to it by section 15(2).

(6) The Controller may, on the application of any person so entitled for invalidation of the registration of a design on the ground that a distinctive sign which are registered as a trade mark under the Trade Marks Act, 1996, has been subsequently used in the design make such order as he or she thinks fit.

(7) The Controller may, on the application of the person concerned by the use for the invalidation of the registration of a design or on the initiative of the Controller, where the design consists of or includes anything which would not be registered make such order as he or she thinks fit.

(8) “A person so entitled” means—

(a) The person entitled to the design right;

(b) The holder of the conflicting right.

(9) A registration may be declared invalid after it has lapsed or after it has been surrendered.

(10) An invalidation shall take effect from the date of registration or from such later date as the Controller may direct.

(11) Where a design has been invalidated under the provisions the Controller may register the design in an amended form, where that form complies with the requirements for registration and the identity of the design is retained.

(12) A registration may be accompanied by a partial disclaimer by the registered proprietor or by entry in the Register of a court decision declaring the partial invalidity of the design right.

Exceptions to Design Right Protection

Section 48

(1) The design right is not infringed by—

(a) Acts done privately and for non-commercial purposes,

(b) Acts done for experimental purposes, or

(c) Acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

(2) The design right is not infringed by—

(a) Use of equipment on ships and aircraft registered outside the State where these temporarily enter the State,

(b) The importation into the State of spare parts and accessories for the purpose of repairing such craft, or

(c) The execution of repairs on such craft.

Section 49

(1) At any time after a design has been registered, any person may apply to the Controller for the grant of a compulsory licence in respect of the design on the ground that—

(a) A demand in the State for a product incorporating the design is not being met or is not being met on reasonable terms, or

(b) A demand in the State for a product incorporating the design is being met by importation other than from a member of the World Trade Organisation, and the Controller may make an order on the application as he or she thinks fit.

(2) An order for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed executed by the registered proprietor and all other necessary parties granting a licence in accordance with the order.

(3) Where an order granting a compulsory licence has been made any person may apply to the Controller for an order amending or cancelling that order on the grounds that the circumstances which led to that order have changed or have ceased to exist and are unlikely to recur, and the Controller may make an order on such application upon such terms as he or she thinks fit, including terms which provide for the protection of the interests of the licensee concerned.

Section 50

(1) Where a person has commenced use within the State, or has made serious preparations to that end, of a design which has not been copied from a registered design, the continued use of that design by that person for that purpose shall not infringe the design right in the registered design.

(2) The design referred to which has not been made available to the public before the filing date of the application for registration of the registered design or, where priority is claimed, the date of priority of the registered design, and the use of which commenced before the said filing date or, as the case may be, the said date of priority.

(3) The right conferred by this section may not be transmitted.

Infringement of Design Right

Section 51

1. The design right is infringed by a person who, without the license of the registered proprietor of the design and while the design right is in force, undertakes or authorises another to undertake any act which is the exclusive right of the registered proprietor of the design.

2. The design right is not infringed by the reproduction of a feature of the design which is not taken into account in determining whether the design is registrable.

Section 52

A person infringes the design right where he or she without the license of the registered proprietor of the design and while the design right is in force

(a) Sells, rents or offers or exposes for sale or rent,

(b) Imports into the State, otherwise than for his or her private and domestic use, or

(c) in the course of a business, trade or profession, has in his or her possession, custody or control, a product which is, and which he or she knows or has reason to believe is, an infringing product.

Section 53

A person infringes the design right where he or she without the licence of the registered proprietor of the design

(a) Makes,

(b) Sells, rents or offers or exposes for sale or rent,

(c) Imports into the State, or

(d) Has in his or her possession, custody or control, an article specifically designed or adapted for applying to or incorporating in a product the design, knowing or having reason to believe that it has been or is to be used to make infringing products.

Section 54

In this Act, a product shall be an “infringing product” in relation to a registered design where—

(a) The application of the design to or the incorporation of the design in the product is an infringement of the design right in the design,

(b) The product has been or is proposed to be imported into the State and the application of the design to or incorporation of the design in the product in the State would constitute an infringement of the design right in the design, or

(c) The use of the product in any other way infringes the design right.

(2) Nothing in subsection (1)(b) shall be construed as applying to products which have been put on the market in a Member State of the EEA by or with the consent of the registered proprietor of the design.

(3) An article shall be an “infringing article” in relation to a registered design where it is specifically designed or adapted for applying the design to products and a person makes, sells or rents, or offers or exposes for sale or rent, or imports into the State, such an article, or has it in his or her possession, custody or control knowing or having reason to believe that it has been or is to be used to make infringing products.

Remedies

Section 55

(1) Where in proceedings before the appropriate court the validity of the registration of a design is contested and it is found by that court that the design is validly registered, the

court may certify that finding and the fact that the validity of the registration of the design was contested in those proceedings.

(2) Where a certificate has been granted and in any subsequent proceedings before the appropriate court for infringement of the design right or for invalidation of the registration of the design, a final order or judgment is made or given in favour of the party relying on the validity of the registration, that party shall, unless the court otherwise directs, be entitled to his or her costs as between solicitor and client.

(3) Subsection (2) shall not extend to the costs of an appeal in any proceedings.

Section 56

(1) Where a person (whether or not the registered proprietor of, or entitled to any design right in, or any other interest in a design) by circulars, advertisements or otherwise threatens another person with proceedings for infringement of design right, a person aggrieved by the threats (whether or not he or she is the person to whom the threats are made) may bring proceedings in the appropriate court against the person making the threats for any such relief.

(2) In any proceedings the plaintiff shall, where he or she proves that the threats were so made and satisfies the court that he or she is a person aggrieved by them, be entitled to the relief claimed unless

(a) The defendant proves that the acts in respect of which the proceedings were threatened constitute or, if undertaken, would constitute an infringement of the design right, and

(b) The plaintiff fails to show that the registration of the design concerned is invalid.

(3) The relief referred to in subsections (1) and (2) shall be—

(a) A declaration to the effect that the threats complained of are unjustifiable,

(b) An injunction against the continuance of the threats, and

(c) Such damages, if any, as have been sustained by the plaintiff by reason of the threats.

(4) For the purposes of this section, a notification of the existence of a registered design does not of itself constitute a threat of proceedings within the meaning of this section.

(5) “A person aggrieved” shall not include a person making or importing any object.

Section 57

(1) An infringement of the design right is actionable by the registered proprietor of the design.

(2) No proceedings shall be taken in respect of an infringement committed before the date on which the certificate of registration of the design is granted.

(3) In an action for infringement of the design right, all relief by way of damages, injunction, account of profits or otherwise is available to the plaintiff as it is available in respect of the infringement of any other property right.

Section 58

(1) Where in an action for the infringement of the design right in a registered design, it is shown that at the time of the infringement the defendant did not know and had no reason to believe that the design was registered, the plaintiff shall not be entitled to damages against the defendant and no order shall be made for an account of profits.

(2) A person shall not be regarded as knowing or having reason to believe that the design was registered by reason only of the application to a product, or to any printed matter accompanying a product, of the word ‘registered’, or any word or words or abbreviation expressing or implying that a design has been registered, unless the registration number of the design accompanied the word or words or abbreviation concerned.

(3) Nothing in this section shall affect the power of the appropriate court to grant an injunction in any proceedings for the infringement of the design right in a registered design.

(4) In an action for infringement of design right, the appropriate court may, if it thinks fit, refuse to award any damages or make an order for an account of profits in respect of an infringement committed at any time during the period referred before the fees referred to in that subsection are paid.

Section 59

In addition to or as an alternative to awarding compensation to a plaintiff for financial loss, the appropriate court may award aggravated or exemplary damages or both aggravated and exemplary damages.

Section 60

(1) Where, in proceedings for infringement of the design right in a design in respect of which a licence is available as of right, the defendant undertakes to take a licence on such terms as may be agreed or, in default of agreement, settled by the Controller—

(a) No injunction shall be granted against the defendant,

(b) No order for delivery up shall be made under section 61, and

(c) The amount recoverable against the defendant by way of damages or on an account of profits shall not exceed 3 times the amount which would have been payable by the defendant as licensee where a licence on those terms had been granted before the earliest infringement.

(2) An undertaking may be given at any time before the final order in the proceedings without any admission of liability.

(3) Nothing in this section shall affect the remedies available in respect of an infringement committed before a licence was available as of right.

Section 61

(1) Where a person in the course of a business, trade or profession has in his or her possession, custody or control infringing products or articles the registered proprietor of the design may apply to the appropriate court for an order that the infringing products or articles be delivered up to him or her or to such other person as the court may direct.

(2) An application shall not be made after the expiration of the period specified in subsection (1) of section 71 as being the limit of the period for delivery up and no order shall be made unless the appropriate court also makes, or it appears to the appropriate court that there are grounds for making, an order as to the disposal of an infringing product or article.

(3) A person to whom an infringing product or article is delivered up pursuant to an order made under this section shall, where an order under section 72 as to the disposal of the infringing product or article is not made, retain it pending the making of an order, or the decision not to make an order, under that section.

Section 62

(1) Where the registered proprietor of a design applies to the District Court, it may, where satisfied that there are reasonable grounds for believing that there are being hawked, carried about or marketed infringing products or articles, authorise by order a member of the Garda Síochána accompanied by such other members of the Garda Síochána or other person or persons as that member thinks proper, to seize without warrant the products or articles and to bring them before the District Court.

(2) On being satisfied that any product or article referred to in subsection (1) is an infringing product or article the District Court may order the product or article to be destroyed or to be delivered up to the registered proprietor or otherwise dealt with as the Court may think fit.

(3) In an application to the District Court or, in any ex parte application or interlocutory motion to a court of competent jurisdiction for an order which would permit the applicant to enter and search a premises or place specified in that order and take possession of material found in those premises or that place on terms set out in such order, the court hearing such an application may receive hearsay evidence to the effect that the witness or deponent believes that the material may be found in a particular location.

(4) A witness or deponent shall not be obliged to indicate the source of the information upon which that witness formed the belief that material may be found in a particular location.

(5) After the implementation of an order made, the appropriate court may, on the application of a person aggrieved by it, award damages against the applicant for the order as it considers just, on being satisfied that

(a) No infringement of design right has been established, and

(b) The information on which the registered proprietor applied for the order was given maliciously.

Other legislations

1. Kenya³

According to industrial property Act 2001, an industrial design is defined as "any composition of lines or colours or any three dimensional form whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as pattern for a product of industry or handicraft" .

An industrial design is registrable if it is new. An industrial design is deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration. However a disclosure of the industrial design is not taken into consideration if it occurred not earlier than twelve months before the filing date or, where applicable, the priority date of the application and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title; or an evident abuse committed by a third party in relation to the applicant or his predecessor in title.

2. India⁴

India's Design Act, 2000 was enacted to consolidate and amend the law relating to protection of design and to comply with the articles 25 and 26 of TRIPS agreement. The new act, (earlier Patent and Design Act, 1911 was repealed by this act) now defines "design" to mean only the features of shape, configuration, pattern, ornament, or composition of lines or colours applied to any article, whether in two or three dimensional, or in both forms, by any industrial process or means, whether manual or 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.

3. Indonesia⁵

In Indonesia the protection of the Right to Industrial Design shall be granted for 10 (ten) years commencing from the filing date and there is not any renewal or annuity after the given period.

Industrial Designs that are Granted Protection

1. The Right to Industrial Design shall be granted for an Industrial Design that is novel/new

2. An Industrial Design shall be deemed new if on the filing date, such Industrial Design is not the same as any previous disclosure.

3. The previous disclosure as referred to in point 2 shall be one which before

a. The filing date or

³ www.kipi.go.ke/

⁴ The Design Act, 2000 patentoficce.nic.in.

⁵ The Design Act of Indonesia, 2000

- b. The Priority Date, if the applicant is filled with priority right.
- c. Has been announced or used in Indonesia or outside Indonesia. An industrial design shall not be deemed to have been announced if within the period of 6 (six) months at the latest before the filing date, such industrial design
 - a. Has been displayed in a national or international exhibition in Indonesia or overseas that is official or deemed to be official; or,
 - b. Has been used in Indonesia by the designer in an experiment for the purposes of education, research or development.

4. Canada⁶

Canada's industrial design act affords ten years of protection to industrial designs that are registered; there is no protection if the design is not registered. The Industrial Design Act defines "design" or "industrial design" to mean features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye.

During the existence of an exclusive right, no person can "make, import for the purpose of trade or business, or sell, rent, or offer or expose for sale or rent, any article in respect of which the design is registered." The rule also applies to kits and substantial differences are in reference to previously published designs.

5. Europe

Registered and unregistered Community designs are available which provide a unitary right covering the European Community. Protection for a registered Community design is for up to 25 years, subject to the payment of renewal fees every five years. The unregistered Community design lasts for three years after a design is made available to the public and infringement only occurs if the protected design has been copied.

6. United Kingdom⁷

In addition to the design protection available under Community designs, UK law provide its own national registered design right and an unregistered design right. The unregistered right, which exists automatically if the requirements are met, can last for up to 15 years. The registered design right can last up to 25 years subject to the payment of maintenance fees. The topography of semi-conductor circuits are also covered by Integrated circuit layout design protection, a form of protection which lasts 10 years.

7. Japan

Article 1 of the Japanese Design Law states: "This law was designed to protect and utilize designs and to encourage creation of designs in order to contribute to industrial development". The protection period in Japan is 20 years from the day of registration.

8. United States⁸

U.S. design patents last fourteen years from the date of grant and cover the ornamental aspects of utilitarian objects. Objects that lack a use beyond that conferred by their appearance or the information they convey, may be covered by copyright—a form of intellectual property of much longer duration that exists as soon as a qualifying work is

⁶ Industrial Design Act (Canada)

⁷ www.ipo.gov.uk/types/design.htm

⁸ www.uspto.gov/patents/resources/types/designapp.jsp

created. In some circumstances, rights may also be acquired in trade dress, but trade dress protection is akin to trademark rights and requires that the design have source significance or "secondary meaning." It is useful only to prevent source misrepresentations; trade dress protection.

9. Australia⁹

In Australia, design patent registration lasts for 5 years, with an option to be extended once for an additional 5 years. For the patent to be granted, a formalities exam is needed. If infringement action is to be taken, the design needs to become certified which involves a substantive examination.

INDUSTRIAL DESIGNS AND ITS REMEDIES

An industrial design refers to the ornamental or aesthetic aspects of an article. A design may consist of three-dimensional features, such as the shape or surface of an article, or two-dimensional features, such as patterns, lines or color. Industrial designs are applied to a wide variety of industrial products and handicrafts: from technical and medical instruments to watches, jewelry and other luxury items; from house wares and electrical appliances to vehicles and architectural structures; from textile designs to leisure goods.

To be protected under most national laws, an industrial design must be new or original and nonfunctional. This means that an industrial design is primarily of an aesthetic nature, and any technical features of the article to which it is applied are not protected by the design registration. However, those features could be protected by a patent.

Why protect industrial designs?

Industrial designs are what make an article attractive and appealing; hence, they add to the commercial value of a product and increase its marketability.

When an industrial design is protected, the owner – the person or entity that has registered the design – is assured an exclusive right and protection against unauthorized copying or imitation of the design by third parties. 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, encouraging creativity and promoting more aesthetically pleasing products. Protecting industrial designs helps to promote economic development by encouraging creativity in the industrial and manufacturing sectors, as well as in traditional arts and crafts. Designs contribute to the expansion of commercial activity and the export of national products. Industrial designs can be relatively simple and inexpensive to develop and protect. They are reasonably accessible to small and medium-sized enterprises as well as to individual artists and crafts makers, in both developed and developing countries.

How can industrial designs be protected?

⁹ www.ipaustralia.gov.au/

In most countries, an industrial design must be registered in order to be protected under industrial design law. As a rule, to be registrable, the design must be “new” or “original”. 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 previously existed. Once a design is registered, a registration certificate is issued. Following that, the term of protection granted is generally five years, with the possibility of further renewal, in most cases for a period of up to 15 years.

Hardly any other subject matter within the realm of intellectual property is as difficult to categorize as industrial designs. And this has significant implications for the means and terms of its protection. Depending on the particular national law and the kind of design, an industrial design may also be protected as a work of applied art under copyright law, with a much longer term of protection than the standard 10 or 15 years under registered design law. In some countries, industrial design and copyright protection can exist concurrently. In other countries, they are mutually exclusive: once owners choose one kind of protection, they 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 available can differ significantly.¹⁰

How extensive is industrial design protection?

Generally, industrial design protection is limited to the country in which protection is granted. The Hague Agreement Concerning the International Registration of Industrial Designs, a WIPO administered treaty, offers a procedure for international registration of designs. Applicants can file a single international application either with WIPO or the national or regional office of a country party to the treaty. The design will then be protected in as many member countries of the treaty as the applicant

Rights of the owner

The owner of a registered industrial design has the rights to take legal actions against any person who has infringed or is infringing any of the rights conferred by the registration of the industrial design; or performed acts which make it likely that an infringement will occur.

Legal proceedings mentioned above may not be instituted after five (5) years from the act of infringement.

If the owner proves that an infringement has been committed, the court may award damages or an account of profits and may grant an injunction to prevent further infringement and any other legal remedies.

If the owner proves that acts are being performed which make it likely that an infringement will occur, the court may grant an injunction to prevent infringement and any other legal remedies.

The court may refuse to award damages, or to make an order for an account of profits, if the defendant satisfies the court: that, at the time of the infringement, he was not aware

¹⁰ www.wipo.int/hague/en/general/id_faq.html

that the industrial design was registered; and that he had, prior to that time, taken all reasonable steps to ascertain whether the industrial design had been registered.¹¹

What constitutes an infringement?

An unregistered design is only infringed by copying. Independently created designs are not infringements. You have the right to take civil court action against infringement of a design right.

Copyright in designs

Copyright may exist in designs, and will principally protect documents detailing the design as well as any artistic or literary work incorporated within the finished product. Evidence of claim to copyright and unregistered design rights may be obtained by submitting your work to the UK Copyright Service.¹²

What are the available remedies for industrial design infringement?

The owner of a registered industrial design has the rights to take legal actions against any person who has

- infringed or is infringing any of the rights conferred by the registration of the industrial design; or
- performed acts which make it likely that an infringement will occur.

Legal proceedings mentioned above may not be instituted after five (5) years from the act of infringement.

If the owner proves that an infringement has been committed, the court may award damages or an account of profits and may grant an injunction to prevent further infringement and any other legal remedies

If the owner proves that acts are being performed which make it likely that an infringement will occur, the court may grant an injunction to prevent infringement and any other legal remedies.

The court may refuse to award damages, or to make an order for an account of profits, if the defendant satisfies the court:

- that, at the time of the infringement, he was not aware that the industrial design was registered; an
- that he had, prior to that time, taken all reasonable steps to ascertain whether the industrial design had been registered.

¹¹ www.lawyerment.com/library/kb/Intellectual_Property/Industrial_Design/1423.htm

¹² www.copyrightservice.co.uk/protect/p15_design_rights

CASES

J.N. Electricals (India) vs. President Electricals¹³

This is a suit against infringement of registered design of electric toaster of the plaintiffs, for passing off and rendition of accounts and damages. The plaintiffs are M/s. J. N. Electricals (India) a partnership firm, manufacturing various electrical goods, including electric toaster for the last so many years. The plaintiffs started manufacturing and selling electric toaster of a design which they got registered vide No. 140873 dated April 23, 1973.

A part from distinctive features of the electric toaster of the plaintiffs, the shape, configuration, upper view and side view of the plaintiffs' toaster are new and original and protected under the Designs Act, 1911

It is further stated that the arrangement of the outer sheet of the plaintiff's toaster has been made into two sheets which is quite novel. The upper portion of the said sheet is approximately 1/3rd and the lower portion is approximately 2/3rd of the total height of the plaintiffs' toaster. The said arrangement has been made in such a manner as to give fine outlook and appealing to the eye. The distinctive knob of the plaintiffs' toaster is different from a conventional knob which has been put on the side of the toaster.

The plaintiffs are the prior user of the distinctive design in respect of the electric toaster since 1973 while the defendants came into the market with their electric toaster in the year 1977.

The defendants have adopted identical and/or deceptively similar features as those of the plaintiffs' toaster and have been marketing the same, thereby infringing the plaintiffs'

¹³ ILR 1980 Delhi 215

registered design. Both, the shape and configuration of the plaintiffs' registered design have been infringed by the defendants. It is also alleged by the plaintiffs that apart from infringement of the plaintiffs' aforesaid design, the defendants have copied each and every word of instruction/pamphlet and each every photo and arrangement of the said pamphlet.

The plaintiffs have prayed for permanent injunction restraining the defendants from infringing their registered design in relation to the electric toaster and also for permanent injunction restraining the defendants from passing off electric toaster and pamphlet as that of the plaintiffs' manufacture.

The plaintiffs have also prayed for rendition of accounts with regard to manufacture and sale of impugned electric toaster and also for an order for destruction of the impugned electric toaster as well as other media pertaining thereto, including the pamphlet and semi finished goods.

The result of the aforesaid discussion is that the plaintiffs are granted a decree for permanent injunction restraining the defendants, their servants, agents, dealers and/or representatives from manufacturing/selling and offering for sale or dealing with the impugned electric toaster either directly or indirectly which is fraudulent or obvious imitation of the plaintiffs electric toaster registered under No. 140873 and from doing anything with a view to enable the registered design belonging to the plaintiffs to be so applied.

The plaintiffs are further granted a decree for permanent injunction, restraining the defendants, their servants, agents, dealers and representatives from using the impugned pamphlet/catalogues of the plaintiffs.

An order is also passed for destruction of the impugned electric toasters of the defendants as well as other media pertaining thereto including the pamphlets/catalogues in dispute.

Khadim Shoe Pvt. Ltd. vs Bata India Ltd. And Anr. ¹⁴

Respondent No. 1, Bata India Limited is manufacturer of various rubber slippers commonly known as hawai. The petitioner, Khadim Shoe Pvt, Ltd. is also a manufacturer of similar product and sales it in the market with the brand name "Vibrato",

Bata got a particular design of rubber slippers registered on 10th September, 1998 being the design No. 177386. Before the said design was registered Bata made a wide publicity in print media as well as in electronic media under the banner Hawaii Revolution.

Khadim applied for cancellation of the said design on the ground that the said design was published prior to the date of registration and hence such registration was liable for cancellation.

Prior to initiation of the said cancellation proceeding Bata filed a suit for infringement of their registered design as against the Khadim, Bata obtained an interim order restraining Khadim from infringing three registered designs which include design No. 177386

¹⁴ (2005) 1 CALLT 602 HC, 2005 (1) CHN 346

It is an admitted fact that the only issue involved herein is whether there was a prior publication of the design.

"Prior publication" is a publication by which the members of the public at large are made known the design prior to its registration either by the registered designer himself or by any other party. Such publication might be an unintentional act on the part of the publisher. The intention of the publisher is not relevant fact for considering a prior publication. The idea is whether the people knew of the design or not prior to the date of registration.

The contention of the Bata that the publication was not intended for any purpose other for making promotional approach prior to the launching of the product. 30. Hence the design was published prior to its date of registration.

In the result, the application succeeds. The design No. 177386 dated 10th September, 1998 granted to Bata is cancelled.

Marico Co LTD vs. Raj Oil Mills Co LTD¹⁵

The Plaintiffs are the registered proprietor of the designed article, for reference called "Parachute Cap", since 1999. The Respondents Application for registration of their cap i.e. for reference called "Cocoraj Cap" was rejected sometime in the year 2004.

The cause of action arose, when the Plaintiffs learnt about the use by the Respondents of the impugned caps for which they have registered and acquired copyright of the said design.

There no prima facie case. Hence the injunction is denied

Joginder singh V/s Tebu Enterprises Ltd.¹⁶

The court held that if the goods imported from abroad are used by the importer without its discloser to anyone else and goods of such a design are not freely available, then there is no publication of the design so imported. If, however, the goods which are imported are used in full view of the general public, the design of such goods are regarded as published in India and would not be regarded as new or original designs. The court, in this case cancelled the registration of the design in the favour of the respondent as it has been per published.

Calico printers association Ltd vs D.M. Mukherjee.¹⁷

It was held in this case that the burden of proof was on the defendant in the case for infringement of design that there was no infringement on his part. The plaintiff, had the initial burden to prove registration, copyright etc. In a design . it was also plaintiffs burden to prove the fraudulent or obvious limitation thereof.

Western Engineering Co vs. Paul Engineering Co.¹⁸

¹⁵ AIR 2008 Bom 111, 2008 (110) Bom L R 638

¹⁶ AIR 1989 Del. 81=1989 PTC 175

¹⁷ AIR 1936 cal. 493

Where the sameness or identity of two designs was to be determined it was held that similarity of device in external appearance might be a relevant factor in considering the substantial difference between the two but was certainly not a determining factor. One practical test was to find out whether there were substantial differences between the designs registered earlier and subsequently. The conclusion was to be arrived at by visual examination of the two things.

B.K.plastic industries vs. Jayantilal Kalidas Sayani¹⁹

It was held that in an action for damages for infringement or in an application for cancellation or revocation of a registration of a design if it was proved that the design was neither new nor original then it should be cancelled or revoked.

CONCLUSION

An industrial design right is an intellectual property right that protects the visual design of objects that are not purely utilitarian. An industrial design consists of the creation of a shape, configuration or composition of pattern or color, or combination of pattern and color in three dimensional form containing aesthetic value. An industrial design can be a two- or three-dimensional pattern used to produce a product, industrial commodity or handicraft.

Under the Hague Agreement Concerning the International Deposit of Industrial Designs, a WIPO-administered treaty, a procedure for an international registration exists. An applicant can file for a single international deposit with WIPO or with the national office in a country party to the treaty. The design will then be protected in as many member countries of the treaty as desired. Design rights started in the United Kingdom in 1787 with the Designing and Printing of Linen Act and have expanded from there.

¹⁸ AIR 1968 Cal. 109 (111)

¹⁹ AIR 1972 Cal. 339 (341)

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