

DESIGNS

India



Designs

Quick reference guide enabling side-by-side comparison of local insights, including into the legal framework; registered and unregistered designs; registration and opposition procedures; enforcement; assignment and licensing; and recent trends.

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Table of contents

LEGAL FRAMEWORK

Relevant legislation

Nature of system

Agency

Overlap with other rights

UNREGISTERED DESIGNS

Protection

Use requirements

Exclusions

REGISTERED DESIGNS

Ownership

Scope

Costs

Grace period

PROCEDURES

Application

Examination and appeals

Opposition

Registration time frame

Removal from register

ENFORCEMENT

Grounds for a claim

Procedures

Remedies

Enforcement time frame

Recent cases

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Assignment and licensing

Licences of right

UPDATE AND TRENDS

Key developments and future prospects

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LEGAL FRAMEWORK

Relevant legislation

What is the relevant legislation?

The protection of industrial designs in India is governed by a dynamic legislative framework that is aligned with advances in technology and concomitant international developments. The Designs Act 2000, which repealed and replaced the Designs Act 1911, sets down the statutory framework for the protection of designs and has been in force since 11 May 2001. The Act not only provides for minimum standards of protection for industrial designs (as contemplated in the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)) but also conforms to international trends in design administration. In conjunction with the Designs Rules 2001, the Act streamlines the procedural aspects of registering and processing design applications. The 2014 amendment to the Designs Rules adds 'small entity' as a new category of applicant in addition to natural persons. India is also party to various international treaties that protect international designs, including the Paris Convention and TRIPs. The Designs (Amendment) Rules 2021 come into effect from said date and further amended the Design Rules, 2001. With the amendment rules, India now follows the 13th Edition of the Locarno Classification as per the current edition of the International classification for industrial designs as published by the World Intellectual Property Organization. With the amendment rules, start-ups have been expressly recognised as a new category of applicants that can benefit from discounted fees for filing, prosecuting and maintaining a design application/registration in India, which was previously applicable only to natural persons or small entities. Indian entities must be recognised as a start-up by the competent authority under the Union Government's Start-up India initiative. The Amendment Rules further permit foreign entities to claim the status of start-ups, provided it fulfils 'the criteria for turnover and period of incorporation or registration as per Startup India Initiative and submitting declaration to that effect'.

Law stated - 30 August 2022

Nature of system

Are design rights considered to be distinct or treated as patent rights?

The design rights are distinct and separate from patent rights. They only protect the aesthetic features of an article.

Law stated - 30 August 2022

Agency

Which agency is responsible for registration and grant of design rights?

The design office, based in Kolkata, is responsible for the registration of design rights in India.

Law stated - 30 August 2022

Overlap with other rights

Is there any overlap between design rights and other rights?

The shape of a product, its packaging or combination of colours used on a product may be a trademark, trade dress or a design applied to that product. The difference lies in the distinct purposes fulfilled by trademarks and designs. On one hand, a design is applied to a product to merely enhance its aesthetic value or commercial appeal. On the other

hand, a trademark is applied to a product to showcase its source of origin. A trademark may also appeal to the eye and enhance the aesthetic value of the product, but it is necessary that it acts as an association between the product and the source of origin, the manufacturer and the producer of the product. If a product feature merely enhances the aesthetic value or commercial appeal or appeals to the eye without pinpointing any source of origin, it is clearly the subject matter of a design right. However, if it enhances the aesthetic value or commercial appeal or appeals to the eye while also indicating the source of origin, there is an overlap between trademark and design rights.

In India, parallel statutory protection cannot be sought under the Trademarks Act and Designs Act. This is because the definition of a 'design' clearly excludes trademarks. However, it is much debated whether statutory protection on design rights and common law protection on trademark rights can simultaneously exist in cases where a registered design is also acting as a trademark because it indicates the source of origin to consumers.

In addition, copyright protection for a design may be claimed under the Copyright Act 1957 if the design is capable of being registered under the Designs Act but was not registered. However, in such cases, protection is limited and expires once the design has been applied to more than 50 articles by an industrial process. The judgment of a division bench of the Delhi High Court in *Microfibres Inc v Girdhar & Co* (2009) provided much-needed clarity with respect to the conflict between 'original artistic work' as defined under the Copyright Act and 'design' as defined in the Designs Act. It was held that copyright would exist in the original work of art and the author or copyright holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work. The court held that the legislative intent was to grant greater protection to original, purely artistic works (eg, paintings and sculptures) and lesser protection to design activity, which is commercial in nature. The protection accorded to a work that is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure art.

The unregistered design has no statutory protection and is susceptible to copying. Thus, it is advisable to obtain design protection to ensure adequate and effective protection.

Law stated - 30 August 2022

UNREGISTERED DESIGNS

Protection

What protection and rights are there for unregistered designs?

An unregistered design is not enforceable under the law, so a design must therefore be registered in order to enjoy protection. However, it may be possible to protect a design under other legislation. An unregistered design may be protected under the common law tort of passing off if it has become distinctive due to long and continuous use. In order to claim such a remedy, the design owner must establish that the design has become distinctive in respect of such goods due to long and continuous use.

Designs, if not registered under the Designs Act, may also be protected under the Copyright Act 1957. However, in such cases, protection is limited and expires once the design has been applied to an article more than 50 times by an industrial process.

Law stated - 30 August 2022

Use requirements

How much use is generally required to establish unregistered design rights?

There is no specific use period to establish unregistered design rights, the use should be substantial to make the design distinctive and such design must attain sufficient goodwill and reputation. If an unregistered design has

become distinctive due to long and continuous use, and if it has attained sufficient goodwill and reputation, it may be protected under the common law tort of passing off. An action for passing off is founded on the use of the unregistered design element in the trade for sale of goods and for offering services, generation of reputation and goodwill, the association of the unregistered design element to the plaintiff's goods and the misrepresentation sought to be created by the defendant by the use of the plaintiff's unregistered design element.

Law stated - 30 August 2022

Exclusions

What exclusions apply to unregistered design rights?

In unregistered designs, copyright protection is mutually exclusive and would exist as long as the article to which the design is applied is not reproduced more than 50 times by an industrial process.

Law stated - 30 August 2022

REGISTERED DESIGNS

Ownership

Who can apply for and own a design?

Any person claiming to be the owner of any new or original design may apply for design registration. Apart from a natural person, any company or association or body of individuals, whether incorporated or not, society or partnership firm can also own a design in India.

Law stated - 30 August 2022

Scope

What may and may not be protected?

According to Indian design law, a 'design' is defined as:

'the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether 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.'

A design does not include any mode or principle of construction or anything which is in substance merely a mechanical device. Thus, any trademark or property mark as defined under section 479 of the Indian Penal Code, 1860 or any artistic work as defined in section 2(c) of the Copyright Act, 1957 does not fall under the scope of design.

To protect a design, it must be new and original. 'New' in this context means that the subject design must not have been previously published anywhere in India or any other country in a tangible form or by use or in any other way. 'Original' implies that the design should originate from the author of the design, but as a matter of fact, those old designs which are new in terms of application are also considered original.

Indian design law protects any new and original design that is capable of being applied to an article. The feature

becomes eligible for registration, provided that it:

- is new or original;
- has not been disclosed by prior publication or use or in any other way;
- is sufficiently distinguishable from known designs or their combination; and
- contains no scandalous or obscene matter and is not contrary to public order or morality.

To protect part of an article, the applicant must ensure that each part of such article meets the requisite condition of being 'capable of being made and sold separately'. If part of the article is capable of being made and sold separately and can be judged solely by eye, design protection can be obtained for such part.

Under Indian design law, a design cannot be registered that:

- is not new or original;
- has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration;
- is not significantly distinguishable from known designs or combination of known designs;
- comprises or contains scandalous or obscene matter;
- includes any mode or principle of construction or operation or anything which is in substance a mere mechanical device; and
- is a trademark, property mark or an artistic work.

Law stated - 30 August 2022

Costs

What are the costs involved in registration?

It depends on several factors, such as whether there are objections or need for hearing in prosecution of application. However, the average cost of obtaining a design registration in India can be between US\$500 and US\$800.

Law stated - 30 August 2022

Grace period

Is there a grace period for filings?

Under the Indian design law, a six-month grace period is available but is limited to the disclosure made in a notified exhibition or trade show and where prior notice of such public disclosure is given to the Controller of Designs in India. Prior publication without notification to the Controller of Designs would hit the novelty of the proposed Indian design application and the grace period will not be available.

Law stated - 30 August 2022

PROCEDURES

Application

What is the application process?

The foremost step in the process of design registration is the filing of Form 1, which includes:

- the applicant's full name, address and nationality;
- the name of the article;
- the class number; and
- an address for service in India.

The application may be signed by the applicant or its authorised agent.

Along with Form 1, the applicant must submit:

- two copies of the design;
- a brief statement of novelty endorsed on each representation sheet;
- the priority documents, in case of a convention application; and
- a power of attorney, if the application is filed by an agent or attorney.

Indian law does not permit the filing of multiple embodiments of the same article in a single application. Therefore, if an applicant wishes to register a particular design for the articles in different classes, they must file separate applications for each class. Further, in case an applicant desires to register a design for different embodiments, the law stipulates that a separate application must be filed for each embodiment.

The law does not provide any specifications regarding the number of drawings to be filed alongside an application. As per the rules, a design should be represented exactly in drawings, photographs, tracings or other representations of the design. Such representation should clearly depict the details of the elements of the design that are sought to be protected.

In case of a claim for surface ornamentation, a photograph or computer graphic must be submitted. Further, to claim the shape and configuration of an article, it is advisable to file all basic views of the article (ie, top and bottom, front and back, left and right side and perspective views). Dotted lines are generally not acceptable.

Law stated - 30 August 2022

Examination and appeals

How are the examination and appeals procedures conducted?

The Design Office conducts both procedural and substantive examinations. A novelty search is conducted in the database of earlier designs applied for, registered and published in India. The representations of the design are checked to ascertain whether they clearly exhibit the claimed features of the design. The examiners also examine the class of the article to which the design is applied and whether it is capable of being sold separately. If the design, as applied for, does not comply with any legal requirement, an office action is issued. Under current practice, an office action is issued around one to two months after the date of filing and the applicant must file its response to the office action within six months of the date of filing. This period can be extended by three months, provided that a prior application seeking such an extension is filed with the Controller of Designs. In exceptional cases, where it is not possible to show the design by way of representation, the Design Office may request the submission of a sample of the

article. The Design Office's procedural objections to design applications usually comprise requests for a power of attorney, clear drawings and certified copies of the priority documents. If the highlighted defects are not rectified, the applicant will be heard in person. After the hearing, the controller decides whether the application should be accepted. The controller's decision is communicated in writing to the applicant or its agent, stating the reasons for the decision. The controller's decision to refuse a design registration may be appealed to the High Court within three months of the controller's decision. Once examined and accepted the design is registered in the Register of Designs and a certificate of registration is generally issued within three months of acceptance. Thereafter, the registration is published in the Official Journal . The term of protection for a registered design is 10 years from the date of the application and can be extended for a further five years on payment of an extension fee.

Any person aggrieved from the order passed by the Controller of Designs, Design Office, India has a right to appeal before the Calcutta High Court within three months from the date of order of refusal.

Law stated - 30 August 2022

Opposition

What are the opposition rules?

Indian design law has no provision to file opposition. However, the design can be cancelled at any time after registration, by filing a petition for cancellation along with the prescribed fee to the Controller of Designs on the following grounds:

- the design has been previously registered in India;
- the design has been published in India or another country before the date of registration;
- the design is not new or original;
- the design is not registrable; and
- the design is not a 'design' as defined under section 2(d).

Law stated - 30 August 2022

Registration time frame

What are the registration time frames?

The term of protection of a design is 15 years, subject to renewal of 10 years from the date of filing or the priority date before the expiry of the initial term.

Law stated - 30 August 2022

Removal from register

In what instances does removal from the register occur?

A design registration can be challenged by any interested person presenting a petition for the cancellation of design registration on the following grounds:

- the design has been previously registered in India;
- the design has been published in India or another country before the date of registration;
- the design is not new or original;

- the design is unregistrable under the Act; and
- the design is not a 'design' as defined under section 2(d).

Law stated - 30 August 2022

ENFORCEMENT

Grounds for a claim

What are the key causes of action?

A person infringes a registered design if, during the term of registration of the design, and without a licence or the authority of the registered design owner:

- the person, applies or causes to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof;
- the person imports any article belonging to the class in which the design has been registered, and has applied to it the design or any fraudulent or obvious imitation of the design; and
- the person publishes, exposes or causes to be published or exposed for sale the design or any fraudulent or obvious imitation of the design has been applied to any article in any class of articles in which the design is registered, for the purpose of sale or to import for the purpose of sale.

The registered owner whose design is infringed can file a civil suit against such infringer before the District Court.

Law stated - 30 August 2022

Procedures

What enforcement procedures are available?

Design rights can only be enforced through civil procedures in India.

Law stated - 30 August 2022

Remedies

What remedies are available?

The Designs Act does not impose any criminal remedy. A registered design in India can be enforced by way of a civil action. The registered owner of a design enjoys the exclusive right to apply a design to the article in the class in which the design has been registered. A registered owner can file an infringement suit. A civil action enforcing a registered design can be filed before the District Court where the defendant resides or conducts business or where infringement has taken place. In addition to using the defence of non-infringement, the infringer can use the defence of invalidity of the design on the grounds that the design lacks novelty, is indistinguishable from a known design or contains scandalous matter. If the defence of invalidity is used in a civil action, the District Court no longer has jurisdiction and the suit is transferred to the High Court with jurisdiction over that District Court. Under the act, the registered owner of a design should mark the article with the word 'Regd' or 'Registered' and the registration number, except in cases of textile designs and articles made of charcoal dust. If the mark is missing, the owner is not entitled to claim damages. Indian courts regularly deal with design infringement matters and a robust body of case law lays down the established legal principles.

Passing off

The common law remedy of passing off can also be availed. In a case before the Delhi High Court, the court held that the remedy of the passing off would lie in case the competitor copies both the shape of the article and the trade dress, get up or any other feature. In this case, the owner can act to the extent that there is confusion regarding the source as indicated on the packaging.

Law stated - 30 August 2022

Enforcement time frame

What are the time frames for the resolution of enforcement actions for registered and unregistered rights?

The time frame of enforcement action in both registered and unregistered rights is largely the same, largely because the stages of suit proceedings before the court are the same. Further, in a number of cases, the dispute is settled by signing and submitting a 'compromise application' before the trial begins (ie, within one to years of instituting a suit). Further examples include:

- the admission of suit and hearing on ex parte injunction application – the suit is listed for hearing within two to three days from the date of filing;
- the appearance of defendants – within 30 days from serving the summons on the defendants; and
- filing a written statement – within 30 days from serving the summons on the defendants (extendable up to a maximum of 120 days, subject to the payment of costs and agreeing to a delay if the application is moved). The defendant is also required to file an affidavit admitting and denying the plaintiff's documents.

Should no written statement be filed, the plaintiff can file an application requesting summary judgment. If the application is allowed, the court will hear the suit ex parte and pass a summary judgment within one to two years of instituting a suit. Should this be disallowed, the plaintiff will be asked to move their evidence before the court and record oral evidence before proceeding to complete adjudication of the case.

Should the suit be contested by the defendant, the timeline is as follows:

- filing a replication by the plaintiff – two to four weeks from receipt of the written statement (the plaintiff is also required to file an affidavit admitting and denying the defendant's documents); and
- framing issues – 12 to 18 months from filing suit.

The completion of the trial stage of the suit (submitting a list of witnesses, filing evidence, exhibiting of documents before the board, recording examination-in-chief and cross-examination of witnesses from both sides), the final argument before the court and passing of final judgment may take anywhere between three and five years.

Law stated - 30 August 2022

Recent cases

What key cases from the past 18 months should rights holders be aware of?

Forum: High Court of Madhya Pradesh, Indore Bench; Case No.: I.A. No.01/2020 in Civil Suit No. 1/2021; Order dated: 1 September 2021

Issue: Whether the plaintiff was entitled to a temporary injunction

The plaintiff alleged that the defendant had fraudulently and dishonestly adopted the registered designs of the plaintiff's products and prayed for a decree of declaration along with a permanent injunction restraining the defendant from using its registered designs. It also prayed for an award of damages. The defendant argued that it does not manufacture the containers and lids in question and procures the same from a third party. The defendant further submitted that it has also filed a counterclaim for cancellation of the plaintiff's designs. The defendant had placed multiple documents on record giving details of similar designs which have already been registered and/or applied for registration all over the world, prior to the application of the plaintiff's registered designs. The defendant also highlighted that similar designs were published on the plaintiff's own website prior to the filing of the application for the plaintiff's registered designs.

The court observed that the registration of designs does not give any presumption that they are not previously registered in India or that it is an original design. It is the register of design that shall be prima facie evidence of any matter. Considering the material placed by the defendant on record which challenged the validity of the plaintiff's registered designs, the court noted that the matter was arguable, and the claim of the injunction could be determined only after the parties lead their evidence. Furthermore, the court observed that since the plaintiff has also sought damages in terms of the profit which the defendant has earned by way of using the plaintiff's designs, it means that it is not a case of irreparable injury being caused to the plaintiff as the same can be compensated in terms of money if a decree is passed in favour of the plaintiff. The court opined that it cannot also be said that the balance of convenience is tilted in favour of the plaintiffs, especially when the defendant's primary objection is that it is not the manufacturer of the impugned containers and lids, as it procures the same from a third party. Accordingly, the application for a temporary injunction was rejected.

M/s Kamdhenu Ltd v M/s Aashiana Rolling Mills Ltd; Forum: High Court of Delhi; Case No.: I.A. 647/2018 in CS (COMM) 90/2018; Judgment dated: 12 May 2021

Issue: Whether published standards constitute prior publication of a design

The plaintiff alleged that the defendant was fraudulently imitating its registered design in respect of steel bars. In its defence, the defendant submitted that the design adopted by it was based on universally accepted and adopted standards. The defendant argued that the plaintiff's registered design was not new or novel but was copied from prior published standards and was a design well known since the year 1984. The defendant claimed that the registration should be cancelled, and this suit be dismissed which the plaintiff countered by saying that the specific angles adopted by it in the ribbed pattern were a unique feature and that it was these angles that were copied by the defendant. To this, the court said that the design should be visible to the eye and such minute angle specifications could not have been distinguished from the ones published earlier by a naked eye. The court also observed that these angles were not protected by design registration. With reference to the fact that the plaintiff's own website mentioned that it conforms with the aforementioned standards, the court specifically held that: 'Such an assertion itself indicates the prevalence of the design elsewhere in the world, which is sufficient to attract the prohibition contained in section 4(b) of the Act.' In view of this, the court directed the cancellation of the plaintiff's registered design and held that this was a fit case for a summary judgment and no further trial was required. Thus, the suit was dismissed.

New Holland (Fiat) India Pvt Ltd Presently CNH Industrial India Pvt. Ltd. v The Controller of Patents And Designs And Ors; Forum: High Court of Calcutta; Case No.: AID/1/2021; Order Dated: 16 March 2021

Issue: Whether the controller can be directed to not remove the cancelled design from the register during the pendency of an appeal against the order cancelling the design registration

The appellant filed an appeal against an order dated 27 November 2020 passed by the Deputy Controller of Patents and Designs cancelling an existing registration of the appellant. The appellant submitted that though the impugned order concludes that the registered design of the appellant is similar to a pre-existing design, however, does not specify the reasons why such conclusions were arrived at. The appellant contended that the controller be directed not to remove the registered design from the records till the present appeal is pending. The court noted that, by the impugned order, the registration of the design stands cancelled; however, what the appellant is seeking during the pendency of the appeal is that the controller should not remove the registration immediately in order to allow the appellant to obtain renewal of the registration in the event the appellant succeeds. The court accepted the argument of the appellant, observing it to be reasonable. The court held that the controller will not remove the registered design if not already removed during the pendency of this appeal. The court also clarified that the present order should not be construed to mean that the impugned order of cancellation of the registered design stands set aside.

Law stated - 30 August 2022

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Assignment and licensing

What are the rules surrounding assignment and licensing of design rights?

According to Indian design law, the right in a registered design can be transferred by way of assignment. An application in Form 10 and Form 11, with prescribed fees in respect of one design and appropriate fees for each additional design, for registration of the transfer documents, is required to be made by the beneficiary to the controller within six months from the date of execution of the instruments or within a further period not exceeding six months in aggregate. An original or notarised copy of the assignment deed is required to be enclosed with the application.

Further, an individual can file for registration of licensing of a design in the Register of Design. Only a registered licence in respect of a registered design is admissible as evidence before the courts or in any other proceeding, and therefore such instrument must be registered with the Design Office.

Law stated - 30 August 2022

Licences of right

Are licences of right available?

Yes, an individual can file for registration of licensing of a design in the Register of Design. Only a registered licence in respect of a registered design is admissible as evidence before the courts or in any other proceeding, and therefore such instrument must be registered with the Design Office.

Law stated - 30 August 2022

UPDATE AND TRENDS

Key developments and future prospects

What were the key judicial, legislative, regulatory and policy developments of the past year in relation to the protection and enforcement of designs? What are the prospects for future developments?

The Designs (Amendment) Rules 2021 (Amendment Rules) further amended the Design Rules, 2001. With the amendment rules, India now follows the 13th Edition of the Locarno Classification as per the current edition of the International classification for industrial designs as published by the World Intellectual Property Organization.

With the amendment rules, start-ups have been expressly recognised as a new category of applicants that can benefit from discounted fees for filing, prosecuting and maintaining a design application/registration in India, which was earlier applicable only to natural persons or small entities. Indian entities must be recognised as a start-up by the competent authority under the Union Government's Start-up India initiative. The Amendment Rules further permit foreign entities to claim the status of start-ups, provided it fulfils 'the criteria for turnover and period of incorporation or registration as per Startup India Initiative and submitting a declaration to that effect'.

The Design Office is reluctant to grant protection to graphical user interface (GUI)/Icons under design law. The Design Office at present does not consider GUI as 'design' defined under section 2(d) as the same does not appear on the surface of the display screen but is visible/appears when the complete processing/computer system is in ON mode or operating mode only and as such in OFF mode 'no alleged design' would appear on the screen. In addition to this, the Design Office has also reasoned that a GUI does not meet the requirements of 'article' as provided under section 2(a) of the Designs Act (ie, it is neither manufactured by any industrial process including chemical, mechanical or manual nor can it be sold separately in the market). In view of such rationale, the applicability of design laws on GUIs has become ambiguous.


Indian Design laws recognise GUI/icons as the same fall under the domain of Locarno Class 14-04 which provides for Screen Displays and Icons, which are included in the Third Schedule of the Design Rules, 2001. The industrial design protection of graphical user interface (GUI) of electronic products has become a new trend in recent years.

This diversity in design protection for GUIs worldwide, and the lack of compatibility of some aspects of existing design registration systems with the specificities of GUIs, has resulted in a challenging environment for businesses wishing to obtain design protection for GUIs in an efficient and effective way. Therefore, the practice of Design Office needs reconsideration on this aspect and, if required, the definition of article and design may be amended to include GUI as a protectable feature under Designs Law and we are hopeful that this aspect will be taken care of by Indian Design Office very soon.

The jurisprudence on enforcement of registered designs has been well established through several case laws in India which will continue to grow in future.

Law stated - 30 August 2022

Jurisdictions

	Argentina	Palacio & Asociados
	Australia	Cooper IP
	Brazil	Kasznar Leonardos
	European Union	Berggren Oy
	Germany	KUHNEN & WACKER Intellectual Property Law Firm PartG mbB
	Greece	Dr Helen G Papaconstantinou and Partners Law Firm
	India	LexOrbis
	Italy	GLP Intellectual Property Office
	Poland	JWP Patent & Trademark Attorneys
	Romania	Răzvan Dincă & Asociații
	Ukraine	PETOŠEVIĆ
	United Kingdom	CMS Cameron McKenna Nabarro Olswang LLP
	USA	Foley & Lardner LLP