IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
ORIGINAL SIDE

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

AID NO. 2 OF 2019

IN THE MATTER OF

UST GLOBAL (SINGAPORE) PTE LTD

Vs

THE CONTROLLER OF PATENTS AND DESIGNS AND ANR.

For the Appellant	: Mr. Sidhartha Das, Adv. Mr. S. Mitra, Adv. Mr. A. Munshi, Adv. Mr. Yash Vardhan Deora, Adv. Ms. Amrita Choudhury, Adv.
For the Controller	: Ms. Rini Bhattacharyya, Adv.
Reserved on	: 19.12.2022
Judgment on	: 20.03.2023

Ravi Krishan Kapur, J.:

1. The appellant assails an order dated 4 September 2019 passed by the Assistant Controller of Patents of Designs under the Designs Act 2000 refusing an application being Application no.298921 filed on October 30, 2017 for registration of a design titled "Touch Screen" for a novel surface ornamentation which is a Graphical User Interface (GUI).

2. Briefly, the appellant is a global leading provider of end-to-end IT services and solutions for different companies. The appellant offers services in areas like Advanced Analytics, Data Engineering Services, Data Strategy Consulting, Industry Point Solutions, Data Management Cyber Security, Infrastructure etc.

3. It is contended that the claimed design is a novel surface ornamentation displayed on a touch screen. The concept of GUI contemplates visual representation of configuration of icons and several elements on a touch screen. GUI is also used as a powerful differentiation of products and user experience with the ultimate aim of influencing customer decision when buying such products.

4. By the impugned order, the application for registration has been rejected on the ground that a GUI is incapable of design registration. It has also been held that since the GUI is only visible when it is in 'ON' mode or operating mode there can be no design when the product is on 'OFF' mode. Hence, GUI cannot be treated as a design of any article. It has also been found that the ICON/GUI does not follow the process of industrial manufacturing but is mainly created by software development processing.

5. On behalf of the appellant it is contended that the impugned order is erroneous and is liable to be set aside. It is alleged that GUI is a software, an intellectual property, an article of value and hence capable of registration. Moreover, the subject design is original and

has never been in the public domain. A well implemented GUI can positively influence customers in buying such products.

6. Section 2(a) and 2(d) of the Designs Act, 2000 provides as follows:

> *(a) "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural and includes any part of an article capable of being made and sold separately;*
>
> *(d) "design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).*

7. The amendments caused to The Design Rules 2001 provide for classification of designs and articles. The 2008 amendment provides for an elaborate classification of goods and articles on which designs can be applied and registered. In fact, Class 14.02 and 14.04 of the Locarno Classification specifies articles belonging to "Screen Displays and Icons" which has also been recognised in the Design Rules

(Amendment) 2019. Additionally, the amendments made in 2021 to the Design Rules, 2008 introduced a new class 32 containing graphic symbols, graphic designs, logos, ornamentation and surface patterns. In view of the aforesaid, the finding that GUI/ ICON is incapable of registration is incorrect and ignores the aforesaid amendments.

8. Similarly, the finding that the GUI is visible only in ON mode or operating mode and hence not capable of registration is erroneous. The GUI in the present case is in-built. In-built ICONS are displayed in shops as well as in advertisements. Designs registered may be applied to any external or internal feature and are capable of registration if they appeal to the eye and enhance the aesthetic value of the product. Ordinarily, the design of a product is concerned with the external appearance of an article. However, the pertinent feature of visual appeal may in the case of certain articles be considered as features of a registrable design. In *Gramaphone Company Ltd. Vs. Magazine Holder Company (1910) 27 R.P.C. 152* it had been held as follows:

> *"A jack-in-the-box was the example considered in the hearing at the* Office, *and it was very understandably accepted by Mr. Miller that it might be possible to secure the registration of such an article, although in truth the only features of novelty would reside in whatever it was that sprang out of the box, and the box itself would possibly have no novelty at all from the design point of view."*

9. In *P. Ferrero and CSPA's Application (1978) RPC 473* it has also been held as follows:

> *"What is regarded as novel is the contrast between the exterior and the interior; and the application has been refused on the very simple ground that if one considers the finished article as sold, having stripped any wrapping paper that there may be from the egg, all that one can see is an ordinary chocolate egg. Unless of course it be of very small dimensions, at some stage it is inevitably going to be broken so that pieces of a convenient size can be put into the mouth; and at this stage it will become apparent that there is a feature in the egg which may be of some appeal, namely the interior coating of a different colour."*
>
> *"Many of us can no doubt remember the form of egg which was once available consisting of a chocolate exterior with a simulated egg white and yolk in the interior; and, although it was only by some advertisement that one was enabled to ascertain that the egg, when purchased, would have this particular feature, nonetheless one of the attractions of buying an egg of this character was what one was going to find inside the egg*."

10. The design submitted by the appellant is a 2D design i.e. a design which possesses the dimensions of length and width but does not possess depth. The novelty of the same can be judged by the eye as soon as the device is turned on. There is no requirement to touch the device in respect of the design. The process of application of the subject design i.e. GUI on the finished article is a mechanical and manual process which falls within the definition of "industrial process" mentioned in section 2(d) of the Designs Act 2000.

A software developer develops a source code which creates the GUI. This source code is then embedded in the micro-controllers and micro-processors and is displayed in screen by illuminating pixels by electronic means. Therefore, the design is applied to the article by industrial process and means. The criteria of "industrial process" has been dealt with in Re: *Apple Computer Inc.'s Design Applications [2002] F.S.R. 38* wherein it has been held as follows:

> "*The icons for which registration was sought were those inherently built into a computer. They were not the sort of icons which appeared temporarily whenever a particular computer program was loaded.*
>
> *There was no policy reason why registration should be refused. The icons were patterns or ornaments applied to an article by an industrial process. They were built into the software whose inclusion in the machine was part of an industrial process.*"
>
> *"That the icons/patterns/ornamentations are built into the software whose inclusion in the machine is part of an industrial process. The Registered Design Acts, 1949 required the features claimed to be features in the finished article; it did not require those features to be judged at the time the article was bought."*

11. In, *K.K. Suwa Seikosha's Design Application [1982] R.P.R. 166* it has been held that icons, consisting of a design to be applied on a display panel for an electronic timepiece, were registrable.

12. It had also been contended that the aforesaid design has been granted registration in USA and the European Union. Even though not binding

on the Controller, this aspect of the matter has not even been adverted to in the impugned order.

13. In view of the aforesaid, the impugned order is unsustainable and is set aside.

14. The matter is remanded back to the Controller for consideration afresh within a period of three months from the date of communication of this order and after giving a right of hearing to the appellant. In hearing the matter afresh, the Controller shall not be bound by any finding or observation in this order insofar as the merits of the case are concerned. With the aforesaid directions, AID 2 of 2019 stands allowed.

(Ravi Krishan Kapur, J.)