

**INDICAM along with the Indian Intellectual property (IP) law firm, K&S Partners and the Italian IP law firm, STUDIO TORTA S.P.A. organized a webinar on June 3, 2021, titled as: 'Design by Design'**

**Mr. Anupam Trivedi and Mr. Anand Choubey, both partners in the Engineering patent practice at K&S Partners, shared their insights on the Indian Designs Law. Key highlights of the discussion are as under:**

## **1. Legal Framework for Design protection in India**

In India, protection of industrial Designs is governed by the Designs Act, 2000 ("the Act") and the Designs Rules, 2001 (as amended 2021). Thus, Design protection is a statutory right which requires registration as a prerequisite for obtaining enforceable rights within India. Like all other IP rights, Design rights are territorial.

The Designs Act defines an Article<sup>1</sup> as any article of manufacture, any substance, artificial or partly artificial and partly natural, and includes any part of an article which is capable of being made and sold separately. Further, Design<sup>2</sup> is defined as only the features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article. Such features can be applied in two dimensional or three dimensional or in both forms. The Act further defines that the said features are applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined. The essential aspect is that features in finished article appeal to and are judged solely by the eye.

## **2. Criteria for registration**

Novelty or originality of design is the key qualifying requirement to obtain a Design registration in India. A design is considered novel if it has not been previously disclosed to the public or used, in India or elsewhere in the world.

## **3. Procedure**

India follows a substantive examination process for evaluating Design applications for registration. However, unlike the patent system, there is no need to make a formal request for examination.

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<sup>1</sup> As per Section 2(a) of the Designs Act 2000, "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.

<sup>2</sup> As per Section 2(d) of the Designs Act 2000, "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 as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957

Indian Design Office (“IDO”) conducts search for prior publications to evaluate the novelty and originality aspects of the claimed design. Generally, the IDO issues a First Examination Report (“FER”) in ~2-3 months from the date of filing of the design application. The Applicant is required to file a response to the FER and place the application in order for acceptance within six months from the date of filing. An extension of 3 months can be available on making a request along with official fee. If the Applicant complies with the requirements raised in the FER, the design application proceeds for registration. The IDO is fairly quick in processing design applications and generally issues a design registration in about 6-8 months of time from filing, provided the requirements raised in the FER are complied within the prescribed period.

## **4. Extending design protection to EP and other countries**

As Design protection is territorial, separate design applications are required to be filed in countries where the protection is desired. Indian design application can be filed within six months, claiming reciprocity from the first filed design application in other country<sup>3</sup>.

## **5. Representation of drawings in Indian design applications**

In an Indian design application, representation sheets clearly depicting the claimed design are to be submitted. In general, a total of six views - including top view, bottom view, front view, rear view left and right-side views, and a perspective view are required for the representation sheets. Line diagrams are preferred. Discrete/broken lines and shaded portions are not allowed in the representation sheets. Portion intended to be disclaimed in the design can be depicted using dotted lines.

## **6. Claiming multiple embodiments**

Indian designs practice follows a system of one embodiment for one design application. Multiple embodiments cannot be claimed in a single design application and are required to be covered in separate design applications.

## **7. Exclusion from Design registration**

Indian design law prohibits registration of designs which include scandalous or obscene matter, mode or principle of construction, mere functional features, Trademark/Logo, word, letters and numbers.

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<sup>3</sup> Reciprocity application means an application in India under section 44 of the Designs Act. 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 intergovernmental organizations, may file an application for registration of the same design in India, within six months from the date of priority.

## **8. Enforcement**

Indian Law provide civil remedy against the infringement or piracy of designs. Plaintiff can file a suit for injunction and can also claim damages. Designs Act prescribes damages of INR 25,000 (~Euro 300) for every contravention in case of any design infringement, however, the maximum total amount recoverable for any one design is INR 50,000 (~Euro 600). Moreover, the plaintiff can sue for damages based on gains made by the infringer or the losses suffered by the proprietor. Overall, the Indian Courts have been very proactive in enforcement of Design rights.

As decided in *Samsonite Vs. Vijay Sales & Ors (1998 Ptc 18)*, registration under the Designs Act is a prerequisite for enforcing any rights in India against infringement of design features in the design registrable article.

Design applications filed in India are from various industry sectors such as automobiles, consumer home appliances, telecommunication devices, mobile handsets, home furnishing, clothing and fashion accessories.