

PAPER II

NATURE AND SUBJECT MATTER OF INDUSTRIAL DESIGN

By

VIDITA P. KHUTKAR

2ND YEAR L.L.M

(Year 2013)

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INTRODUCTION

Meaning of industrial design:

1. Design is the process of taking something from its existing state and moving it to a preferred state." This applies to new artifacts, whose existing state is undefined and previously created artifacts, whose state stands to be improved.¹
2. According to WIPO's definition, an industrial design refers to the aesthetic aspects of an item, such as its shape and colour. Industrial designs are applied to a large array of products, ranging from medical instruments to watches and smartphones.²
3. Meaning as per Indian Design Act 2000- According to Section 2 (d) "design" means 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 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, 1957.³

Industrial designs refer to creative activity which result in the ornamental or formal appearance of a product and design right refers to a novel or original design that is accorded to the proprietor of a validly registered design. Industrial designs are an element of intellectual property. As a developing country, India has already amended its national legislation to provide for these minimal standards. The essential purpose of design law is to promote and protect the design element of industrial production. It is also intended to

¹ http://en.wikipedia.org/wiki/Industrial_design visited on 23/11/2013

² <http://ictsd.org/i/news/bridgesweekly/151994/> visited on 20/11/2013 at 8.30pm

³ Law of copyright and industrial design by P. NARAYANAN

promote innovative activity in the field of industries. The existing legislation on industrial designs in India is contained in the New Designs Act, 2000 and this Act will serve its purpose well in the rapid changes in technology and international developments. India has also achieved a mature status in the field of industrial designs and in view of globalization of the economy, the present legislation is aligned with the changed technical and commercial scenario and made to conform to international trends in design administration.⁴

⁴ http://en.wikipedia.org/wiki/Industrial_design visited on 23/11/2013

HISTORICAL BACKGROUND OF INDUSTRIAL DESIGN

During the last century, before the existence of any international convention in the field of industrial property, it was difficult to obtain protection for industrial property rights in the various countries of the world because of the diversity of their laws. Moreover, patent applications had to be made roughly at the same time in all countries in order to avoid a publication in one country destroying the novelty of the invention in the other countries.

These practical problems created a strong desire to overcome such difficulties.⁵

During the second half of the last century the development of a more internationally oriented flow of technology and the increase of international trade made harmonization of industrial property laws urgent in both the patent and the trademark field. When the Government of the Empire of Austria-Hungary invited the other countries to participate in an international exhibition of inventions held in 1873 at Vienna, participation was hampered by the fact that many foreign visitors were not willing to exhibit their inventions at that exhibition in view of the inadequate legal protection offered to exhibited inventions.⁶

This led to two developments: firstly, a special Austrian law secured temporary protection to all foreigners participating in the exhibition for their inventions, trademarks and industrial designs. Secondly, the Congress of Vienna for Patent Reform was convened during the same year, 1873. It elaborated a number of principles on which an effective and useful patent system should be based, and urged governments “to bring about an international understanding upon patent protection as soon as possible.” As a follow-up to the Vienna Congress, an International Congress on Industrial Property was convened at Paris in 1878. Its main result was a decision that one of the governments should be asked to convene an international diplomatic conference “with the task of determining the basis of uniform legislation” in the field of industrial property. Following that a final draft proposing an international “union” for the protection of industrial property was prepared in France and was sent by the French Government to a number of other countries, together with an invitation to attend the 1880 International Conference in Paris. That Conference adopted a draft

⁵ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

⁶ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

convention which contained in essence the substantive provisions that today are still the main features of the Paris Convention.⁷

A Diplomatic Conference was convened in Paris in 1883, which ended with final approval and signature of the Paris Convention for the Protection of Industrial Property. The Paris Convention was signed by 11 States: Belgium, Brazil, El Salvador, France, Guatemala, Italy, the Netherlands, Portugal, Serbia, Spain and Switzerland. When it came into effect on July 7, 1884, Great Britain, Tunisia and Ecuador had adhered as well, bringing the initial number of member countries to 14. El Salvador, Guatemala and Ecuador later denounced the Paris Convention to join again in the 1990s. It was only during the first quarter of the 20th century and then particularly after World War II that the Paris Convention increased its membership more significantly. The Paris Convention has been revised from time to time after its signature in 1883. Each of the revision conferences, starting with the Brussels Conference in 1900, ended with the adoption of a revised Act of the Paris Convention. With the exception of the Acts concluded at the revision conferences of Brussels (1897 and 1900) and Washington, D.C. (1911), which are no longer in force, all those earlier Acts are still of significance, although the great majority of the countries are now party to the latest Act, that of Stockholm of 1967.⁸

⁷ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

⁸ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

LAWS RELATING TO INDUSTRIAL DESIGN

The formulation of a legal system for the protection of industrial designs, like the provision of legal protection for all forms of intellectual property, requires the establishment of a balance of interests. On the one hand, there is the need to provide efficient and effective protection, in order that the law may fulfill its function of promoting the design element in production. On the other hand, there is the need to ensure that the law does not unnecessarily extend protection beyond what is necessary to create the required incentive for design activity, so that the least number of impediments are introduced to the free use of available designs. The establishment of this balance requires careful consideration of a number of matters, of which the most important are:

- the definition of the subject matter of protection;
- the rights which apply to the proprietor of the subject matter;
- the duration of such rights;
- the entitlement to such rights;
- the method of acquisition of such rights.⁹

Paris Convention: on the intellectual property rights conveyed in the year 1883 laid down important principles which can be divided into four main categories:

1. first category contains rules of substantive law which guarantee a **basic right known as the right to national treatment in each of the member countries**:

National treatment means that, as regards the protection of industrial property, each country party to the Paris Convention must grant the same protection to nationals of the other member countries as it grants to its own nationals. The same national treatment must be granted to nationals of countries which are not party to the Paris Convention if they are domiciled in a member country or if they have a “real and effective” industrial or commercial establishment in such a country. Article 2(3) states an exception to the national treatment rule. The national law relating to judicial and administrative procedure, to jurisdiction and to requirements of

⁹ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

representation is expressly “reserved.” An example is a requirement for foreigners to deposit a certain sum as security or bail for the costs of litigation. The term “national” includes both natural persons and legal entities. Generally, no nationality as such is granted to legal entities by the various national laws. There is of course no doubt that State-owned enterprises of a member country or other entities created under the public law of such country are to be considered as nationals of the member country concerned.¹⁰

2. Second category establishes another basic right known as the **right of priority**: The right of priority means that, on the basis of a regular application for an industrial property right filed by a given applicant in one of the member countries, the same applicant (or its or his successor in title) may, within a specified period of time (six or 12 months), apply for protection in all the other member countries. These later applications will then be regarded as if they had been filed on the same day as the earliest application. Hence, these later applications enjoy a priority status with respect to all applications relating to the same invention filed after the date of the first application. They also enjoy a priority status with respect to all acts accomplished after that date which would normally be apt to destroy the rights of the applicant or the patentability of his invention. the length of priority period for industrial designs is six months.¹¹

3. Third category defines a certain number of common rules in the field of substantive law which contain either rules establishing rights and obligations of natural persons and Legal Entities, or rules requiring or permitting the member countries to enact legislation following those rules¹²

4. A fourth category deals with the administrative framework which has been set up to implement the Convention, and includes the final clauses of the Convention.¹³

Article 5 of The Paris Convention deals with Industrial Designs. This provision merely states the obligation of all member countries to protect industrial designs. Nothing is said

¹⁰ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

¹¹ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

¹² <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

¹³ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

about the way in which this protection must be provided. Member countries can therefore comply with this obligation through the enactment of special legislation for the protection of industrial designs. They can, however, also comply with this obligation through the grant of such protection under the law on copyright or the law against¹⁴

The Hague Agreement: It 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”); The London Act of June 2, 1934 (the “1934 Act”). The London act of 1934 is no more in force.

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.

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

¹⁴ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

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.¹⁵

Protection of Industrial Designs under the new Indian Designs Act, 2000:

The 1911 act was amended so many times in the British colonial period and after the Indian independence. Finally Indian Designs Act, 2000 was enacted to consolidate and amend the law relating to the protection of designs and to implement the TRIPS Agreement. It came into effect in India on May 11, 2001, replacing the old law of 1911 to provide more effective protection to the registered designs and to encourage design activities. The new act of 2000 grants the owner or proprietor of the registered designs an **exclusionary right of selling, licensing, assigning and using the same in any product**. In India, registration of an industrial design is possible to protect if it is new or original provided it is a: non-functional features of shape, configuration, pattern, ornamentation 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 guide, mechanical or chemical, separate or combined. India, under this act, has adopted the 'first to file, first to get' system, which means that the inventor or creator of a design should file the application for registration on the earliest possible time in order to prevent other persons claiming rights on that particular designs. A design is considered to be new if no design has been made available to the public before the date of filing, or the application for registration. In India, novelty is determined on a worldwide basis. The main change that the act has brought in is the exclusion of 'artistic works' as defined in the Indian Copyright Act, 1957 from the definition of the term 'design'. Likewise the Copyright act also excludes any design which is registered under the Designs Act from the scope of protection under the copyright act. The new definition to the term 'design' made many conflicts in giving protection to the artistic works. This was explained by the Delhi High Court in *Microfibers Inc. v. Girdhar Co. & Another* 2009(40) PTC 519(Del) that the artistic works which are excluded from designs protection are the piece of art by itself in the

¹⁵ <http://www.lex-ip.com/Paris.pdf> visited on 22/11/2013 at 5.30pm

form of painting. The court further observed that the artistic work with an object to put them into industrial use are not excluded from the section 2(d) of the designs act and they needs to be registered to get protection. The court clearly explained in that case that “The exclusion of an 'artistic work' as defined in Section 2(c) of the Copyright Act from the definition of 'design' under Section 2(d) of the Designs Act, 2000 is only meant to exclude the nature of artistic works like painting of M. F. Hussain. It is, thus, the paintings, sculptors and such works of art which are sought to be specifically excluded from the new Act”¹⁶

The definition under the act of 2000 is an improved one and more comprehensive. The inapplicability of copyright law to the fashion industry has not caused any instability, nor has it adversely affected the incentive to innovate and create. It is beyond doubt that the fashion industry needs to regulate dissemination of designs and art to reduce if not curb unauthorized use and appropriation of creative artistic works.¹⁷

The new act has made another major change to the existing act by extending the initial period of protection to ten years from five years, but the maximum term of protection remains the same for fifteen years In case of piracy of the designs, the person who infringed the design copyright shall be liable for the fine not exceeding fifty thousand rupees. The proprietor can also bring a suit for recovery of damages and infringement. The suit for infringement of registered designs cannot be instituted in any court lower than that of a district judge. The new act is more superior and effective in giving protection and encouraging the industrial designs in India.¹⁸

¹⁶ <http://www.scribd.com/doc/53318556/Evolution-of-Designs-Act-in-India-Protection-of-Industrial-Designs-under-International-IPR-Regime> visited on 23/11/2013 at 5.30pm

¹⁷ <http://www.scribd.com/doc/53318556/Evolution-of-Designs-Act-in-India-Protection-of-Industrial-Designs-under-International-IPR-Regime> visited on 23/11/2013 at 5.30pm

¹⁸ <http://www.scribd.com/doc/53318556/Evolution-of-Designs-Act-in-India-Protection-of-Industrial-Designs-under-International-IPR-Regime> visited on 23/11/2013 at 5.30pm

Relation to TRIPS (TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS): The TRIPS Agreement obliges members to provide for the protection of independently created industrial designs that are new or original. It says that the members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features and that such protection shall not extend to designs dictated essentially by technical or functional consideration. Further the TRIPS requires the members to grant the owner of a protected industrial design the right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes. Under the TRIPS agreement, the minimum term of protection given to the proprietor should be ten years.¹⁹

¹⁹ <http://www.scribd.com/doc/53318556/Evolution-of-Designs-Act-in-India-Protection-of-Industrial-Designs-under-International-IPR-Regime> visited on 23/11/2013 at 5.30 pm

NATURE AND SCOPE OF INDUSTRIAL DESIGNS

It goes without saying that design skills and processes pervade the entire spectrum and spheres of human endeavours and activity. Thus their roots are steeply embedded in the evolutionary trends of any given society's cultural, economic, political and legislative beliefs, values, perceptions, perspectives and aspirations. In this sense they are reflective of an intimate blend of practices underlying public spirit and utility objectives of societies. The end result of which is that designs evolve into forms that are well-suited to the end-users' needs, aspirations and expectations. For instance, in England, Cardinal Richelieu's disgust with a dinner guest's constant habit of picking his teeth with a pointed knife prompted the design of the blunted knife, whose subsequent shortcoming to spear meat in turn led to the design of the two-fingered fork, then further improved to modern day diverse fork designs. So too did the Orientals' displeasure with human fingers dipping into food lead to the design of chopsticks. These related developments amply demonstrate and reinforce the truism that different and culture-specific solutions to similar problems, needs and wants are at the core of design processes. In this context, design processes are to be viewed as by and large inspired and propelled by the failure of existing products and processes to function optimally to produce the desired result and by the extent to which the creator can innovatively imagine a suitable alternative.²⁰

Design means a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied to an article to by some manual, mechanical or chemical means. It is a suggestion of form or ornament to be applied to a physical body. It is a conception, suggestion or idea, and not an article, which is the thing capable of being registered. The design is not the article, but is the conception, suggestion, or idea of a shape, picture, device, or arrangement which is to be applied to the article.²¹

²⁰ <http://www.theindependent.co.zw/2012/07/27/intellectual-property-perspectives-rationale-of-industrial-design-protection/> visited on 23/11/2013 at 5.30pm

²¹ Law of copyright and industrial design by P. NARAYANAN

Industrial design is a discipline which relates to the skill of designing products for either consumer or industrial use. In pursuance whereof requisite are attributes of striking an appropriate balance between elegance, visual appeal, functionality, comfort, safety and affordability against considerations of fashion, style, competition, technology trends, production processes, raw material and social concerns.²²

Rights in Industrial Designs: The rights which are accorded to the proprietor of a validly registered industrial design again emphasize the essential purpose of design law in promoting and protecting the design element of industrial production. Thus, industrial design law accords to the proprietor the exclusive right to prevent the unauthorized exploitation of the design in industrial articles.²³

Entitlement to Rights: The right to legal protection in respect of an industrial design belongs to the creator (or author or originator) of the industrial design. Two questions concerning the operation of this principle arise and are often the subject of particular legislative provisions. First, there is the question of the entitlement to legal protection in respect of an industrial design that has been created by an employee, or by a contractor pursuant to a commission. In these situations, the law usually provides that the entitlement to legal protection of the design shall belong the employer, or to the person who has commissioned the design. The basis for this rule is that the creation of the design falls within the duties which the employee is paid to perform, so that the employee should seek the reward for his creative activity in an appropriate level of remuneration, responsibility and other conditions of employment. Likewise, in the case of the contractor, the thing for which the contractor is being paid is the production of the design for the use of the person commissioning the design.²⁴

²² http://www.dww.com/?page_id=1034#III.b visited on 24/11/2013 at 7.45 pm

²³ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

²⁴ <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> visited on 20/11/2013 at 8.30pm

Nature of the Rights: The right to prevent others from exploiting an industrial design usually encompasses the exclusive right to do any of the following things for industrial or commercial purposes:

- make articles to which the design is applied or in which the design is embodied;
- import articles to which the design is applied or in which it is embodied;
- sell, hire or offer for sale any such articles.

In some laws, the exclusive rights of the proprietor also extend to preventing another from stocking any articles to which the design has been applied or in which it is embodied. While this right is sometimes considered as excessive in that it deals only with preparatory acts, it is on the other hand often included in order to facilitate the enforcement of a proprietor's rights, since it may often be easier to locate a stock of infringing articles than to apprehend a person in the act of selling or offering for sale such articles.²⁵

Relation to Copyright: Objects qualifying for protection under the law of industrial designs might equally well receive protection from the law of copyright. Thus, industrial designs law has relations both with copyright law and with industrial property law. Supposing a particular design embodies elements or features which are protected both by the copyright law and the industrial design law, a creator of an industrial design may claim cumulatively or simultaneously the protection of both laws. Cumulation of protection means that the design is protected simultaneously and concurrently by both laws in the sense that the creator can invoke the protection of either or both, the copyright law or the industrial design law, as he chooses. It also means that if he has failed to obtain the protection of the industrial design law by failing to register his design, he can claim the protection of copyright law, which is available without compliance with any formality. Finally, it means that after the term of protection of the registered design expires, the creator may still have the protection of the copyright law. But it is to be noted that cumulation must be distinguished from "co-existence." Co-existence of protection means that the creator may choose to be protected either by the industrial design law or by the copyright law. If he has chosen the one, he can

²⁵ http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_3-main1.pdf
visited on 23/11/2013 at 5.30pm

no longer invoke the other. (The system of cumulation of protection by the industrial design law and the copyright law exists in France and in Germany. And the system of co-existence of protection by both laws prevails in most other countries.)²⁶

²⁶ http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_3-main1.pdf visited on 23/11/2013 at 5.30pm

SUBJECT MATTER OF INDUSTRIAL DESIGN

The subject matter of an industrial design is defined by the design which has been registered.

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 view point. The design act, 2000 serves the purpose of visual appeal.²⁷

As understood by the way of design act of 2000 the industrial design relate to features of shape, configuration, pattern or ornamentation applied or applicable to an article. The design should be such which can be applied or applicable to any article and to do so industrial process is required. Generally designs which are of artistic nature like painting, sculptures etc. which are not produced by way of industrial process are not included as industrial designs. A design to be considered as industrial design must have a pattern or shape which appeals to the eye of the person and must appear and should be visible on the finished article.

Industrial design needs to be registered to get the protection given under the industrial design law. For the purpose of registration it needs to satisfy the conditions needed for the registration of design. Registration of design is done of the basis of the subject matter which is qualified for the registration. Industrial design is not an abstract idea which can be registered but it is actual matter or a pattern drawn on the paper that would be applied to an article which would be produced by way of industrial process and appeals to the eye of a person for its design and not because of its use for any purpose.

²⁷ Intellectual property law handbook by DR. B.L. WADEHRA

Article: a design is something which is applied to an article. A piece of paper on which a pattern is drawn cannot be a subject matter for registration of design. But the article itself cannot be a design. But a piece of paper on which is drawn a three dimensional object with the pattern shown on it may be registered as a design because here the design is a representation of the article on which the pattern is applied similarly if the drawing is that of an article like bottle, vase, chair, table a motor body it would be registrable as a design if it is novel. Here what is registered is the shape of an article and the drawing on the paper is only a convenient representation of the shape of the article.²⁸

Application to or Embodiment in an Article: While the subject matter of design protection is an essentially abstract conception, one of the basic purposes of industrial design protection is the stimulation of the design element of production. It is, accordingly, a usual feature of industrial design laws that a design can be protected only if the design is capable of being used in industry, or in respect of articles produced on a large scale. The requirement that a design must be applied to utilitarian articles in order to be protected is one of the principal matters which distinguish the objectives of industrial design protection from copyright protection, since the latter is purely concerned with aesthetic creations.²⁹

Three dimensional and two dimensional design: a design may be three dimensional or two dimensional. Shapes and configuration are synonymous and three dimensional for example the shape of the bottle, vase and so on. On the other hand a pattern or ornament is two dimensional as in the case of patterns for textile, wallpaper etc.³⁰

Design must be non-functional: The concern of industrial design protection with appearance only is also apparent from the requirement, commonly found in industrial design laws, that designs which are dictated solely by the function which the article is to

²⁸ Law of copyright and industrial design by P. NARAYANAN

²⁹ http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_3-main1.pdf visited on 20/11/2013 at 7.30 pm

³⁰ Law of copyright and industrial design by P. NARAYANAN

perform shall be excluded from protection. In this respect, Article 25.1 of the TRIPS Agreement provides, for example, that Members of the WTO may provide that industrial design protection shall not extend to designs dictated essentially by technical or functional considerations. A fundamental purpose is served by the exclusion from protection of designs dictated solely by the function which the article is to perform. Many articles to which designs are applied are not themselves novel, and are produced by a large number of different manufacturers. Belts, shoes, screws and piston rings, for example, may be produced by hundreds of different manufacturers, and all articles within each class are intended to perform the same function. If a design for one such article, for example, screws, is dictated purely by the function which the screw is intended to perform, protection for that design would have the effect of excluding all other manufacturers from producing items intended to perform the same function. Such an exclusion is not warranted, unless the design is sufficiently novel and inventive to qualify under the rigorous standards for patent protection.³¹

Registration of design: for protection under industrial design the industrial design has to be registered in the by way of an application. Registration of design is done on the basis of the design in the application and only if it fulfils certain conditions laid down which are as follows:

Application for Registration: An application for registration must relate to only one design (designs showing close variants may be included). A complete application consists of two parts: (i) a written application and (ii) an illustration of the design. Since the aesthetic content of the sample or model must be immediately recognizable, great significance is placed on the illustration. Photos are also permitted although not preferred.³²

Three conditions must be satisfied in order to obtain registration: the work must have aesthetic appeal and it must be original and novel.

³¹ http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_3-main1.pdf visited on 20/11/2013 at 7.30 pm

³² http://www.dww.com/?page_id=1034#III.b visited on 20/11/2013 at 7.30pm

Aesthetic Appeal: Features that appeal to eye only are protected under the industrial design law. The design must be on the outside of the article and visible to the user. It should not be inside the article to be manufactured by a mechanical process.³³

Originality: The requirement for originality is not expressly stated in the Indian Design Act, however, the IDA states that a certificate of registration of an industrial design is, in the absence of proof to the contrary, sufficient evidence of the originality of the design. The applicant must declare that the design was not in use, to the applicant's knowledge, by any person other than the applicant at the time the design was adopted by the applicant.³⁴

Originality is a question of fact for assessment, having regard for the nature of the subject matter. The Industrial Design Office has adopted a three prong test as to originality: (i) the applicant's design and the prior art design should not be examined side by side, but separately; (ii) the applicant's design is viewed as a whole; and (iii) any change (change relevant to a prior art design) must be substantial. Originality requires at least a spark of inspiration in creating an entirely new design or discovering a new use for an old one.³⁵

Novelty: It is a requirement of all industrial design laws that protection through registration shall be granted only to designs which are novel or, as it is sometimes expressed, original. The novelty of the design constitutes the fundamental reason for the grant of a reward to the originator through protection by registration of the industrial design. While the requirement of novelty is to be found in all laws, the nature of the novelty that is required as a condition of protection differs amongst the laws of various countries. The novelty required is sometimes absolute or universal, meaning that the design for which registration is sought must be new as against all other designs produced in all other parts of the world at any previous time and disclosed by any tangible or oral means. On the other hand, a qualified standard of novelty is sometimes required. In this latter situation, the qualification may relate to time, meaning that novelty is judged by reference to designs published within a limited preceding period of time;

³³ http://www.dww.com/?page_id=1034#III.b visited on 20/11/2013 at 7.30pm

³⁴ http://www.dww.com/?page_id=1034#III.b visited on 20/11/2013 at 7.30pm

³⁵ http://www.dww.com/?page_id=1034#III.b visited on 20/11/2013 at 7.30pm

or may relate to territory, meaning that novelty is judged by reference to all designs published within the relevant jurisdiction, as opposed to anywhere in the world; or may relate to means of expression, meaning that novelty is assessed by reference to written or tangible disclosures anywhere in the world and to oral disclosures only within the relevant jurisdiction. The broad policy argument in favour of a standard of unqualified universal novelty is that exclusive rights by registration should be granted only where the originator of the design has produced something which is truly novel, and which therefore justifies the reward of exclusive rights. The broad policy argument in favour of a qualified standard of novelty is that one purpose of design registration is to encourage new design within the relevant jurisdiction, so that a novel design registered within that jurisdiction should not be deprived of protection by the publication elsewhere of a design which its originator did not introduce into the jurisdiction to add to the designs available to industry. It should be noted, however, that it would not necessarily follow from a qualified standard of novelty that a person could obtain valid rights within the jurisdiction simply by registering a design which he had seen overseas and copied, since it is often also a requirement of design law that the applicant be the author of the design.³⁶

No Prior Publication (section 5 of IDR 2000): An application for registration of a design should be for a new or original design and not for previously published in any country. Thus it is an essential requirement for registration that the design should not be published in India prior to the date of application.³⁷

Duration of the registration of a design: The total time of a registered design is 15 years. Initially the right is granted for a period of 10 years, which can be extended, by another 5 years by making an application and paying a fee of Rs. 2000/- to the Controller before the

³⁶ http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_3-main1.pdf visited on 20/11/2013 at 7.30 pm

³⁷ The copyright and industrial design by P. NARAYAN

expiry of initial 10 years period. The proprietor of design may make application for such extension even as soon as the design is registered.³⁸

³⁸ <http://www.indianpatents.org.in/faqdesign.htm#86> visited on 20/11/2013 at 7 pm

CONCLUSION

Industrial design is not an abstract idea instead it is a pattern or shape drawn on a paper which will be applied to an article giving it a distinct feature which appeals to the eye of a person for its appearance and not for the use of the article.

The industrial design needs to be registered in order to get protection under industrial design law in the India as well as in other countries (member countries to the Paris convention for protection of industrial property) by way of a proper application

The Industrial Design registration helps in safeguarding the ornamental or aesthetic elements of the article and it gives exclusionary rights to the holder or proprietor of the registered designs against unauthorized use like replicating or copying by a person without his consent. The protection to the industrial designs helps the economic development, which promote creativity in the industrial arena. From the above discussion it is clear that The Hague system for international registration of designs provides maximum advantages and benefits to the international merchandisers to acquire registration and get protection within the contracting states through a single application. It makes the procedure simple and efficient in registering and getting protection for the designs created by an individual at the international level. However, India is not a member to the Hague system of international registration of design; it gives wider protection to the industrial designs under the designs act of 2000. But it will be better to have international protection in India to make the protection available in all the contracting parties to the Hague system and to provide much protection to the international traders in India.³⁹

³⁹ <http://www.scribd.com/doc/53318556/Evolution-of-Designs-Act-in-India-Protection-of-Industrial-Designs-under-International-IPR-Regime> visited on 23/11/2013 at 5.30 pm

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