



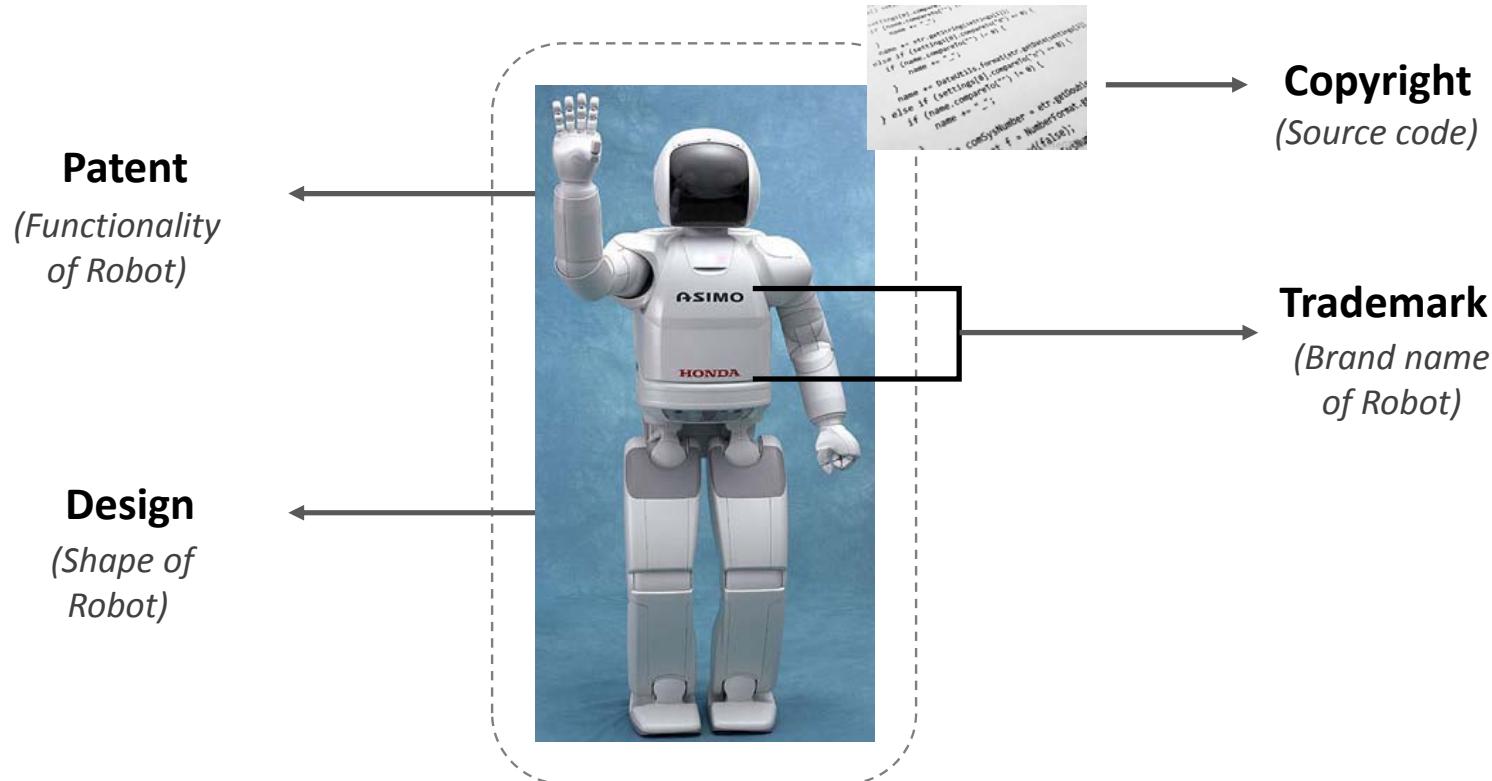
Only Designs!

Ravi Bhola
Partner

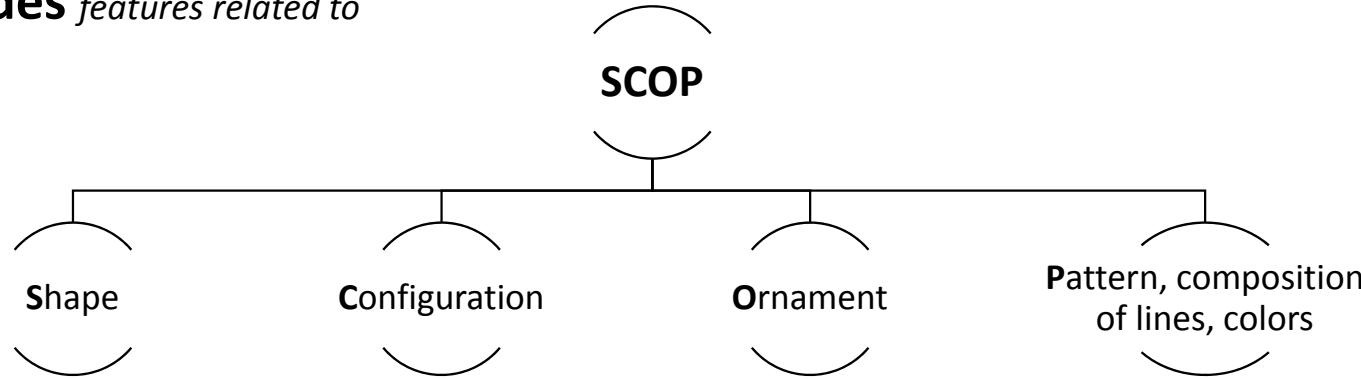
November 08, 2022



FORMS OF INTELLECTUAL PROPERTY



Design includes features related to



Features applied to any article,

which can be judged solely by the eye

aesthetic appeal of external features of an article

Objective: To protect the rights of the creator, the artisan, the originator, the designer and
the owner is not deprived of reward for the efforts

| *As per Designs Act*

Design Means:

- Design is “applied” on an “Article” - “industrial design”
- Applied in: two or three dimensional or both forms
- Applied by: an “Industrial process or means” – Manual, Mechanical, Chemical, or combination

Article means:

- any article of “Manufacture”
- any substance, artificial or partly artificial and partly natural; and
- any part of an article which is capable of being made and sold separately

Criteria for Registration of Designs and Registration Procedure

DESIGN: KEY FEATURES

NOVELTY - the key qualifying requirement

Considered new or novel if

- it has not previously been disclosed to the public anywhere in the world

Considered “Original” if

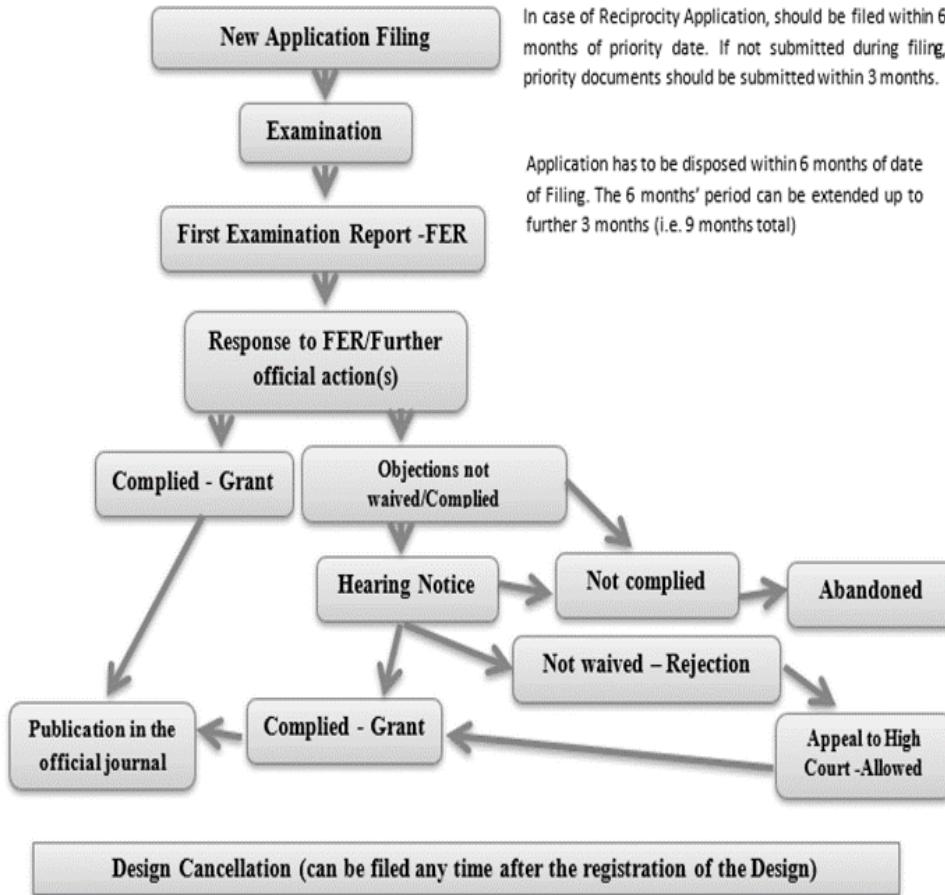
- Design though old in itself yet new in its application

ORIGINAL

“Original”- Though the design is old, yet new in its application



DESIGN REGISTRATION PROCESS



Average time: 6 to 8 months

Approx. filing official fee –INR 4000 for large entity
Protection Term -10 years (+ 5 years)

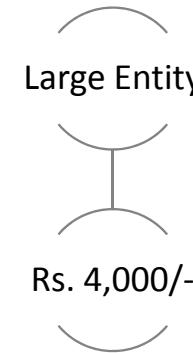
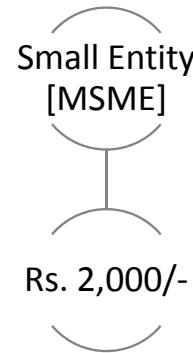
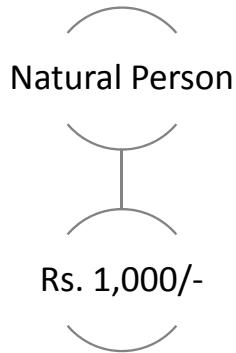
Article to be marked with the word 'REGISTERED' (or abbreviation 'REGD' or 'RD') and with registration number

FILING OF DESIGN APPLICATION: KEY POINTERS

- Statutory right – accrues only on registration
- Territorial – protected only in the country where it is registered
- Priority Date - first filing date in convention country
- Class and sub-class* for registration - Locarno Classification
- Application is to be made at sub-class level – in a sub-class which relates closest to the product
 - For example, Class 24 is for “Medical and laboratory equipment” – some of the sub-classes are
 - 24-01 - apparatus and equipment for doctors, hospitals and laboratories
 - 24-02 - medical instruments, instruments and tools for laboratory use
- Term of registration
 - Initial term of 10 years + 5 years
- Post expiry of term – public domain

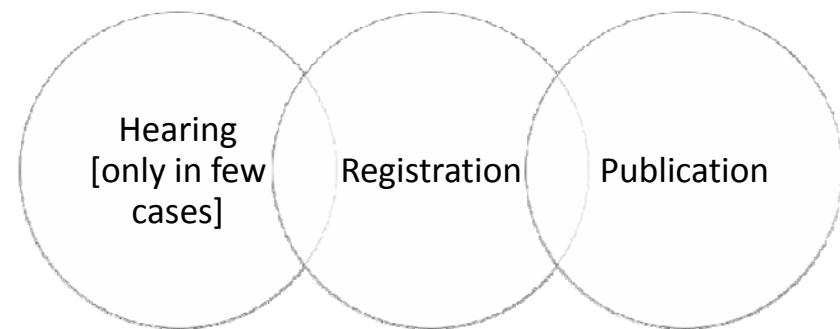
* Please mention the meaning

Who can file & fee involved



Examination

Novelty/originality – publication anywhere in the world



PROTECTION OF DESIGNS OUTSIDE INDIA

6 months from the date of first application

| One application can be filed to cover multiple countries or jurisdictions:

Hague Union

66 Contracting states

OHIM

All countries of the
European Union

TRENDS OF DESIGN APPLICATION FILINGS IN INDIA

Year	Filed	Registered
2012-2013	8,337	7,252
2013-2014	8,533	7,178
2014-2015	9,327	7,147
2015-2016	11,108	7,904
2016-2017	10,213	8,276
2017-2018	11,838	10,012

THE OVERLAP

Many Industrial works are based on the artistic works i.e., drawings

Possible protections

- **Copyright:** Right on expression of Idea in a tangible form
- **Copyright Term:** Lifetime of author plus 60 years
- **Design:** Rights will be granted for new or original creations in terms of shape configuration, surface pattern, color, color combination, applied to an article either 3 or 2 dimensional, by an industrial process

DESIGN & COPYRIGHT...contd.

To avoid confusion:

If a work has eye-appealing features, protect under 'design'

If such work is not registered as a 'design' and 50 reproductions have been made

- the work falls in public domain
- no protection in law

SUGGESTIONS

Design registration is for aesthetic appeal

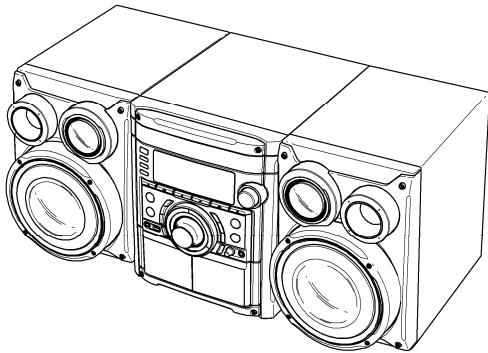
Seek registration of obvious variations

Individual registration of articles which can be made and sold separately

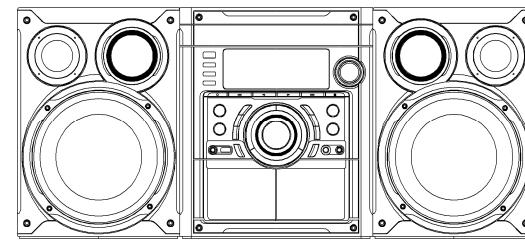
Representation preferably CAD models or line diagrams

Consider protecting product under other forms of IP such as patent, copyright, etc.

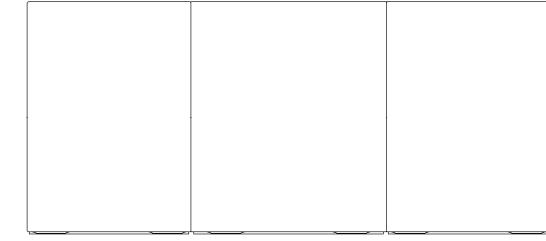
REPRESENTATION SHEETS IN DESIGN



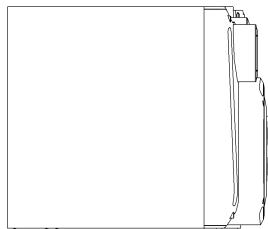
PERSPECTIVE VIEW



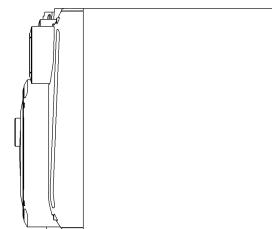
FRONT VIEW



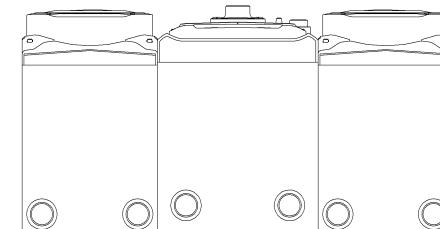
REAR VIEW



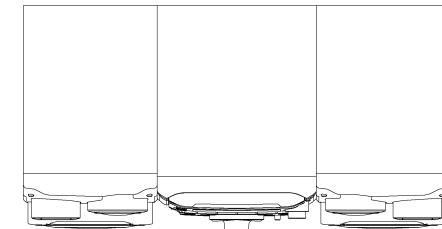
LEFT-SIDE VIEW



RIGHT-SIDE VIEW



BOTTOM VIEW



TOP VIEW

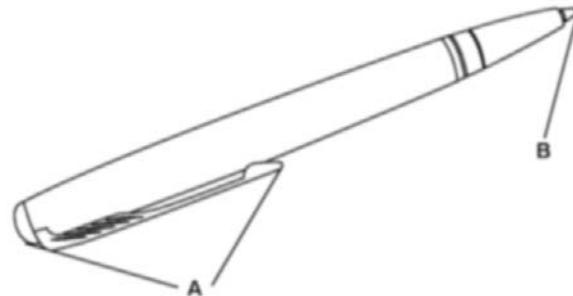
REPRESENTATION SHEET

NAME OF THE APPLICANT(S)	Total Sheets: X Sheet 1 of X
 ILLUSTRATION Perspective View	
<p>The novelty resides in the _____ of the [Name of the Article] as illustrated.</p> <p>No claim is made by virtue of this registration of respect of any mechanical or other action of any mechanism whether or in respect of any mode or principle of construction of the Article.</p> <p>No claim is made by virtue of this registration to any right to the exclusive use of the words, letters, numbers, or trademarks appearing in the copies of the representation of the designs.</p> <p>Dated: _____</p> <p>[Signature]</p>	

Novelty Statement to be included in the illustration sheet, indicating where novelty resides

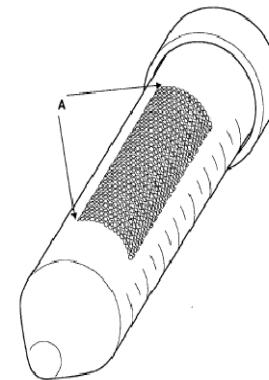
Disclaimer statements in representation sheets, for certain portion which are not intended to be claimed in the design

PIN-POINTING NOVEL FEATURES



NOVELTY STATEMENT

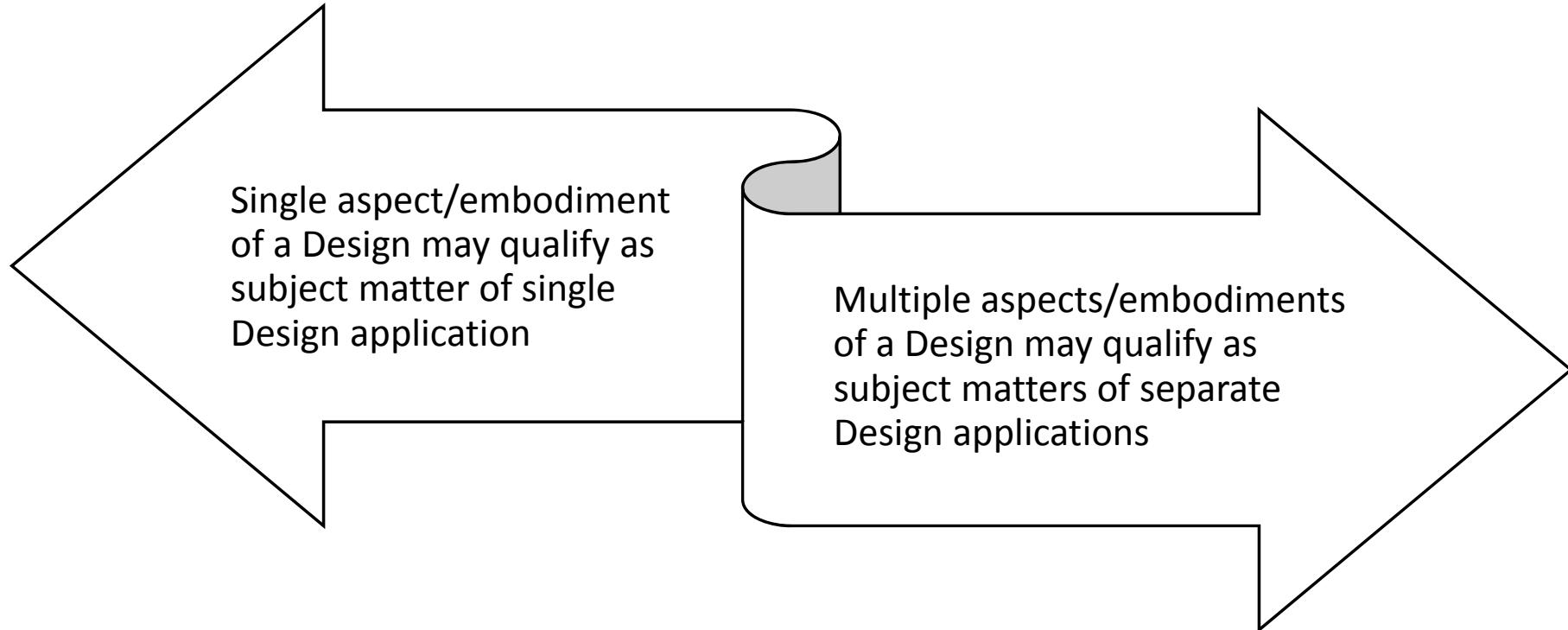
The novelty resides in Shape and Configuration of
“Writing Instrument” as marked “A” and “B”.



NOVELTY STATEMENT

“The novelty resides in the portion marked
“A” of the “TEST TUBES” as illustrated”

MULTIPLE ASPECTS/EMBODIMENTS IN DESIGN



WHAT IS NOT REGISTRABLE AS DESIGNS

- Designs of industrial plans, layouts and installations
- Designs with “functional” elements
- Designs of articles not produced in bulk by any industrial process
 - such as articles of artistic nature like painting, sculptures
- Designs of the inside arrangements of a product
 - For example, a box, money purse or an almirah, where such interiors are not shown when the article generally put in the market in a closed state.

DESIGN NOT REGISTRABLE?

- It comprises or contains scandalous or obscene matter
- Other exclusions
 - mode or principle of construction
 - mere mechanical device - functional features
 - Trademark - Logo, word letters, numbers, color or color combination



For instance, design of a “key” claiming novelty only in the shape of its corrugation or bend at the portion intended to engage with levers inside the associated lock, would not be registrable as a design under the Act

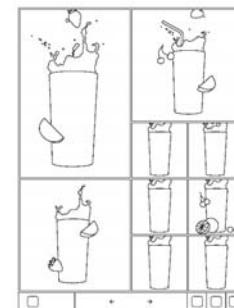
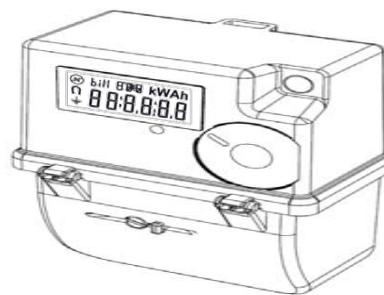
If a design has protectable “Aesthetic” features and other non-aesthetic features which are not registrable, registration could be available by “disclaiming” such non-aesthetic features

FEATURES APPLIED ON ARTICLE

Features	Design Registrability
Only Functional	✓
Only Aesthetic	✓
Functional + Aesthetic*	✓

Graphic User Interface (GUI):
Are these registrable as designs?

GUIs are registrable in many
countries but Registration of
GUI's in India still surrounded by
ambiguity



ENFORCEMENT OF DESIGNS IN INDIA

REMEDY AGAINST PIRACY OF DESIGN

- Only Civil remedy: Criminal remedy not available
- Registered proprietor may bring a civil action against a pirate to seek
 - Injunction against piracy
 - Damages
- Damages: Options
 - INR 25,000 for every contravention but the maximum total amount recoverable for any one design is INR 50,000; or
 - Sue for damages based on gains made by the pirate or the losses suffered by the proprietor
- District court is the lowest court for infringement action (Jurisdiction of court to be decided as per CPC)
- Where “cancellation” is taken as a defense in a suit before a District Court, the suit will be transferred to the Commercial Division of the appropriate High Court

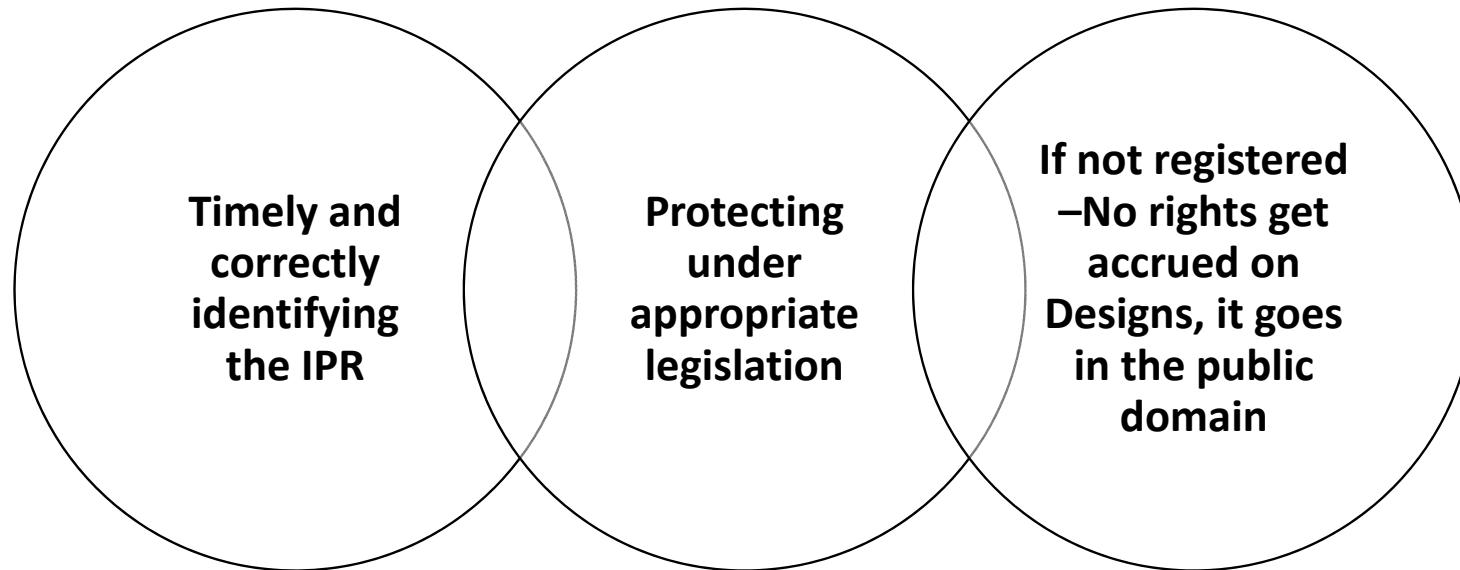
CANCELLATION OF A DESIGN REGISTRATION

- A petition for cancellation may be filed at the Patent Office by any person on certain grounds

These are:

- Not a “design” under Clause (d) of Section 2
 - Previously registered in India
 - Published in India or elsewhere prior to the date of registration
 - Not new or original
 - Not registrable under the Act
 - Comprises or contains scandalous or obscene matter
- Defendant in an infringement proceeding can take the ground of cancellation of the design as a defense

KEY LEARNINGS



THANK YOU

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