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12 October 2023

Office of the Controller General of Patents, Designs & Trade Marks
Department for Promotion of Industry and Internal Trade
Ministry of Commerce and Industry
Government of India
New Delhi 110001
India

Submitted via: email to cgoffice-mh@nic.in

Dear Prof. (Dr.) Unnat P. Pandit:

Intellectual Property Owners Association (IPO) appreciates the opportunity to submit its suggestions/comments regarding revision of the existing manuals and guidelines or for issuance of fresh manuals and guidelines in respect of Patents, Designs, Trade Marks, Geographical Indications and Copyrights as per the Public Notice dated August 30, 2023. IPO wishes to provide its suggestions/comments regarding revision of the Manual of Designs Practice and Procedure (“the Designs Manual”).

IPO is an international trade association representing a “big tent” of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO’s vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO’s mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO appreciates the opportunity to provide the following comments and suggestions for the Controller General’s consideration for revisions to the Designs Manual.

Comments on the Designs Manual

1. IPO appreciates and commends the commitment of the Designs Office to register a properly filed application which complies with the substantive criteria of registrability in one month from the date of filing (as already recorded under paragraph 03.01 of the Designs Manual). It is suggested that more and specific

- illustrations be provided of properly completed applications along with representations for different kinds / categories of design articles, including the designs for surface repeat patterns, two-dimensional articles like textile fabrics and clothing items, ornamentation, screen displays and icons, graphic symbols, part of articles, etc. This will help the Applicants, as well as the Designs Office, to accomplish the deadline of one month for registration of designs.
2. It is observed that, for compliance with the Designs Office practice of submitting perspective view and six orthogonal views of the designs, the Applicants are sometimes required to add representations in the convention / priority application. Accordingly, it could be clarified in the Designs Manual that while filing a reciprocity application in India (claiming priority from an application in the Convention Country), an Applicant is allowed to add representations / views of the article (in addition to the representations / views in the priority application) for compliance with local practice of providing perspective and orthogonal views of the article, provided that the additional views are consistent and compatible with the representations / views of the article in the priority application.
 3. IPO understands that, during the prosecution of electronically filed designs applications, some Examiners are still directing the Applicants to file physical copies of the representation sheets and other documents. Accordingly, it could be clarified in the Designs Manual that during the prosecution and examination of an electronically filed design application, the Applicant need not file physical copies of the electronically filed representation sheets and Power of Attorney document. IPO would suggest that, even for other documents such as priority documents, assignment documents, etc., the electronic filing should be found sufficient and the Applicants should not be required to file a physical copy of the electronic documents.
 4. IPO appreciates that the Designs Office has granted design registrations to Graphic User Interfaces (GUIs) in the past (such as Design Registration Nos. 274917, 274918, 274925, 276736, 284680, and 284682) in class 14-04, but it is notable that the Designs Office is currently refusing design applications for GUIs despite a recent observation made by the High Court of Kolkata that “*the finding that GUI/ ICON is incapable of registration is incorrect.*”¹ This has resulted in ambiguity about the registrability of designs for GUIs, Icons and other articles in Classes 14-04 and Class 32. Accordingly, it is suggested that a clarification be provided in the Designs Manual with respect to the registrability of designs applied to the articles under Class 14-04 and Class 32 of Locarno Classification, and, in particular, with respect to the articles listed below:
 - Graphic User Interface (GUI), Screen Displays, and Icons, as covered under Class 14-04 of Locarno Classification; and
 - Two-dimensional graphic designs, graphic symbols, and logos, which are covered under Class 32 of Locarno Classification.

¹*UST Global (Singapore) Pte. Ltd. Vs. The Controller of Patents and Designs and Anr.*

- It could be clarified that the articles listed above are “articles” within the meaning and definition under section 2(a) of the Designs Act, and any designs applied to these articles will not be refused registration on the basis that they do not qualify as articles under section 2(a) of Designs Act and that, further, in the case of Graphic User Interfaces (GUIs), Screen Displays, and Icons, the representations may be allowed to disclaim the underlying electronic device (phone, computer, etc.) by means of visual disclaimers such as dotted lines.
5. Presently, only limited details of registered designs with only one (perspective) view of the registered designs are available on the electronic Register of the Designs. It is suggested that the E-Register of Designs provide all the representations / views of the Registered Designs which have been finally approved and granted by the Designs Office. Like the practice in patents and trademarks, the E-Register of Designs could also provide the file docket of registered designs, including the office actions, responses, assignment documents, reciprocity details, priority documents, etc. This would help improve transparency and enable the public to understand the scope of the registered designs through all the granted representations of the design.
 6. Since the electronic filing of designs applications, representations, forms, and other documents has been enabled and in practice for years, IPO suggests that Paragraph 03.06.02.02 of the Designs Manual be amended to include “*For electronic filing of a design application, representations sheets must be uploaded online along with the application at the online filing portal of the Designs Office. In case of e-filing, physical copies of the representations are not required to be sent separately to the Designs Office,*” in accordance with section 11 of the Designs Act and rule 14 of the Designs Rules, 2001 (“the Designs Rules”). Likewise, paragraph 03.01 and other relevant paragraphs of the Designs Manual could be amended to reflect that an application for registration of a Design can be filed electronically through the online filing portal of the Designs Office, or physically at any of the four patent offices.
 7. IPO would also suggest that, pursuant to the adoption of India’s accession to Locarno Classification in the Designs Rules under the Design (Amendment) Rules, 2021, paragraph 03.06.02.01, paragraph 03.06.02.06, and other relevant paragraphs of the Designs Manual be amended to identify that (per the Designs Rules) articles are classified according to the current edition of “*International Classification for Industrial Designs (Locarno Classification) published by the World Intellectual Property Organization (WIPO).*”
 8. For clarity and consistency with practice, paragraph 03.06.02.03 of the Designs Manual could be amended in clause (a) to include that in case the General Power of Attorney (“GPA”) has already been filed in another Design Application, it should suffice to file a copy thereof with endorsement of the Application Number in which the GPA was filed.

9. Since India is a Participating and an Accessing Office of the WIPO Digital Access Service (DAS) with effect from January 31, 2018, and the same is also implemented in practice, paragraph 03.06.02.04 and paragraph 04.02(h)(II) of the Designs Manual could be amended to identify that DAS Code can be provided as an alternative to submitting a certified copy of a priority application in the reciprocity applications. Further, Paragraph 03.06.02.04 could be amended to include that if the copy of a priority application is digitally certified and/or downloaded from the online records of the IP office of a Convention Country, the same shall be found sufficient for establishing priority and a physical copy of the priority document would not be required to be filed in such cases. This would facilitate claiming priority from an IP Office which does not issue physical certified copies of priority applications, as well as increase efficiency and convenience in filing reciprocity applications.
10. IPO understands that it is commonly observed that the Examiners insist on the filing of all 7 representations (one perspective view and 6 orthogonal views) even for articles which are two-dimensional and/or symmetrical where some of the views are either unintelligible or redundant. Accordingly, in Paragraph 03.06.02.05 of the Designs Manual, it could be clarified that, in the case of symmetrical three-dimensional designs or two-dimensional designs, repeated views and obvious, unintelligible, or unornamented views (such as side views of two-dimensional designs) need not be filed. Mirrored images, flat bottoms, and unornamented surfaces can be clearly indicated in the description.
11. Paragraph 04.03.01 (f) of the Designs Manual provides an illustrative list of non-registrable designs which include articles like calendars, certificates, dress making patterns, greeting cards, postcards, stamps, medals, cartoons, etc. IPO understands that many articles listed in this paragraph are registrable under different classes of Locarno Classification, and are also registered by the Designs Office. Accordingly, to remove ambiguity and inconsistency, it is suggested that paragraph 04.03.01 (f) be either deleted altogether or that clarifications be provided, in respect of the list, to avoid any confusion.
12. Under paragraph 14.02 of the Designs Manual, it is mentioned that “*all the appeals under the Designs Act, 2000, lie to the High Court of Kolkata.*” This creates a possible conflict in the future with the observations or findings that may be made by a High Court or Supreme Court on the issue of jurisdiction of these appeals, particularly when the Designs Act or Designs Rules do not specifically prescribe the jurisdiction or the work of other IP Offices might be involved. Accordingly, it might be ideal if the Designs Manual refrains from commenting upon the jurisdiction of a High Court against the orders of the Controller.

IPO thanks the Controller General for the opportunity to share these comments.

Sincerely,

A handwritten signature in black ink, appearing to read 'Karen Cochran', is centered below the word 'Sincerely,'. The signature is fluid and cursive.

Karen Cochran
President