



INDUSTRIAL DESIGN AND IPR

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Introduction:

What is an Industrial Design?

An industrial design may consist of three dimensional features, such as the shape of an article, or two dimensional features, such as patterns, lines or colour.

An Industrial Design Right is an intellectual property right that protects the visual design of objects that are not purely utilitarian. An industrial design consists of the creation of a shape, configuration or composition of pattern or colour, or combination of pattern and colour in three-dimensional form containing aesthetic value. An industrial design can be a two- or three-dimensional pattern used to produce a product, industrial commodity or handicraft.

Under the Hague Agreement Concerning the International Deposit of Industrial Designs, a WIPO-administered treaty, a procedure for an international registration exists. To qualify for registration, the national laws of most member states of WIPO require the design to be novel.^[1] An applicant can file for a single international deposit with WIPO or with the national office in a country party to the treaty. The design will then be protected in as many member countries of the treaty as desired. Design rights started in the United Kingdom in 1787 with the Designing and Printing of Linen Act and have expanded from there.

Industrial Design protection is provided for a shape, configuration, surface pattern, colour,

or line (or a combination of these), which, when applied to a functional article, produces or increases aesthetics, and improves the visual appearance of the design, be it a two-dimensional or a three-dimensional article. As per Indian Law, under the Design Act of 2000, Industrial Design protection is a type of intellectual property right that gives the exclusive right to make, sell, and use articles that embody the protected design, to selected people only. Protection rights are provided for a period of 10 years. They can then be renewed once for an additional period of 5 years. Design protection provides geographical rights, like Patents and Trademarks do. To obtain Design Protection in India, the same has to be registered in India.

The pre-requisites for a design to qualify for protection are as follows:

- It should be novel and original.
- It should be applicable to a functional article.
- It should be visible on a finished article.
- It should be non-obvious.
- There should be no prior publication or disclosure of the design.

The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) is the forum where WIPO's member states and observers meet to address issues relating to the development of the international legal framework for industrial designs. SCT members are currently seeking agreement on a number of key issues relating to international designs. An industrial design



may constitute the ornamental or aesthetic aspect of an article. It may consist of 3-D features such as the shape of an article, or 2-D features, such as patterns, lines or colour. India has seen the evolution of design as an important fragment of the intellectual property family in protecting the aesthetic value of the articles.

How to obtain Industrial Design protection in India?

The application procedure for Design protection is fairly simple. The Design office provides a paper filing option as well as an online filing option. All designs are categorized as per the Locarno Classification for Industrial Designs, and filing is done as per the class that pertains to the design in question. An application is to be submitted to the design office with the desired designs, with a classification code and a description of the design.

The application then goes through an examination process, after which the applicant receives a communication from the Design office regarding any objections, if present. After rectifying the application based on the objections and responding to the Design Office, the application will be granted if all the requirements are met. Once granted, and if there is no objection from any third party sources, the design is exclusive to the owner for the time period mentioned above.

Why Should One Look Into Filing for Industrial Design?

The outer appearance of a product makes it visually more appealing and attractive. This acts as a value-adding aspect, which in turn increases the marketability of the product. This leads to the need to protect your creation

from third parties' use, in order to prevent them from taking advantage of your rights in this world of competition.

In many cases, the design itself becomes the identity of a brand. Some of the most famous examples are Coca Cola's contour bottle, the contours of the iPhone/iPad/iPod, and the shape of the Volkswagen Beetle and the Mini Cooper. When a product's design is protected, it stops illegitimate products from destroying the brand's efficacy and safety. Protection of industrial designs also encourages creativity in the manufacturing and industrial sectors, which leads to an expansion in commercial activities.

Paris Convention for the Protection of Industrial Property:

The Paris Convention, adopted in 1883, applies to industrial property in the widest sense, including patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications and the repression of unfair competition. This international agreement was the first major step taken to help creators ensure that their intellectual works were protected in other countries.

The Paris Union, established by the Convention, has an Assembly and an Executive Committee. Every State that is a member of the Union and has adhered to at least the administrative and final provisions of the Stockholm Act (1967) is a member of the Assembly. The members of the Executive Committee are elected from among the members of the Union, except for Switzerland, which is a member *ex officio*. The establishment of the biennial program and budget of the WIPO Secretariat – as far



as the Paris Union is concerned – is the task of its Assembly.

The Paris Convention, concluded in 1883, was revised at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967, and was amended in 1979. The Convention is open to all States. Instruments of ratification or accession must be deposited with the Director General of WIPO.

Each Contracting State must refuse registration and prohibit the use of marks that constitute a reproduction, imitation or translation, liable to create confusion, of a mark used for identical and similar goods and considered by the competent authority of that State to be **well known in that State** and to already belong to a person entitled to the benefits of the Convention.

Berne Convention for the Protection of Literary and Artistic Works:

The Berne Convention, adopted in 1886, deals with the protection of works and the rights of their authors. It provides creators such as authors, musicians, poets, painters etc. with the means to control how their works are used, by whom, and on what terms. It is based on three basic principles and contains a series of provisions determining the minimum protection to be granted, as well as special provisions available to developing countries that want to make use of them.

As to the **duration** of protection, the general rule is that protection must be granted until the expiration of the 50th year after the author's death. There are, however, exceptions to this general rule. In the case of anonymous or pseudonymous works, the

term of protection expires 50 years after the work has been lawfully made available to the public, except if the pseudonym leaves no doubt as to the author's identity or if the author discloses his or her identity during that period; in the latter case, the general rule applies. In the case of audio-visual (cinematographic) works, the minimum term of protection is 50 years after the making available of the work to the public ("release") or – failing such an event – from the creation of the work. In the case of works of applied art and photographic works, the minimum term is 25 years from the creation of the work.

Hague Agreement Concerning the International Registration of Industrial Designs:

The Hague Agreement governs the international registration of industrial designs. First adopted in 1925, the Agreement effectively establishes an international system – the Hague System – that allows industrial designs to be protected in multiple countries or regions with minimal formalities.

Two Acts of the Hague Agreement are currently in operation – the 1999 Act and the 1960 Act. In September 2009, it was decided to freeze the application of the 1934 Act of the Hague Agreement, thus simplifying and streamlining overall administration of the international design registration system.

An international design registration may be obtained only by a natural person or legal entity having a connection – through establishment, domicile, and nationality or, under the 1999 Act, habitual residence – with a Contracting Party to either of the two Acts.



The Hague Agreement allows applicants to register an industrial design by filing a single application with the International Bureau of WIPO, enabling design owners to protect their designs with minimum formalities in multiple countries or regions. The Hague Agreement also simplifies the management of an industrial design registration, since it is possible to record subsequent changes and to renew the international registration through a single procedural step.

The TRIPS Agreement is a minimum standards agreement, which allows members to provide more extensive protection of intellectual property if they so wish. Members are left free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice.

TRIPS and India's IPR Regime:

The TRIPs (Trade Related Intellectual Property) regime has emerged as the basic framework for ensuring intellectual property rights across the world. It is not the universal Intellectual property law. But it provides a basic framework. Every member of WTO should include TRIPs provisions in their domestic intellectual property legislations.

Intellectual property regime is anchored by legislations in the corresponding fields. With the establishment of WTO and the international enforcement of its various provisions; India also has made corresponding changes in the intellectual property regime.

The intellectual property right regime of the country has been modified by a number of legislation since 1995. For India, the WTO's TRIPs agreement became binding from 2005 onwards as

the country has got a ten-year transition period (1995-2005) to make the domestic legislation compatible with TRIPs. Here, India has got additional five-year transition period because of not having product patent regime in critical sector like pharmaceutical. Hence, existing laws were amended and fresh legislations were introduced during this period.

Citations:

- **Cello Household Products v. M/S Modware India and Anr.** ^[21]

The case was filed by popular 'household product' production company 'Cello' against Modware India seeking an injunction for design infringement and passing off. The dispute was over the copying of design of the bottle name PURO launched by the plaintiff in the year 2016, the bottle was a two-toned colour with certain specific phrases and words. The defendant launched a similar bottle called 'KUDOZ' in the following year for which they were sued by the plaintiff. Thus, here the subject matter is the infringement of the design of the bottle launched by Cello for which the company has invested ample money in the market for selling and marketing purposes.

The court on the basis of merits decided that the plaintiff was justified in filing the suit against the defendant as Modware India introduced a bottle which is deceptively similar to the bottle of Cello and denied defendant's contention of lack of jurisdiction of Bombay High court to decide the case following a grant of injunction and relief to be given by the defendants to the plaintiff as damages keeping the loss faced by the



plaintiff as the base. Therefore, cello won the case.

- **M/S Crocs Inc. USA v. Liberty Shoes Ltd. & Others**

The recent case filed by crocs against numerous footwear companies has established the importance of design act and given a verdict against crocs on the basis of prior publication of design. The case was filed in the Delhi High Court and was taken up by Hon'ble Justice Valmiki J. Mehta

Crocs USA filed cases against shoe manufacturers alleging infringement of their design which is related to perforated and non-perforated shoe design. The plaintiff claimed the design as registered from 25.8.2003, the defendant contended that the design registration is subject to cancellation as it does not qualify under the category of 'new' or 'novel'.

The Delhi High Court held that the registered design of the plaintiff with respect to its footwear, does not have the necessary newness or originality for the same to be called a creation or innovation or an Intellectual Property Right. The Court accordingly observed that the registered design of the plaintiff is liable to be cancelled as per Section 19(1)(d)^[1] of the Act read with Section 4(a)^[2] of the Act. The Court in the case also awarded litigation costs as well present to costs incurred by them towards time and man hours spent by these defendants for conducting their defences in the present suits. An appeal filed in the Supreme Court by the plaintiff was dismissed, upholding the orders of the Delhi High court in January, 2019.

Conclusion:

More judicial decisions means better interpretation and more usage of the law, thus establishing the increasing significance of design law. It is an imminent fact that Patents is not the only important IP that an organization should focus on, Design in itself holds significant place in the commercial value of a product. Design as an IP holds immense value because customers may also associate a product with a company or a particular quality standard based on product aesthetics. For companies, the design is the simplest way of differentiating one's products from competing products.

As a result, it becomes important to protect the design from being copied. Thus, it is pertinent to note that businesses and companies are taking active step to protect the aesthetic value of their products under the Designs Act, 2000. Design as an intellectual property right holds as much value as any other subject matter under the umbrella of intellectual property rights.

The old saying goes 'the first impression is the best impression'. In the case of a product, the first impression is inadvertently made by the appearance of the product, before the user even explores its functionality. In this era of creativity, aesthetics and presentation, the overall design and visual appeal of any product is very significant. Hence, the ability to design a creative appearance is a marketable talent in itself. So why not protect your creativity and efforts, without allowing others to use your novel creations? Think beyond just functionality, and look into eye appeal too!



When a product's design is protected, it stops illegitimate products from destroying the brand's efficacy and safety. Protection of industrial designs also encourages creativity in the manufacturing and industrial sectors, which leads to an expansion in commercial activities.

