

FREQUENTLY ASKED QUESTIONS: DESIGN

Q: What is meant by 'Design' under the Designs Act, 2000?

A: 'Design' means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether 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 or construction or anything which is in substance a mere mechanical device, and does not include any trade mark, as define in clause (v) of sub-section of Section 2 of the Trade and Merchandise Marks Act, 1958, property mark or artistic works as defined under Section 2(c) of the Copyright Act, 1957.

Q: What is meant by an article under the Designs Act, 2000?

A: Under the Designs Act, 2000 the "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

Q: What is the object of registration of Designs?

A: Object of the Designs Act is to protect new or original designs so created to be applied or applicable to particular article to be manufactured by Industrial Process or means. Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. The important purpose of design Registration is to see that the artisan, creator, originator of a design having aesthetic look is not deprived of his bonafide reward by others applying it to their goods.

Q: Can stamps, Labels, tokens, cards be considered an article for the purpose of registration of Design?

A: No. Because once the alleged Design i.e., ornamentation is removed only a piece of paper, metal or like material remains and the article referred ceases to exist. Article must have its existence independent of the Designs applied to it. [Design with respect to label was held not registrable, by an Order on civil original case No. 9-D of 1963, Punjab,

High Court]. So, the Design as applied to an article should be integral with the article itself.

Q: When does the Applicant for Registration of Design get the registration certificate?

A: When an application for registration of a Design is in order, it is accepted and registered and then a certificate of registration is issued to the applicant. However, a separate request should be made to the Controller for obtaining a certified copy of the certificate for legal proceeding with requisite fee.

Q: What is a Register of Designs?

A: The Register of Designs is a document maintained by The Patent Office, Kolkata as a statutory requirement. It contains the design number, class number, date of filing (in this country) and reciprocity date (if any), name and address of Proprietor and such other matters as would affect the validity of proprietorship of the design and it is open for public inspection on payment of prescribed fee & extract from register may also be obtained on request with the prescribed fee.

Q: What is the effect of registration of design?

A: The registration of a design confers upon the registered proprietor 'Copyright' in the design for the period of registration. 'Copyright' means the exclusive right to apply a design to the article belonging to the class in which it is registered.

Q: What is the duration of the registration of a design? Can it be extended?

A: The duration of the registration of a design is initially ten years from the date of registration, but in cases where claim to priority has been allowed the duration is ten years from the priority date. This initial period of registration may be extended by further period of 5 years on an application made in Form-3 accompanied by prescribed fees to the Controller before the expiry of the said initial period of ten years. The proprietor of a design may make application for such extension even as soon as the design is registered.

Q: What is the date of registration?

A: The date of registration except in case of priority is the actual date of filing of the application. In case of registration of design with priority, the date of registration is the date of making an application in the reciprocal country.

Q: Is it possible to re-register a design in respect of which Copyright has expired?

A: No. A registered design, the copyright of which has expired cannot be re-registered.

Q: How one can ascertain whether registration subsists in respect of any design?

A: For ascertaining whether registration subsists in respect of a design, a request should be made to the Patent Office, Kolkata. If the Design number is known, the request should be made on Form 6, otherwise on Form 7, together with prescribed fees. Each such request should be confined to information in respect of a single design.

Q: What is piracy of a Design?

A: Piracy of a design means the application of a design or its imitation to any article belonging to class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor. Publishing such articles or exposing terms for sale with knowledge of the unauthorized application of the design to them also involves piracy of the design.

Q: What is the penalty for the piracy of a registered Design?

A: If anyone contravenes the copyright in a design he is liable for every offence to pay a sum not exceeding Rs. 25,000/- to the registered proprietor subject to a maximum of Rs. 50,000/- recoverable as contract debt in respect of any one design. The registered proprietor may bring a suit for the recovery of the damages for any such contravention and for injunction against repetition of the same. Total sum recoverable shall not exceed Rs. 50,000/- as contract debt as stated in Section 22(2)(a). The suit for infringement, recovery of damage etc should not be filed in any court below the court of District Judge.

Q: Is marking of an article compulsory in the cases of article to which a registered design has been applied?

A: Yes, it would be always advantageous to the registered proprietors to mark the article so as to indicate the number of the registered design except in the case of Textile designs. Otherwise, the registered proprietor would not be entitled to claim damages from any infringer unless the registered proprietor establishes that the registered proprietor took all proper steps to ensure the marking of the article, or unless the registered proprietor show that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

Q: Can the Registration of a Design be cancelled?

A: The registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in form 8 with prescribed fee to the Controller of Designs on the following grounds:

That the design has been previously registered in India or

That it has been published in India or elsewhere prior to date of registration or

The design is not new or original or

Design is not registrable or

It is not a design under Clause (d) of Section 2.

Q: Is it mandatory to make the article by industrial process or means before making an application for registration of design?

A: No, design means a conception or suggestion or idea of a shape or pattern which can be applied to an article or capable to be applied by industrial process or means. Example- a new shape which can be applied to a pen thus capable of producing a new appearance of a pen on the visual appearance. It is not mandatory to produce the article first and then make an application.

Q: Why is it important for filing the application for registration of design at the earliest possible?

A: First-to-file rule is applicable for registrability of design. If two or more applications relating to an identical or a similar design are filed on different dates only first application will be considered for registration of design.

Q: Can the same applicant make an application for the same design again, if the prior application has been abandoned ?

A: Yes, the same applicant can apply again since no publication of the abandoned application is made by the Patent Office, provided the applicant does not publish the said design in the meanwhile.

Q: Whether it is possible to transfer the right of ownership?

A: Yes, it is possible to transfer the right through assignment, agreement, transmission with terms and condition in writing or by operation of law. However, certain restrictive conditions not being the subject matter of protection relating to registration of design should not be included in the terms and condition of the contract/agreement etc. An application in form-10, with prescribed fees in respect of one design and appropriate fees for each additional design, for registration of the transfer documents is required to be made by the beneficiary to the Controller within six months from the date of execution of the instruments or within further period not exceeding six months in aggregate. An original/notarized copy of the instrument to be registered is required to be enclosed with the application.

Q: What is meant by priority claim?

A: India is one of the countries party to the Paris Convention so the provisions for the right of priority are applicable. On the basis of a regular first application filed in one of the contracting state, the applicant may within the six months apply for protection in other contracting states, latter application will be regarded as if it had been filed on the same day as the first application.

Q: How it is possible to restore the lapsed design due to non-payment of extension fee within prescribed time?

A: A registration of design will cease to be effective on non-payment of extension fee for further term of five years if the same is not paid before the expiry of original period of 10 years. However, lapsed designs may be restored provided the following conditions are satisfied:

Application for restoration in Form-4 with prescribed fees is filed within one year from the date of lapse stating the ground for such non-payment of extension fee with sufficient reasons.

If the application for restoration is allowed the proprietor is required to pay the prescribed extension fee and requisite additional fee and finally the lapsed registration is restored.

Q: Can the name, address of proprietor or address for service be altered in the register of design?

A: Name and address of the registered proprietor, or address for service can be altered in the register of designs provided this alteration is not made by way of change of ownership through conveyance i.e. deed of assignment, transmission, licence agreement or by any operation of law. Application in form-22 with prescribed fee of should be filed to the Controller of Designs with all necessary documents in support of the application as required.

Q: Are the registered designs open for public inspection?

A: Yes, registered designs are open for public inspection only after publication in the official journal on payment of prescribed fee on a request in Form-5.

Q: Can the application for registration of design be filed by the applicant himself only or through a professional person?

A: The application for registration of design can be filed by the applicant himself or through a professional person (i.e. patent agent, legal practitioner). However, for the applicants not resident of India an agent residing in India has to be employed.

Q: What are the important criteria for determining a "set of article"?

A: If a group of articles meets the following requirements then that group of articles may be regarded as a set of articles under the Designs Act, 2000:

Ordinarily on sale or intended to be used together.

All having common design even though articles are different (same class).

Same general character.

Generally, an article having the same design and sold in different sizes is not considered as a set of articles. Practical example: "Tea set", "Pen set", "Knife set" etc.

Q: What is an artistic work which is not subject matter of registration?

A: An artistic work as defined under Section 2(c) of the Copyright Act, 1957 is not a subject matter for registration which reads as follows:

"Artistic works" means: -

A painting, a sculpture, a drawing (including a diagram, map, chart or plan) on engraving or a photograph, whether or not such work possesses artistic quality.

An work of architecture and

Any other work of artistic craftsmanship.

Q: What is meant by classification of goods mentioned in the Third Schedule?

A: The applications for registration of Designs applied to articles are classified according to the Third Schedule of Designs Rules, 2001 for its classification. This is mainly based on the International Classification System for Industrial Designs known as Locarno Classification. Only one class number is to be mentioned in one particular application which is mandatory under the Rules. This classification has been made on the basis of Articles on which the design is applied.

Practical Example: If the design is applied to a toothbrush it will be classified under class 04-02. Similarly if the design is applied to a calculator, it will be classified in class 18-01. Subsequent application by the same proprietor for registration of same or similar design applied to any article of the same class is possible, but period of registration will be valid only up to period of previous registration of same design.

Q: What is meant by Property mark as per the Indian Penal Code, Sec. 479?

A: A mark used for denoting that movable property belongs to a particular person is called a property mark. It means that marking any movable property or goods, or any case, package or receptacle containing goods; or using any case, package or receptacle, with any mark thereon. Practical example: The mark used by the Indian Railway on

their goods may be termed as a Property Mark for the purpose of easy identification of the owner.

Q: What is meant by Intellectual Property?

A: Intellectual Property is the Property, which has been created by exercise of Intellectual Faculty. It is the result of persons Intellectual Activities. Thus Intellectual Property refers to creation of mind such as inventions, designs for industrial articles, literary, artistic work, symbols which are ultimately used in commerce. Intellectual Property rights allow the creators or owners to have the benefits from their works when these are exploited commercially. These rights are statutory rights governed in accordance with the provisions of corresponding legislations. Intellectual Property rights reward creativity & human endeavor which fuel the progress of humankind.

The intellectual property is classified into seven categories i.e

Patent

Industrial Design

Trade Marks

Copyright

Geographical Indications

Lay out designs of integrated circuits

Protection of undisclosed information/Trade Secret according to TRIPs agreements.

Q: What are the essential requirements for the registration of 'design' under the Designs Act, 2000?

A: The design should be new or original, not previously published or used in any country before the date of application for registration. The novelty may reside in the application of a known shape or pattern to new subject matter.

The design should relate to features of shape, configuration, pattern or ornamentation applied or applicable to an article.

The design should be applied or applicable to any article by any industrial process.

The features of the design in the finished article should appeal to and are judged solely by the eye. This implies that the design must appear and should be visible on the finished article, for which it is meant.

Any mode or principle of construction or operation or any thing which is in substance a mere mechanical device, would not be a registrable design. For instance a key having its novelty only in the shape of its corrugation or bent at the portion intended to engage with levers inside the lock associated with, cannot be registered as a design under the Act.

The design should not include any Trade Mark or property mark or artistic works as defined under the Copyright Act, 1957.

Q: How does a registration of design stop other people from exploiting?

A: Once a design is registered, it gives the legal right to bring an action against those persons (natural/legal entity) who infringe the design right, in the Court not lower than District Court in order to stop such exploitation and to claim any damage to which the registered proprietor is legally entitled. However, it may please be noted that if the design is not registered under the Designs Act, 2000 there will be no legal right to take any action against the infringer under the provisions of the Designs Act, 2000.

The Patent Office does not become involved with any issue relating to enforcement of right accrued by registration. Similarly The Patent Office does not involve itself with any issue relating to exploitation or commercialization of the registered design.