

INTRODUCTION TO DESIGN

A design refers to the features of shape, configuration, pattern, ornamentation or composition of lines or colours applied to any article, in two or three dimensional (or both) forms. This may be applied by any industrial process or means (manual, mechanical or chemical) separately or by a combined process, which in the finished article appeals to and judged solely by the eye. Design does not include any mode or principle of construction or anything which is mere mechanical device. It also does not include any trademark or any artistic work.

INDUSTRIAL DESIGNS

We see so many varieties and brands of the same product (e.g. car, television, personal computer, a piece of furniture etc.) in the market, which look quite different from each other. If the products have similar functional features or have comparable price tags, the eye appeal or visual design of a product determines the choice. Even if the similarities are not close, a person may decide to go for a more expensive item because that item has a better look or colour scheme. What is being said is that the external design or colour scheme or ornamentation of a product plays a key role in determining the market acceptability of the product over other similar products. If you have a good design that gives you an advantage, then you must have a system to protect its features otherwise there would be wide scale imitation.

Design as per the Indian Act means 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 it does not include any mode or principle of construction or anything which is in substance a mere mechanical device. In this context an article means 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. Stamps, labels, tokens, cards, etc cannot be considered an article for the purpose of registration of design because once the alleged design i.e., ornamentation is removed only a piece of paper, metal or like material remains and the article referred to ceases to exist. An article must have its existence independent of the designs applied to it. So, the design as applied to an article should be integral with the article itself.

Industrial Design is one of the categories of IPR where the design system focuses on the aesthetic feature of an article derived from its visual appearance. Relevant aspects are the shape, configuration, surface pattern, the colour or line or a combination thereof as applied to an article, which produces an aesthetic impression on the sense of sight. Those who wish to purchase an article for use are often influenced not only by their practical efficiency but also by appearance. Purchasers are attracted by a design that is uncommon in look and solely appealing to their eyes i.e. Design is solely judged by eyes. Registration of Design is nothing but the protection of the new or original design for a limited period.

Industrial designs are compositions of lines or colours or any three-dimensional forms, which give a special appearance to a product or handicraft. They protect the ornamental or aesthetic aspect of a useful article, which usually appeals to the sense of sight or touch and can be reproduced in significant quantities.

Industrial designs are applied to a wide variety of products of industry and handicraft; from technical and medical instruments to watches, jewelry, and other luxury items; from housewares 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 appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied.

Concept of Industrial Designs

The terms design, industrial design or design patent, when used in intellectual property law and practice, have a specific connotation. In most cases, they refer to the eye appeal of — that is, the features of shape, configuration, pattern or ornament, or any combination of these features — of a finished article made by hand, tool or machine, as opposed to functional features which may be protected by other types of intellectual property rights, such as patents, utility models or trade secrets. In many countries, the requirement of eye appeal of an article of manufacture or handicraft has been modified to that of perceptible features of appearance, and the rule of novelty has been replaced or supplemented by an individual character requirement.

A good design strategy must compare the various alternatives for protecting industrial designs, as there are different legal ways to prevent unscrupulous competitors from unauthorized copying. Legal options may include one or more of the following: protection under industrial design law, copyright law, trademark law — as a two or three-dimensional mark — and unfair competition law. In some countries, the protection of these different laws may be mutually exclusive, in others it is cumulative to varying degree.

Industrial design issues affect various types of business decisions of an enterprise. For example, the type of protection and its cost or effectiveness may affect which details should be disclosed to the designer, especially when the designer is employed by a contractor, whether to undertake design development entirely in-house, or to contract or commission an outside agency or do it jointly; timing of the initial use of a new design in advertising, marketing or public display in an exhibition; if and when to seek or continue to maintain design registration; if and when to initiate action against unauthorized/infringing acts of competitors, counterfeiters or importers; if and when to license or partially assign a design; and if and when to register the design in other markets for export or for exploring the potential of entering into strategic business alliances, joint ventures, setting up wholly owned subsidiaries, etc.

It is therefore hardly surprising that smart enterprises take great pains to timely protect the new or original aesthetic aspect of its products so as to prevent such designs from being

copied by competitors; otherwise the competitive edge may be easily lost even though functionally the product of an enterprise may be superior to those of its competitors.

Industrial Designs Wing in India

The registration of industrial designs under the Designs Act, 2000 (which has repealed and replaced the Designs Act, 1911) is done by the Designs Wing of the Head Office of Patents located at Kolkata. The Act modernizes the earlier legislation to provide for a wider ambit of coverage and incorporates several user-friendly features in order to harmonize the legislation with similar acts in other countries.

Design as per the Indian Act means 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 it does not include any mode or principle of construction or anything which is in substance a mere mechanical device. In this context, an article means 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. Stamps, labels, tokens, cards, etc cannot be considered an article for the purpose of registration of design because once the alleged design i.e., ornamentation is removed only a piece of paper, metal or like material remains and the article referred to ceases to exist. An article must have its existence independent of the designs applied to it. So, the design as applied to an article should be integral with the article itself.

It is interesting to note that the protection under the Design Act is provided in the form of "copyright in design". Copyright means an exclusive right to apply a design to any article in any class in which design is registered. If a design is registered under Design Act, it is not eligible for protection under Copyright Act.

DESIGNS ACT, 2000

'Design' means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two-dimensional or three-dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle or construction or anything that is in substance a mere mechanical device, and does not include any trade mark, as defined in clause (v) of sub-section of Section 2 of the Trade and Merchandise Marks Act, 1958, property mark or artistic works as defined under Section 2(c) of the Copyright Act, 1957.

Under the Designs Act, 2000 the "article" means 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.

NEED FOR PROTECTION OF A DESIGN

- 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 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 attractive products.
- Protecting industrial designs helps economic development, by encouraging creativity in the industrial and manufacturing sectors, as well as in traditional arts and crafts. They contribute to the expansion of commercial activities and the export of national products.
- It increases interest in innovating more designs in the field of consumer products.
- Industrial designs are business assets that can increase the commercial value of a company and its product. The more successful a design, the higher its value to the company.
- A protected design may also be licensed (or sold) to others for a fee.

ESSENTIAL REQUIREMENTS FOR THE REGISTRATION OF DESIGN

- The design should be new or original, not previously published or used in any country before the date of application for registration. The novelty may reside in the application of a known shape or pattern to a new subject-matter. However, if the design for which the application is made does not involve any real mental activity for conception, then registration may not be considered.
- The design should relate to features of shape, configuration, pattern or ornamentation applied or applicable to an article. Thus, designs of industrial plans, layouts and installations are not registrable under the Act.
- The design should be applied or applicable to any article by any industrial process. Normally, designs of artistic nature such as painting, sculptures and the like which are not produced in bulk by any industrial process are excluded from registration under the Act.
- The features of the designs in the finished article should appeal to and are judged solely by the eye. This implies that the design must appear and should be visible on the finished article, for which it is meant. Thus, any design in the inside arrangement of a box, money purse or almirah may not be considered for showing such articles in the open state, as those articles are generally put in the market in the closed state.

- Any mode or principle of construction or operation or anything, which is in substance a mere mechanical device, would not be a registrable design. For instance, a key having its novelty only in the shape of its corrugation or bend at the portion intended to engage with levers inside the lock it is associated with, cannot be registered as a design under the Act. However, when any design suggests any mode or principle of construction or mechanical or other action of a mechanism, a suitable disclaimer in respect thereof is required to be inserted on its representation, provided there are other registrable features in the design.
- The design should not include any trademark or property mark or artistic works.
- It should be significantly distinguishable from known designs or combination of known designs.
- It should not comprise or contain scandalous or obscene matter.

EXCLUSION FROM SCOPE OF DESIGN

Designs that are primarily literary or artistic in character are not protected under the Designs Act. These will include:

- Book jackets, calendars, certificates, forms and other documents, dressmaking patterns, greeting cards, leaflets, maps and plans cards, post cards, stamps, transfers, medals
- Labels, tokens, cards, cartoons
- Any principle or mode of construction of an article
- Mere mechanical contrivance
- Buildings and structures
- Parts of articles not manufactured and sold separately
- Variations commonly used in the trade
- Mere workshop alterations of components of an assembly
- Mere change in size of article
- Flags, emblems or signs of any country
- Layout designs of integrated circuits

OBJECTIVE OF REGISTRATION OF DESIGNS

The objective of the Designs Act is to protect new or original designs so created to be applied or applicable to a particular article to be manufactured by industrial process or means. Sometimes, purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. The important purpose of design registration is to see that the artisan, creator, originator of a design having aesthetic look is not deprived of his bona fide reward by others applying it to their goods.

REGISTER OF DESIGNS

The Register of Designs is a document maintained by the Patent Office, Kolkata as a statutory requirement. It contains the design number, class number, date of filing (in this country) and reciprocity date (if any), name and address of proprietor and such other matters as would affect the validity of proprietorship of the design and it is open for public inspection on payment of prescribed fee. An extract from register may also be obtained on request with the prescribed fee.

Inspection of the Register of Designs

Any person can inspect the Register of Designs upon request to the Controller with prescribed fee. This will enable an applicant to find out whether a design has been previously registered or not.

REGISTRATION OF DESIGN

The registration of a design confers upon the registered proprietor 'Copyright' in the design for the period of registration. 'Copyright' means the exclusive right to apply a design to the article belonging to the class in which it is registered.

The duration of the registration of a design is initially ten years from the date of registration, but in cases where claim to priority has been allowed the duration is ten years from the priority date.

This initial period of registration may be extended by further period of 5 years on an application made in Form-3 accompanied by a fee of Rs. 2,000/- to the Controller before the expiry of the said initial period of Copyright.

The proprietor of a design may make application for such extension even as soon as the design is registered.

PROCEDURE FOR REGISTRATION OF DESIGNS

An application accompanied by the prescribed fee and four copies of the representation of the design, on receipt at the office, are numbered and dated in the Designs office and taken up for examination.

The number accorded to an application is in the order of its receipt and the date accorded to an application is the actual date of its receipt in the office.

Note: Applications unaccompanied by the prescribed fee or copies of the representation of the design will not be numbered and dated until the receipt of the fee or copies of the representation of the designs. The date allocated for such applications is the actual date of the receipt of all the documents in the office, and not the earlier date on which the application was first received in the office.

Defects in the application, if any noticed on examination of the application are communicated to the applicant or to his agent at the address for service. The defects should be corrected and the application resubmitted to the Design office for acceptance within six months from the official date of the application.

Acceptance & Notification: An application is accepted when all the shortcomings have been rectified. It is then notified in the Official Gazette for objections, if any, from interested persons.

Refusal: In case the defects as required by the Controller are not rectified, a personal hearing will be provided to the applicant. At such a hearing the Controller will decide whether the application should be accepted or not.

The decision of the Controller will be communicated in writing to the applicant or his agent stating the reasons for the decision.

Appeals: Any person aggrieved by the decision of the Controller refusing to register a design may appeal to the High Court. The appeal should be made within three months from the date of the Controller's decision.

Abandonment: An application, which owing to any neglect or default on the part of the applicant has not been completed so as to enable registration to be effected within six months will be treated as abandoned. Such an application cannot be revived and no further action will be taken on it by the Design office.

Fees: The fees for the registration and renewal of a design are:

- Application for registration of design Rs. 1,000/-
- Extension of copy right Rs. 2,000/-

STANDARD FORM OF THE STATEMENT OF NOVELTY

The following statement of novelty should be mentioned on the representation of a design as per the Act:

"The novelty resides in the shape and configuration of the article as illustrated."

"The novelty resides in the portion marked as 'A' and 'B' of the article as illustrated."

"The novelty resides in the ornamentation or surface pattern of the article as illustrated."

Example: The novelty resides in the floral ornamentation of the carpet as illustrated.

FORM OF DISCLAIMERS

If the ornamental pattern on an article is likely to be confused with a trade mark, a disclaimer may be made in the following manner:

No claim is made by virtue of this registration to any right to the use as a trade mark of what is shown in the representations.

If the representation suggests any mechanical action of the article, a disclaimer may be inserted in the following manner:-

No claim is made by virtue of this registration in respect of any mechanical or other action of the mechanism whatever or in respect of any mode or principle of construction of the article.

If the representation contains words, letters, numerals, etc., a disclaimer may be inserted in the following manner:-

No claim is made by virtue of this registration to any right to the exclusive use of the words, letters, numerals, flags, crowns, etc. appearing in the design.

BENEFITS OF DESIGN REGISTRATION

The registration of a design confers upon the registered proprietor the exclusive right to apply a design to the article in the class in which the design has been registered.

A registered proprietor of the design is entitled to a better protection of his intellectual property. He can sue for infringement, if his right is infringed by any person. He can license or sell his design as legal property for a consideration or royalty. Registration initially confers this right for ten years from the date of registration. It is renewable for a further period of five years. If the fee for extension is not paid for the further period of registration within the period of initial registration, this right will cease. There is provision for the restoration of a lapsed design if the application for restoration is filed within one year from the date of cessation in the prescribed manner.

CANCELLATION OF REGISTRATION OF A DESIGN

The registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in Form 8 with a fee of Rs. 1,500/- to the Controller of Designs on the following grounds:

1. That the design has been previously registered in India or
2. That it has been published in India or elsewhere prior to date of registration or
3. The design is not new or original or
4. Design is not registrable or
5. It is not a design under Clause (d) of Section 2.

PIRACY OF A DESIGN

Piracy of a design means the application of a design or its imitation to any article belonging to class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor. Publishing such articles or exposing terms for sale with knowledge of the unauthorized application of the design to them also involves piracy of the design.

PENALTY FOR THE PIRACY OF A REGISTERED DESIGN

If anyone contravenes the copyright in a design he is liable for every offence to pay a sum not exceeding Rs. 25,000/- to the registered proprietor subject to a maximum of Rs. 50,000/- recoverable as contract debt in respect of any one design. The registered proprietor may bring a suit for the recovery of the damages for any such contravention and for injunction against repetition of the same. Total sum recoverable shall not exceed Rs. 50,000/- as contract debt as stated in Section 22(2)(a). The suit for infringement, recovery of damage etc should not be filed in any court below the court of a District Judge.

CANNOT BE PROTECTED BY INDUSTRIAL DESIGN RIGHTS

- Designs that do not meet the requirements of novelty, originality and/or individual character.
- Designs that are considered to be dictated exclusively by the technical function of a product; such technical or functional design features may be protected, depending on the facts of each case, by other IP rights.
- Designs incorporating protected official symbols or emblems (such as national flag).
- Designs, which are considered to be contrary to public order or morality.

DURATION OF THE REGISTRATION OF A DESIGN

The total term 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 by paying a fee of Rs. 2000/- to the Controller before the expiry of initial 10 years period. The proprietor of design may make the application for such extension even as soon as the design is registered.

APPLICATION PROCEDURE

Any person who desires to register a design is required to submit the following documents to the Design Office at Nizam Palace, 2nd M.S.O. Building, The Patent Office, 234/4, A.J.C. Bose Road, Kolkata - 700 020 or any of the branch offices of the Patent Office at Delhi, Mumbai and Chennai. The applications received by the branch offices shall be transmitted to the head office for processing and prosecuting.

1. Application duly filed in on the prescribed form (Form-1) along with the prescribed fees, stating name in full, address, nationality, name of the article, class number, address for service in India. The application shall also be signed either by the applicant or by his authorized agent.
2. Representation (in quadruplicate of size 33 cm × 20.5 cm with a suitable margin) of the article. Drawings/sketches should clearly show the features of the design from different views and state the view (e.g. front or side).
3. A statement of novelty and disclaimer (if any) in respect of mechanical action, trademark, word, letter, numerals should be endorsed on each representation sheet which should be duly signed and dated.

4. Power of attorney (if necessary).
5. Priority documents (if any) in case of convention application claimed under Section 44 of the Designs Act, 2000.

GUIDELINES FOR THE PREPARATION OF REPRESENTATION SHEET

A representation sheet of an article is an important document required to be filed in quadruplicate along with the application for registration. Representation means the exact representation of the article on which the design has been applied. It should be prepared on white A4 size paper of durable quality but should not be prepared on card board or should not be mounted on other paper.

The following points should be considered while preparing a representation:

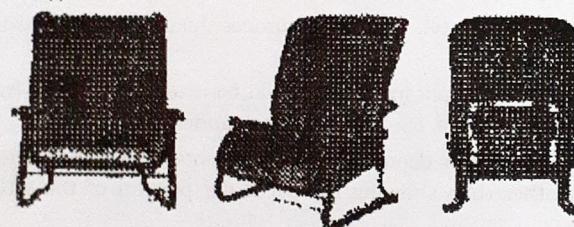
- The article must be shown in isolation and features of the design must be clearly and accurately visible.
- The article shown in the drawing should be consistent with the name of the article mentioned in the application form. The name of the article should be such that is known in the trade.
- The margin of the representation sheet should be one and half on all sides.
- The figure shown should be of sufficient scale in order to visualize all the details of the features of the design applied to the article.
- The figure should be shown in upright position with respect to top and bottom position of the sheet.
- The name of the applicant should be mentioned in left hand top corner of the sheet.
- The total number of sheets and sheet number should be mentioned in the right hand top corner of the sheet.
- The signature of the applicant/agent should be made in the right hand bottom corner mentioning the name of the signatory thereunder.
- No descriptive matter or denoting the components by reference letter/numerals should be included other than showing the particular portion of the article where novelty resides.
- A sufficient number of views should be incorporated in the representation sheet in order to show the article completely and to visualize the exact nature of the design clearly.
- No sectional view should be incorporated in the representation sheet.
- No dimensions or engineering symbol etc. should be mentioned in the representation sheet. The representation is not to be regarded as engineering drawing of the article.
- Unnecessary matter not being the feature of the design such as trade marks, letters, and numerals etc should not be included. However, if it is integral with the article so represented a disclaimer to that effect should be provided.
- Photographs should be covered with cellophane paper in order to prevent it from sticking to other pages.

- Drawings should be clear and should be prepared in a manner that clear reproduction of the views is possible on imaging and are reproducible by photocopying.
- A clear photocopy of the original representation sheet may be filed for other copies of the representation sheet, except when a photograph of the original representation has been filed.
- No extraneous matter or background support surface, shadows, brick walls, trees etc. should appear in the representation sheet.
- Hidden parts that are not visible in the finished article should not be shown. Exploded view should be avoided.
- In order represent a set, to whole set should be shown clearly with different views as required.
- Perspective views are most preferable. Odd angle views which distort the shape should not be filed.
- A brief statement of novelty, claim of features of design, which is new and original, are required to be mentioned on each set of representation sheet. No description stating the features of the design should be incorporated.
- If there is any other matter appearing in the representation not being the feature(s) of the design, a statement of disclaimer is required to be mentioned in each set of the representation sheet as required.
- Shading/etching lines may be used only if these are absolutely essential to the sense of the shape of the article and should be normally and should be normally avoided.

FIGURE 5.1**Specimen of Representation Sheets**

Name of the Applicant XYZ PVT. Ltd. CO.

No. of Sheets-2 Sheet NO. 1



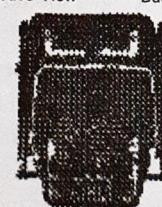
Front View

Front Perspective View

Back View



Top View



Bottom View

The novelty resides in the shape and configuration of the 'CHAIR' as illustrated above.