

MODULE 5

Industrial Designs: Eligibility Criteria. Acts and Laws to Govern Industrial Designs. Design Rights. Enforcement of Design Rights. Non-Protectable Industrial Designs India. Protection Term. Procedure for Registration of Industrial Designs. Prior Art Search. Application for Registration. Duration of the Registration of a Design. Importance of Design Registration. Cancellation of the Registered Design. Application Forms. Classification of Industrial Designs. International Treaties. Famous Case Law: Apple Inc. vs. Samsung Electronics Co.

Geographical Indications: Acts, Laws and Rules Pertaining to GI. Ownership of GI. Rights Granted to the Holders. Registered GI in India and their Identification.

Classes of GI, Document and Procedure required for GI registration

08 Hours

□ Definition of Design

- The word 'Design' is defined as the features of shape, configuration, pattern, ornament, or composition of lines or colors applied to any article.
- The Design may be of any dimension, i.e., one or two or three dimensional or a combination of these.
- In addition, it may be created by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeals to and is judged solely by the eye.
- However, the word 'Design' does not include any mode or principle of construction or anything that is in substance a merely mechanical device.
- Example : Consider a smartphone case with a unique pattern embossed on its surface. The pattern and its arrangement contribute to the design of the case
- Object of Registration:
- The main object of registration of industrial designs is to protect and incentivize the original creativity of the originator and encourage others to work towards the art of creativity
- Example : If an artist creates a novel and unique design for a chair, registering that design ensures that the artist is recognized as the originator and has exclusive rights to the design

ELIGIBILITY CRITERIA

The Design for which protection is being sought must be novel or original, i.e., it should not be disclosed to the public by prior publication or by prior use or in any other way.

The Design should be significantly distinguishable from the already registered Designs existing in the public domain.

Example : Consider a new and unique chair design that has not been publicly disclosed or used before.

To be eligible for protection, this design must not closely resemble any existing registered designs in the public domain

Acts and Laws to Govern Industrial Designs

In India, Industrial Designs are governed under The Designs Act, 2000 (<http://www.ipindia.nic.in/acts-designs.htm>) and Design Rules, 2001 (<http://www.ipindia.nic.in/rules-designs.htm>), which have been amended from time to time in 2008, 2013, 2014, and 2019.

The Design should include the following characteristics:

- It should be novel and original.
- It should be applicable to a functional article.
- It should be visible on a finished article.
- There should be no prior publication or disclosure of the Design.

Design Rights

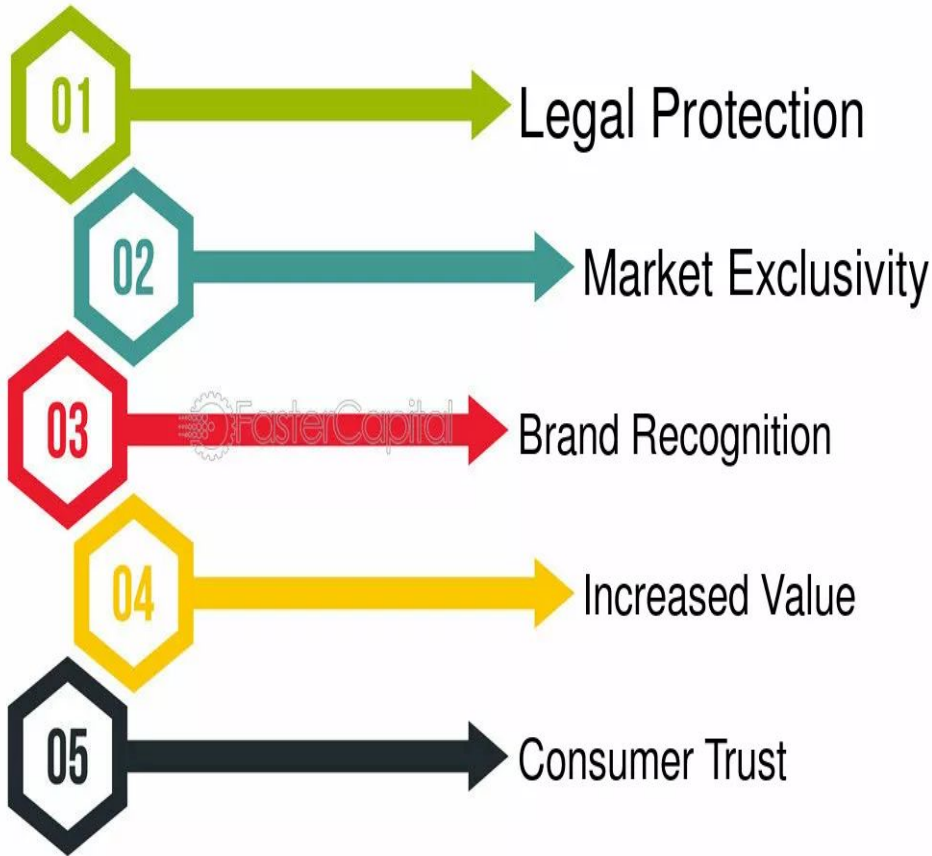
The Design registration also confers a monopolistic right to the Proprietor by which he can legally exclude others from reproducing, manufacturing, selling, or dealing in the said registered Design without his prior consent.

The Design registration is particularly useful for entities where the shape of the product has aesthetic value, and the entity wishes to have exclusivity over the said novel and original Design applied to its product(s) or article(s).

Example :Consider a company that designs a unique and aesthetically pleasing chair.

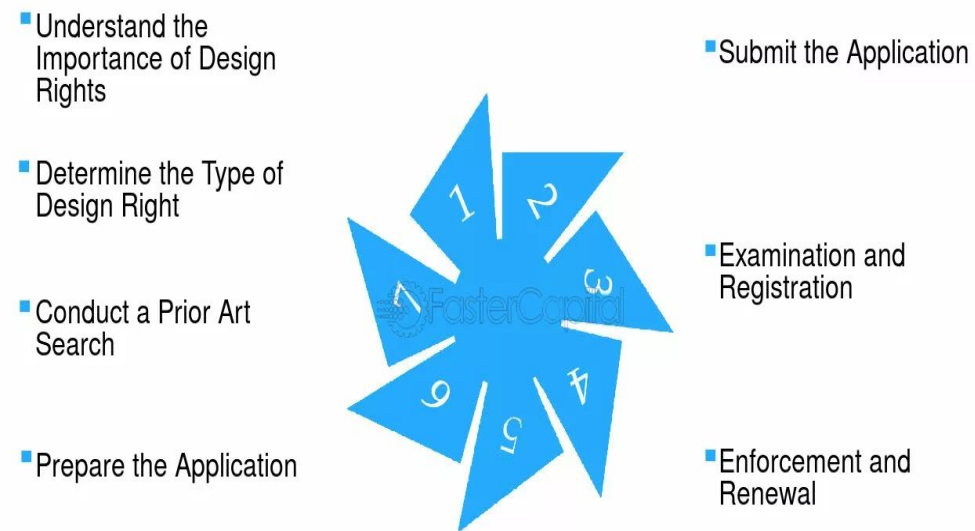
By registering the design, the company obtains exclusive rights to the design. This means that no other entity can reproduce, manufacture, sell, or deal in a chair with the same registered design without the prior consent of the proprietor

Benefits of Protecting Your Design



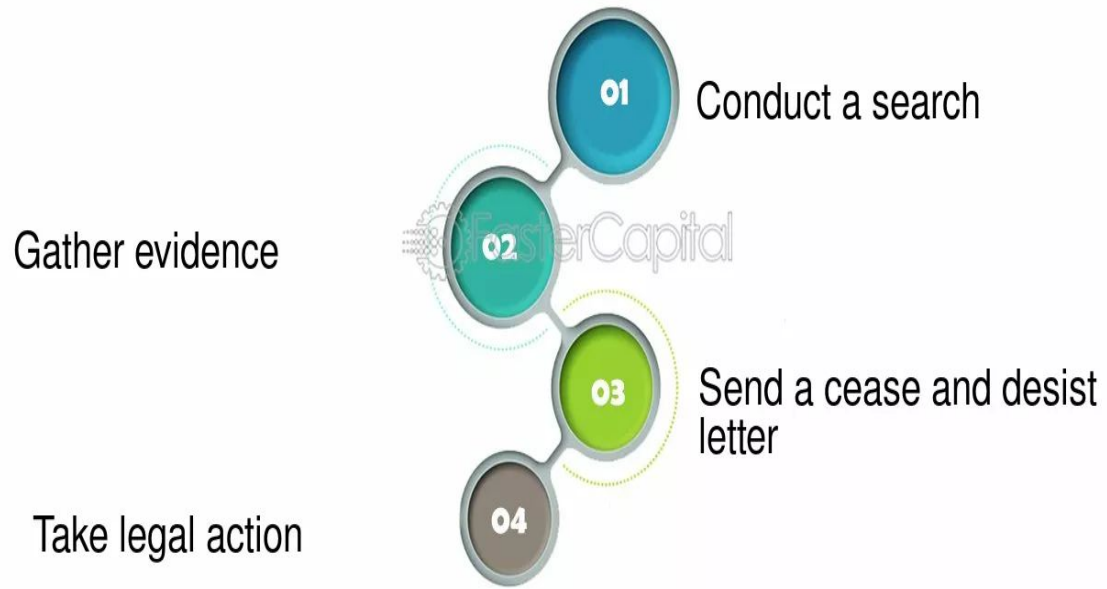
1. **Legal Protection:** Safeguards your design from unauthorized use and allows legal action against infringers.
2. **Market Exclusivity:** Grants exclusive rights to use and profit from your design, ensuring a competitive edge.
3. **Brand Recognition:** Distinguishes your products, strengthening brand identity and customer loyalty.
4. **Increased Value:** Adds business value, enabling licensing, sale, or use as financial collateral.
5. **Consumer Trust:** Enhances credibility and assures customers of your product's authenticity and quality.

Steps to Obtaining Design Rights



1. **Understand the Importance:** Design rights protect your product's appearance and ensure exclusivity.
2. **Identify the Type:** Choose suitable protection like industrial, registered, or copyright design rights.
3. **Conduct a Prior Art Search:** Check for existing similar designs to confirm originality.
4. **Prepare the Application:** Provide clear images and descriptions following IP office guidelines.
5. **Submit the Application:** File with the relevant IP office, include documents, and pay fees.
6. **Examination and Registration:** The office reviews for novelty and grants rights if approved.
7. **Enforcement and Renewal:** Monitor infringements, take action, and renew rights as required.

How to Identify and Respond



- Conduct a Search :**

Look for identical or similar products online, in trade fairs, or catalogs, or hire a professional searcher.

- Collect Evidence:**

Gather photos, screenshots, invoices, and other proof showing the infringing product, along with dates, locations, and infringer details.

- Send a Cease and Desist Letter:**

Notify the infringer formally to stop using your design, remove infringing products, and compensate for damages. Keep copies of all correspondence.

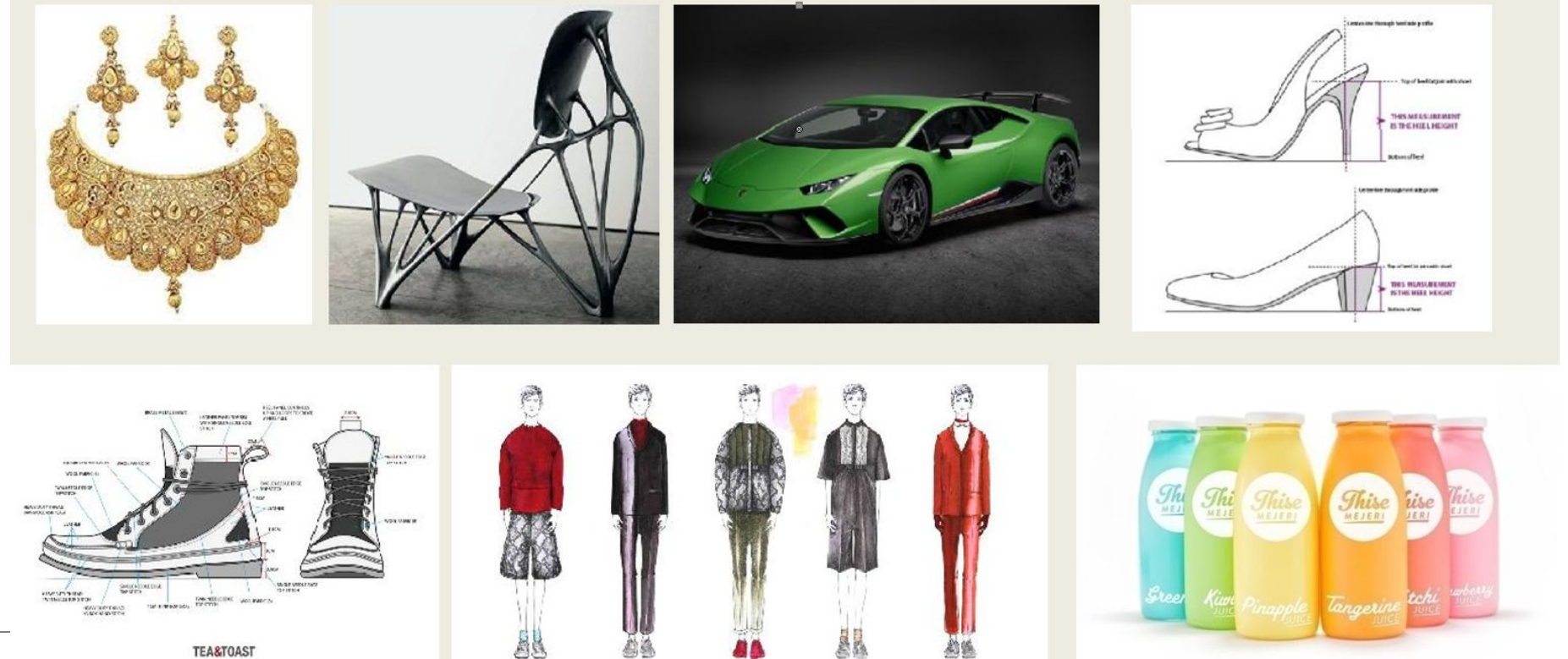
- Take Legal Action (if needed):**

File a lawsuit to seek an injunction, damages, or orders for delivery up/destruction of infringing products if the infringer fails to comply.

Industrial Designs

For Design Registration

1. Filing, Publishing,
2. FER From Office,
3. Reply for FER, then
4. Hearing and
5. Granting



What is Design?

‘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*.

List of Industrial Designs

A list of Industrial Designs can be accessed from <https://www.creativebloq.com/product-design/examples-industrial-design-12121488>. Some of the famous Industrial Designs are mentioned below:

1. Coca-Cola Bottle: The contoured-shaped glass bottle of the Coca-Cola Company is marvelled as a master showpiece in the field of industrial design. It was designed in 1915 and is still a cynosure or all eyes.
2. Piaggio Vespa: Piaggio is an Italian company famous for manufacturing Vespa scooters. These scooters are sold worldwide since the 1940s. The structural design of the scooter is pleasing to the eyes, with a painted steel body concealing the engine, comfortable driver's feet rest, and a well-designed front portion.
3. iPhone: A highly popular mobile phone manufactured by the American company 'Apple Inc.' The sleek, handy, and rectangular body is pleasing to the eyes, with round and smooth corners. The features, such as on/off and speech volume, are easy to operate.
4. Mini Cooper: An automobile car manufactured by the British Motor Corporation. Its unique shape provides plenty of space
- Rocking Wheel Chair: A sleek, circular-shaped chair that provides a smooth rocking motion. There is a provision for a headlight in the upper part of the chair.
6. Juicy Salif: A citrus juice squeezer considered an iconic structural design. The alumina-based body has been molded in the shape of the fish called squid

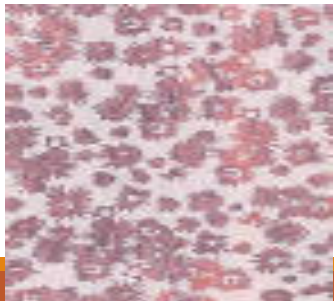
Consumer Products



Pharmaceutical Product



Textile & Jewellery



Design Registration Forms/Format

FORM 1

Application for Registration of Design

[See section 5 and 44]

You are requested to register the accompanying design in Class No.12 and Subclass No.11 CYCLES AND MOTORCYCLES

In the name of:

Sl. No.	Name	Nationality	Address
1	MOUNESH NAGALINGAPPA RAMPUR	Indian	NHCE Patent Cell, "MOUNA" KALIKANAGAR SINDAGI, BIJAPUR, KARNATAKA -586128

who claim(s) to be the proprietor(s) thereof.

Four exactly similar representations of the design accompanying this request.

The design is to be applied to **RASAHRA MOTORCYCLE DESIGN**

Details of first application in India or Convention country or group of countries or inter-governmental organization.

(i) Priority Country :

(ii) Priority Date:

(iii) Application Number:

(iv) Name of Applicant(s):

Address for Service in India is-

Declaration:

The applicant(s) claims to be the proprietor(s) of the design and that to the best of his knowledge and belief the design is new or original.

Dated this 06th day of December 2018

SIGNATURE
MOUNESH NAGALINGAPPA RAMPUR

To,

The Controller of Patents & Designs,
The Patent Office Kolkata

NAME OF APPLICANT: **MOUNESH NAGALINGAPPA RAMPUR**
SHEET NO.

NO.OF SHEETS USED: 14
: 01

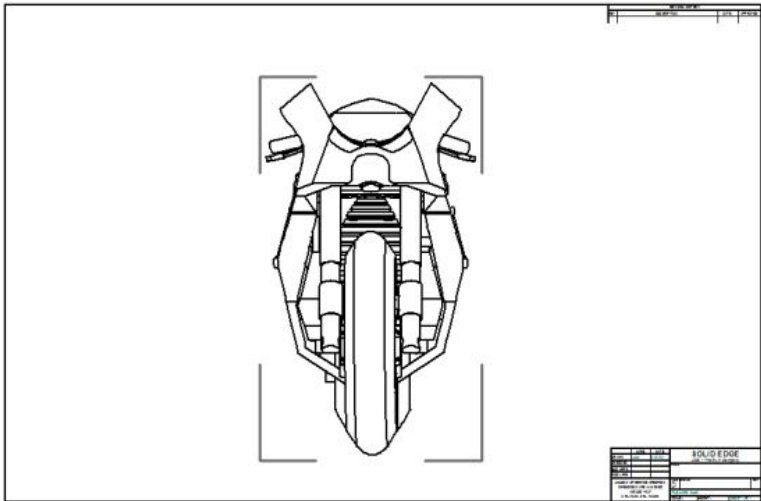


Fig 1 : showing front view of the new motorbike design

The novelty resides in the shape and configuration of MOTORCYCLE as illustrated:

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism or in respect of any mode or principle of construction of the article.

No claim is made by virtue of this registration in respect of the use of letters, numerals, trademark or words appearing in the said representation.

Dated this 06th day of December 2018

Applicant

NAME OF APPLICANT: **MOUNESH NAGALINGAPPA RAMPUR**
SHEET NO.

NO.OF SHEETS USED: 14
: 11

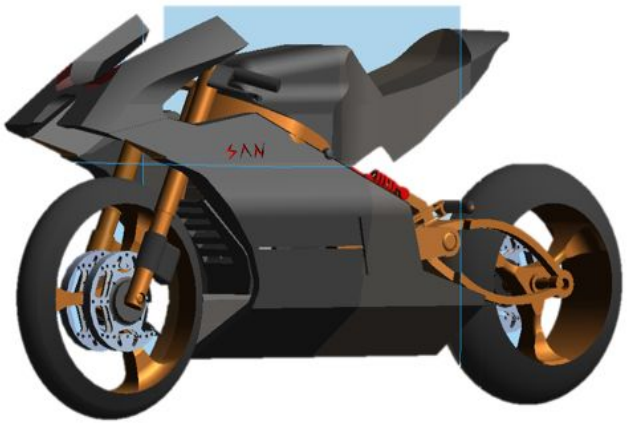


Fig 11: showing a front right perspective thereof,

The novelty resides in the shape and configuration of MOTORCYCLE as illustrated;

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism or in respect of any mode or principle of construction of the article.

No claim is made by virtue of this registration in respect of the use of letters, numerals, trademark or words appearing in the said representation.

Dated this 06th day of December 2018

Applicant

In 2011, Apple Inc. filed a case against Samsung Electronics Co. in the United States District Court for the Northern District of California for infringing their Designs and Utility Patents of the user interface like screen app grid and tap to zoom.

As evidence, Apple Inc. submitted the side-by-side image comparison of the iPhone 3GS and the i9000 Galaxy S to demonstrate the alleged similarities in both models.

However, later it was found that the images were tempered by the Apple Company to match the dimensions and features of the controversial Designs.

In simple words, this means that it was discovered later on that Apple had altered or changed the images to make them look like they fit the specific sizes and characteristics of the designs that were being questioned or criticized. Essentially, Apple adjusted the images to make them match the controversial designs more closely, possibly to make them appear more acceptable or to align with certain expectations.

Samsung's lawyer accused Apple of providing false and misleading evidence in court. In response, Samsung filed lawsuits against Apple in multiple places: Seoul (South Korea), Tokyo (Japan), Mannheim (Germany), Delaware (USA), and with the U.S. International Trade Commission in Washington D.C.

The proceedings continued for the 7 years in various courts. In June 2018 both companies reached for a settlement and Samsung was ordered to pay \$539 million to Apple Inc. for infringing on its patents.

\$539 million is approximately 44.83 billion INR.

The legal battle between Apple and Samsung went on for 7 years in different courts. Finally, in June 2018, both companies agreed to settle the case. As part of the settlement, Samsung had to pay Apple \$539 million because it had used Apple's patented technology without permission.

FAMOUS CASE LAW: APPLE INC. VS. SAMSUNG ELECTRONICS CO.



Apple and Samsung always had conflicts in business, sales, technological innovations, and many others because they are offering similar technology and are targeting the same market consumers.

Such rivalry competitions are regular market activities. Every company would strive to take a competitive advantage to gain a higher market share. Hence, several conflicts have existed between Samsung and Apple to beat rival technology, innovation, and global market share.

These rivalry strategies go to the next level, comprising legal obligations and court trails

Samsung and Apple have been involved in a direct conflict over the issues surrounding patent infringements.

As a result, the two firms have been engaged in severe lawsuits, which were first initiated by the legal team of Apple Inc., in the US district court against Samsung, for infringing various patent rights (Park & Kim, 2020). Some of the patents that Samsung was accused of 'adopting' include the utility and design patents.

On the other hand, Samsung also filed similar lawsuits against Apple, ranging from everyday essentials to feature patents. In this conflict, both sides lost in some cases and won in others.

Other types of conflicts were relatively smaller conflicts of which no such detailed and verified data could be found. Hence, the legal wars between the two were placed to be the most extreme conflicts. Both companies had been going through with unofficial cold war during the last several decades, but nothing was notable through official means.

Geographical Indications: Acts, Laws and Rules Pertaining to GI.

A GI is defined as a sign-used on products belonging to a particular geographical location/region and possesses qualities or a reputation associated with that region. In GI, there is a strong link between the product and its original place of production.

ACTS, LAWS AND RULES PERTAINING TO GI

In India, GI was introduced in 2003 and is governed under the Geographical Indications of Goods (Registration & Protection) Act, 1999
Geographical Indications of Goods (Registration & Protection) Rules, 2002

OWNERSHIP OF GI

The ownership/holders of GI (registered) can be of the producers, as a group/association/cooperative society or association or in certain cases, government

Geographical Indications of Goods

What is a Geographical Indication?

Geographical Indication is an indication which identifies goods as **agricultural** goods, **natural** goods or **manufactured** goods as originating, or manufactured in the territory of country, or a region or locality in that territory, where a given **quality, reputation** or **other characteristic** of such goods is essentially **attributable to its geographical origin**.

Registration

In India, geographical indications have to be registered.

Geographical Indications Registry examines and publishes the application before registration

Registration is valid for 10 years but can be renewed indefinitely

Rights

- ❑ Exclusive right to use the Geographical Indication on the goods
- ❑ Right to obtain relief for infringement of the Geographical Indication

Geographical Indications (GI)

Explanation clarifies that GI need not be a geographical name

□ E.g. Alphonso, Basmati

Goods include goods of handicraft or of industry and also foodstuff.

Kanchepuram Silk Sarees, Tirupati Laddu, Thirunelveli Halwa, Manaparai Murkku, Mysore Pak, Mysore Malligae, Dharawrd Peda, Hyderabad Briyani, Ambur Briyani, Kovilpatti Kadalai Mittai, Kovilpatti Kaarachevu, Darjeeling Tea, Nagpur Orange, Kolhapuri Chappals etc



Plant Varieties and Farmer's Rights

Protection of Plant Varieties (PPV) & Farmers Rights (FR)

- ▶ Registrable varieties and criteria:
 - New Varieties
 - ❖ Novelty, Distinctiveness, uniformity and stability
 - Extant varieties
 - ❖ Distinctiveness, uniformity and stability
- ▶ Persons who can Register

- ▶ Period of protection
 - 15 years for annual crops
 - 18 years for trees and vines

RIGHTS GRANTED TO THE HOLDERS

Right to grant the license to others - The holder has the right to gift, sell, transfer/grant a license, mortgage or enter into any other arrangement for consideration regarding their product.

A license or assignment must be given in written and registered with the Registrar of GI, for it to be valid and legitimate.

Right to sue - The holder of GI has the right to use and take legal action against a person who uses the product without his consent.

Right to exploit - The holder of GI can authorize users with exclusive right to use goods for which the GI is registered.

Right to get reliefs - Registered proprietors and authorized users have the right to obtain relief concerning the violation of such GI products

REGISTERED GI IN INDIA

- GI products registered in India belong to the domains of handicrafts, agricultural, food stuffs, alcoholic beverages, etc.
- The first GI tag was granted in 2004 to Darjeeling Tea and the latest being Kashmir Saffron and Manipur Black rice (Chakhao) in May 2020. A total of 370 GI have been registered in India till May 2020.
- Nearly 58% of these belong to handicrafts, followed by agriculture (30%).
- Other categories belong to food stuff, manufacturing, and natural goods.
- In the Handicraft category, Tamilnadu holds the maximum number (21) of GI followed by Uttar Pradesh (20) and Karnataka (19).
- A few stands out GI are mentioned in the below table

GI	Type	State
Darjeeling Tea	Agriculture	West Bengal
Mysore Silk	Handicraft	Karnataka
Kashmir Pashmina	Handicraft	Jammu & Kashmir
Banaras Brocades and Sarees	Handicraft	Uttar Pradesh
Naga Mircha	Agriculture	Nagaland
Tirupathi Laddu	Foodstuff	Andhra Pradesh
Phulkari	Handicraft	Punjab, Haryanam Rajasthan
Basmathi	Agriculture	India

○ IDENTIFICATION OF REGISTERED GI

- Registered GI products are granted a tag, which is printed on the registered products.
- The tag confirms the genuineness of the product in terms of its production (by set standards) and location of production.
- Non-registered GI products cannot use/exploit this tag.
- By and large, GI tags represent the place of origin (of the product) along with cultural and/or historical identity e.g. Darjeeling Tea, Mysore Silk, Tirupathi Laddu, etc.
- In India GI tags are issued by the Geographical Indication Registry under the Department for Promotion of Industry and Internal Trade, Ministry of Commerce and Industry.
- The head of GI registry is at Geographical Indications Registry Intellectual Property Office Building, Industrial Estate, G.S.T Road, Guindy and Chennai - 600032.
- GI registered products can be grown / produced in any part of the world using standards laid down by the GI Registry.
- However, these products cannot be labeled as GI as they are not produced/ manufactured in a specific geographical location, as mentioned in the official records maintained by the GI Office of GI.
- For example, plants of Darjeeling Tea can be grown in any part of India.
- But the tea leaves of these plants cannot be sold under the brand name of Darjeeling Tea, as the concerned plants were not grown in the soil and climate of the Darjeeling area

CLASSES OF GI

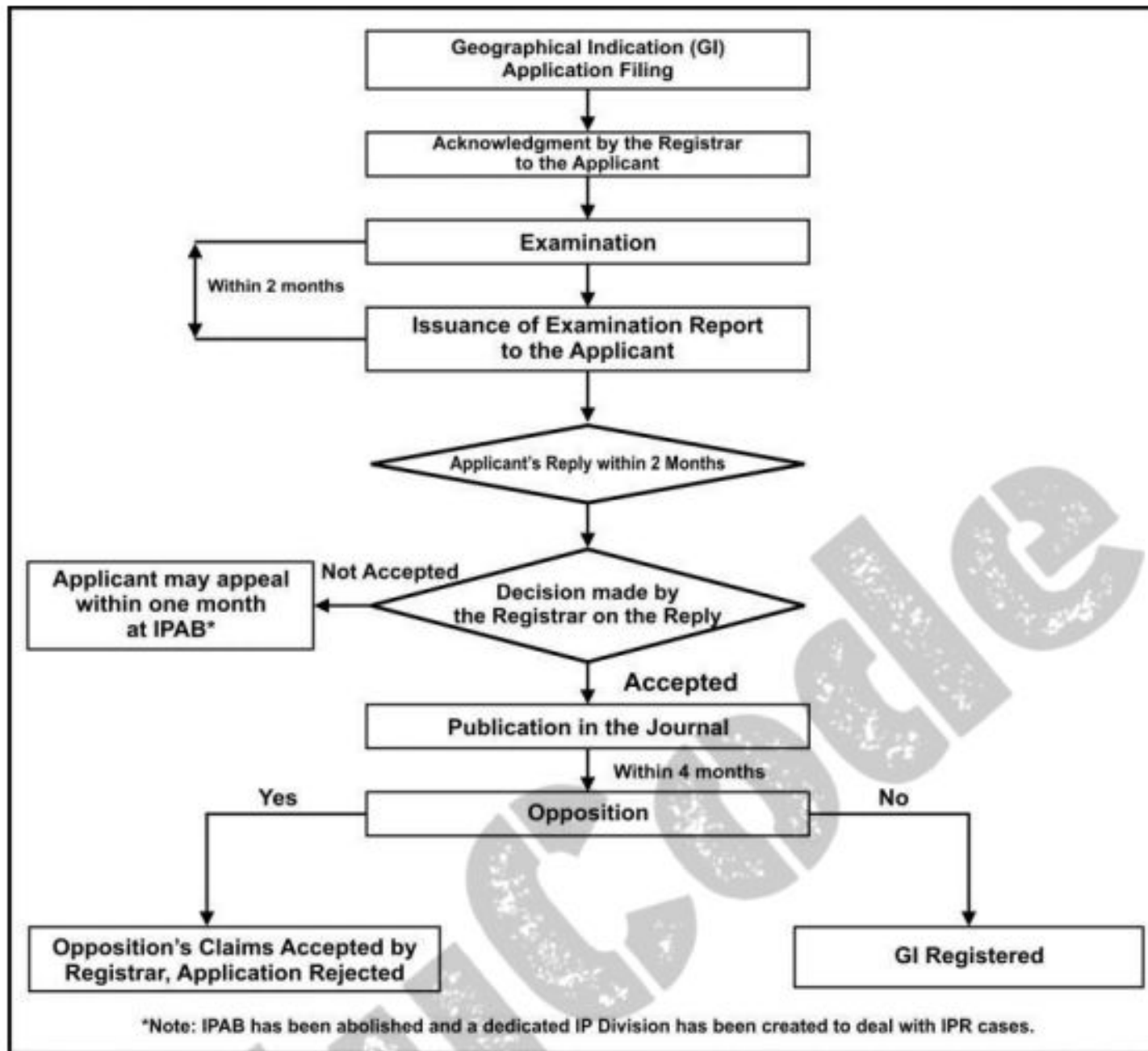
GI certified goods are classified under 34 different classes, such as Class 1 is for chemicals used in industry, science, photography, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 33 is for alcoholic beverages (except beers) and
Class 34 is related to tobacco, smoker's articles and matches. More details can be extracted from the official website of CGPDTM Office (Controller General of Patents, Designs and Trademarks)

PROCEDURE FOR GI REGISTRATION DOCUMENTS

- ◆ Prior to filing an application for registering GI, it is prudent to search whether the concerned GI is already protected or not. This can be done by using search engines created by WIPO (World Intellectual Property Organization)
- ◆ The list of registered GI in India can be accessed from the official website of CGPDTM.
- ◆ Once the prior search for registered GI is done, the applicant has to file an application.
- ◆ The application for GI can be forwarded by an individual or an organization or authority of people established under Indian law.
- ◆ The application in a prescribed format is submitted to the Registrar, Geographical Indications along with the prescribed fee.
- ◆ In the application, the applicant needs to mention the interest of the producers of the concerned product.

- ❑ The application should be duly signed by the applicant or his agent with all the details about the GI that how its standard will be maintained.
- ❑ The submission of three certified copies of the map of the region where the GI belongs is mandatory. Once the application is filed at GI Registry, the Examiner will scrutinize the application for any deficiencies or similarities.
- ❑ If the examiner finds any discrepancy, he will communicate the same to the applicant, which is to be replied within one month of the communication of the discrepancy.
- ❑ Once the examiner is satisfied with the response/s, he files an examination report and hands over the same to the Registrar. Once again, the application is scrutinized. if need be, the applicant is asked to clear any doubts/objections within two months of the communication otherwise, the application will be rejected.
- ❑ After getting a green signal from the Registrar, the application is published in the official Geographical Indication Journal for seeking any objections to the claims mentioned in the application.
- ❑ The objections have to be filed within four months of the publication. If no opposition is received, the GI gets registered by allotting the filing date as the registration date.
- ❑ Initially, GI is registered for ten years but is renewable on the payment of the fee



Procedure for GI registration document

DOCUMENTS REQUIRED FOR GI REGISTRATION

1. Details about the applicants name, address and particulars.
2. Application form GI-1A.
3. Statement about the designated goods being protected under GI
4. Class of goods
5. Affidavit to establish the claim of genuinely representing the interest of the producers
6. Characteristics of GI
7. The special human skill required (if any)

Form No	Title	Requisite Fee in Rs
GI - 1	Application for the registration of a Geographical Indication for goods included in one class.	5000
	Application for the registration of a Geographical Indication for goods included in one class from a Convention country.	5000
	A single application for the registration of a Geographical Indication for goods in different classes.	5000 for each class
	A single application for the registration of a Geographical Indication for goods in different classes from a Convention country	5000 for each class
GI - 2	Notice of opposition to the registration of a Geographical Indication or an opposition or an authorized user.	1000 for each class
	Form of counter-statement	1000
	Application for extension of time for filing notice of opposition	300

GI - 3	Application for the registration of an authorized user of a registered Geographical Indication.	500
	Request for issuance of a registration certificate as an authorized user.	100
	For renewal of an authorized user.	1000
GI - 4	Renewal of the registration of a Geographical Indication at the expiration of the last registration	3000
	Application for restoration of a Geographical Indication or an authorized user removed from the Register.	1000 + applicable renewal fee
	Application for renewal within six months from the expiration of last registration of Geographical Indication.	3500
GI - 8	Application for registration of a Geographical Indications agent.	1000
GI - 10	Application for cancellation of an entry in the Register or to strike out goods	300

GI ECOSYSTEM IN INDIA

- India is among the geographically and traditionally rich countries.
- The scope of generating GI products in India is enormous. These products can contribute to the economic development of a particular region or society.
- However, till June 2021, a total of 370 GI have been registered in India, which is much below its potential.
- The below Figure represents the statistics for GI (filed, and registered) for the period 2010-20. Maximum number (148) of GI was filed in 2011-12 whereas, minimum number (17) was observed in 2015-16.
- Not much change in the number of GI registrations was observed during the period 2010-20. Each year the number hovered around in the twenties, with maximum registrations (34) seen in 2016-17.