



**Patents | Trade Marks | Copyrights |  
Industrial Designs | Geographical Indications |  
Internet and Domain Names | IP Protection against  
infringement and passing off | Anti-counterfeiting &  
anti-piracy | IP due diligence & Audit / IP litigations |  
Licensing | Franchising**

**306 & 405, Kapadia Chamber  
599, J. S. S. Road,  
Marine Lines  
Mumbai (Bombay) 400 002  
INDIA**

**Tel: +91 22 2201 3959/2201 3962  
Fax: +91 22 2201 8194/2806 1923  
Email: [info@adityaandassociates.com](mailto:info@adityaandassociates.com)/  
[adityaassociates@vsnl.net](mailto:adityaassociates@vsnl.net)  
Internet: [www.adityaandassociates.com](http://www.adityaandassociates.com)**

**MUMBAI | PUNE | CHENNAI | INDORE**

# Progression in design

Vipul N Bhuta and Sudha Jha of Aditya & Associates discuss trends in opposition and recent developments in design registration

The present Indian Designs Act 2000 was enacted repealing the Design Act 1911, to facilitate the changing demands of a developing nation. India's progression in design activity made it important to protect design to promote a healthy competitive market economy and also to bring the law in consonance with the TRIPs Agreement.

Design as per section 2(d) of the Designs Act 2000, means 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, separately or combined, which in the finished article appeals to and are judged solely by eye.

By registering a design, protection is only conferred on the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article. Such article can be any article of manufacture and any substance artificial or partly artificial and partly natural and includes any part of an article capable of being made and sold separately. The design does not stand on its own as an artistic work but is to be copied or applied or affixed in a commercially produced artifact/object by an industrial process conferring protection on the manufactured article itself without any conceptual separation between the artistic work and the product on which it is applied. Such design applied to an article can be in two dimensional or three dimensional or in both forms, by means of any industrial process, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by eye.

## Novelty and originality

To be registered as a design in India, the law makes it mandatory to possess both or either of the criteria of novelty and originality. To be novel a design need not be new. A new arrangement of old components or combination of colour, a new pattern or ornament or shape which may result in novelty of design and appealing to eye is regis-

trable. In cases where the design is not new, it can still be registered provided it is original. As laid down in *Bharat Glass Tube Limited v Gopal Glass Works Limited* [2008 (37) PTC 1 (SC)] the term original, in relation to a design, means originating from the author [or creator] of such design and includes those cases which though old in themselves yet are new in their application.

The Design Office while processing the design application for registration compares it to all previous designs applied to all articles in the same class. The outer appearance of the design on an article is the only criteria to decide whether particular design is prior in existence. It is imperative that a design can be categorised as new and/or original in substantial manner. Just any trade variant or mere arrangement or re-arrangement in a design does not make it new or original. However, the fact that two things are similar does not necessarily mean that there cannot be any point of difference at all. It is to be noted that a small difference is sufficient to avoid alleged infringement if there existed such small difference between the registered design and the prior registered design. The object of the Designs Act is to protect new or original designs created to be applied or affixed to particular articles as manufactured by industrial process or means. The purpose is to see that the artisan, creator, originator of a design with a particular aesthetic look is not deprived of his *bonafide* reward by others applying it to their goods.

The word, original, contemplates that the person had originated something by his exercise of intellectual activity which had not occurred to anyone before. The terms new or original involve the idea of novelty either in the pattern, shape, configuration or ornament itself or in the way in which an old pattern, shape, configuration or ornament is to be applied to an article. There must be the exercise of intellectual activity to suggest for the first time, something which had not occurred to anyone before as to applying pattern, shape, configuration or ornament to an article to which it had not been applied before. It is important as laid down in *Bharat*

*Glass Tube Limited v Gopal Glass Works* by the Supreme Court that a design in abstract cannot be registered. A design has to be registered in relation to some article. It is also important that an addition or minute alteration in design to a well recognised shape of an article of common use in the market cannot make it an article new or original in design.

### Publication

Publication of a design prior to application for registration renders the design unregistrable and consequently un-protectable. To avail protection by registering a design it is mandatory that the design should not have been disclosed to the public anywhere in India or in any other country by publication in any tangible form or by use in any other way prior to the date of filing the application. Exception can be made by disclosing the same in an exhibition with prior intimation to the controller of design and necessary application is made within six months from the date of first exhibiting or publishing the design.

There is no territorial limit to the scope of prior publication. Prior publication in India or elsewhere will have the same effect of invalidating a design. As held in *Reckitt Benckiser (India) Ltd v Wyeth Limited* 2009

(41) PTC 24(Del.) while a previous registration in India would be a ground for cancellation without looking into the aspect of disclosure to the public or publication in general, a design registered in any other country prior to the date of registration in India would also be required to have been disclosed to the public by publication in tangible form or by use or in any other way for it to qualify as a ground for cancellation of the subsequent registration in India.

As laid down in *Venus Industries v Magppie Exports* [2003 (26) PTC 312 (PO)] while there is no specific definition of publication in the Designs Act 2000 nor in the old Designs Act 1911, any design which has been made available to any person in India who is free to use or disclose it is treated as published. Also *Faber Castell Aktiengesellschaft v Pikpen (P.) Ltd* [2003 (27) PTC 538 (Bom) Notice of Motion No. 240 of 2003 in Suit No. 285 of 2003] details that, the word published used in sections 43 and 51A of the Act has not been defined in the Act. Publication within the meaning of the Act means the opposite of being kept secret. It is published if a design is no longer a secret. There is publication if the design has been disclosed to the public or the public has been put in possession of the design. Russell-Clarke in *Copyright in Industrial Designs*, Fourth Edn. (pages 41-42) says:

“.....It is sufficient, and there will be publication if the knowledge was either :

- (1) Available to members of the public; or
- (2) Actually in fact shown and disclosed to some individual member of the public who was under no obligation to keep it secret.

It is not necessary that the design should have been actually used. There will be just as much be publication if it is shown that it was known to the public without ever having been actually put into use. Thus, publication may be of two types:

- (a) Publication in prior documents.
- (b) Publication by prior user.”

It was observed that publication even to a single person is sufficient.

In *Gunston v Winox Ltd.*[38 RPC 40] it was held that showing of a design to a prospective customer to obtain an order constitutes publication thereof. In *A. Pressler & Co. Ltd v Gartside & Co. (of Manchester) Ltd and Widd & Owen Ltd* [50 RPC 240], the availability of the design in a private library was held to constitute its publication. In *W. Steel & Co. Ltd* [1958 R.P.C. 411], the publication of the design in a magazine was sufficient to constitute its publication.

According to *Gopal Glass Works Ltd v Assistant Controller of Patents & Designs* [2006 (33) PTC 434(Cal)] under the law presently in force in India, specifications, drawings and/or demonstrations in connection with registration of a design do not *per se* con-

## Vipul N Bhuta



Vipul N Bhuta, High Court advocate and patent attorney, is a commerce and law graduate from the University of Mumbai (Bombay) and fellow member of the Institute of Company Secretaries of India. He is a registered patent attorney with the Government of India and registered trade mark agent in Canada.

For over a decade, Vipul acquired corporate experience in matters relating to IP and other commercial legal matters related to IP, due diligence, commercial contracts, JVs, mergers, acquisitions and spin offs before venturing into independent practice in IP. Today, he has considerable experience in dealing with all IP issues both domestically and internationally in about 90 countries around the world. He is also a regular faculty lecturer at various seminars and has presented papers on IPRs in India, Singapore, Hong Kong and the US.

He is the co-founder of firm Aditya & Associates (formerly known as Ess Vee IP Bureau) which is one of the leading law firms in India specialising in intellectual property practice.

He is a member of INTA, AIPPI, IBA, AIPLA, APAA and ECTA.

stitute publications which prohibit future registration of that design. Had publication of design specifications by a registering authority, particularly a registering authority in a foreign country, in connection with registration of a design, in itself, amounted to prior publication, it would have hit all future applications in India for registration of designs. It is significant that parliament consciously made publication in a country other than India a ground of cancellation, in addition to publication in India, but expressly restricted the embargo of prior registration to registration in India. Thus registration in a country other than India has not been made a ground for the cancellation of a registered design.

To constitute prior disclosure by publication to destroy the novelty of a design, the publication should have to be, in tangible form applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article with the same visual effect would be sufficient. In the case of *Joginder Singh v Tebu Enterprises Ltd* [AIR 1989, Del 16] the court held that if the goods imported from abroad are used by the importer without its disclosure to anyone else and goods of such design are not freely available in India, 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.

Another important criteria for registration of design is that the features of the design in the finished article should appeal to the eye and be judged solely by the eye. This implies that the design must appear and be visible on the finished article, for which it is meant. Law accords protection only to designs that are aesthetic in nature. A design can also be a decorative element added to an article. If the shape is not there to appeal to the eye, but solely to make the article work, then it is excluded from the statutory protection. Eye appeal is the most important requirement of a design, however as decided in *Amp. Inc v Utilux Proprietary Ltd* (1972) RPC 103 (HL) and *Kestos v Kemp Ltd & Kemp* (1936) 53 RPC 139, "If a designer who only thought of practical efficiency, actually produces a design which does appeal to the eye, he would not be denied the protection as that was not his object when he composed the design."

It is important to compare the pattern and/or configuration and consider the visual appeal thereof and also the visual appeal of the pattern and/or configuration on the article, for example the visual appeal of the finished product. The main criteria of comparing design are a visual comparison of physical dimension of two products. Thus, it is important to display the design from all

angles and the test of ascertaining whether the two designs are identical is that the designs have to be judged by the eye and each design has to be compared as a whole with all its novel features, important and unimportant.

### Application of designs

To be registered, a design must be applied to an article by an industrial process but that does not mean that the article must be machine-made, because hand-made articles may also be registrable. The nature of article on which the design is applied should be suitable so as to be produced in quantity.

An article which is a part of another article and can be manufactured and sold separately is entitled to separate protection, as laid down in *Marico Limited v Raj Oil Mills Limited* [2008 (37) PTC 109(Bom.) (DB)]. This kind of article, which is separate from the other parts of the goods and registered separately as a design, if intended and or desired by the proprietor of the registered article, as capable of being made and sold, is saleable in the market separately. Therefore, it is registrable under the Act. The phrase, as inserted, in the Designs Act 2000, now even covers "any part of an article capable of being made and sold separately". Thus, once a part of an article falls within the ambit of the definition of an article and is capable of being made and sold separately, then whether such article or part of an article has any commercial identity in the market of its own is immaterial. It is an exclusive privilege and or a right of the registered owner of the design to sell it separately or not.

### Rights and term

The registration of a design confers upon the proprietor copyright in the design for the period of registration, thereby conferring exclusive right to apply a design to the article belonging to the class in which it is registered. The duration of protection is initially ten years from the actual date of filing of the application. If before the expiration of initial term of ten years, an application for extension of period of copyright is made to the controller, the period of copyright would be extended for a second period of five years. In cases where claim to priority has been allowed the duration is ten years from the priority date ie date of making an application in the reciprocal country.

A design which comprises or contains scandalous or obscene matter, is not registrable.

### Registration procedure

Registration of a design is procedurally different from the registration granted under the Patents Act 1970 and/or the Trade Marks Act 1999. Under both the Patents Act and the Trade Marks Act, prior to registra-

tion there is a substantive examination, publication before registration and provision for opposition by any third party before registration. These are all absent in the case of a registration of a design.

India follows the Locarno Classification for registration of design comprising 32 classes, numbered 1 to 31 and an additional class 99 to include articles not falling under the aforesaid 31 classes. These classes are further divided into sub classes.

An inventor or any other person or company assigned by the inventor, can make application with the designated office to register a design in a particular class depending on what material the article is made of.

An application to register a design is made using Form-1 accompanied by four copies of representation of the design and the prescribed fee. Application can be filed at one of the four offices of the Patent Office located at Kolkata, Mumbai, Delhi and Chennai. On filing the design application, the Designs Office initially provides a filing number and filing date and issues a filing receipt. Thereafter the application is formally examined by the Designs Office and if defects are found in the application then the same is communicated to the applicant. Once the application is found to be in order it is accepted and the Designs Office issues the registration certificate. Registered designs are open for public inspection only after publication in the official gazette on payment of prescribed fee on a request made in prescribed form.

### Marking

Once the design is registered, it is necessary that the registered proprietor mark the article, indicating the number of registered design (except for textile designs). The registered proprietor of a design will not be able to claim damages from any infringer until and unless it is established that proper steps were taken at marking the article, or else the registered proprietor has to establish that the infringer knew or had received notice of existence of copyright in the design.

Design rights are territorial rights and are granted on a country-by-country basis. An Indian registration provides protection only in India and its territories. If the proprietor of a design wishes to protect a design in other countries, the owner must seek protection in each country separately under the relevant laws.

There is no system as yet wherein a single design application is sufficient to protect the design right internationally. However, India is one of the countries party to the Paris convention and it provides certain privileges to member countries in design registration. A party who files design application in a member state of the convention, such as India, can within six months of that filing date, file applications in other member countries claiming the priority of the first application. If such a

design is accepted for registration it will be deemed to have been registered from the same date on which the application is made in the home country.

As the rights conferred under the Designs Act is known as copyright, there is some overlapping between the design under the Designs Act and the Copyright Act. However, the rights thereunder are aptly detailed in *Microfibres Inc. v Girdhar & Co. & Anr* 2009 (40) PTC 519(Del.) (DB) which emphasises that under the Designs Act, a copyright has a different connotation from a copyright under the Copyright Act. If the design is registered under the Designs Act, the design would lose its copyright protection under the Copyright Act.

It is pertinent to note that s.15 of the Designs Act clearly states that if a design is registrable under the Designs Act but has not so been registered, the design would continue to enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process of more than 50 times is not reached; once that limit is crossed it would lose its copyright protection under the Copyright Act. However while there is an overlapping area under which the protection of design is covered under Design Act and Copyright Act, protection cannot be claimed for a design under both the Acts.

In *Devendra Somabhai Naik v Accurate Transheat Pvt. Ltd* [2005 (31) PTC 172 (Guj.) (DB)] when the law says that the copyright shall cease as soon as an article to which the design has been applied has been reproduced more than fifty times, then the logical and intelligible interpretation would be that any article has been produced for more than fifty times applying the said design. Application of the design for manufacturing or creating an article would not mean that the design has been reprinted and has been posted on the body of the machine. The word, application, in the present context would mean that the knowledge has been derived from the said design and that knowledge has been applied for manufacturing a particular machine.

### Piracy

If the design is not registered under the Designs Act 2000, the proprietor will have no legal right to take any action against the infringer. The protection to the registered proprietor under the Designs Act is by way of civil remedy as per provisions of section 22 of the Act. It is the sole responsibility of the proprietor to see that his design is not being infringed upon by others. It is the proprietor's duty to file a suit of infringement against the infringer. The reliefs which may be usually awarded in such a suit are – injunctions (interim or final) and damages. Under the Designs Act 2000 no criminal action is available against the infringer.

Since there is no provision towards pre-registration

opposition against a design application, if a person intends to oppose the registration, then the provision as per law is to apply for cancellation of the registered design under section 19 of the Designs Act 2000. Any person interested by way of petition may request the controller of design to cancel the registration on the ground that the design has been previously registered in India or published in India or any country prior to the date of registration, or it is not new or original or it is not registrable as per the Act or it does not fall within the scope of statutory definition of design.

Pertinently, every ground on which registration of design may be cancelled under section 19 of the Act aforementioned, shall be available as a ground of defence in any suit or a proceeding where a relief is sought under sub-clause (2) of section 22 of the Act of 2000 for recovery of damages/injunction; once such a ground is taken in defence, then under section 22(4) of the Act of 2000, the suit or any such proceeding is to be transferred to the High Court for decision.

It would not be lawful for any person to apply or cause to be applied to any article or any class of article in which the design is registered, the design of any fraudulent or obvious imitation thereof for the purpose of sale without the licence or written consent of registered proprietor of the said design. The law also prohibits doing anything with a view to enable the design to be so applied. In other words if a person places orders to the manufacturer or an importer of goods for which the design is an obvious imitation or similar to a design registered in the name of another person for the purpose of sale of the said goods under its own brand, it would clearly be contravening the law. It would also be unlawful for such a person to publish or expose for sale of the pirated version of that registered design.

Once a legal proceeding is initiated by the registered proprietor claiming ad-interim injunction, then the following criteria are applied to the grant of ad interim injunction: i) whether the registered proprietor has made out a *prima facie* case that there is a *bonafide* contention between the parties or a serious question to be tried, (ii) whether the balance of convenience is in favour of the registered proprietor, that is to say whether it would cause greater inconvenience to the registered proprietor if the ad interim injunction is not granted than the inconvenience to which the other side will be subjected if it is granted, and, (iii) whether the registered proprietor would suffer irreparable loss and injury if the prayer for grant of temporary injunction is refused. All these three considerations must be satisfied before the order of ad interim injunction is granted by the court.

It was held in *Dart Industries Inc. & Anr v Techno Plast & Others* [2007 (35) PTC 129(Del.)] that taking a holistic view of the matter, an interlocutory injunction

is not the remedy when the case is primarily founded on the basis of rights under the Design Act and that right, *prima facie*, is not established. In *Niky Tasha India Pvt. Ltd v. Faridabad Gas Gadgets Pvt. Ltd.*, (1984) PTC (Del HC-DB), the court refused the injunction at interlocutory stage while observing: "I take it to be well settled that an interlocutory injunction will not normally be granted where damages will provide an adequate remedy should the claim succeed. Furthermore, I have always understood the rule to be that the court will not grant an interlocutory injunction unless satisfied that there is a real probability of the plaintiff succeeding on the trial of the suit; where the design is of a recent date, as in this case, no injunction should be granted. More so, when there is a serious question as to the validity of the design to be tried in the suit and an application for cancellation has been made. Where a person is entered as a proprietor of a registered design that is under the Act no conclusive proof that the plaintiff is the proprietor of the design, but it is the only evidence that he is the proprietor. The plaintiff has this advantage that if no evidence at all is given then the certificate is sufficient evidence that he is the proprietor."

Design is a very important and effective intellectual property right especially in a world where the shape and configuration of products and product packs is ever changing to attract and appeal to the masses. Compared to patents and other forms of intellectual property, design is a very effective way of protecting an intellectual activity and can be done in a relatively short period of time and with minimal cost. Moreover, exclusive protection is conferred to the new and/or original designs applied to any products for a period of 15 years, while the definition of design and article are broad enough to confer wide protection under the Designs Act.

## Sudha Jha



Sudha Jha, High Court advocate and patent attorney, holds a masters degree in biotechnology and also a degree in law. She is a registered patent attorney with the Government of India.

Sudha has over five years experience in handling patent and design matters such as patentability search, drafting of specifications/descriptions for various types of inventions and prosecution thereof. She has been highly successful in the prosecution of mechanical and plant related patents.