Concept of Originality and Novelty in Industrial Design: Mapping through Indian Judicial Precedents

Shailja Sharma[871]

ABSTRACT

Industrial design protection is central to the Indian Designs Act, 2000 which entails the two essential conditions of novelty and originality. Although these terms have been clarified in the statutory text in Section 2(g) and 4, the judicial interpretation especially by the Delhi High Court, the Madras High Court and tribunals have served to clarify the design jurisprudence of India. The paper attempts to discuss how the notions of originality and novelty have been applied in the Indian courts based on classic cases like M/s B. Chawla and Sons v. In cases of interpretation of the Sections 4, 19 and 22 of the Act, Bright Auto industries, Pentel Kabushiki Kaisha & Anr. v. M/s Arora Stationers and Ors, and other similar cases. In the study of doctrinal law, this paper has been able to establish crucial ambiguities and a structure of future judicial and legislative transparency. The study concludes that even though originality and novelty are statutory conditions in order to be registrable, courts have established an instructed eye approach where products must have a high degree of distinguishability in comparison with other trade designs. It promotes more explicit tests in order to balance industrial development with design protection.

Keywords: Originality, Novelty, aesthetic.

INTRODUCTION

The industrial design protection is a unique and frequently under-theorized place in the larger structure of the Indian intellectual property law. In contrast to patents, which provide a reward to technical innovation, or copyright, which secures an artistic and literary expression, the industrial design law protects the aesthetic and visual characteristics of an article, its shape, configuration, pattern, ornamentation, or composition of lines or colours, provided that such characteristics can be applied to an article by industrial process. The policy of this protection lies in the fact that the visual image is a major factor in consumer decision, competition in the market and industrial progress.

[871] Student at Lovely Professional University, Punjab.

In a consumer society like the Indian, which is fast changing, the looks of the product tend to be the deal in the business. In the case of the automobile industry, consumer electronics, kitchen appliances, furniture, packaging and fashion accessories, industrial design has emerged as a very important differentiator.

An unusual form of a bottle, an efficient pen design, or a peculiar form of an appliance could not entail a technical breakthrough, but it could get a significant amount of goodwill on the market. The legislation, then, attempts to provide a balance: it is promoting aesthetic creativity and avoiding the monopolization of ordinary or trade-oriented designs.

The industrial design protection in the Indian legislation aims at recognizing the ingenuity of forms, designs, forms, or ornamentation of articles through industrial procedures. This regime is under the Designs Act, 2000 ("Act), with major criteria of a registrable design such as novelty and originality- words that entangle intellectual innovativeness and untrodden field of design. In **section 2(g),** the term design is given a meaning, which is features of shape, configuration, pattern, ornamentation, or composition of lines or colour to an article; and it is required that the features must be produced by the human intellect, and that they must be novel or original[872]. **Section 4(a)** also does not allow registration of designs that is not new and original, whereas **Section 4(b)** does not allow registration of design that was disclosed in the tangible form anywhere in the world[873].

Although the terms novelty and originality may seem to be simple to understand as per the statutory language, they are not defined separately in the Act. This lack of statutory definition has resulted in large scale judicial interpretation. Novelty and originality: are the two terms the same? Does creativity need to be an individual intellectual endeavor? What is the amount of variation necessary to become novel? Is it enough to combine familiar traits in a new combination? These are the questions that have been raised in Indian courts.

Notably, the Indian courts have also made a distinction between originality of the industrial design and originality of copyright. In contrast with copyright, where artistic works are

[872] Design Act 2000
[873] Section 4 (a)-(b)

safeguarded by low innovation standards, industrial design law requires novelty in a commercial way of the design in question, that is, it must not have been previously published or utilized and provide a visual impression that can be greatly distinct to the previous designs existing in the trade. This distinction reveals the hybridity of design protection: it neither is artistic, nor is technical, but commercial-aesthetic in its nature.

This issue of the interpretation of novelty and originality is magnified further in the industries that are typified by incremental development in designs. The contemporary production is often based on the existing aesthetic models. It is usually minor ergonomic adjustments, style changes, or fashion-based changes. The law system thus needs to decide when these changes move beyond the boundary of acceptability of adaptation to safe guardable originality. Over protection may lead to death of competition and under protection may lead to lack of investment in product design innovation.

In addition, globalization and digital distribution have made the novelty requirement difficult. Section 4(b) takes a global novelty test, as such, previous publication in any part of the world can be fatal to registration. In an era of immediate worldwide accessibility by way of online routes, ascertaining preceding revelation is a complex evidentiary concern. In assessing novelty issues, courts are becoming more obliged to work with electronic evidence, trade catalogues and overseas design data bases.

So, the principles of originality and novelty are not the technical statutory provisions, but the philosophical basis of the Indian design protection system. These statutory phrases of abstraction have been successfully turned into legal standards that are practical through judicial interpretation. Nonetheless, with the increasing design orientation and globalization of the industries, the necessity to have a clear doctrine gain even more momentum.

The present research paper thus carries out a critical doctrinal analysis of the way that the twin requirements of novelty and originality have been understood and applied by the Indian courts. The analysis of the top precedents, statutory provisions, and commentary of the scholars is aimed at offering conceptual clarity and determining whether the Indian jurisprudence has managed to create a consistent and predictable framework. By so doing, it has added to the current academic debate on the changing scene on industrial design protection in India.

RESEARCH PROBLEM

In India, the novelty and originality of a design is determined on the basis of visual appearance including the pattern, shape, arrangement or ornamentation of products. These words may seem easy but the harsh reality is that they pose grave legal issues in practical life.

The Designs Act, 2000 fails to present clearly the meaning of the terms novelty and originality. Due to this, courts have been forced to give meaning to such concepts using individual cases. With time, judges have come up with some standards e.g. a design should not be made up of a minor variation of trade. Meanwhile, also, the appearance of the whole product is observed in courts. Although the principles are useful, they are not always a definite rule that can be followed by the designers and businesses in advance.

One of the practical challenges is presented in the industries, where the products inherently resemble each other. As an example, the functional needs or expectations may leave kitchen appliances, pens, bottles, or motor parts similar in their shape. In these cases, one will not be able to determine whether a change is only cosmetic or something original. When the law secures very small distinctions it might promote unjust monopoly. Conversely, when the standard is set very high, then the actual creativity might not be secured.

The other increasing issue is associated with previous publication. The Indian law adheres to an international criterion of novelty, that is, a design can never be registered after it has been published in any part of the world. In the modern digital world, designs can be immediately seen in the form of websites, online stores, exhibitions and online catalogues. This complicates the process of establishing the fact that a design is actually novel when registering the design.

The fundamental issue to be discussed in this study is hence whether Indian courts have managed to provide straightforward and coherent interpretation of originality and novelty. Have judicial precedents resulted in conceptual clarity, or is there still any uncertainty in the application of these terms? The answer to this question would not only be of importance in the academic context but it is also essential in the context of industrial design protection in the sense of certainty.

SCOPE OF THE STUDY

This paper is particularly concerned with interpretation of originality and novelty to the Designs Act, 2000. It does not endeavor to deal with all that the design law encompasses but rather focuses on the legal definition of the two key provisions.

The study is an analysis of pertinent statutory measures especially, Section 2(g), 4, 19 and 22 of the Act 2000. It examines the interpretation of these provisions by Indian courts in some of the landmark cases. The special focus is paid to the decisions of the Supreme Court and High Courts, particularly, the Delhi High Court or Madras High Court in particular because these courts often handle the issues of intellectual property.

The research is doctrinal in character. It is founded on case law, statutory interpretation and academic literature. It is not based on empirical surveys, interviews or statistical research on design registrations. Rather, it seeks to learn how judges make decisions concerning cases that involve alleged novelty and originality. There are also similar issues that the research examines including prior publication, slight variations, combination of already known features, and the overall visual impression test. It however does not make a detailed comparative analysis with other jurisdictions in other countries such as the European Union or the United States unless there are brief references which need to be made in context.

Concisely, this study has a narrow but a focused scope. It tries to comprehend how originality and novelty as interpreted by the Indian judicial precedents have influenced the meaning of originality and novelty and whether such interpretations have given a satisfactory clarity to the designers, businesses and courts.

RESEARCH GAP

Although the concept of industrial designs has been academically discussed and professionally debated, there is a scarcity of academic synthesis that breaks down the way Indian courts have narrowed in to the interpretation of novelty and originality tests and how they have adjusted them to the words of the statute. Most literature uses novelty and originality as synonyms with patent law tests and creates confusion in doctrines. Moreover, more often Judicial decisions are under-analyzed to impact on the iterative design innovation in industries in India. Thus, this study deals with:

- Indian courts and their conception of novelty and originality.

- What practical tests have we had on the basis of judicial interpretations?
- Judicial interpretation provides adequate predictability to the stakeholders.

RESEARCH OBJECTIVES

1. To examine judicial meanings of novelty and originality in the Designs Act, 2000.
2. To find out ways in which Indian courts can tell the difference between insignificant changes and true design innovation.
3. In order to examine the interaction between the text and judicial reasoning of statutes.
4. To evaluate the existing data and offer suggestions for betterment accordingly.

RESEARCH QUESTIONS

1. How does Indian jurisprudence deals with the concepts like originality and novelty in the context of industrial design?
2. How do courts interpret whether a design is substantially new or original?
3. Are the designs act judicial interpretations in line with the legislative intent?
4. What is the implication of judicial interpretation on designers and industry?

METHODOLOGY

The methodology adopted for the successful completion of this research paper is Doctrinal in nature. It shall further incorporate both primary as well as the secondary sources. Constitutional provisions, statutory frameworks and judicial decisions have been taken up for research as primary source of data whereas articles from various existing research papers and reputed law journals available on this topic is taken into account being a secondary source.

Primary Sources: -

- Design Act, 2000
- Judicial decisions
- AIR (All India Reporter)
- SCC
- PTC (Patent & Trademark Cases)

Secondary Sources: -

- Textbooks on IP law

- Journals
- Law articles

JUDICIAL PRECEDENTS

- CASE: BHARAT GLASS TUBE LTD. Vs GOPAL GLASS WORKS LTD[874]

The doctrine of "New Application" was emerged through this case

Facts: The respondent had registered a design of the shape of the diamond on glass sheets. The appellant objected to it citing that the design had been published by a German firm in a catalog.

Legal Principle: The Supreme Court made it clear that there is a difference between a design and its application. It believed that although there may be a pattern (e.g. on paper or textile), its use to a new medium (glass sheets) can be considered as "originality" under Section 2(g).

Held: Originality does not require the creation or the invention of some new form never to be seen before rather it involves the novel use of an old form to a particular article of manufacture.

- CASE: B. CHAWLA & SONS vs BRIGHT AUTO INDUSTRIES[875]

Mostly recognized as the case of the "Trade Variant" specifications

Facts: The appellant had registered a design of a rear-view mirror of motor vehicles. It was a normal rectangular mirror in a shape with slightly rounded corners.

Legal Reason: The rule of Trade Variant was determined by the Delhi High Court.

Ratio: A design is not new or original because it is simply a variation which any expert in the trade would naturally make. A geometric figure with a curve or a fillet added to it fails to qualify with regards to novelty. There has to be a significant transformation, which will be felt as something different.

- CASE: PENTEL KABUSHIKI KAISHA vs M/S ARORA STATIONERS & Ors[876]

In the case of Pentel Kabushiki Kaisha v. M/s Arora Stationers and Ors. (SCC OnLine Delhi 11781), 2019, the Delhi High Court reconsidered the novelty and originality conditions under the Designs Act, 2000 in a case involving the alleged piracy of a design of a ballpoint pen. The defendants also claimed that the plaintiffs registered design not only lacked novelty, but also they also knew of the similar elements in the trade. The Court reinforced the fact that novelty,

[874] 2008 10 SCC 657
[875] AIR 1981 Del 95
[876] 2019 SCC

and originality should be judged by reference to the registration date and a registered design has a prima facie claim of validity unless successful challenged under Section 19. It also noted that originality is determined by the general visual impression, but not isolated similarities.
This ruling is notably pertinent in the way that it updates the concept of Bright Auto Industry established in the context of the 2000 Act and makes it clear that the issues with novelty are to be supplemented by the evident facts of previous publication or the absence of a significant difference.

- CASE: RECKITT BENCKISER (INDIA) LTD vs WYETH LTD[877]

Facts: The point of contention was on whether a design that was registered in foreign countries but not in India may be a prior publication to revoke an Indian registration.
Legal Principle: The Full Bench dealt with the territoriality of novelty.
Held: Publication is not limited under Section 4(b) to India. When a design is registered in the database of a foreign patent office and it has been digitally available in India, then it is said to be published. This formed the Global Novelty criteria in the Indian Design Law.

- CASE: WHIRLPOOL INDIA LTD vs VIDEOCON INDUSTRIES LTD[878]

Facts: Whirlpool sued Videocon because of imitating the washing machine with a semi-automatic washing machine that included a definite shape with curvy lines.
Legal Principle: The Bombay High Court discussed the Mosaic of the earlier arts.
Ratio: According to the court, the novelty test is the Appeal to the Eye. Although an individual component of a design (such as a circular tub) may be familiar, the specific combination and positioning of said components may produce a new aesthetics. Moreover, when the shape is determined by the mere utility of the object, one cannot protect the shape as a design; but when the designer had a choice of ways to attain that functionality, but he or she took up a particular aesthetic path, the shape can be safeguarded. The case emerged two doctrines: the functional necessity and the eye of the consumer

- CASE: MAYA APPLIANCES LTD vs PREETHI KITCHEN APPLIANCES LTD[879]

[877] 2013 (54) PTC 90 (Del)
[878] 2014 (60) PTC 155
[879] AIR 2013 Mad 134

The allegation in Maya Appliances (P) Ltd. v. Preethi Kitchen Appliances (P) Ltd., AIR 2013 Mad 134 was a design piracy case in respect of mixer-grinders. The Court stated that registration of a design gives rise to a prima facie presumption of novelty and originality which is only refutable by substantial evidence under Section 19 of the Designs Act. Significantly, the Court used the so-called instructed eye test or the way in which the individual that knows the existence of such goods would rate visual distinction.Small or trivial changes that have no substantial difference to the general impression were not sufficient. This case has a direct bearing since it brings together the evidentiary and perceptual criteria pertaining to originality by reinforcing the concept that design distinctiveness should be evaluated using visual and commercial realism.

- CASE: MICROFIBRES INC. vs GIRDHAR & CO.[880]

In Microfibres Inc. v. Girdhar and Co., AIR 2009 Del 15, the copyright and design protection earlier, but the most notable observation of the court was on the originality of the industrial design. The Court made it clear that as soon as a design that can be registered according to the Designs Act is put to an industrial use, the copyright protection is not available anymore, and the novelty and originality tests under the design law are bound to take their toll. The case highlights the fact that design law originality is not exactly the same as copyright originality and it must meet the statutory criteria of novelty and visual effect. It is relevant because it brings out the boundaries provided by the doctrines of originality, whereby when there is a dispute between two or more intellectual property rights, it is likely to blur the standards of novelty.

SUGGESTIONS

Having analyzed statutory clauses in the Designs Act 2000, judicial precedents and commentaries, there seems to be some structural and doctrinal refinements which need to be undertaken so as to achieve clarity in the interpretation of new and original designs in India.

1. Clear Judicial Differentiation between the terms Novelty and Originality is required.

The new and original terminologies have at times been used interchangeably by the Indian courts. Although Section 4 of the Designs Act speaks of a new or original, judicial

[880] AIR 2009 Del 15

interpretation has not been consistent to state whether it is a one or the other requirement or is a combination of the two. Courts are indicated to expressly state:

- Novelty as lack of pre-publication.
- Originality as pictorial difference due to autonomous production.
- The adoption of a formal judicial test to differentiate the two concepts would minimize the interpretative mismatch and enhance predictability in the litigation process.

2. Tracing a Standardized Informed Eye Test.

When determining infringement and validity, the courts often make reference to the so-called ocular impression or the instructed eye standard. Nevertheless, the amount of expertise that is ascribed to such a hypothetical observer is not always determined.

A standardized test must be able to explain:

- The viewer will be either a normal consumer or somebody who is conversant with the trade.
- The level of attention anticipated.
- The applicability of insignificant differences.

Making this test codified or explicitly defined by some official Supreme Court teaching would enhance the coherence of the doctrine.

3. More Intense Inspection during Registration.

The numerous contests are due to the registration of the designs without strict examination of the previous publication. The Design Office should:

- Intensify previous art studies.
- Diversify and computerize databases across the globe.
- Train examiners better in comparative visual examination.

This would lessen after registration litigation and also weak or non-original designs would not be registered in the registry.

4. International Standards harmonization.

India is a member to the TRIPS Agreement which requires protection of independently designed industrial designs that are new, original. Although the Indian law is has been adhered to in principle, judicial articulation can more concurring to the global jurisprudence, especially in:

- Doctrine of European Union overall impression.
- UK understanding of design uniqueness.
- Comparative therapy of functional exclusions.

Harmonization would increase compatibility of India in terms of international trade and enforcement of intellectual property.

5. Elucidation on Functional Elements.

Courts have been right in stating that purely functional features cannot be safeguarded under design law. Nevertheless, their conflict is common on the boundary of the aesthetic and functional features.

It is suggested that courts:

- Use a systematic, functionality exclusion, analysis.
- Look at the possibility of using alternative designs to accomplish the same purpose.
- Individual technical innovation (patent field) and visual appeal (design field).
- This would stop the abuse of design law as an alternative to patent protection.

6. Constant Resort to Previous Publication Standards.

Cases have underlined that the design should be publicly disclosed through pre-publication. There is however an inconsistency in matters of online publication, catalog circulation and foreign disclosures.

Definite directions are required to define:

- Whether publication in foreign countries is prior publication in India.
- What is an adequate visual disclosure.
- The burden of evidence necessary.
- This would help in minimizing confusion during cancellation.

7. Academic and Judicial Discourses.

Scholarly literature and judicial reasoning in design cases are not well cross-referenced. It may be better encouraged that the judiciary engage with scholarly commentary in the context of enhancing conceptual richness in decisions.

Training programs in judicial work, workshops and academic partnerships could help produce more sophisticated reasoning in sophisticated design cases.

CONCLUDING REMARK

Protection of industrial designs takes a special place in the intellectual property law. Design law protects aesthetic creativity in industrial articles unlike patents which acknowledge technical innovation or copyright which upholds artistic expression. The most crucial aspect of this protection is the fact that a design should be new or original.

The meaning of these words has been greatly influenced by the Indian judicial precedents. Courts have demystified that the originality in design law is visual newness and not functional newness. They have also put an emphasis on the visual impression overall and have shunned protection on isolated trade differences. The judiciary has been able to avoid the misuse of design registration through landmark decisions and has strengthened the boundary between aesthetics and functional disciplines.

But even with these developments, there are still conceptual ambiguities. The interchangeability of judicial terms originality and novelty, inconsistent expression of the standard of an informed observer and occasional confusion of design and patent concepts show the need to be more precise in the doctrine. It would be useful to have a more organized interpretative system that would be of value to several stakeholders:

- Designers would have more confidence about protection.
- Companies would have fewer litigation risks.
- There would be consistent jurisprudence in the court.
- The Indian intellectual property system would be much closer to the international standards.

Finally, originality in the industrial design law ought not to be a somewhat statutory ritual. It is the legalization of aesthetic creativity in industry production. The judiciary must have a clear

definition and application of this requirement not only in dealing with cases but also in fostering creativity, art and healthy competition in the market.

The history of Indian design jurisprudence is an indication of the increased maturity in intellectual property adjudication. India can create a consistent and robust structure with the more distinct lines of doctrinal thinking and better institutionalized processes that actually give true rewards to true aesthetic innovation and avoid monopolizing everyday designs.