
Delhi High Court demystify 'Prior Publication' of a Design

On March 15, 2013, the three judges bench (also referred to as full bench) of Delhi High Court on a reference made by a Division Bench of the same Court in the case titled *Reckitt Benkiser India Ltd. v. Wyeth Ltd.* [FAO(OS) 458/2009] provided guidelines as to what amounts to 'prior publication' under The Designs Act, 2000 ("the Act"). The Design Act provides that 'prior publication' before registration can be a ground for cancellation of a Design. The court was therefore asked to clarify meaning of 'prior publication'.

In an earlier case titled *Gopal Glass Works Ltd. v. Asst. Controller of Patents & Design* [2006 (33) PTC 434 (Cal)], it was held by the Calcutta High Court that mere publication of designs, specifications, drawings by a foreign patent office would not in itself constitute prior publication thus making a design registered in India susceptible to cancellation. Later on, in *Dabur India Ltd. v. Amit Jain* [2009 (39) PTC 104 (Del) (DB)], the Delhi High Court concurred with this viewpoint of Calcutta High Court. However, the correctness of this was questioned. It was argued that decision seem to have overlooked the provision of Section 44 of the Indian Designs Act which provides for reciprocal arrangement with convention countries, if a design application is filed in India within six months of filing in a convention country

The full bench analyzed the definition of Design and highlighted the following aspects

- 1) Design is meant to produce an article by industrial process or means (manual, mechanical, chemical etc.).
- 2) Design is not the article itself but the conceptual design containing the features of a shape, configuration, pattern, composition of lines etc.
- 3) Design is to be judged solely by the eye which is put in the form of finished article.
- 4) The subject matter of a Design is not a copyright that falls under the Copyright Act or a trademark under the Trademark Act.

In terms of what constitute an 'original' design, the bench clarified that new or original is ordinarily understood to mean such designs which are not well-known and do not exist in public domain. As per the Design Act 'original' means, new in its application to a specific article. In other words it is not necessary that the design must be totally new, and it is enough that the existing design is applied in a new manner to an article to which that design has not been applied before.

The bench also analyzed the scope Section 4(b) of the Designs Act which prohibits registration of a design which is already disclosed to the public in India or in any other country abroad

through publication. The bench noted that disclosure to public in India and abroad is accompanied by the language which requires publication “in a tangible form or by use or in any other way”. The court opined that registration of a design would not be barred by mere publication but publication by use, or in a tangible form or any other way. The meaning of the term ‘any other way’ is guided by ‘tangible form’ or ‘use’. Thus, a design on paper would qualify as publication only if the visual impact of the design is similar to when the design is viewed on a physical object i.e., in a tangible form or in use. The court clarified publication of a design in the form of photographs or explicit pictures illustrations in a magazine, catalogue, book, newspaper etc. that clearly depict the application of the design on the same article, with the same visual effect would amount to prior disclosure or publication.

The bench concluded that what amounts to publication is a question of fact to be decided as per the evidence led in each case. Thus, mere existence of a design in the records of a Registrar of Design in a convention country may not amount to publication in all cases.

The court also considered effect of failing to apply in India for registration within six months of making of an application abroad to claim convention priority.

In such case, the court opined the person will of course lose priority if such an application is not filed in India within 6 months of filing in a convention country. The court elaborated if in the meanwhile an Indian applicant files an application for same or similar design then he will have prior rights in India over the foreign applicant. However, the foreign registered holder can challenge the registration of the Indian application if there is a prior publication of design in a foreign country before registration in India. The Design in such case being invalid both parties can use the design to market the products in India and cannot maintain infringement action.

About RNA: RNA is a full service Intellectual Property Law Firm with offices in Gurgaon and Chennai in India. Please note that the above is not advice on the subject. For more information/advice, please contact us at: info@indiaiprights.com.

Vatika Towers
10th Floor Block-B
Sector-54
Gurgaon-122002
National Capital Region (Haryana)
India

Tel. +91 124 465999
Fax. +91 124 4045047
Email info@indiaiprights.com

Copyright © Ranjan Narula Associates.