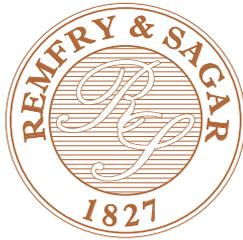


**World
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Review**

Designs: A Global Guide 2014



Remfry & Sagar

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Legal framework

In India, design law is governed by the Designs Act 2000 and the Designs Rules 2001 (as amended in 2008).

The preceding legislation, the Designs Act 1911, dated back nearly a century. Tremendous progress in science and technology over the course of the 20th century, a vastly changed economic milieu and India's accession to the Agreement on Trade-Related Aspects of IP Rights necessitated an urgent review of the legal design protection system to address modern demands. The Designs Act 2000 was enacted to meet this objective.

Design protection is territorial in nature. If design registration is sought outside India, the owner must seek protection in each country separately under its relevant laws. However, India is a party to the Paris Convention and recognises the right to claim priority from other member states. This right is available for six months from the earliest priority date (ie,

the date on which the design application is first filed in a reciprocal country).

Additionally, while India is not a signatory to the Locarno Agreement, its design classification system is modelled on the Locarno Classification system. There are 32 classes, of which most are further divided into sub-classes. These classes have been numbered as Class 1 to 31 and Class 99. Class 99 covers articles which are not specifically mentioned under any of the other 31 classes.

Unregistered designs

Designs are a statutory right in India and the statute prescribes registration as a condition precedent for protection. Hence, there is no right in or remedy available for unregistered designs.

Registered designs

A design registration protects the aesthetic aspect of a product. Registration confers protection on the features of shape, configuration, pattern, ornament or composition of lines or colours as applied to an article. Functional or technical features of

articles are not protected under the Designs Act. An 'article' includes, among other things, any substance – artificial or partly artificial and partly natural – and any part of an article which is capable of being manufactured and sold independently.

Further, novelty or originality is a prerequisite for design registration in India.

A design is considered 'novel' if:

- it has not been disclosed to the public anywhere in the world by publication or use, or in any other way, before the filing date or priority date; and
- it is significantly distinguishable from known designs or a combination of known designs.

'Original' in relation to a design means originating from the author of the design and includes designs which, although old in themselves, are new in their application. The statutory definition of a 'design' covers "features...which in the finished article appeal to and are judged solely by the eye" (Section 2(d) of the Designs Act). The 'appealing to the eye' requirement is a preliminary test of novelty. Similarity between designs is ascertained by the 'judged solely by the eye' test.

Prior publication or display of a design is novelty vitiating. The only exception to this rule involves disclosure of a design in industrial or other exhibitions which are notified in the *Official Gazette* with prior intimation to the controller general of patents, designs and trademarks, where the necessary application is made within six months of the date of first exhibition or publication.

The Designs Act includes no specific provisions or exclusions on the registration of spare parts and partial designs. These are registrable provided that they satisfy the essential registrability criteria. Insofar as partial designs are concerned, the novelty requirement is restricted to the novel portion only.

Protection can also be afforded to a set of articles if the articles included in the set:

- are ordinarily sold together or intended to be used together;
- have common designs, despite the articles being different; and
- have the same general character.

Not all designs are registrable under the Designs Act. Unregistrable designs include those which:

- are not new or original;
- have been previously published or used anywhere in the world;
- are not significantly distinguishable from known designs or a combination of known designs;
- comprise or contain any scandalous or obscene matter;
- are against public order or morality;
- are mere mechanical contrivances; or
- contain a trademark or artistic work.

The official fee for filing and registration (extension of term) of a design is Rs3,000 (approximately \$45). This excludes fees incurred in seeking time extensions, if required.

Procedures

An application for design registration can be filed directly by an applicant or its assignee, or through an attorney. In the case of foreign nationals, an address for service in India must be furnished in any proceedings under the Designs Act. Electronic filing of design applications is not available as yet.

The application form should include the following details:

- the applicant's name, address and nationality;
- the class in which the design is to be filed;
- a representation of the design depicting various views of the article;
- the articles to which the design is to be applied;
- an address for service in India; and
- details of priority, if claimed.

Where an application is filed through an agent or attorney, a power of authority must be submitted. Details of the designers need not be provided.

Multiple embodiments of a design or multiple designs in a single application are not allowed. Separate applications for each distinct embodiment or design should be filed simultaneously or, in any event, before expiry of the priority deadline. Figures can be submitted in the form of line drawings, computer graphics or photographs, and should

contain no descriptive matter, reference numerals/letters or trademarks. Dotted or discrete lines or any shading in the line drawings is usually not allowed.

The examination process is substantive. The Designs Office examines an application for compliance with formal and technical requirements. The design is checked for novelty or originality. If defects are found in an application, they are communicated to the applicant in an examination report. A design application must be placed in order for acceptance within six months of the filing date. Thus, if the applicant is unable to reply to the examination report within this period, it can file a formal request for an extension (of up to three months) at the Designs Office, along with the prescribed official fees. Once an application is found to be in order, a registration certificate is issued and registration of the design is published in the *Official Journal*. If an application is rejected, the controller's decision can be appealed before the High Court.

Deferment of publication is not available in India; a design is published in the *Official Journal* as soon as it is registered.

After publication, registered designs are open for public inspection on submitting a request on a prescribed form. However, if a design application has been abandoned or refused, related documents are neither open for public inspection nor published in the journal.

A registration is initially granted for 10 years from the filing date or priority date, whichever is earlier. Statutory rights may be extended for a further five years on payment of prescribed renewal fees before the expiry of the original 10-year registration period. Design registration ceases to be effective on non-payment of the renewal fee within the prescribed period.

However, the Designs Act provides an opportunity to the registered proprietor to restore a lapsed design if an application for restoration is made in the manner prescribed.

Unlike the Patents Act, which provides for pre-grant oppositions, there is no provision under the Designs Act for pre-registration oppositions. Any interested party wishing to oppose the registration of a design may file only a cancellation petition at any time post-registration. A cancellation petition may be filed on the grounds that the design:

- has been previously registered in India;
- has been published in India or in any other country before the date of registration;
- is not new or original;
- is not registrable as per the relevant statute; or
- does not satisfy the statutory definition of a 'design' under Section 2(d) of the Designs Act.

Enforcement

Registration of a design confers on the registered proprietor copyright in the design (ie, an exclusive right (in India) to apply the design to any article in the class in which the design is registered). Further, Section 22 of the Designs Act provides that applying a registered design, or any fraudulent or obvious imitation of a registered design, to an article without a licence or the registered proprietor's written consent is unlawful.

Design rights can be enforced by instituting a suit for infringement against an infringer for any of the following acts:

- A registered design or any fraudulent or obvious imitation thereof is applied to any article in any class in which the design is registered, for the purpose of sale;
- An article belonging to the class in which a design has been registered is imported for sale and the design or any fraudulent or obvious imitation thereof has been applied to the same; or
- An infringer publishes or exposes or causes to be published or offered for sale an article in any class in which a design is registered with the knowledge that a registered design or any fraudulent or obvious imitation thereof has been applied to the article.

All of these acts constitute piracy of a registered design.

Relief is available in the form of damages or an injunction. An infringer is liable to pay the registered proprietor of a design a sum of money as prescribed by the Designs Act. However, if the proprietor elects to file suit for recovery of damages and for an injunction to prevent recurrence of the infringing acts, the infringer is liable to pay such damages as may be awarded by a court and may be restrained by an injunction. The remedy to institute

the common law action of passing off is also available to a registered proprietor; however, this cannot be combined with an infringement suit. Further, every ground on which a design registration may be cancelled is available as a ground for defence in an infringement suit.

The Designs Act specifically provides for marking of goods to which a registered design is applied. A proprietor can mark such an article with the word 'registered' or with the abbreviation 'REGD' or 'RD', or with the design number appearing on the design certificate, except in the case of textile goods or articles which are soft or brittle in nature. There are no specific guidelines as to how the article is to be marked, but the marking should preferably be on the article itself. The marking may be stamped, engraved, impressed on or otherwise applied to an article. However, if it is not possible to mark an article, then the marking indication may be affixed to the packaging thereof.

The marking on an article is important from an enforcement perspective. An infringer in a suit for an injunction or recovery of damages can plead that it was unaware of the existence of copyright in the design and had no reasonable grounds to believe the same, unless the proprietor can establish that proper effective measures were taken to publicise the design registration or ensure that the infringer had knowledge of the design registration in the proprietor's name.

No timeframe is prescribed for enforcement of IP rights in India, and it may take between three and five years for the resolution of an enforcement action in the case of design rights.

Ownership changes and rights transfers

Transfer of rights is provided for under Section 30 and Rules 32 to 37 of the Designs Act. Any person is entitled to copyright in a registered design by way of assignment, mortgage, licence or otherwise. The document creating the right in favour of a person other than the registered proprietor must be in writing and embody all terms and conditions governing the rights and obligations of each party. Any contravention of these requirements renders an instrument invalid.

An application for registration of title must be made in the prescribed manner and submitted with an original or certified copy of

the transfer instrument. The application should be made within the stipulated period (ie, within six months of the date of execution of the instrument, extendable by a maximum period of a further six months).

Related rights

Registration of a design confers on the registered proprietor copyright in the design during the period of registration. 'Copyright' is defined in Section 2(c) of the Designs Act as an exclusive right to apply a design to any article in any class in which the design is registered.

Registration of designs and copyright cannot occur concurrently. In the case of a design which qualifies for registration under the Designs Act, but is not so registered, copyright will subsist under the Copyright Act 1957. However, copyright will cease to exist as soon as any article to which the design or pattern has been applied is reproduced more than 50 times by an industrial process by the rights holder or its licensee. [WTR](#)

Contributor profiles

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Ranjna Mehta-Dutt is a partner at Remfry & Sagar. She has practised in the field of IP rights for more than 18 years and has vast experience of drafting patent specifications and handling patent applications in diverse fields of technology, including chemistry, biotechnology and pharmaceuticals. Ms Mehta-Dutt is also an expert at prosecuting design applications and handling patent/design oppositions and litigations.



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Payal Kalra is a managing associate at Remfry & Sagar. She holds a master's degree in biotechnology and a bachelor's degree in law. As a registered patent agent, she has more than seven years' experience in the area of patents and designs, and is actively involved in the filing and prosecution of design applications.