

3.6 Design Act

3.6.1 Introduction

The Designs Act, 2000 ("the Act"), is a complete code in itself and protection under it is totally statutory in nature. It protects the visual design of objects that are not purely utilitarian. Section 2(d) of the Act, defines a Design as: "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

(43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).

Designs are registered in different classes as per the Locarno Agreement. It is used to classify goods for the purposes of the registration of industrial designs which further helps in design searches. These classes are mainly function oriented. The copyright on a registered design is in total for 15 years. Initially the Copyright in Design is registered for 10 years, which can further be extended by 5 years on making an application for renewal.

In addition to the above, the design sought for protection must be new or original, i.e., not disclosed to the public in India or elsewhere in the world by prior publication or by prior use or in any other way. The design should be significantly distinguishable from designs or combination of designs that are already registered or pre-existing or disclosed to the public. Furthermore, the design shall not include any scandalous or obscene matter or any feature that is purely functional in nature.

As in case of any other IP rights, the design registration also bestows the monopolistic right to the proprietor by which the right holder can legally exclude others from reproducing, manufacturing, selling, or dealing in the said registered design without consent from the proprietor.

3.6.2 Remedies

As per Section 19 of the Designs Act, 2000, anytime during the subsistence of the design registration, any person can seek cancellation of the same by filing a Petition before the Controller, on the following grounds for Cancellation of design registration :

- That the design has been previously registered in India; or
- That it has been published in India or in any other country prior to the date of registration; or
- That the design is not a new or original design; or
- That the design is not registerable under this Act; or
- That it is not a design as defined under clause (d) of section 2...

Further an appeal against the order of the Controller can be made to the High Court.

On the other hand, Section 22 of the Designs Act, 2000, provides that any fraudulent or obvious imitation of a registered design without the consent of the proprietor is unlawful and also prohibits the import of such material which closely resembles a registered design. The section very specifically provides that in a civil case compensation payable shall not exceed Rs. 50,000/- in respect of infringement of one registered design. Because the compensation payable is statutorily limited, this is a good ground for insisting on an interim injunction even before the commencement of trial.

3.6.3 Comparison of Design Registration versus Different IPs

3.6.3.1 Design Registration versus Patents Registration

A patent protection is granted over a novel product or process comprising inventive step (technical advance) and exhibiting industrial applicability. One of the prime differentiators for design vis-à-vis patent protection is that contrary to designs, patents must contain a functional and/or structural feature of technical significance; while a design is judged on aesthetics only and not the functionality/technicalities of the shape/pattern of an article.

3.6.3.2 Design Registration versus Copyright

Both design and copyright protections relate to aesthetic features of the article. The differentiating factor is clearly provided under Section 15(1) of the Copyright Act, 1957, which states that :

- Copyright shall not subsist in any design registered under the Designs Act, 1911, or
- Copyright in any design capable of being registered under the Designs Act, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process.

3.6.3.3 Design Registration versus Trademark Registration

A registered design and a trademark (not yet registered) may have an overlapping area. Say if a unique shape is a registered design and the said unique shape of the article attains such level of popularity leading to brand recognition amidst available articles in the same classification of goods, the same may fall under consideration for a trade marks registration by the proprietor/company.

3.6.4 The Pros and Cons of the Indian Design System

Pros : India has a definite governing and established structure for the protection of industrial designs. Essential criteria for protection have been prescribed and are in line with international standards. The procedural formalities for filing design applications are simple and time constrained. It is important that the applicants ensure the procedural requirements carefully, as bulk of Indian design applications are rejected on procedural issues, while very few rejections are due to lack of fulfillment of substantive criteria. Thus, it is important to ensure that both the application form and the representation sheet comply with the guidelines so that design applications are processed speedily and efficiently.

Cons : One of the reasons why design is so infrequently protected is because in many industries such as jewelry and shoes, the designs change rapidly to keep up with consumer trends. The

requirement, that prior to registration a design cannot be in public domain, thus cannot be met by most of these industries. Another problem that the design protection regime faces is the term of protection. 15 years is too short a time. A company/individual would rather resort to trademark or copyright protection depending on the article in question, to get a longer term of protection.