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Design Patenting in India: A Pressing Priority

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While most of us have heard of patents, about a few are fully conversant with design patents. Design is what gives a product or a new invention its appearance. How often do we see similar products with nearly identical designs on the market? Design piracy is commonplace in this digital era. Whether it be in jewellery designs, branded merchandise, or even something as simple as sunglasses. Designs can easily be pirated by anyone at any place. Pointing fingers becomes challenging in cases of design theft due to the product's advertisement being made available to the entire market hence design patent laws must be strictly enforced. It is not only for the protection of the designers' creative and innovative content, but it also encourages the creation of new designs that are distinct from the existing ones giving birth to new trends. This article will delve deeper into emphasizing the current need for design patents, with India rapidly becoming a hub for startups developing designs for new technology and products daily. It will also study the design registration process in India.

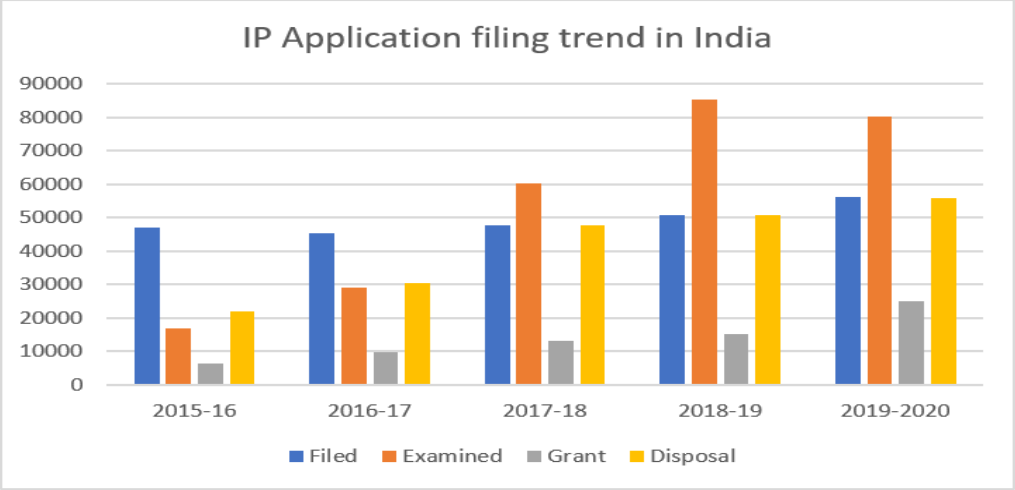
Keywords: *intellectual property, design, design patenting, piracy, patent laws.*

INTRODUCTION

Many well-known brands, from Dior to Vero Moda, have been accused of violating individual designers' patenting rights by stealing, imitating, and combining their ideas with the original ones. This being done, the original designer's work is regarded as inferior compared to the

manipulated version of the same work. The need for design patenting is greater than ever. With the promotion of 'Make In India' to realize the dream of Atmanirbhar Bharat, the market for design patenting in intellectual property is tremendously increasing with innovations coming up every day in different sectors. In 2021 alone during the Covid-19 era, a total of 52,379 patent applications were published. Out of which, a total of 30,431 patents were granted.[1]

As per the Economic survey of 2021-22 tabled in parliament, 58,502 patents were filed in India with the applications of patents rising by 30% in the last 5 years. This has also helped India in pushing its rank to 46th in 2020-21 from 81st in 2015-16 in the Global Innovation Index.[2] India was ranked 10th globally in the number of patents filed and 8th in terms of trademarks. It just so happens that the spike in patent applications in this decade resonates with the birth of the Make in India project, which has given rise to the establishment of start-ups to reduce import dependency from foreign markets and to make the Indian market competent at an international level. With the proper enforcement of IP laws in the country, new inventions with new faces necessitate protection under the law. The principal objective of registering a patent is to protect the original work from being subverted and bootlegged.



[1] 'Patent and Design Statistics-2021' (*BananaIP*, 11 January 2022) <https://www.bananaip.com/ip-news-center/patent-and-design-statistics-2021/> accessed 14 September 2022

[2] Abhijit Ahaskar, 'Patents granted in India tripled in last 5 years; still a fraction of China, US' (*Livemint*, 31 January 2022) <https://www.livemint.com/companies/start-ups/patents-granted-in-india-tripled-in-last-5-years-still-a-fraction-of-china-us-11643630387938.html> accessed 14 September 2022

When we read about patents, we frequently confuse utility patents with design patents. "Utility patents" protect how an article is used and works, whereas "design patents" protect only the outlook, and appearance of an article, such as its shape, configuration, or surface ornamentation.[3]

STAGES OF DESIGN FILING AND DESIGN REGISTRATION IN INDIA

It is critical to register any new design of any product so that it can have legal protection, and any individual or company who endeavours to duplicate such registered design will be penalized under the design act. Chapter II of the Designs Act of 2000 governs design registration. According to the act, "Design" is defined as original features of new shape, configuration, surface pattern, ornamentations, and composition of lines or colours applied to articles that appeal to and are judged solely by the eye in the finished state.

The registration process commences when the owner of such design submits the required registration form to the controller in tandem with the said act. Section 5(1) states that the Controller may, upon the application of any person claiming to be the proprietor of any new or original design that has not previously been published in any country and is not contrary to public order or morality, register the design under this Act. The application must be submitted to the patent office in the prescribed manner and with the prescribed fee.[4] According to Chapter 3 and Section 11 of the act, once the design is registered, the holder of such design can hold a design patent for ten years, which can be prolonged for an additional five years by filing a renewal application before the ten-year period expires.[5]

[3] 'Distinction between design and utility patents' (*uspto.gov*, R-07.2015) <https://www.uspto.gov/web/offices/pac/mpep/s1502.html> accessed 16 September 2022
[4] Designs Act 2000, s 5(1)
[5] Designs Act 2000, s 11

INDIA 8TH OVERALL

Ranking of IP (intellectual property) filing activity in 2020

Toppers	Patent	Trademark	Design
China	1st	1st	1st
US	2	2	4
Germany	5	4	3
Japan	3	5	8
S Korea	4	11	2
France	6	9	7
UK	7	7	9
India	**9**	**6**	**13**

Source: WIPO

The filing procedure includes certain steps that must be completed before the registration is complete, as outlined in the rules:[6]

- The applicant must first determine whether the design is already registered or not; this is done by the design office. The prescribed fees are not to exceed 1000 rupees.
- The design should be classified into one of 32 different classes. The classification separates the design into categories such as foodstuffs, brush ware, articles of adornment, printing and office machinery, and so on.
- The goal of classification is to protect within that category. There is also a miscellaneous class for all designs that do not fall into the categories of classes 1-31.
- If the design's appearance is similar to that of a trademark, the representation of words, letters, and numerals must be used to distinguish it. This is a disclaimer for the design office.
- The proprietor must also include a statement of novelty for the design to be examined more quickly. A statement of novelty is simply a statement that provides information about the features of the design, such as part of the design, shape and configuration, pattern and ornamentation, and so on, for which the patent is being claimed.

[6] 'How to file an application for industrial design?' <https://www.ipindia.gov.in/writereaddata/images/pdf/ten-steps-to-design-application.pdf> accessed 17 September 2022

- Finally, the application must include all relevant documents that satisfy the requirement for obtaining a registered design patent.

It should be noted that not all designs are eligible for registration. There are a few items, the designs of which are not subject to registration. Stamps, labels, tokens, cards, signs, emblems, or flags of any country are examples of such items. On March 9, 2015, The Controller General Of Patents, Designs, and Trade Marks released a public notice, Notice No. CG/F/Public Notice - Designs/2015/46, announcing the digitization of the filing system to accept online applications. Owners of any design now have the option of completing the design registration process online.

WHO CAN REGISTER?

As per the "General Information Regarding Registration Of Industrial Designs" by the Design wing of the patent office, Any person or the legal representative or the assignee can apply separately or jointly for the registration of a design. The term "person" includes firm, partnership, small entity, and body corporate. An application may also be filed through an agent in which case a power of attorney is required to be filed.[7]

PENALTY FOR PIRACY

If anyone violates the provisions of the said act; The Design Act of 2000, by counterfeiting or trying to apply the imitated version of an already patented invention in their work, he/she will be fined not more than 25,000 rupees to the original proprietor, subject to a maximum amount of 50,000 rupees which can be claimed as the amount due under a contract for a specific design as an injunction. Section 22(2)(a) of the act mentions the particular provision. Any court lower than that of a district judge shall have no jurisdiction to hear such a case.

[7] 'General Information Regarding Registration Of Industrial Designs' (*IP India*) <https://www.ipindia.gov.in/writereaddata/Portal/Images/pdf/General-Info-Reg-of-Industrial-Designs.pdf> accessed 18 September 2022

FAMOUS CASES

Rajesh Masrani *v* Tahiliani Design Pvt. Ltd.[8]

In this case, sections of the design act and the copyright act were used. Section 15(2) of the Copyright Act applies to the copyright in any design capable of registration but not registered under the Design Act of 2000, and the copyright in the said design dissipates to exist once any article to which the design has been applied has been reproduced more than 50 times by an industrial process. However, Section 2(d) of the Design Act states that the definition of a design does not include any trademark as defined in clause (v) of Section 2(1) of the Trade and Merchandise Act, 1958, or property mark as defined in Section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957(14 of 1957). The Delhi High Court went on to state that "*work registration is neither mandatory nor a prerequisite for filing a suit for damages for infringement of copyright*."

Tarun sethi & Ors. v Vikas Budhiraja & Ors.[9]

The High Court of Delhi had been hearing this case. In this case, the plaintiff applied for a design patent for a door knob, for which the defendant accused them of copying their knob design. Filing with novelty is one of the requirements for obtaining a design patent. The plaintiff claimed that the door knob was novel only in its configuration and shape. They contended that certain features of the plaintiff's product differed from those of the defendant's product. The court went on to rule that the "*novelty of a design awaiting approval must not be the same as a previously published or used design or pattern, or one that is substantially similar.*"

Bharat Glass Tubes Ltd. *v* Gopal Glass Works Ltd.[10]

In the instant case, the appellant filed a lawsuit against the defendant for infringement of rights under Section 4(1) of the Designs Act of 2000. The defendant used the design of the engraved rollers which is a product of the plaintiff on glass sheets, which was a violation of the said

[8] *Rajesh Masrani v Tahiliani Design Pvt Ltd* [2008] FAO (OS) No 393 of 2008
[9] *Tarun Sethi & Ors v Vikas Budhiraja & Ors* [2012] Del
[10] *Bharat Glass Tube Ltd v Gopal Glass Works Ltd* [2008] Civil Appeal No 3185 of 2008

section. The definition of the "new and original" work mentioned in Section 4(1) is that the registered design has never been published or made known to the public and that it was invented for the first time or has never been reproduced by anyone. Looking at the explanation, the court specifically stated in its verdict that for Section 4(1) to be made appropriate, "*the design in conundrum should not be used in the same line of work as the defendant, and thus, the respondent has exclusive rights to file for a design patent even if the design already exists*."

ADVANTAGES OF ISSUING A DESIGN PATENT

As a developing economy, now is the time for India to climb the ladder and become a prominent country with the highest number of registered patents in various sectors. The simplest way to acquire intellectual property is to patent a design. With such a broad domain, it covers all perceived threats and provides methods for the legal protection of a design. Among the huge benefits of design patenting, the following a few significant advantages:

Protecting the first step towards completion of the design: Design is what gives a product its appearance and form. It is the first thing that a person notices about a product before using it. Having a design patented gives the owner of the design, confidence in the product. The assurance that it is ready for market release

Protects domestic market: Given the amount of exposure to various designs in the market, it is both an effortless and common exercise to imitate an existing design and use it for self-interested gains. Indigenous designs must be prioritized for registration. Without registration, a design is like a sitting duck for a larcenist, waiting to exploit the Indian market. Having a registered patent becomes an essential tool for fighting against such deception and fraud.

Competitive edge in the global market: From an international standpoint, designs with registered patents foster a competitive spirit among market participants. It prevents design tampering and alternate misuse. It promotes fair market competition.

Increases profits: When a person's new or original work receives patent approval, it grants the owner of the design exclusive rights. The article can then be commercialized and advertised,

boosting public awareness of the article and doubling sales. It also improves their intangible assets since obtaining a design patent is the simplest way to expand your intellectual property portfolio.

Product differentiation: The owner of a design is required to categorize a certain design in classes when applying for registration. The Indian patenting legislation establishes 32 such classes. This defines the concept, configuration, and art that distinguishes it from other designs. The classification aids in the provision of protection within that category.

CONCLUSION

Having a design registered is a win-win situation for everyone. It is primarily for two reasons: first, it is relatively inexpensive to have a design registered in India under the Design Act, 2000, with a fairly reasonable official cost of 4000 rupees, and second, it provides legal protection as well as the benefit of increasing profits. With the significant growth in the IP sector in recent years, India is on the verge of becoming a major industrial hub and achieving its goal of transforming into a first-world country; the World Intellectual Property Organization (WIPO) confirms the same. The Covid-19 lessons have been a boon to the Indian IP sector. Both the consumer and the producer share a common online platform where people buy what appeals to them the most, and the only way to gain is to design the product accordingly. The product's centre of gravity is shifting to its design. "*What is appealing sells quickly.*" As the industrial sector advances, so does the demand for patent registration.