

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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10th March, 2011

Shri P.H. Kurian,
Controller General of Patents, Designs & Trade Marks
Bhoudhik Sampada Bhavan,
Near Antop Hill Head Post Office,
S.M. Road, Antop Hill,
Mumbai-400037,
India

Dear Shri P.H. Kurian,

Re: Draft Manual of Design Practice and Procedure

The Japan Intellectual Property Association (JIPA) is a non-governmental organization that was established in 1938, which represents users of intellectual property systems. As an association having about 900 Japanese leading companies, JIPA submits requests and proposals to the relevant authorities and organizations with regard to the establishment of intellectual property systems overseas and improvements in the implementation thereof.

As for recruiting comments " Draft Manual of Design Practice and Procedure " on your website, we have often discussed since 2005 with Indian Patent officials in New Delhi, Mumbai Kolkata and Tokyo. And we still continue to maintain an awareness of this issue today.

Therefore, we reviewed the above Draft Manual, and submit important issues for IP stakeholders.

Your deeply consideration on these matters will be appreciated.

Yours faithfully,

(Kenichi Osonoe)

Managing Director of Japan Intellectual Property Association
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Comments on the Draft Manual of Design Practice and Procedure
Japan Intellectual Property Association

1. Notice of reasons for refusal issued without citing any references

(Relevant Clauses)

Manual of Design Practice and Procedure, 04.03.02.03, 04.04 b

(Comment)

When the Controller notifies the applicant of his/her objection to the design application (reasons for refusal) based on the lack of novelty, the examiner should cite the references that he/she has found in the databases, etc. in the notice of reasons for refusal without exception.

(Reasons)

Some applicants received notices of reasons for refusal of a design application that state, "The design prima facie appears to be lacking in novelty." Against such notices, they submitted written answers in which they rebutted the refusal, stating that they could not accept such reasons for refusal without any cited references to prove the reasons, and as a result, all of these applications matured into the registration of designs.

That the examiner is unable to find any public evidence to deny novelty (publicly known designs) proves the existence of novelty. Having received such notices of reasons for refusal, the applicants would have to respond to them by submitting written opinions, and spending extra time and money, even though novelty had existed from the beginning.

2. Definitions of *originality*

(Relevant Clauses)

Manual of Design Practice and Procedure, 04.03.02.02

(Comment)

Item b should be deleted.

(Reasons)

As examples of original designs, this clause mentions designs of a flower vase or ash tray in the form of the figure of Taj Mahal. However, these designs are nothing more than the products of replacement, made merely by applying an established or well-known figure of an object to another object. From the perspective of protecting creations (designs), *originality* should be recognized only for *one and only, original figures (designs)*.

3. Amount of damages for piracy of a registered design

(Relevant Clauses)

Manual of Design Practice and Procedure, 06.02

(Comment)

The upper limit of the amount of damages should be raised.

(Reasons)

Item c stipulates as follows: "If any person commits piracy of a registered

design, as defined in Section 22, he shall be liable to pay for a payment of a sum not exceeding twenty thousand rupees, recoverable as contract debt. However, the total sum recoverable in respect of any one design shall not exceed fifty thousand rupees." Considering that the Designs Act aims to protect the creator's exclusive right to use the result of his/her creative activities, and for the purpose of preventing repeated offenses of piracy, the upper limit set in this clause needs to be raised.

4. Use of dotted lines to indicate those elements of the article outside the scope of protection

(Relevant Clauses)

Manual of Design Practice and Procedure, 03.06.02.05

(Comment / Question)

Item t stipulates, "Dotted lines may be used in representation to indicate those elements of the article for which no protection is sought." On the contrary, the definitions of "design" under Section 2, paragraph (a) of the Designs Act do not include a definition of "partial design."

Does this clause in the manual apply under the partial design system, which protects parts of a design?

5. Definitions of *non-registrable design*

(Relevant Clauses)

Manual of Design Practice and Procedure, 04.03.01 f

(Comment)

The scope of non-registrable designs should be revised.

(Reasons)

This clause lists examples of non-registrable designs, i to iv. However, the designs of those articles in the list should be protected under a design right if they are both creative and decorative.

For instance, among the articles in the list, designs of labels and cartons should be protected under a design right from the perspective of preventing imitation if such protection does not interfere with public use of the articles and these designs are both creative and decorative.

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