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Cancellation of registered design – Is prior registration abroad a valid ground?

By Jayaram Sekaran

Introduction

Like any other Intellectual Property Right, industrial design registration protects the rights of the proprietor in his 'registered design'. In general, an industrial design right is awarded for the aesthetic appeal of an article, which is not purely functional in nature¹. According to Section 2 (d) of the Designs Act, 2000 (hereinafter the 'Act'), 'design' is defined as features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article by any industrial process or means. This definition is similar to the definition of design in the UK. Section 1 (2) of the UK Registered Designs Act, 1949 defines 'design' as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

Registration of Industrial Designs

As in the case of patents, protection of industrial designs is territorial. Registration is mandatory to seek protection in any jurisdiction. Registration of industrial designs has several benefits attached to it. Registration protects industrial designs from being copied and falsely imitated. Many stakeholders are under the false notion that a separate protection to aesthetic features of an article is not necessary in view of a parallel protection offered to the industrial

drawings under the Copyright Act. However, according to the provisions of Section 15 (2) of the Copyright Act, copyright in any design which is capable of being registered under the Designs Act, but which has not been so registered under the Designs Act, shall cease as soon as the article to which the design has been applied has been reproduced more than fifty times by an industrial process. Hence, registration of design becomes all the more important.

In addition to meeting the basic requirements of being judged solely by the eye, a design has to meet certain other requirements for being registered. A design should be new or original², should not be disclosed to the public anywhere in India or in any other country by (i) publication in tangible form, (ii) use, or (iii) in any other way prior to the filing or the priority date of the application³, should be distinguishable from known designs or combination of known designs⁴, and should not include any scandalous or obscene matter⁵.

Cancellation of registration

There is no concept of pre-grant opposition in the design law like in the case of patents⁶. This difference is based on the fact that the design is published only upon registration⁷. Publication of design also involves public inspection of the registered design. Hence, the design law, on the lines of the post-grant

¹ http://en.wikipedia.org/wiki/Industrial_design_right

² Section 4 (a) of the Act

³ Section 4 (b) of the Act

⁴ Section 4 (c) of the Act

⁵ Section 4 (d) of the Act

⁶ Section 25 (1) of the Patents Act, 1970

⁷ Section 7 of the Act

opposition in patents, provides an opportunity for invalidating a design only after its registration. The registration of a design can be challenged by presenting a petition for cancellation of registration of the design on several grounds⁸.

Registration can be cancelled if the design has been previously registered in India⁹. Publication of the design in India, or in any other country prior to the date of registration can also lead to cancellation of registered design¹⁰. Section 19 (1) (b) of the Act can be separated into two parts, where one part refers to “published in India”, and the other part refers to “published in any other country”. The words “published in any other country” have been the subject matter of controversy.

Case analysis

The decision of the Delhi High Court in *Reckitt Benckiser (India) Ltd. v. Wyeth Limited*¹¹ may be of interest. The division bench referred the matter to be examined by a larger bench in view of disagreement with the stand taken by it in the matter of *Dabur India Ltd. v. Amit Jain*¹². In Dabur case, the court concurred with the Calcutta High Court decision in *Gopal Glass Works Ltd. v. Assistant Controller of Patents & Designs* [2006 (33) PTC 434 (Cal)] and concluded that prior registration of similar article in the U.S. cannot be considered as “published in any other country”. On the contrary, the division bench of the Delhi High Court in *Reckitt Benckiser* (supra) preferred to differ. In *Reckitt* the court distinguished previously registered designs outside India as, for example in the UK, designs that are kept secret post registration and those that are not kept secret post registration, and considered those that are not kept secret post registration as designs “published in any other country” within the meaning of Section 19 (1)

(b) of the Act. To come to this conclusion, the court relied on a combined reading of other sub-sections of Section 19 and Section 4. In particular, it relied on the provisions of Section 44 (1) and (2) that deal with claiming priority from an application filed in a convention country if the design application in India is filed within six months from the priority date, and Section 4 (b) which is broader in scope, *available in public domain* as compared to Section 19 (1) (b), *mere publication*.

The court also answered the question whether there is any legislative intention for not including previously registered designs outside India as a ground for cancellation of registration in Section 19 (1) (a) of the Act. It held that the legislature could never have intended that a design in India, which is a complete copy of the design registered abroad, cannot be cancelled although the design is registered abroad and available in public domain post its registration.

Conclusion

The current position of law in respect of considering previous registration of design outside India as a valid ground of cancellation under the provisions of Section 19 of the Act, and as a defence against infringement under the provisions of Section 22 (3) of the Act is not yet decided. Under the present scenario, applicants aspiring to file design application in India by taking priority from a previously filed foreign application may comply with the provisions of Section 44 of the Act and file within six months from the priority date to avoid cancellation of registration.

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⁸ Section 19 of the Act

⁹ Section 19 (1) (a) of the Act

¹⁰ Section 19 (1) (b) of the Act

¹¹ FAO (OS) No. 458/2009, 8 October 2010 (Del HC).

¹² FAO (OS) No. 293/2007, 3 December 2008 (Del HC).

Statutory Updates

Filing of Form 27 – IPO reminds patentees and licensees:

The Indian Patent Office has asked patentees and licensees to file Form 27 and comply with Section 146(2) of the Patents Act, 1970. Form 27 is the statement regarding working of the patented invention on commercial scale in India. This statement is required to be filed in respect of every calendar year within 3 months of the end of each year. The IPO's public notice dated 12th February, 2013 also mentions Section 122 of the Patents Act, 1970 which provides penalty if information as per provisions is not furnished.

Registration as associated trademarks – Fee payment mandatory:

The Indian Patent Office has issued a public notice on 4th February, 2013 according to which association fee of Rs. 500 is payable by applicants when they seek association of identical or similar trademarks with the trademarks for which registration is sought. If such fee is not paid, registration certificate will not be issued, as per the notice. The fee mentioned is payable for each trademark required to be associated. Section 16 of the Trademarks Act, 1999 provides for registration of associated trademarks.

Ratio Decidendi

Trademarks – Registration of marks which are descriptive of quality

The European General Court has denied the registration of trademark 'ecodoor' for class of products covering electrical household and kitchen machines, dispensing machines and apparatus for heating, steam generating and cooking, etc. The Court held that the element 'eco' would have been perceived by the relevant public as meaning 'ecological' and the term 'ecodoor' would be understood immediately by the relevant public to mean 'a door the construction and mode of operation of which are ecological'. It was observed by the court that the mentioned goods may contain doors and hence the mark applied for may describe the ecological qualities of the door which the product in question is equipped with. As per EU's law, under Article 7(1)(c), of Regulation No 207/2009, trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service, are not to be registered. [*BSH Bosch und Siemens Hausgeräte*

GmbH v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) - Judgment of the General Court (Fourth Chamber), dated 15-1-2013].

Following the same principles, registration of another mark 'steam glide' was also denied by the Court in its judgment dated 16-1-2013 in the case of *Spectrum Brands (UK) Ltd*. The court in this latter case held that since the smooth movement of an iron across clothes, which results from the steam, corresponds to what the consumer may expect from a product of that type, the description of that movement by the said words is clearly descriptive of a very real characteristic of the goods.

Divisibility of patent application in absence of plurality of inventions

The Intellectual Property Appellate Board has rejected the argument that even if there is no plurality of inventions, divisional application can be filed provided it is done before the grant or abandonment of the parent application and subject to certain other conditions. It was noted that the legislature clearly intended that further application is for one of the inventions disclosed in the first

mentioned application and the basis for grant of division is plurality of invention and that the word “division” cannot be meant to split one invention into splinters. The contention that Section 16 of the Patents Act should be read in a manner as to allow the inventor to re-submit the application and that it was only where division application was filed at the instance of the Controller that plurality of invention was a must, was rejected by the Board. [*Sygenta Participations Ag v. Union of India* – IPAB Order dated 29-1-2013 in OA/17/2009/PT/DEL].

Amendment to patent claims – Conduct and delay when fatal

Persisting with original claim despite knowledge of prior art and delay in bringing amendment are grounds for refusing amendment of patent claims, as per IPAB’s recent order. The respondent had sought to make certain amendments pleading inadvertent error and new perspectives and insight gained as a result of the understanding of the technologies. However, on facts, the Board found that the respondent had persisted in the unamended claim even after their own expert’s evidence on prior art.

Examining a petition for revocation of patent, the IPAB allowed filing of appropriately amended claims in respect a small inventive step though other claims were not novel and the conduct of the respondent would have justified ordering revocation.

The IPAB rejected the ground of licensee estoppel put forth by the respondent holding that no licensee can be estopped from challenging the patent. It reasoned that as per Section 140 of the Patents Act, 1970, it is unlawful to insert any condition

to prevent challenges to validity of patent. It also observed that the Patents Act which is a special enactment as far as patents were concerned would prevail over the general rules relating to contract. [*Enercon (India) Ltd v. Alloys Wobben* – IPAB order dated 23-1-2013]

Registration of trademark for unrelated goods

Quashing the order of the Deputy Registrar of Trademarks refusing registration of CYCLE mark in respect of brooms, the IPAB held that reputation of the earlier mark for unrelated goods (incense sticks) cannot be a ground for refusal. In refusing registration, it had been reasoned that the mark was likely to cause confusion and also that the mark was devoid of any distinctive character. The respondent contended that it had been using the mark since 1954 and also that the mark was registered in the same Class 21. As regards absolute grounds of refusal under Section 9 of the Trade Marks Act, 1999, the IPAB observed that a trademark had only to pass a minimal threshold test of being capable of distinguishing the goods from another. Though the mark in the instant case was ‘proposed to be used’, it was capable of distinguishing the goods and was not hit by Section 9.

In another order rejecting the petition to rectify the mark, the IPAB held that International Classification is merely general indication relating to the field to which, in principle, the goods or services belong and goods in the same class can be totally unrelated. [*Shree Balaji Associates v. Ranga Rao & Sons & Ors.* – IPAB Order dated 4-1-2013]

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