

Designs and Patent: A Comparative Study

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ABSTRACT:

Intellectual property can comprise of various zones, from logos and corporate identity through to products, administrations and procedures that separate your business advertising. It's the point at which these thoughts are utilized without authorization that an organization can suffer. All organizations have without a doubt profited from the internet, where products, administrations and marketing communications can contact tremendous audiences at relatively low expenses yet this has additionally expanded the chances of intellectual property theft. IP protection applies to organizations of all sizes even tremendous companies have had their thoughts infringed upon and have made multi-million pound claims simply look at the on-going question amongst Apple and Samsung over their smart phones.

In Design is a process of taking something from its current state and moving it to a preferred state. This applies to new ancient artifacts, whose current state is undefined and already made artifacts, whose state stands to be improved. An industrial design is the commercial or aesthetic part of an article. It makes a product attractive and appealing thus they add to the business value of a product and increase its attractiveness¹. Designs implies just highlights of shape, configuration, pattern, ornament or composition of lines or colors connected to any article whether it is two dimensional or three dimensional or in the two structures, by any industrial process or means, regardless of whether manual, mechanical or chemical, isolated or consolidated which in the completed article appeal to and are judged exclusively by the naked eyes, but does not include any mode or rule of development or anything which is in substance a mere mechanical device. A patent is an intellectual property right identifying with inventions and is the grant of exclusive right for constrained period gave by the Government to the patentee. The motivation behind this framework is to encourage the inventions by advancing their protection and use in order to add to the improvement of industries, which thus adds to the advancement of technological development and to the transfer and discrimination of technology.

I. ENCOURAGING PROTECTION OF DESIGN-

As design enables firms to separate themselves and their products, in this way enabling them to fitting superior value contrasted and more "commoditized" product or service, protection of design rights may offer incentives to improve and put resources into outline in both manufacturing and service businesses. All things considered, industrial design is said in various international treaties.

The Berne Convention: The Berne Convention was the primary international copyright treaty, ended up viable in 1886 and characterized industrial design as an artistic work. Industrial design is not particularly controlled

¹ Howe, M, (2010) "Russell-Clarke and Howe on Industrial Designs", Eighth Edition, Chapter 1, page 1

under the Berne Convention, yet it is considered as a "work of applied art" [Art. 2(1)] and abandons it to the discretion of member nations whether they need to ensure industrial design as applied art [Art. 2(7)]. The convention gives equal rights to security of industrial design, with the end goal that if an industrial design is ensured under the laws of one signatory nation, it might get a similar protection under similar legislation in other signatory states. If a signatory state's law does not articulate on the protection of industrial design, the Berne Convention offers protection under copyright law, as it views industrial designs as artistic work.

The Paris Convention: The principal international treaty for the regulation of patents, the Paris Convention was signed in 1883 and the last amendment was made in 1967. Under the Paris Convention, industrial design was managed as industrial property and was agreed a patent-like protection. It stipulated that nationals of contracting states must be managed level with privileges of protection as nationals of other contracting states in those jurisdictions. An applicant can file separate applications with every office specifically to acquire protection in various jurisdictions, but gets protection from the time the first application was recorded insofar as the take after on applications were documented within twelve months for patents and utility models, six months for industrial design and trademarks². It likewise stipulated the industrial design must be managed assurance in a contracting state regardless of whether products got from those designs were not fabricated in that country. This was a push to bring down boundaries exchange³.

The TRIPS Agreement: The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) is controlled by the World Trade Organization (WTO) and wound up compelling in 1994. The TRIPS does not give a meaning of industrial design but rather only characterizes the necessities and extent of its protection. Language of the TRIPS Agreement is generally sparse with respect to industrial design. Regardless, it integrates configuration rights into the bigger ordinance of law giving worldwide protection of intellectual property. It additionally sets up at least ten years of protection for an industrial design that meets novelty and different necessities.

The Hague Agreement: Concluded in 1925 and modified in 1999, the Hague Agreement accommodated a solitary purpose of use for individuals from all signatory states. It builds up an underlying five-year protection period for industrial designs at the universal level, with the likelihood of numerous renewal periods. The advantage is that design proprietors can get protection for their designs with a single registration, consequently limiting conventions and cost. An applicant can acquire security for up to 100 industrial designs for products having a place with one and a similar class and in various purviews with a single application recorded through WIPO. The agreements and treaties give holders of design related intellectual property with a sound

² <http://www.indianpatents.org.in/faqdesign.htm#86>

³ "Declaration on TRIPs Agreement and Public Health," World Trade Organization, November 20, 2001, http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_trips_e.htm.

arrangement of rules and regulations whereby they can hope to get reasonable and unprejudiced treatment in as much as they work inside the set up arrangement of a member state.

Design protection vs patent protection (2013) Adams and Adams, Journal of Intellectual Property Rights

A design must be new and original, while a functional design must be new and not commonplace in the art being referred to. Despite the fact that the extent of protection acquired by method for an registered design might be fairly smaller than that got by method for a patent, the protection managed by method for a design registration may well be more grounded sometimes, i.e. it might be less vulnerable to attack. Unlike patents, the designs act permits an author a grace period of a 6 months from the first public disclosure inside which a design application can even now validly be filed.

II. DEVELOPMENT OF TRIPS IN INDIA-

The TRIPS agreement set least measures for protection for IPR rights and furthermore set a time span inside which nations were required to make improvements in their laws to agree to the required degree of protection.

The Designs Act, 2000:

Science and technology boosting up in the start of twentieth century, and the inclination to give more dependable judicial setup came set up for better protection of this field and for the protection of the industrial designs. The means were required to be taken to advance increasingly improvement in plan industry by giving security under enlisted outline. In spite of the fact that it was extremely fundamental to secure the plan just to the degree it was required and no more than that and to permit utilization of accessible outline for nothing as well⁴. The present Act is in accordance with the TRIPS agreement and therefore line with globalization of trade and commerce.

The Industrial item essentially incorporates two variables, i.e. artistic work and working part of the product. In spite of the fact that in Design Act just aesthetic work is secured and not working part of the product, however the artistic work ought to be one of a kind and not common. For instance, table with for legs and top would not be considered as design, but rather the table with extraordinary top and remarkable style of base can be registered. Day by day industrial design becoming part of the life of the consumer by getting consumer eyes through one of a unique design. For a similar reason, it has turned out to be basic to give protection to such industrial designs.

Patents Act, 1970:

India in the wake of consenting to the TRIPS agreement and shaping piece of the Agreement setting up the

⁴ the report "From History to Policy - The development of design law - past and future", Alexander Carter-Silk and Michelle Lewiston

World Trade Organization (WTO) with the end goal of reduction of distortions and disabilities to worldwide exchange and advancement of effective protection of intellectual property rights, progressed toward becoming signatory, the Patent go about as changed time to time in the year 1995, 1999, 2002 and 2005 to meet its commitments under the TRIPS agreement. Further, it has been amended to help the different innovative advancements in India, to coordinate with the improvement of the International intellectual property laws, India has likewise made amendments in the Intellectual property rights⁵. The amendments were likewise gone for making the Act a modern, harmonized and easy to use enactment for protection of national and public interests alongside satisfying India's global commitments under the TRIPS Agreement. In this way the guidelines under the Patent Act have likewise been corrected and these ended up successful from May 2003. These rules have been amended by Patents (Amendment) Rules 2005, 01.01.2005. Subsequently, the Patent Amendment Act, 2005 is currently completely in power and operative.

The Modern Law design

The protection of design has exhibited the governing body and legal with challenges for more than 400 years. During this time, the duration, exclusion, extension and definition and the base prerequisites for protection of configuration have oscillated between extremes, reacting to changes in industry and economic pressure. However well meaning, the administrative history of design has been unremarkable and has led to unnecessary complexity. Today, designs in the UK are ensured by no less than five legitimate rights:

European Union registered designs rights,

European Union unregistered designs rights

United Kingdom registered design rights

United Kingdom unregistered design rights and aesthetic copyright.

The UK unregistered design right, made by the Copyright, Designs and Patents Act 1988 secures shape and configuration, yet leaves the protection of surface enhancement and ornamentation to the dispatch of copyright. In 2001, the Community Design Regulation made a unitary right which gave a base level of predictable protection over every EU member states, however with each being able to force distinctive neighborhood or national design right protection. While legislation has looked to embody the "essence of design" in a way which has predictable outcomes when tried in Court, the rights protected by the EU enactment contain various parts that require judicial interpretation. Recent case law outlines differentiating methodologies of the Office for Harmonization in the Internal Market (OHIM) and those of national Courts, which have added to the confusion

⁵ Hargreaves, Professor Ian. (May 2011) "Digital Opportunity: A review of Intellectual Property and Growth" - <http://www.ipo.gov.uk/ipreview-finalreport.pdf>

and unpredictability of result that is seen by industry. The judicial approach to deal with understanding of enactment has frequently seemed disconnected from the question behind its sanctioning. Judgments often appear to be subjugated to a legal want not to expand plan insurance any more distant than is completely important, being more concerned about the limitations than with the object of the rights granted.

III. PATENT REGISTRATION

Publication

All patent applications will be published in the official journal after 18 months from the date of filing or the date of priority whichever is earlier. There is also a provision for early publication of an Indian patent application by filing a formal request.

Opposition pre-grant representation

The Pre-Grant Opposition can be filed after the publication of the application in the Patent Office Journal, till the grant of the patent.

This opposition can be filed by any person against the grant of the patent along with a statement and evidence in support requesting a hearing at the appropriate office. This opposition will be considered after a request for examination of the application has been filed. The Controller then decides upon the merits of this case and if the Controller feels that the application needs amendment or rejection, a notice along with the opposition statement will be sent to the applicant in this regard⁶. The applicant must now reply within a period of 3 months from the date of the notice with a reply statement and evidence supporting his application again requesting a hearing

After receiving the statement from both parties the Controller, depending on the merits of the case, fixes a date and time for the hearing of the opposition. After hearing both the parties, the Controller shall then decide and the decision shall be notified to the parties giving reasons thereof.

Request for examination

The request for examination must be filed within 48 months from the date of priority or date of filing, whichever is earlier. The Patent Office will examine an application after the pre-grant publication of the Application.

In case of a divisional application, if this 48 month period has expired taking into account the deemed filing or priority date of a divisional application, then the request for examination can be filed within six months from the date of actual filing of the divisional application.

⁶ http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_3-main1.pdf

Examination

Once the request is filed, the Patent Office will issue the First Examination Report. The Applicant must respond to the objections raised by the Examiner and place the application in order for grant within 12 months from the date of issue of the FER. All procedural compliances must be met within the prescribed time. Subsequent examination report may be issued with outstanding objection or any new objection⁷. Irrespective of the number of Examination Reports issued, the Applicant has only 12 months from the First Examination Report to comply with all the requirements and place the application in order for a grant.

Grant

After the objections are met, the Patent Office will issue Intimation of Grant. The grant is then recorded at the Register of Patents and the Letters Patent is issued to the applicant. The date of patent is the date on which the application for patent is filed or is deemed to have been filed; except in the case of national phase patent applications, for which the date of patent is the PCT filing date.

Term of patent

20 years from the date of patent.

Post grant opposition-

Any interested person can file the Post Grant Opposition within 12 months from the date of publication of the grant of patent in the Patent Office Journal. For this purpose, a notice of opposition has to be filed in prescribed form at the appropriate office. This must be accompanied by a written statement containing details of the opponent's interest, the facts and matters on which the opponent bases his case in support of the grounds taken by him; the relief sought by the opponent; and the evidence⁸, if any. A copy of the statement and evidences must be provided to the patentee.

Reply statement and evidence by patentee

As a response the patentee can submit a reply statement setting out fully the grounds upon which the opposition is contested; and evidence, in support of his case. This reply statement has to be filed within 2 months from the date of receipt of the copy of the opponent's evidence. A copy of the statement and evidences is to be provided to the opponent by the patentee. The opponent strictly confining to matters in the patentee's evidence may file reply evidence. This reply has to be filed within 1 month from the date of delivery to him of a copy of the

⁷ <http://economictimes.indiatimes.com/news/economy/policy/national-ipr-policy-will-soon-go-for-cabinet-approval-nirmalashitharaman/articleshow/49386064.cms>

⁸ Bessen, J. and Meurer, M. (2005), 'The patent litigation explosion', Boston University School of Law Working Paper No. 05-18.

patentee's reply statement and evidence⁹. A copy of reply evidence has to be sent to the patentee also. After receiving the statement from both parties the Controller decides on the case and on the recommendation of the Opposition Board, a date and time for the hearing of the opposition may be fixed. The party desiring to be heard has to inform the Controller by a notice along with the prescribed fee.

Decision

After hearing the party or parties desirous of being heard, and after taking into consideration the recommendation of the Opposition Board, the opposition shall be decided and the reasoned decision of the Controller shall be notified to the parties.

Renewal

Renewal fee is to be paid only from the third year onwards and is to be paid before the expiry of the second year from the date of patent. Renewal fee is payable only after patent grant. If a patent is not granted within two years from the date of patent, then the renewal fees accrue till such time a patent is granted. All the renewal fees, which accumulate before the grant of patent, are paid upon patent grant and within three months from the date of recordal (the date, on which a patent is recorded in the Register of Patents). Subsequent renewal fees are due to be paid on or before the anniversary of the date of patent. Six months' grace period is available to pay renewal fees on payment of monthly surcharge. Failure to pay renewal fees leads to cessation of patent on the date on which the renewal has been due.

Restoration of patent

If a patent lapses due to non-payment of renewal fees, such patent can be restored, if necessary application for restoration is filed within 18 months from the date of cessation.

IV. DESIGN FILING AND REGISTRATION PROCEDURE IN INDIA

Filing an application- An applicant may apply for the registration of design by filing an application on prescribed form accompanied by the prescribed fee and four copies of the representation of the design.

The application can either be filed at the design wing of the patent office in Kolkata or any of the branch of the offices at Delhi, Mumbai, Chennai.

Examination- Unlike the procedure followed in patents, the design applications are taken up for examination by way of filing the application for registration of design only. That is no separate request for examination is required to be filed with the Indian patent office in this regard.

⁹ <http://spicyip.com/2014/03/delhi-hc-vacates-injunction-granted-in-favour-of-steelbird-design-not-new-or-original.html>

Notifications of objections- the applicant is required to correct the defects and resubmit the application to the patent office for acceptance within 6 months from the official date of the application.

Registration and publication- An application is accepted when all the shortcomings raised in the examination report have been rectified. If accepted the patent office issues the registration certificate and thereafter it is duly notified in the patent office's journal¹⁰.

In case of the objections are not rectified, a personal hearing is provided to the applicant. After hearing the controller decides whether the application should be accepted or not.

Term of protection- In India, a design registration lasts for a period of ten years from the date of registration of design. The term can be further extended for another five years by filing the application for extension along with the prescribed fee.

Cancellation of Registration of a Design

The registration of design may be cancelled at any time after registration of design, on a petition for cancellation in Form- 8, with a fee of rupees 1500/- to the Controller of Design on the following grounds-

That the design has been previously registered in India

That it has been published in India or elsewhere prior to date of registration

That the design is not new or original

Design is not registrable

It is not design under Clause(d) of Section 2¹¹

Restoration of the lapsed design due to non-payment of extension fee within prescribed time

A registration of design will cease to be effective on non-payment of extension fee for further term of five years, if the same is not paid before the expiry of original period of 10 years. However, new provision has been incorporated in the Act so that lapsed designs may be restored, provided the following conditions are satisfied:

Application for restoration in Form-4 with fee of Rs. 1,000/- is filed within one year from the date of lapse stating the ground for such non-payment of extension fee with sufficient reasons. If the application for restoration is allowed, the proprietor is required to pay the extension fee of Rs: 2,000/- and an additional fee of Rs. 1,000/- and finally the lapsed registration is restored.

Piracy of a Design

¹⁰ <http://www.scribd.com/doc/53318556/Evolution-of-Designs-Act-in-India-Protection-of-IndustrialDesigns-under-International-IPR-Regime>

¹¹ <http://www.theindependent.co.zw/2012/07/27/intellectual-property-perspectivesrationale-of-industrial-design-protection>

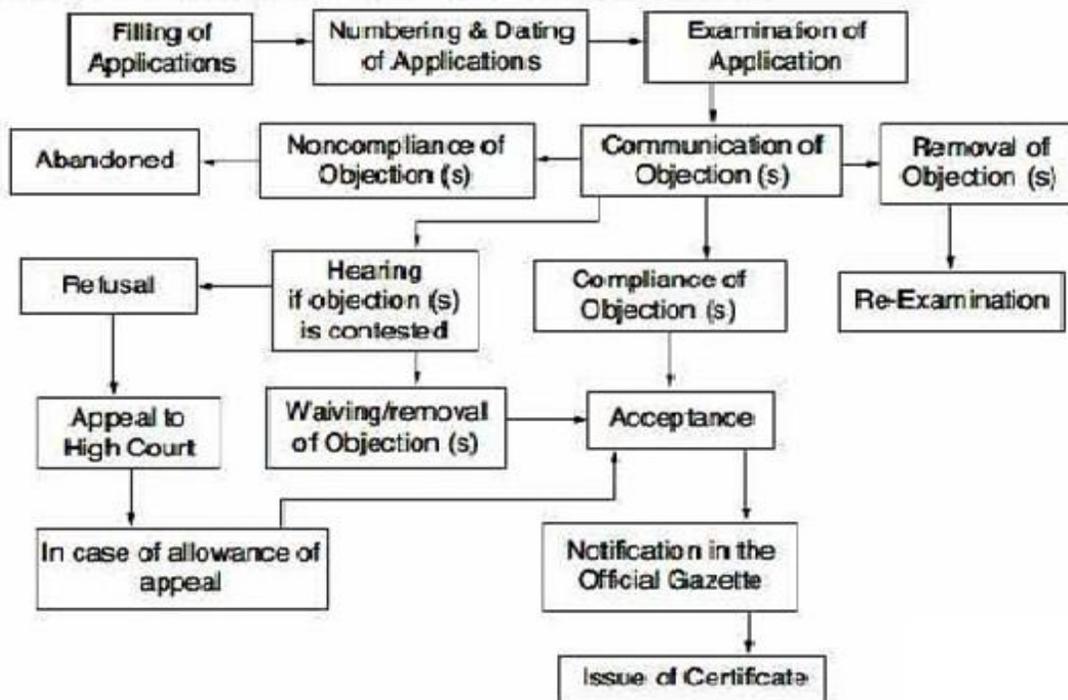
Piracy of a design means the application of a design or its imitation to any article belonging to class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor¹². Publishing such articles or exposing them for sale with knowledge of the unauthorized application of the design to them also involves piracy of the design.

Penalty for the piracy of a registered Design

If anyone contravenes the copyright in a design for the every contravention he/she is liable to pay a sum not exceeding Rs. 25,000/- to the registered proprietor subject to a maximum of Rs. 50,000/- recoverable as contract debt in respect of any one design. The registered proprietor may bring a suit for the recovery of the damages for any such contravention and for injunction against repetition of the same. Total sum recoverable shall not exceed Rs. 50,000/- as contract debt as stated in Section 22 (2) (a). The suit for infringement, recovery of damage should not be filed in any court below the court of District Judge.

Process of Registration of Design

The process of registration of a design is explained below



¹² <http://www.mondaq.com/india/x/65772/Trademark/Dabur+Design+Decided+Upon+No+Infringement>

V. CONCLUSION-

Design protection law contained in the Designs Act, 1911 is in fact the leftover part of Patents and Designs Act, 1911. The patent provisions which were repealed from the Patents and Designs Act, 1911 were incorporated in the Patent Act, 1970 after a thorough revision on the basis of expert committee report and legislative debates. But unfortunately no such exercise was undertaken in respect of design law. The Designs Act, 1911 is outdated in many respects and inadequate to meet the growing demands for design protection in India. The main deficiencies of the existing legislation which require immediate attention are outlined below. The definition of design under the Designs Act, 1911 is inadequate. Functional designs should also be included in the definition to make it effective. One can claim better rights under copyright law in functional or mechanical design but not under the Designs Act. Unlike patent annual report, there is no provision for annual report on designs.

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