
INDIA'S DESIGN RIGHTS: A LOOK INTO THE NON-COMPLIANCE OF THE DESIGN ACT, 2000 WITH INTERNATIONAL CONVENTIONS

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ABSTRACT

Designs or Industrial Design, were first introduced in the British era in 1872, when the British Parliament passed "The Patterns and Designs Act, 1872" for the purpose of safeguarding Industrial Designs. This was the first time they enacted legislation for the safeguarding of Industrial Designs in India. In the year 1911, the British Parliament passed "The Patents and Designs Act, 1911," which ensured and provided protection against design infringement, as well as the methods or process for registering design applications in India. However, after several years of inaction, the Indian government established new legislation in 2000 to strengthen the protection of industrial designs. Basically, this act was enacted to consolidate and amend the law governing the protection of designs and to carry out the TRIPS Agreement. It took effect in India on May 11, 2001, superseding the 1911 statute and ensuring the viability of enlisted outlines and empowering plan activities. This new Act specifies a more effective method of defending against design infringement and establishes a new and simple mechanism for registering design applications in India. Additionally, this act enumerated numerous other significant provisions, such as the time frame of design extension, penalty for infringement, rights of registered proprietors, and the process for enforcement; all of these details and procedures are outlined in this act. Throughout time, this statute has been revised multiple times to include other significant clauses. This article aims to analyse most of the significant provisions of the current Design Act, 2000 in comparison with the international conventions. It also aims to check whether the amended Designs (Amendment) Rules, 2021 are in compliance with the international treaties and conventions. Such comparison and analysis would lead to highlight the major issues that exist in the current Indian design rights regime.

CONCEPT OF INDUSTRIAL DESIGN RIGHTS - THE GLOBAL PERSPECTIVE

Industrial Design Rights is a part of the intellectual property rights that provides the rights of exclusiveness to the visible designs of objects like textile, jewellery, furniture, flower vase or any other decorative items that are usually not popular utilitarian. Design protects design of the industrial object as well as its appearance. It aids in constructing any material or item much attractive and appealing resulting in growing trading viability of product and help in increasing its market eventuality¹. Human beings are creative and that creative tendency derives inspirations from nature. This creativity leads to designs that are unique in nature and force the human soul towards its beauty since it appeals to the finer senses and the eye. It can be said that The Design Act, 2000 essentially protects the elements of design which can be judged only by the eye².

A design is applied to an object and it is not the object itself. Design applied to an object ought to be something that to be provided to the consumer as a finished goods. As Intellectual property is of two-fold nature, so the rights granted on a design varies from country-to-country in aspects of both national as well as international arena. Any type of artistic creation possesses designs rights as well as copyright over it. Design law provides provisions of protecting any article in national as well as international arena, and in order to acquire protection registration of such design is essential under law.

There are also several International Agreements & Conventions which have forced India to adopt the new laws in relation to industrial designs. However, even after ratifying several International conventions & agreements, there are still several lapses in The Design Act, 2000 which have led into different issues. The major reason is the non-compliance with different international provisions and India still not being a member of few International Conventions. This article would aim to analyse the purpose of International conventions related to Industrial Design and would also aim to identify the issues with respect to the Indian perspective.

INTERNATIONAL CONVENTIONS GOVERNING INDUSTRIAL DESIGN

The Intellectual property rights (IPR) is of dual nature which means it has both the aspects of International as well national. The design rights are granted on the basis of country by country.

¹ E.T. Lokganathan, "INTELLECTUAL PROPERTY RIGHTS (IPRS) TRIPs AGREEMENT AND INDIAN LAWS", 1st ed. 2012, pp. 128.

² Mathew Thomas, "UNDERSTANDING INTELLECTUAL PROPERTY", 1st ed. 2016, pp. 339

Hence, the international protection of industrial design must not only be judged as an element of industrial property but also as an element of copyright law, as some of the national laws are applied to designs of an artistic work as well. Generally, industrial design protection is country-specific. But if the owner of a design desires to safeguard a design in another country, he must separately seek protection in each country under the respective relevant laws.

If application has been made for registration of design in India, it provides protection only in India. Yet there is no provision where a single application will be enough to protect design rights internationally. However, there are several international conventions that administer the fundamental requirements of intellectual property protection in industrial designs. For design registration, an application must be filed with the Indian patent and design office that appropriately establishes a priority date for a design application filed in a country that complies with international treaties, Paris convention³, and TRIPS, as well as local laws. Following section is an examination of many international treaties pertaining to industrial design in comparison with the Indian Designs Act, 2000,

I. PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, 1883⁴

The Paris convention for the protection of industrial property, 1883, was the first international convention at the international level that was established for the protection of industrial property (WIPO). This convention is the corner stone of the international system pertinent to all types of industrial property in broadest sense, including industrial design that provides protection to the individuals as well as to the commercial sectors of industrial property.

This convention took the first initiative in protecting the works of a creator in other countries as well and requires the member countries to acquire minimum protection for industrial properties. It was through this convention which establishes that same protection must be given to a creation as one would give to the national citizen of its own state. India, as a signatory or member of the Paris treaty, protects industrial designs. The countries to whom this convention applies form an industrial property protection union⁵. In context of Industrial design, this convention was mainly designed to unify the norms of protection of design among the member

³ Paris Convention for the protection of Industrial property, 1883, the first and the earliest international instrument for the protection of Intellectual property.

⁴ *supra note 3*

⁵ Article 1(1), Paris Convention for the Protection of Industrial Property, 1883

countries.

II. HAGUE AGREEMENT CONCERNING INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGN, 1925

The Hague Agreement is one of the international treaties administered by the World Intellectual Property Organization. This agreement establishes a procedure for worldwide registration of industrial designs for protection, but does not specify the context in which a design is protected or the rights that result from the protection, except for the minimum duration of protection. This agreement establishes an international registration system that basically enables the acquisition of industrial design protection in a number of states and intergovernmental organisations by submitting a single international application with the World Intellectual Property Organization's (WIPO) International Bureau. The application may include more than one design and a maximum of one hundred designs⁶, provided that the designs are of the same international class.

III. LOCARNO AGREEMENT ESTABLISHING AN INTERNATIONAL CLASSIFICATION FOR INDUSTRIAL DESIGN, 1968

The Locarno Agreement created the 'Locarno Classification', which is an International Classification for Industrial Designs. This is an agreement between countries that form a special union and have agreed “a single classification for industrial designs (hereinafter defined as the international classification)⁷”. It is based on a global treaty overseen by the World Intellectual Property Organization. This agreement clarifies the manner industrial design is protected and classified around the globe. It requires that if there is more than one design to be included in international application, all designs must belong to same class of Locarno classification.

The Locarno Classification is “*solely of an administrative character and does not bind the contracting countries as regards the nature and protection afforded to the industrial design in those countries*”⁸. It stipulates that such worldwide classification must be conducted in either English or French.⁹

⁶ WIPO Intellectual property handbook, p. 232.

⁷ Article 1, Locarno Agreement Establishing an International Classification for Industrial Designs, 1968.

⁸ Article 2(1), *ibid*.

⁹ Article 1 (7), *ibid*

IV. THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS), 1994¹⁰

TRIPs is one of the most comprehensive multinational intellectual property agreements in existence, having entered into force on January 1, 1995, with India as its founding member. The agreement targets to offer adequate protection to intellectual property rights and to ensure that the methods and processes for administering intellectual property do not become an impediment to legitimate trade. Apart from the minimum term of protection, it established few concrete international standards.

ANALYSIS – MAJOR ISSUES IN THE DESIGNS ACT, 2000 ARISING DUE TO NON-COMPLIANCE

I. ISSUE OF COMPULSORY LICENSE AFFECTING THE PROTECTION OF INDUSTRIAL DESIGN

Article 5B¹¹ of the Paris Convention states that industrial design protection shall not be forfeited for failure to work or for the importation of items identical to those covered. Members therefore have an in-built discretion to provide for compulsory license to ensure the working of the product. However, the Designs Act 2000 does not provide for compulsory licenses.

II. LACK OF ENOUGH PROTECTION TO INDUSTRIAL DESIGNS

Section 26(2)¹² of the TRIPS Agreement also provides that contracting members may make limited exceptions to the protection of industrial designs, provided that such exceptions don't materially harm the normal exploitation of protected industrial designs and do not materially harm the owner's legitimate interests, taking into account the legitimate interests of third parties. It is known that such exceptions are not included in The Designs Act, 2000, for the purpose of protecting industrial designs.

III. CONDITIONAL COMPLIANCE IN RELATION TO ADOPTION OF LOCARNO CLASSIFICATION (DESIGN AMENDMENT RULES, 2021)

¹⁰ Agreement on Trade-Related Aspects of Intellectual Property Rights, available at, https://www.wto.org/legal_e27-trips

¹¹ Article 5B, Paris Convention - All Industrial Property Rights: Period of Grace for the Payment of Fees for the Maintenance of Rights; Patents: Restoration

¹² Section 26(2), TRIPS Agreement – Protection.

Until January 25, 2021, the Indian Classification of Industrial Designs was based on the Locarno Classification's tenth edition, which contained 31 classes and a miscellaneous Class 99. The World Intellectual Property Organization (WIPO) published the tenth edition of the Locarno Classification in 2013, but it omitted classes for diverse items made utilising cutting-edge technologies. However, the Designs (Amendment) Rules, 2021¹³ require that the articles claimed in design applications must be classified in accordance with the most recent version of the World Intellectual Property Organization's International Classification for Industrial Designs (Locarno Classification)" (WIPO). As a result, applicants will rely on the Locarno Classification's 13th Edition, which became effective on January 1, 2021, until WIPO announces a new classification. The Locarno Classification's most recent edition comprises 32 groupings and 237 subclasses, as well as explanations.

The revised rules allow applicants to submit applications using the most recent classes and subclasses indicated in the Locarno Classification, rather than the earlier classifications specified in the Third Schedule of The Designs Regulations. Allowing applicants and agents to utilise the most recent version of the Locarno Classification simplifies the process of filing Design Applications for freshly generated articles by allowing them to use the most relevant classes/sub-classes, avoiding misunderstandings about the articles' kind and usage.

The revised Locarno Classification, as released by WIPO, may potentially contribute to the universal classification of design applications filed in many jurisdictions. A widely recognised single classification scheme can obviate the requirement for reclassification in reciprocity applications. Additionally, it would streamline concept searches on a national and worldwide level. However, a caveat to new Rule 10 of the new Design (Amendment) Rules, 2021 specifies that registration of any design is subject to conformity with Act criteria, specifically Sections 2(a) and 2(b)(d).

CONCLUSION – INDIA ENSURES PROPER STRUCTURE HOWEVER ISSUES MUST BE RESOLVED

In a country like India, one of the numerous reasons why designs are often not protected is that market dynamics in clothes and technology are constantly changing, and new models must keep up with current trends. The condition that a design should not be in the public sphere

¹³ Designs (Amendment) Rules, 2021, available at, https://ipindia.gov.in/writereaddata/Portal/Images/pdf/The_Designs__amendment__Rules__2021.pdf

before registration is something that the majority of these corporations are unable to achieve, resulting in an increase in piracy and infringement on a daily basis.

The duration of industrial design protection has also become a point of contention. This is also why businesses choose to file for copyrights and trademarks, as it offers them with a longer period of protection, especially if the design of the corporation is the sole source of profitability in the marketplace. As a result of which, it becomes significant that more provisions are introduced resolving the issues mentioned above, thus ensuring enough protection to the industrial designs. However, even with these issues, India has ensured that an appropriate structure is in place to protect the industrial designs of every individual, entrepreneur, inventor, innovator, and producer on the market.