

ROLE OF COPYRIGHT & PIRACY OF REGISTERED DESIGN UNDER INTELLECTUAL PROPERTY RIGHTS

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INTRODUCTION

Design of an article is an intellectual property of a person who creates it as a person may not have invented an article but may have thought of a good design for it. A design of an article has a commercial value in the world of business and trade. Besides the practical utility and efficiency, a buyer is also influenced by the design of an article. Design of an article is judged solely by the eyes. An eye catching design may enhance the sale of an article. The person who creates a design has exclusive right over his design which is his intellectual property. No one can apply his design to any article without his consent, as any unauthorized application of his design to any article amounts to piracy of his design. The protection of design is important as it encourages the creativity in the industrial and manufacturing sectors and helps in the economic development of a nation. The manufacturers, therefore, pay adequate attention to the designs of the articles they produce. Legal protection, therefore, becomes necessary for the creation of new designs and their application to articles, as it ensures a fair return on investment. An effective system of protection promotes fair competition and honest trade practices, encourages creativity and promotes more aesthetically attractive products.¹ 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 any article in any class in which the design is registered. Piracy of registered design means unauthorized application of designs to the articles with respect to which the design is registered during the existence of their copyright. According to Section 22 of the Designs Act, 2000, during the existence of copyright of registered design, no one can fraudulently imitate or apply the registered design without the written consent of the registered proprietor of that design. Section 22 also provides remedies in case of piracy of registered design to the registered proprietor.²

COPYRIGHT IN REGISTERED DESIGNS

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¹ V.K. Ahuja, Law relating to Intellectual Property Rights. 2nd Edition (Haryana: Lexis Nexis 2013) at p. 217

² Meenu Paul, Intellectual Property Law. 4th Edition (Haryana: Allahabad Law Agency 2012) at pp. 525 & 530

According to Section 2(c) of the Designs Act, 2000 Copyright means the exclusive right to apply a design to any article in any class in which the design is registered. This means that if a design is registered in respect of several articles in one class, the proprietor of such design shall have the exclusive right to apply the design to all of them. The term “copyright” as defined under the Designs Act, 2000 is to be contrasted with “copyright” which is conferred on the author of an original literary, dramatic, musical or artistic work under the Copyright Act, 1957. The copyright in the aforesaid works protects the works from being copied or reproduced, whereas the registration of design confers on the registered proprietor not mere an exclusive right to copy or reproduce the design, but a monopoly to produce articles of the class in which the design is registered with that design applied.³

DURATION OF COPYRIGHT IN DESIGN

According to Section 11 of the Designs Act, 2000 when a design is registered, the registered proprietor of the design shall have copyright in the design during ten years from the date of registration. Sub-section (2) of Section 11 provides that if, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years. The total duration of copyright in design shall not exceed 15 years. After 15 years, the design will fall in public domain and will become public property.⁴

EFFECT OF DISCLOSURE ON COPYRIGHT

According to Section 16 of the Designs Act, 2000 provides that the disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person, other than the proprietor of the design, and the acceptance of a first and confidential order for articles bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.⁵

³ *Supra* note 1 at p. 235

⁴ *Supra* note 2 at p. 525

⁵ *Ibid* at p. 526

RESTORATION OF LAPSED DESIGNS

According to Section 12 of the Designs Act, 2000 where a design has ceased to have effect by reason of failure to pay the fee for the extension of copyright, the proprietor of such design or his legal representative may make an application for the restoration of the design in the prescribed manner on payment of prescribed fee within one year from the date on which the design ceased to have effect. The application shall contain a statement which is to be verified in the prescribed manner and fully setting out the circumstances which led to the failure to pay the prescribed fee. The Controller may require from the applicant such further evidence as he may think necessary.⁶

PROCEDURE FOR DISPOSAL OF APPLICATION FOR RESTORATION OF LAPSED DESIGNS

According to Section 13 of the Designs Act, 2000 provides that if after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is satisfied that the failure to pay the fee for extension of the period of copyright was unintentional and that there has been no undue delay in the making of the application, the Controller shall upon payment of any unpaid fee restore the registration of design. Sub-section (2) of Section 13 provides that the Controller may, if he thinks fit, as a condition of restoring the design, require that any entry shall be made in the register of any document or matter which under the provisions of this Act, has to be entered in the register which has not been so entered.⁷

RESTORATION OF LAPSED DESIGN- RIGHTS OF PROPRIETOR

According to Section 14 of the Designs Act, 2000 the rights of a proprietor of a lapsed design which has been restored shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the benefit of applying the design between the date when the registration of the design ceased to have effect and the date of restoration of the registration of the design. In addition, no suit or other proceeding shall be commenced in

⁶ *Supra* note 1 at p. 236

⁷ *Supra* note 2 at p. 526

respect of piracy of a registered design or infringement of the copyright in such design committed between such dates.⁸

REQUIREMENTS BEFORE DELIVERY ON SALES

According to Section 15 of the Designs Act, 2000 the proprietor shall fulfill the following requirements before delivery on sale of any articles to which a registered design has been applied:

- a) He shall furnish to the Controller the prescribed number of exact representations or specimens of the design. If he fails to do so, the Controller may after giving notice thereof to proprietor, erase his name from the register and thereupon the copyright in the design shall cease.
- b) He shall cause each such article to be marked with the prescribed mark, or with the prescribed words or figures denoting that the design is registered. If he fails to do so, he shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.⁹

INSPECTION OF REGISTERED DESIGN

According to Section 17 of the Designs Act, 2000 provides that during the existence of copyright in a design, any person on furnishing such information as may enable the Controller to identify the design and on payment of the prescribed fee may inspect the design in the prescribed manner. Sub-section (2) of Section 17 provides that any person may, on an application to the Controller and on payment of such fee as may be prescribed, obtain a certified copy of any registered design.¹⁰

INFORMATION AS TO EXISTENCE OF COPYRIGHT

According to Section 18 of the Designs Act, 2000 provides that on the request of any person furnishing such information as may enable the Controller to identify the design, and on

⁸ *Supra* note 1 at p. 237

⁹ *Ibid* at pp. 237-238

¹⁰ *Supra* note 2 at p. 528

payment of the prescribed fee, the Controller shall inform such person whether the registration still exists in respect of the design, and, if so, in respect of what classes of articles, and shall state the date of registration, and the name and address of the registered proprietor.¹¹

PIRACY OF REGISTERED DESIGNS

Piracy of registered design means unauthorized application of designs to the articles with respect to which the design is registered during the existence of their copyright. Section 22 of the Designs Act, 2000 gives the detailed provisions relating to piracy of registered design. Section 22(1) provides that during the existence of copyright in any design, it shall not be lawful for any person- (a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.¹²

REMEDIES AGAINST PIRACY OF REGISTERED DESIGN

The Designs Act, 2000 provides two alternative remedies to the proprietor of registered design under Section 22(2). Section 22(2) provides that if any person acts in contravention of Section 22, he shall be liable for every contravention:

- (i) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or
- (ii) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly. Provided that the total sum recoverable in respect of any one design under clause (a) shall not

¹¹ *Ibid* at p. 529

¹² *Ibid* at pp. 530-531

exceed fifty thousand rupees .Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.¹³

CONCLUDING OBSERVATION

In a world where simultaneous copying rages and piracy has become a business model, legislation addressing innovators' rights is a necessary addition to intellectual property law and a fair complement to anti-counterfeiting measures. Design denotes those which are protected by the Designs Act, 2000. But Designs Act prohibits registration of those which lack novelty or originality and also those designs which have been disclosed to the public domain in a tangible form or in any other way prior to the filing date. This Act has been enacted, taking into consideration the international standard that has been kept for design protection. It also states that the design must have an eye appeal, which means that it should attract people towards the article. A rationale basis for the protection of designs is to reward the designer's creativity and to provide incentives for future contributions. The registration of a design confers upon the registered proprietor Copyright in the design for the period of registration. Unauthorized application of designs to the articles with respect to which the design is registered amounts to piracy. Section 22 of the Designs Act gives the detailed provisions relating to piracy of registered design. It also provides remedies to the registered proprietor. Designs which appeal to the eye can be of a tremendous commercial value. So there is a real need to register the design as a registered design. It is the only way to prevent piracy of designs and to encourage the origin of new and original ones. The Designs Act, 2000 to a great extent serves as an umbrella protection for Designs.

¹³ *Supra* note 1 at p. 252