

Overview of the Indian Industrial Design Law and Practice

Niloy Kumar Gupta

Patent Office, Nizam Palace

2nd M S O Building, 234/4, A J C Bose Road, Calcutta 700 020

'Industrial designs' is a branch of intellectual property which was established to give the proprietors of innovative designs a set of competitive advantages in manufacture and trade. Industrial design registration involves a number of techno-legal issues that need to be appreciated. Beginning with the historical background of registration of Industrial designs in India and other basics of such registration, the paper addresses various aspects of registration of industrial designs. It presents an overview of the Indian industrial design law and practice, facts and procedures.

The concept of Industrial design existed since the production of useful articles. From the days of ancient civilization, efforts have been given to the outline and the ornamentation of the articles produced by the craftsman himself.

The first Act dealing with copyright in industrial designs was the Designing and Printing of Linens Act, 1787, came into force on 1 June 1787 in United Kingdom. It was concerned with designs for certain specified textile materials (namely: linens, cottons, calicos and muslins). By virtue of this act the sole right and liberty of printing and reprinting them was for two months from the date of first publication, that too with condition that the name of the proprietor was marked on

each piece. Thereafter many Acts came into force namely 1794 Act, 1839 Act, 1842 Act, 1850 Act, 1858 Act, 1861 Act, etc. etc. The 1839 Act provided for appointment of a registrar of designs by the Board of Trade and this responsibility was transferred from the Board of Trade to Patent Office in 1875.

Thus in 1911, the Patents and Designs Act, 1907 came into force in England. It did away with substantially all the existing copyright legislations which had been accumulating over a period of two centuries, repealing no less than 18 Acts most of them substantially in toto. Every branch of subject was brought within the statutes.

The British Patents & Designs Act, 1907 was adopted as Indian Patents & Designs Act, 1911 in 1912, and subsequently amended by Patents Act, 1970 and has been substituted by the words Designs Act, 1911 by item 24(1) to the fifth schedule to Patents Rules, 1972. Presently Designs rules, 1933 is in force with effect from 1 April 1933 and amended on 6 July 1985, effective from 6 June 1985.

As per the the Section 2(5) of the Design Act, 1911, the 'design' means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in finished article appeal to and are judged solely by the eye.

The word article as stated in the definition of design has been defined as any article of manufacture and any substance, artificial or natural, or partly artificial and partly natural.

The principle or the mode of construction of th article, mere mechanical contrivances, the building and structure, the part of an article not sold separately, variations commonly used in the trade, mere workshop alterations of components of an assembly, stamps, labels, token, cards, cartoons and mere change in size will not be the subject matter of registration of design (Section 2 (5) of the Designs Act, 1911).

Essential Requirement for Registration of a Design

The design should be new or original, not previously published in India, at the date of application for registration. Clear statements on the novelty of the designs in terms of its shape and or configuration, ornamental surface pattern must be indicated. The nov-

elty must also be clearly marked in the design submitted.

The novelty or the originality of a design is judged by the eye with reference to the external appearance of the finished article to which the design is applied is compared to the published design. It may be noted that the novelty or the originality of a design is destroyed by the publication of design. Publication of a design occurs when the same is available to public in the form of documents such as books or catalogues, etc. or where the design has been disclosed to some individual member of the public who was in no obligation to keep it secret (Section 49 of the Designs Act, 1911).

Procedure for filing an Application

Any person claiming to be the proprietor of any new or original design not previously published in India, may apply for the registration of the said design in prescribed forms, prescribed manner and accompanied by the prescribed fee (Rs 30/- only per application for registration of design) to the Patent Office, Calcutta.

If the design is to be applied to a single article, the application should be drawn up in Form 15, if the design is to be applied to a number of articles, comprising a set, Form 17 should be used. Form 16 should be used if it is intended to claim priority. Such application should be made within six months from the date of application in reciprocal country and should be accompanied by a certified copy of the design application filed there. Each application referred above should be accompanied by four copies of representations consisting of front, rear, sides, top and bottom views of the article (preferably photographic views) pasted on a A-4 size papers. A brief statement of novelty

claimed and statement of disclaimers should be endorsed on each copies of representation.

For the purpose of registration, articles have been classified into 14 different classes as provided in the fourth Schedule of the Designs Rules, 1933. The classification is based on the material or predominating material of which the article is made of (Table 1). It may be noted that each copy of the design (representation) and application form should be

signed and dated by the applicant or his agent (Forms 15, 16, 17 and a copy of representation sheet can be obtained from the Patent Office, Calcutta).

Official Action Taken

On receipt of an application for registration of design, the same is numbered, dated and examined, and defects (objections) if any are communicated to the applicant(s) or his agent. The applicant(s) or his agent should

Table 1-Classification of goods

Class	Description
One	Article composed wholly of metal or in which metal predominates, and jewelry.
Two	Books and book binding of all materials.
Three	Articles composed wholly of India-rubber, wood, bone, ivory, paper mache, celluloid, bakelite, or like substances, or of materials in which such substances predominate (except articles included in Class 10).
Four	Articles composed wholly of glass, earthenware, or porcelain, clay (burnt or baked), or cement or in which such materials predominate.
Five	Articles composed wholly of paper, card-board, mill-board or straw-board (except articles included in Class 2 and paper hangings), or in which such materials predominate.
Six	Articles composed wholly of leather or in which leather predominates, not included in other classes.
Seven	Paper hangings.
Eight	Carpets, rugs and floor coverings in all materials.
Nine	Lace.
Ten	Boots, shoes and the like foot-wear
Eleven	Millinery and wearing apparel (except articles included in Class 10).
Twelve	Goods not included in other classes.
Thirteen	Printed or woven designs on textile goods other than checks or stripes.
Fourteen	Printed or woven designs on textile goods being checks or stripes

meet the official objections within six months from the date of application. If the objections are contested a hearing before the Controller may be requested. At the hearing the Controller may agree with the submission of the applicant or applicant may agree to carry out corrections suggested by the Controller. Failing which the decision of the Controller shall be communicated to the applicant, who may within one month apply to the Controller requiring him to state the grounds and materials used by him in arriving at the said decision and the same is appealable to the Government of India.

An application which owing to any default or neglect on the part of the applicant has not been completed within six months from the date of application shall be deemed to be abandoned and said documents shall never be open to public at any stage (Rule 43 of the Designs Rules, 1933).

However, when an application for registration of a design is in order it is registered and notified in the official gazette, a certificate of registration is issued to the applicant (Section 45 of the Designs Act, 1911) and registration is recorded in the 'register of designs'. It may be noted that this certificate is not valid for legal proceedings. A separate request on a prescribed form with requisite fee may be made for obtaining a certified copy of the certificate for legal proceedings.

Register of Design

'Register of Design' is maintained by the Patent Office as statutory requirement. This document contains number of design, class number, date of filing (with reciprocity date if any) name and address of the proprietor(s) of the design, notification of assignments and of transmissions if any and other mat-

ters. It is open to public inspection on payment of prescribed fee.

A certified copy of the entries of this register of design may be obtained by making a request on a prescribed form with requisite fee.

The registered design is not open for public inspection until two years after the date of application for registration of the design (Rule 46 of the Designs Rules, 1933). After the period of said two years the design shall be open to inspection and copies thereof may be taken by any person on payment of prescribed fee.

Search under Section 51 of the Act

When a person is in possession of the registration number of a design, on the request of any person on a prescribed form with requisite fees, the Patent Officer (the Controller) shall inform in writing whether the registration still exists in respect of the said design, and if so in respect of what classes of goods, date of registration and name and address of the registered proprietor.

When a person is not in possession of registration number and submits a representation or specimen of the design, on the request of any person on a prescribed form with requisite fees and annexed with representation or specimen of the design in duplicate, the Patent Office (the Controller) shall inform in writing whether registration of such design exists, if so its registration number, date of application, name and address of the registered proprietor and the present status of it.

Duration of the Registration of a Design

The duration of the registration of a design is initially five years from the date of application (from the priority date in reciprocal country). The initial period of registration may be extended by two further periods of five years each on application on a prescribed form with requisite fees.

It may be noted that the maximum period of the registered design is 15 years only (Section 47 of the Designs Act, 1911).

Cancellation of Registration u/s 51A of the Act

Any person interested may present a petition for cancellation of the registration of a design:

- a. At any time after the registration of the design to the High Court on following grounds:
 - (i) that the design was previously registered in India;
 - (ii) that it has been published in India prior to the date of registration; or
 - (iii) that the design is not new or original.
- b. Within one year from the date of the registration to the Controller on following grounds:
 - (i) that the design has been previously registered in India; or
 - (ii) that it has been published in India prior the date of registration.

The decision of the Controller is appealable at High Court within three months from the date of the said decision.

Filing of application for cancellation of registration at the Patent Office and the decision

of the Controller are notified in the official gazette.

In case of cancellation of the registration of design by High Court or by the Controller, the same is also reflected in the Register of Design.

Entry of Subsequent Proprietorship

If a person become entitled by assignment, transmissions or other operation of law to a copyright in a registered design, or to any interest therein as mortgagee or licensee, he shall make a request on prescribed form with requisite fee and necessary documents for the entry in the register of his name as proprietor or part proprietor of the design or of notice of such interest.

Marketing of Article

Before delivery or sale of any article to which a registered design has been applied, the proprietor or the design is required to mark the articles with the word REGISTERED or with abbreviation REGD or RD as he may choose and also with the number of registration of the design. If the proprietor fails to do so he shall not be entitled to recover any penalty or damage in respect of any infringement of copy right in the design.

It may be noted that the articles registered under classes 9, 13, or 14 are exempted from said marketing (Rule 45 of the Designs Rules, 1933).

Piracy of Registered Design

Piracy of the design means the application of a design or its imitation to any article belonging to the particular class of goods in which the design has been registered for the purpose of sale or importation of such articles without the consent of the registered

proprietor (Section 53 of the Designs Act, 1911).

In this case 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.

Design Registration Scene of India

Number of applications for registration of designs filed under Section 43 of the Act and number of designs registered under Section 45 of the Act from 1989-90 to 1997-98 are given in Table 2.

Table 2- Applications for registration of designs filed and designs registered

Year	Applications filed	Designs registered
1989-90	1,148	1,069
1990-91	1,093	781
1991-92	1,114	921
1992-93	1,282	747
1993-94	1,655	1,203
1994-95	1,850	1,430
1995-96	2,024	1,851
1996-97	2,452	2,187
1997-98	2,595	1,337