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Introduction

The design which one sees produces a great impression on the eyes of the viewer and so it is very important to protect the designs from being copied. It is important to understand what the Design Act exactly is and how one can protect one's design under the ambit of this Act.

Meaning and definition

Design is defined under [Section 2\(d\)](#) of the Design Act as any feature which consists of shape, figure, a configuration which is applied to an article and is made by an industrial process be it mechanical, chemical, manual, separate or combined which appeal to in the finished article and is judged solely by the eyes and it does not include any mode of construction or anything unjust a mechanical device and anything which is a part of a trademark or artistic work.

The evolution of design protection laws through judicial pronouncements

In India, the need for protection of design was felt in the 18th century and so the [Patterns and Design Protection Act](#) was introduced in 1872. This Act gave the exclusive right of making, selling of the designs to the inventors for a short duration of time.

The act was followed by an [Inventions and Design Act, 1988](#) which was replaced by the [British Design and Patent Act, 1907](#) which formed the basis of Indian

Patents and Design Act, 1911. After this, the [Patent and Design rules](#) were formed in 1933 for the regulation of practise registration and carrying into effect the provisions of the Act.

When the [Design Act, 2000](#) came into effect the main change was regarding the exclusion of artistic works as defined in [Section 2\(d\)](#) of the Copyright Act, 1957 from the definition of term design. There were many conflicts regarding giving protection to the artistic works under the ambit of the Design Act.

This issue was explained by the Delhi High Court in the case of [Microfibers Inc. v. Girdhar Co. & Another](#) that the artistic works which are excluded from protection under the Design Act are in itself a piece of art, for example, a painting and the artistic work which are to be used in industry is not excluded from the ambit of protection provided under [Section 2\(d\)](#) of the Design Act.

In the case of [Bharat Glass Tube Ltd. v. Gopal Gas Works](#), the Court emphasized the object of the Design Act which is to protect and reward the inventor of the design for his hard work. The Court further held that the protection is given to advance the industries.

Nature of copyright protection in designs

[Section 11](#) of the Design Act mentions about copyright when a design is registered. Whenever a design is registered the inventor of such design shall have the copyright over it for the next ten years subject to other provisions of the act.

The copyright over the design can be further increased for five years if before the expiration of the term of ten years application for the extension of the period of copyright is made in the prescribed manner to the Controller and the prescribed fees are paid.

Key provisions of the Design Act, 2000

The key provisions of the Design Act are as follows:

- The scope of the definition of the terms article, design and introduction of a definition of original has been enlarged.
- India is a member of the Paris Convention of the World Trade Organisation and all the signatories of the convention are allowed to claim priority rights.
- It also mentions about the delegation of powers of controllers to other controllers and the statutory duties of the examiners is also provided.
- The secrecy period of two years of design is also revoked.
- Under the Act, the quantum of punishment in case of any infringement of a registered design has also been enhanced.
- To keep a watch and regulate anti-competitive practices in contractual licenses provision for the avoidance of certain restrictive conditions are also there.
- In the new enactment, there are laws which tell about the substitution of the application before registering a design.

- Registration is to be considered when a new license is to be brought under the public domain. Anyone can inspect it by getting a certified copy of the same.
- There are provisions in the new Act for the maintenance of a register on the computer as Register of Designs.
- The appeal against the orders of the Controller is not to be made to the Central Government but instead to the High Court.
- The cancellation proceeding to be held in the front of the Controller in place of the High Court and the additional ground is to be provided in a cancellation proceeding.

Requirements for design registration

To protect the hard work of the inventor of the design it is very essential to get it registered. For the proper registration of the design, there are certain requirements which should be met.

Who can register?

Any person can register for a certain design which is original and new, who claims to be the proprietor of that design and it does not fall under [Section 4](#) of the Design Act. Any person mentioned above includes in its ambit an individual, any firm, any partnership firm, company or an agent on behalf of the proprietor can also register.

Eligibility criteria

For a design to be registered there are certain qualifications which should be met. They are:

It should be new and original

New and original in this context means that the article is produced for the first time and it was unknown until then. In the case of [Gammeter v. Controller of Patents and Designs](#), the Calcutta High Court held that the design for which the novelty is being claimed should be placed side-by-side with the other design and then decided.

It should not be published earlier

The design should not be published earlier for which the registration is being claimed. It should not be publicly accessible which means that it has not been made available to the public by registration or some other way.

It should not be contrary to morality and order-

The design must not be contrary to morality and order or prohibited by the Government of India or any institution. The design which is capable of disrupting the public order and peace is not considered capable of registration as mentioned under [Section 5](#) of the Act.

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The interlocutory injunction under the civil procedure code

A person can seek an interlocutory injunction under [CPC Order 39 Rules 1 and 2](#). The principle is the same for both patents and designs when it comes to granting of an interlocutory injunction. The person has to make out a *prima facie* case and show that the balance of convenience rests in his favour.

The claim for interlocutory damages will not easily succeed if there is an adequate remedy available. In the case of [Niki Tasha P. Ltd. v. Faridabad Gas Gadgets P. Ltd.](#), [AIR 1985 DELHI] the delhi high Court held that they cannot be granted interlocutory injunction unless there is a probability of them succeeding after the trial. Interlocutory Injunction won't be granted if there are chances of attacking the validity of the registration. An interlocutory injunction can also be denied if the defendant gives an undertaking to check on whether he is a person of substance and he is ready to give relief to the plaintiff which he requires under the undertaking.

In the case of [Bansal Plastic Industries v. Neeraj Toys Industries](#), the delhi high Court held that granting someone temporary injunction is to be decided by the Court according to its discretion by following reason and sound principles.

Landmark judgements

Reckitt Benckiser (India) Ltd. v. Wyeth Ltd. delhi high court 15.03.2023

Facts– In this case the issue was regarding the registration of S-shaped spatulas. The defendant in this case i.e. Wyeth Ltd. claimed that the appellant's design was not original as it has already been registered in a foreign country before its registration in India. And also there was the suppression of facts regarding the prior registration in a foreign country.

Judgment- The Court held that if it can be shown that the design was disclosed anywhere in India or a foreign country by means mentioned under Section 4(b) then the registration in India would be considered to be cancelled and it can be sought as a defence against alleged infringement under [Section 22\(3\)](#).

Sree Vishnu Bottles v. The State Of Tamil Nadu [madras high court 9.2.2012]

Facts- This case deals with the rights of re-sellers. The petitioners have a business of buying empty beer bottles and paper from Tamil Nadu and transporting it to Karnataka and Madhya Pradesh. They have been doing this business smoothly for 30 yrs without any interruption in crossing borders until recently when they were stopped. And the reason for the disruption is that some bottles were registered as designs under the Designs Act. They were held liable for piracy of registered designs under sec 22 of the Design Act. They said that no one can be stopped from transporting empty bottles in such fashion when even there is no injunction from the Court.

Judgment- The madras High Court held that the relief they sought was vague and no blanket order can be passed by the Court.

M/s S K Industries v. Dipak Ghosh[delhi high court 04.12.2009]

Facts- In this case the Plaintiff claimed that there was a certain cup in which jelly was being packed and marketed and the defendant cannot use the design.

Judgment- In this case, the Court held that the cup which the plaintiff used has no novelty and was just any regular cup with no originality in its shape or dimension. The cup is the same as manufactured by most of the manufacturers for storing something.

Hello Mineral Water pvt.ltd vs Thermoking Californiya Pure[1999 Delhi high Court]

Dispute was concerning a water dispenser which was designed in a cylindrical shape. Delhi HC held that mere form and shape is not sufficient for the purpose of novelty. The ultimate test is to consider the design with an instructed eye to locate the difference between the design previously published and the registered design.