

# All Things IP



**Eshwars | House of Corporate & IPR Laws**

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## AllThings IP Newsletter – May 2019

### Registration of Designs:

In this month's newsletter we bring out some basic and important information on another interesting area of Intellectual Property Rights (“IPR”) commonly known as Industrial Design Rights or Industrial Designs (“**Designs**”). Industrial Designs and its protection in India are governed under the Designs Act, 2000 and the Designs Rules, 2001, as amended from time to time. The abridged meaning of the word ‘Design’ as defined under the Designs Act, 2000 is as under:

“A Design:

- a. *is a shape, configuration and pattern, ornamentation or composition of lines or colours, of a finished article of manufacture that appeals to and is judged solely by the eye;*
- b. *may be in two or three dimensional or in both forms;*
- c. *shall be capable of being a product of industrial process or means;*
- d. *shall not be a mere mechanical device, mode or principle of construction;*
- e. *does not include any trademark (as defined in the Trademarks Act, 1999) or any property mark (as defined in the Indian Penal Code, 1860) or any artistic work (as defined in the Copyrights Act, 1957)”*

Thus, very simply stated a Design is that aspect of IPR which relates to the external appearance, visual elements and aesthetics of any product that has industrial utility in any business process and is different from a Copyright or a Trademark. While a Trademark (as an IPR), on a product substantially always pertains to the brand name or the trade name under which a product is sold, a Design pertains to the visual elements and shape of that actual product that is manufactured by an industrial process. By way of



an illustration: This image of Coca Cola bottle\*  
 , containing both the visual elements of the unique shape of the actual “Bottle” and the words “Coca Cola” is a “Trademark”, whereas the shape of the bottle in which the products are sold is a “Design” eligible for protection under the Design Act, 2000.

Following are the essential criteria for the registrability of a Design in India:

- Design should be new or original and significantly distinguishable from known designs or combination of known designs;
- Design has not been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the date of filing the application for its registration;
- Design does not comprise or contain scandalous or obscene matter.

The relevance of Design registration in today's business context has assumed paramount importance for organisations across various industries, more so owing to the fact that purchasing decisions of consumers today in India are not merely driven by brand names and trademarks but also the visual appeal of a product and its price. This has also indirectly led to a growth of counterfeit products in the market and in addition to this India is also witnessing a tremendous growth in e-commerce transactions, thus making it difficult for IP owners to enforce their rights against such counterfeiters who indulge in shameless imitation

\* Above image may be subject to copyright. Source: <https://www.target.com/p/coca-cola-de-mexico-12-fl-oz-glass-bottle/-/A-12959570>



of the distinctive visual elements of products in order to pass-off their counterfeit products as that of the original and consequentially leading to loss of competitive edge that could have arisen to such Design owners from their distinctive product Designs. Such imitation and counterfeits could very well also lead to brand tarnishment of the original IP owner owing to defective and inferior quality of products and industrial products employed in manufacturing of such counterfeit products. Thus, where any product has a distinctive packaging or where the external appearance of a product is intrinsically capable of being distinguished with that of other similar products or packaging then organisations need to seriously consider Design registration as an additional mode of IP protection that will go a long way in enforcing its IP against counterfeiters and infringers in an effective and timely manner.

From a procedural perspective, if a product satisfies all the above mentioned criteria, then it is strongly advisable to file an Application with the Indian Patent and Designs Office to protect the distinctive elements in the Design of a product prior to offering such product for sale to the general public or in any manner whatsoever publicising the same prior to its sale. It is also important to note that India follows the "First-to-file" rule in relation to registrability of Designs viz., If two or more applications relating to an identical or a similar design are filed on different dates, then the application that has been first filed shall enjoy priority over the latter in relation to the registration of such similar Design. It is also pertinent to note that prior to filing a Design application it is also strongly advisable to conduct a preliminary search to ascertain if the subject Design is similar to any other design already on the records of the Indian Patent and Designs Office. After having ascertained the same requisite application for the registration of such Design can be filed. The Indian Patent and Designs Office also allows online filing of the Design applications.



The registration of a Design will be valid initially for a period of ten years from the date of filing of Application and this initial period of registration may be extended by a further period of 5 years on an application made accompanied by prescribed fees to the Controller before the expiry of the said initial period of ten years. However, where the said registration has not been renewed as mentioned hereinabove, the said registration can still be restored within a period of one year from the date of expiry, by filing requisite form accompanied by the prescribed extension and restoration fee with the Indian Patent and Designs Office. It is pertinent to note if the proprietor of a registered Design has failed to extend or restore the registration as mentioned hereinabove, the Design will be removed from the register of design.

Once a Design has been registered, the registered proprietor has to mark each article with prescribed mark or with the prescribed words or figures so as to indicate that the Design is registered. For more details and assistance on registration of your Designs please contact [saisunder@eshwars.com](mailto:saisunder@eshwars.com).



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