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PROPERTY **INDIA**

PATENTS | DESIGNS | TRADE MARKS
GEOGRAPHICAL INDICATIONS

Manual Of Designs Practice & Procedure

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Preface

This Manual is intended to provide detailed information to the public and users of Design Registration System on the practice and procedures followed by Designs Wing of the Indian Patent Office, for processing of Design Applications and other related procedures. The primary objective of this manual is to streamline the procedure in the Designs Wing and to make the system more transparent and efficient. The Manual is based on the provisions of Designs Act, 2000 and the Designs Rules, 2001 as amended in 2008.

The Manual is formatted as a sequence of events from filing of application to registration and post registration procedures. Reference to sections and rules is provided in the right hand column. References to decisions of the courts of India and other countries have been given in the annexure for better understanding.

Complete automation of the Designs Wing is in progress and the entire process will be made fully e-enabled shortly, which will result in provision of online availability of the status of application, Register of Designs and file documents. E-filing of Design Applications and further documents will be introduced soon.

It is observed that 90% of the applications are objected to at the time of examination based on formality issues only. Very few applications are objected on substantive grounds such as novelty and originality. Such formality objections and their compliance take at least 4-5 months, resulting in delay in disposal of the application. Such faulty filing may be due to lack of proper understanding of the filing procedure, as required under the Law. This manual is expected to bring in the required understanding of filing procedure among the stakeholders. The Designs Wing expects to register a properly filed Design Application within a period of three months from the date of filing, starting April 2011.

The Manual will bring a level of awareness, both among officers and the applicants, as regards the correct procedure involved in the prosecution of Design Applications, which will reduce the current delay in registration.

The Manual does not constitute rule making and hence does not have the force and effect of law. Statements made in the Manual are not in themselves an authority as far as registrability of a Design Application is concerned. However, the procedural aspects as explained in the manual shall be binding on the officers and users of the Designs System. While the Manual may be regarded as a guide, it shall not be construed as an interpretation of the Designs Act and Rules and consequently may not be quoted to that end.

The Manual will be updated periodically in order to reflect important judgments, decisions and changes in practice and to correct errors, if any. Suggestions to improve the Manual will be appreciated.

P.H.KURIAN

Controller General of Patents, Designs & Trade Marks

CHAPTER-1

INTRODUCTION

1. The first legislation in India for protection of Industrial Designs was The Patents & Designs Protection Act, 1872. It supplemented the 1859 Act passed by Governor General of India for granting exclusive privileges to inventors and added protection for Industrial Design. The 1872 Act included the term “any new and original pattern or design, or the application of such pattern or design to any substance or article of manufacture”.
2. The Inventions & Designs Act of 1888 re-enacted the law relating to protection of inventions and designs and contained provision relating to Designs in a separate part.
3. The Patents & Designs Act enacted in 1911 also provided for protection of Industrial Designs.
4. The Patents Act, 1970 repealed the provisions of the Patents and Designs Act, 1911, so far as they related to Patents. However, the provisions relating to Designs were not repealed and continued to govern the Designs Law. India joined the WTO as a “member State” in 1995. Consequently, the Patents & Designs Act, 1911 was repealed and the Designs Act, 2000 was enacted, to make the Designs Law in India TRIPS compliant. The definition of ‘design’ in the Designs Act, 2000 is more or less the same as that of the 1911 Act. Novelty under the 1911 Act was determined with reference to India, whereas under the Designs Act, 2000 novelty is determined on a global basis. The classification system of the 1911 Act was based on material characteristics of the article, whereas the Design Rules 2001 and the amendment in 2008 provide an elaborate classification based on Locarno Classification system.
5. The Designs Act and Rules provide for filing of a Design Application in any of the four Patent Offices i.e. Patent Office Delhi, Mumbai, Chennai or Kolkata. However, the prosecution of a Design Application is done only at Patent Office, Kolkata. Even after providing facility to file applications in any of the four IP Offices, the number of Design Applications has increased only from about 4000 in 2004-05 to 6700 in 2009-10. This is irrespective of the tremendous growth achieved in the Industrial Sector and expansion of Design education in the Country. Tardy growth in filing of Design Applications may be contributed to, amongst other things, lack of awareness about

prosecution procedures and ignorance of the benefits of registration. The general feeling of the Creators appears to be that Design registration is a lengthy, time consuming and costly affair, whereas the facts are to the contrary. This manual is intended to remove such misconceptions. It is also intended to sensitise the stakeholders about the simple registration procedure along with the benefits of registration.

6. Some of the key definitions have been explained in Chapter-2.
7. Chapters 3 to 5 explain the procedure for filing of Design Applications, examination, registration and publication of design in the Patent Office Journal.
8. Chapter 6 to 8 explain the rights of the proprietor, extension of copyright, restoration of design, transfer of copyright, and post grant procedures such as cancellation and rectification.
9. Chapter 9 explains the general services provided by the Designs Wing.
10. Chapter 10 explains the provisions relating to use and acquisition of registered designs by Government.
11. Chapters 11 and 12 explain the powers and duties of Controller and the procedures regulating Evidence.
12. Chapter 13 explains the provisions relating to restrictive conditions in contract.
13. Chapter 14 & 15 explains the provisions relating to appeals & requirements before delivery on sales.
14. Chapter 16 provides the timelines prescribed under the Designs Act and Rules.
15. The Officers functioning under the Act have been vested with statutory powers. They also have some discretionary powers under the Act which are to be exercised judiciously. As far as registrability is concerned, the matter under consideration shall not be decided solely based on the contents of this manual. A judicious decision based on the Act, Rules and precedents shall be taken. However, as far as procedure is concerned, all officers of Designs Wing shall follow the procedure set forth in this manual.

CHAPTER – 2

IMPORTANT DEFINITIONS

02.01	General	
	For better appreciation of this manual, the user may require to have clear understanding of certain terms which are defined in the Act or Rules. Definitions of some of the important terms are as under.	
02.02	Definitions	
02.02.01	Controller	
	<p>"Controller" means the Controller General of Patents, Designs and Trade Marks referred to in Section 3(1) of the Designs Act, 2000. Controller shall be construed as including a reference to any officer discharging the functions of Controller in pursuance of Section 3(3).</p> <p>Office of the Controller General of Patents, Designs and Trademarks is at Mumbai.</p> <p>The Controller General of Patents, Designs and Trademarks is appointed by the Government of India under Section 3 of the Trademarks Act, 1999. The person so appointed is the Controller of Designs for the purposes of Designs Act, 2000.</p> <p>The Central Government may also appoint other officers who discharge, under the superintendence and directions of the Controller General of Patents, Designs and Trademarks, such functions of the Controller under this Act as he may authorize in writing, from time to time by</p>	<p>Section 2(b), 3(1) Section 3 of the Trade Marks Act, 1999</p>

	<p>general or special order.</p> <p>Examiner of Patents & Designs is authorised to conduct examination of a Design Application under the provisions of the Designs Act. The Assistant Controllers, Deputy Controllers and Joint Controllers of Patents & Designs may be authorised to discharge the functions of Controller of Designs under the Designs Act by the Controller General of Patents, Designs and Trademarks.</p>	
02.02.02	Article	
	<p>–article” means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of any article capable of being made and sold separately.</p>	Section 2(a)
02.02.03	Copyright in Designs	
	<p>–copyright” means the exclusive right to apply a design to any article in any class in which the design is registered.</p>	Section 2(c)
02.02.04	Design	
	<p>–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 or property mark (as defined in Section 479 of the Indian Penal Code) or artistic work (as defined in clause (c) of section 2 of the Copyright Act, 1957).</p>	Section 2(d)
02.02.05	Legal representative	
	<p>–legal representative” means a person who in law represents the estate of a deceased person.</p>	Section 2(f)

02.02.06	Original	
	–original”, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application.	Section 2(g)
02.02.07	Patent Office	
	–Patent Office” means the patent office referred to in Section 74 of the Patents Act, 1970. In India, the Patent Office is located at four locations viz. Delhi, Mumbai, Kolkata & Chennai. However, Designs Wing is located only at Kolkata. Accordingly, the documents relating to designs received in the other three offices are sent to Kolkata. It may be noted that there is no separate Designs Office in India.	Section 2(h)
02.02.08	Proprietor of a new or original design	
	a. where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; b. where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and c. in any other case, means the author of the design; and where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.	Section 2(j)
02.02.09	Reciprocity Application	
	a. –Reciprocity Application” means an application in India under section 44 of the Designs Act. b. A person, who has applied for protection of a Design, in any of the convention countries or group of countries or countries which are members of	Rule 2(d) Section 44

	intergovernmental organisations, may file an application for registration of the same design in India, within six months from the date of priority. Such applications are called reciprocity applications.	
02.02.10	Set	
	–Set” means a number of articles of the same general character ordinarily sold together or intended to be used together, all bearing the same design, with or without modification not sufficient to alter the character or substantially to affect the identity thereof. For instance, tea set, dinner set, furniture set etc.	Rule 2(e)

CHAPTER-3

FILING OF DESIGN APPLICATION

03.01	General	
	<p>Properly filled up application form and appropriately prepared representation are crucial for efficient prosecution of a Design Application. It is observed that 90% of the applications are objected on formality issues. Very few applications are objected on substantive issues, such as novelty and originality. Extensions are sought by the agents/legal practitioners for filing reply to such formal objections, which results in a further delay of 4-5 months. Accordingly, it is required that the documents related to Design Applications shall be prepared diligently. This can significantly reduce the time taken for registration. The Designs Wing of the Patent Office is committed to register a properly filed application, which complies with the substantive criteria of registrability, in one month from the date of filing, from April, 2011 onwards.</p>	
03.02	Where to apply	
	<p>An application for registration of a Design shall be addressed to the Controller of Designs, The Patent Office, CP-2, Sector-V, Salt Lake, Kolkata - 700091. (E-mail: controllerdesign.ipo@nic.in)</p>	Section 5(2), 3(3), 3(4)
03.03	Type of Applications	
	<p>a. <u>Ordinary application.</u> An ordinary application does not claim priority.</p> <p>b. <u>Reciprocity application.</u> A reciprocity application claims priority of an application filed previously in a convention country. Such an application shall be filed in India</p>	Section 5, 44

	within six months from the date of filing in convention country. This period of six months is not extendable.	
03.04	Applicant	
	<p>Any person claiming to be the proprietor of any new or original design may apply for registration. A proprietor may be from India or from a Convention Country.</p> <p>A proprietor may be:</p> <ol style="list-style-type: none"> a. an author of design, b. a person who has acquired the design, c. a person for whom the design has been developed by the author, or d. a person on whom the design has devolved. 	Section 5(1), 2(j)
03.05	Substitution of applicant or joint claiming	
	<ol style="list-style-type: none"> a. Name of an applicant can be substituted or a joint claim can be made for an applied design, if the following requirements are met: <ol style="list-style-type: none"> i. The claim for substitution is made before the design has been registered; and ii. Right of claimant shall be created only by: <ol style="list-style-type: none"> I. an assignment; II. agreement in writing made by the applicant or one of the applicants; or III. operation of law; and iii. The design under consideration shall be identified in the assignment or agreement specifically by reference to the number of application for registration; or iv. The rights of the claimant in respect of the design have been finally established by a Court; 	Section 8 Form-2

	<p>b. A request for substitution of applicant shall be filed in Form-2 along with the required fee. If the above said requirements are fulfilled and the Controller is satisfied that, upon registration of design, the claimant would be entitled to any interest in the design the Controller may direct that the application shall proceed:</p> <ul style="list-style-type: none">i. in the names of the claimant(s); orii. in the names of the claimant(s) and the applicant or the other joint applicant(s), as the case may be. <p>c. However, in case of joint applicants, the Controller shall not pass such direction without with the consent of the other joint applicant(s).</p> <p>d. In case, joint applicant(s) die(s) at any time before the design has been registered, a request may be made for substitution by the survivor(s) and the Controller may direct that the application shall proceed in the name of the survivors alone. However, no such direction shall be issued without the consent of legal representative of the deceased.</p> <p>e. If case, there is any dispute between joint applicants as to whether or in what manner the application should be proceeded with an application may be made by any of the parties. The Controller may give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may be. However, the Controller shall not pass any such direction without giving an</p>	
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	opportunity to be heard to all the concerned parties.	
03.06	Filing of Application	
	An application/petition for registration of design, extension of copyright, cancellation of registration and rectification of register may be filed at any of the four Patent Offices. However, the Patent Offices located at Delhi, Mumbai and Chennai transmit such applications to the Patent Office, Kolkata for further processing and prosecution.	
03.06.01	E-filing	
	E-filing facility for filing of Design Applications and all the subsequent documents will be made available shortly.	
03.06.02	Contents of Application	
03.06.02.01	Application form	
	<p>a. An application shall be filed in Form-1, along with the prescribed fees, stating the full name, address, nationality, name of the article, class number and address for service <u>in India</u>. Foreign applicants are also required to give an address for service in India, which could be the address of their Agent in India. In case of foreign applicants, it is mandatory to give an address for service in India. Unless, such an address is given, the Office shall not proceed with the application.</p> <p>b. The class to which the article belongs shall be mentioned correctly in Form-1. Under the Designs Rules, 2001, articles have been classified in the Third Schedule based on Locarno Classification. It may be noted that for registering a design in more than one class, a separate application is required to be filed for each class.</p>	<p>Section 5, 6, 43, 44 Rule 4, 9, 10 Form-1, 21 Third Schedule</p>

	<p>c. The application shall be signed either by the applicant or by his authorized agent/legal representative. In India, only a registered patent agent or a legal practitioner can be appointed as an authorised agent.</p> <p>d. In case, the applicant has already registered a design in any other class of articles, the fact of such registration along with the registration number shall be mentioned in Form-1.</p>	
03.06.02.02	Representation of design	
	Two copies of representation of the design shall be submitted. Detailed requirements of representation are described in 02.05.02.05.	Section 11 Rule 14
03.06.02.03	Power of attorney	
	<p>a. A Design Application may be filed personally by an applicant or through a patent agent/legal practitioner. If the application is filed through a patent agent/legal practitioner, a power of authority shall be submitted, along with the application. General Power of Attorney is also acceptable.</p> <p>b. The Register of Patent Agents containing the names and addresses of all the registered patent agents is available at: www.ipindia.nic.in</p> <p>c. It is observed that a large number of applications are filed by agents/legal practitioners, without a power of attorney. Such discrepancies cause undue delay in the disposal of applications and may amount to unnecessary harassment of the applicant. If the power of attorney was not submitted along with the application, the same shall be submitted within a month from the date of filing.</p>	Section 43 Rule 9 Form 21

03.06.02.04	Priority document	
	<p>A reciprocity application shall be accompanied by a copy of the design application filed in the Convention Country. Such copy shall be duly certified by the Official Chief or Head of the Organisation in which it was filed.</p> <p>If the priority document was not filed with the application, the same may be filed within an extended period of three months. Extension may be sought by filing Form-18 along with the prescribed fee.</p>	<p>Section 44 Rule 2(d), 15 Form-18</p>
03.06.02.05	Representation sheet	
	<p>a. The representation sheet of an article needs to be prepared diligently and shall be filed along with the application, in duplicate. The Designs Rules require that four copies of the representation shall be filed along with the application. However, as the records are digitised and processed electronically, two copies of the representation shall suffice.</p> <p>b. Representation means the exact representation of the article for which registration is sought. A representation may contain more than one page.</p> <p>c. Representation shall be exactly similar drawings, photographs, tracings including computer graphics or specimens of the design. The Controller may require a specimen of the article to be submitted at the time of examination, in rare cases.</p> <p>d. Photographs should be pasted on the representation sheets with the help of adhesive and not by other means like stapler, pin and cello tape. While using photographs in representation sheets, one of the copies of representation sheet shall not be covered by cellophane or tracing paper so as to</p>	<p>Rule 11, 14, 12</p>

	<p>enable digitization.</p> <p>e. Representation shall be prepared on white A4 size paper (210 mm X 296.9 mm) of durable quality, but not on card board, and only on one side of the paper.</p> <p>f. The figure(s) shall be placed in an upright position on the sheet. Each figure shall be designated clearly (e.g. perspective view, front view, side view).</p> <p>g. If design is to be applied to a set, the representation shall depict various arrangements in which the design is to be applied to articles in the set.</p> <p>h. Where an application is for a design as applied to a set, whether the given articles constitute a set or not, shall be determined by the Controller.</p> <p>i. In case, name or representation of living persons appear on a design, consent of such persons may be submitted along with the application. In case of a deceased person, the consent of legal representative may be submitted. It may be noted that non-submission of such consent may result in office objections and resultant delay in registration. In case, the representation contains the image or name of an imaginary person, such fact may be mentioned in the declaration on the representation sheet.</p> <p>j. A statement of novelty and disclaimer (if any) in respect of mechanical action, trademark, word, letter, numerals should be endorsed on each representation sheet. For specimen statements please see Annexure II.</p> <p>k. Representation, which consists of a repeating</p>	
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	<p>surface pattern, shall show the complete pattern, and a sufficient portion of the repeating pattern in length and width, and shall not be less than 15.00 centimeters by 10.00 centimeters in size.</p> <p>l. The name of applicant shall be mentioned in left hand top corner of the representation sheet.</p> <p>m. Total number of sheets and sheet number shall be mentioned in the right hand top corner of the representation sheet in Arabic numerals. .</p> <p>n. The representation sheet shall be signed and dated by the applicant/agent.</p> <p>o. No descriptive matter or matter denoting the components by reference letters/numerals shall be included.</p> <p>p. No sectional views shall be incorporated in the representation sheet.</p> <p>q. Dimensions or engineering symbols etc. shall not be used in the representation sheet. The representation is not to be regarded as engineering drawing of the article. The relevant parameter is the shape and not the size of the article.</p> <p>r. Where Trade Marks, words, letters or numerals are not the essence of the design, they shall be removed from the representations or specimens. Where they are essence of the design, a disclaimer shall be given in the representation sheet disclaiming any right to their exclusive use. Non inclusion of this disclaimer will result in an office objection and resultant delay. For specimen disclaimer statement please see Annexure II.</p> <p>s. No extraneous matter or background shall appear in the representation sheet. A background is considered neutral as long as the design is clearly</p>	
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	<p>visible in it.</p> <p>t. Dotted lines may be used in representation to indicate those elements of the article for which no protection is sought. Dotted lines identify elements which are not part of the claimed design. In such a case, features of design for which protection is sought must be shown in solid lines in the drawing.</p> <p>For instance, an ornamentation or surface pattern on an article can be registered. In such a case, the representation shall contain a solid line drawing for the claimed ornamentation or surface pattern, and dotted line for rest of the article.</p> <p>u. When colour combination is the essence of a design as applied to an article, the same shall be clearly depicted in the representation.</p> <p>v. Colouring may be used, on a black and white drawing, to highlight only those features of the design for which protection is sought. In such cases, it shall be clearly indicated in the novelty statement that the claim is restricted only to the portions depicted by colouring and the colours so given are not part of the design.</p> <p>w. Representations shall ordinarily be prepared in one format e.g. drawings, graphics or photographs etc. However, for better clarity, if the applicant so desires, a representation may be given in different formats.</p> <p>x. The applicant shall keep in mind the requirements of an Examiner to visualize the design and distinguish the same from any probable prior art. The number of views required in a representation sheet may be decided in light of this requirement.</p>	
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03.06.02.06	Classification of designs	
	<p>a. For the purpose of registration of designs, articles are classified into thirty-one classes and a miscellaneous class 99, as described in The Third Schedule of The Design Rules, 2001.</p> <p>b. The appropriate class shall be clearly identified with reference to The Third Schedule and shall be mentioned in Form 1. In case of any ambiguity, the Controller may decide the same, if necessary, in consultation with the applicant.</p> <p>c. When a Design Application is for an article with multiple utilities, the application may be made with depiction of an article in any one or more of the utilities. For instance, in case of a design of pen cum torch, the applicant is at liberty to apply in the class relating to pen, torch, pen-torch, or file two applications in different classes for better protection.</p> <p>d. The classification of articles under The Third Schedule is based on the International Classification of Industrial Designs according to the Locarno Agreement. However, India is not a signatory to the agreement.</p> <p>e. Ordinarily, the name of article should be common/familiar in the Trade or Industry and shall be analogous to the representation of the article. If the name of article is not common, the applicant may state the purpose for which the article is intended to be used, in Form-1 and representation sheet, so as to enable the Office to correctly decide the classification and facilitate search. An error in mentioning the article correctly may result in office objection with resultant delay</p>	<p>Section 5(3). Rule 10, 11. The Third Schedule.</p>

	of 2-3 months.	
03.06.03	Address for Service	
	<p>a. An address for service <u>in India</u> shall be given by every person in any proceeding under the Act or Rules.</p> <p>b. Change in address for service before a design has been registered shall be effected by filing a petition under Rule 46 with the prescribed fee, along with the fresh Form-1.</p> <p>c. Any change in address for service for a registered design shall be effected by filing Form-22 with the prescribed fee.</p> <p>Note: If the change in address for service in case of (b) and (c) is due to the change in agent/legal practitioner, duly executed power of attorney in favour of such agent/legal representative shall be filed along with the petition. Non-compliance of this requirement results in undue delay.</p> <p>d. Address for service is treated for all purposes as the actual address of such person.</p> <p>e. Unless an address for service is given, the Controller shall not proceed with the application.</p> <p>f. An address for service shall include e-mail of the agent/applicant.</p>	Rule 4, 31, 46 Form-22
03.07	Leaving and serving documents	
	<p>a. Any application and any other related document may be sent by hand or by letter addressed to the Controller of Designs. The letter may be sent by post or courier service or by electronic transmission duly authenticated.</p> <p>b. In case of electronic transmission which is not duly authenticated, the duly signed or executed document shall be submitted within fifteen days</p>	Rule 3

	<p>from the date of such transmission. However, the date of filing of document shall be taken to be the date on which fee is duly submitted. All non-fee documents may be sent by fax, or e-mail with a scanned copy of the signed document as attachment.</p> <p>c. If any document is sent by post or electronic transmission duly authenticated, it shall be deemed to have been filed at the time when the letter containing the same would have been delivered in the ordinary course. In proving such sending, it shall be sufficient to prove that the letter was properly addressed and transmitted.</p> <p>d. The following documents along with the prescribed fee may be filed at any of the four Patent Offices:</p> <ol style="list-style-type: none"> i. application for registration of design, ii. application for extension of copyright, iii. petition for cancellation of registration of design, and iv. application for rectification of Register of Designs. <p>However, all further documents relating to above said matters shall be filed in the Patent Office, Kolkata only.</p>	
03.08	Fee	
	<p>a. The fee to be paid in respect of any matter is prescribed in the First Schedule of The Design Rules, 2001.</p> <p>b. The fee payable under the rules may either be paid in cash or through electronic means or may be sent by bank draft or cheque payable at par, to the Controller of Designs and drawn on a scheduled</p>	<p>Rule 5 The First Schedule</p>

	<p>bank located at the respective filing location.</p> <p>c. Stamps and Indian Postal Orders are not accepted.</p> <p>d. Where fee is payable in respect of a document, the entire fee shall accompany the document.</p> <p>e. Fee once paid in respect of any proceedings shall not ordinarily be refunded irrespective of whether the proceeding has taken place or not.</p>	
03.09	Initial processing of application	
	<p>a. On receipt of an application, the Office accords a date and serial number to the application. This serial number, upon registration, becomes the registration number of the design.</p> <p>b. If the representation sheet is in such a form that the design cannot be visualised e.g. representation sheet received by fax, the application number shall not be allotted. Such an application shall be returned by post or at the counter itself, along with the fee, for non-fulfilment of basic requirements. The applicant/agent should be diligent enough to fulfil such basic requirements.</p> <p>c. A money receipt, which contains the application number, date and address, is handed over at the receipt counter or sent to the address for service, by post, as the case may be.</p> <p>d. Applications received at the Counter or by Post in Chennai, Mumbai and Delhi Patent Offices are sent to Patent Office, Kolkata within a week.</p> <p>e. All applications and other documents are digitized and verified at the Designs Wing, Kolkata and are uploaded to the server.</p> <p>f. The documents are then stored for official records.</p>	

CHAPTER-4

EXAMINATION AND REGISTRATION OF DESIGNS

04.01	Examination	
	<p>The application for registration of a design is referred by the Controller of Designs to an Examiner of Designs for conducting examination as to:</p> <ol style="list-style-type: none"> a. whether the application and the documents satisfy the formal requirements, and b. whether such design as applied to an article is registrable, <p>under the provisions of the Designs Act, 2000 and Designs Rules, 2001.</p>	Section 5(1)
04.02	Formality check	
	<p>The Examiner determines whether:</p> <ol style="list-style-type: none"> a. the application is in prescribed format? b. the prescribed fee has been paid? c. the name, address, and nationality of the applicant is mentioned? d. address for service is given in the application form? e. declaration of proprietorship is given in the application form? f. representation sheet is in a manner as prescribed in Rule 14? g. power of authority, if applicable, is filed? h. in case of reciprocity application: <ol style="list-style-type: none"> I. the application was filed within the prescribed time? II. the priority document was filed at the time of filing? If not, whether the priority document was filed within the extendable period of three months along with the prescribed form and fees? 	

	<p>III. the application was filed by the same applicant? If not, whether the assignment document has been filed?</p> <p>When the application is deficient in respect of (g), the Examiner reports the deficiency to the Controller, who communicates the statement of objections to the applicant. Such an application shall proceed for substantive examination only after compliance of the objections.</p> <p>The applicant may comply with the deficiencies within three months from the date of communication of the statement of objections or respond to the objections, failing which the application shall be treated as withdrawn. If the applicant wishes to contest the objections, he may respond to the objections clearly indicating the reasons. Thereupon, the Controller shall give a hearing and the matter shall be decided accordingly. In case of any decision adverse to the applicant, the Controller shall issue a speaking order.</p> <p>In view of the above, it is desirable that the applicant/agent shall be diligent enough to comply with the formal requirements.</p>	
04.03	Substantive examination	
	<p>Substantive examination is carried out to determine whether the design under consideration is:</p> <ol style="list-style-type: none"> a ‘design’ under the Act? new or original? prejudicial to public order or morality? prejudicial to the security of India? 	Section 2 (d), 2(g), 5(1), 46
04.03.01	Design	
	<p>A design:</p> <ol style="list-style-type: none"> is shape, configuration and pattern, ornamentation or composition of lines or colours, as applied to an article of manufacture, which in the finished form appeals to 	Section 2(d). Section 2(zb) of the Trademarks Act 1999.

	<p>and is judged solely by the eye;</p> <p>b. may be in two or three dimensional or in both forms;</p> <p>c. shall be capable of being a product of industrial process or means, whether manual, mechanical or chemical, separate or combined;</p> <p>d. shall not be a mere mechanical device, mode or principle of construction;</p> <p>e. does not include</p> <ol style="list-style-type: none"> i. any trademark, as defined in Section 2(zb) of the Trademarks Act, 1999, or ii. any property mark, as defined in Section 479 of the Indian Penal Code, 1860, or iii. any artistic work, as defined in Section 2(c) of the Copyrights Act, 1957 <p>[(i) A painting, sculpture, drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality.</p> <p>(ii) Any work of architecture i.e. any building or structure having an artistic character or design or any model for such building or structure.</p> <p>(iii) Any work of artistic craftsmanship.]</p> <p>f. An illustrative list of non-registrable designs is as under:</p> <ol style="list-style-type: none"> i. book jackets, calendars, certificates, forms and documents. ii. dress making patterns, greeting cards, leaflets, maps and plan cards. iii. post cards, stamps and medals. iv. labels, tokens, cards and cartoons. <p>g. Important case laws as to what constitutes a design”, are given in Annexure-I.</p>	<p>Section 479 of the Indian Penal Code, 1860.</p> <p>Section 2(c) of the Copyrights Act, 1999.</p>
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04.03.02	Novelty and originality	
	A design is capable of being registered only if it is new or original.	
04.03.02.01	Novelty	
	<p>a. A design shall be considered to be new when it has not been disclosed to the public, anywhere in India or in any other Country, by publication or by use or in any other way, prior to the filing date or priority date.</p> <p>b. A design shall be considered new if it is significantly distinguishable from known designs or combination of known designs.</p> <p>c. Disclosure of a design shall not be deemed to be publication of design, sufficient to invalidate the copyright thereof, in the following circumstances:</p> <p>i. Proprietor disclosed the design to any other person before registration, in such circumstances as would make it contrary to good faith for that other person to disclose the design However, that other person discloses the design in breach of good faith.</p> <p>ii. Acceptance of first and confidential order, before registration, for articles bearing a new or original textile design intended for registration.</p> <p>d. A design is not invalidated or prevented from registration:</p> <p>i. if a design or an article to which a design is applied has been exhibited in an exhibition to which the provisions of Section 21 of the Designs Act, 2000 have been extended by the Central Government by notification in the official gazette; or</p> <p>ii. if a description of the design is published, during or after the period of holding of such exhibition; or</p> <p>iii. if any person:</p> <p>I. exhibits the design or the article to which</p>	Section 4, 16, 21

	<p>the design is applied; or</p> <p>II. publishes a description of the design, during or after the period of holding of the exhibition, without the privity or consent of the proprietor.</p> <p>However, to avail the benefit of this provision, the proprietor shall:</p> <p>I. give a notice in Form-9 to the Controller before exhibiting the design, and</p> <p>II. file the application for registration of design within a period of six months from the date of first exhibiting the design or publishing the description.</p>	
04.03.02.02	Originality	
	<p>‘Original’ in relation to a design, means</p> <p>a. originating from the author of design, and</p> <p>b. includes the cases, which though old in themselves yet are new in their application.</p> <p>For instance, the figure of Taj Mahal is centuries old. But if a person conceives for the first time, the idea of making a flower vase or an ash tray in the form of figure of Taj Mahal, that may be an original design and shall be registrable.</p> <p>Important case laws relating to novelty and originality are given in Annexure-I</p>	Section 2(g)
04.03.02.03	Novelty Search	Section 4, 5
	<p>The Examiner conducts a novelty search in the available databases to ascertain the novelty of the design under consideration. Search is conducted class-wise or article-wise to ascertain whether the applied design is significantly different from the previously registered, used or published designs. If it is found that the design is not new, the Examiner mentions the fact along with the</p>	

	citations in his report to the Controller.	
04.03.02.04	Special provision relating to prior registered designs	
	<p>a. If the applicant has registered the design in any other class of articles, prior to the application under consideration, the fact shall be mentioned in Form-1.</p> <p>b. Upon Examination, if it is found that the design under consideration is already registered by the same applicant in another class and the applicant has not disclosed that fact in the application form, the Examiner shall raise an objection only with an objective to predate the application, and not on the ground of novelty. In such cases, the objection is communicated along with the citation of such prior registered design and the applicant is asked to amend the application. The term of the copyright of the design under consideration shall be co-terminus with the term of previously registered design.</p> <p>c. Upon Examination, if it is found that the applied design is already registered by another person in respect of some other article, the design under consideration may be registered only if the applicant becomes registered proprietor of the already registered design. The term of the copyright of the design under consideration shall be co-terminus with the term of previously registered design.</p> <p>d. Where any person makes an application for registration of a design in respect of any article and either:</p> <ol style="list-style-type: none"> i. that design has been previously registered by other person in respect of some other article, or ii. the design to which the application relates consists of a design previously registered by other person in respect of the same or some 	Section 6(3) & 6(4)

	<p>other article with modifications or variations not sufficient to alter the character or substantially to affect the identify thereof, and</p> <p>iii. if during the pendency of the application, the applicant becomes the proprietor of the previously registered design, the application shall not be refused on the ground:</p> <p style="padding-left: 40px;">I. that the design is not new or original only because it was previously registered, or</p> <p style="padding-left: 40px;">II. that design has been previously published in India or in any other Country, only because the design has been applied to article in respect of which a design has been registered.</p> <p>e. Apart from the above, while examining the application the Examiner shall consider other criteria of registrability e.g. scandalous matter etc.</p>	
04.03.03	Public order and morality	
	An application for registration of design is not registrable if it is contrary to public order and morality. Examiner’s opinion on this aspect is reported to the Controller.	Section 5(1) & 35 (1)
04.03.04	Security of India	Section 34, 46
	<p>a. Any application for design which is prejudicial to the security of India is not registrable and is not published.</p> <p>b. For the purposes of this provision, the expression –security of India” means any action necessary for the security of India which relates to the application of any design registered under this Act to any article used for war or applied directly or indirectly for the purposes of military establishment or for the purposes of war or other emergency in international relations.</p> <p>c. The Examiner examines the applied design vis-à-vis</p>	

	<p>the security of India and if there is an objection, the same is reported to the Controller. If the Controller confirms the view of the Examiner, the application is referred to the Defence Research Development Organisation, Ministry of Defence, Government of India, for directions by virtue of the Powers conferred by Section 34 of the Act. On receipt of a view favourable to the applicant, the application proceeds further.</p>	
04.04	Consideration of report of Examiner	
	<p>a. The Controller shall consider the report of Examiner on registrability of a design as applied to an article and if it is registrable, the same shall be registered forthwith. The registration certificate shall be issued and sent to the applicant at the earliest.</p> <p>b. If upon consideration of the report, the Controller is of the opinion that there are objection(s) adverse to the applicant or the application requires some amendment(s), a statement of objections shall be communicated to the applicant by the Controller. The communication shall be made either by registered post or electronic transmission.</p> <p>c. When an objection is raised on the ground of novelty, the Controller shall cite the specific prior art.</p> <p>d. If the applicant fails to comply with the objections or fails to apply for a hearing within three months from the date of communication of statement of objections, the application shall be deemed to be withdrawn.</p> <p>e. The period for removal of objections shall not exceed the time period of six months from the date of filing of the application.</p> <p>However, the said period of six months can be extended for a further period not exceeding three</p>	<p>Section 5(1) Rule 18</p>

	<p>months provided a request in Form-18 is filed before the expiry of six months.</p> <p>f. On consideration of response of the applicant, if the Controller is of opinion that the requirements of Act and Rules have not been met, the fact shall be communicated to the applicant clearly mentioning that the application is liable to be refused for reasons to be detailed and fixing a date for hearing.</p> <p>g. If the applicant fails to appear for the hearing without any request for adjournment, the application shall be refused giving a reasoned order.</p> <p>h. If written submissions are filed, while the opportunity to be heard is not availed by the applicant, no further opportunity to be heard may be provided and the matter shall be decided in light of the written submissions.</p> <p>i. If the applicant complies with all the requirements laid down under the Act and Rules, communicated in the form of statement of objections, the application shall be registered forthwith.</p>	
04.05	Registration & publication	Section 7
	<p>a. Once an application is registered, it is published in the Patent Office Journal ordinarily within one month. The registration number is same as the application number.</p> <p>b. The date of registration of an ordinary application is the date of filing of the application. In case of reciprocity application, the date of registration is the date of filing of application in the Convention Country.</p>	
04.06	Register of designs	

	<p>a. All the registered designs are entered in the Register of Designs maintained at Patent Office, Kolkata. The register is available to public for inspection and an e-register is also available at the official website.</p> <p>b. The Register contains the following details:</p> <ul style="list-style-type: none"> i. names(s) and address(s) of proprietor(s) of registered designs; ii. registration number; iii. class; iv. date of filing in India and date of filing in Convention Country (if any); v. renewal of copyright; vi. assignments and of transmissions of registered designs; vii. any other matter which would affect the validity or proprietorship of the design. 	Section 10, 26 Rule 30, 37, 38, 41
04.07	Certificate of Registration	
	Upon registration, the Controller issues a certificate of registration to the proprietor of the design. The certificate is sent by registered post to the address for service. No hand delivery of certificate of registration is allowed.	Section 9

CHAPTER 5

THE PATENT OFFICE JOURNAL

05.01	General	
	After registration, the design is published in the Patent Office Journal in the last part. After publication, the design is open to public for inspection.	Section 7
05.02	Publication	
	<p>Patent Office Journal is published on every Friday and contains the following matters on designs:</p> <ol style="list-style-type: none"> a. Public notice, if any. b. Registered designs. <ol style="list-style-type: none"> i. Registration number. ii. Date of filing. iii. Name of article. iv. Class of the article. v. Name and address of the registered proprietor. vi. Priority details like priority date and country. vii. Best view(s) of the article from the representation. c. Renewal of designs (only registration number). d. Restored Designs. e. Assignments / licenses/ Mortgage registration. f. Matters relating to rectification. g. Matters relating to cancellation. <p>The Patent Office Journal is available at the official website (www.ipindia.nic.in).</p>	
05.03	Prohibition of publication	
	If an application for a design has been abandoned or refused, the related documents cannot be published and are not open to public inspection.	Section 28

CHAPTER 6
PIRACY OF REGISTERED DESIGNS AND
CONSEQUENCES THEREOF

06.01	Piracy of registered design	
	<p>During the existence of copyright in any design it shall not be lawful for any person, without the license or written consent of the registered proprietor:</p> <ol style="list-style-type: none"> i. for the purpose of sale to apply or cause to be applied, to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, or to do anything with a view to enable the design to be so applied; ii. to import such article for the purposes of sale. iii. to publish or expose or cause to be published or exposed for sale, that article. 	Section 5(6), 22
06.02	Copyright in design (rights of registered proprietor)	
	<ol style="list-style-type: none"> a. The proprietor of the design gets exclusive right to apply the design to the article in a class in which the design is registered. b. A registered proprietor can institute a suit for injunction as well as recovery of damages against any person engaged in piracy of the registered design. Such legal proceedings can be instituted from the date of registration and till the expiry of copyright. However, in case of reciprocity application, the registered proprietor can claim damages in only from the actual date on which the design is registered in India. c. If any person commits piracy of a registered design, as 	Section 2(c), 11, 22, 44

	<p>defined in Section 22, he shall be liable to pay for a payment of a sum not exceeding twenty thousand rupees, recoverable as contract debt. However, the total sum recoverable in respect of any one design shall not exceed fifty thousand rupees.</p> <p>d. The suit for injunction / damages shall not be instituted in any Court below the Court of District Judge.</p>	
06.03	Provisions of Copyright Act as applied to a design	
	<p>A creator of a design shall keep in mind the following provisions of the Copyright Act, 1957:</p> <p>a. Copyright shall not subsist under the Copyright Act in any design which is registered under the Designs Act.</p> <p>b. Copyright in any design, which is capable is being registered but which has not been so registered 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, by the owner of the copyright, or with his license, by any other person.</p>	Section 15 of The Copyright Act 1957
06.04	Period of protection	
	<p>a. The proprietor shall have copyright in the design for ten years from the date of registration.</p> <p>b. This period of ten years can be extended by five years, if the registered proprietor applies for extension in prescribed manner.</p>	Section 11
06.05	Rights in lapsed design, which has been restored	
	<p>A proprietor shall have no right to institute a suit or proceeding in respect of piracy of design or infringement copyright, which has been committed between the date on which the design ceased to have effect and the date of restoration of the design.</p>	Section 14

CHAPTER 7

POST REGISTRATION PROCEDURES

07.01	Cancellation of registration	
	<p>a. Any person interested may file a petition for cancellation of a registered design in Form 8.</p> <p>b. Such petition may be filed at any of the four Patent Offices. Such petitions filed in Offices other than Kolkata, are transmitted to the Kolkata Patent Office. However, at present, all further proceedings of cancellation take place only at Patent Office, Kolkata and hence all communications relating to cancellation petitions are required to be communicated to that office.</p> <p>c. The petition for cancellation of registration of a design may be filed on any of the following grounds:</p> <ol style="list-style-type: none"> i. that the design has been previously registered in India; ii. that it has been published in India or in any other country prior to the date of registration; iii. that the design is not a new or original; iv. that the design is not registrable under this Designs Act; v. that it is not a design as defined under Section 2(d). 	Section 19
07.01.01	Procedure	
	<p>a. The petition for cancellation shall be accompanied by a statement and evidence setting out the facts based upon which the petition is filed. The statement shall also state the nature of applicant's interest so as to determine, whether the petitioner is a person interested.</p> <p>b. The fact of filing of a petition for cancellation of</p>	Section 19 Rule 29

	<p>registration of a design is published in the Official Journal.</p> <p>c. On receipt of a petition for cancellation, the Controller shall send a copy of the petition along with statement and evidence to the registered proprietor at the earliest.</p> <p>d. If the registered proprietor desires to oppose the petition, he shall file at Patent Office, Kolkata, a counter statement and evidence, if any, setting out fully the grounds upon which he intends to oppose the petition, within one month from the date of intimation by the Controller, and deliver a copy to the Petitioner, simultaneously. This period of one month is extendable by a maximum of three months, by filing a petition for extension with the required fee.</p> <p>e. After receipt of counter statement and evidence, if any, from the registered proprietor, the Petitioner may file his reply statement and evidence, by way of affidavits, within one month from the date of delivery of the registered proprietor's counter statement and evidence. Reply evidence of the petitioner shall be strictly confined to matters in the evidence of the registered proprietor. This period of one month is extendable by a maximum of three months, by filing a petition for extension with the required fee. The petitioner shall deliver a copy of his reply statement and evidence to the registered proprietor, simultaneously.</p> <p>f. No further evidence shall be delivered by either party, except with the leave or direction of Controller.</p> <p>g. Where a document is in a language other than English and is referred to in any statement or evidence, an attested translation thereof in duplicate in English</p>	
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	<p>should be furnished.</p> <p>h. After completion of the filing of statement and evidence by the Petitioner and Registered Proprietor, the Controller shall give at least ten days' notice for hearing.</p> <p>i. On receipt of the notice of hearing, if either party desires to be heard, a notice of intention to attend the hearing shall be filed in Form 20.</p> <p>j. The Controller may refuse to hear any party which has not given such notice and fee.</p> <p>k. If either party intends to rely on any publication at the hearing, not already mentioned in the petition for cancellation, statement or evidence, he shall give to the other party and to the Controller a notice of his intention to do so, together with details of such publication. Such notice shall be given at least five days' in advance.</p> <p>l. After hearing the parties, or if neither party desires to be heard, then without a hearing, the Controller shall decide the petition and issue a speaking order. The decision of Controller shall be notified to the parties and shall be published in the Official Journal.</p> <p>m. Subsequent entries, if necessary, shall be made in the Register of Designs.</p>	
07.02	Extension of copyright (renewal)	
	<p>a. The copyright in a registered design may be extended by a period of five years, from the expiration of original period of ten years.</p> <p>b. An application for extension of copyright shall be filed before the expiry of the original period of ten years.</p> <p>c. The Designs Wing shall complete the proceedings of extension of copyright in designs, within a week from</p>	Section 11 (2) Form 3

	<p>the date of receipt of Form-3.</p> <p>d. The fact of extension of copyright in a registered design is entered in the Register of Designs and is published in the Journal of Patent Office.</p>	
07.03	Restoration of lapsed design	
	<p>When copyright in a registered design has ceased to have effect due to non payment of fees for extension of copyright, within the prescribed time, an application for restoration may be filed within twelve months from the date on which the design ceased to have effect.</p>	<p>Section 12 Form-4</p>
07.03.01	Procedure for restoration	
	<p>a. The proprietor or his legal representative may apply for restoration of the design.</p> <p>b. If the design is held by two or more person, then, with the leave of the controller, one or more of them without joining the others may apply for restoration.</p> <p>c. If the application for restoration is filed by any other person claiming as proprietor of the design, such application shall be accompanied by Form-11, for affecting a change in name or proprietorship in the register of designs. The application for restoration shall be proceeded with only after the change in name or proprietorship is affected as per provisions of the Act. However, if change in proprietorship happened after the design ceased to have effect, such an application for restoration from the latter alleged proprietor will not be entertained.</p> <p>d. If the registered proprietor failed to register a change of name before or after the cessation, he shall first apply for such alteration in the Register. The application for restoration shall be proceeded with only after change in name has been affected in the register of designs.</p>	<p>Section 12, 13, 14. Rule 24 Form 4, 11.</p>

	<p>e. The application shall include a statement fully setting out the circumstances that led to failure to pay the fee.</p> <p>f. The evidence must support the claim that the failure to pay was unintentional and there has been no undue delay in applying for restoration.</p> <p>g. Controller may require evidence in support of the statement.</p> <p>h. If the Controller is satisfied that the failure to pay fee for extension was unintentional and that there has been no undue delay in making the application, the Controller shall restore the registration of design.</p> <p>i. If in the opinion of Controller there is a prima facie case for not allowing the application for restoration, the proprietor of the design shall be intimated accordingly. In such a case, the proprietor of the design may request for a hearing in the matter within one month from the date of such intimation. Unless such a request for hearing is made, the application shall be refused by the Controller.</p> <p>j. If the registered proprietor requests for hearing within the time allowed and the Controller, after such a hearing, is satisfied that the failure to pay the fee for the extension of copyright is unintentional and there is no undue delay in the making the application for restoration, the application for restoration shall be allowed.</p> <p>k. The fact that a design has been restored is published in Official Journal.</p>	
07.03.02	Payment of unpaid extension fee	
	<p>If the application for restoration has been allowed, the registered proprietor shall pay the unpaid fees for the extension of copyright along with additional fee prescribed in the First Schedule, within one month from the date of</p>	Rule 25

	order of Controller.	
07.04	Rectification	
	<p>a. An application for rectification of register of designs may be filed by any person aggrieved on the following grounds:</p> <ol style="list-style-type: none"> i. non-insertion or omission of an entry; ii. entry made without sufficient cause; iii. entry wrongly remaining on the register; iv. error or defect in any entry. <p>b. The rectification may be made by way of making, expunging or varying any entry.</p> <p>c. Rectification does not include cancellation of a design.</p>	Section 31 Rule 39, 40 Form-17
07.04.01	Procedure for rectification	
	<p>a. On receipt of an application for rectification, the Controller shall notify all persons, whose names are entered in the register as having an interest in the design. Such application shall also be published in the Patent Office Journal.</p> <p>b. Any person having an interest in the registered design may give notice of opposition to the application for rectification within three months from the date of publication of the application for rectification.</p> <p>c. The opponent shall, within fourteen days of giving notice of the opposition, leave at the office his written statement and evidence, in duplicate, setting out the nature of his interest, the facts upon which he bases his case and the relief, which he seeks.</p> <p>d. The Controller shall forward a copy of the notice of opposition along with the written statement and evidence to the applicant for rectification within fifteen days of the receipt of statement and evidence.</p> <p>e. If the applicant desires to contest the notice of</p>	Rule 39, 40 Form-19

	<p>opposition, he shall file at Patent Office, Kolkata, a counter statement and evidence, if any, setting out fully the grounds upon which he intends to contest the notice of opposition, within one month from the date of intimation by the Controller, and deliver a copy to the opponent, simultaneously. This period of one month may be extended by the Controller up to a maximum of three months.</p> <p>f. After receipt of counter statement and evidence from the applicant, the opponent may file his reply statement and evidence, by way of affidavits, within one month from the date of delivery of the registered proprietor's counter statement and evidence. Reply evidence of the opponent shall be strictly confined to matters in the evidence of the applicant. This period of one month may be extended by the Controller up to a maximum of three months. The opponent shall deliver a copy of his reply statement and evidence to the applicant, simultaneously.</p> <p>g. No further evidence shall be delivered by either party, except with the leave or direction of Controller.</p> <p>h. Where a document is in a language other than English and is referred to in any statement or evidence, an attested translation thereof in duplicate in English should be furnished.</p> <p>i. After completion of the filing of statement and evidence by the opponent and applicant, the Controller shall give at least ten days' notice of hearing to the parties.</p> <p>j. On receipt of the notice of hearing, if either party desires to be heard, a notice of intention to attend the hearing shall be filed in Form 20 along with the required fee.</p>	
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	<p>k. The Controller may refuse to hear any party which has not given such notice and fee.</p> <p>l. If either party intends to rely on any publication at the hearing, not already mentioned in the petition for cancellation, statement or evidence, he shall give to the other party and to the Controller a notice of his intention to do so, together with details of such publication. Such notice shall be given at least five days⁶ in advance.</p> <p>m. After hearing the parties, or if neither party desires to be heard, then without a hearing, the Controller shall decide the application for rectification and issue a speaking order. The decision of Controller shall be notified to the parties and shall be published in the Official Journal.</p>	
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CHAPTER 8

TRANSFER OF RIGHTS

08.01	Transfer of rights	
	<p>a. A person may become entitled to copyright in a registered design on account of assignment, transmission or operation of law.</p> <p>b. A person may also become entitled to any interest in a registered design on account of a mortgage, license or otherwise.</p> <p>c. The claimant, who becomes entitled to any such right, may file an application to register his title along with original or copies of the instrument, certified by the Notary Public.</p> <p>d. If the change in proprietorship is due to an assignment, the application shall be submitted in Form-11. If the change due to mortgage or license, the application shall be submitted in Form-12. In case of registration of notification of any document, the application shall be filed in Form-13.</p> <p>e. The Controller may ask for any other proof of title or written consent, to his satisfaction. If such document is a public document, an official or certified copy thereof may be presented.</p> <p>f. In any case, the document, creating the right in favour of a person other than a registered proprietor, shall be in writing and the agreement between the parties concerned shall be reduced to the form of an instrument embodying all the terms and conditions governing their rights and obligations. Any contravention of this requirement will render the instrument invalid.</p>	<p>Section 30</p> <p>Rule 32, 33, 34, 35, 36, 37</p> <p>Form 10, 11, 12, 13</p>

	<ul style="list-style-type: none">g. An application for registration of title shall be filed within six months from the date of execution of the instrument. This period is extendable by a maximum of six months.h. Upon entry of its particulars in the register of designs, the instrument shall be effective from the date of its execution.i. The person registered as a proprietor shall have absolute power to deal with the design as far as assignments and licences etc. are concerned.j. An instrument, which has not been registered, shall not ordinarily be admissible in any Court as proof of title to copyright in a design or to any interest therein.	
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CHAPTER 9

GENERAL SERVICES

09.01	The Designs Wing of the Patent Office, Kolkata provides certain services to the interested public for dissemination of information relating to registered designs.	
09.02	Information as to existence of copyright	
	<p>a. Any person may request for information regarding the existence of registration in respect of a design.</p> <p>b. Such a request shall be filed in Form-6 and shall contain the registration number of the design for which information is sought. If any registration in design exists, in accordance with the information provided by such person, the Controller shall provide the information relating to classes of articles in which the registration exists, date of registration, name and address of the registered proprietor.</p> <p>c. If the applicant is unable to furnish the registration number of the design, the request shall be filed in Form-7 with the required, along with such information as may enable the Controller to identify the design. As far as possible, search shall be conducted based on the information supplied, in the indicated class of articles. Information retrieved, based on the information received from the applicant, shall be furnished to the applicant.</p> <p>d. Applications in Form-6 & 7 shall be disposed off by the Controller within a week from the receipt of such application.</p>	<p>Section 18</p> <p>Rule 28</p> <p>Form 6</p> <p>Form 7</p>
09.03	Certified copies	
	Any person may apply for certified copies of the following documents in Form-15 or 16, as the case may be, along with the required fee:	<p>Section 17, 26, 38, 39</p> <p>Rule 41</p>

	<p>a. any registered design;</p> <p>b. an entry in the Register of Design,</p> <p>c. extracts from disclaimers, affidavits, declarations, and</p> <p>d. other public documents in the Office, or from Register and other records.</p> <p>Such certified copies shall be furnished by the Controller within a week of receipt of the request.</p> <p>Certified copies under the hand of the Controller and sealed with the seal of the Patent Office are admissible in evidence in all Courts in India, without further proof or production of the originals.</p> <p>However, in rare cases, if the Court has reason to doubt the accuracy or authenticity of the copies tendered in evidence, the Court may require the production of originals or such further proof as it considers necessary.</p>	Form-15, 16
09.04	Inspection of registered design and register of designs	
	<p>a. When a design is registered, during the existence of the copyright, any person may make a request to the Controller for inspection of the design by filing an application in Form-5 along with the required fee.</p> <p>b. Where an application for a design has been abandoned or refused, any document related to such application is not open to public inspection.</p> <p>c. The register of designs maintained at Patent Office, Kolkata is open to inspection on payment of required fee.</p> <p>d. Inspection shall be allowed by the Controller as far as possible on the same day, if the applicant is present. If the request is received by post, an earliest date for inspection may be fixed and communicated to the applicant at the earliest.</p>	Section 17(1), 26 Form-5
09.05	Alteration of address	
	A proprietor of a registered design may make a request in	Rule 31

	Form 22 to the Controller for alteration of his name, or address, or addresses for service, in the Register of Design. The Controller may require such proof of alteration so requested as he may think fit before acting on the request and on satisfaction, the Controller shall cause the Register to be altered accordingly.	Form 22
09.06	Duplicate certificate	
	<p>a. The Controller may, in case of loss of the original certificate, or any other case in which he deems it expedient, furnish one or more copies of the certificate to the proprietor.</p> <p>b. If the certificate is lost or in any other case, an affidavit from the proprietor shall be sufficient for issue of a duplicate certificate.</p>	Section 9

CHAPTER 10
USE & ACQUISITION OF
REGISTERED DESIGN BY GOVERNMENT

10.01	A registered design shall have to all intents the like effect as against the Government as it has against any person. However, as in the case of Patents, the Central Government has the power to use a registered design for purposes of Government and to acquire a registered design for public purpose.	Section 20 Chapter XVII of The Patents Act, 1970.
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CHAPTER 11

GENERAL POWERS OF CONTROLLER

11.01	Powers of a Civil Court	
	<p>In any proceedings before the Controller under this Act, the Controller has the powers of a civil court for the purpose of:</p> <ol style="list-style-type: none"> a. receiving evidence; b. administering oaths; c. enforcing the attendance of witnesses; d. proceedings compelling the discovery and production of documents; e. issuing commissions for the examining of witnesses; and f. awarding costs, such award being executable as a decree of a Civil Court. 	Section 32
11.02	Awarding costs	
	<p>In all proceedings before the Controller, the Controller may award such costs as he considers reasonable, having regard to all circumstances of the case. However, the maximum amount that can be awarded by the Controller as cost, in respect to a matter given in Fourth Schedule, shall not exceed the amount mentioned therein.</p>	Section 32 Rule 43 Fourth Schedule
11.03	Power to seek directions of the Central Govt.	
	<p>When Controller has doubt or difficulty in the administration of any of the provisions of this Act, he may seek the directions of Central Government in the matter.</p>	Section 34
11.04	Exercise of discretionary power by Controller	
	<ol style="list-style-type: none"> a. Before acting adverse to any party, the Controller shall give an opportunity of being heard to the party with at least ten days notice. b. The discretionary powers shall be exercised 	Section 33 Rule 44

	<p>judiciously with due care and caution and not in an arbitrary manner.</p> <p>c. Reasons for any adverse decision shall be recorded in the file by the Controller.</p>	
11.05	Power of Controller to correct clerical errors	
	On a request made in Form-14 along with the required fee, the Controller may correct any clerical error in the representation of a design or in the name or address of the proprietor of any design, or in any other matter, which is entered upon the register of designs.	Section 29
11.06	Controller may require statements	
	Whether an applicant or agent desires to be heard or not, the Controller may at any time require him to submit a statement in writing within a specified time period, or to attend before him and make explanations with respect to such matters as the Controller may require.	Rule 45
11.07	General power of amendment	
	<p>a. Any document for the amendment of which, no special provision is made by the Act, may be amended, and any irregularity in procedure which, in the opinion of the Controller, may be obviated <u>without detriment to the interest of any person</u>, may be corrected if the Controller thinks fit, and upon such terms as he may direct.</p> <p>b. The applicant shall file a petition along with the required fee stating the amendment required and reasons therefor.</p> <p>c. While considering such petitions, only such an irregularity is allowed to be obviated which is without detriment to the interests of any person. Further, only such amendment for which there is no special provision in the Act and which may be made without detriment to the interests of any person are allowable.</p>	Rule 46

	<p>d. Ordinarily, a failure to act within prescribed time shall not be considered as an irregularity, capable of being obviated.</p> <p>e. If any amendment is required resulting from any mistake on part of the office, no fee shall be charged.</p>	
11.08	General power for extension of time	
	<p>a. The time prescribed by the rules for doing any act or taking any proceeding, for which no special provision is made thereunder, may be extended by the Controller, for a period not exceeding three months, if he thinks fit, and upon such terms as he may direct.</p> <p>b. The petition shall explain the circumstances requiring the extension of time and reasons therefor.</p> <p>c. Extension of time should be allowed only in cases where no special provision for extension of time has been prescribed in the Rules. Where a time limit is specified in the Act itself, no extension can be sought under this provision.</p>	Rule 47

CHAPTER 12

EVIDENCES ETC.

12.01	Evidences	
	<p>a. In any proceeding before the Controller, evidence shall be given by way of an affidavit, in the absence of directions to the contrary.</p> <p>b. The Controller may also take evidence through viva voce, in lieu of or in addition to affidavit or allow any party to be cross-examined on the contents of his affidavit.</p>	Section 37
12.02	Form of affidavits	
	<p>a. The affidavits under the Act and rules shall be with an appropriate heading indicating the matter; drawn in the first person; and divided into paragraphs consecutively numbered; each paragraph shall, as far as possible, be confined to one subject. Every affidavit shall state the description and true place of abode of the person making the same, shall bear the name and address of the person leaving it and shall state on whose behalf it is left.</p> <p>b. Affidavits shall be confined to such facts as the deponent is able of his own knowledge to prove, except on interlocutory applications, on which statements of his belief may be admitted, provided that the grounds thereof are stated.</p> <p>c. Affidavits shall be sworn to as follows :-</p> <p style="padding-left: 40px;">i. In India, before any court or person having by law authority to receive evidence, or before any officer empowered by such court or person as aforesaid to administer oaths or to take affidavits;</p>	Rule 42

	<p>ii. In any country or place outside India, – before a diplomatic or consular office, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of 1948) in such country or place or before a notary of the country or place, recognized by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952), or before a judge or magistrate of the country of place.</p> <p>d. The person before whom an affidavit is sworn shall state the date on which and the place where the same is sworn to and shall affix thereto his seal, if any, or the seal of the court if the affidavit is sworn to before the court or an officer empowered by that court and signed his name and state his designation and address at the end thereof.</p> <p>e. Any affidavit purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorized, in testimony of the affidavit having been sworn to before him, may be admitted by the Controller without proof the genuineness of the seal or signature, or of the official position of that person.</p> <p>f. Alterations and interlineations shall, before an affidavit is sworn to or affirmed be authenticated by the initials of the person before whom the affidavit is sworn to.</p> <p>g. Where the deponent is illiterate, blind or unacquainted with the language in which the affidavit is written, a certificate by the person before whom the affidavit is sworn to, to the effect that the affidavit was read, translated or explained in his presence to the deponent, and the deponent perfectly understood it</p>	
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	<p>and has signed the affidavit or affixed his mark in his presence, shall be attached at the end of the affidavit.</p> <p>h. Every affidavit filed before the Controller shall be duly stamped.</p>	
12.03	Evidences of documents in Patent Office	
	<p>Printed or written copies or extracts of documents in the Patent Office, certified by the Controller as, of or from registers and other books kept in the Patent Office are admissible as evidence in all courts in India without further proof for production of the originals. However, if the Court has reason to doubt the accuracy or authenticity of the copies tendered in evidence, the Court may require the production of the originals or such further proof as it considers necessary.</p>	Section 39
12.04	Certificate of Controller to be evidence	
	<p>A certificate purporting to be under the hand of the Controller as to entry, matter or thing which he is authorised by this Act, or any rules made there under to make or do, shall be prima-facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.</p>	Section 38
12.05	Annual report by the Controller	
	<p>1. The Controller of Designs prepares an annual report on activities of the Designs Wing. The Annual Report is placed by the Central Government before both the Houses of Parliament.</p> <p>2. The Annual Report contains information on:</p> <ol style="list-style-type: none"> a. brief about the activities during the year; b. Design Applications filed and registered; c. examination; d. cancellations; e. restoration; f. extension of copyrights; 	Section 45

	<p>g. requests for inspection of registered designs; h. certified copies; i. assignments; j. designs in force; k. revenue.</p> <p>Annual report is uploaded on the official website (www.ipindia.nic.in) after the same is placed before both Houses of the Parliament.</p>	
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CHAPTER 13

RESTRICTIVE CONDITIONS IN CONTRACTS ETC.

13.01	Avoidance of certain conditions in Contracts	
	<p>a. The Designs Act provides that the insertion of certain conditions in Contract etc., concerning an article having a registered design, is unlawful and such conditions are void. Accordingly, while entering into Contracts etc. the registered proprietor may avoid such conditions.</p> <p>b. It shall not be lawful to insert certain restrictive conditions in:</p> <ul style="list-style-type: none"> i. a Contract in relation to the sale or lease of an article; or ii. a Licence to manufacture or use an article; or iii. a licence to package the article; <p>in respect of which a design is registered; the effect of which may be:</p> <ul style="list-style-type: none"> i. to require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor or his nominees, or to prohibit him from acquiring or to restrict in any manner or to any extent his right to acquire from any person or to prohibit him from acquiring except from the vendor, lessor, or licensor or his nominees any article other than the article in respect of which a design is registered; or ii. to prohibit the purchaser, lessee or licensee from using or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee, to use an article other than the article in respect of which a design is registered which is not supplied by the vendor, lessor or 	

	licensor nor his nominee. c. and any such condition shall be void.	
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CHAPTER 14 APPEALS

14.01	Appeals	
	<p>a. An appeal lies to the High Court against an order passed by the Controller under the following provisions:</p> <ol style="list-style-type: none"> i. an order under Section 5, refusing registration of a design; ii. an order under Section 19, passed in a cancellation petition; iii. an order under Section 31, passed in a rectification petition; iv. an order under Section 35, refusing registration on the ground of public order or morality. <p>b. Every appeal shall be made within three months of the date of the order of the Controller. The date of such order is the date on which the order is dispatched.</p> <p>c. In calculating the said period of three months, the time taken in granting a copy of the order appealed against shall be excluded.</p> <p>d. The High Court may, if it thinks fit, obtain the assistance of an expert in deciding such appeals, and the decision of the High Court shall be final.</p>	Section 36
14.02	Jurisdiction	
	At present, as the Designs Wing of the Patent Office is functioning only at Patent Office, Kolkata, all the appeals under the Designs Act, 2000, lie to the High Court of Kolkata.	Decision of Hon'ble Supreme Court of India in Civil Appeal No. 996-997/2010

CHAPTER 15

REQUIREMENTS BEFORE DELIVERY ON SALES

15.01	General	
	Marking of an article before delivery on sale by a registered proprietor is very important for ensuring the protection of a registered design, as explained below.	
15.02	Marking of article before delivery on sales	
	<p>a. Before delivery on sale of any article with registered design, the registered proprietor shall mark such article with any of the following words:</p> <ol style="list-style-type: none"> i. REGISTERED; ii. REGD.; iii. RD, and iv. the registration number (Except in the case of articles soft or brittle in nature, to which have been applied designs registered in different classes of articles) <p>b. It is not necessary to mark the articles as required above in:</p> <ol style="list-style-type: none"> i. textile goods in which the design is printed or woven, other than handkerchiefs; and ii. articles made of charcoal dust, which are brittle and which are not sold in single piece <p>c. If the registered proprietor fails to mark an article, as required in (1), he shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design, unless he proves that he took all proper steps to ensure the marking of the article, or unless he proves that the infringement took place after the alleged infringer knew or had already received a notice of the existence of copyright in the</p>	Section 15, Rule 26

	<p>design.</p> <p>d. In respect to any class or description of articles, a trade or industry may represent to the Central Government that it is expedient to dispense with or modify the marking requirement as required above. The Central Government, may, if it thinks fit, dispense or modify such requirements through a rule made under the Act.</p>	
15.03	Requirements before delivery on sales	
	<p>a. Before delivery on sale of any articles to which a registered design has been applied and if exact representations (photographs) or specimens were not furnished on the application for registration, the proprietor shall furnish to the Controller the exact representations (photographs) or specimens of the design.</p> <p>b. If the registered proprietor fails to comply with the above condition, the Controller may, after giving notice to the registered proprietor and an opportunity of being heard, remove the name of the registered proprietor from the register. On such removal, the copyright in the design shall cease.</p>	Section 15

CHAPTER-16 TIMELINES

S.No.		Section/ Rules	Form	Prescribed time
01	Application for registration of Design claiming priority date under Paris Convention/WTO/reciprocity arrangement	Section 44(1)(a)	Form 1	Within 6 months from date of earliest filing in the country (s) under Paris convention/WTO.
02	Filing of certified copy of priority Document	Rule 15(2)	Form 18	Along with application or within 3 months from the date of filing.
03	Application for registration of assignment or of the instrument for change of ownership	Section 30(3)	Form 10	Within 6 month from the date of execution of assignment/instrument. Further extension of 6 months available.
04	Compliance of all requirements for making application in order for acceptance	Rule 18(1)	Form-18	Within 6 months extendable up to nine months from the date of filing.
05	Application for extension of period of copyright for 5 years	Section 11(2)	Form 3	Before the expiry of initial period of 10 years from the date of registration.
06	Application for restoration of lapsed design due to non payment of fee for extension of copyright	Section 12(2) Rule 24	Form 4	Within one year from date of cessation
07	Petition for cancellation of the registration	Rule 29	Form 8	Any time during existence of copyright
08	Appeal to High Court against the order of the Controller	Section 19(2), 36		Within three months the date of order of Controller.
09	Application for registration of design after first exhibiting the design	Section 21(b)		Within 6 months from the date of exhibition, provided that prior intimation was given to the Controller in Form 9.
10	Substitution of applicants before Registration	Section 8(1)	Form 2	Any time before the registration
11	Filling of original or paper copy where the corresponding document already sent by e-mail / Tele Fax	Rule 3(1)	-	Within 15 days from the date of Telefax / e-mail

12	Request for alteration of name, address and address for service in the Register of Designs	Rule 31	Form 2	At any time after registration
13	Extension of time as prescribed under the Rules	Rule 47		Up to three months and upon such terms as decided by the Controller.

ANNEXURE I

IMPORTANT CASE LAWS

Topic	Provision	Case Law
Article	Sec 2 (a)	<p><i>In Hindustan Lever Limited Vs Nirma Pvt. Ltd. Ahmedabad AIR 1992 Bom 195</i>, it was held that label put on a carton to be used as container for the goods can never amount to design within the meaning of section 2 (3) of the Designs Act, 1911.</p> <p><i>In Re Littlewoods Pools Ltd's Application (1949) 66 RPC 309</i> application was made to register a form of football coupon consisting of a rectangular sheet of paper on which a pattern was formed by straight lines, the spaces between were filled with literary matter. Wynn-Parry J in holding that the paper was not an article stated that as the function of the paper was –solely to carry the imprint of the design” and did not have any other function it was not an –article”, within the meaning of the act.</p> <p><u>Explanation:</u> It would appear to follow that paper or canvass could be considered an article. However, to be registrable an article must have some function other than that of merely carrying the design. A drawing or painting on ordinary paper or canvas are not the same as wallpaper or wrapping paper or textiles.</p> <p>The paper used for printing or canvas used for painting have no function other than to carry the printing or painting. Therefore, they are unregistrable.</p> <p>The wallpaper, wrapping paper or textiles all perform a function other than just being a vehicle for</p>

		<p>the design. For example the wallpaper is used for sticking on the wall to either enhance the décor of a room or for the more practical purpose of covering cracks or faults in the wall surface. Textile material is used for making up a variety of articles e.g. curtains, clothing, bed linen etc. This factor makes these registrable articles.</p> <p><i>In King Features Syndicate Inc. & Betts V O & M Kleeman Ltd. (1941) 48 RPC 207 at 222</i>, where comic strip drawings of “Popeye the Sailor” were held not to be themselves design capable of registration under the act although when the features of shape and configuration depicted in the drawings were applied by industrial process to dolls and brooches a registrable design came into existence.</p> <p>A design which can not be repeated is not registrable. Thus an ornament made on an article of natural rock and when it would be difficult to get a multiple same varieties of natural rocks is not a proper subject for design registration.</p>
Part of Article	Sec 2 (a)	<p>In <i>The Sifam Electrical Instrument Co Ltd V Sangamo Weston Ltd.</i> [1973 RPC 899 at 909] it was submitted in this case that the proper interpretation was “susceptible of being sold separately”, but the court held that it was the actual intention at the time of registration that was important. The article in question, a face for an electric meter, was found not to be registrable, and Graham J observed —“... I find the matter difficult to decide, but on the whole I think the intention must be to grant registration only for such articles as are intended by the proprietor of the design to be put on the market and sold separately, such as for example a hammer handle.....”</p>

	<p><u>Explanation</u> : The inclusion in the definition of article –any part of an article capable of being made under sold separately” is to prevent the registration of a part of an article which has no separate identity and which is really an integral part of an article, for example the shape of a portion of a chair leg which is really an integral portion of the chair. The design of a part of an article is not registrable as a design unless the part is made and sold separately as an article.</p> <p>The primary object the Act is to protect shape and not the function or functional shape. The expression design doesn't include a method or principle of construction or features of shape or configuration which is dictated solely by the function which the article to be made in that shape or configuration has to perform. . In addition to the industrial drawing of the entire crane, the plaintiff also claimed copyright in the following key components (i) the boom and slider assembly, (ii) the lower structure assembly, (iii) the main frame – axle assembly, (iv) the differential housing etc. The Delhi High Court observed that the aforesaid parts of the crane are made in a particular shape so as to interrelate with others mechanically. These parts of the crane are not made to appeal to the eye but solely to make the crane work or function. Most of the key components or parts, unseen in the crane for which are they are required, had only to pass the test of being able to perform their function. They would be judged by performance and not by appearance. Consequently the aforesaid key components or parts are incapable of being registered as designs. [Escorts construction Equipment Ltd. Vs Action construction Equipment Pvt. Ltd 1999</p>
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		<p>PTC 36(Del) at pp 39,40,48].</p> <p>AIR2008Bom11 Held, phrase, “capable of being made and sold separately” used in Section 2(a) covers cases not only of an article upon which a design article can be made but also can be sold separately - Therefore, such article which is separate from other parts of goods and registered separately as a design, if intended and or desired by the proprietor of the registered article, as capable of being made and sold, is saleable in the market separately - Only because such article in present circumstances may not be put up in the market for sale separately, it is not correct to say that the cap involved in the present case, cannot be said to have an independent life as an article of commerce - Therefore, cap is an article within the ambit of definition of “an article” under Section 2(1) of the Designs Act.</p>
Set of article	Rule 2 (e)	<p>A set of articles can be: -</p> <ul style="list-style-type: none"> (i) a set of articles; (ii) each article in the set; or (iii) both a set of articles and each article in that set, as the case requires <p>If a group of articles meets the requirements of a “set”, they can be registered under one application. For a group of articles to be a set all three of the criteria in the definition of “set” must be met.</p> <p>These are:-</p> <ul style="list-style-type: none"> (i) ordinarily on sale or intended to be used together (ii) commonality of design (bearing the same design) (iii) same general character

<p>Design and provisions of the Copyright Act 1957</p>	<p>Section 2 (d) [The Designs Act 2000] Section 15 [The copyright Act 1957]</p>	<p>High Court of Delhi in the case of Microfibers Inc. vs. Girdhar and Co. and Anr. Had observed on the following guidelines:</p> <ol style="list-style-type: none"> a. The definition of artistic work has a very wide connotation as it is not circumscribed by any limitation of the work possessing any artistic quality. Even an abstract work, such as a few lines or curves arbitrarily drawn would qualify as an artistic work. It may be two dimensional or three dimensional. The artistic work may or may not have visual appeal. b. The rights to which a holder of an original artistic work is entitled are enumerated in Section 14(c) of the Copyright act. c. It is the exclusive right of the holder of a Copyright in an original artistic work to reproduce the work in any material form. For example, a drawing of an imaginary futuristic automobile, which is an original artistic work, may be reproduced in the three-dimensional material form using an element, such as a metal sheet. d. The design protection in case of registered works under the Designs Act cannot be extended to include the copyright protection to the works which were industrially produced. e. A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher protection to pure original artistic works such as paintings, sculptures etc and lesser protection to design activity which is commercial
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		<p>in nature. The legislative intent is, thus, clear that the protection accorded to a work which is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure Article</p> <p>f. The original paintings/artistic works which may be used to industrially produce the designed article would continue to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and would be entitled to the full period of copyright protection as evident from the definition of the design under Section 2(d) of the Designs Act. However, the intention of producing the artistic work is not relevant.</p> <p>g. This is precisely why the legislature not only limited the protection by mandating that the copyright shall cease under the Copyright Act in a registered design but in addition, also deprived copyright protection to designs capable of being registered under the Designs Act, but not so registered, as soon as the concerned design had been applied more than 50 times by industrial process by the owner of the copyright or his licensee.</p> <p>h. In the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work per se.</p> <p>i. If the design is registered under the Designs Act, the design would lose its copyright protection under the Copyright Act. If it is a design registrable under the Designs Act but has not so been registered, the design would continue to</p>
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		<p>enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process for more than 50 times is reached. But once that limit is crossed, it would lose its copyright protection under the Copyright Act. This interpretation would harmonize the Copyright and the Designs Act in accordance with the legislative intent.</p>
<p>Mere mechanical device</p>	<p>Section 2 (d)</p>	<p>Mere Mechanical contrivance does not qualify for design registration.</p> <p><i>In the matter of Glaxo Smithkline CH GmbH & Co. v. Anchor Health & Beautycare P. ltd. 2004 (29) PTC 72 (Del)</i> the subject design pertained to design of tooth brush. The purported novelty resided in the zig zag S bend of the tooth brush. The court was of the view that zig zag S bend was a utilitarian and functional part, regarding which the plain tips had even obtained a patent on the ground that the zig zag S bend introduces mere flexibility in the tooth brush. By merely putting rubber cushion in the gaps these part does not become a design so as to preclude others from using it. This rubber cushions may enhance the flexibility and as such as utilitarian components. The handle also is a utilitarian part and introduction of certain patches thereon does not introduce any design therein.</p> <p>—A mere mechanical device is a shape in which all the features are dictated solely by the function or functions which the article has to be performed.....”<i>Kestos Ltd. v. Kempat Ltd. & Kemp. (1936) 53 RPC 139.</i></p>

		<p>—In cases where the designer has no option but to design an article in a particular shape because of the function it has to perform. If the function required the article to be made in one shape only, then and only then where its features dictated by solely by function” RPC 103, 1972.</p> <p>However if the design is not an essentially a mechanical contrivance but also meets the criterion for registration apart from its functionality, it may qualify for registration. In Cow & Co. Ltd. v. Cannon Rubber Manufacturers, Ltd. (1959) RPC 240,347. The design at issue was diagonal arrangement of ribs on a hot water bottle. The defendant pleaded that the simplest and most economical way to form the rib was to form them diagonally and hence it should not be registrable. The court observed —Think that in fact that it is functionally useful but I am not satisfied for my self that the defendants proved that it was that object and that object alone which dictated the adoption of this type ribbing”.</p>
<p>—judged solely by eye;</p>	<p>Section 2 (d)</p>	<p>Explanation: Section 2(d) contains a positive requirement for registrability: there must be features which —in the finished article appeal to and are judged solely by the eye‘.</p> <p>Designs apply to nothing but that which the eye can tell entirely. Nothing in my opinion is a good design but that of which full knowledge is given when you once shown to the eye what your design is. It may be shape or configuration, that is given by a specimen or paper drawing, and the eye can see it and the eye can recognize whether it has been imitated”. 24 RPC 65 Pages 74,77 and 80</p>

	<p>In the first place then, the eye to which the appeal must be made and the eye which is to judge is not the eye of the court but the eye of the customer. The purpose of the Act is to preserve the owner of the design the commercial value resulting from the customers preferring the appearance of the article, which have the design to those, which do not have it. The design will therefore be calculated to attract the attention of the beholder regardless of whether or not it makes a favourable appeal to him. (<i>Amp. V. Utilux (1972) RPC 103 pp107</i>).</p> <p>the requirement of appealing to the eye is therefore really a preliminary test of novelty, as compared to the fundamental form of the article”.(<i>Amp. V. Utilux (1972) RPC 103, pp 107</i>).</p> <p><u>Test of “ influencing customer preference”</u></p> <p>In considering eye appeal, Amp [note : see (<i>Amp. V. Utilux (1972) RPC 103 pp107</i>)] devised the important test of ‘_influencing customer preference’. In other words, whatever ‘_appeal’ might mean, it is the eye of the customer not the court which is the judge. The real importance of this is not so much the reference to the customer but rather the fact that the court itself can not properly assess the matter without assistance. Thus, faced with evidence that a design does not have eye appeal, eg because it was devised with functional intent, evidence confirming that the design is attractive to the appropriate person will be needed to support registrability. The appropriate person would normally be the customer (whether a purchasing member of the general public or a manufacturer), although it could also be a consumer.” [<i>Benchairs Ltd. v Chair Centre Ltd. (1974) RPC 429 and Kevi A/S v Suspa-Verein</i></p>
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		<p><i>UK Ltd. (1982) RPC 173].</i></p> <p>Test of Noticability: Eye appeal essentially consist notice ability.</p> <p><i>In Ferrero and CspA’s application (1978 RPC 473, HL)</i> the design at issue was an inner layer of a chocolate, which formed an essential part of the design. The design was upheld and the court observed –I think it is fairly plain that the underlying reason was that the design feature was present all the time, even though it only becomes apparent when the article, that is to say the egg, was being used for its purpose, when it had been broken so that it could be eaten”.</p> <p>Explanation: Design features which are internal but visible only during use, may be subject matter of registration. For example, features of an open able/sliding cell phone and internal arrangement of chambers /trays in a refrigerator may be given along with the closed views of the article.</p>
Exclusion of trade mark from registrability	Section 2 (d)	<p>Under Section 2 (5) of the 1911 Act, it was held –A design or pattern covers the whole body or the goods and forms part and parcel or the goods but a trade mark is apart from and different from the goods for denoting the goods to be the manufacture or merchandise of a particular person. The copying of a design cannot, therefore, be treated as counterfeiting a trade mark”. <i>Narumal Khemchand v. The Bombay Co., Ltd., (1914), 25 Ind. Cas. 998.</i></p> <p>In another case it was held –The shape of an article con not be regarded as its trade mark. The shape comes within the definition of a –design” as given in section 2(5) of the Indian Patents and Designs Act. Any infringement of copyright in the shape should, therefore, be dealt with under the Indian Patents and</p>

		<p>Designs Act and not under the Criminal Procedure Code”. <i>Bhagirathi Marwari v. Bukshi Ram Sharma and Ors. Court of the Sub-Divisional Magistrate, Jamshedpur (1932). Re. Design NO.14103.</i></p> <p><i>In Ampro Food Products Vs Ashok Biscuit works and Others AIR 1973 AP 71</i>, It was held that _ a design is different from a trade mark. A design is necessarily part and parcel of the article manufactured while a trade mark is not necessarily so. Design does not include trade mark.</p>
Property Mark	Section 2 (d)	<p>Explanation :</p> <p>Property marks as defined in Section 479 of the Indian Penal Code which reads as follows: -</p> <p><i>Section 479:</i> A mark used for denoting that moveable property belongs to a particular person is called a property mark.</p> <p>For example, the mark used by the Indian Railways on their goods may be termed as Property Mark for the purpose of easy identification of the owner.</p>
Representation	Rule 14	<p><i>Pugh v. Riley 1912 RPC 196</i> which emphasizes the fact that a design necessarily requires something in the nature of a drawing or tracing:</p> <p>A design to be registrable under the Act must be some conception or suggestion as to shape, configuration, pattern, or ornament. It must be capable of being applied to an article in such a way that the article, to which it has been applied, will show to the eye the particular shape, configuration, pattern or ornament, the conception or suggestion of which constitutes the design. In general, any application for registration must be accompanied by a representation of the</p>

		design; that is, something in the nature of a drawing or tracing, by means of which the conception or suggestion constituting the design may be imparted to others. In fact, persons looking at the drawing ought to be able to form a mental picture of the shape, configuration, pattern, or ornament of the article to which the design has been applied.
High Court	Section 2 (e)	High Court shall have the same meaning as assigned to it in clause (i) of section 2 of the Patents Act, 1970. <i>In the Civil Appeal No. 996-997/2010, M/s Godrej Sara Lee Limited Vs Reckitt Benckiser Australia,</i> Supreme Court Of India held that High Court for appeal is High Court of Kolkata.
Proprietor of a design	Section 2 (j)	It was also held that to “acquire” a design within the meaning of section 2(14) (b) of the Designs Act, 1911 means to obtain a transfer of the proprietary rights in the design and not merely to learn the design. [<i>Mohd. Abdul Karim v. Mohd. Yasin and Anr. Allahabad High Court (1934) Re. Design No.43516</i>]. A person who made a sketch of a design for woven goods which he wished to have worked out and passed it on to a weaver without any particular instruction as to the working out of it, was held not to be the author of the design. [<i>(1933) 50 RPC 240</i>] If there are two persons each of whom has produced a similar design and each has communicated the fact of such authorship to the other, neither of them alone is the proprietor of a new or original design and neither of them can validly register it. [<i>(1935) 52 RPC 7</i>] <i>In Pressler V Gartside (1933) 50 RPC 240</i> the managing director of the plaintiff made an ink sketch of a design which he wished to have worked out and applied to woven goods and gave to a weaver to

		<p>produce the cloth in accordance with the design. With no further instruction the weaver produced some cloth which was satisfactory to the plaintiff. The weaver was not given any particular instructions with regard to any particular way in which the sketch was to be worked out. It was found on evidence that on the basis of the sketch and instructions given, the weaver might have produced a number of different designs. It was held that the managing director was not the author of the design in question entitled to be registered as proprietor of the design.</p>
New or original	Section 4 (a)	<p><i>In the matter of M/s Brighto AutoIndustries Vs Shri Raj Chawla (ILR 1978 (I) Delhi)</i> it was held by the Honorable Court —‘new’ is taken generally to mean as different to what has gone before and original as something originating from the author. In the matter of novelty the eye has to be the ultimate arbiter and the determination has to rest on the general ocular impression. To secure recognition for its newness or originality it is imperative that a design identical with or even materially similar to the relevant design should not have been published or registered previously. A slight trivial or infinitesimal variation from a pre-existing design will not qualify it for registration taking into account the nature involved the change introduced should be substantial. It is not necessary to justify registration that the whole of the design should be new, the newness may be confined to only a part of it but that part must be a significant one and it should be potent enough to impart to the whole design a distinct identity, unless the registration sought for the said part alone”.</p>

		<p>Further it was held that it is the duty of the court to take special care that no design shall be counted new or original, unless it is distinct from what previously existed by something essentially new or original which is different from ordinary trade variants, which may have lost, been common matters of test or choice in that trade.</p>
		<p><i>In the matter of Gammeter Vs Controller of Patents and Others (AIR 1919 Calcutta 887)</i> it was held –the design should be protected provided it was not merely an analogues and the test of novelty is the eye of the judge who must place the two designs side by side whether the one for which novelty is claimed is new”</p>
		<p><i>In the matter of Glaxo Smithkline Consumer Healthcare Gmbh & Co. KG Vs Amigo Brushes (2004 (28) PTC I Del)</i>; the court has quoted M/s B Chawla & Sons Vs M/s Bright Auto Industries ((supra) wherein it was held that in respect of a mirror claimed to be a new and or original design that addition in the shape of a mirror which were available in the market did not constitute a mirror new or original in design. It was observed that addition of a curve here or there in a shape which is well-recognized shape of an article of common use in the market cannot make it an article new or original in design. It was further observed that where the rear view mirrors available in market were rectangular in shape with rounded edges; width sides curved or sloping and the appellant who had registered his design of mirror under the Act by adding a further curve in such shape claimed his design as new and original; without endorsing the extent and nature of novelty in design;</p>

		<p>on application for cancellation of registration by respondent it was held that design made by the appellant was devoid of newness and equally devoid of originality.</p> <p>In the matter of Glaxo Smithkline Consumer Healthcare Gmbh & Co. KG Vs Amigo Brushes (2004 (28) PTC I Del); the court has quoted Hello Mineral Water Pvt Ltd Vs Thermoking California Pure, 2000 PTC 177, it was held that mere novelty of form or shape is insufficient. Novelty involves the presence of some element or new position of an old element in combination, different from anything found in any prior structure.</p> <p>Hon’ble Supreme Court of India in Supreme Court Of India in Civil Appeal No. 3185 of 2008 (Arising out of S.L.P. (C) No. 16321 of 2006) has held that expression, “new or original” appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public and that it had been invented for the first time or it has not been reproduced by anyone — Burden was on the Complainant to show that the design was not original or new — Said burden not discharged by the Complainant as it only tried to prove on the basis of the letter of the German company that they produced the rollers and sold in market but it was nowhere mentioned that these rollers have been reproduced on the glass sheets by the German company or by any other company — Even though the proprietary right was acquired from the German company, design which is to be reproduced on glass has been registered for the first time in India and therefore is a new and original design.</p>
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Publication	Section 4 (b)	<p><i>In the matter of Rotela Auto Components (P) Ltd Vs Jaspal Singh reported in 2002(24)PTC449(Del)</i>, it was held by the court in Para 21 —.....word ‘published’ used in section 19 or under section 4 of the Designs Act has not been defined under the Designs Act‘2000. It is published if a design is no longer a secret. There is publication if the design has been disclosed to the public or public has been put in possession of the design. Russell Clarke in Copyright in Industrial Design, 4th edition, pages 41-42 says that</p> <p>.....it is sufficient, and there will be publication if the knowledge was either</p> <ol style="list-style-type: none"> 1. Available to the member of the public; or 2. Actually in fact shown and disclosed to some individual member of the public who was under no obligation to keep it secret. <p>It is not necessary design should have been actually used. There will just as much be publication if it is shown that it was known to the public without ever having been actually put into use. Thus, publication may be of two types:</p> <ol style="list-style-type: none"> a) Publication in prior documents, b) Publication by prior user.” <p><i>In the matter of Gopal Glass Works Ltd Vs Asstt. Controller of Patents and Designs [2006(33) PTC434 (Cal)]</i>, it was held by the court that to constitute prior disclosure by publication to destroy the novelty of the registered design, the publication would have to be intangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine, or news paper containing photographs or explicit picture illustrations that clearly depict the application of the design on the</p>
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		<p>same article with the same visual effect would be sufficient.</p> <p><i>In the matter of Venus Industries Vs Magppie Expots reported in 2003(26) PTC312 (PO)</i> the Controller held that While there is not given any specific definition of publication in the Designs Act‘2000 as well as in the old Designs Act‘1911, any design, which has been made available to any person in India who is free to use or disclose it, is treated as published.</p> <p><i>In the matter of Glaxo Smithkline Consumer Healthcare Gmbh & Co. KG Vs Anchor Health and Beauty Care Pvt Ltd,[2004(29)PTC 72 (Del)]</i>, the court held thatIt is true that even a small inventive step may create a new design but in the case in hand the three improvements in the earlier design as pointed out by the learned counsel for the Plaintiffs are neither inventive nor introduced new features in the design..... Only by introducing few insignificant changes, the Plaintiffs have succeeded in getting new design registered which are already in public domain.</p>
Publication and effect of disclosure	Section 4 & 16	2000(20) PTC 96 held under the Designs Act 1911, that a disclosure of a design by the proprietor to any other person in good faith is not deemed to be a publication of design sufficient to invalidate the copyrights thereof if the registration is obtained subsequently to the disclosure. The other person to whom the design has been disclosed if acts in contrary to good faith in which the design was disclosed to him and uses such design or publishes such design, such user and publication of design by the other person other than the proprietor of the design by legal fiction under Section 49 is not deemed to be a publication of the design sufficient to invalidate copyrights. Section

		<p>49 thus preserves and protects the proprietor's registration in the circumstances, when the disclosure of design is made by the proprietor to any other person in good faith. The expression "disclosure" used in section 49 when seen in the light of the facts of the present case, it would be noticed that the 1st Plaintiff has sold the chairs of design in question prior to its registration as a commercial proposition. Such sale by the 1st Plaintiff to the 2nd Plaintiff of the chairs having the design in question prior to its registration or for that matter prior to the application for registration, in the facts and circumstances of the case and material placed on record, obviously would not be covered under Section 49 of the Act.</p>
<p>Significantly Distinguishable from Known Designs</p>	<p>Section 4(c)</p>	<p><i>In the matter of Phillips V Harbro Rubber Co. (1919)36RPC 79 at P 85(CA)</i> clearly indicates that it is not open to a manufacturer to bring one or more important leading features of different articles already present in a market and by registering a design incorporating merely a combination <i>without any mental activity</i> by application of mind for its production and acquire registration of design. The manufacturers who are already manufacturing those products shall be under pressure of carrying out the business for unduly registration made and be a subject of monopoly. It would be an oppressive if any mere change in the outline or pattern of such an article would justify the registration of design. It will not only hamper the business activity at large but also preclude others for making such article.</p>

		<p><i>In the matter of Clark's Registered Design (1896) 13 RPC 351 at page 362, (Lopes LJ),</i> it is however established law that a new combination of two or more old features may constitute a good subject matter of valid registration; but it is to be seen that the combination must not be obvious and must result in something creative that is new or original as a whole in respect of ornament, pattern shape or configuration</p>
Repeal & saving provision	Section 48	<p>In the matter of Faber Castell Aktiengesellschaft Vs Pikpen(P) Ltd reported in 2003 (27) PTC 538(Bom), it was held that as regards registration, etc.. done under the old Act, subsection (2) of section 48 of the 2000 Act clearly lays down that it shall continue to be in force and have effect as if done under the corresponding provisions of the new Act. This means that registration of the design must continue in force and have effect as things done under section 4 of the Act. It is, therefore, clear that the intention of the parliament is that all things done under the old act can only be continued to be in force and have effect as if made under the corresponding provision of the new Act. The only exception made in section 48 is provided in subsection (4) which provides that any proceedings pending in any court at the commencement of the new Act may be continued in that court as if the new Act has not been passed. It is therefore clear that parliament intended that all things done under the old act, after the enactment of the new Act be governed only by the new Act, the old Act being completely repealed.</p> <p>The question of registration and cancellation of registration must be decided under the new Act. Therefore, also the question whether and to the extent</p>

	<p>to which it can be used as a ground of defence in a suit for injunction will also have to be decided with reference to the new Act.</p> <p>In the matter of IAG Company Ltd Vs Triveni Glass Ltd reported in 2005(30)PTC (Cal) (DB) wherein it is held that it is no doubt true that under subsection (2) of section 48 of the new Act, the registration of the Appellant is saved. But the said registration shall continue in force and have effect as if it has been issued under the corresponding provisions of the new Act.</p> <p>Once the new Act has come into force, the registration given under the old Act will continue in force as if given under the new Act. The obvious consequence is that such registration is subject to same grounds of cancellation, which are provided under section 19 (1) of the new Act. This is the obvious interpretation of section 48 (2). So, even though the registration certificate is saved, but , its continuance is subject to the grounds of cancellation provided under the new Act. The grounds of cancellation under the new Act are substantially wider and more comprehensive than those provided under the old Act.</p> <p>Subsection (4) of section 48 of the new Act says that if any proceeding is pending in any court at the commencement of the new Act, the same may continue in that court As if the new Act has not been passed. In the instant case, the suit was filed before the Calcutta High Court in the month of July‘2001and the new Act came into force in the month of May‘2000. As such, the said suit was filed about one year three month after the new Act has come into force and cannot be considered a pending proceeding under</p>
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		subsection (4) of section 48 of the new Act. This is the plain interpretation immerges on a plain reading of section 48(4) of the new Act in as much as the language of section 48(4) is very clear and admits of no ambiguity.....”
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ANNEXURE-II

SPECIMEN NOVELTY STATEMENTS & DISCLAIMERS IN REPRESENTATION SHEET

Novelty Statements	<p>a. The novelty resides in the shape of the ash-tray as illustrated.</p> <p>b. The novelty resides in the shape or configuration in the bookshelf as illustrated.</p> <p>c. The novelty resides in the groove (A) and projection (B) as illustrated.</p> <p>d. The novelty resides in the ornamental surface pattern of the football as illustrated.</p> <p>e. Novelty is claimed for the floral ornamentation of tea-pot as illustrated.</p> <p>Note: There is no need to highlight or pin-point any portion of the representation as novel, as novelty of the design resides in the article taken as a whole.</p>
Disclaimers	<p>a. 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>b. No claim is made by virtue of this registration to any right to the exclusive use of trade marks, words or letters and numerals appearing in the design of the article.</p> <p>c. No claim is made by virtue of this registration to any right to the exclusive use of colour or colour combination appearing in the design of the article.</p> <p>d. No claim is made by virtue of this registration to any right to the exclusive use of any extraneous matter like xxxxxxxxx etc. appearing in the representation sheets.</p>

Specimen of Representation Sheet

Name.....



Total sheet....

Sheet No.....

Perspective View

The novelty resides in the shape & configuration of the TEA POT' as illustrated.

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 this registration to any right to the exclusive use of the words, letters, numbers, or trade marks appearing in the representation.

Dated:

Signature of the applicant/agent
(Name of the Signatory)