



Need for Unregistered Design Rights in India: A Contemplative Cogitation

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India has a specific legislation for the scheme of industrial designs which mandates statutory registration as a prerequisite to obtain IP rights in designs. Industries characterised by products having short lifecycle, release colossal number of new designs in the market in short intervals of time. Due to the dynamism of these sectors, registering all the industrial designs, is not practically and commercially feasible. As the present design regime in India, governed by the Designs Act, 2000, only protects the registered designs, it leaves the unregistered ones open to rampant copying and piracy. The European Union and the United Kingdom are two jurisdictions which offer advanced protection to the unregistered designs, which has proved to provide a competitive edge to their industries, by incentivising their design innovation. Against this background, the article seeks to critically analyse the Designs Act, 2000 to locate loopholes under it, in extending protection to the unregistered designs, undertake a comparative analysis of the unregistered design protection in European Union and United Kingdom, and propose suggestions for introduction of unregistered design rights in India. Further, rapid design piracy caused by 3-D printing, mass production techniques and advanced technologies, supports the urgent need to extend an argument for protection of unregistered designs under the Indian Design regime.

Keywords: Unregistered Designs, Unregistered Design Rights, Community Designs, Short-term products, Designs Act, 2000, EU Regulation, Copyright Act, 1957

Designs are the reflection of creative intellect of the designer. The market appeal and the commercial success of the article depend on the visual appeal of the product, as much as its performance. The appearance of a product has a great influence over a consumer in choosing which product to buy. The new and innovative designs help in evolving the industrial sector and giving it a competitive edge, by diversifying the options available in the market and preventing them from saturation. The designers meticulously and purposely apply different features of design such as shape, pattern, configuration, ornamentation, line or colours to add a visual appeal to the product. In doing so, they invest substantial capital including professional expertise to create innovative designs. The person putting his research and labour in evolving a new and innovative design must be benefitted and protected under the IPR legal regime. The rationale behind design protection is manifold and include promoting and maintaining a highly competitive market economy, development of high-quality products and to debar the third parties from free riding the intellect and labour of the designers.

Some industries like fashion, apparel, footwear, toy etc. create a large number of products (with new designs) in short intervals of time. These articles have a short shelf life and last for a few seasons and become obsolete quickly. Constant product innovation, new design development and high cannibalization rates are typical to these industries and are the key to remain competitive in the market. Demand for a fad-sensitive product in these industries can shift from lukewarm to boiling overnight and then suddenly evaporate as the next trendy design hits the market.¹ Thus, these industries require regular insertion of innovative new designs in the market. The financial stakes of these industries in the Indian economy are hardly trivial. For example, the fashion sector, which is closely related to the textile and apparel industry, is one of the most crucial pillars of the Indian economy. According to the Annual Report of 2021-22 of the Ministry of Textiles, India is the second largest producer and sixth largest exporter in the textiles and apparel industry. The industry contributed 11.4% in the total exports of India in the year 2020-21 and India has a significant share of 4% in the global trade of textiles and apparels. The Indian textile and apparel industry is projected to grow at 10% CAGR (Compounded Annual Growth Rate)

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from 2019-20 to reach 190 billion US dollars by 2025-26.² Another industry with a high product turnover ratio is the toy industry. The Indian toy industry is worth 1.5 billion US dollars and has a 0.5% total share in the global toy market. The Indian toy industry is forecasted to grow at 10-15% rate, against the global average of 5% and has a large potential growth opportunity in the international trade.³ As these industries heavily invest in creation of new designs, they need to be protected against rampant copying and counterfeiting, which reduces companies' revenue and in turn their ability to innovate new designs. According to the OECD report (Organisation for Economic Cooperation and Development) on counterfeited products, clothing, footwear, watches, toys, jewellery are among the world's most counterfeited products.⁴ These counterfeited products violate the design rights of the designers, among other IP rights.

The relevant statute regulating the design rights in India is the Designs Act, 2000 (the Act). The legal remedy against piracy of designs is only available under the legislation, if the design is registered.⁵ Thus, registration of designs being compulsory, there is no protection to the large number of unregistered designs created by the above-mentioned industries. Presently, India lacks a legal framework to extend protection to the unregistered designs under the Act. This poses serious implications especially for those industries that develop large number of designs in short interval of time.

Rationale for the Protection of Unregistered Design Rights in India

The new designs of the above-mentioned industries are not adequately protected under the Act.

Registration of All Designs Not Commercially Viable

The industries like fashion, toys, apparel, footwear etc. introduce short-term products into the market. The shelf life of these products is ephemeral. For instance, the fashion industry characterised by its dynamism and volatility, produces colossal number of designs, out of which a large number last only a season and only a few become classics. At the time when the article is introduced, the popularity of the design cannot be predicted. The registration process under the Act takes around six months and has certain formalities. Six months is a long period for industries like fashion, clothing, footwear etc.

which are dynamic in character and release several lines of articles in a year. Further several micro, small and medium enterprises and indigenous designers are involved in these industries, who do not have the awareness, the know-how, the money or the time for registration of their multiple designs. Moreover, these industries often consider that as most of their products or designs last only for a few months in the market (or even less in some cases), the ten-year minimum protection period⁶ from the date of registration is not appropriate for their ephemeral designs. The registration trends under the Act for the articles of clothing, travel goods, textile piece, watches, articles of adornment have not been substantial over the recent years and it appears that the designers are not much inclined in registering their products in these industries under the Act.⁷ Thus, it is not commercially viable to register all the designs introduced into the market.

Prior Disclosure Deprives the Design of its Novel Character

The conditions to qualify for design registration are provided under Section 4 of the Act. The design must have a novel character and should not have been disclosed publicly in India or abroad. The publication shall be in some tangible form, by use or in any other way, before the date of filing of the registration application or the priority date for registration.⁸ If the design is put to actual use by creating an article out of it and if it is commercially exploited and put to public use, then the design is considered to be published.⁹ As discussed earlier, all designs (of the above-mentioned industries) cannot be registered and thus, the design loses its novel character by being introduced into the market, which is a pre-requisite condition for registration. This lacuna poses serious implications on these industries, as they are deprived with an opportunity to test their designs in the open market and register only those designs which become a commercial success. Legal regimes where the unregistered designs are protected, proprietors are given an option to test their designs without undergoing the whole process of registration, and then make a decision as to which designs should be registered and which should be given up. Also, under the Act, there is no provision of grace period provided to the designer, for deciding which designs to register on the basis of the demand or popularity of the product, which cannot be predicted before the products are disclosed. Limited exceptions are provided under the Act, under which disclosing or

exhibiting the design will not invalidate the subsequent design registration by the designer. The exceptions are:

- (i) If the design owner discloses the design to another person in such a manner that the disclosure by such other person will result in breach of good faith and if he so discloses the design owner's design.
- (ii) Accepting the first confidential order for articles to which a new and original textile design has been applied.¹⁰
- (iii) The exhibiting of the design or the exhibiting of an article to which the design is applied or publication of the design description by the design proprietor, at an exhibition which has been notified by the Central Government under Section 21 of the Act and the exhibiting of the design or article or publication of the design description by any other person elsewhere by any other person, during or after such exhibition without the permission of the design proprietor.¹¹ However, the design proprietor is required to give prior notice of the same to the Controller of Designs under Form-9 provided under the Design Rules, 2001¹² and file the registration application within a period of 6 months from the date on which the design has been first exhibited or the design description published.

Thus, due to lack of protection to unregistered designs, and lack of a provision providing a grace period to register the designs after disclosure, the best-seller designs are left with no protection whatsoever under the Act and the investment and labour of the designer is left exposed to be freely copied by the unscrupulous copycats in the market.

Lack of Automatic Protection Against Copying

There is no provision under the Act for providing automatic protection to unregistered designs, even for a limited period of time. Automatic protection available under the Copyright Act regime is weak comparing to the protection the Industrial Designs regime offers.

This kind of protection is considered necessary for dynamic industries like fashion, footwear, apparel etc., where registration of all the released designs is not commercially viable. This results in free riding of the innovative designs of the proprietors, as they lack even the limited rights against copying for a

short period of time, which is provided under other legal jurisdictions (like the European Union and United Kingdom). This also poses another risk where a dishonest competitor can misappropriate the unregistered design and can file a claim for registration of the same before the rightful designer. In such a situation, the proprietor has to go through the cumbersome process of cancellation of the design so registered.¹³

Limited Copyright Protection to Unregistered Design

The unregistered designs can get some limited protection in India under the Copyright Act, 1957. Section 13 of the Copyright Act, 1957 provides the "subject matter in which copyright subsists" and enumerates the following works:

- a) Original literary, dramatic, musical and artistic works,
- b) Cinematographic films and,
- c) Sound recordings.¹⁴

The designs can be protected under the Copyright Act, 1957, if they come under the realm of 'artistic works', which has been defined under Section 2(c) of the Copyright Act, 1957 to mean:

- a) a painting, a sculpture, a drawing (including diagrams, maps, charts etc.);
- b) a work of architecture;
- c) any other work of artistic craftsmanship.¹⁵

Thus, the Copyright Act, 1957 entails protection to the original design if qualifies as an 'artistic work' under the Copyright Act, 1957. For instance, in the case of *Rajesh Masrani v Tahiliani Design Pvt. Ltd.*,¹⁶ the Delhi High Court held that the plaintiff's original designs were protected under Section 2(c) of the Copyright Act, 1957 as an original 'artistic work', although the same were neither registered under the Copyright Act, 1957, nor under the Act. The Court also reiterated that registration under the Copyright Act, 1957 is not compulsory.

However, Section 15(2) of the Copyright Act, 1957 introduces a huge hindrance in the copyright protection to the original unregistered design. It provides:

*"Copyright in any design, which is capable of being registered under the Designs Act, but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his licence, by any other person."*¹⁷

An analysis of the above section suggests that a registrable design under the Act which has not been so registered, can be protected under the Copyright Act, 1957 only to a limited extent. A major impediment to such protection is that the article, to which the said design has been applied, should not have been reproduced more than 50 times by an industrial process by the copyright proprietor or the licensee. This threshold of 50 articles may have been justified when the above-mentioned section was enacted, however in the present times of industrialisation and technological advancement, producing 50 articles in a single day is also easily achievable.

This provision has proved to be a major obstacle in providing copyright protection to unregistered designs, especially in the toy, fashion and apparel industries. For instance, in *Mattel, Inc. and Others v Jayant Agarwalla and Others*,¹⁸ the plaintiff, the owner of the famous board game ‘Scrabble’, sued the owner of the electronic game ‘Scrabulous’ for copyright infringement in the design of the board as an ‘artistic work’. The Delhi High Court invoked Section 15(2) of the Copyright Act, 1957 and held that since the said board has been industrially produced for more than 50 times, it loses copyright protection. Similarly, unregistered designs of upholstery fabrics in the *Microfibres Inc. v Girdhar & Co. & Others*¹⁹ and garment designs in the *Ritika Private Ltd. v Biba Apparels Private Ltd.*²⁰ have been held to lose copyright protection for exceeding the threshold of 50 articles.

Unregistered Design Protection under Different Jurisdictions

There are a couple of jurisdictions which provide guaranteed legal protection for unregistered designs.

European Union

The European Union (EU) has harmonised the design rights by adopting the Directive 98/71/EC on 13 October 1998 and the member states implemented it on December 9th, 2001. The objective of this Directive was to harmonise the existing national laws on protection of industrial designs across the EU, by setting the standards for eligibility and protection of registered designs. EU further introduced the Community Designs (unified design rights available throughout the EU) by adopting Regulation (EC) No. 6/2002 on Community designs (‘Regulation’) on December 12, 2001, which came into effect on March

6, 2002. The Regulation was adopted after 10 years of rigorous discussions and dialogues following the publication of the Green Paper on the Legal Protection of Industrial Design by the European Commission in June, 1991. It provided two-tier protection. Firstly, the Community Registered Designs (hereinafter referred to as ‘EU RCD’) which get protection for a minimum period of 5 years from registration, and can be renewed up to a maximum period of 25 years. Secondly, the Community Unregistered Design (‘EU UCD’) which protects against unauthorised copying, for 3 years.

The subject matter of protection under EU UCD is the “*appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product and/or its ornamentation*”.²¹ The designs which constitute a component part of a complex product which is not visible during normal use, designs which are dictated solely by their functionality, designs of interconnections and designs that are immoral and against public policy, are not protected.²²

The conditions for protection of the EU UCD are the same as required for EU RCD. The EU UCD must be new and have an ‘individual character’.²³ The novelty exists if no other design which is identical to the claimed design has been made available to the public, before the date on which the asserted design has been made available to the public. If the features of the asserted design differ from the previous design only in immaterial details, the asserted design would not be considered new.²⁴ The other requirement of ‘individual character’ is fulfilled only if the overall impression that the claimed design produces on the informed user, is different from overall impression produced by available design corpus existing before the date on which the asserted design has been made publicly available. The factors to be taken into consideration while differentiating the two are the degree of designer’s freedom in creating the design, the nature of the article to which the design is applied and the industrial sector to which it belongs.²⁵

The term of protection conferred through the EU UCD is 3 years from the date on which the asserted design has been made available to the public.²⁶ The design is considered to be made available to the public when it is published, exhibited, used in trade or otherwise disclosed in a manner that it could have been reasonably known to the concerned sectors

operating within the EU, in the normal course of business. Thus, the disclosure could be in any part of the world, but it should be in the reasonable knowledge of the concerned sectors within the EU only. The exceptions to the disclosure rule include the disclosure to another person under expressed or implied terms of confidentiality.²⁷ The EU UCD confers the design holder an automatic right to prevent any other person from using the design without his consent. The contested use can be to make, offer or put to sale, import, export or stock a product to which such design has been applied. However, the contested use or infringement must be a result of copying his EU UCD and not by an independent creation of the other party. Also, the other party must be reasonably familiar with the EU UCD.²⁸

There is a landmark judgement of the Court of Justice of the EU (hereinafter referred to as 'CJEU') on the issue of assessment of the 'individual character' requirement of the claimed design. In *Karen Millen Fashions Ltd. v Dunnes Stores, Dunnes Stores (Limerick) Ltd.*,²⁹ the petitioner was Karen Millen Fashion Ltd. (hereinafter referred to as 'Karen Millen'), who is a luxury fashion designer and retailer mainly dealing with women clothing throughout the UK and Ireland. Dunnes Stores is one of the largest retailers in Ireland and also deals in women clothing. Three particular articles of clothing were designed and displayed for sale by Karen Millen in 2005 in Ireland and Dunnes Stores displayed nearly identical copies of the same in 2006 in Ireland. Karen Millen was successful in getting a favourable judgement by the Irish High Court against the infringement of his EU UCD of these articles as they were within the 3-year protection period granted to the EU UCD. Against this ruling, Dunnes Stores preferred an appeal in the Supreme Court of Ireland. The Court stayed the proceedings and referred the case to the CJEU for a preliminary ruling on two questions related to the 'individual character' requirement of the EU UCD, which are as follows:

(i) Whether the individual character has to be determined by differentiating between the asserted design and the impression produced on an informed user by an individual design previously made available to the public or by differentiating between the asserted design and the combination of features of the previous designs, and

(ii) Whether the asserted design holder has to merely indicate what constituted the individual character or has to establish and prove it as a matter of fact.

The CJEU decided these questions as provided under:

- (i) The asserted design will fulfil the requirement of having an individual character if the overall impression created by this design on the 'informed user' is different from earlier designs taken individually. It is not required to prove that the asserted design should produce an overall impression that is different from combination of various features of various previous designs.
- (ii) The EU UCD right holder has to only indicate those elements which constitute the individual character of the design and not necessarily prove the individual character as a matter of fact.

The efficacy of the UCD was largely untested until this decision of the CJEU, which has proved that the protection available through the tool of UCD is a potent one. The decision has been celebrated by the designers, especially belonging to the fashion and textile sectors, as it has provided certainty that their unique designs will be effectively protected under the UCD legal regime. It further diminishes the chance of an infringing party from making a successful claim of challenging the new design's validity on the ground that it creates an impression based on the existence of various elements of earlier available designs.³⁰

United Kingdom

The unregistered design protection is provided in the United Kingdom (UK) under the Copyright, Designs and Patents Act, 1988 (CDPA). The Unregistered Design Right ('UK UDR') affords protection to the "*shape or configuration (whether internal or external) of the whole or part of an article*".³¹ As opposed to the UK registered designs regime, there is no requirement that the appearance of the UK UDR must evoke some kind of attraction in the viewer or be visible to the human eye.³² Some features of the design such as "method or principle of construction" and "surface decoration" are excluded from protection.³³ Further, two important exclusions are commonly called the "Must Fit"³⁴ and "Must Match."³⁵

For protection under the UK UDR, the unregistered design must be ‘original’³⁶, as opposed to requirement of ‘novelty and individual character’ for the UK registered designs³⁷. The originality requirement is considered to be similar to the copyright law and thus the design must not be copied and should be the independent creation of the designer.³⁸ However, a design will not be regarded as original if it is “*commonplace in the design field in question at the time of its creation*”.³⁹ In *Ocular Sciences Ltd. v Aspect Vision Case Ltd.*⁴⁰, the “*not commonplace*” provision has been interpreted by Laddie J. to exclude any design which is, “*trite, trivial, common-or-garden, hackneyed or the type which would excite no particular attention in the relevant field*”.

The scope of protection extends to providing a monopoly or exclusive right to reproduce the design for commercial purposes, for applying the designs to an article, or making a design document.⁴¹ Further, UK UDR is protected against Primary infringement (copying of the design for commercial purposes) and Secondary Infringement (dealing with infringing articles for commercial purposes). Primary infringement is the reproduction of the design, by copying either directly or indirectly, to produce products that are exactly or substantially similar to the asserted design.⁴² In this kind of infringement, there is no need to prove that the infringement has been carried out with the knowledge or intention that there was UK UDR in the article that has been copied. In *C & H Engineering Ltd. v F Klucznik & Sons Ltd.*,⁴³ the Court held that like copyright, UK UDR infringement turns to the test of copying and whether an article has been produced ‘substantially to the design’ is an objective test viewed through the eye of the intended customer. Secondary infringement includes dealing in certain commercial activities without the license of the UK UDR holder. Secondary infringement will be proved only if the defendant has the knowledge or has reason to believe that he is dealing with the infringing article.⁴⁴

The UK UDR is protected for a period of 15 years from the end of the calendar year in which the design was first recorded in a design document, or the design was first applied to an article, whichever occurred first. However, if the articles to which the design has been applied, are legitimately marketed anywhere in the world or are available for sale or hire within the first 5 years of recording or making the design, then the period of protection is 10 years from the beginning of the first activity.⁴⁵

It is pertinent to mention that after the Brexit, UK has conferred ‘supplementary unregistered design rights’ to the designs which are first disclosed in the UK after January 1st, 2021. This right functions in addition to the UK UDR. It confers automatic protection to 2D and 3D appearance of whole or part of the product, including the surface decoration for a period of 3 years. However, as this right is relatively new and mirrors the EU UCD in all major aspects, the same has not been discussed in detail.

Other Jurisdictions

Turkey and Israel are the two jurisdictions which have recently extended protection to unregistered designs comprehensively under their IPR regime.

Turkey

Turkey has enacted the Industrial Property Code on 22 December 2016, which came into effect on 10 January 2017. The Code has not only consolidated the different IP rights, but also introduced the automatic protection to unregistered designs. Design means the appearance of a product or its part, ensuing from the features of shape, material, colour, contour, or texture of the product, or its ornamentation (Article 55). Unregistered design must be new and individual character to qualify for protection (Article 56). Unregistered design gives the right owner an automatic right to prevent other parties from producing, selling, importing, using or stocking the product to which the design has been applied for commercial purposes. To avail this automatic right without registration, copying of the unregistered design has to be proved. Producing of identical designs or of designs which produce a general impression that they indistinguishably similar to that of the unregistered design which is sought to be protected. However, it shall be deemed that the design has not been copied if the third party created the design independently and did not reasonably have the knowledge about the existence of the prior unregistered design (Article 59). The term of protection to unregistered designs is 3 years from the date of its first presentation to the public (Article 69).

Israel

Israel is another jurisdiction where the unregistered designs protection has been introduced by the new Designs Act, 5777-2017, which came into effect on 7 August 2018. Design is defined as the appearance of a product or part of a product, demonstrated by one or

more visual characteristic including the colour, shape, texture, outline, decoration or the material from which they are made. (Article 1) An unregistered design should be novel and possess individual character. Also, the design product should have been offered for sale or distributed in Israel for a commercial reason, including over the Internet, within 6 months from the relevant date (Article 4). The relevant date is the date on which the design or the design product has been made public in Israel or abroad (Article 1). The term of protection is 3 years from this relevant date (Article 6). The grace period of 12 months from the relevant date is also provided to file the registration application (Article 64).

The design proprietor has the automatic right to prevent any other person from manufacturing, a design product, for commercial use, which is a copy of the asserted design, whether the copying is by manufacturing an identical design product or such a design product which creates on an 'informed user' an overall impression which cannot be differentiated from the one created by the unregistered design product (Articles 61 and 67). An additional right against indirect infringement has been provided under which the sale, lease, distributing, importing into Israel, for commercial purposes of an unregistered design product, which is known or should have known to be infringing the unregistered design, can be prevented (Article 68).

An innovative provision related to unregistered designs that deserves attention is 'marking of an unregistered design' under Article 62. It states, "*A proprietor of an unregistered design believing that his design is eligible for protection as an unregistered design under the provisions of this Law may mark the design product in the manner prescribed by the Minister; the mark will indicate that this is an unregistered design and the relevant date applying to the design*". Further, if the unregistered design is so marked, it is presumed that the infringer had the knowledge about the existence of rights in the unregistered design (Article 78).

Japan and South Korea

Unregistered designs are afforded protection in Japan and South Korea. It is provided under the Unfair Competition Prevention Act (Act No. 47 of 1993) in Japan and under the Unfair Competition Prevention and Trade Secrets Act, (Act No. 911 of 1961) in Republic of Korea. However, as the protection is not provided by a design legislation,

under the IPR regime, the same has not been discussed in detail.

Suggesting Adequate Provisions for Protection to Unregistered Designs under the Act

There is a dire need for protecting unregistered designs in India in the era of rapidly changing fashion trends, digital technology infused innovations in industrial designs and commercial ecosystem. For the purpose of suggesting some important outlines for the same, it is indispensable to conduct a comparative analysis of the EU UCD, UK UDR and unregistered design protection in Turkey and Israel (Table-1).

The comparative analysis of the unregistered design protection in EU, UK, Turkey and Israel suggests that the unregistered design rights under Turkey and Israel have a close resemblance to the EU UCD. As the unregistered design protection in Turkey and Israel is relatively new, and mirrors the EU UCD in all major aspects, the UK UDR and EU UCD have been compared in greater detail in the next part, to extract the best possible solution for extending protection to unregistered designs in India.

The Industrial Designs Act must have Explicit Provision for Protection of Unregistered Designs

Under the EU, the EU UCD (Unregistered Designs) and the EU RCD (Registered Designs) are protected under a single legislative framework i.e., the Regulation. In the UK, the registered designs are entailed protection under the Registered Designs Act, 1949 and UK UDR under the CDPA. This duplicity of laws should be avoided and the unregistered designs should be afforded protection under the Act itself, which is the Indian legislation protecting the registered designs. This will provide a comprehensive protection to the Registered and unregistered designs under a single law, without the need to enact a separate law on unregistered designs. Thus, the Act can be amended and a separate Chapter on protection of unregistered designs be added.

Subject Matter and Conditions for Protection

The UK UDR protects the 'shape and configuration' of the design and excludes 'surface decoration'. EU UCD provides a broader protection to lines, colours, contours, textures, material and even surface decoration. As the features of lines, colours, textures, materials and surface decoration are of utmost importance to industries such as fashion, textiles etc., the EU definition seems more appropriate to protect unregistered designs. Moreover, under the

Table 1 — Comparative analysis of the unregistered design rights in EU, UK, Turkey and Israel

	EU UCD	UK UDR	TURKEY	ISRAEL
Conditions for protection	Novelty & individual character	Original and not commonplace	Novelty & individual character	Novelty & individual character
Subject matter of protection	Appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product and/or its ornamentation	Shape or configuration (whether internal or external) of the whole or part of an article. Surface decoration of the product is excluded from protection	Appearance of a product or its part, ensuing from the features of shape, material, colour, contour, or texture of the product, or its ornamentation	Appearance of a product or part of a product, demonstrated by one or more visual characteristic including the colour, shape, texture, outline, decoration or the material from which they are made
Scope of protection	Automatic protection against copying of design for commercial purposes	Automatic protection against copying of design for commercial purposes. It also provides exclusive monopoly right to reproduce the design for commercial purposes.	Automatic protection against copying of design for commercial purposes	Automatic protection against copying of design for commercial purposes
Time period of protection	3 years from the date on which design has been made available to the public	15 years from the end of the calendar year in which the design was first recorded or first applied to an article, whichever occurred first. If the applied article is legitimately marketed anywhere in the world or is available for sale or hire within the first 5 years of recording or making the design, then the period of protection is 10 years from the beginning of the first activity		

Act, design is similarly provided under Section 2(d) to mean the features of, “*shape, configuration, pattern, ornament or composition of lines or colours applied to any article*”. Thus, the same definition can be extended to Unregistered Designs protection under the Act.

The conditions of protection under UK UDR are originality and not “*commonplace in the design field in question at the time of its creation*”. Whereas, the registered designs that have novelty and individual character are protected.⁴⁶ The EU UCD and EU RCD both require novelty and individual character for protection. Section 4 of the Act provides similar requirements for protection of registered designs and the same can be replicated as qualifying conditions for protection to the unregistered designs.

Scope and Time Period of Protection

EU UCD provides an automatic right against infringement of the design. The infringement must be a result of copying and not an independent creation of the opposite party. Also, the infringing party must be familiar with the existence of the Community Design. On the other hand, the UK UDR not only protects the right holder against copying of the design, but also confers monopoly

right to reproduce the design for commercial purposes. Providing such extensive monopoly rights without the requirement of registration (as provided under UK UDR), is not a viable option. Monopoly right of reproducing the design shall only be conferred on registration, and only limited protection against copying shall be provided. Thus, the Act shall confer automatic protection against copying of the unregistered designs when they are disclosed in public. The extensive monopoly rights provided to registered designs under Section 22 of the Act need not be extended to unregistered designs.

Time period of protection of unregistered designs is 3 years in EU and 10 to 15 years in UK. The unregistered designs deserve protection for industries with short term products. Conferring protection for a long period (10 or 15 years) is thus erroneous. Moreover, the Act gives protection to registered designs for the maximum period of 15 years. Extending the same term of protection for unregistered designs is inappropriate as the registration must be incentivised as it entails time, money and administrative cost. Thus, the unregistered designs must be afforded protection under the Act for the period of 3 years from the date of public disclosure.

Grace Period for Filing the Registration Application

Further, both UK⁴⁷ and EU⁴⁸ provide a grace period of 12 months from the date of making the design available to the public, to file an application for design (without losing the requirement of novelty). However, the Indian Act does not have a provision providing for any such grace period. This is detrimental to the small and medium enterprises and indigenous designers, who are less aware about the stringent legal requirements of novelty and thereby losing the option of subsequent registration. The grace period provides an opportunity to the designers to test the marketability of their designs by commercialising it and then deciding according to the demand of the design, the viability to go through the registration process. Thus, grace period of 12 months from the date of public disclosure should be provided to the designer to file for registration of his designs under the Act.

Miscellaneous Provision

One innovative provision that can be replicated in the Indian design landscape from the new Designs Act of Israel is the 'marking of the unregistered design', which has been discussed above. The unregistered design or the article to which it has been applied, can be marked by the designer, who believes that his design can be afforded protection as an unregistered design. The relevant date of disclosure of the unregistered design must also be indicated through marking the design product. The mode and formalities of marking can be required to be in a manner prescribed by rules made by the Central Government in this regard.

Conclusion

Article 25(2) of the TRIPS Agreement provides a special mandate to the Member Countries to secure protection for 'design textiles' through industrial design or copyright law. The industries producing textile designs are specially characterised by short product lifecycles and release large number of designs in small intervals of time. Other industries like the toy, footwear, fashion industry, also have similar characteristics. The lack of unregistered design protection in India results in an apparent gap in the IP protection that causes a higher risk of copying in industries with shorter product lifecycle. From the foregoing discussion, it is clear that the present IPR protection in India to textile designs (and other similarly characterised industries) is far from

sufficient. The industrial design protection is only conferred on the registered designs and copyright protection is limited to the threshold of 50 articles. Thus, in order to fulfil the requirement of Article 25(2) of TRIPS Agreement in its true spirit, it is essential to grant protection to the unregistered designs.

Although, unregistered design rights were first introduced in the UK, the EU UDR appears to be in a better position to protect the industries like fashion, textiles etc.⁴⁹ UK UDR has complex qualification requirements, covers functional designs, does not confer protection to surface decoration and provides a long-term protection of minimum 10 years.⁵⁰ EU UDR appears to be a better model and the same can be used for drawing suggestions for extending protection to unregistered designs in India. Thus, an automatic protection to unregistered designs shall be conferred against copying under the Act. The period of 3 years protection seems appropriate as the period is long enough for recoupment of investments entailed into creation of new designs, and substantially shorter than acquired from registration. Further, a grace period of 12 months from the public disclosure shall be provided for registering the design, without losing the novelty requirement. This will give an option to the designers to test their products in real market conditions, and then make a decision whether to register their designs (within these 12 months) or continue with the 3-year protection to unregistered designs.

No valid reasons can be located for denying the protection to unregistered designs. However, awareness must be created amongst the designers to create a record of their design process for proving the existence of the unregistered design. This includes properly signed and dated copies of design drawings, initial sketches, conversation records related to the design process and documentation related to the first disclosure. The importance of maintaining proper proofs of the design process can be witnessed from the case of *G-Star Raw C V v Rhodi Ltd & Others*,⁵¹ where the proper design process account helped in providing compelling evidence against copying of unregistered design and strengthened the case. Marking of the design or the article, can also be helpful way of indicating the existence of the unregistered design and the disclosure date.

In the age of 3-D printing and other technological advancements, affixing and printing of complex

designs to large number of products in a few hours is seamless task. This substantially increases the risk of unscrupulous ripping off the creative labour of the designers, without a legal remedy. Thus, the protection of unregistered designs can prove to be a useful instrument against rampant counterfeiting of short-term designs and in strengthening the competitive position of the Indian industries.

References

- 1 Johnson M E, Learning from Toys: Lessons in managing supply chain risk from the toy industry, *California Management Review*, 43 (3) (2001) 106.
- 2 Indian Brand Equity Foundation, *Textile Industry Report*, 2022.
- 3 Federation of Indian Chambers of Commerce and Industry and Klynveld Peat Marwick Goerdeler, *State of Play: India's Toy Story- Unboxing Fun and Beyond*, 2021.
- 4 Organisation for Economic Co-operation and Development, *Trends in Trade in Counterfeit and Pirated Goods*, 2019.
- 5 The Designs Act, 2000 (16 of 2000), Section 22.
- 6 The Designs Act, 2000 (16 of 2000), Section 11(1). It provides that registered designs get protection for 10 years and can be further renewed for 5 years.
- 7 Swarup S K & Rastogi S, Fashion Design and Intellectual Property Rights: An Indian Perspective, *Journal of Intellectual Property Rights*, 26 (2021) 127.
- 8 The Designs Act, 2000 (16 of 2000), Section 4.
- 9 *Reckitt Benkiser India Ltd. v Wyeth Ltd.*, 2013 (54) PTC 90 (Del) (FB).
- 10 The Designs Act, 2000 (16 of 2000), Section 16.
- 11 The Designs Act, 2000 (16 of 2000), Section 21.
- 12 'Form 9' provided under the Design Rules, 2001 provides the form for "Notice of intended exhibition or publication of unregistered design".
- 13 Section 19 of the Designs Act, 2000 (16 of 2000) provides the provision related to cancellation of design.
- 14 The Copyright Act, 1957 (14 of 1957), Section 13(1).
- 15 The Copyright Act, 1957 (14 of 1957), Section 2(c).
- 16 2009 (39) PTC 21 (Del.) (DB).
- 17 The Copyright Act, 1957 (14 of 1957), Section 15(2).
- 18 IA No. 2352/2008 in CS (O S) 344/2008 (Delhi HC).
- 19 2009 (40) PTC 519 (Del).
- 20 MANU/DE/0784/2016.
- 21 Regulation (EC) No. 6/2002, Article 3.
- 22 Regulation (EC) No. 6/2002, Articles 4, 8 and 9.
- 23 Regulation (EC) No. 6/2002, Article 4.
- 24 Regulation (EC) No. 6/2002, Article 5.
- 25 Regulation (EC) No. 6/2002, Article 6.
- 26 Regulation (EC) No. 6/2002, Article 11.
- 27 Regulation (EC) No. 6/2002, Article 7.
- 28 Regulation (EC) No. 6/2002, Article 19.
- 29 Case C-345/13 (CJEU, June 19, 2014).
- 30 Witzburg F M, Protecting fashion: A comparative analysis of fashion design protection in the United States and the European Union, *The Trademark Reporter*, 107 (2017) 1131.
- 31 UK Copyright, Designs and Patents Act, 1988, Section 213(2).
- 32 Cornish W, Llewelyn D & Aplin T, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet and Maxwell Limited, London), 7th Edition, 2010, 624.
- 33 UK Copyright, Designs and Patents Act, 1988, Section 213(3)(a) and 213(3)(c).
- 34 UK Copyright, Designs and Patents Act, 1988, Section 213(b)(i). It provides, "Design rights does not subsist in features of shape or configuration of an article which enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function".
- 35 UK Copyright, Designs and Patents Act, 1988, Section 213(b)(ii). It provides, "Design rights do not subsist in features of shape or configuration of an article which are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part".
- 36 UK Copyright, Designs and Patents Act, 1988, Section 213(1).
- 37 UK Registered Designs Act, 1949, Section 1B.
- 38 Cornish W, Llewelyn D & Aplin T, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet and Maxwell Limited, London), 7th Edition, 2010, 625.
- 39 UK Copyright, Designs and Patents Act, 1988, Section 213(4).
- 40 [1997] R.P.C. 289.
- 41 UK Copyright, Designs and Patents Act, 1988, Section 226(1).
- 42 UK Copyright, Designs and Patents Act, 1988, Section 226(2).
- 43 [1992] FSR 421.
- 44 UK Copyright, Designs and Patents Act, 1988, Section 227.
- 45 UK Copyright, Designs and Patents Act, 1988, Section 216.
- 46 UK Registered Designs Act, 1949, Section 1B.
- 47 UK Registered Designs Act, 1949, Section 1B(5) and 1B(6).
- 48 Regulation (EC) No. 6/2002, Article 6.
- 49 Rockett E, Trashion: An analysis of Intellectual Property Protection for the fast fashion industry, *The Plymouth Law & Criminal Justice Review*, 11 (2019) 80.
- 50 Kur A & Levin M, *The Design Approach Revisited: Background and Meaning in The EU Design Approach* (Edward Elgar Publishing Limited, UK), 2018, 1-27.
- 51 [2015] EWHC 216 (Ch).