



# **FACULTY OF JURIDICAL SCIENCES**

**COURSE:BA.LL.B**

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**SUBJECT: Cyber Law**

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**NAME OF FACULTY: Dr.Puja Paul Srivastava**

# Lecture-40



## ➤ LECTURE 40: Law relating design.

### Introduction

The Designs Act, 2000 ("the Act"), is a complete code in itself and protection under it is wholly statutory in nature. It protects the visual design of objects that are not purely utilitarian. *Section 2(d) of the Act*, defines a Design as:

- *"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 (43 of 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 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.
- There should be no prior publication or disclosure of the design.

### Locarno Classification

Designs are registered in different classes as per the Locarno Agreement. It is used to classify goods for the purposes of the registration of industrial designs which further helps in Design searches. These classes are mainly function oriented.

### Protection term

The Copyright on a registered design is in total for 15 years. Initially the Copyright in Design is registered for 10 years, which can further be extended by 5 years on making an application for renewal.

### Design Rights

As in case of any other IP rights, the design registration also bestows a monopolistic right to the Proprietor by which he/she can legally exclude others from reproducing, manufacturing, selling, or dealing in the said registered design without his/her prior consent. The design registration is particularly useful for entities where the shape of the product has aesthetic value and the entity wishes to have exclusivity over the said novel and original design applied to its product(s) or article(s).

In addition to the above, the design sought for protection must be new or original, i.e., not disclosed to the public in India or elsewhere in the world by prior publication or by prior use or in any other way. The design should be significantly distinguishable from designs or combination of designs that are already registered or pre-existing or disclosed to the public. Furthermore, the design should not include any scandalous or obscene matter or any

feature that is purely functional in nature.

### Remedies

- It is submitted that as per *Section 19 of the Designs Act, 2000*, at any time during the subsistence of the Design registration, any person can seek cancellation of design registration by filing a Petition before the Controller, on the following grounds: [ra1]"...*(a) that the design has been previously registered in India; or*
- *(b) that it has been published in India or in any other country prior to the date of registration; or*
- *(c) that the design is not a new or original design; or*
- *(d) that the design is not registerable under this Act; or*
- *(e) that it is not a design as defined under clause (d) of section 2..."*

Further, an appeal against the order of the Controller can be made to the High Court.

## Piracy of Registered Designs

Section 22 of the Designs Act, 2000, provides that any fraudulent or obvious imitation of a registered design without the consent of the proprietor is unlawful and also prohibits the import of such material which closely resembles a registered design. The section very specifically provides that in a civil case compensation payable shall not exceed Rs. 50,000/- in respect of infringement of one registered design. As the compensation payable is statutorily limited, it is a good ground for insisting an interim injunction even before the commencement of trial.

## Comparison of Design Registration against different IPs

- *Design registration versus Patents registration:* A patent protection is granted over a novel product or process comprising inventive step (technical advance) and exhibiting industrial applicability. One of the prime differentiators for design vis-à-vis patent protection is that contrary to designs, patents must contain a functional and/or structural feature of technical significance. While a design is judged on aesthetics only and not the functionality/technicalities of the shape/pattern of an article, the patents on the other hand are judged solely on the functionality and not the aesthetics of the feature/shape.
- *Design registration versus Copyright:* Both design and copyright protections relate to aesthetic features of the article. The differentiating factor is clearly provided under Section 15(1) of the Copyright Act, 1957, which states that:
  1. Copyright shall not subsist in any design registered under the Designs Act, 1911, or
  2. Copyright in any design capable of being registered under the Designs Act, shall cease as soon as any article to which the design has been applied to has been reproduced more than fifty times by an industrial process.

Therefore, by virtue of Section 15 of the Copyrights Act, **a design registration and copyright over the article cannot co-exist**, both forms of IP protection are mutually exclusive.

- *Design registration versus Trademark registration:* 10A registered design and a trademark (not yet registered) may have an overlapping area. Say if a unique shape is a registered design and the said unique shape of the article attains such level of popularity leading to brand recognition amidst available articles in the same classification of goods, the same may fall under consideration for a

trade marks registration by the proprietor/company. Accordingly, a unique industrially applied shape or pattern shall be registered as design, and if and when the design becomes indicative of the origin of the article/products of the company, the company may consider applying for registration of the shape/pattern as a trademark.

## SELF-TEST QUESTIONS

S.NO	Question	Option (a)	Option (b)
1.			
2.			
3.			

4.			
5.			

**Answers: 1-(),2-(), 3-(),4-(),5-()**