

# **DESIGNS and IPR**

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# Objective of Design Protection

- ▶ To protect a new or original designs so created to be applied or applicable to an article manufactured by Industrial process or similar means
- ▶ Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance
- ▶ The artisan, creator, originator of a design having aesthetic look is to be rewarded for his contribution by others applying it to their goods.

# What is Design

- ▶ Design means only the features of shape, configuration, pattern, ornament, or composition of lines or colours applied to any article, 2-D or 3-D, by any industrial process - Manual, mechanical or chemical - which in the finished article appeal to the eye and are judged solely by it.
- ▶ Aesthetic aspect of an article which is generally mass-produced & useful
- ▶ Protects the way the article looks and not the functional way in which it works

# What is Design

- ▶ Design is not the article
- ▶ Article: an article of manufacture
  - wholly natural or artificial or partly so,
  - capable of being made and sold separately
- **design is integral to the article;**

# A set of Articles

- ▶ Ordinarily on sale or intended to be used together.
- ▶ All having common design even though articles are different (same class).
- ▶ Same general character.  
Ex. Tea set, Pen set, Knife set etc.

## Designs Excluded from Registration

- ▶ Designs of industrial plans, layouts and installations
- ▶ Normally, designs of artistic nature like painting, sculptures and the like which are not produced in bulk by any industrial process are excluded
- ▶ 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 any thing which is in substance a mere mechanical device
- ▶ Stamps, Labels, Tokens, Cards
- ▶ A trade mark or a logo forming part of an article

# Design Registration

## ▶ Design must be

- original means originating from the authors; include application of a known shape or pattern to new subject matter (old designs with new applications)
- novelty judged on world wide basis- not previously published or used in any country before the date of application for registration
- design must not
  - be contrary to public order or morality
  - contain scandalous/obscene matter.

# Rights in Regd. Designs

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 with legal right to sue for infringement

## ▶ Term 10 years from registration

- Extendable by 5 years if applied for before the expiry of the first term
- Certificate of Registration/Register of Design



# Copyright in Unregistered Designs

- ▶ A design, not registered under the Designs Act has the protection under the Copyright Act.
  - Such protection ceases to exist when the design article has been reproduced more than 50 times by an industrial process.

## Patenting the Statue of Liberty

One of the more famous design patents is that of the Statue of Liberty, patented by Auguste Bartholdi of Paris in 1879.

DESIGN.  
A. BARTHOLDI.  
Statue.  
No. 11,023. Patented Feb. 18, 1879.



LIBERTY ENLIGHTENING THE WORLD.

*E. A. Nick  
J. C. Carpenter.*

*Auguste Bartholdi  
By A. Pollak  
adv.*

*To all whom it may concern:*

Be it known that I, AUGUSTE BARTHOLDI, of Paris, in the Republic of France, have originated and produced a Design of a Monumental Statue, representing "Liberty enlightening the world," being intended as a commemorative monument of the independence of the United States; and I hereby declare the following to be a full, clear, and exact description of the same, reference being had to the accompanying illustration, which I submit as part of this specification.

The statue is that of a female figure standing erect upon a pedestal or block, the body being thrown slightly over to the left, so as to gravitate upon the left leg, the whole figure being thus in equilibrium, and symmetrically arranged with respect to a perpendicular line or axis passing through the head and left foot. The right leg, with its lower limb thrown back, is bent, resting upon the bent toe, thus giving grace to the general attitude of the figure. The body is clothed in the classical drapery, being a stola, or mantle gathered in upon the left shoulder and thrown over the skirt or tunic or under-garment, which drops in voluminous folds upon the feet. The right arm is thrown up and stretched out, with a flamboyant torch grasped in the hand. The flame of the torch is thus held high up above the figure. The arm is nude; the drapery of the sleeve is dropping down upon the shoulder in voluminous folds. In the left arm, which is falling against the body, is held a tablet, upon which is inscribed "4th July, 1776." This tab-

let is made to rest against the side of the body, above the hip, and so as to occupy an inclined position with relation thereto, exhibiting the inscription. The left hand clasps the tablet so as to bring the four fingers onto the face thereof. The head, with its classical, yet severe and calm, features, is surmounted by a crown or diadem, from which radiate divergently seven rays, tapering from the crown, and representing a halo. The feet are bare and sandal-strapped.

This design may be carried out in any manner known to the glyptic art in the form of a statue or statuette, or in alto-relievo or bas-relief, in metal, stone, terra-cotta, plaster-of-paris, or other plastic composition. It may also be carried out pictorially in print from engravings on metal, wood, or stone, or by photographing or otherwise.

What I claim as my invention is—

The herein-described design of a statue representing Liberty enlightening the world, the same consisting, essentially, of the draped female figure, with one arm upraised, bearing a torch, while the other holds an inscribed tablet, and having upon the head a diadem, substantially as set forth.

In testimony whereof I have signed this specification in the presence of two subscribing witnesses.

A. BARTHOLDI.

Witnesses:

C. TERINIER,  
COTTIN.

# USPTO Definition of “Design”

- ▶ Visual ornamental characteristics embodied in, or applied to, an article of manufacture
- ▶ Since a design is manifested in appearance, the subject matter of a design patent application may relate to the **configuration or shape** of an article, to the **surface ornamentation** applied to an article, or to the combination of configuration and surface ornamentation.

# USPTO Definition of “Design”

- ▶ A design for surface **ornamentation is inseparable from the article** to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture.

*A Guide to Filing a Design Patent Application, USPTO (2005)*

# Interesting Examples of Design Patents

- <https://www.eff.org/files/2015/12/28/patd554140.pdf>



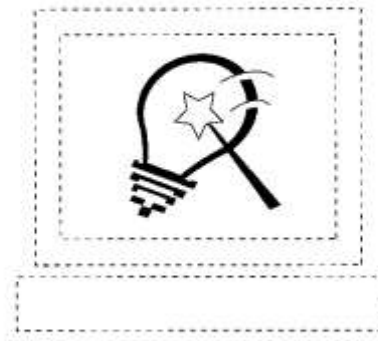
# Computer Icon for Display Panel

## U.S. Patent No. D439,912

U.S. Patent

Apr. 3, 2001

US D439,912 S





# Shaver

U.S. Patent

Nov. 8, 2005

Sheet 1 of 3

US D511,399 S

FIG. 1

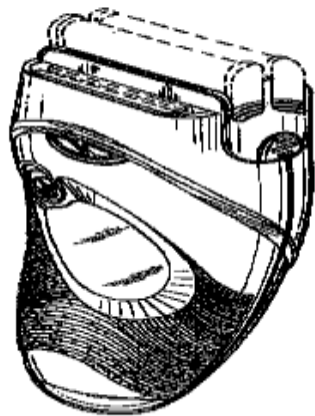
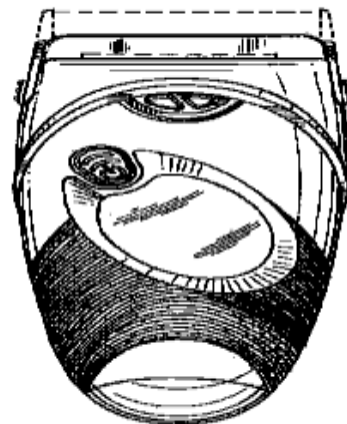
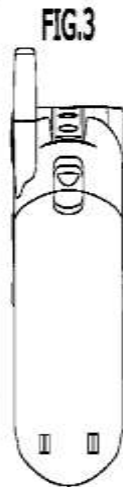
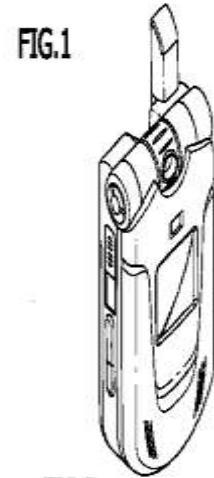


FIG. 2



# Mobile Phone

U.S. Patent Nov. 6, 2006 Sheet 1 of 2 US D511,336 S



# Tire Ribs

U.S. Patent Nov. 8, 2005 Sheet 1 of 4 US D511,321 S

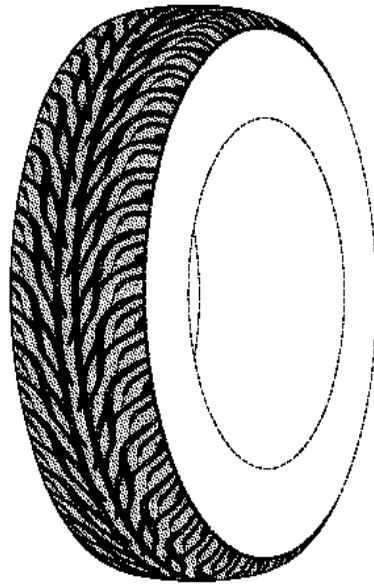
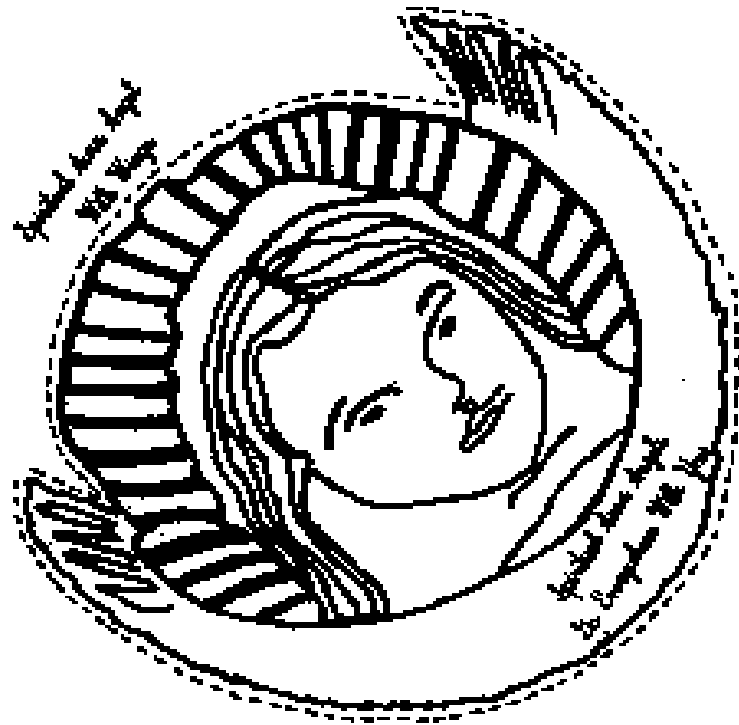


FIG-1

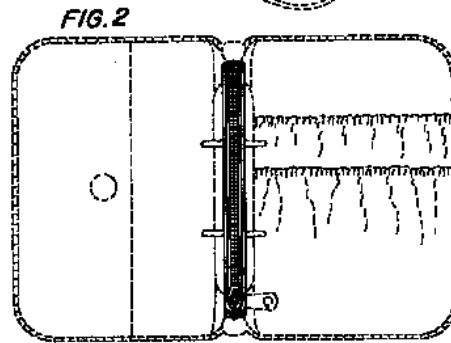
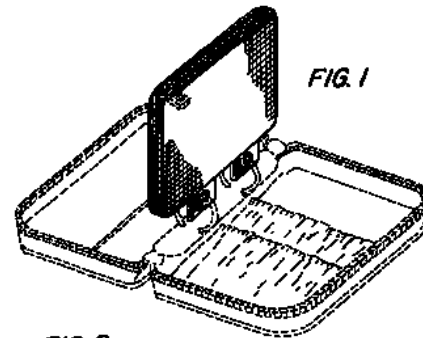
Spiritual aura angel with wings  
appliqué Issued Nov. 8, 2005  
D511,405



# Mesh Bag Insert for Make-up Planner

Nov. 8, 2005

U.S. Patent Nov. 8, 2005 Sheet 1 of 2 US D511,492 S



# Hair Bun Holder

U.S. Patent

Nov. 8, 2005

Sheet 1 of 4

US D611,397 S



FIG. 1



FIG. 2

# Baluster

U.S. Patent

Nov. 8, 2005

Sheet 1 of 7

US D511,388 S



FIG. 1

# Lamp Post

U.S. Patent Nov. 8, 2005 Sheet 1 of 4 US 6811,395 B

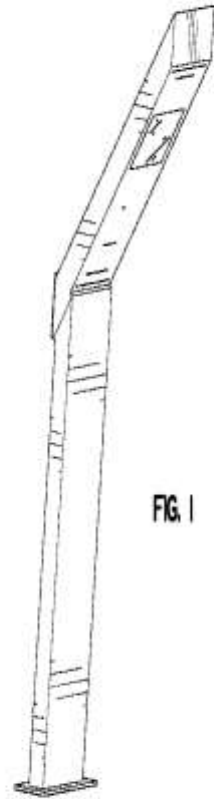


FIG. 1



# Ear Plug

U.S. Patent

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FIG. 1

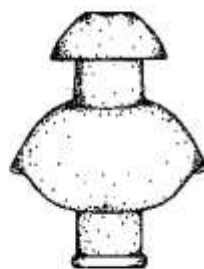


FIG. 2

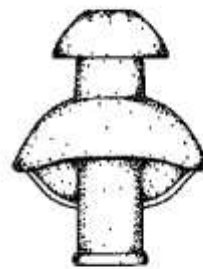
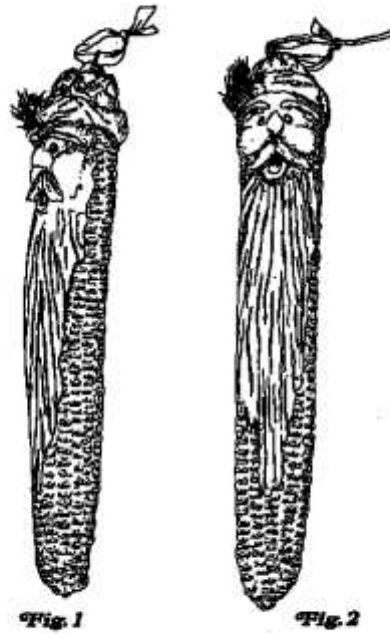


FIG. 3

# Handicrafts

U.S. Patent Nov. 8, 2005 Sheet 1 of 1 US D511,313 S



# Bracelet

U.S. Patent Nov. 8, 2005 Sheet 1 of 1 US D511,310 S

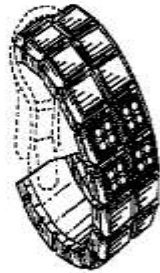


FIG. 1



FIG. 2

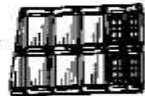


FIG. 3



FIG. 4

# Bottle

U.S. Patent

Nov. 8, 2005

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US D511,299 S

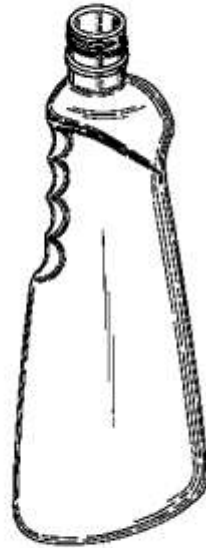


FIG. 1

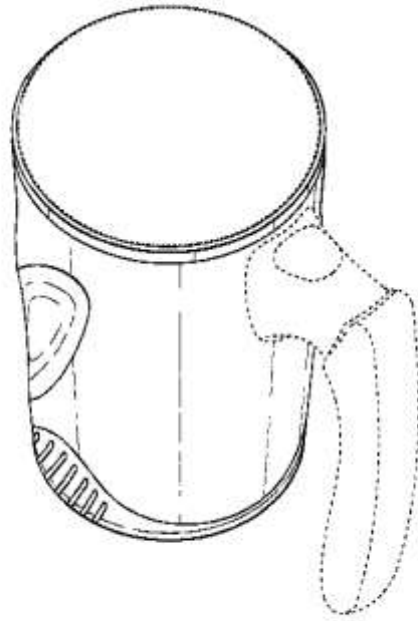


FIG. 2

# Mug

U.S. Patent Nov. 8, 2006 Sheet 1 of 4 US D511,295 S

*Fig. 1*



# Chair

U.S. Patent Nov. 8, 2005 Sheet 1 of 7 US D511,253 S



FIG. 1

# Chappal

U.S. Patent    No. 8, 205    Sheet 2 of 4    US D511,241 S

*FIG. 3*



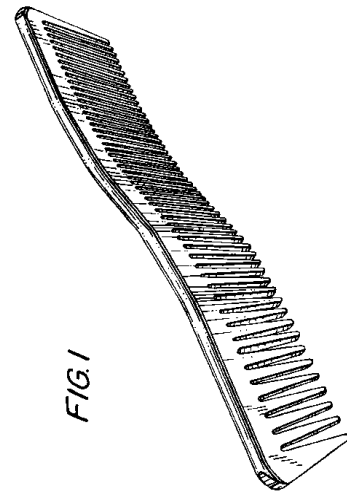
# Comb

U.S. Patent

Oct. 4, 2005

Sheet 1 of 2

US D510,459 S



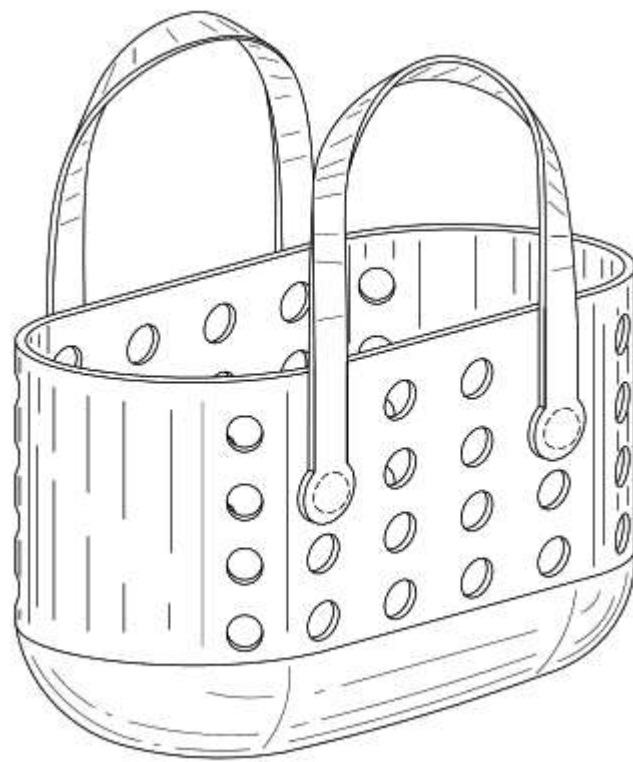
*FIG. 2*





Bag

USD0765398-20160906



# European Union Design System

- ▶ Came into force 1 April 2003
- ▶ Single registration of a unitary right to cover EU
- ▶ Low cost
- ▶ Quick registration
- ▶ New opportunities
- ▶ Applies to any product e.g. goods, packaging, get up

# International Treaties

- ▶ Paris Convention
- ▶ TRIPS Agreement
- ▶ Hague Agreement

## Hague System

- ▶ International Filing System with designated countries
- ▶ Domestic Registration is not mandatory
- ▶ Right of refusal lies with each country
- ▶ Notification to WIPO - International register

# Period of Protection

- ▶ Varies from 10 to 25 depending upon country
- ▶ Subject to timely renewal
- ▶ Period of ten year at a time

# Reciprocal Arrangement With UK/Convention Country

- ▶ A convention country basically accords to citizens of India the same privileges as it accords to its own citizens in matters of registration and protection of IP. It is to be notified as such by the GOI.

# Steps to Design Registration

- ▶ Finding Prior Art (Existing Registration)
- ▶ Preparing Representation of Design
- ▶ Identifying the Class of Design
- ▶ Providing Statement of Novelty
- ▶ Including a Disclaimer (TM, Mech. Action, Words, Letters, Numericals etc.)
- ▶ Claiming any Priority Date

# Classification of Goods

- ▶ Based on Locarno Agreement.
- ▶ The classification of goods is based upon the function
- ▶ Classes and subclasses (32 Classes)
- ▶ Only one class number is to be mentioned in one particular application.
- ▶ Multiple applications are permitted

# The Statement of Novelty

- ▶ "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.**



# Disclaimers

- ▶ *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.*
- ▶ *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.*
- ▶ *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.*

# Designs – Cancellation After Registration

## Grounds

- ▶ Previous registration in India
- ▶ Prior publication anywhere
- ▶ Design is not new/original
- ▶ Design not registrable
- ▶ It is not a design as defined in the Act

# Restoration of Lapsed Design

- ▶ If the design has lapsed, due to failure to apply for renewal before the expiry period, an application can be made for its restoration giving full reasons forth failure, within one year of the lapse.
  - any one of the persons holding the design can apply
  - Controller may prescribe new provisions to protect or compensate persons who may have begun availing of the design when it had lapsed.

# Designs - Infringement

- ▶ Others prohibited from using the design without permission of the proprietor, or his licensee or assignee.
  - applying a design by a person when the design has lapsed, even temporarily, is not infringement.

# Design Right Infringement

- ▶ Activities amounting to infringement
  - applying the design or any fraudulent imitation of it to any article, in any class in which the design is registered for sale;
  - importing for sale any article belonging to the class in which the design is registered and applying to it the design or its fraudulent imitation;
  - to publish or to expose for sale any article in any class in which the design is registered, knowing that the design or any fraudulent imitation of it has been applied to the article.

# Designs - Penalties for Infringement

- ▶ Damages and injunction as decided by the competent Court in a Civil suit;
- ▶ Up to Rs.25,000/- recoverable as a contract debt for every contravention, subject to a maximum of Rs.50,000/- in respect of any one design.
- ▶ Can recover damages if
  - ▶ He had taken all steps to ensure marking of the article (except textile designs)
  - ▶ The infringer had prior knowledge regarding the existence of copyright in the design

# Microfibres Inc vs. Girdhar and Co.

- ▶ Claim of copyright in the artistic work applied to upholstery design
- ▶ No registered design however they claimed a copyright in the drawings.
- ▶ Court held that the motive of the plaintiff was artistic and that the defendants had copied the same. However, since more than 50 reproduction had been made, the court refused to grant injunction.

# Dabur India Ltd. Vs. Rajesh Kumar

- ▶ Infringement of design was alleged in respect of a bottle which is being used by plaintiff for packing hair oil
- ▶ Plaintiff's bottle is a very common bottle used by several other companies. There was no peculiar feature of the bottle registered as a design
- ▶ The plaintiff had not pin pointed any novelty in the design of the bottle
- ▶ Bottles were in use much prior to the registration of the design



# Vikas Jain Vs. Aftab Ahmad And Ors

- ▶ Infringement as well as passing off of design in Toy Scooter. (Boom scooty Vs Dhoom trendy)
- ▶ There was a prior publication of the design and that he too was registered owner of the design
- ▶ There were various dissimilarities in the prior published design and
- ▶ That the design of the defendant was identical to the design of the plaintiff
- ▶ Defendant is not protected even on account of the registration having been obtained by him which admittedly is the subsequent registration

# Baldev Singh vs. Shriram Footwear

- ▶ Plaintiff claimed an injunction on the ground that his designs of shoe soles had distinctive shape and configuration
- ▶ The plaintiff himself had copied designs from Bata India Ltd.
- ▶ Plaintiff himself being a pirater, no injunction can be granted in his favour.

# Design Related Dispute



## *Facts:*

- Like slide to unlock, there is one more popular dispute between apple and Samsung, is design case dispute.
- The design dispute started in April 2011.
- Apple accused Samsung for copying the design of the iPhone for its Galaxy S series.
- Apple wants Samsung to pay up the damages for the infringements.
- The design patent dispute relates to Apple's  
3 Design patents and 3 Utility patents

# Design Related Dispute Cont'd...



- The infringed design patents claim certain design elements embodied in Apple's iPhone.
- The design elements are, rectangular, round-cornered front face; a similar rectangular round-cornered front face plus the surrounding rim, known as the bezel; and a colourful grid of 16 icons.
- The infringed utility patents claim certain features in the iPhone's user interface.

# Apple's patent under infringement

**US7469481**  
**Bounce**  
**Back Effect**

**D593087**  
**Ornamental**  
**design(bez**  
**el) on front**

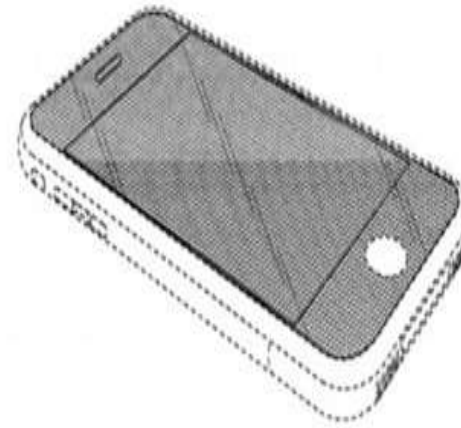
**US7844915**  
**On-Screen**  
**Navigation**

**D618677**  
**Design on**  
**front face**

**US7864163**  
**Tap-To-**  
**zoom**

**D604305**  
**Design of**  
**GUI**

Apple also alleged that Samsung had diluted its trade dresses relating to Apple iPhone.



D'677 Patent



D'087 Patent



D'305 Patent

# Design Related Dispute Cont'd...



# Designs and Fashion

- ▶ Fashion designs may be adequately protected by copyright law as works of applied art
- ▶ The short product life cycle does not justify investment in protection
- ▶ Works of fashion are protected as “artistic works” as under the Copyright Act
- ▶ Registration of a design helps the owner to prevent all others from exploiting its new or original ornamental or aesthetic aspects, which may relate to a three dimensional feature, such as the shape of a hat, or a two-dimensional feature, such as a textile prints

# Tahiliani Design Pvt.ltd. vs Rajesh Masrani

- ▶ Dealt with the copying of designs that had been used on Tahiliani fabric and which had been blatantly copied, feature-by-feature
- ▶ Masrani contended that the work to which protection under the Copyright Act was being claimed as “artistic work” were actually designs on textiles and came under the purview of the Designs Act.
- ▶ A copyright would not exist in any design registrable under the Designs Act, 2000



# Tahiliani Design Pvt.ltd. vs Rajesh Masrani

- ▶ The protection of copyright was available in view of the fact that the author/owner of the creative work was Tahiliani or his employees.
- ▶ Drawings made in the course of developing garments were artistic works
- ▶ Contended that “artistic work” is distinct from “design” and remains “artistic work” per se, distinct from the garment on which it is applied
- ▶ the Copyright Act provisions were wholly inapplicable to the case, since for copyright to cease to exist in the design, the same must be produced at least 50 times by an industrial process

# Tahiliani Design Pvt. Ltd. vs Rajesh Masrani

- ▶ Tahiliani design had been reproduced not more than 20 times.
- ▶ Court stated that uniqueness not only in conceptualisation but also in creation and presentation are “sine qua non of haute couture”. the Legislature deemed it expedient to exclude an “artistic work” from the definition of “design” as under the scheme of the Designs Act

# Design Registration for Fashion

- ▶ Design registration is the primary IP protection available for clothing designs. A design is the visual appearance of a product, such as a skirt with ruffles or the cut or decorative pattern of a shirt. A design registration gives designers protection for the visual appearance of the product, not the feel, material or function of a product.
- ▶ Design registration should be sought by designers wishing to mass produce or make multiple copies of products

# Fashion and Trade Mark

- ▶ Designers can use trade mark law to protect not only logos and brand names, but also other distinct features of a product.
- ▶ For example, Bettina Liano has registered the distinctive pocket stitching on her garments as a trade mark, while British fashion house Burberry holds trade mark rights in both the trade mark “Burberry” and the Burberry check pattern.
- ▶ Burberry has enforced its trade marks in many jurisdictions incl. US

# Copyright & Fashion

- ▶ Copyright law provides limited protection for a designer's designs. Copyright does not encompass ideas, information, styles, techniques and names; it may however include original artistic works such as sketches and patterns.
- ▶ This protection is limited as copyright law will not protect the “reverse engineering” of a garment.
- ▶ One-off fashion designs is OK but not mass production.

# Copyright and Designs Overlap

- ▶ Copyright in a paper pattern for a design; say a beachwear design, may be lost once that particular beach wear is made to that design unless the relevant design is the subject of a registered design. In other words, unless a clothing pattern is the subject of a registered design, third parties may be able to copy that pattern without infringing the designer's IP rights.
- ▶ Patents: Artistic creations cannot be patented  
Inventions which control odour and body temperature respectively in garments have been successfully patented

## Design Case Studies

- ▶ LEGO
- ▶ IP Protection in perpetuity ?

# History



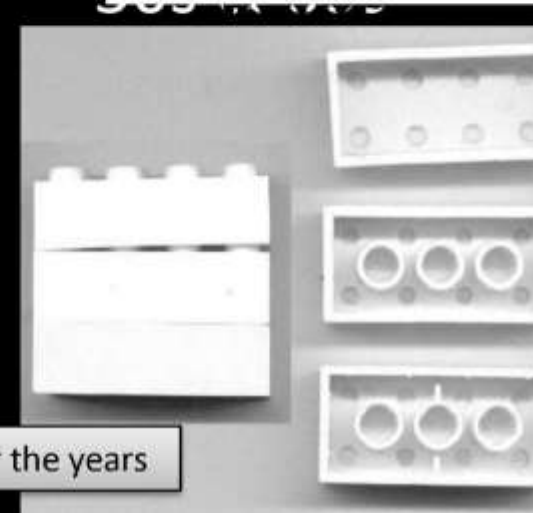
Ole Kirk Christiansen

Godtfred Kirk Christiansen

Kjeld Kirk Christiansen

Founded: 1932

- Based: Billund, Denmark
- Wooden Toys
- Patents filed in 50s & 60s



Lego blocks over the years



# Lego Brick

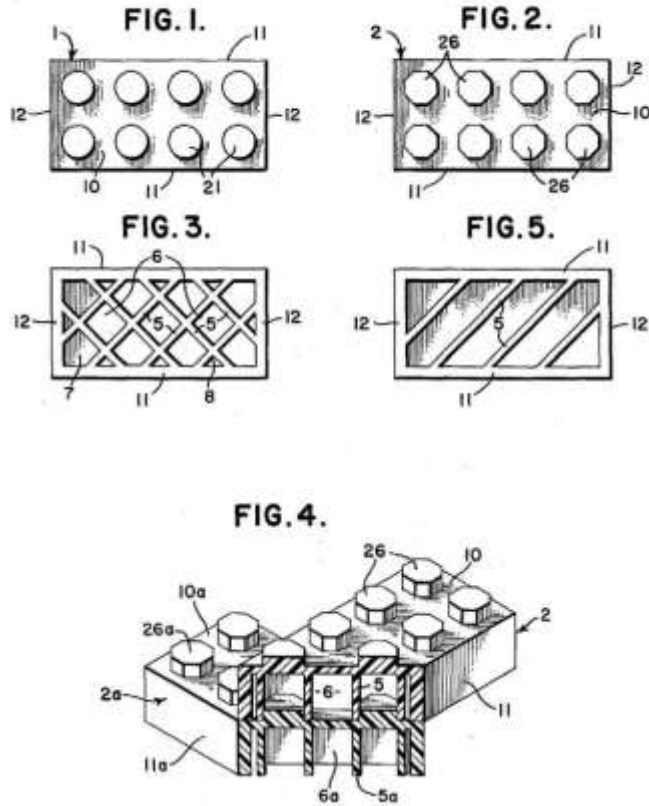
- ▶ Regarded as the Toy of the century
- ▶ First attempted by Hilary Page of Kiddicraft
- ▶ Lego worked out sophisticated design features that gave bricks improved 'clutch power'
- ▶ The brick in its present form was launched in 1958.
- ▶ The interlocking principle with its tubes makes it unique, and offers unlimited building possibilities.
- ▶ There are actually more than 900 million different ways of combining six eight-stud bricks of the same colour.
- ▶ Lego bricks from 1958 still interlock with those made in 2018

# Patents

Dec. 29, 1964

G. K. CHRISTIANSEN  
TOY BUILDING ELEMENT  
Filed June 27, 1961

3,162,973



► Patent for the Lego Block

# Lego post patents

- ▶ Last Lego brick patent expired in 1988
- New competitors: Tyco Toys, Mega Bloks, Coko
- Lawsuits
  - 1989: vs Tyco Industries - Lost
  - 2002: vs Coko for copyright infringement - Won
  - 2003: vs Biltema/Coko for product confusion - Won
  - 2000s: vs Mega Bloks - Lost
- Trademark still valid and under current laws 'the shape of goods' can be protected

# Play Set Themes



The Lego Group has released thousands of play sets themed around a variety of topics like Harry Potter, Indiana Jones

# Mindstorm - the new age of brick



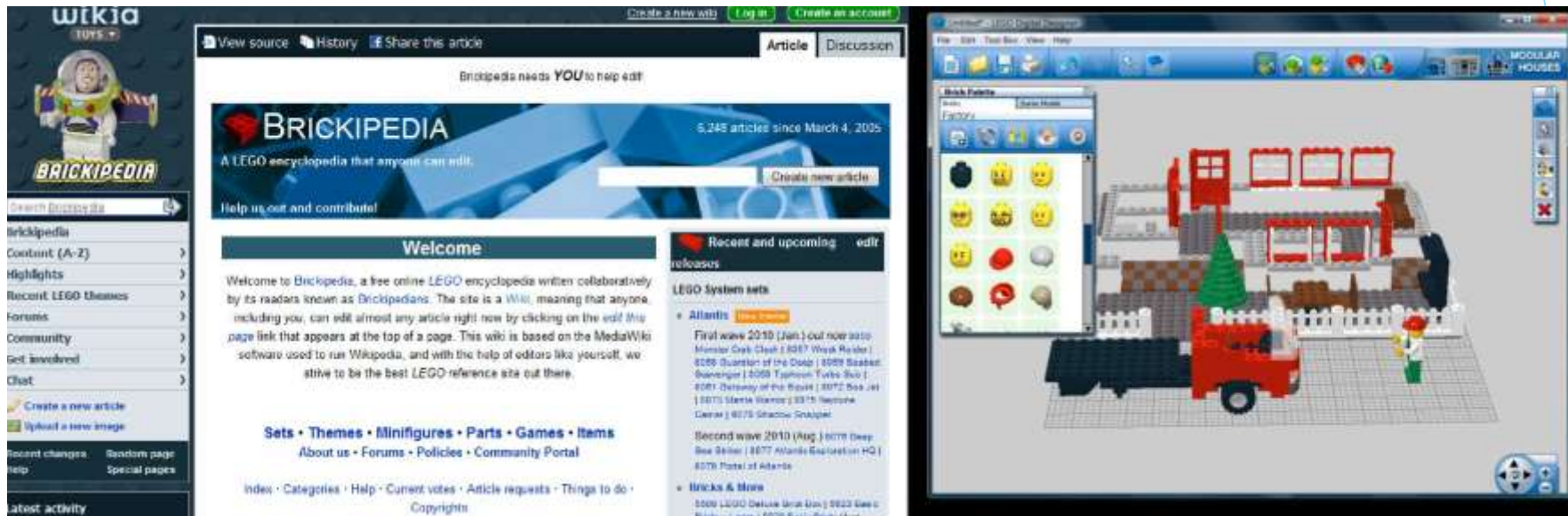
- ▶ The Lego NXT (Mindstorm) that can be programmed with a PC or a Mac to perform very complicated and useful tasks...



# The Future

Toy specific patents rather than the bricks

- ▶ Digital designs
- ▶ Crowdsourcing
- ▶ Computer & video games
- ▶ Legoland theme parks



# Duracell

- ▶ Manufacturer of Batteries in UK
- ▶ Identified gap in the market for torches
- ▶ Design Brief- Well designed portable light



Short-range lightening needs in a flexible and versatile way, free standing as well as hand held, desirable as personal possession and interesting as gift, high quality and performance but economical in price

Enhance the sale of Duracell batteries

# Duracell

- ▶ 'Flip-top' concept for pocket torch
- ▶ Head containing the bulb was to be on the ratchet which could move from fully close to fully open position. Swivel action acts as on/off switch and bulb protected when not in use
- ▶ Yellow and black colour scheme \*
- ▶ Won UK Design Council Award





# Duracell

- ▶ Swivel head in the pocket torch protected by patents in major countries
- ▶ Design features protected by design registrations
- ▶ Duracell is registered Trademark in all relevant countries
- ▶ More than dozen torches in the range. Pocket torch still one of the best sellers.
- ▶ Duracell torches led to intense competition in the market but designs have not been copied except once in Taiwan-poor quality (stopped by legal action).

# Toblerone

- ▶ Distinct shape of chocolate bars was created in 1908
- ▶ Triangular form inspired by the geometric silhouette of Matterhorn
- ▶ Word 'TOBLERONE' registered TM in 120 countries
- ▶ Shape of the TOBLERONE pack and the shape of the chocolate inside registered in Switzerland and countries party to Madrid Agreement

# Coca Cola

- ▶ The logo has been use and unchanged since 1886. TM in more than 160+ countries
- ▶ From 1915 onwards the coke bottle has had shape something close to its present shape
- ▶ Contour bottle design has near to worldwide trade mark registration ( In US since 1960)
- ▶ UK gave TM for 2D drawing of the bottle
- ▶ Distinctive shape gives virtual monopoly by reason of 'passing off' law in many countries



# Cutlery

(David Mellor)

- ▶ Meticulous attention to detail and finish make plagiarism very difficult
- ▶ Subtle manufacturing techniques in varying the thickness of the steel from relatively heavy to very thin
- ▶ Design Registration



# Millenium Chair (Artistic Craftsmanship)

- ▶ Designed by John Makepeace
- ▶ Purchased by The Art Institute, Chicago
- ▶ Skill in blending design, craftsmanship and choice of materials
- ▶ Industrial copying has rarely occurred because the form defies it.
- ▶ Such works get protected by copyright
- ▶ Design Registration, Design Right



# Packaging



- ▶ Lemon Juice by Reckitt & Colman (R&C)
- ▶ Pack has a size , shape & colour of a real lemon
- ▶ Words JiF embossed on to its textured surface
- ▶ Screw cap to enable juice to be squeezed out
- ▶ Attempts to copy and even sale it under trade name ' Realemon' foiled by litigation
- ▶ House of Lords upheld the right of R&C
- ▶ R&C gave licences to two similar designs larger in size and of different appearance.

# Conclusion

- ▶ Most successful designs have multiple protections
- ▶ Design is an integral part of Innovation
- ▶ IP Strategy has to be an important part of Strategic Design Management