



SUGGESTIONS/COMMENTS ON MANUAL OF DESIGNS
PRACTICE AND PROCEDURE

Submitted to the Office of CGPDTM

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BACKGROUND

The Office of the Controller General of Patents, Designs, and Trademarks (hereinafter referred to as “CGPDTM” or “IP Office”) issued a notification calling for comments and suggestions on existing intellectual property (IP) manuals and Guidelines on August 20, 2023. In furtherance of the said notification, IP attorneys at BananaIP Counsels (“BananaIP”) are hereby submitting their views and suggestions with respect to the Manual of Designs Practice and Procedure (“Manual”) for the CGPDTM’s consideration. These comments and suggestions are being submitted with the honest and bonafide intent of enabling the IP Office improve the Manual based on experiences of all stakeholders.

STRUCTURE

The comments and suggestions in this document are divided into the following parts:

- I. Latest Locarno Classification
- II. Clarity on Registration of UI/UX Designs
- III. Division of Application
- IV. Accessibility of the IP Process/Systems to Persons with Disabilities

- V. Design Cancellation
- VI. Filing Request for Withdrawal
- VII. Name of the Designer
- VIII. Renewal Process
- IX. Design Public Search
- X. Online access to Registered Representation Sheets
- XI. Online Portal to access documents and track progress
- XII. Issues in Registration Certificates and Representation Sheets

COMMENTS AND SUGGESTIONS

I. Latest Locarno Classification

With respect to classification, the Manual under the section Application Form (03.06.02.01 on Page 14) states as follows:

“Under the Designs Rules, 2001, articles have been classified in the Third Schedule based on Locarno Classification.”

The section Classification of Design (03.06.02.06 on Page 20) in the Manual states as follows:

“d. The classification of articles under The Third Schedule is based on the International Classification of Industrial Designs according to the Locarno Agreement. However, India is not a signatory to the agreement.”

India is now a contracting party of the Locarno Agreement, and Rule 10(1) of the Designs Rules, 2001 (as amended by The Designs (Amendment), Rules, 2021) (hereinafter “Rules”) states as follows:

“10. Classification of Goods.-

(1) For the purposes of the registration of designs and of these rules, articles shall be classified as per current edition of “International Classification for Industrial Designs (Locarno Classification)” published by World Intellectual Property Organization (WIPO) ...”

The Third Schedule of the Rules which the Manual refers to is the older version of the Locarno Classification.

SUGGESTION: - It is suggested that the Manual be updated to state that the current/latest edition of the “International Classification for Industrial Designs (Locarno Classification)” published by the World Intellectual Property Organization (WIPO) will be applicable.

II. Clarity on Registration of UI/UX Designs

The IP Office issues examination reports in applications seeking protection over UI/UX designs, objecting broadly on the grounds of the design being non-registrable. The objections either state that the Third Schedule of the Rules does not allow for registration of a UI/UX design or that the representation of a UI/UX is not a design as per the Designs Act, 2000 (hereinafter “Act”). As per Rule 10 of the Rules, we must comply with the latest edition of the Locarno Classification for the purposes of classification of design. As per the 14th edition of the Locarno Classification, sub-class 14-04 which is for “SCREEN DISPLAYS AND ICONS” lists the following registrable articles under this sub-class:

1. 102529 - Graphical user interfaces [computer screen layout]
2. 104993 - Graphic symbols for screen display
3. 105098 - Augmented reality graphical user interfaces [for screen display]

In the matter of UST Global (Singapore) PTE Ltd v. The Controller of Patents and Designs and Anr. (AID No 2 of 2019), the Hon’ble Calcutta High Court vide judgment dated 20th March 2023 set aside an order passed by the Assistant Controller of Designs under the Act refusing registration to the design solely on the ground that a Graphical User Interface (“GUI”) or UI/UX is not a design as per the Act and Rules.

Based on the aforementioned, it may be inferred that the Act and Rules allow applications seeking registration of UI/UX designs under sub-class 14-04. However, in order to file for registration of GUIs, applicants require clarity on how the

representation sheets should be filed in order to ensure fewer objections with respect to specificities of representations.

SUGGESTION: - It is requested that the IP Office issues specific guidelines for filing applications seeking to register a GUI design. It would be really helpful if the Manual specifically clarifies how the applicant should submit the representations of the UI/UX designs.

III. Division of Application

In certain cases, the applicant receives objections regarding the multiplicity of designs in a single application. In such a situation, the IP Office requires the Applicant to choose one of the probable designs and submit amended representation sheets. As for the other design possibilities fresh independent filings are required.

SUGGESTION: - It will be helpful if the Manual can provide the applicant with an option to divide the application from the objection stage onwards into one or more divisional applications.

IV. Accessibility of the IP Process/Systems to Persons with Disabilities

Owing to the advantages offered by the IP profession that makes it possible for persons with disabilities to practice independently, and earn a dignified livelihood, the number of IP attorneys and agents with disabilities is increasing. Additionally, many persons with disabilities are not only inventors and creators, but also use the website and the online systems of the IP Office for technical, design, and other information. To facilitate the accessibility of information, systems, and the IP process, the IP Office has taken the much-needed step of issuing Guidelines for Accessibility and Reasonable Accommodations in March, 2022. However, many officers in the IP Office are not aware of these guidelines, and the need to facilitate accessibility and reasonable accommodations. To address this issue, and to integrate accessibility into IP processes and systems, a section on accessibility may be included in the Manual of Designs and other forms of IP.

SUGGESTION: - The following para may be considered for inclusion in the Manual:

“Accessibility to Persons with Disabilities

The IP Office recognizes the need to facilitate accessibility of its website, processes, and systems to persons with disabilities, and is committed to taking accessibility steps and providing reasonable accommodations. Towards this end, the Office of CGPDTM has issued ‘Guidelines for Accessibility and Reasonable Accommodations on 4th March 2022. To implement the same, all controllers, examiners, and other officers shall:

- i. Provide the requisite accessibility measures and reasonable accommodations as stated in the guidelines for accessibility and reasonable accommodations, and as required under the Rights of Persons with Disabilities Act, 2016, and rules/guidelines framed thereunder;
- ii. Provide the reasonable accommodations recommended by the nodal officer appointed to address accessibility issues of persons with disabilities.
- iii. Acknowledge communications from persons with disabilities relating to accessibility within twenty-four (24) hours, and confirm if a requested accessibility measure and/or accommodation will be provided or not;
- iv. Give reasons in writing if a requested/recommended accessibility measure or accommodation cannot be provided without undue delay, and bearing in mind the statutory timelines applicable for a given case/file; and
- v. Not require the person with a disability to pay fee for processing an accessibility request, or to provide a reasonable accommodation such as adjournment or time extension to address accessibility issues.”

V. Design Cancellation

The Act and Rules provide for filing a petition seeking cancellation of a registered design on various grounds. The documents are usually filed online using the online

portal and also submitted in hard copy. Once the documents are duly received the IP Office then checks for discrepancies in the hard copy submitted and communicates the same to the petitioner. Once the IP Office ensures that the petition is proper, the petition is then served to the registered proprietor and the cancellation process and related procedure follows as per the Act and Rules. At this point of time, the petition filed, notice of cancellation, and other subsequent documents and processes cannot be tracked online by either the applicant or the petitioner.

SUGGESTION: - It will be helpful to applicants and attorneys/agents if the IP Office can provide the facility of online tracking of the petition for cancellation, subsequent documents and IP Office communications, filed or issued, respectively. It is also requested to allow tracking of requests for extension of time filed and the order passed relating to the same. The IP Office may include details regarding the same in the Manual.

VI. Filing request for withdrawal

At times, an applicant or registered proprietor of a design may desire to withdraw their application or registration of their own volition. It could also be at times in the context of court proceedings or disputes. The registered proprietor may also choose to negotiate with the opposite party to withdraw its registration, rather than having the opposite party initiate the process for design cancellation against its design.

SUGGESTION: - The IP Office may consider providing guidance on the mechanism and process to withdraw a design application or registration in the Manual.

VII. Name of the Designer

A patent application allows for the inclusion of the inventor's name in the application form, distinguished from the applicant's name, as a means of offering appropriate acknowledgement to the inventor. Similarly, circumstances may arise wherein the person or entity applying for a design registration is different from the person who designed the article.

SUGGESTION: - It would be really beneficial in the interest of giving due credits to the designer, if the IP Office considers providing the applicant with an option to add

the name of the designer in the application and the registration certificate and/or representation sheets. The details regarding this may be incorporated in the Manual.

VIII. Renewal Process

As per the Act and Rules, a registered proprietor can extend the term of copyright in designs any time after registration by filing Form – 3 before the expiry of 10 years from the date of filing. If the 10-year period lapses the registered proprietor is required to file a request to restore the lapsed design.

SUGGESTION: - It would be convenient to applicants and attorneys/agents if a renewal intimation notice is issued at least 06 to 03 months prior to the deadline and if a renewal certificate is issued post-successful renewal, showing that the term of copyright in design has been extended by 5 years. The IP Office may consider including guidelines with respect to the same in the Manual.

IX. Design Public Search

The Design Public Search facility displays only one view of the article registered. The Rules require an applicant to submit a minimum of 4 views of an article with the design application. It is challenging to form an opinion about an article based on a single viewpoint.

SUGGESTION: - It is requested that the IP Office may consider providing a facility to display all the views of an article, as registered, in the design public search portal. Though this issue is not directly related to the revision of Manual, the IP Office may consider the same.

X. Online access to Registered Representation Sheets

All views of an article as registered are neither published in the design journal nor visible in the public search window. It is established through cases that design is a visually driven form of intellectual property with tests such as the ocular test for infringement and so on, which emphasize on what meets the eye. The analysis and conclusions regarding infringement and the existence of prior art are based on visual



similarity. All the views of the article, as registered, are not available for public perusal because of which it is difficult to construct and understand the article as a whole.

SUGGESTION: - It would be really beneficial if the Representation Sheet as granted is available on the design e-register for public perusal. The IP Office may consider this suggestion also though it is not directly related to the revision of the Manual.

XI. Online Portal to access documents and track progress

The application filed, examination report issued, response filed, hearing notice issued, hearing submissions filed, registration certificate along with the representation sheets as issued, petition of cancellation of design filed and any other documents uploaded by the applicant, petitioner or the designs are not accessible once filed or issued.

SUGGESTION: - The IP Office may consider making this information available online, and may include details regarding the same in the Manual.

XII. Issues in Registration Certificates and Representation Sheets

At times, discrepancies may arise between the details provided in the registration certificate and those in the representation sheets, as issued. In such instances, registered proprietors reach out to the IP Office by email or telephone in order to rectify the issue, and await its resolution.

SUGGESTION: The IP Office may consider including guidelines and process for correcting errors in registration certificates in the Manual.

DISCLAIMER

The comments, suggestions, and opinions provided in this document are based on the experience and understanding of design attorneys at BananaIP Counsels. They may not be considered as generalization of any particular aspect or matter addressed in this document. It is understood that attorneys and experts within and outside BananaIP may have differing opinions, and that the suggestions provided are not the only ways of resolving issues expounded in the document.



The views expressed in this document do not reflect the views of BananaIP's clients.

These comments, suggestions, and opinions with respect to the Manual of Patents have been submitted with the bonafide and honest intent of aiding the Office of Controller General of Patents, Designs, and Trademarks to improve the Manuals, and make the IP process more transparent, accessible, certain, and efficient.

ABOUT BANANAIP

BananaIP's Attorneys have been filing & prosecuting design applications over the last 20 years. The comments in this document are based on their experience in the field, ongoing research activities, and understanding of Designs Law.

CONTACT INFORMATION

Given the opportunity, we will be happy to give a presentation regarding the comments in this document. For any questions/clarifications regarding the document, please feel free to contact us at: designs@bananaip.com; contact@bananaip.com and/or on +91-76-25093760/+91-80-26860414/24/34