



**DESIGN REGISTRATION
PROCEDURE
&
SCOPE OF PROTECTION**

BY
Ms. RINI TRIPATHI
National Institute of Design

HISTORICAL PREVIEW OF INDIAN PATENT SYSTEM



- The Indian Patents and Designs Act 1911 contained the provisions on protection of Industrial Designs.
- After the Patents Act 1970 repealed the provisions with respect to patents law to patents law from the Patents & Designs Act, 1911, the provisions with respect to designs as contained in the 1911 Act continued to govern the Design Law until 2000 when the Design Act 2000 was enacted.
- The Act came into force from 11th May 2001.



KEY FEATURES OF THE DESIGNS ACT-1911

- The term of filing – 5+5+5 years.
- Classification of Goods – 14 Classes
(This was based on construction of materials)
- Reciprocal Arrangement – Common Wealth Countries.
- Penal Provision – Piracy
(Rs. 500 & 1000 maximum damages decided by the court).
- The approximate filing – 1,85,493.



KEY FEATURES OF THE DESIGN ACT - 2000

- The broadened scope of “Article” which now specifically includes any part of an article capable of being made and sold separately;
- “Design” to include apart from shape, configuration, pattern or ornament even composition of lines or colours applied to any article;
- Absolute novelty (world wide) for registration of designs; (under the old law, it was restricted to the territory India only)
- Introduction of delegation of powers to Examiners and other officers by Controller.



KEY FEATURES OF THE DESIGN ACT - 2000

- Codification of non-registerable Designs.
- Substitution of Classification system – (Locarno Classification).
- Public inspection available after notification.
- Rights of registered proprietor defined.
- Provision of Restoration of Lapsed Design.
- Electronic Register of Design.
- Initial term of protection for 10 years extendable by 5 years on request.



KEY FEATURES OF THE DESIGN ACT - 2000

- Provision for preferring **Appeal** on the Controller's order before the High Court.
- Substitution of Applicants before registration of design.
- Additional grounds for **cancellation of design**.
- Registration of assignments/transfer of right made **mandatory**.
- Penalty for piracy of registered design enhanced.
- Inclusion of Paris Convention Countries apart from Commonwealth Countries for priority.



BENEFITS OF DESIGN REGISTRATION

- A person accrues **Statutory Right** only on registration – which is territorial in nature.
- It gives the **Right to Prevent** all other from producing, importing, selling or distributing products having an identical appearance or fraudulent or obvious imitation.
- **Right of Monopoly** (duration of registration) is obtained.
- It is **an Asset** and can be licensed.



REQUIREMENTS FOR REGISTRATION OF DESIGN

- A design should-
 - ❖ Be new or original;
 - ❖ Be distinguishable from known designs;
 - ❖ Be applied to an article;
 - ❖ Not be disclosed to public in any form;
 - ❖ Appeal to eye;
 - ❖ Not comprise of obscene matter;
 - ❖ Not to be contrary to public order or morality.

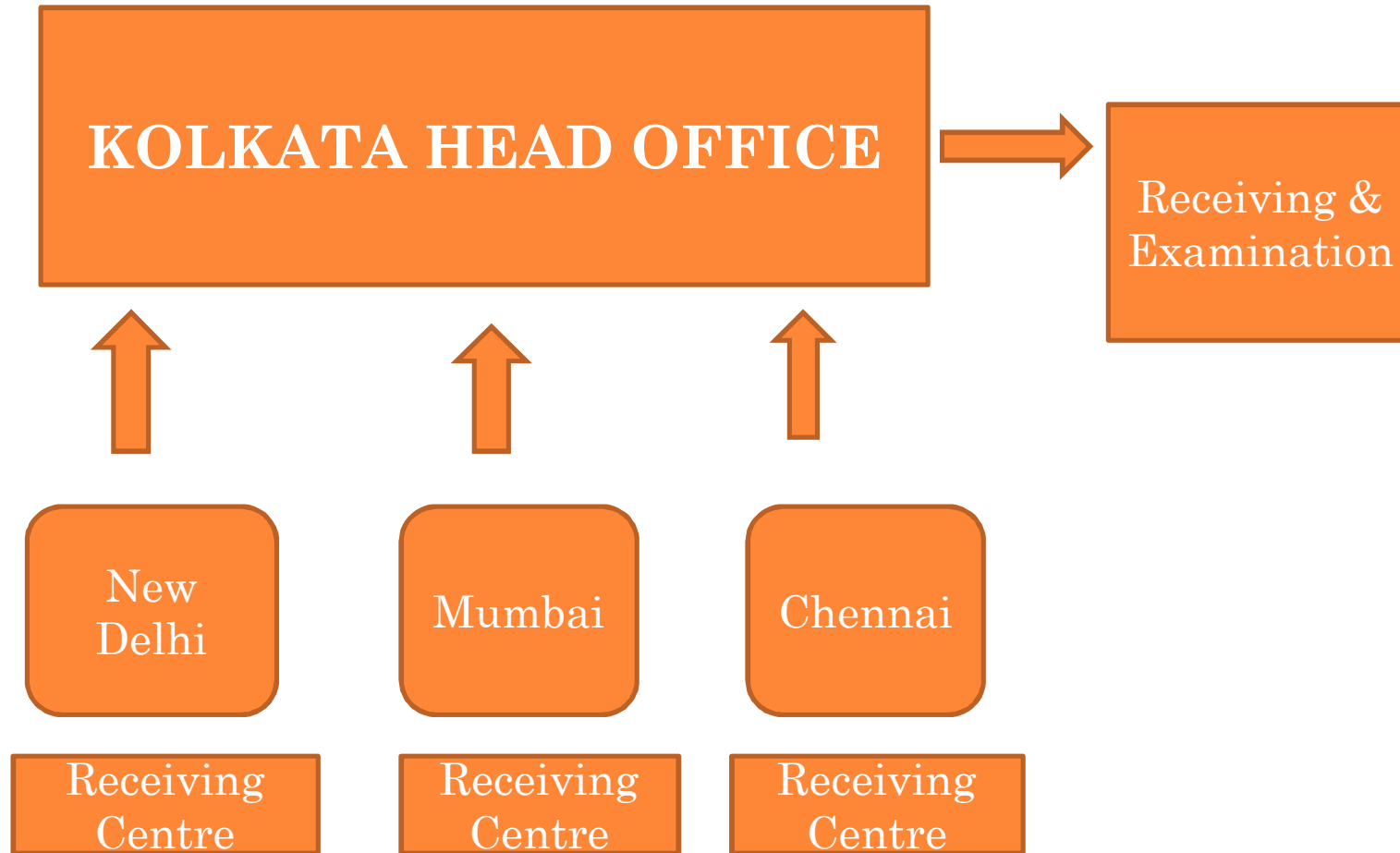


WHO CAN APPLY FOR THE REGISTRATION OF DESIGN?

- Any person; or
 - “ The legal representative; or
 - “ The assignee can apply separately or jointly for the registration of design.
- “Person” includes-
 - “ A firm,
 - “ A partnership and
 - “ A body corporate
- An application may be also filed through an agent in which case a POA (Power of Attorney) shall be filed.



APPLICATION PROCEDURE



PROCEDURAL REQUIREMENTS

- Application duly filed in on the prescribed form (Form-1) along with the –
 - ❖ Prescribed fees,
 - ❖ Stating the name in full address,
 - ❖ Nationality,
 - ❖ Name of the article,
 - ❖ Class number,
 - ❖ Address for service in India.
- The application shall also be signed either by the applicant or by his authorized agent.
- Representation of the article in quadruplicate (4 copies) stating the views eg. Front, rear, top, bottom, side and perspective views.



PROCEDURAL REQUIREMENTS (CONT)

- A statement of novelty and disclaimer (if any) in respect of-
 - mechanical action,
 - trademark,
 - word,
 - letter,
 - numerals
- should be endorsed on each representation sheet which should be duly signed and dated.



PROCEDURAL REQUIREMENTS (CONT)

- Power of Attorney
- Along with the application:
 - Priority documents (if any) in case of convention application claimed under section 44 of the Designs Act, 2000.
 - To be filed within 3 months from the date of filing of the application by taking extension of time [Form - 18] for filing priority document.



PROCEDURE FOR DESIGN REGISTRATION

○ Application Number:

- Upon filing the application, the filing receipt is issued indicating the Application number and date of lodgment and the application is taken up for Examination.

○ Examination:

- Defects in the application [procedural as well as substantive], if any noticed on examination of the application are communicated to the applicant or to his agent at the address of service. The defects should be corrected and the application needs to be resubmitted to the Design Office for acceptance **within six months** from the date of filing the application.



PROCEDURE FOR DESIGN REGISTRATION

○ Acceptance & Notification:

- An application is accepted when all the shortcomings have been rectified. It is then notified in the Official Gazette for objections, if any, from interested persons.

○ Refusal:

- In case the defects as required by the Controller are not rectified, a hearing will be provided to the applicant. In the hearing the Controller will decide whether the application should be accepted or not.



PROCEDURE FOR DESIGN REGISTRATION

○ Appeals:

- Any person aggrieved by the decision of the Controller refusing to register a design may appeal to the High Court. The appeal should be made within three months from the date of the Controller's decision.

○ Abandonment:

- An application which owing to any neglect or default on the part of the applicant has not been completed so as to enable registration to be effected within six months will be treated as abandoned. Such an application cannot be revived and no further action will be taken on it by the Design Office.



Form - 1
Application for registration of Design
(Section 5 and 44)

You are requested to register the accompanying design in **class 26-05** in the name of **National Institute of Design** located at Paldi, Ahmedabad-380007 Gujarat, having nationality as Indian and who claims to be the proprietor thereof.

Three exactly similar photograph specimens of the design accompany this request.

The design is to be applied to:

%Aroma Lamp+

Address for service in India is:

Intellectual Property Rights Cell
National Institute of Design
Paldi
Ahmedabad-380007
Gujarat, India

Declaration:

The applicant claims to be the proprietors of the design and that to the best of his knowledge and belief the design is new or original.

Dated this 14th November 2011

To,
The Controller of Designs
The Patent Office
Kolkata

Secretary and Head
General Administration
National Institute of Design



Representation Sheet

Name of the Applicant:
National Institute of Design



Total Sheets: 03
Sheet No: 02

Front View

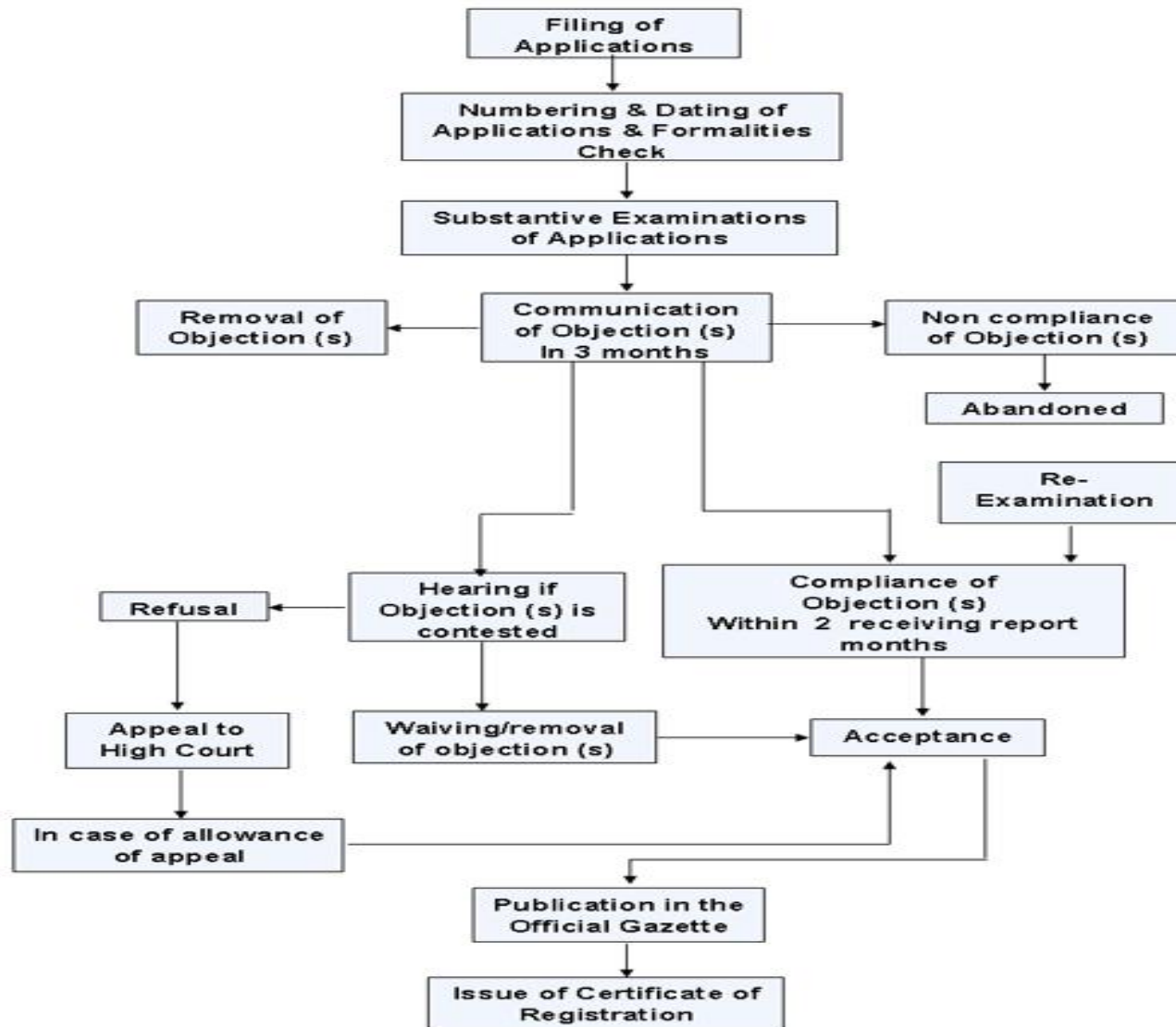
- ~ The Novelty resides in the shape and configuration of the Aroma Lamp as illustrated.
- ~ The claim is made by virtue of this representation for extraneous matter which is not forming the integral part of the article.
- ~ No claim is made by virtue of this registration in respect of any mechanical or other action of any mechanism whatever or in respect of any mode or principle of construction of the article.
- ~ No claim is made by virtue of the registration to any right to the exclusive use of words, letters, numbers, colours, colour combination or Trade Marks as appearing in the representation.

Date: 14th November 2011
Place: Ahmedabad

Secretary and Head
General Administration
National Institute of Design



FLOW CHART – DESIGN REGISTRATION PROCEDURE



SCOPE OF PROTECTION

- Grant:
 - After acceptance of the application the Design Office will proceed to grant registration.
- Term Of Design
 - The term of registration is for **15 years**. The registration is valid for an initial term of **10 years** and by renewal this term could be extended for another **5 years**.



SCOPE OF PROTECTION

○ Time Frame:

- A design registration can be obtained within a period of 12 (Twelve) months. As regards the design rights, all what is required to be done is to prepare and file design specifications along with the formal documents (the details of which are given below) with the Indian Patent Office. In preparing the design specification, it is to be ensured that the various claims regarding the design in its entirety with all its modifications have been covered.



SCOPE OF PROTECTION – A DIFFERENT VIEW

- In principle, depending on the provisions of the national laws of each country, a design may be protected in different ways.
- On the one hand, it may be protectable under an Industrial Property right and, on the other hand, it may be protectable under Intellectual Property or Copyright law.



SCOPE OF PROTECTION – A DIFFERENT VIEW

- Likewise, in some cases the design is protectable under Unfair Competition Law. In this case, the scope of protection, design copyright and other features of legal protection are normally very different from those applied under Industrial or Intellectual Property law.
- In most countries the different forms of protection may coexist, whereas in other countries coexistence is expressly excluded (for example in France).



SCOPE OF PROTECTION – INDUSTRIAL PROPERTY

- Within the scope of Industrial Property Laws, a design may be protected as:
 - **An industrial design:**
 - To have access to this sort of protection the design must be new, although a different degree of novelty is required in each country.
 - In most States, (the European Union, Canada, Mexico, Brazil, Argentina and even **India**), **worldwide novelty is required** (absolute), but there are some national laws (the Benelux countries, Australia) which simply require nationwide novelty (relative).



SCOPE OF PROTECTION – INDUSTRIAL PROPERTY

- Likewise, depending on the specific requirements of the laws in question, the design will have to be original or have an individual character , or be applied to a product having a useful function.
- The duration of protection conferred by the industrial design right generally ranges from **10 to 25 years**, depending on the applicable national laws, from the date of filing of the registration application.



SCOPE OF PROTECTION - TRADEMARK

○ A trade mark:

- The shape, design or packaging of a specific product may be the distinguishing factor] between this and other companies' products. In this case, the design may be registered as a trade mark.
- In order to be protected as a trade mark, the design must be distinctive and not consist of an exclusively functional shape or one which is necessary for the functioning of the product to which it is applied.
- The duration of design protection as a trade mark is **unlimited**.
- Trade mark and design protection **may coexist** (depending on the laws of each country), but they must be applied for separately and the design must fulfil the requirements for each form of protection.



SCOPE OF PROTECTION- INTELLECTUAL PROPERTY

- Some designs are conceived and considered a work of art, that is why, in some cases, they are automatically protected from the outset under **Copyright Laws**.
- The protection granted in these cases is, in principle, for the whole life of the author **plus 70 years** after his death (depending on relevant national legislation).
- Independently of whether the design enjoys intellectual property protection, it is also convenient to apply for an industrial design registration (taking into account that not all legal systems allow for the coexistence of these two forms of protection), as the protection and defence mechanisms recognised under industrial property laws are more effective.
- **Indian laws do not provide co-existence of two laws.**



SCOPE OF PROTECTION – UNFAIR COMPETITION

- In most countries, the Industrial Design is also protected by **Unfair Competition laws**.
- The design is protected against any acts of unfair competition, especially acts of
 - confusion,
 - imitation,
 - taking advantage of someone else's reputation, etc.



INTERNATIONAL DESIGN PROTECTION

- International design protection can be availed through –
 - Paris Convention
 - Hague Agreement



PARIS CONVENTION

- Paris convention provides certain privileges to member countries in design registration.
- A party who files design application in a member state of the Convention, such as India, can **within six months** of that filing date file applications in other member countries claiming the priority of the first application.
- If such design is accepted for registration it will be deemed to have been registered from the same date on which the application is made in the home country.



HAGUE AGREEMENT

- The Hague system gives the owner the possibility to have his design protected in several countries by simply filing one application with the International Bureau WIPO, in one language.
- The design so registered with the WIPO under this system will get the protection to all the member countries to the Agreement.



HAGUE AGREEMENT

- At present there are 58 countries who are contracting parties of the Hague Agreement, of which 41 countries are bound by the Geneva Act, 1999 which provides for International registration for industrial design.
- **India is not a member** to the Hague Agreement.



CONCLUSION

- We have various scopes of protecting the “design” the best available mean should be opted and put forth **enhancing the value of the knowledge capital.**
- Also, India as a country of rich art and culture should now put forth its steps to sign the Hague Agreement which will take the design to new heights.



CREATING THE IMPOSSIBLE AND ADVANCING
IN TECHNOLOGY - DESIGN

