

Design Registration

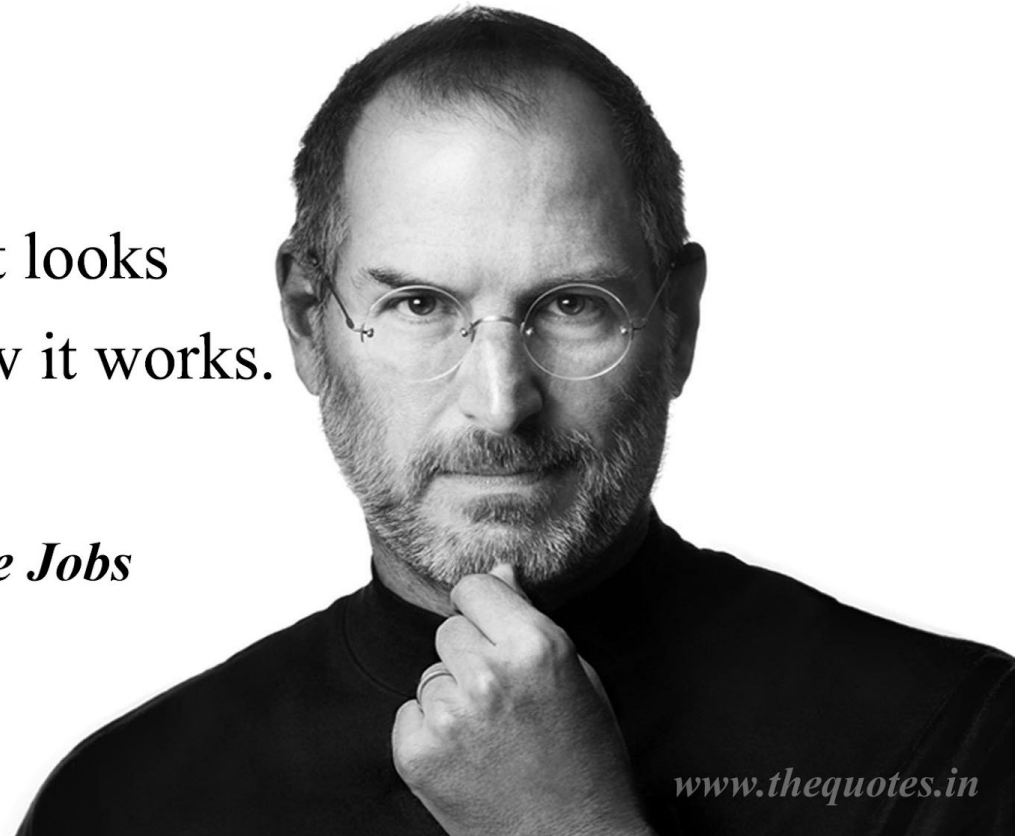
SWAPNA SUNDAR

IP DOME

How we understand design

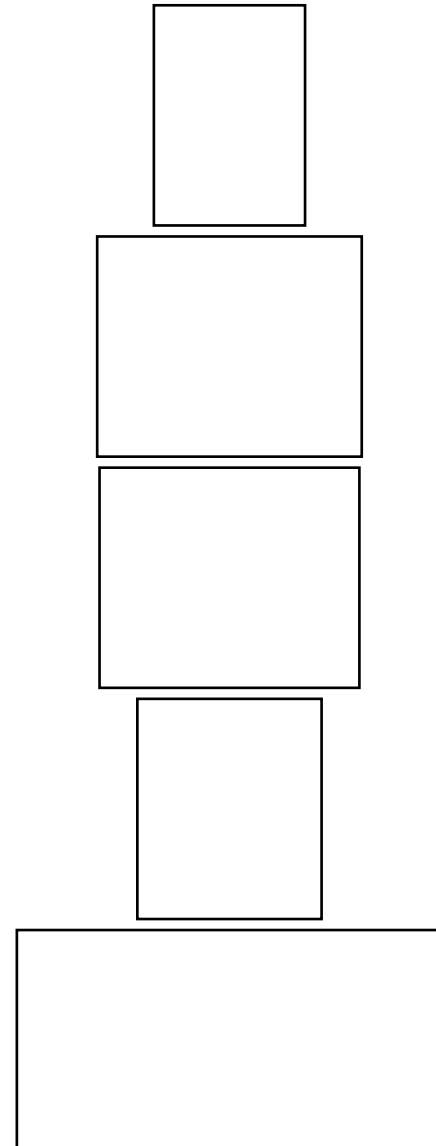
Design is not just what it looks
and feels like. Design is how it works.

Steve Jobs



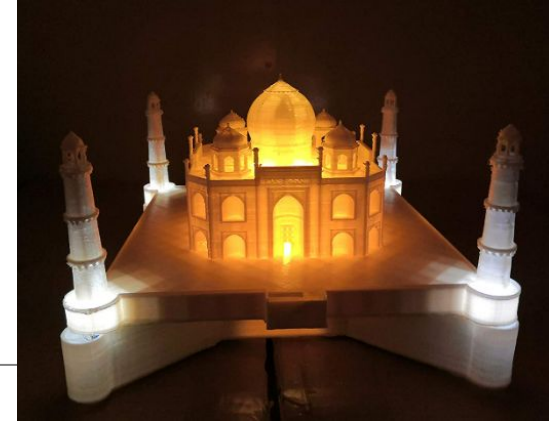
www.thequotes.in

...although there are different laws,
in industry, they work together



Designs Act , 2000

- which came into force on 11th May 2001
- repealing the earlier Act of 1911.
- Designs Rules , 2001 amended by Designs (Amendment) Rules 2008 and Designs (Amendment) Rules 2014, incorporates a new category of applicant as small entity in addition to natural person and other than small entity.
- (a) “article” means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately;
- (g) “original”, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;

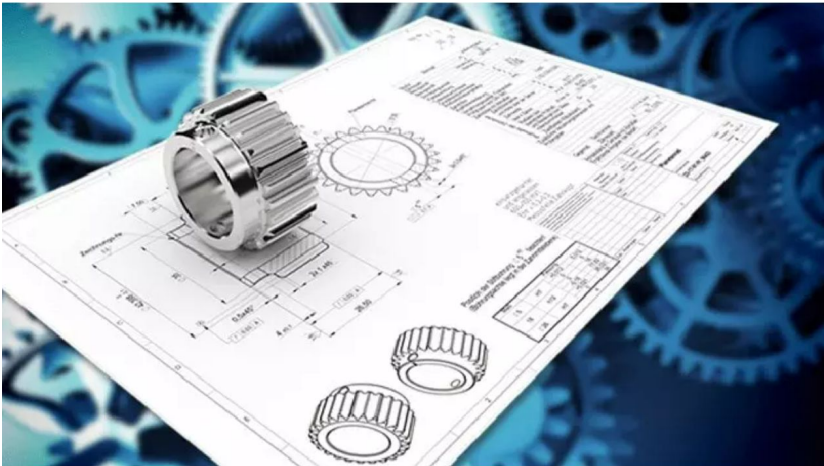


What the law says

Sec 2(d) "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 or property mark or any artistic work



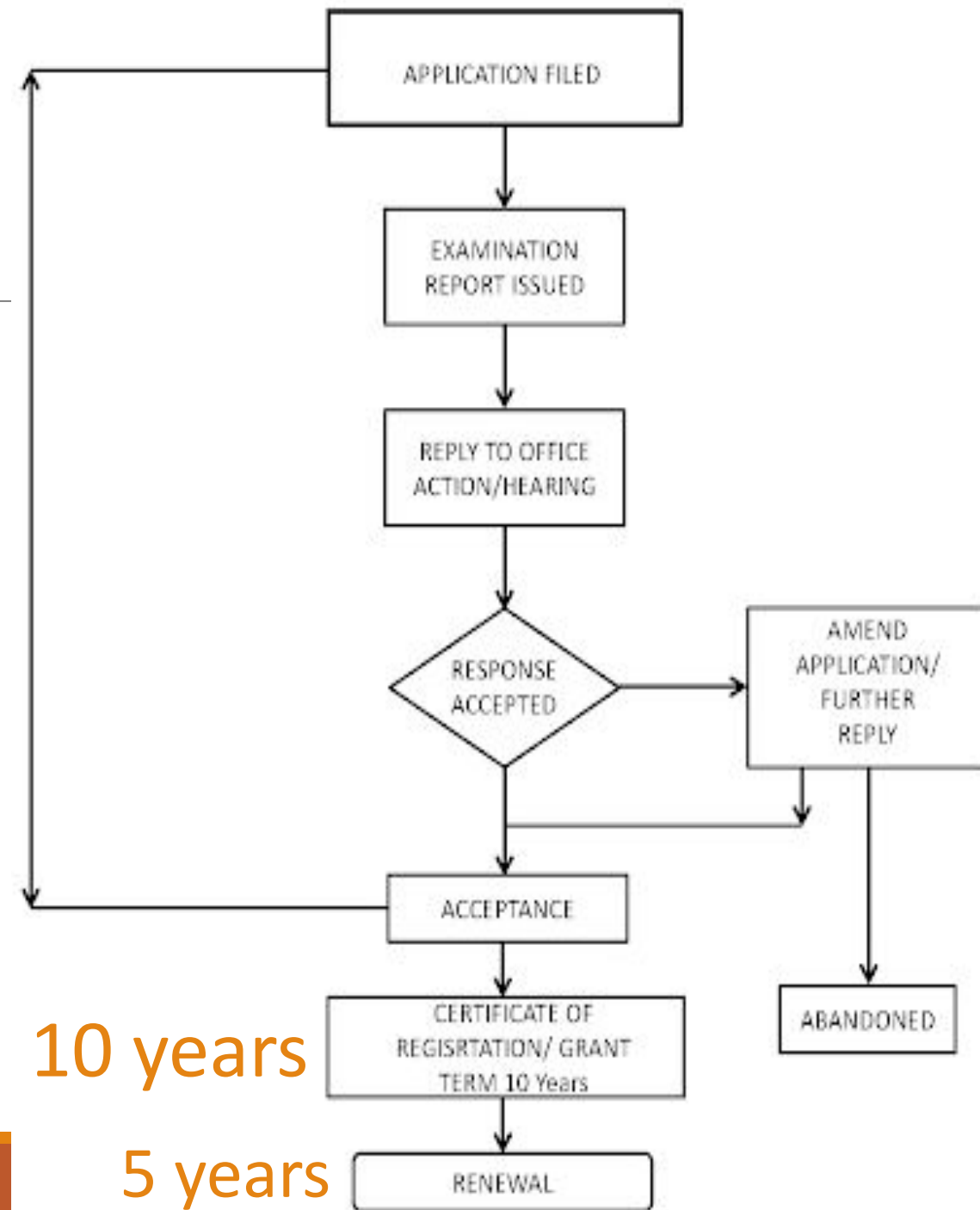
Engineering design and 'design'



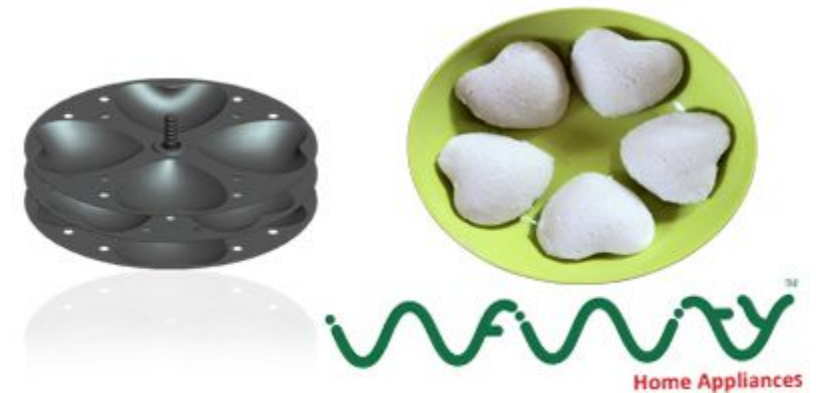
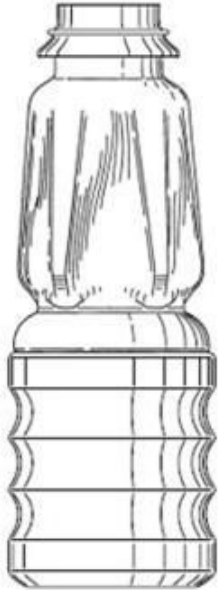
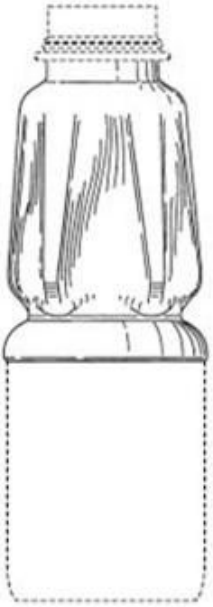
Engineering design means a systematic way to produce, or steps used for producing, functional products and/or processes. A lot of factors have to be taken into account in designing a new product.



Designs



Design



Requirements

2(g) "original", in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;

2 (j) proprietor of a new or original design: Person for whom the designer executed the work; person who acquires the design right; in any other case, means the author of the design.

4. A design cannot be registered if it is (a) not new or original; or (b) has been disclosed to the public anywhere in India or in any other country by publication, use or in any other way prior to the filing date; (c) is not significantly distinguishable from known designs or combination of known designs; or (d) comprises or contains scandalous or obscene matter.



Sanganeri hand block printed textiles got a geographical indication (GI) on March 19, 2010. (Image: Hastkaar by Bahrtesh Vaibhav)



Nilaya Sabyasachi Wallpaper - Sanganer

Significantly distinguishable



Birss...rectangular, biaxially symmetrical slab with four evenly, slightly rounded corners; flat transparent surface without any ornamentation covering the entire front face of the device up to the rim; A very thin rim of constant width, surrounding and flush with the front transparent surface; rectangular display screen surrounded by a plain border of generally constant width centred beneath the transparent surface; substantially flat rear surface which curves upwards at the sides and comes to meet the front surface at a crisp outer edge; thin profile; Overall, a design of extreme simplicity without features which specify orientation

Samsung v. Apple, UK High Court of Justice
Chancery Division, Patents Court – 09/07/2012

Concepts

1. Informed user – user of handheld (tablet) computers; is interested in functioning, performance and aesthetics; how it looks matters to the informed user.
2. Design corpus – not purely functional designs like engine parts; the other designs for products of that type which existed at the date of creation of the relevant design; informed user is aware of design corpus.
3. Overall impression on comparison – Important to consider both similarities and differences.
4. Degree of freedom –

The informed user, therefore, appears to be a particularly observant person who, being neither the producer or seller of a product that incorporates the design at issue, nor a technical expert or designer, makes use of the product according to its intended aim, exhibiting a relatively high degree of attention when using it (Case T-153/08 Shenzhen Taiden Industrial Co v OHIM [2010] ECR II-02517)

Based on

THE INFORMED USER

A user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller. Unlike the average consumer of trade mark law, he is particularly observant, has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned and is interested in the products concerned and shows a relatively high degree of attention when he uses them. He conducts a direct comparison of the designs in issue. Does not merely perceive the designs as a whole, and does not analyse details, nor observes in detail minimal differences.

THE EXISTING DESIGN CORPUS

The idea of tablet computers: imagined in science fiction, referring to Star Trek (from 1966 onwards) and 2001: A Space Odyssey (Stanley Kubrick, 1968). Any tablet computer should offer unfettered views of electronic media by means of a large display screen and that the screen would be the main element in the design of any tablet.

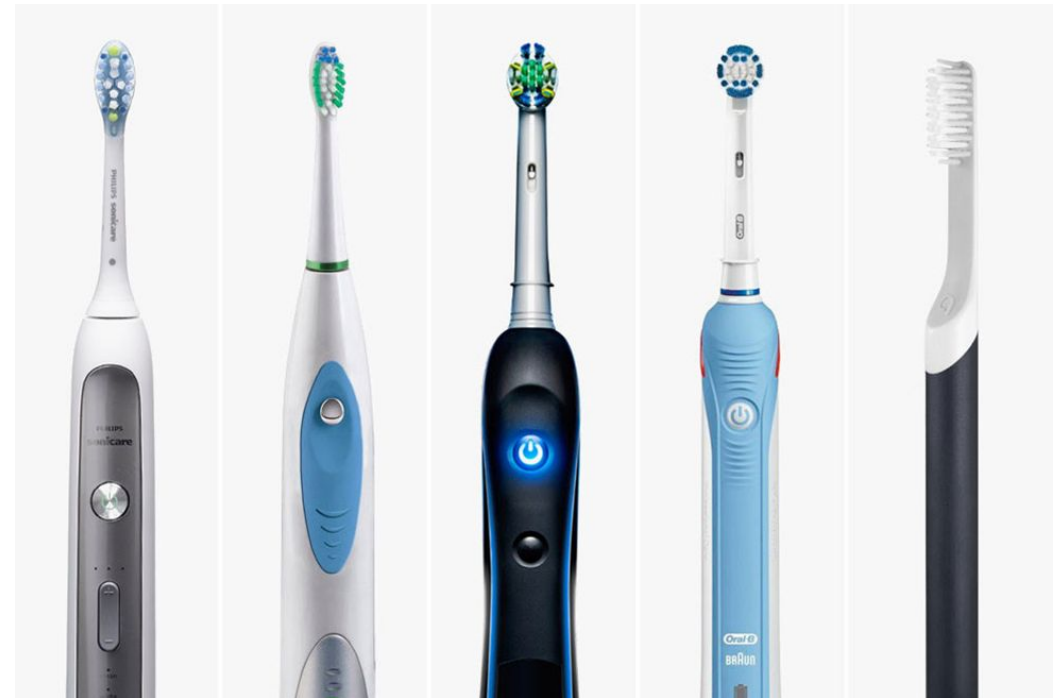


Function

1. Design freedom – design options: “design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

2. Solely dictated by function

Apple's list of features included a ‘surface without any ornamentation’ and ‘without features which specify orientation’, and Samsung did not challenge this as a characterization of the registration. Accordingly, both Judge Birss and the Court of Appeal accepted lack of ornamentation as a feature of the design registration.



5. Application for registration of designs.—

1) The Controller may, on the application of any

person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act: Provided that the Controller shall before such registration refer the application for examination, by an examiner appointed under sub-section (2) of section 3, as to whether such design is capable of being registered under this Act and the rules made thereunder and consider the report of the examiner on such reference.

(2) Every application under sub-section (1) shall be in the prescribed form and shall be filed in the patent office in the prescribed manner and shall be accompanied by the prescribed fee.

(3) A design may be registered in not more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Controller may decide the question.

(4) The Controller may, if he thinks fit, refuse to register any design presented to him for registration; but any person aggrieved by any such refusal may appeal to the High Court.

(5) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(6) A design when registered shall be registered as of the date of the application for registration.

Registration requirements



6. Registration to be in respect of particular article

- (1) A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.
- (2) Any question arising as to the class within which any article falls shall be determined by the Controller whose decision in the matter shall be final.
- (3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof be invalidated— (a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or (b) on the ground of the design having been previously published in India or in any other country, by reason only that it has been applied to article in respect of which it was previously registered: Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.
- (4) Where any person makes an application for the registration of a design in respect of any article and either— (a) that design has been previously registered by another person in respect of some other article; or
(b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application, the applicant, had been the registered proprietor of that design

Locarno classification

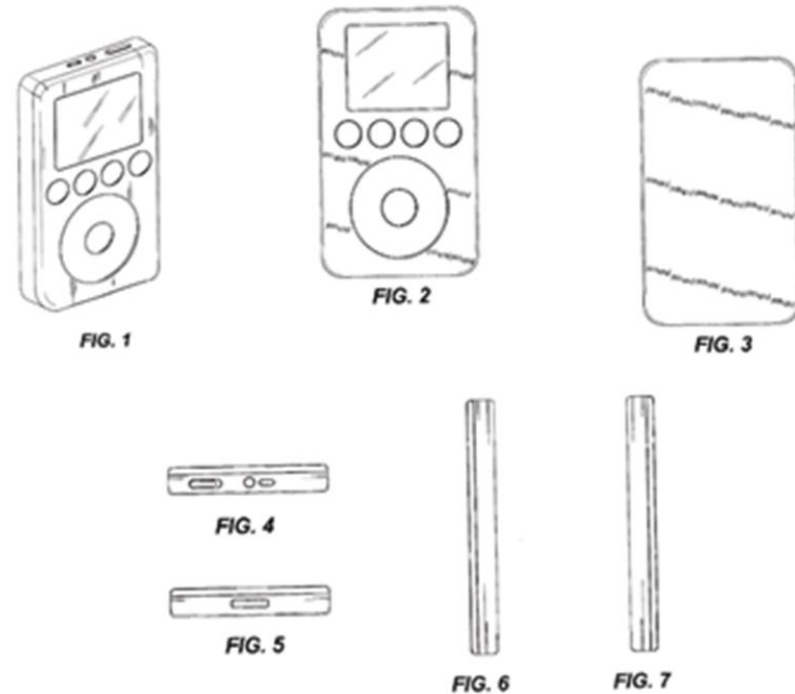
Was established by the Locarno Agreement (1968), is an international classification used for the purposes of the registration of industrial designs.

32 classes

Computers/calculating machines in Class 18

Design patent granted 2006 for the ornamental design of its third-generation (3G) iPod media player

TM 2007 consists of the design



21. Provisions as to exhibitions.—

The exhibition of a design, or of any article to which a design is applied, at an industrial or other exhibition to which the provisions of this section have been extended by the Central Government by notification in the Official Gazette, or the publication of a description of the design, during or after the period of the holding of the exhibition, or the exhibition of the design or the article or the publication of a description of the design by any person elsewhere during or after the period of the holding of the exhibition, without the privity or consent of the proprietor, shall not prevent the design from being registered or invalidate the registration thereof:

Provided that—

- (a) the exhibitor exhibiting the design or article, or publishing a description of the design, gives to the Controller previous notice in the prescribed form; and
- (b) the application for registration is made within six months from the date of first exhibiting the design or article or publishing a description of the design.

22. Piracy of registered design.

(1) During the existence of © in any design it shall not be lawful for any person— (a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor; or (b) to import for the purposes of sale...; or (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention— (a) to pay a sum not exceeding 25K recoverable as a contract debt, or (b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly: Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed 50k: Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge. (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under section 19 shall be available as a ground of defence. (4)

Notwithstanding anything contained in the second proviso to sub-section (2), where any ground or which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence under sub-section (3) in any suit or other proceeding for relief under sub-section (2), the suit or such other proceedings shall be transferred by the Court, in which the suit or such other proceeding is pending, to the High Court for decision. (5) When the court makes a decree in a suit under sub-section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs.

Delhi High Court - Reckitt Benckiser (India) Ltd. vs R.R. Corporation - 2005

Harpic Power Bottle with a unique and unusual child resistant cap registered in No. 184080, 2000 in Class 3 - defendant sold MAGIK toilet cleaner in a bottle which incorporates the design of the plaintiff and thus infringes the copyright in the design subject of design registrations 176807 and 184080.

Use of the similar bottles by the defendant attract members of the trade and public to the product of the defendant and in the circumstances, defendant passes off his products as that of plaintiff.



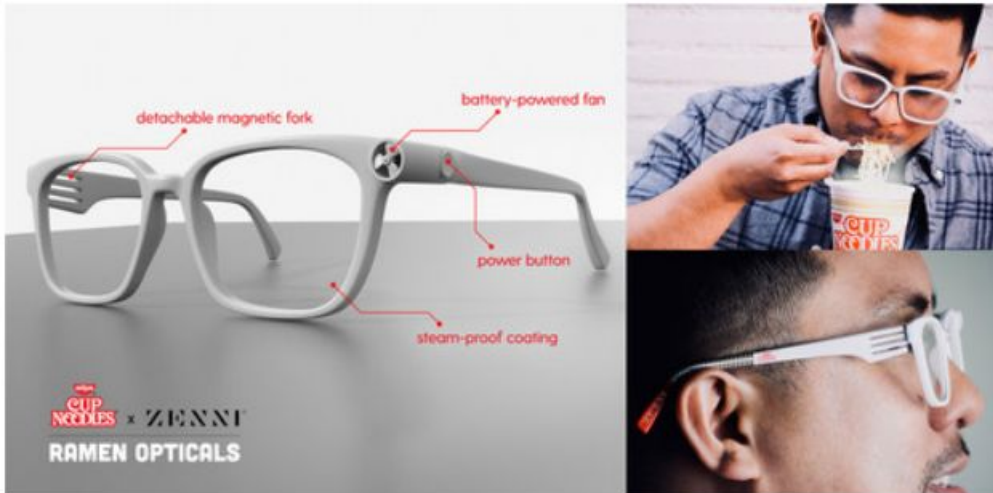
Delhi High Court - Mattel, Inc. & Ors. vs Mr. Jayant Agarwalla & Ors., 2008



Scrabulous faced legal issues due to its resemblance to Scrabble along with a similar name. It also copied the board layout, rules, and at one stage the number of tiles. These issues forced the removal of the game from Facebook in mid-2008 and its eventual rebranding. The rights to Scrabble are currently owned within the US and Canada by Hasbro, and throughout the rest of the world by Mattel. No design registration - although the game Scrabble itself could not be copyrighted as it is a 3-D board, and the Agarwalla brothers could therefore continue to offer their similar game online, they were however not permitted to use the name Scrabulous or any other name similar to that of Scrabble. Now called Lexulous.

23. Application of certain provisions of the Act as to patents to designs.—

The provisions of the Patents Act, 1970 (39 of 1970) with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for reference to a patent, and of references to the proprietor of a design for references to patentee, and of references to the design for references to the invention.



Stylish and functional Ramen Opticals employ an integrated electric fan & steam-resistant glasses specially-designed to wear while eating warm and steamy Cup Noodles

Madras High Court - M/S Maya Appliances Private vs Butterfly Gandhimathi, 2017



As product has several functional aspects, they filed a patent application on 01.10.2014, which is still pending. They also hosted a promotional video apart from making publication in the books such as Mangaiyar Malar, exhibiting the functional aspects of the products. Pleadings have been made in the plaint qua the functionality to the concept of framelessness. Thereafter, the applicants registered certain designs for the subsequent products under Registration Nos.272882, 272883, 276080, 272567 and 264344. The respondent/defendant has introduced the same framelessness recently at a higher price. Functionality v design - This Court cannot give a relief to the applicants, which they would otherwise might become entitled to under the Patents Act, 1970.

Bombay High Court Whirlpool Of India Ltd vs Videocon Industries Ltd, 2014



In 2012 Whirlpool filed a civil suit against Videocon contending that the washing machines manufactured and marketed by Videocon under the brand name Videocon Pebble infringed Whirlpool's design registrations Nos 223833 and 223835, and that Videocon was passing off its machines as those of Whirlpool.

Test of the eye – attributing design to functional aspects, specious arguments about being influenced by Matsushita Washing Machine.

Bombay High Court -M/S. Kemp & Company & Another vs M/S. Prima Plastics Ltd. 1998

- The plaintiffs claim that the design of Baby chair with human face on the backrest has been originally conceived by them in or about 1994. Defendants claim earlier publication by 3rd company.
- the design of the defendants chair is not substantially different from the plaintiffs chair.
- The design has an educational use.

Copyright and design right

A famous painting/photo will continue to enjoy the protection available to an artistic work under the Copyright Act.

A design created from such a painting for the purpose of industrial application on an article may also be entitled design protection in terms of the provisions of the Designs Act.

If the design is registered under the Designs Act, the design would lose its copyright protection under the Copyright Act

If the design is registrable under the Designs Act but has not been registered, the design would continue to enjoy copyright protection until the threshold limit of its application on an article by an industrial process 50 times is reached. Once that limit is crossed, it would lose its copyright protection under the Copyright Act.

Original copies of sculpture – restricted to 13 from 9; French govt capped the reproductions at 12 for Rodin's *Thinker* and *The Walking Man*. In 1968 tax originals were limited to 8 copies benefiting from reduced VAT.



Sept 1954



23.02.1945



Debi Prasad
Roy Choudhry,
Jan 1959

Derivative, adaptive, transformative works



A 2017 Samsung poll ranked Girl with Balloon as the United Kingdom's number one favourite artwork.



Do you know these companies?

Quanta

Foxconn (Hon Hai)

Compal

Inventec

Wistron

Flextronics

Asus

...

Quanta

HP, Dell, Compaq, Apple, Cisco

Foxconn

(Hon Hai)

ipad, Acer, Cisco, HP,
Microsoft

Compal

Motorola, Lenovo, Dell, imac

Inventec

HP, Toshiba, Acer

Wistron

Acer, Microsoft

Flextronics

Microsoft, Kodak, Ericsson, Lenovo, Dell

The vast majority of laptops on the market are manufactured by a small handful of Original Design Manufacturers (ODM)

ODMs design & manufacture products which are specified and eventually branded by another firm.

ODM owns and/or designs in-house the products that are branded by the buying firm. ODMs create their own intellectual property and are proactive in patenting it.

Some companies, such as Hon Hai patent their innovations at three times the rate of IBM when measured on a per employee basis. Most of their patents are filed in the US, Taiwan and China.

- - 82.6% of ODMs are based out of Taiwan.

Several ways to make a car

No Radio, Power windows, air conditioning, anti lock brakes, air bags, remote locks or power steering.

Cheaper

Rear wheel drive: manually actuated 4-speed trans axle that gives the car better fuel efficiency

Wheel Bearing: Wheel bearing is strong enough to drive the car at 72kmph but would quickly wear out at higher speeds.

Analogue speedometer, odometer and fuel gauge.

Single windscreen wiper



Or

... *Understand* *taxation!*

Cars shorter than 4 meter in length in India have considerably lesser excise duty as they are classified as 'Small Cars'. The Difference in excise duty is around Rs. 22,000 which can be transferred to customers



Tata Indigo CS:

Length 3,988 mm
Width 1,620 mm
Height 1,540 mm
Wheelbase 2,450 mm
Ground clearance 165 mm

Tata Indigo Manza 4.413 mts

Manza CS 42 cm shorter - will be achieved by cutting down space near the front grille of the car.

FUEL EFFICIENCY OF av.17kpl achieved through engineering design features:

Engine: 69bhp, 14.2kgm DiCOR engine

Concentration on reducing friction losses on the 1.4-litre DiCOR diesel.

Design changes in the cylinder head and sealing gaskets.

Improved camshafts and valves and an ECU re-calibration.

Tata's engineers have also paid keen attention to small things like wheel bearings; *and fitted the new e-CS with lower-rolling resistance tubeless tyres.*

The brand name for a range of precisely-cut crystal (a particular type of glass) and related luxury products produced by Swarovski AG of Wattens, Austria.



POETRY of PRECISION: Swarovski is the synonym for crystal.

In 1895, Daniel Swarovski pursued his dream of creating a crystal so perfect that it captured both the eye and the heart.

•



Swarovski, now the undisputed world leader in cut crystal has remained fully independent since its foundation in Wattens, Austria. The company employs 26,000 people and maintains a presence in more than 120 countries worldwide.

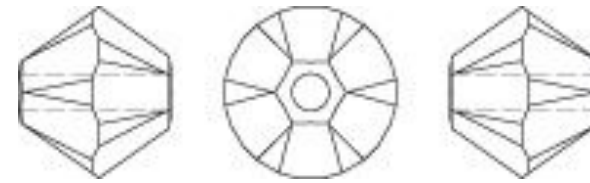
The company draws its richness of expression from the cultural heritage of Central Europe and its talents from *forging links between the arts, science and economics.*

•

In 2007 Swarovski formed a partnership with electronics giant Philips to produce the "Active-Crystals" consumer electronics range. This includes six USB Memory keys, four in-ear headphones, and Bluetooth wireless earpieces with some form of Swarovski crystal on them as decoration.



Patented Xilion Cut



Swarovski has become the world-leading producer of precision-cut crystal lighting. The Swarovski philosophy is that crystal reveals its full beauty and array of colours only in proper combination with light. So those who know how to handle crystal have the power to control light as well.

With expertise in glass production and finishing technologies already used to manufacture jewellery stones, Wilhelm Swarovski developed **a novel prism fabrication and grinding process** that he applied in constructing his first 6x30 binocular and founded SWAROVSKI OPTIK in 1949. His company's first serial product, the Habicht 7x42, is still an industry standard in the field of hunting optics, followed by the first telescope, rifle scope with shock absorber and extendable telescope



In 1892, Daniel Swarovski patented an electric cutting machine that facilitated the production of crystal glass. Swarovski markets the grinding and dressing tools it has developed under the brand name of TYROLIT. In 1919 the TYROLIT company is founded and the brand registered and protected.



SWAREFLEX was founded in 1950 to exploit their expertise in glass elements. They produce reflectors and road marking studs with glass elements in a variety of sizes and designs ever since.



Every new era offers new possibilities for action and development. One must remain alert at all times, always ready to make the very best use of what emerges.



"constantly improve on what is good."

DANIEL SWAROVSKI I
(1862 - 1956)



Daniel J. Cohen, head of Swarovski's North American division, situated outside of Providence, R.I. Says: "The luxury aspect is important, but the money is made in the everyday product."

Thank you for your patience



swapna@ipdome.in



www.swapnasundar.com



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