
A CRITICAL ANALYSIS OF DESIGN PROTECTION LAWS IN INDIA

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ABSTRACT

Intellectual property protection plays an extremely important role in fostering and encouraging inventions and innovations. If ideas are not protected, businesses and individuals will not be able to make profits and thus, will not be motivated. The design law is that part of the IP regime that deals with and protects shapes, figures and configuration of an article.

The term ‘design’ has been defined under Section 2(d) of the Design Act, 2000 which states that design is associated with the features of an article such as the shape, pattern, configuration, composition of lines and colors that has been applied to a product through an industrial process. The product or the article can either be two dimensional or three dimensional but should be capable of being judged solely by the eye. In simpler words, design law acts on the physical appearance of any article and protects it from any sort of infringement.

Through this paper, the authors seek to provide a comprehensive overview on the design laws applicable in India, the issues and the challenges and an analysis of the judicial pronouncements that have helped in the interpretation and its evolution in India.

Keywords: Industrial designs; Designs Act, 2000; Design law; Novelty; Registration

Research Methodology

This study has been conducted with the use of the analytical and doctrinal methods and has analyzed various international agreements, acts, case laws, books, previous study reports and articles related to the subject at hand.

Research Objective

The objective of this research paper is to holistically understand the evolution of design law since its development. The authors also seek to understand and analyze the laws that govern designs in India and the issues and challenges of the same.

Introduction

The Design Act of 2000 is responsible for the protection and registration with respect to the aesthetics of any article or product in India. It aims at protecting the features, shape and configuration of the product which has been added through an industrial process which might be manual, chemical or mechanical.¹ To prevent other businesses from developing, manufacturing, selling or distributing articles having an appearance which is similar to the product, it is important for a design to be registered, making this right a territorial statutory right.² The Design Act, 2000 and the corresponding rules that is The Design Rules, 2001, govern the filing and registration of designs in India. Like any other legislation, the Design Act, 2000 also faces numerous issues and challenges which shall be discussed in this paper subsequently.

Evolution of Design Law in India

The need for protecting designs in India was first felt in the late 18th century which led to the introduction of the Patterns and Design Protection Act of 1872. It provided exclusive rights to the inventors for manufacturing and selling their designs for a short period of time. This Act, however, was replaced by the Inventions and Designs Act of 1900 followed by the British Design and Patent Act, 1907. The British Design and Patent Act, 1907, then acted as a

¹ Section 2(d), Design Act, 2000.

² STA Law Firm, <https://www.stalawfirm.com/en/blogs/view/design-rights-in-india.html>, (Last visited May 29, 2021).

foundation for the Patents and Designs Act, 1911.³

Initially, there was one legislation that dealt with patents as well as designs. However, in the year 1970, the Patent Act came into being which led to the provisions relating to patents being repealed. But the part of the Act that dealt with designs continued to be in force. When India became a member of the World Trade Organization (WTO) in the year 1995, the Patents and Design Act of 1911 was repealed in order to create a new legislation that was in compliance with the TRIPs Agreement.⁴ This is how the current legislation of the Designs Act, 2000 was introduced. Apart from the compliance with the TRIPs Agreement, the considerable changes in science and technology also became an important reason for the enactment of a new Act.

The main difference between the older Acts and the new legislation is that the new Act excludes artistic works from the definition of designs. The Delhi High Court went ahead and explained the issue relating to the protection of artistic works under Designs Act in the case of *Microfibers Inc. v. Girdhar Co. & Another*⁵. In this case, the court stated that the artistic works that were excluded under the Design Act are not to be excluded and should be given protection under Section 2(d) of the Act.

Salient Features of the Designs Act, 2000

As has been discussed, the TRIPs Agreement that India is a part of gives out the minimum standards that have to be followed in protecting industrial designs. The Design Act, 2000 adhered to the minimum standards that have been provided by the Agreement. The salient features that form the basic crux of the Act are as follows:

1. As per the Act, the total validity of registration of designs under the Act is fifteen years. Initially, on registration of a design, the proprietor is granted exclusive rights for a period of ten years which is extendable by a period of five years subject to the fulfillment of the renewal procedure.
2. The Act is divided in 11 chapters, each of them dealing with important matters related to design law. Chapter 1 talks about the applicability of the Act and defines the term

³ Legal Services India, 'Origin and Development of Designs Act, 2000', <http://www.legalserviceindia.com/legal/article-475-origin-and-development-of-designs-act-2000.html>, (Last visited on May 30th, 2021, at 6:25 pm).

⁴ Ibid.

⁵ *Microfibers Inc. v. Girdhar Co. & Another*, Suit No. 1480/2002.

design, Chapter 2 of the Act deals with registration of designs and gives out the eligibility criteria as well as the process of registration, Chapter 3 and 5 of the Act deals with copyrights in registered design and legal proceedings respectively. The provisions relating to the fees is discussed in Chapter 6. Furthermore, Chapter 7 discusses the powers and the duties of the controller and states that the controller shall have the powers of a civil court only for the purpose of getting evidence, enforcing attendance and discovering and producing documents that are required during the proceedings. Chapter 8 of the Act deals with the evidence and Chapter 10 prescribes the powers of the central government.

3. The Act provides the eligibility criteria for registration⁶ and the process of registration, cancellation⁷ and refiling in consonance with the minimum standards set out by the International Agreements that India is a party to.
4. Designs have been classified on the basis of the Locarno classification which classifies the designs as per the subject matter whereas before this Act, the classification was based on the basis of material the matter was made of.
5. The Act prescribes provisions to avoid restrictive conditions in order to ensure that anti-competitive practices are regulated.
6. The Act gives the power to the District Courts to transfer cases to the High Court having jurisdiction in a case where the petition challenges the validity of an industrial design registration.⁸

Registration of Design under the Design Act, 2000

From the above discussion, it is clear that design refers to the aesthetic appearance of an article in terms of the features, colors and configuration and design law provides protection to the features of the article against misuse and prevents all the others from selling, manufacturing and distributing similar products. However, it is important to note that this right is a statutory right and is only available to a person who has registered his design under the Act. For the design to be registrable, there are certain conditions that have been laid down in the Act. These are⁹-

1. The article should be new and original.

⁶ Section 3, Designs Act, 2000.

⁷ Section 19, Designs Act, 2000.

⁸ Shivalik Thaman, *All About the Designs Act, 2000*, Latest Laws, (Accessed on May 31st, 2021, at 4:00 pm) <https://www.latestlaws.com/articles/all-about-the-designs-act-2000-by-shivalik-thaman/>

⁹ Section 4, Designs Act, 2000.

2. It should be capable of being judged solely by the eye.
3. The design should not be publicly known in India or published in any other part of the world.
4. The design should be notably different from the other known designs and should not be a combination of two known designs either.
5. A technical or useful function of an article cannot be registered as a design.
6. The design should not be against public morality.
7. It should also not attract the provisions of Section 4 of the Design Act, 2000 that deals with reasons for prohibition in registering new designs.

Even though the provisions of the Act are clear and draws a line between what is registrable under the act and what is not. However, there have been many instances where a legal question regarding what is new, and original has arisen before the courts. This was first discussed in the case of *Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd.*¹⁰ where the courts explained that a design can be said to be new or novel if it has been invented for the first time and if the design has not been publicly introduced in India or published in any other part of the world.

Further, this question again arose in the case of *Crocs Inc. USA v. Liberty Shoes Limited and Others*,¹¹ wherein Crocs which is a footwear brand based in the US, initiated legal proceedings against Liberty and others, restraining them from producing, selling or distributing certain products that they claimed to be a replica of their clog-like slippers. The Delhi High Court took up these cases and gave out one single judgment.

The main issue that was highlighted in the court was that whether the shoes registered by CROCS were new and original. The court while answering this issue extensively discussed and debated on the prior publication of the product on the Holey Soles Website. It was proved that the product was published on the said website much prior to the registration of this design and on this ground itself the registration could be cancelled.¹² The court also discussed the newness and originality of the shoes in contention and placed reliance on various judgments¹³ and stated that if an ordinary variation is added to an old product, it cannot be considered as new and original and cancelled their registration.

¹⁰ *Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd.*, 2008 (10) SCC 657.

¹¹ *Crocs Inc. USA v. Liberty Shoes Limited and Others*, CS (COMM) No. 772/2016.

¹² Section 19(1)(d), Designs Act, 2000.

¹³ *Pental Kabushiki Kaisha v. Arora Stationers and Others*, 247 (2018) DLT 9.

Issues and Challenges

Like any other legislation, the Design Act, 2000 too faces a lot of issues and challenges on the ground level. Some of the major issues and challenges are enlisted below-

1. A huge chunk of designs get rejected easily because of small procedural issues that happen while registering and there are very few that actually get rejected due to a substantive criteria.
2. The protection that is granted under the Act is only for a period of 15 years, which demotivates companies from getting their designs registered under the Act and instead they choose trademarks and copyrights based on their articles.
3. The design rights are not valid in any other country, if not registered separately. The protection is only valid in India or UK.
4. People are unaware about the online registration process and there are a lot of formalities that have to be carried out for registration of a design, which dissuades proprietors from benefiting from the act.
5. There is no proper mechanism that provides that status of registration.
6. Another challenge that proprietors face is that the process of design registration is extremely time consuming.

Landmark Judicial Pronouncements

1. ***Reckitt Benckiser (India) Ltd. v. Wyeth Ltd***¹⁴- In this case the design in contention was an S-shaped spatula. The defendant in the case, that is Wyeth Ltd. contended before the court that the design was not new and original and has already been registered in another country, before getting registered in India. After analyzing the facts of the case and hearing both sides the court held that since it could be proved that the design was first published in another country, the registration in India would be cancelled.¹⁵
2. ***Sree Vishnu Bottles v. The State of Tamil Nadu***¹⁶- The rights of the re-sellers have been reiterated in this case. As per the facts of the case, Sree Vishnu Bottles were dealing in the procurement of empty beer bottles and paper from the State of Tamil Nadu and then transporting the same to Karnataka and Madhya Pradesh. However,

¹⁴ Reckitt Benckiser (India) Ltd. v. Wyeth Ltd, (FAO(OS) No. 458/2009).

¹⁵ Section 4(b), Design Act, 2000.

¹⁶ Sree Vishnu Bottles v. The State of Tamil Nadu, W.P.Nos.1295 and 1296 of 2012.

recently, they were stopped from doing so as the bottles were registered under the Design Act, and they were held liable for piracy of those designs as per Section 22¹⁷ of the Act. In this matter, the court came to a conclusion that the relief which was being sought by the petitioners was vague and thus, the Court could not pass an order.

3. *M/s S K Industries v. Dipak Ghosh*¹⁸- The plaintiff in this case, contended that the cup in which the jelly was being sold could not be used by the defendant. The court was not convinced and held that the cup was a regular cup and there was no originality or novelty in the shape or dimensions of the cup. Thus, the contention of the plaintiff did not hold.
4. *M/S. Whirlpool of India Ltd. v. M/S. Videocon Industries Ltd.*¹⁹- As per the facts of this case, two designs were registered by Whirlpool and later on, Videocon too registered the same design. The features, shape as well as the configuration was the same. Videocon contended that since it has already registered the design, the company cannot be held liable for infringement. The court in this case stated that the designs registered by Videocon was similar to that registered by Whirlpool and thus, Videocon was held liable for infringement and passing off the design of Whirlpool.

Suggestions and Conclusion

When a design is registered by a proprietor in India, he protects it from being infringed by others. This protection comes at a low cost and in case of infringement, the courts actively protect the rights of the inventor as has been seen above. The Design Act, 2000 not only provides protection for a period of fifteen years, but also sets out a well-defined criterion that needs to be fulfilled before registration. However, there are still some lacunas in the implementation of this Act.

Infringements still go unnoticed by the authorities even though the designs have been registered and the process of carrying out infringement proceedings is slow and time-consuming. Thus, it is important to set up a process through which infringement by small firms can be noticed and actions must be taken to avoid the same.

¹⁷ Section 22, Design Act, 2000.

¹⁸ *M/s S K Industries v. Dipak Ghosh*, IA No. 10778/2007 in CS(OS) No. 1300/2007.

¹⁹ *M/S. Whirlpool of India Ltd. v. M/S. Videocon Industries Ltd*, Suit No. 1675 Of 2012.

The Design Act, 2000 is of utmost importance as it protects designs developed by proprietors which encourages innovation and invention. Protection of designs allows the products to be marketable and profitable.

References

Articles:

- Shivalik Thaman, All About the Designs Act, 2000, Latest Laws.

Websites:

- STA Law Firm, <https://www.stalawfirm.com/en/blogs/view/design-rights-in-india.html>.
- Legal Services India, <http://www.legalserviceindia.com/legal/article-475-origin-and-development-of-designs-act-2000.html>.

Statutory Provisions:

- Section 2(d), Design Act, 2000.
- Section 3, Designs Act, 2000.
- Section 19, Designs Act, 2000.
- Section 4, Designs Act, 2000
- Section 19(1)(d), Designs Act, 2000.
- Section 4(b), Design Act, 2000.
- Section 22, Design Act, 2000.

Cases:

- Microfibers Inc. v. Girdhar Co. & Another, Suit No. 1480/2002.
- Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd., 2008 (10) SCC 657.
- Crocs Inc. USA v. Liberty Shoes Limited and Others, CS (COMM) No. 772/2016.
- Pental Kabushiki Kaisha v. Arora Stationers and Others, 247 (2018) DLT
- Reckitt Benckiser (India) Ltd. v. Wyeth Ltd, (FAO(OS) No. 458/2009).
- Sree Vishnu Bottles v. The State of Tamil Nadu, W.P.Nos.1295 and 1296 of 2012.
- M/s S K Industries v. Dipak Ghosh, IA No. 10778/2007 in CS(OS) No. 1300/2007.
- M/S. Whirlpool of India Ltd. v. M/S. Videocon Industries Ltd, Suit No. 1675 Of 2012.