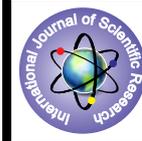


Protection of Industrial Designs in India



Law

KEYWORDS :

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ABSTRACT

TRIPS Agreement provides minimum standards to be adopted by the member nations for protecting the industrial designs. It requires protection for the new or original designs. The Indian Designs Act, 2000 also affords protection to the proprietor of the design for the minimum term mandated by the TRIPS Agreement, irrespective of the fact that such person is the originator of the design or not. The Designs Act further confers copyright to the proprietor of the registered design and confers protection against its piracy. This article is an endeavour to analyze the minimum standards prescribed by the TRIPS Agreement with respect to the protection of industrial designs and its application in India to protect the designs under the Designs Act, 2000. For the purpose this article is divided into four parts. First part deals with the general introduction of the subject. Second part is attributed to the TRIPS provisions relating to requirements of protection and rights accruing out of such protection of designs. In the third part, Indian perspective on the subject of industrial designs has been dealt in, and finally conclusion is drawn.

I. INTRODUCTION

A design refers to the features applied to an article or a product; it is not the article or product itself. Literally speaking the word 'design' can mean a plan or a scheme capable of being written or drawn, showing how something is to be constructed, or how the elements of an item or article are to be arranged. It may also mean a decorative arrangement. In legal terms, however, it carries a different meaning. Design is an intellectual property and may refer to the functional aspect of the articles on which it is applied, such as a can opener, a tool box, a container for frozen food or an exhaust pipe for a car. Articles which are functional in nature are generally, but by no means exclusively, in the province of the design right. The designs are those that are original and new. They relate to the features of shape or configuration of an article (Bainbridge, 2003, p. 453). Design is an intellectual property of the person who creates it irrespective of whether the article or the product on which such design is applied belongs to that person or not. Though the design of an article no way adds to the practical utility, efficiency or functionality of an article, however, it has a great commercial value. As a matter of common parlance, it is true that the customer when buys any product in the market wants that along with good functional features of that product, the design of it should also be new and appealing. Thus design is judged solely by the eyes, as what appeals to the eye is a good design for the customer. As design has economic and commercial value, it is necessary that the creator of the design should have exclusive right to apply his design to an article. An unauthorized application of the design is protected by the law, as the same amounts to piracy (Paul, 2009, at 501). The owners of the protected designs get a right to prevent the manufacture, sale or importation of articles bearing or embodying a design which is a copy of the protected design (Bhandari, 2010, at 18). The Paris Convention for the Protection of Industrial Property of 1883 was the first multilateral effort to protect industrial property. Industrial designs were also protected under it and the Contracting parties had an obligation to protect them. Besides, Hague Agreement Concerning the International Deposit of Industrial Designs, 1925, which was revised at Hague in 1960, is an agreement to facilitate the international protection to the industrial designs. The WIPO protects such designs in all the member countries. The establishment of the WTO has further necessitated the protection of designs by its member countries under the TRIPS Agreement. The TRIPS Agreement stipulates some minimum standards to be observed by the member nations for protecting intellectual property, including the designs, as earlier the varying standards of protection had become a source of tension of international economic relations, besides being detrimental to the interests of the owner of the intellectual property.

II. Industrial Designs:

Article 25 and 26 of Section 4 in Part II of TRIPS Agreement contain provisions regarding the scope of protection, term of protection and exceptions to rights conferred in relation to the industrial designs. The negotiations regarding industrial designs were difficult as there was controversy as to whether

the standards of protection to be granted for industrial design should be based on the protection available in Europe or in the United States. One of the main practical interests at stake was trade in automobile spare parts. The automotive industry wanted to obtain protection from cheaper parts produced by foreign competitors. Extension of protection, however, was opposed by developing countries and the car insurance industry (Macrory, 2005, at 1091).

Certain improvement in the protection of industrial designs was also the result of intervention by the textile industry that wanted greater protection for fashion designs.

Article 25 of TRIPS Agreement obliges the Members to provide the protection to independently created industrial designs possessing the element of newness or originality. Members must ensure that the requirements for obtaining protection for textile designs do not unreasonably impair the opportunity to obtain such protection as textile design does not remain in fashion for a very long time.

Thus Article 25(1) of TRIPS deals with scope of protection of industrial designs and explains the situations where such protection might be afforded. This provision obliges the Members to provide protection only to those industrial designs that have been created independently from the influence of earlier existing designs and those that can be treated as new or original. However, Members could provide that designs are neither new nor original, if there is no substantial difference from those existing designs or from combinations of known design features, as that feature is to be judged solely by eye and if no difference appears between the two designs, than the later cannot be treated as new, thus cannot be protected. Additionally, those designs with only technical or functional changes might also not be provided protection by the Member States.

In this area there were more of intra-North differences rather than North-South differences. The European community refused to accept that some Members could levy the requirement of both 'novelty' and 'originality' for the protection of industrial designs (Watal, 2001, at 279).

Thus a compromising language was inducted in Article 25, so as to accommodate both points of view as it enabled members to deny protection to designs that do not significantly differ from known designs.

Designs, those are the descriptive of the ordinary shape of an object are also usually excluded from the grant of such protection as these may not be novel or original and, even if they are, cannot be taken away from the public domain.

Article 25(2) was included in acknowledgment of the short lifespan of such design creations due to changes in fashion and amounts to a novel instrument in design protection. Article 25(2) creates an obligation to, and puts pressures for, facilitating

filing procedures in countries extremely slow in registering designs which depend on fashion cycles. Moreover, in many countries copyright protection can also be used as a possible way for protecting designs without any registration requirements. For example, Section 15 of the Indian Copyright Act, 1999 provides for protection to the designs as a copyright, however, if the number of such designs produced by industrial methods exceeds fifty, then the protection is provided under Designs Act, 2000. The cost, examination or publication cannot create hindrances in seeking protection for textile designs unreasonably.

Articles 26(1) of TRIPS provide an exclusive right to the owner of the protected industrial design to make sell or import article bearing that design. At the same time, the owner of the design has been given an exclusive right to prevent third party from exploiting his design or exploiting one which is substantially a copy of the protected design solely for the purpose of trade and commerce. Thus without the consent of the holder of design, the same cannot be used for commercial purposes by any third person, as proprietor of the design has right to prevent others from using the same.

Article 26(2) of TRIPS provides limited exceptions that do not unreasonably conflict with the legitimate interests of the right holder, taking into account the legitimate interests of third parties. Here 'third parties' could mean the general public and design that are contrary to morality or public order could be refused registration for protection. Thus members have an option to provide exceptions to the protection of industrial designs, but up to a limited extent that they do not interfere unreasonably with the normal exploitation of protected industrial designs at the cost of interest of the owner.

TRIPS Agreement imposes an obligation of the minimum requirement of term of protection upon the Member countries that the term of protection of industrial designs should not be less than 10 years as stipulated in Article 26(3). This language is bit flexible as compared to that used in protection of other IPRs viz., copyright, patents, trademarks or layout-designs. This language was meant to accommodate different initial terms of protection, so long as the total number of years of protection afforded does not fall below 10 years. In India a protection of 10 years is recognized which can further be renewed for 5 more years before the expiry of period of 10 years.

III. DESIGNS ACT OF 2000:

The purpose of the Designs Act (hereinafter, Act) is to provide protection of the intellectual labour of a person utilized in developing a design. The Act provides an initial copyright protection to the industrial design for ten years, which is extendable for a second period of five years from the expiration of the original period of ten years. The Act by enlarging the scope of the term 'article' defined under Section 2 (a) of the Act, has brought within its ambit any part of an article capable of being made and sold separately in addition to what was protected under the repealed Designs Act, 1911. The Bombay High Court, while explaining the meaning of the words 'capable of being made and sold separately', in the case of Marico Ltd. v. Raj Oil Mills Ltd., AIR 2008 Bom111, HELD that the phrase covers the cases not only that an article upon which a design article can be made but

also can be sold separately. Therefore such article is separate from the other parts of the goods and registered separately as a design, if intended and or desired by the proprietor of the registered article as capable of being made and sold, is saleable in the market separately and is register able under the Act.

The ambit of the term 'design' defined under Section 2 (d) of the Act was also expanded. The Supreme Court while explaining the meaning of the term 'design' HELD in the case of Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd., AIR 2008 SC 2520, that it is a feature or a pattern which is registered with the registering authority for being produced on a particular article by an industrial process, whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by an eye appeal (Wadehra, 2012, at 413).

The requirement of novelty or originality of a design is a pre requisite for the purpose of registration of such design. The same can be gathered from the provision contained in Section 4 of the Act prohibiting registration of designs, where a design besides other prohibitions, if not found new or original is incapable of being registration. Besides being new or original, it should not comprise or contain scandalous or obscene matter. Design should also not have a prior publication and should be distinguishable from the other registered designs. Additionally, design is capable of registration only if the same is applied to an article. Under Section 5 of the Act 'proprietor' of any new or original design fulfilling other conditions of the registration, can have copyright in the registered design and under Section 22 of the Act it would not lawful for any person during the existence of copyright of the proprietor in a design to imitate or fraudulently apply the same to an article for the purpose of trade or importation of such articles for sale, as it would amount to piracy or infringement of the design. In *Britannia Industries v. Sara Lee Bakery*, 2001 PTC 23 (Mad), where the applicant, Britannia Industries for the purpose of preventing the acts of piracy in their registered design of biscuits, filed a suit for injunction contending that the respondents in the impugned product 'Milk Wala', the milk cream biscuits, bore the design identical with or similar to their design. The Madras High Court on taking into account the facts of the case HELD that the main features in both the biscuits were not substantially same in the eye of the customer, who were children for the purpose of distinction, hence there was no infringement of the design and no piracy of the same as design is something that appeals to an eye and if it appears different than the question of piracy of that design does not arise.

IV. CONCLUSION:

The design is an intellectual property and the proprietor of the design, who may be an author of the design, or any person who has obtained a design from the author for good consideration, or any person on whom design has devolved from the original proprietor, has a right of legal protection only if the design fulfills the criteria of register ability under the Designs Act, 2000. After the registration the proprietor of the design gets a copyright in the design for a period of ten years, which can further extended by the law for five years and cannot be fraudulently misappropriated. The Act is in compliance with the TRIPS Agreement, which requires the design to be new or original and also demands protection of such designs.

REFERENCE

- Bainbridge, David (2003), Intellectual Property, (Delhi: Pearson Education), First Indian Reprint. | -Bhandari, Dr. M.K. (2010), Law Relating to Intellectual Property Rights, (Allahabad: Central Law Publications) 2nd Edition. | -Macrorry, Patrick F. J., Appleton, Aurthur E., and Plummer, Michael G., (2005) The World Trade Organization: Legal, Economic and Political Analysis, (Springer Science + Business Media, INC.: New York), Vol. I. | -Paul, Meenu (2009), Intellectual Property Laws, (Faridabad: Allahabad Law Agency), 3rd Edition. | -Wadehra, Dr. B.L. (2011), Law Relating to Intellectual Property, (New Delhi: Universal Law Publishing), 8th Edition, (Reprint, 2012) | -Watal, Jayashree, (2001), Intellectual Property Rights in the WTO and Developing Countries, (New Delhi: Oxford University Press,).