

Entrepreneurship and IP Strategy
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Lecture No. 29
Industrial Design Infringement

A very warm welcome in the fourth module of week 6 of the course, Entrepreneurship and IP Strategy, titled Industrial Design Infringement. So, we have already seen what is the definition of industrial design? How to do the application for industrial design? What are the key features of industrial design? Then how industrial design and business are related we have seen a few examples in the last module only. And then now, we will check a few more details about the industrial design. When we find industrial design, we follow certain steps.

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Now, these steps are like first novelty, second representation, third classification, fourth statement of novelty, fifth is a claiming a priority, sixth is a fee, then seventh is a details of the applicant and eight is complying with the objections. So, generally these are the 8 steps we can say a few more things are also there, but generally these 8 steps are generally followed when we are dealing with her industrial design application.

Now, when we say novelty check, what exactly we are doing, we are checking the originality novelty of that IP and we know that you take any example of IP novelty is a prime thing for a IP. Then we are talking about a representation and we have seen that there are like a when we are doing the representation, then we have to submit two copies when you are doing physical submission of that industrial design. Nowadays everything is online.

When we are doing the identification of class, we are following like a the classification which is followed for the industrial design, what is that classification? It is a Locarno classification which is followed for industrial design and for trademark what is that? It is a Nice and Vienna classification. So, when trademark comes it is a Vienna or Nice classification is there. And when we are thinking about industrial design, it is a Locarno classification.

Now this Locarno classification came into existence after the agreement or that is a Locarno agreement in 1968. So, now, the after going through that classification and choosing the correct classification, we are providing a statement of novelty and it says that it gives some disclaimer and the disclaimer is that as we know that industrial design is like appearance, it is for the appearance, it is the article which is there which is sold for that appearance for that shape or that configuration that industrial design is protection is given.

So, we gave the statement like the novelty resides in the shape and configuration of that article, any name of that article, whatever it may be a chair, it may be a lamp, whatever it may be. So, that statement, which is given that is a statement of novelty, when we are giving we are clearly saying that the novelty results in the shape and configuration of the article as illustrated and we are submitting that particular presentation. Now, we require the claiming of priority date, if we are doing a conventional application and we have already seen a reciprocity of application in the module 2.

So, when we are talking about claiming of a priority date through that, if there is an entry through conventional application or application is through conventional application, we are calling it as a reciprocity application. Now, the next that is a sixth point that is a fees

and generally the fees is like a for individual it is 1000 rupees, again for MSME it is a 2000 a double of individual and then for other category, there is a the fee is like a 4000 and then we are giving a full details of the applicant.

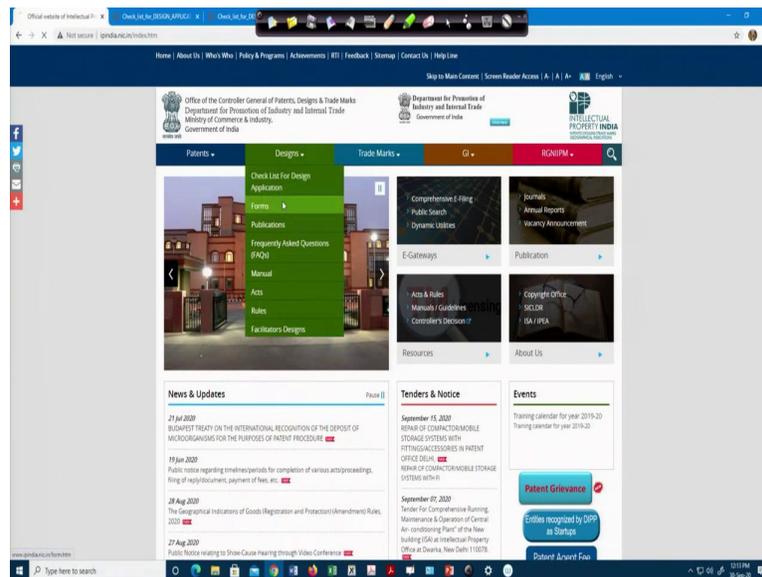
So any application you take trademark , patent and you are giving full details of applicant that is a name, address, email, phone number, then legal status, maybe like a private limited or partnership whatever that details are there you are providing that particular details. And then if any objections come in examination start that will be objections. And when that objection comes we are complying with that objection. And then once you comply that objections if it passed through examination that registration of the design will occur.

(Refer Slide Time: 4:56)



So next is like a we will just quickly go through the website of industrial design, registration or an IP into industrial design website. So, that you can get the idea about how exactly and where exactly you will get at Fee forms and or other details about industrial design.

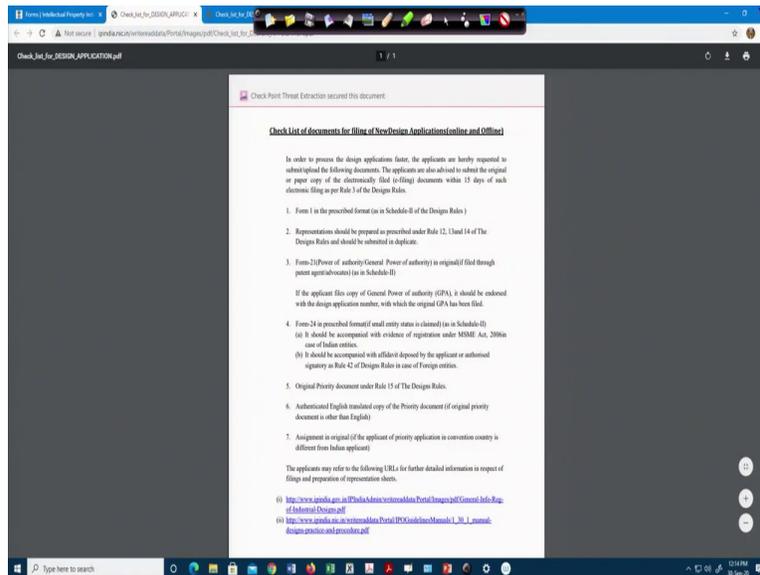
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So, we have given you the link there on the screen when you click on that, that link you will go on this site and here you will see the design part. Now, in the design part there is a checklist for design application, various forms whatever required are hosted here. Then there is a publications then the frequently asked questions if you stuck somewhere this part will definitely help you then manual part is there that you will get a much more details about the industrial design and how would the examination of the Industrial Design occur.

Then the Acts part here you will get a different types of acts which are related to innocence like a if amendments are there rules are there what exactly that acts and rules are there these are hosted here and facilitators for design like a the experts which are registered experts, the list of that facilitators with their details like address and contact number are hosted here on this website. So, you can visit this website and you can get the idea about that particular thing.

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Now, these are the forms which are required for the particular what we can say the filing and we know that this is the application of a registration generally this form is the most important for you, when you are dealing with that particular thing. And then you can go all these details and you can get the information about this particular thing. Then if you want to see the checklist that is one important thing, this is the checklist right which is posted here, so that you can go through that checklist and once you do the application filling and all that representation and everything you will make ready you can cross check what exactly you have prepared and you can file the industrial design registration.

So, I guess this is good enough for you, you can just go visit the site and you can go the details of that particular industrial design website. Now, moving further we can go. So, this is the website, whatever IP India website is there you can visit that website and you can go through the details about the industrial design and you can get the idea about that particular industrial design and related publications and the forms and fees and every details you will get there.

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Now, the next part is like a substantive examination, when we are talking about a substantive examination Yes, once you file the application, you follow that checklist and then the examiner will whenever it is a goes to examination, examiner will carry out that substantive examination. Now, what parts will be taken into consideration or what things the examiner will take into consideration is like a, whether it is really a design enter that whether it is a original that will be checked, then whether it is not pre judicial to a public order or morality.

And this is obviously in every IP is followed you have seen that in Section 3 of a patent law that yes, if it is against the public order or morality that kind of industrial design will not be allowed. And then obviously, the next important point always check is whether it is not a prejudicial to the security of India. So, if it passes through these 4 things like whether it is a design as for act, we have seen the definition then whether it is a really new novelty is there it is original and then the, it is not against public order or morality, if it is not doing anything or any harm to the security that that will be checked when they examiner that will go through that particular substantive examination.

(Refer Slide Time: 8:46)



Now the once it passes through that examination, yes, it will be registered and then the register of design is there and it is a document which is maintained in Patent Office and we know that Kolkata is that in the among that four offices Kolkata is taking care of industrial design. So, anywhere you file us you can file according to your jurisdiction that industrial application, it will be transferred to Kolkata and the examination will have that industrial design will happen only in Kolkata. Now, what it whenever you are seeing that register offer design what exactly that register maintains.

So, it will maintain the design number, then the class number according to Locarna class, then the date of filing that what is that date in which country because there may be a different application date and different priority date it may depends. So, that date of filing is important. Then the reciprocity date that is very important if it is coming through a conventional route. So, the reciprocity is important here. And then the name and address and other details of a proprietor are mention there in the register.

So, when you are talking about a register of design, all these things information you will get in the in this register and along with obviously, you will get the that proprietorship related information also in the register. Now, this register it is open for a public inspection and on a payment of a prescribed fee and extract from register you can get on request or after giving a prescribed fee. Now, duration of registration we have seen that

industrial design registration it is like a 10 plus 5 you and you will know that date of registration priority date is taken into consideration and from priority date that 10 plus 5 years it will be that way the calculation will be done.

Now, initial period we know that it may be extended for 5 and for that you have to give a form 3. Now, now, this proprietor of a design he can apply for the that extension of 5 years as soon as design a registered design is registered. So, it is not like that is a trademark what the thing is happening for renewal you have to wait for the tenth year and in the tenth year when it is a starting you are given that application for renewal of trademark.

Now, in this industrial design as soon as your design is registered, maybe it may take some one year or around that particular time and once it is registered immediately you can go for the extension of that if you want that extension. So, you need not to wait for a 10 years or something like that. So, this is what about a register of design where you are getting the information about that design and then the few things are there about the extension and all that also you can follow with the help of form three as soon as the registration of a design occur.

(Refer Slide Time: 11:50)



Now moving further the publication now we know that in a patent, we know that there is a publication of patent means after 18 months that publication occur which month it will occur in the patent? And which is that day? So, it is after 18 months and it is published every Friday. So, similarly here when design registration thing comes every Friday the whatever the there is application that application for that designs are there, that designs will be that the details of that designs will be published every Friday. So, this is about the publication.

(Refer Slide Time: 12:33)



Now the next is a infringement part. Now, here when we are talking about a industrial design infringement, it differs according to jurisdiction, but the generally if you see what the infringement is like unauthorized use of industrial design. So, unauthorized use of that industrial design. So, the person who is not a authorized owner, if he uses if he makes some copies of that article that with that with that particular design, then the if it is important or if it is sold, so, if that kind of activity is done in unauthorized way, this is an illegal thing and we call that infringement has occurred and we can take action against that infringement.

Now, here to understand if a person has infringed that monopoly of registered design, the design is assessed under each jurisdictions from regions and what exactly that part is checked then here the part which is checked is a visual appearance of the manufactured

product rather than the function because we have already know that the functional part is covered by a patent and the appearance part is covered under that IP that is industrial design.

So, when the any in any jurisdiction and there is a checking of infringement is there that visual appearance is taken into consideration and within that also, if you see in that visual appearance, the similarities between the two designs are taken into considerations. So, the original one and the one which is like against which is a complaint is there that the similarities what are the similarities are there that will be focused than the differences. So, that way generally, this is the way in which in any jurisdiction that check will done and examination will be done if there is an infringement.

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Now, the this piracy of design is like a next point, because see, when you are talking about a design, it is like a copyright kind of thing is that right. Now, what the thing is happening if this kind of infringement is occurring related to the industrial design, if somebody is doing that particular thing, what will happen, that we the you can take action and what that action is like that she if she or she do that particular illegal activity, they are liable for a almost the fine which is that it is about 25,000 and for registered proprietor it may cannot go beyond 50,000 rupees.

So, find is like in between, I am just giving you in a layman language it is in between like a 25,000 to 50,000 and you can file a suit in for a damages or whatever the recovery of damages you can file the suit or also you can get the injunction order. And the when you talk about a court, the court is not below the district District Court. So, you have to whenever you want to file any suit, it should go into the district court or above.

So, this is about the infringement like an illegal use us make sale use and then they import if anything kind of thing an unauthorized way if somebody do we call it as an infringement and it attracts legal action against that particular thing. Now, I will just see a few examples on the industrial design when you do the public search on the website if you do public search.

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So, you can see us few pictures, this is example of a tea pot now, you can just see the various kind of designs which are there for a tea pot. So, this is the this is what we can serve example of that tea pots you can see on the screen and if you want to, if you are in the entrepreneurial activity, you can if you are manufacturing say chair or table or some generators or tyres, whatever it may be, you can just type that public search part is there on the industrial design, which we have visited type that particular word and you can get the existing designs and then you can decide on that particular thing, whether you are not

infringing the anybody else design. So, this is what the different kinds of designs are there and you can just go through that particular thing.

Anytime people have a polarizing reaction towards your design, it means you are onto something. Indifference or apathy towards a product is rarely a good thing. So in that regard, the PlayStation 5 console is a success. When the PS 5 console was revealed people had strong reactions to it, the design makes a really bold statement. And a lot of people really love the way it looks while others really hated it.

Now I have a lot of respect for the design team at Sony for taking that risk. And we are going to look at the PS 5s industrial design to figure out what is working, what is not working and why that is the case. Now to start we need to understand Sony's aim for this product, the tagline for PS 5 is play has no limits, gaming in essence is an escape right. The industry

Professor: Now we have seen that industrial design, we know that what is a application then we know what is the registration procedure, then we have seen the infringement related things then you have visited the website also then you know the details of the facilitators actually we are expecting that you yourself can do industrial design, registration, it is very simple, just like a copyright, you can just visit the checklist is there that form 1 is there, form 3 is there everything is there on website it is a self like self explanatory website and you yourself can do this registration then and you can file your industrial design application.

So, I guess this much information is good enough for you for industrial design. And with this we are coming to the end of this session. In the next session or the next module we are dealing with a case study case study 5 it is related to automobile. So, see you in the next session. Thank you