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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Reserved on:29th March 2023

Pronounced on:13th April 2023

+ CS(COMM) 697/2022

TTK PRESTIGE LTD Plaintiff

Through: Mr. Hemant Singh, Ms. Mamta Rani Jha, Mr. Manish Kumar Mishra, Ms. Akansha Singh, Mr. Srinivas Venkat Rangan, Ms. Tarushi Agarwal and Ms. Pragya Jain, Advs.

Versus

KCM APPLIANCES PRIVATE LIMITED Defendant

Through: Mr. Jayant Bhushan, Sr. Advocate with Mr. Anill Dutt, Ms. Vindhya S. Mani, Mr. Gursimran Singh Narula, Ms. Vaishali Joshi, Ms. Justina Mathew and Mr. Rishabh Paliwal, Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

J U D G M E N T

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13.04.2023

AN INDEXED VIEW OF THE JUDGEMENT

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I.A. 16467/2022(Order XXXIX Rules 1 and 2 of the CPC)

The lis

The plaint

1. The plaintiff alleges piracy, within the meaning of Section 22(1)¹ of the Designs Act, 2000, of the Design No. 324727-001, registered in the petitioner’s favour for a “Pressure Cooker with Container and Lid (Set) for Household”. The suit design was registered on 1st July 2020, w.e.f. 13th December 2019.

¹ 22. **Piracy of registered design.** –

(1) During the existence of copyright in any design it shall not be lawful for any person –
 (a) for the purpose of sale to apply or cause 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, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; ...

2. The certificate of registration of the suit design is undoubtedly peculiar , as would become apparent from what follows.

3. As always, the Certificate of Registration is issued for the front view, back view, right view, left view, top view, bottom view and perspective view of the suit design. Thus far, it is like any other certificate of registration of a design under the Designs Act. Below each view, the following recital figures:

“Novelty resides in the shape and configuration of the PRESSURE COOKER WITH CONTAINER AND LID (SET) FOR HOUSEHOLD as illustrated.

No claim is made by virtue of the registration in respect of any mechanical or other action of the mechanisms whatsoever.

No claim is made by virtue of the registration in respect of any mood or principle of construction of the article.

No claim is made by virtue of the registration in respect of colour or colour combination.

No claim is made by virtue of the registration in respect of words, letters, number or trademark.”

4. Over the afore extracted recitals, in each view, is to be found, however, the image, not of one, but of six pressure cookers, of which one has a lid and a pressure gasket and five are open. These pressure cookers are of different dimensions and capacities. The aforesaid views of the suit design, as provided in the certificate of registration, may be reproduced thus:

Front View



Back View



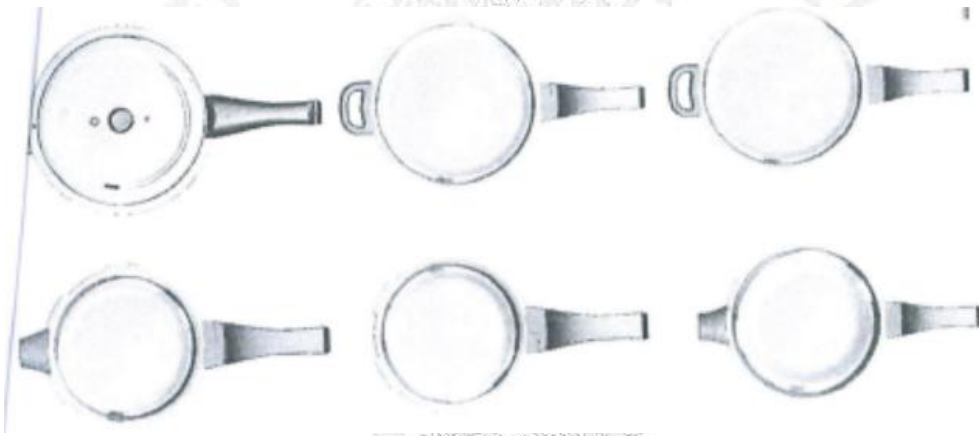
Right View



Left View



Top View



Bottom View



Perspective View



5. There was a certain amount of consternation, during arguments, as to the exact meaning and interpretation of such a certificate of registration of a design. Mr. Jayant Bhushan, learned Senior Counsel for the defendants, in fact advanced, as his first submission, the contention that a certificate of registration such as the one held by the plaintiff in respect of the suit design was *ipso facto* invalid, as it did not clarify the exact design which it was certifying and was, in fact, a certificate registering — design, which the Designs Act does not permit. I shall advert to this aspect of the matter later, during the course of further discussion.

6. The claim of the plaintiff is that novelty, in the suit design, primarily vests in the design of the lid of the pressure cooker. It is claimed that the lid is not flat, as in the case of normal pressure cookers, but has a circular depression with a raised “wall” around it. The circular depression extends almost till the edge of the lid, and is bordered by the wall. The purpose of this depression is to collect froth which, otherwise, would spill over the sides of the lid and

accumulate on the surface on which the pressure cooker is resting, which would then have to be cleaned. This exercise, it is claimed, is obviated by the unique design of the lid, which allows the froth to accumulate in the depressed “valley” on the surface of the lid, with the encircling wall preventing it from spilling over the sides of the lid. The heat of the pressure cooker ensures that the froth continually evaporates. This anti-spillage quality, conferred by the unique design of the lid, lends the lid both aesthetic and utilitarian advantages over normal pressure cooker lids, which are flat. This feature is sought to be explained, in para 11 of the plaint, thus:

“11. It is submitted that the list of the Plaintiffs Svachh Deluxe Alpha pressure cooker is a circumferential depression from the centre outwardly with the peripheral upwards projection running around the circumference of the lid. The peripheral protrusion/protection created by a contour on the lid contains the froth leaking from within the pressure cooker through the pressure weight valve. Due to the novel and unique design of the lid, the froth is prevented from flowing/running down the lid by containing all such froth within the contour on account of the peripheral projections along the circumference of the lid. This enables the collected froth to evaporate on the lid itself due to the high temperature of the pressure cooker. The lid of the Plaintiffs *Svachh* Deluxe Alpha pressure cooker is shaped entirely different from the list of ordinary pressure cookers in the market granting instant recognition owing to the novelty and aesthetic eye appeal of the design.”

7. As they aid in maintaining cleanliness, these pressure cookers, with their uniquely shaped lid, are manufactured and sold, by the plaintiff, as the “*Svachh* range” of pressure cookers. The suit design relates to the *Svachh* Deluxe Alpha pressure cooker. It is important to note, here, that, though the certificate of registration of the suit design contains images of six pressure cookers, one with a lid and five open, para 9 of the plaint, in the present suit, reads thus:

“9. One of the most popular design created by the Plaintiff is a unique and novel pressure cooker series sold under the trademark *Svachh*. In June, 2019, the Plaintiff launched a range of *Svachh* pressure cookers which had a mechanism to control spillage to ensure that the froth stays and evaporates on the lid while retaining

the flavour and preserving nutrition thereby ensuring a safer and cleaner cooking experience. One such pressure cooker is *Svachh Deluxe Alpha* pressure cooker which comprises novel and original shape and configuration and is subject matter of suit design registration no. 324727-001 dated 11.12.2019 as depicted herein below:



Front View



Perspective View



Top View





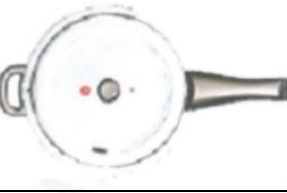

8. Thus the plaintiff, in the plaint, asserts the first of the six designs represented in the certificate of registration of the suit design, which shows a pressure cooker with a lid. This judgment shall, therefore, treat the plaintiff's claim of piracy, against the defendant, in relation to the said pressure cooker and lid.

9. The plaint asserts that, owing to its unique aesthetic and utilitarian appeal, the pressure cooker bearing the suit design has become extremely popular and has garnered, over a period of time,

tremendous goodwill and reputation amongst consumers. The plaint also provides details of the returns from sales of the *Svachh* Deluxe Alpha range of pressure cookers which, during the financial year 2021-2022, was ₹ 12.442 crores and, during the period April to September 2022, was ₹ 7.279 crores. The plaintiff also claims to have spent ₹ 4.476 crores on promotion of its *Svachh* range of pressure cookers as on 31st March 2021 and ₹ 4.495 crores as on 31st March 2022, as reflected in the books of accounts of the plaintiff. These statistics, I may note, are not disputed by the defendant during arguments.

10. As the lid of the suit design has, according to the plaintiff, both aesthetic and utilitarian advantages, it is entitled to both design as well as patent registration. The plaintiff has accordingly applied, *vide* Application 201941025068 dated 24th June 2019 for grant of patent in respect of the pressure cooker and the outer lid, which is presently pending examination before the Controller of Patents. The fact that the plaintiff has applied for a patent does not, however, assert the plaint, affect the registration of the suit design in any manner, as the plaintiff's product is not only utilitarian, but is also possessed of aesthetic appeal.

11. The plaintiff alleges that the design of the Impex Delight Virgin Aluminum Dripless pressure cooker infringes the suit design and results, therefore, in "piracy" within the meaning of Section 22(1) of the Designs Act. This has sought to be demonstrated by the following tabular comparison of the suit design and the defendant's product, in para 16 of the plaint:

Plaintiff's registered design	Defendant's Product
	
FRONT VIEW	
	
BACK VIEW	
	
TOP VIEW	

12. Para 17 of the plaint also provides the following product-to-product comparison:



13. At the request of the Court, learned Counsel have also provided physical samples of the plaintiff's *Svachh* Deluxe Alpha pressure cooker, bearing the suit design, and the defendants Dripless pressure cooker bearing the allegedly infringing design. Perspective views of the 5 L and 8 L *Svachh* Deluxe Alpha pressure cookers of the plaintiff and of the 5 L Dripless pressure cooker of the defendant look like this:

5 L pressure cooker of plaintiff	8 L pressure cooker of plaintiff	5 L pressure cooker of defendant
		

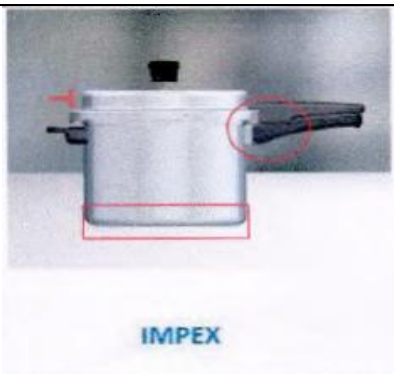

14. The plaintiff alleges that the defendant copied or imitated novel features of the suit design, including the design of the lid, of which the plaintiff is the pioneer and inventor. It is further averred that “evidently, the design of the lid with the peripheral projections/prove crucial is not the only method/manner in which spillage control can be achieved”, so that there was no justification for the defendant copying the plaintiff’s registered suit design. That the defendant is, indeed, imitating the suit design, it is submitted, further manifested by the fact that the defendant describes its product as “smart spillage control”. This, in fact, according to the plaint, amounts to an admission, on the defendant’s part, of novelty and uniqueness of the suit design, particularly the lid, which ensures spillage control. Once the aspect of novelty thus stands admitted, the plaint avers that the plaintiff, being the originator and inventor of the said design, is entitled to exclusivity and protection thereof against infringement or piracy.

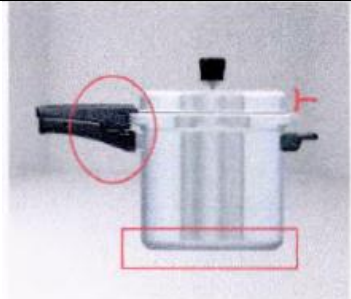


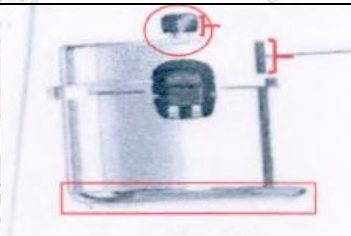

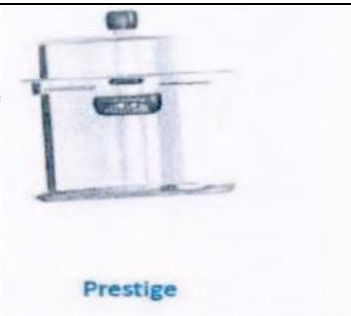
15. Predicated on these assertions said allegations, the plaintiff has, by the present suit instituted before this Court, sought a decree of permanent injunction against the defendant manufacturing, selling or otherwise dealing in pressure cookers, the designs of which are fraudulent or obvious imitations of the suit design. Delivery up, rendition of accounts, costs and damages have also been sought.

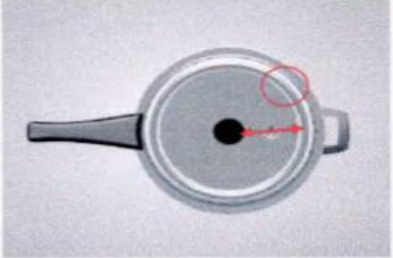





The written statement of the defendant



16. In its written statement, filed by way of response to the plaint, the defendant also claims to be a pioneer in home appliances, including pressure cookers. The defendant claims to have launched its Dripless range of pressure cookers in 2022.

17. The defendant denies the allegation of infringement/piracy. This is sought to be demonstrated by the following tabular comparison, in para 19 of the written statement:

S.no	Impugned Pressure Cooker sold by the Defendant	Registration Design of the Plaintiff
FRONT VIEW		
1.		
REAR VIEW		

<p>2.</p>	 <p>IMPEX</p>	 <p>Prestige</p>
<ul style="list-style-type: none"> - There is a significant difference in the height of the lid. The height of the Defendant's cooker lid is lesser in comparison to the Plaintiff's design. - The Defendant's pressure cooker handle has a straight moulding of bakelite. Whereas the Plaintiff's pressure cooker design's handle has a visibly distinct curvature at the base making it visually different from that of the Defendant's. - The base of the Defendant's Pressure cooker is smooth and flat. Whereas the base of the Plaintiff's pressure cooker design curves into a slight elevation provided by the addition of an additional base plate at the bottom surface of the cooker. 		
<p>RIGHT SIDE VIEW</p>		
<p>3.</p>	 <p>IMPEX</p>	 <p>Prestige</p>
<p>LEFT SIDE VIEW</p>		
<p>4.</p>	 <p>IMPEX</p>	 <p>Prestige</p>
<ul style="list-style-type: none"> - There is a significant difference in the height of the lid. The height of the Defendant's cooker lid is lesser in comparison to the Plaintiff's design. - The height of the weight set of the safety valve is different. The weight set of the safety valve of the Defendant's pressure cooker is higher in comparison to the weight set of the safety valve of the Plaintiff's design. - The structure and shape of the weight set of the safety valve is different. The weight set of the safety valve of the Plaintiff's design has smooth round edges with a more circular visual appearance. Whereas the weight set of the safety valve of the Defendant's pressure cooker does not have smooth and round edges. It is more geometric in its appearance with a wider appearance on top and slightly tapering below. 		

TOP VIEW		
5.	 <p style="text-align: center;">IMPEX</p>	 <p style="text-align: center;">Prestige</p>
<ul style="list-style-type: none"> - The surface area of the pressure cooker lid within the inward depression is more in the Defendant's product in comparison to the Plaintiff's design. As a result, the radial distance of the safety valve from the edge of the inward depression is more in the Defendant's product in comparison to the Plaintiff's design. - The width of the outward wall/elevation on the circumference of the pressure cooker lid is thicker in the Plaintiff's design in comparison to the Defendant's product. 		
BOTTOM VIEW		
6.	 <p style="text-align: center;">IMPEX</p>	 <p style="text-align: center;">Prestige</p>
<ul style="list-style-type: none"> - The bottom portion of the Defendant's cooker and the Plaintiff's design are completely different from each other. Due to the presence of an additional base plate, the Plaintiff's design has another visible curvature seen as a second circumference in the bottom view. The same is not present in the Defendant's product. 		
PERSPECTIVE VIEW		
7.	 <p style="text-align: center;">IMPEX</p>	 <p style="text-align: center;">Prestige</p>
ISOMETRIC VIEW		

8.	 <p data-bbox="603 412 687 439">IMPEX</p>	 <p data-bbox="986 405 1070 432">Prestige</p>
<ul style="list-style-type: none"> - There is a visibly clear difference in the height of the lids of the Defendant's cooker and the Plaintiff's design. - The upward wall, that makes a barrier, creating an inward depression in the center has a flat top in the Plaintiff's design. Whereas the same has a circular curvature in the Defendant's product. - The structure and shape of the weight set of the safety valve is different. The weight set of the safety valve of the Plaintiffs design has smooth round edges with a more circular visual appearance. Whereas the weight set of the safety valve of the Defendant's pressure cooker does not have smooth and round edges. It is more geometric in its appearance. - The Defendant's pressure cooker handle has a straight moulding of bakelite. Whereas the Plaintiff's design handle has a visibly distinct curvature at the base making it visually different from that of the Defendant's 		

It is submitted, the written statement, that the shape, design, configuration, trade dress and packaging of the *Svachh Deluxe Alpha* pressure cooker of the plaintiff and of the *Impex Dripless* pressure cooker of the defendant are totally different and distinct, bearing no identity or similarity. There is, therefore, in the defendant's submission, no possibility of any confusion or deception. It cannot, therefore, be sought to be contended that the design of the defendant's product is an obvious imitation of the suit design.

18. I may note, here, that, while issuing summons in the present suit, this Court, on 27th October 2022, directed the plaintiff to place, on record, other design registrations on which it sought to place reliance. The plaintiff has done so, and the defendant has, in its written statement, sought to contend that the impugned design does not infringe the said designs. To my mind, however, in the absence of

any pleadings relying on the said designs, or any amendment of the plaint alleging infringement, by the impugned design, of the said additional designs, this Court cannot countenance a challenge to the impugned design based on the said additional designs, which formed part of the plaint. I do not propose, therefore, to return any finding thereon.

19. The written statement avers that, as the certificate of registration of the suit design certifies novelty to be residing “in the shape and configuration of the pressure cooker with container and lid (set)”, the overall appearance of the plaintiffs and defendants pressure cookers were required to be compared. Thus compared, there is no substantial similarity between the two.

20. Invoking Section 22(3)² with Section 19(1)(b)³ of the Designs Act, the defendant alleges, in the written statement, that the suit design is liable to be cancelled as it was published, prior in point of time to the date of application, by the plaintiff, for its registration. As such, it is contended that the suit design was not entitled to registration, in view of Section 4(b)⁴ – which is essentially a sister provision to Section 19(1)(b) – of the Designs Act. Prior publication of the suit design, it is stated, had taken place *via* a video clip

² (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence.

³ **19. Cancellation of registration.** –

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:—

(b) that it has been published in India or in any other country prior to the date of registration;







⁴ **4. Prohibition of registration of certain designs.** – A design which –

(b) has been disclosed to the public any where 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;

shall not be registered.

uploaded and posted by the plaintiff on 11th November 2019 in its YouTube channel “Prestige Social”, titled “Prestige *Svachh* Pressure Cooker/No Mess Cooker/Prestige”, 1 minute and 20 seconds long. The pressure cooker advertised in the said clip, it is contended, embodies the suit design. A screenshot of a still from the said video clip has been filed with the written statement, and para-28 of the written statement seeks to provide the following tabular comparison of the suit design and the pressure cooker advertised in the said YouTube video, to buttress the contention that the suit design is liable to be cancelled on the ground of prior publication:

Plaintiff's Design Registration	YouTube Video Image
OVERALL LOOK	
	
LID DESIGN	
	

HANDLE DESIGN	
 <p>Prestige</p>	
BASE DESIGN	
	
SAFETY VALVE DESIGN	
 <p>Prestige</p>	

The date of uploading of the aforesaid video on the plaintiff's YouTube channel (11th November 2019) being prior to the date of registration of the suit design (13th December 2019), the written statement alleges that the suit design was liable to be cancelled on the ground of prior publication. It is further averred that the intent of the

plaintiff while uploading the video is irrelevant to the issue of prior publication.

21. Without specifically citing the provision, the written statement also invokes clause (c)⁵ of Section 19(1) of the Designs Act, by alleging, in para-30, that the suit design is neither new nor original. However, this allegation is also predicated on the YouTube video uploaded by the plaintiff on 11th November 2019. It is contended that the suit design is, at best, an ordinary trade variant of existing prior designs and cannot, therefore, be regarded as novel or original. In assessing novelty and originality, the test is of the instructed eye, which is aware of prior art. An instructed eye, which is aware of the “YouTube design”, would not regard the suit design as novel or original. To emphasise the lack of novelty and originality *vis-à-vis* existing prior designs, para-44 of the written statement provides the following tabular comparison:

Registered Design No 318976-001 dated 21 June 2019	Registered Design No 319361-001 dated 5 July 2019	Suit design dated 13 December 2019
		

On the aspect of novelty and originality *vis-à-vis* existing prior art, the written statement also relies on the acknowledgement, in the plaint

⁵ 19. **Cancellation of registration.** –

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:—

(c) that the design is not a new or original design;

itself, that, much prior to the application seeking registration of the suit design, the plaintiff had already launched its *Svachh* range of pressure cookers with the unique lid design, intended to control spillage while preserving flavour and nutrition. In view of this acknowledgement, the defendant contends that the plaintiff was bound to disclose its earlier models of pressure cookers which fulfilled the function of spillage control, failing which the plaintiff could not plead novelty and originality in the suit design.

22. The written statement also invokes clause (e)⁶ of Section 19(1), read with Section 2(d)⁷ of the Designs Act. It is contended that the suit design is purely functional and is, thus, a “mere mechanical device” and is not, therefore, entitled to registration. A customer who purchases the plaintiffs *Svachh* Deluxe Alpha pressure cooker, bearing the suit design, it is contended, would do so, not because of the aesthetic appeal of the pressure cooker, or even of the lid, but because of its functional utility in spillage control. In examining the contention that a functional design also has aesthetic appeal, it is submitted that the Court is required to examine the dominant features of the design; as to whether it is predominantly functional or aesthetic. The premise of the suit design, and its very *raison d’etre*, being its functional utility, the written statement alleges that it could not have been registered as a “design” under the Designs Act.

⁶ 19. **Cancellation of registration.** –

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:—

(e) that it is not a design as defined under clause (d) of Section 2.

⁷ (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 an 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 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957;

23. It is further submitted, in the written statement, that pressure cookers with depressions in the lid are commonplace, and well known in the public domain. Even on this ground, the defendant contends that the registration of the suit design is liable to be cancelled.

24. Grant of exclusivity to commonplace designs such as the suit design, contends the written statement, would create disorder in the market, and would also unduly impact the industry.





25. Thus, contends the defendant, the plaint instituted by the plaintiff, being the bereft of merit, deserves to be dismissed.

Replication by the plaintiff

26. The plaintiff, in its replication, submits that the defendant has sought to vivisect the suit design and compare individual features which the impugned design, which is an improper method of assessing infringement or piracy. Piracy, or infringement, it is submitted, does not require the defendants' design to be an exact replica of the suit design. The test has to be one of overall ocular appeal, on comparing the suit design with the design of the defendant's product. If the unique and novel features of the suit design are replicated in the defendant's design, it is submitted that piracy, *ipso facto*, has taken place. Thus viewed, the plaintiff would submit that the design of the defendant's Dripless pressure cooker is a slavish imitation of the suit design.

27. It is further contended that the reliance, by the defendant, on the YouTube design is completely misplaced. The design of the pressure cooker in the YouTube video, it is submitted, already stands registered

in plaintiff's favour, as Design No 319361-001 dated 5 July 2019. At a plain glance, it is submitted that the design of the lid of the pressure cooker advertised in the YouTube video is completely different from the suit design. A comparison is thus provided in para-4 of the replication:

Actual product depiction	Corresponding registration
	Design Registration no. 319361-001 
	Design registration no. 324727-001 (Suit design) 

“As is evident from the aforesaid tabular chart”, submits the plaintiff in its replication, “the lid configuration of the Suit design incorporates a step/upward projection on the circumference of the lid whereas the lid configuration of the design registration no. 319361-001 features no such step/upward projection and the lid is a flat plate type structure with a depression in the middle”. In fact, the replication submits that the pressure cooker advertised in the YouTube video was the first *Svachh* pressure cooker launched by the plaintiff. The law, it is submitted, permits registration of variations of designs, and no design would, in such a circumstance, be invalidated on the ground of prior publication. The only statutory consequence, in such a situation,

envisaged by Section 6(3)⁸ of the Designs Act, would be that the validity of all such registrations would be co-terminus with the earliest registration. Design No 318976-001, to which the YouTube video relates, it is pointed out, is to expire only on 21st June 2034.

28. The plaintiff stridently contests the defendant's contention that the suit design is purely functional. The plaintiff underscores the aesthetic appeal of the suit design, distinct from its utilitarian advantages. The handle and the lid of the suit design, it is submitted, conferred clear advantages in handling the pressure cooker as well as in maintaining cleanliness by ensuring that there is no spillover of froth from the lid. The utilitarian advantage of the lid and handle of the *Svachh* Deluxe Alpha pressure cooker has impelled the plaintiff to apply for patent registration as well; that, however, it is submitted, would not detract from the entitlement of the suit design to registration.

29. The plaintiff has further objected to the defendant seeking to plead prior publication, or want of novelty and originality of the suit design, by merely referring to photographs of pressure cookers. Evidence, it is submitted, would have to be led by the defendant to indicate that the cited models of pressure cookers are actually in the market.

⁸ **6. Registration to be in respect of particular article.—**

(3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated—

(a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in India or in any other country, by reason only that it has been applied to article in respect of which it was previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

30. *Qua* the plea of the defendant that the suit design, being purely functional, could not have been registered, the plaintiff further submits that a design would be disentitled to registration, as being purely functional, only if the functional aspect of the design could be achieved only by the said design, and in no other manner. In other words, applying this principle to the present case, the plaintiff contends that the defendant's plea of this entitlement of the suit design to registration is purely functional could sustain only if the defendant were to positively establish that the function of spillage control was achievable only by the suit design, and in no other manner. The plaintiff submits that spillage control could be achieved by other means as well and that, therefore, the plea of the defendant that the suit design was disentitled to registration as being purely functional is without substance. Designs which are both aesthetic and functional are entitled to protection under the Designs Act. Functionality does not *ipso facto* disentitle a design to registration.

31. The plaintiff also disputes the defendant's contention that the suit design is a mere trade variant of existing prior art. Want of novelty and originality *vis-à-vis* prior art, it is submitted, can be alleged only if the defendant were to establish, positively, that similar designs existed prior to the registration of the suit design. Assuming, without admitting, that the suit design was a trade variant of earlier designs registered by the plaintiff itself that, it is submitted, cannot invalidate the suit design, in view of Section 6(3) of the Designs Act. Infringement or piracy, even in the case of designs, it is contended, has to be examined from the point of view of a customer of average intelligence and imperfect recollection, and not by placing the suit design and the defendant's product side-by-side. Minor variations cannot, therefore, detract from the imitating nature of the design of the

defendant's product, *vis-à-vis* the suit design. Such minor variations, it is submitted, would not impress themselves on the mind of the customer of average intelligence and imperfect recollection, who does not have the two products before him side-by-side.

32. Inasmuch as the registration of the suit design is for the entire pressure cooker with lid, the allegation of piracy, too, it is submitted, has to be examined on that basis. Viewed thus, the differences between the design of the defendants Impex Dripless pressure cooker and the suit design are, it is submitted, minor and inconsequential. The defendant's Dripless pressure cooker, it is reasserted, incorporates a design which is an obvious imitation of the suit design and deserving, therefore, of being enjoined.

Rival submissions at the Bar

33. Mr. Hemant Singh, learned Counsel for the plaintiff, besides reiterating the assertions contained in the plaint and the replication, further submits thus:

(i) The novel feature of the suit design, *vis-à-vis* prior art, was the shape and configuration of the lid of the pressure cooker, the central depression of which constituted a unique spillage control feature. This was underscored by the emphasis, even in the certificate of registration, of the container, with the lid, constituting the novel feature of the design.

(ii) The unique utilitarian feature of the lid of the pressure cooker was also the reason why the plaintiff had applied for a patent registration in respect thereof. In this context, my

attention was invited to the recitals relating to the Object of the Invention, Description of the Invention, Summary of the Invention and the Claim itself, in the patent application, which read thus:

“OBJECT OF THE INVENTION

The invention relates to a outer lid Pressure cooker, which incorporates a new feature in the list design, which prevents the froth from overflowing down the list of a Pressure cooker, thus ensuring a safer and cleaner cooker experience, besides an improvement in pressure cooker handle which is extremely unique and distinguished from a conventional cooker handle.

The above object is accomplished by making a pressure cooker and the lid handle in the form illustrated in the accompanying drawings.

DESCRIPTION OF THE INVENTION

The present invention relates to the field of handle designs and lid designs for consumer appliance and more specifically pressure cooker for domestic use. More specifically the present invention is directed to the pair of sandals, the first being the handle portion fixed on lid of the pressure cooker and second being the handle portion fixed on body of the pressure cooker. The invention relates to an improved pressure cooker handle design including a curved portion in each of the handle portions which contour match the other and combinedly align alongwith the surface so that when matched the two handle portions can be griped/grasped together to lift the pressure cooker body locked with the lid.

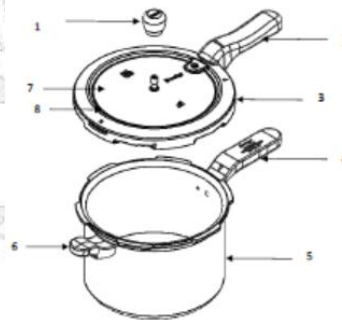
The Lid is matched to the body by using the handle is provided in the body and lid. The profile of the lid is shaped entirely different from the lid of the pressure cookers available at present. The invention prevents the froth as it comes from the valve stem during the time of the functioning of the weight value from flowing down the list and contains them within the contour provided in it. Such froths collected at the list, due to high temperature of the lid surface gets evaporated.”

SUMMARY OF THE INVENTION:

This design (Outer lid of this cooker) of pressure cooker has been done with the uniquely design and aesthetics which is not only easy to use, but also is very compact.”

“WE CLAIM:

1. A pressure cooker comprising:
 - a. a cooking body,
 - b. a lid which is flat surface with a peripheral wall to contain the froth leaking out of pressure weight also mounted on the lid, and
 - c. a handle with two elongated portions for locking the list to the body such that a first handle elongated portion coupled to the list and a second handle elongated portion coupled to the body, and wherein the lower surface of the lid handle portion has a contour which longitudinally aligns with the contour on the top surface of the second body portion, so that two handle portions are so disposed to be closely aligned with the lid handle portion over the body handle portion with the list has been applied and turned to lock with the body of the pressure cooker.



(iii) The mere fact that the plaintiff had applied for a patent for the pressure cooker did not detract from its entitlement to a design registration, as a design, which was both aesthetically and functionally inventive, was entitled to be registered both as a design and as a patent.

(iv) The defendant's contention that the suit design contained merely trade variants over prior art, was not acceptable, as any variation which did not affect the overall visual effect of the design could not be regarded as a trade variant.

(v) The defendant's contention that the suit design was not entitled to be registered as it was merely functional was without substance. Only designs which are "essentially functional" are not entitled to design registration. One of the tests which is required to be satisfied, for a design to be regarded as disentitled to registration as being purely functional, is that the functions performed by the design should not be capable of being achieved by any other shape or configuration. Mr. Hemant Singh cites, in this context,

(a) the judgment of the Supreme Court in *Bharat Glass Tube Ltd v. Gopal Glass Works Ltd*⁹,

(b) the judgment of the High Court of Justice in the UK in *Kestos Ltd v. Kempat Ld & Vivian Fitch Kemp*¹⁰,

(c) the judgment of the High Court of Justice in the UK in *Werner Motors Ld v. A.W. Gamage Ld*¹¹,

(d) the judgment of the Court of Session in Scotland in *Walker, Hunter, & Co. v. Falkirk Iron Co.*¹²,

(e) the judgment of the Chancery Division of the High Court in *Cow (P.B.) & Coy Ld v. Cannon Rubber Manufacturers, Ld.*¹³,

(f) the judgment of a learned Coordinate Single Bench in *Dart Industries Inc. v. Polyset Plastics Pvt Ltd*¹⁴,

⁹ 2008 (37) PTC 1 (SC)

¹⁰ (1936) 53 RPC 139

¹¹ (1903) 21 RPC 137

¹² (1887) 4 RPC 390

¹³ 1959 RPC 240

(g) the judgment of a learned Coordinate Single Bench in *Diageo Brands B.V. v. Great Galleon Ventures Ltd*¹⁵, and

(h) the judgment of a learned Single Judge of the High Court of Bombay in *Whirlpool of India Ltd v. Videocon Industries Ltd*¹⁶.

(vi) To a query from the Court as to the origin of the theory that purely functional designs cannot be registered, Mr. Hemant Singh cites, once again, *Kestos*¹⁰, as well as the judgment of the Privy Council in *Interlego A.G. v. Tyco Industries Inc.*¹⁷ Even as per the defendant, points out Mr. Hemant Singh, only the lid of the suit design was functional. The defendant was not seeking to contend that the entire pressure cooker, in respect of which the design registration had been granted to the plaintiff, was functional.

(vii) With respect to the YouTube video cited by the defendants as constituting prior publication of the suit design, it was submitted that, though the said video also advertises a *Svachh* pressure cooker model of the plaintiff, incorporating a spillage control facility, the configuration of the said pressure cooker was different from the suit design. The said pressure cooker, it was pointed out, was registered as Design No 319361-001 dated 5th July 2019. To substantiate the contention that the said YouTube video did not constitute prior publication, reliance was placed on sub-sections (3) and (4)(a) of Section 6

¹⁴ 2018 (75) PTC 495 (Del)

¹⁵ MANU/DE/2761/2022

¹⁶ 2014 (60) PTC 155 (Bom)

¹⁷ (1988) 16 RPC 343

of the Designs Act. The two designs, submits the plaintiff, are completely dissimilar, and the suit design cannot be treated as a variant of the YouTube design. Even if, *arguendo*, the suit design were to be regarded as a trade variant of the YouTube design, the suit design would nonetheless not be invalidated because of sub-sections (3) and (4) of Section 6. The only caveat, incorporated in the proviso to Section 6(3), is that both designs would expire together. Inasmuch as the life of the YouTube design was till 5th July 2029, even if the submission of the defendant would be accepted, the sequitur would only be that the suit design would also expire on 5th July 2029. In this context, Mr. Hemant Singh cites

(a) the judgment of B.R. Gavai, J. (as he then was, sitting singly) of the High Court of Bombay in *Whirlpool of India Ltd v. Videocon Industries Ltd*¹⁸,

(b) the judgment of the division Bench of the High Court of Bombay, adjudicating on the appeal from the judgment at (a), in *Videocon Industries Ltd v. Whirlpool of India Ltd*¹⁹ and

(c) the judgment of a learned coordinate Single Bench of this Court in *R.B. Health (US) LLC v. Dabur India Ltd*²⁰.

34. Mr. Jayant Bhushan, in response, contends as under:

(i) The registration of the suit design was itself invalid and was, therefore, unenforceable at law. Six designs could not be registered under one certificate. Mr. Jayant Bhushan has also

¹⁸ (2012) 52 PTC 209 : (2013) 1 Mah LJ 197

¹⁹ (2012) 6 Bom CR 178

²⁰ 2020 (84) PTC 492 (Del)

invited my attention, in this context, to the definition of “set”, in Rule 2(e) of the Designs Rules, 2001, as meaning “a number of articles of the same general character ordinarily sold together or intended to be used together, all bearing the same design, with or without modification not sufficient to alter the character or substantially to affect the identity thereof”. While six articles, bearing the same design, could be registered together as a “set”, therefore, six designs could not be embraced in one registration. Mr. Bhushan points out that the certificate of registration issued to the plaintiff certified novelty to be residing in the container with the lid. One container with one lid, therefore, constitutes one design. Six containers would, therefore, necessarily imply six designs, for which one certificate could not have been issued. Mr. Bhushan also relies, in this context, on Rule 14(2) of the Designs Rules, which stipulates that “when the design is to be applied to a set, each representation accompanying the application shall show all the various arrangements in which it is proposed to apply the design to the articles included in the set”.

(ii) While acknowledging that the written statement, filed by way of response to the plaint, does not question the validity of the suit design on this ground, Mr. Bhushan submits that the issue is a pure question of law, which has been raised by him based on the plaintiff’s registration certificate. He cites, for this purpose, the judgment of the Supreme Court in *Saurav Jain v. A.B.P. Design*²¹.

²¹ 2021 SCC OnLine SC 552

(iii) On the aspect of prior publication, by the YouTube video, Mr. Bhushan cites Section 4(b) of the Patents Act. Relying on the decision of a Division Bench of this Court in *Crocs Inc. v. Bata India Ltd*²², Mr. Bhushan submits that prior publication may be in the form of a document of the plaintiff itself.

(iv) Without prejudice, Mr. Bhushan relies on the defence, of the plaintiff, to the allegation of prior publication, as contained in the replication filed by the plaintiff. He points out that, in its replication, the plaintiff has sought to contend that there was “a visible distinction in the overall shape and configuration of the pressure cooker shown in the advertisement, such as the overall shape of the lid as well as the shape of the container”. He submits that, if the suit design is different from the YouTube design, then, equally, the impugned design of the defendant is also different from the suit design. What is sauce for the goose, Mr. Bhushan would submit, is also sauce for the gander.

(v) Mr. Bhushan next refers to the tabular comparison of the suit design with the defendant’s product, as provided in para 16 of the plaint and reproduced in para 11 *supra*. He submits that, if the suit design and the defendant’s product compared on the basis of the said tabular representation, it would be seen that (a) there is a significant difference in the height of the lid in the suit design, *vis-à-vis* that of the defendant’s product, (b) the shapes of the handles in the two pressure cookers is also different and (c) the shape of the safety valves in the two pressure cookers is also different. Where, therefore, the registration of the suit

²² (2019) 78 PTC 1

design certifies novelty to reside in the entire container and lid. These differences, submits Mr. Bhushan, would defeat the allegation of similarity, and piracy, as levelled by the plaintiff.

(vi) Mr. Bhushan further submits that, if the spillage control feature of the lid in the suit design was what imparted it novelty, then the suit design would be bad for want of novelty *vis-à-vis* prior art. In answer to this objection, he submits that the plaintiff relied on the entire shape of the container and the lid. A case of design piracy could not, therefore, be sought to be made out, by the plaintiff, solely on the basis of the shape and configuration of the lid in the suit design.

(vii) To support his plea regarding want of novelty in the suit design, Mr. Bhushan relies on the judgment of a learned Single Judge of this Court in *Crocs Inc. v. Liberty Shoes Ltd*²³ as well as the decision of the Division Bench in *Crocs*²², which dismissed the appeal therefrom. The Special Leave Petition preferred against the decision, it is pointed out, was also dismissed by the Supreme Court.

(viii) Mr. Hemant Singh's reliance on Section 6(3) of the Designs Act, submits Mr. Bhushan, is misplaced. The words "other article" in Section 6(3), he submits, would refer to associated articles, such as a spoon, a fork and knife, being associated articles of cutlery. Else, it would result into multiple design registrations being permissible for the same article, which is completely unacceptable in law. Mr. Bhushan has also sought, in this context, to contradistinguish the words "some

²³ (2018) 73 PTC 425

one or more other articles”, used in Section 6(3) with the words “some other article”, used in Section 6(4)(a). The decision in ***R.B. Health***²⁰, on which Mr. Hemant Singh relies, he submits, was based on Section 6(4).

(ix) The argument of Mr. Hemant Singh on the defendants’ contention that the suit design being purely functional could not have been registered, submits Mr. Bhushan, stands discredited by para 15 of the judgment of the Full Bench of this Court in ***Mohan Lal v. Sona Paint & Hardwares***²⁴. Referring to paras 9 and 11 of the plaint, *vis-à-vis* the Object, Summary Description of the Invention that the plaintiffs desired to patent, Mr. Bhushan submits that the crucial and critical part of the suit design is the lid. The lid is purely functional. He submits that no aesthetics have been applied to the lid at all. The emphasis laid by the plaintiff on the spillage control ability of the lid, he submits, itself indicates that the design is purely functional. Citing, for the purpose, the decision of a learned Single Judge of this Court in ***SmithKline Beecham Plc. v. Hindustan Lever Ltd***²⁵, Mr. Bhushan submits that the dominant feature of the suit design has to be seen, in order to ascertain whether it is functional or otherwise. He relies, in this context, on the advertisement, by the plaintiff, of its *Svachh* Deluxe Alpha pressure cooker, as a “no mess” experience. The novelty claimed by the plaintiff in the suit design is, therefore, limited to the lid and is, therefore, purely functional. He also cites, in this context, the judgment of the High Court of Madras in ***Tractors & Farm Equipment Ltd v. Standard Combines (Pvt)***

²⁴ 200 (2013) DLT 322 (FB)

²⁵ (2000) 52 DRJ 55

*Ltd*²⁶ and of this Court in *Rajesh Kalra v. Safeops Surgical Care*²⁷ . He submits that a customer who purchases the plaintiff's product would do so because of its functional aspect, and not because of its aesthetics.

35. For all these reasons, submits Mr. Bhushan, the claim of the plaintiff is completely devoid of merit, and the plaintiff cannot be regarded as entitled to any interlocutory injunctive relief.

Submissions of Mr. Hemant Singh in rejoinder

36. Arguing in rejoinder, Mr. Hemant Singh contends thus:

(i) Mr. Bhushan cannot be permitted to contest the validity of the certificate of registration of the suit design, as no such plea has been advanced in the pleadings of the defendant thus far.

(ii) Nonetheless, Mr. Hemant Singh submits that, as the provisions of the Designs Act and the Designs Rules permit registration of a design for a set, the suit design is perfectly valid. He also relies on the definition of “set” in Rule 2(e) of the Designs Rules and emphasises, in the said clause, the words “number of articles of the same general character” and “with or without modification”. The same lid, therefore, when used on different pressure cookers, submits Mr. Hemant Singh, would amount to the same design, as the alteration was not sufficient to alter the character of the article. In any event, he submits,

²⁶ MANU/TN/1935/2012

²⁷ 2018 SCC OnLine Del 9516

discretion, in this regard, has been vested in the Controller by Rule 14(1) read with 14(4)²⁸ of the Designs Rules. Once the controller had deemed it appropriate to register all the 6 pressure cookers as a set, that, submits Mr. Hemant Singh, was the end of the matter.

(iii) Mr. Hemant Singh further submits that both Sections 6(3) and 6(4) apply equally where the applicant itself was the proprietor of the earlier cited design. Any other interpretation, he submits, would result in an anomalous situation in which the proprietor of both the earlier and later design would be denied the benefit which would be available to him if he were the proprietor only of the later design. Section 6(3) would, in his submission, have to be read in conjunction with the expression “or some other article with modifications are variations not sufficient to alter the character or substantially to affect the identity thereof” in Section 6(4)(b). Mr. Hemant Singh, relying on the judgments of the Supreme Court in *Shamarao V. Parulekar v. District Magistrate*²⁹ and *New India Assurance Co. v. Nusli Neville Wadia*³⁰, submits that, if there is any anomaly, it could always be cleared by a purposive interpretation of the statutory provisions. He has also cited, in support of the interpretation that he places on Section 6(3) and (4), *R.B. Health*²⁰, *Whirlpool*¹⁸ and *Videocon*¹⁹. Mr. Hemant Singh submits that, therefore, the plaintiff would be entitled to

²⁸ 14. **Representation.** - (1)The four copies of the design required by rule 11 shall be exactly similar drawings, photographs, tracings or other representations of the design or shall be specimens of the design.

(4) When a design is to be applied to a set, any doubt whether the given articles do or do not constitute a set shall be determined by the controller.

²⁹ (1952) 2 SCC 1 : 1952 SCC OnLine SC 64

³⁰ (2008) 3 SCC 279

protection of the suit design even if it were to be regarded as prior published in the YouTube design, the only caveat being that both designs would expire simultaneously.

(iv) Addressing, lastly, the aspect of functionality, Mr. Hemant Singh distinguishes the decision in *SmithKline Beecham*²⁵, cited by Mr. Bhushan, as having been rendered in the context of passing off, and not in an infringement claim. Other judgments cited by Mr. Bhushan, he submits, do not represent the position in law in this country, in which designs which are both functional and aesthetic can be registered.

(v) Besides, submits Mr. Hemant Singh, there is no pleading, by the defendant, that the function of spillage control, achieved by the lid in the suit design, could be achieved by any alternate method. Nor, he points out, does the written statement disclose the source from which the defendant designed a similar spillage control lid.

(vi) *Crocs*²², submits Mr. Hemant Singh, was a case in which the suit design was itself published, prior in point of time to the registration of the asserted design, on the plaintiff's own website. Besides, it was a case in which the Court found, on merits, that the suit design was merely a trade variant of the earlier published design. In order to make out a case of the suit design being a trade variant of prior art, Mr. Hemant Singh submits that the defendant would have to disclose the prior art of which the suit design is a trade variant. In the present case, the prior art cited, in the form of the YouTube design, is the plaintiff's own design.

(vii) Finally, Mr. Hemant Singh submits, relying on the decision of this bench in *Diageo Brands B.V v. Alcobrew Distilleries India Pvt. Ltd.*³¹, that piracy does not require identity between the suit design and the impugned design. All that is required to be shown is that the impugned design copies the essential features which imparts novelty to the suit design.

Analysis

37. Validity of Certificate of Registration

37.1 Mr. Jayant Bhushan advanced, as his first ground of challenge, the contention that the certificate of registration of the suit design was *ipso facto* invalid, as one certificate could register only one design, and the certificate in the present case registered six designs. He has also relied, in this context, on Rule 2(e) of the Designs Rules, which defines “set”. Mr. Bhushan submits that a “set”, per definition, refers to articles of the same general character ordinarily sold together. Six different pressure cookers cannot, therefore, he submits, constitute a “set”. *Ergo*, Mr. Jayant Bhushan would submit that six pressure cookers cannot be covered by one design registration. Mr. Hemant Singh, therefore, *per contra*, would submit that the six pressure cookers can justifiably be regarded as a “set”.

37.2 With respect, I am of the opinion that both the contentions are completely off the point. The definition of “set” in Section 2(e) of the Designs Rules has no relevance, whatsoever, to the validity of the suit design, on the objection that Mr. Bhushan raised. The interpretation of

³¹ 2022 SCC OnLine Del 4499

“set” as advanced by Mr. Bhushan is completely in tune with the definition of “set” as contained in Rule 2(e). As Mr. Bhushan correctly contends, “set”, within the meaning of the Designs Rules, has to comprise articles which are ordinarily sold together. It is difficult, therefore, to hold that six pressure cookers can constitute a “set”. The certificate of registration, in fact, correctly refers to the container, with the handle and the lid as a “set”, as these articles are sold together.

37.3 That said, the definition of “set” in the Designs Rules is, in my opinion, irrelevant to the present controversy.

37.4 Section 6 of the Designs Act deals with the registration of designs. Section 6(1) ordains that a design may be registered in respect of any order of the articles comprised in a prescribed class of articles. “Class of articles” is not defined in the Designs Act. However, Section 2(i) defines “prescribed” as meaning “prescribed by rules made under this Act”. To understand the expression “prescribed class of articles”, therefore, one has to take recourse to the Designs Rules, made under Section 47 of the Designs Act. Rule 10³² of the Designs Rules deals with classification of goods. Sub- rule (1) of Rule 10 stipulates that, for the purposes of registration of designs and for applicability of the Designs Rules, classification of articles would be as per the Locarno Classification, which is the International Classification for Industrial Designs. The “class of articles” would, therefore, have to be discerned from the Locarno Classification, and

³² **10. Classification of Goods.**—(1) For the purposes of the registration of designs and of these rules, article shall be classified as specified in the Third Schedule hereto.
(2) If any doubt arises as to the class to which any particular description of article belongs, it shall be determined by the Controller in consultation with the applicant wherever required.

one registration could, under Section 6(1), cover more than one article within one class.

37.5 The suit design stands registered in Class 07-02 of the Locarno Classification, which covers “Cooking appliances, utensils and containers”. “Article” is defined, in Section 2(a) of the Designs Act, as meaning “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”. One or more articles of manufacture, which fall within the parentheses of the definition in Class 07-02, covering “Cooking appliances, utensils and containers” can, therefore, be covered under one design registration. By operation of Section 6(1), therefore, “a design may be registered in respect of” more than one articles in Class 07-02, provided each of the articles is covered by the overall description of the said Class.

37.6 The certificate of registration of the suit design treats the “pressure cooker with container and lid” as a “set” for the purposes of registration. The open pressure cooker is, therefore, a “container”. One pressure cooker with lid and five open pressure cookers can, therefore, legitimately be covered by one design registration, as they are all articles falling within the same class of articles, i.e. Class 07-02.

37.7 That may all be very well, Mr. Jayant Bhushan would submit, but, under Rule 6 (1) it is “*a design*” which can be registered even for more than one article in a class of articles. Inasmuch as the shape, size and capacity of the six containers reflected in the registration of the suit design, including the container which is capped with a lid and safety valve, are different, he submits that each would constitute a

separate design. Six designs, applicable to six articles, Mr. Jayant Bhushan would submit, cannot be covered by one design registration.

37.8 The submission, in my considered opinion, suffers from an incorrect appreciation of the definition of “design”, as contained in the Designs Act. To the extent it is relevant, “design”, as defined in Section 2(d) of the Designs Act, “means only the features of shape, configuration, pattern, ornament or composition of lines of colours applied to any article...” Thus, the “design” is not the shape, configuration, pattern, ornament or composition of lines of colours applied to the article, but *only the features of* such shape, configuration, pattern, ornament or composition.

37.9 The use of the words “only the features of”, in Section 2(d) are neither superfluity nor tautology. They make a significant impact on the manner in which the clause is to be understood. “Feature” is defined, in the Shorter Oxford English Dictionary, as “form, shape; proportions, especially of the body” and, alternately, as “a distinctive characteristic part of a thing; apart that attracts attention by its prominence etc.”. When, therefore, section 2 (d) defines a design as the features of the shape, configuration, pattern, ornament or composition of lines or colours applied to an article, the Court is required to firstly appreciate the article, thereafter its shape or configuration and, thereafter, identify the features of such shape or configuration. The features of the shape or configuration of the article constitute its design.

37.10 The fact that the closed pressure cooker and the five open pressure cooker container, whose images are reflected in the registration of the suit design, are of different capacities, or even of

different shapes, therefore, do not render them different designs. The features of the shape and configuration of all the six “articles” are fundamentally the same, the only difference between them being relatable to the capacity of the pressure cookers. Even the height of the lids of the pressure cookers would vary only depending on the capacity of the pressure cooker. The features, shape and configuration of all six pressure cookers is the same. All six pressure cookers are cylindrical in shape. The configuration, which would represent the arrangement of individual features in the design, is also the same in all six pressure cookers. The only difference, in height of the container and height of the lid, is attributable only to the differences in capacity of the pressure cookers. That would not, in any way, affect their shape or configuration. The features of the shape and configuration of the containers, as well as of the lids, of all six pressure cookers, each of which would constitute a “set” within the meaning of Rule 2(e) of the Designs Rules, are the same. Indeed, barring the difference relatable to the capacities of the pressure cookers, which would include the height of the lid, Mr. Jayant Bhushan was unable to identify any other significant difference in the shape or configuration of the pressure cookers.

37.11 The certificate of registration, therefore, covers essentially one design, involving the same shape and configuration of the container and lid, which constitutes a set and in which, according to the certificate of registration, novelty resides. Section 6(1) permits one design to be applied to more than one articles covered in one class of articles. As all six pressure cookers, or even one pressure cooker and five containers, would all fall within the same class of articles, and have the same features of shape and composition, meaning thereby that they would have the same design, the certificate of registration

falls within the scope of Section 6(1) of the Designs Act and is, therefore, *prima facie* valid.

38. The Legal Position

38.1 Before examining these aspects, it is worthwhile to refer to the relevant authorities which shed light on the issues in controversy.

38.2 *Bharat Glass Tube*⁹

38.2.1 The decision of the Supreme Court in *Bharat Glass Tube*⁹ is the only authoritative pronouncement by the Supreme Court on the Designs Act, and its intricacies.

38.2.2 The respondent Gopal Glass Works Ltd (“Gopal”, hereinafter), in this case, manufactured and sold figured and wired glass sheets. Gopal claimed to be the originator of new industrial designs, mechanically applied to the glass sheets. The glass sheets, to which the designs were so applied, were claimed to have eye-catching shapes, configurations, ornamental patterns, colour shades, etc. The figured glass sheets were registered as designs, and the case before the Supreme Court related to Design No 190336.

38.2.3 For production of Design No 190336, two rollers were required, which were manufactured by Dornbusch Gravuren GmbH, Germany (“DGG”, hereinafter). Gopal placed an order on DGG for supply of rollers, for launching the Design No 190336, claiming the design to have new and novel features, hitherto unknown.

38.2.4The designed glass sheets were registered on 5th November 2002, under the Designs Act. The registration was for a period of 10 years. The designed glass sheets were marketed under the name Diamond Square.

38.2.5Bharat Glass Tube Ltd (“Bharat”, hereinafter) started imitating Gopal’s Design No 190336. Gopal filed Civil Suit No 1/2004 against Bharat before the District Court, which granted an interlocutory injunction restraining Bharat from infringing the copyright of Gopal in the said Design No 190336.

38.2.6Bharat, as a counterblast, filed an application under Section 19 of the Designs Act, seeking cancellation of Design No 190336 on the ground of prior publication in India and abroad as well as on the ground of want of novelty and originality. Reliance was placed, for the said purpose, on a catalogue of DGG, relating to Design No 2960-9010, developed by DGG in 1992. Reliance was also placed on information downloaded from the Internet website of the United Kingdom Patent Office on 22nd September 2004, indicating that Design No 190336 had been registered in the UK in the name of another company. Gopal, in response, stated, on affidavit, that DGG was engaged only in the manufacture of engraving rollers and had never manufactured designed glass sheets, designed using the said engraving rollers. The UK Company, too, it was asserted, had never manufactured glass sheets having the registered design.

38.2.7The Assistant Controller of Patents and Designs set aside Design No 190336. The decision of the Assistant Controller was reversed by a learned Single Judge of the High Court, in a statutory appeal preferred by Gopal. An application filed by Bharat for

cancellation of the registration of Design No 190336 was also dismissed by the Single Judge. Aggrieved thereby, Bharat appealed to the Supreme Court.

38.2.8The Supreme Court, after referring to the relevant statutory provisions in the Designs Act and the Designs Rules, explained the *raison d'etre* of the Designs Act thus, in para 26 of the report:

“26. In fact, the sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act.”

The following passage from P. Narayanan's Law of Copyright and Industrial Designs was also quoted with approval:

“27.01. Object of registration of designs. – The protection given by the law relating to designs to those who produce new and original designs, is primarily to advance industries, and keep them at a high level of competitive progress.

Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but the appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will increase sales.’ The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods.

The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable (*sic* protectable) at all, ought to be made the subject-matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. Thus the primary concern, is what the finished article is to look like and not

with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of articles of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.”

38.2.9 The Supreme Court went on, thereafter, to examine the grounds on which the Assistant Controller had set aside the design registration granted to Gopal. Two grounds, it was noted, had weighed with the Assistant Controller; the first, that DGG had registered the design for the roller, using which the disputed Design No 190336 was inscribed in glass, way back in 1992, and the second, that a design registration, for the same design, had been obtained in the UK prior point of time, as was apparent from information downloaded from the UK patent website. These considerations impelled the Assistant Controller to hold that Design No 190336 was not new and original and was not, therefore, entitled to registration.

38.2.10 The Supreme Court observed that the burden, to show that the registered design was not new and original, was on him who so asserted. Bharat, it was noted, had failed to discharge the said burden. Evidence of manufacture of the rollers and sale thereof, in the market, by DGG, did not imply use of the said rollers to replicate Design No 190336 on glass. On the meaning of the expression “new or original”, the Supreme Court held thus, in para 29 of the report:

“The expression, “new or original” appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, “new or original” means that it had been invented for the first time or it has not been reproduced by anyone.”

The purchase, by Gopal, of the rollers from DGG did not indicate that they were going to produce the design on the glass sheets using the

rollers. Explaining the definition of “design” as contained in Section 2(d) of the Designs Act, the Supreme Court held, in para 30 of the report, thus:

““Design” has been defined in Section 2(d) which means that a feature 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. That means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal. The definition of “design” as defined in Section 2(d) read with application for registration and Rule 11 with Form 1 makes it clear that the design which is registered is to be applied to any finished article which may be judged solely by eye appeal. A conjoint reading of these three provisions makes it clear that a particular shape or a particular configuration is to be registered which is sought to be produced on any article which will have visual appeal. Such design once it is registered then it cannot be pirated by any other person. But the question is whether it is new or original.”

Following on this line of reasoning, the Supreme Court went on to observe, in para 31 of the report, that “the expression “new or original” in this context has to be construed that whether *this design* has ever been reproduced by any other company on the glass sheet or not”. The Supreme Court observed that there was “no evidence whatsoever produced by the complainant either before the Assistant Controller or before any other forum to show that *this very design which has been reproduced on the glass sheet* was manufactured anywhere in the market in India or in the United Kingdom”. Para 33 of the report reiterated this factual position by observing, again, that “no evidence was produced by the complainant before the Assistant Controller that anywhere in any part of the world order in India *this design* was reproduced on glass or it was registered anywhere in India or any part of the world”. Again, in para 34, the Supreme Court held as under:

“Therefore, what is sought to be protected is that the design which will be reproduced on the roller by way of mechanical process and *that design* cannot be reproduced on glass by anybody else. Now, the question is whether it is new or original design. For that it is clear that there is no evidence to show *that this design which is reproduced on the glass sheet* was either registered in India or in Germany or for that matter in the United Kingdom.”

(Emphasis Supplied)

38.2.11 Thereafter, the Supreme Court went on, in para 36 of the report, after referring to various judicial authorities from other jurisdictions and authoritative texts, to explain the concept of a design in the following words:

“Therefore, the concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. Therefore, whenever registration is required then those configuration has to be chosen for registration to be reproduced in any article. The idea is that the design has to be registered which is sought to be reproduced on any article. Therefore, both the things are required to go together i.e. the design and the design which is to be applied to an article.”

38.2.12 On the concept of eye appeal, crucial for any “design” within the meaning of the Designs Act, the Supreme Court proceeded, in para 40 of the report, to cite, with approval, the judgment of the Privy Council in *Interlego AG v. Tyco Industries Inc.*¹⁷

“In relation, however, to an assessment of whether a particular shape or configuration satisfies the former and positive part of the definition, the fact that an important part of the very purpose of the finished article is to appeal to the eye cannot be ignored. That factor was one which was conspicuously absent from the articles upon which the courts were required to adjudicate in *Tecalemit Ltd. v. Ewarts Ltd.*³³ (No. 2), *Stenor Ltd. v. Whitesides (Clitheroe) Ltd.*³⁴, and *Amp Inc. v. Utilux Pty. Ltd.*³⁵, and in the more recent Irish case of *Allibert S.A. v. O—Connor*³⁶ in all of which the claim to registration failed. It was one which was present in *Kestos*¹⁰ case, where the claim to the validity of the design succeeded. It is present in the instant case. One starts with the

³³ (1927) 44 RPC 503

³⁴ 1948 AC 107 : (1947) 2 All ER 241 : (1948) 65 RPC 1 (HL)

³⁵ 1972 RPC 103 (HL)

³⁶ (1981) FSR 613

expectation of eye appeal, for part of the very purpose of the article is to have eye appeal. That was aptly expressed by Whitford, J. in relation to the same subject-matter as in this appeal in *Interlego AG v. Alex Folley (Vic) Pty. Ltd.*³⁷ (FSR at p. 298):

‘I would have expected a designer designing toys to have the question of the appeal of the toy to the eye, even in the case of a functional toy, in mind. Mr Rylands who gave evidence for the defendants said that when designing a functional toy it is necessary to have regard not only to suitability for purpose but to overall appearance. You have to design so that the article in question will make an immediate visual appeal to a child or to the parent or other person buying for a child.’ ”

38.2.13 The Supreme Court held, thus, that the evidence obtained from DGG did not indicate that Design No 190336 had been published, prior to its registration, elsewhere.

38.2.14 The second piece of evidence which had persuaded the Assistant Controller to revoke the registration of Design No 190336 was a design image downloaded from the website of the UK Patent Office, indicating patterns which could be applied to glass sheets. The Assistant Controller compared Design No 2022468, which was one of the designs reflected on the said website with Design No 190336 and held that both designs appealed equally to the eye and resembled each other. As Design No 2022468 had been published prior in point of time to Design No 190336, the Assistant Controller held that Design No 190336 was neither new nor original and was disentitled to registration. The Assistant Controller held that Gopal had failed to indicate any point of distinction between Design No 2022468 and Design No 190336. The learned Single Judge of the High Court, to whom Gopal appealed, however, disagreed with the decision of the Assistant Controller, and the Supreme Court overwhelmingly approved the view of the learned Single Judge. The learned Single

³⁷ (1987) FSR 283

Judge held that the drawings downloaded from the website of the UK Patent Office may have been the same, in appearance, to Design No 190336, but the visual appeal of the said drawings, for the purposes of comparing them to Design No 190336, *could be asserted only when the drawings were manually etched on glass fees. The visual appeal of the design had, therefore, to be considered as each emerged on the final product.* There was no evidence to indicate that Design No 2022468 had ever been applied to glass sheets; rather, there was an affidavit of an officer indicating to the contrary. What was required, for a finding of prior publication, or the lack of novelty and originality *vis-à-vis* prior art, to be returned, held the Supreme Court, was comparison of glass sheets on which Designs No 190336 and 2022468 had been etched. That not being available, the Supreme Court held the learned single Judge of the High Court to have been correct in his view that no evidence of prior publication of Design No 190336, or want of novelty and originality in the said design *vis-à-vis* prior art, was forthcoming.

38.3 *Carlsberg Breweries A/S v. Som Distilleries & Breweries Ltd*³⁸

38.3.1 The essential issue which arose for consideration before the Full Bench of this Court in *Carlsberg Breweries*³⁸, of five Hon'ble judges, arose from the judgment of an earlier Full Bench of three Hon'ble Judges of this Court in *Mohan Lal*²⁴, and revolved around whether, in a single suit, a plaintiff could sue for both infringement and passing off of its design. The five-Judge Full Bench held that he could. We are not particularly concerned with that issue in the present case, and no dispute on the point has been raised before me. In the course of arriving at its decision, however, the Full Bench in

³⁸ AIR 2019 Del 23 (FB): 256 (2019) DLT 1 (FB): 2019 (77) PTC 1

*Carlsberg Breweries*³⁸ adverted to some of the more empirical principles in design law, which are of significance.

38.3.2The Full Bench in *Carlsberg Breweries*³⁸ noted that the claims in a suit, whether for infringement of passing off, were directed against the same defendant or defendants, and were in respect of the same set of acts and transactions. The only difference was in the nature of relief claimed.

38.3.3Having so noted, the Full Bench went on to observe, further, thus:

“44. A registered design owner, this court notices, *facially* satisfies the test of novelty (of the product's design) and that it was not previously published. For registration, the article must contain uniqueness or novelty in regard to elements such as shape, configuration, pattern, ornament or composition of lines of colours applied to any article; further there must be a visual appeal to the article (i.e. the aesthetic appeal). However, if the defendant establishes that indeed there was no novelty, or that a similar design had been published earlier, in the public domain, the infringement claim would be repelled. In respect of a passing of claim, distinctiveness of the elements of the mark, its visual or other presentation and its association with the trader or owner needs to be established. The factual overlap here is with respect to the presentation - in the design, it is the novelty and aesthetic presentation; in a passing off action, it is the distinctiveness (of the mark) with the attendant association with the owner. To establish infringement (of a design) fraudulent imitation of the article (by the defendant) has to be proved. Likewise, to show passing off, it is necessary for the owner of the mark to establish that the defendant has misrepresented to the public (irrespective of intent) that its goods are that of the plaintiff's; the resultant harm to the plaintiff's reputation is an actionable claim.”

(Italics in original)

Thus, holds the Full Bench,

- (i) the registration of a design *facially* indicates satisfaction of the test of novelty and absence of prior publication,
- (ii) to be eligible to registration,

- (a) the article in question must be unique or novel in regard to elements such as shape, configuration, pattern, ornament or composition of lines of colours applied to it and
- (b) it has to have visual, i.e. aesthetic, appeal.

38.3.4 Though, as already noted, the final conclusion of the Full Bench in *Carlsberg Breweries*³⁸, on the issue referred to it, is not strictly relevant, suffice it to state that, as the above issues would similarly arise for consideration while examining the aspect of piracy/infringement and passing off, the Full Bench held that one suit could be maintained for both causes of action.

38.4 *Reckitt Benckiser Ltd v. Wyeth Ltd*³⁹

38.4.1 This decision is significant, as it addresses the issue of “prior publication” and, though prior publication is one of the reasons why a design may not be registered [under Section 4(b)] and is also one of the grounds on which cancellation of a registered design may be sought [under Section 19(1)(b)], the Designs Act does not enlighten on the aspect of prior publication, or what it entails.

38.4.2 A Division Bench of this held, in *Dabur India Ltd v. Amit Jain*⁴⁰, publication abroad by existence of the design asserted in a suit in the records of the Registrar of Designs which was open to public inspection to constitute “prior publication” for the purposes of Section 4(b) and 19(1)(b) of the Designs Act. The correctness of this view

³⁹ AIR 2013 Del 101 : 198 (2013) DLT 521 (FB) : 2013 (54) PTC 90 (FB)

⁴⁰ 2009 (39) PTC 104 (Del)

was referred to a Full Bench of three learned Judges for examination, resulting in the judgment in *Reckitt Benkiser*³⁹.

38.4.3 The Full Bench held, at the outset, that Section 19(1)(a) of the Designs Act provided, as a ground for cancellation of a design registered in India, only the registration of the said design earlier in India itself. As against this, Section 19(1)(b), it was observed, provided prior publication of the suit design not only in India but also abroad as a ground for seeking its cancellation. A difference in approach was, therefore, apparent, while envisaging prior registration, and prior publication, as grounds for seeking cancellation of a registered design. Prior registration had necessarily to be in India, whereas prior publication could be either in India or abroad.

38.4.4 In the course of its further discussion, the Full Bench went on to dilate on the aspect of “publication”, for the purposes of the Designs Act. In the course of the discussion on the point, the Full Bench, predictably, adverted to the judgment of the Supreme Court in *Bharat Glass Tubes*⁹, but, prior thereto, observed thus, on the aspect of publication:

“11. The expressions ‘published’ or ‘publication’ are not defined in the Act. Various judgments have however defined these expressions found in the Designs Act. Some judgments define publication as being opposed to one which is kept secret, whereas other judgments define publication as something which is available in public domain i.e. available as of right to any member of the public. *We are of course looking into the issue of publication by means of existence in public domain by publication in a paper (which expression “paper” is taken to mean any other medium where the design can be judged by the eye) inasmuch as, it was not (and could not be) disputed by both the parties before us that once there is actual use of the design by making an article out of the same, which is commercially exploited and put in public use (‘by use’ as stated in Section 4(b) of the Act), there would surely be publication.* The issue of publication is accordingly being specifically looked into from the point of view of whether publication by means of publishing in a paper form available in

public generally including of their availability in the office of the Registrar of Designs.

12(i). *Let us therefore see what should be the meaning which should be ascribed to the expression 'published' or 'publication' when we use such expressions qua 'published' or 'publication' in paper form or by depiction in any form which is visible to naked eye without the same having been put in the form of an article.*

We have already in this regard reproduced the definition of design as per Section 2(d) of the Act and the definition of expression 'original' as per Section 2(g) of the Act above, and which sections will be of relevance for discussion of 'publication'.

(ii) *When we read the definition of a 'design' under Section 2(d) we find that there are inter alia four important aspects in the same. The first aspect is that the design is a design which is meant to produce an article as per the design by an industrial process or means. The second aspect is that design is not the article itself but the conceptual design containing the features of a shape, configuration, pattern, composition of lines etc. Third aspect is the judging of the design which is to be put in the form of finished article solely by the eye. Fourthly, the design which is the subject matter of the Act is not an artistic work which falls under the Copyright Act or a trademark which falls under the Trademarks Act.*

(iii) *More clarity is given to the meaning of the word design when we look at the definition of 'original' as found under Section 2(g). The definition of the expression 'original' shows that the design though is not new because such design exists in public domain and is otherwise well-known, however, the design is original because it is new in its application i.e. new in its application to a specific article. Therefore, for seeking registration under the Act it is not necessary that the design must be totally new, and it is enough that the existing design is applied in a new manner i.e. to an article to which that design has not been applied before.*

(iv) *So far as the expression 'new' is concerned, it is well known i.e. it is something which comes into existence for the first time and therefore a new design which comes into existence for the first time obviously will be entitled to copyright protection.*

13(i). *When we see the provision of Section 4(b) we find that a design which is already disclosed by publication in India or abroad will not be registered, however, the bar for registration of a design which is disclosed to the public in India or abroad is accompanied by the language which requires publication 'in a tangible form or by use or in any other way'. It is this language and the fascicle of expressions 'tangible form' or 'use' or 'in any other way' which*

requires to be understood and interpreted so as to understand the meaning of the word 'publication'.

(ii) *So far as the expression 'by use' is concerned, there would be no difficulty because obviously use of the design would be by translating the same into a finished article by an industrial process or means. The real difficulty which arises actually is qua the expressions 'tangible form' or 'in any other way'. These two expressions on a normal literal interpretation are much wider than the expression 'use' (the design having been translated to an article). Publication in a paper form or publication as being visible to the naked eye without the same having been put on an article is very much otherwise included in these wide expressions. The question thus is to what extent should there be publication for the same to be in 'tangible form' or 'in any other way' for being included within the language of 'publication' as found in Sections 4(b) and 19(1)(b)."*

(Emphasis supplied)

38.4.5 The Full Bench, thereafter, went on to refer to the judgment of the Supreme Court in *Bharat Glass Tube*⁹ and culled out the following principles as emanating therefrom:

“(i) The issue of originality of design has to be necessarily looked at in terms of the article to which it applies and *there may be lack of clarity as to existence of prior publication unless the publication is totally clear i.e. it is only completely understood for its effect only when the same is actually put on the article.*

(ii) Primacy was given to the Indian registered design because the design which was registered in the U.K. Patent Office was never used qua the article in question viz the glass sheet and the documents downloaded from the internet of the U.K. Patent Office could not be said to have much clarity for being treated as a prior publication qua the specific article in question viz the glass sheet.

(iii) A foreign registered design cannot be the basis for cancellation under Section 19(1)(a) of a design registered in India unless there is application of a design to an article which is put into public domain/use or unless there would have been complete and sufficient clarity in the documents downloaded through internet from the U.K. Patent Office that it can be held that there is a clear cut clarity qua prior 'publication'.

(iv) In the facts of that case since there was no clarity from the design downloaded from U.K. Patent office it was held that there was no prior publication.”

38.4.6 The Full Bench proceeded, thereafter, to explain the concept of publication “in a tangible form”, as envisaged in Section 4(b) of the Designs Act, thus:

“19(i) *In our opinion the expression ‘tangible form’ refers to a specific physical form or shape as applied to an article and not the mere ability to replicate, convert and give a physical shape to the design, though of course to fall under the expression ‘tangible form’ it is not necessary that the article should have been used, but the expression ‘in any other way’ takes some of its colour from the words ‘used’ or ‘tangible form’. The principle of Nositur a Sociis will be applicable. Section 4(b) therefore, not only, requires publication but it should be publication by use, in tangible form or in any other way. The expression ‘any other way’ here is wider in context and takes into its ambit a design which has been created though not still put to use or exists in tangible form but at the same time it is guided by the words “use” and “tangible form”. Thus, to disqualify a claim for registration or cancel registration of a design in India, the publication abroad should be by use, in tangible form, or in some other way, means that the design should not be a factum on paper/document alone, but further that the design on paper should be recognizable i.e. have the same impact in the public as a furnished article will appeal when judged solely by the eye (see Section 2(d)). Putting it differently if the design is on paper then it must exist upon a piece of paper in such a way that the shape or other features of the article are made clear to the eye. The visual impact should be similar to when we see the design on a physical object i.e. an object in tangible form/in use. As noted otherwise in the present judgment, registration of a design is article specific and thus depending on the facts of each case registration or publication of design of a particular article may or may not necessarily result in rejection or cancellation of registration of the same or similar design on another article. The Act protects the original artistic effort not in form of an idea or on its own as an artistic work, but is an embodiment in a commercially produced artefact. Thus the primary concern is what the finished article is to look like. [see observations of the Supreme Court in **Bharat Das Tools Ltd. v. Gopal Glass Work’s Ltd.**⁴¹ (infra)].”*

(Emphasis supplied)

The Supreme Court, in **Bharat Glass Tube**⁹, it was observed, held that “the documents downloaded through Internet from the website of the UK Patent Office did not add that amount of clarity for the same to be

⁴¹ (2008) 10 SCC 657

said to be prior publication for seeking cancellation on the basis of such alleged prior publication of a design registered in India”.

38.4.7The Full Bench proceeded to place reliance on the following passages from Russell-Clark and Howe on Industrial Design as reinforcing the principles enunciated in *Bharat Glass Tube*⁹:

“What counts as “published” for the purpose of calling into question the novelty of a later design registration? This is broader than the word at first suggests. It is by no means limited to the publishing of a design in a printed publication, although it includes that. In practical terms, there are two main ways in which a design can be published : by prior use of the design, by selling or displaying to the public articles to which the design has been applied; and by paper publications of one sort or another. It is not, in fact, necessary that publication should be on paper; an oral disclosure, provided it is non-confidential, will amount to publication.

Re-registration of the same design for different articles, or a similar design for same or different articles

A special exception existed to the general rule that the novelty of a design will be destroyed by the prior registration or publication of that design as applied to any kind of article. By S.4(1) of the RDA(A), the proprietor of a registered design was entitled to apply for registration of the same design, or a design with modifications or variations not sufficient to affect its identity, in respect of another article. His own previous registration, or the publication of his design as registered, does not then destroy the novelty of his new design registration in respect of the new article, but his term of protection is limited to the term of the original design. This, in effect, gave the proprietor of a design registration the ability to extend the scope of the registration during its lifetime to cover further articles, although in formal terms each application to protect his design on a new article will be a separate application leading to a separate design registration. It appears that his application for registration of the design on the new article must precede his actual use of the design on the new article. This is because, if he uses the design on an article which falls outside the scope of his earlier registration, then that will not count as a publication “of the registered design”, which is all that s.4(1) of the RDA(A) shields him against as regards the novelty of his new application.

A person who makes an application to register a design and finds that it has previously been registered in respect of a different article was allowed to buy up the earlier design registration while his own

application was still pending, and if he did so he could take advantage of this rule in the same way as if he had himself been the owner of the earlier registration all along.

The same rule applied to the registration (whether in respect of the same article or a different article) of a design which is not exactly the same as the earlier registered design, but has “modifications or variations not sufficient to alter the character or substantially to affect the identity thereof”. However, this provision has been interpreted narrowly so that practically any significant change or difference between the earlier and later design will destroy the protective effect of this provision. For an applicant to rely on s.4(1)(b), the subject of his application must have substantial identity with his prior published design. In Sebel Ltd's Application (No. 1), it was held that substitution in the old design of a different stand did substantially alter the identity of the article (a rocking horse), and that the subsection did not apply. Since the stand had already been published in an advertisement showing it applied to another horse, it was held that design failed to qualify for novelty under s.1, the said stand being a mere trade variant. In Sebel Ltd's Application (No. 2), a design was held not to fall within s.4 because the character of the design was different from the character of the applicant's earlier design. Thus it seems that the applicant's own earlier design may be sufficiently similar to destroy the novelty of his later application for protection of his modified design, and yet too different to allow him to take advantage of the protection of RDA(A) s.4(1). This is an odd and unfortunate result if it is indeed correct.

Publication in documents

In cases of publication of a design by prior use as applied to an article, normally the only questions which arise are whether it has been published at all (i.e. whether the articles to which it has been applied have been disclosed to the public), and whether the design is similar enough to the design in suit to destroy the latter's novelty. But where the novelty of a design is tested against a prior published document, a number of additional questions can arise which do not arise in the case of a prior use.

First, it may not be clear whether or not the document discloses a design as **applied to an article at all**. A trade catalogue containing photographs or illustrations of articles to which a design has been applied may be a clear enough case. But the publication in a document of a pattern or picture does not as such destroy the novelty of a design which consists of applying that pattern or picture to an article. For it to destroy the novelty of such a design, the paper publication must suggest explicitly or implicitly by context that the pattern or picture should be applied to an article.

Secondly, the pattern (if it is two-dimensional) or shape (if it is three-dimensional) of the design may not be clear from the

document. Particularly in a case where it involves a written description rather than an explicit picture or illustration, there may be room for argument as to the precise nature of the design which the document discloses, before one can go on to ask whether or not it is similar enough to the later design to destroy novelty.

Thirdly, a paper publication may be shielded from destroying the novelty of a later design registration by the special provisions of subss.6(4)-(5) of the RDA(A). These provisions allowed the owner of copyright in an artistic work to exploit his work so long as he did not apply it industrially to an article, without his own exploitation of it counting against the novelty of his own later application for a design registration covering the artistic work as applied to an article.

Does the document disclose a design applied to an article?

In order to destroy the novelty of a design registration, an earlier design must be published “in respect of the same or any other article”. Mere publication of the pattern which constitutes the design was therefore not sufficient to destroy the novelty of a design registration, which consisted of the application of that pattern to an article. In principle, the same holds true of the publication of a shape, although it is less easy to envisage cases where the publication of a shape does not implicitly convey the article to which that shape is to be applied. Thus, novelty may reside in the application of an old shape or pattern to new subject-matter. This was first laid down in the leading case of *Saunders v. Wiel*⁴². There, the design consisted of the handle of a spoon made to represent Westminster Abbey seen from a particular point of view. The design had actually been copied from a photograph of the Abbey.

The validity of the design was upheld, Bowen L.J. saying

“It seems to me that the novelty and originality in the design, within this section, is not destroyed by its being taken from a source common to mankind...The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all the world may resort. Otherwise, it would be impossible to take any natural or artistic object and to reduce it into a design applicable to an article of manufacture, without also having this consequence following, that you could not do it at all in the first place unless you were to alter the design so as not to represent exactly the original; otherwise there would be no novelty in it, because it would be said that the thing which was taken was not new. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew, nor an elephant unless you drew it and carved it of a kind which had never been seen. An illustration, it seems to

⁴² 1893 R.P.C 29

me, that may be taken about this is what we all know as the Apostles spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking the figures of the Apostles, but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles' figures so that they should be applicable to that particular subject-matter. How does a building differ from that? In no sense it seems to me.

It should be recalled that under the 1949 Act, if a pattern (or shape) has been published in respect of any article, the publication will destroy the novelty of any design which consists of the application of that pattern (or shape) to an article of any kind, however different it is from the kind of article to which the publication suggests that the design should be applied. However, the publication will not invalidate such later design registrations if it does not suggest the application of the pattern (or shape) to an article at all. Thus, a series of pictures published in a fine art catalogue would not destroy the novelty of a later design consisting of the application of one of those pictures to, say, the back of a chair, because a painting or picture simpliciter is not an "article". But the same pictures published in a catalogue of patterns for application to wallpaper would destroy the novelty of such a later design registration, because wallpaper is an article.

What design is disclosed by a prior published document?

Assuming that a prior published document does satisfy the requirement that it discloses a design, i.e. a shape or pattern, as applied or to be applied to an article, the next question may be what is the shape or pattern which it discloses? In some cases this will be clear, for instance where the publication contains explicit pictures or illustrations. However, it may be less clear and the disclosure may consist in whole or in part of written text which needs to be interpreted, or general instructions which can be put into practice in a variety of ways. In such cases the test to be applied is that borrowed from the hpre-1977 patent law of anticipation, i.e. that the prior art document must contain "**clear and unmistakable directions**" to make an article with the shape or pattern which is the same as, or similar enough to the registered design in suit to deprive it of novelty.

This was laid down in *Rosedale Associated Manufacturers Ltd v. Airfix Ltd.*⁴³ Lord Evershed M.R. said

"In this respect the test of prior publication of an alleged invention should, in my judgment, be no less applicable in the case of a registered design, and as regards the former, I venture to cite once more the oft-quoted language of Lord Westbury in *Hills v. Evans*⁴⁴: 'The antecedent statement

⁴³ 1957 RPC 239 (CA)

⁴⁴ (1862) 31 L.J. (Ch.) 457

must, in order to invalidate the sub-sequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments.’ By a like reasoning, to my mind, if a document is to constitute prior publication, then a reader of it, possessed of ordinary knowledge of the subject, must from his reading of the document be able at least to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head.”

On the same point Romer L.J. said:

“In *Flour Oxidising Co. v. Carr & Co.*⁴⁵ Parker J. (as he then was) said: ‘Where the question is solely a question of prior publication it is not, in my opinion, enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result. It must also be shown that the specification contains clear and unmistakable directions so to use it.’ These observations by Parker J. were cited with approval by Lord Dunedin in *British Thomson Houston Co. v. Metropolitan-Vickers Electrical Co.*⁴⁶, and again (when delivering the judgment of the Judicial Committee) in *Pope Alliance Corporation v. Spanish River Pulp & Paper Mills Ltd.*⁴⁷ In the latter case and at the same page Lord Dunedin posed the test as follows: ‘would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that Patent, if he had had the alleged anticipation in his hand, have said “that gives me what I wish”? *It is true that these citations were related to anticipation of inventions, but it seems to me that they apply by analogy to alleged anticipation by “paper publications” of registered designs.*”

It is not permissible to make a mosaic of a number of prior documents for the purpose of attacking novelty. If the attack on novelty is to succeed, the design must be disclosed in the single prior document. If, however, one document contains a reference to another document, the two may be read together.”

(Italics supplied; underscored in original)

38.4.8 Following the above discussion, the Full Bench proceeded to answer the issues referred to it thus:

“23. In view of the above discussion, the following conclusions in our opinion emerge : -

⁴⁵ (1908) 25 R.P.C. 428

⁴⁶ (1928) R.P.C 1

⁴⁷ (1929) 46, R.P.C. 23

(i) Existence of a design registered abroad in a convention country is not a ground under Section 19(1)(a) for cancellation of a design registered in India.

(ii) The provision of Section 44 does not have the effect of changing the literal interpretation of Section 19(1)(a) inasmuch as under Section 44, the foreign registered design becomes an Indian registered design, although, the date of registration of the foreign registered design which is registered in India will relate back and have retrospective effect from the date of application first made in the convention country abroad. Once, the foreign registered design becomes registered in India, the very fact that it is an Indian registered design it will be a previously registered design in India, and by virtue of the priority rule the same will be a ground for cancellation of a design subsequently registered in India on an application made after the date of the priority date given of the application made abroad for registration of the design in a convention country.

(iii) The benefit of foreign registered design after its registration in India for seeking cancellation of an Indian registered design under Section 19(1)(a) will only be available if the application for registration in India is made within six months of the date of the application made in the convention country abroad, notwithstanding there may be prior publication in this interregnum six month period.

(iv) In case, the application for registration in India is not made within the statutory permissible period of six months of having made the application abroad, then, the design registered in India in the meanwhile in six months period cannot be cancelled under Section 19(1)(a), though, the foreign registered design owner on proving of prior publication can have an effective defence to the infringement action filed by the Indian registered design owner and which defence against an infringement action is available vide Section 22 relying on the ground of prior publication under Section 19(1)(b) read with Section 4(b) of the Act.

(v) What is publication is essentially a question of fact to be decided as per the evidence led in each case. Existence of a design in the publication record/office of a Registrar of design abroad may or may not depending on the facts of each case amount to prior publication and there would be prior publication only if the prior registered design is made public and has that much necessary clarity as applied to a specific article capable of judged by the visual appearance or the eye of the mind, that by use of the said knowledge and information in the public record of the Registrar of design office, an article can be made using that design

which will be a piracy or violation of that design i.e. putting it differently unless and until there is complete clarity and understanding to the naked eye or the eye of the mind of the foreign registered design as found in the public record of the Registrar of design qua a specific article, it cannot be said that such public record will amount to prior publication.”

24. We therefore answer the reference that the ratio in the case of *Dabur India Ltd.*⁴⁰ by the Division Bench of this Court that existence of public record in the office of Registrar of design in a convention country abroad may or may not amount to prior publication inasmuch existence of a design in a public record of Registrar of design in a convention country abroad may or may not, depending on the facts of a particular case, amount or not amount to publication abroad, and which depends on the complete clarity available to the eye of the design found in the public record so that it can be said to be understood for being applied to a specific article. Each case has to be necessarily judged by putting the subject design with the articles side by side with the prior publication material and only after thoroughly scrutinizing the same any finding can be given of existence or non-existence of prior publication.”

38.5 *Relaxo Footwears Ltd v. Aqualite India Ltd*⁴⁸

38.5.1The appellant Relaxo Footwears Ltd (“Relaxo”, hereinafter) appealed, in this case, to a Division Bench of this Court, against the judgment of a learned Single Judge, whereby the application of Relaxo under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC), seeking interlocutory injunction was rejected by a learned Single Judge. The case of Relaxo was that footwear, manufactured by the respondent Aqualite India Ltd (“Aqualite”, hereinafter) infringed the registered design of the footwear manufactured by Relaxo. The learned Single Judge rejected the application for injunction, filed by Relaxo, on for considerations, *viz.*, that

⁴⁸ 294 (2022) DLT 429 : 2023 (93) PTC 14

- (i) market survey conducted by the parties, pursuant to an order dated 30th January 2019 passed by this Court, indicated that there were third-party products available in the market, similar to the suit design asserted by Relaxo,
- (ii) Relaxo plaintiff novelty in respect of the combination of colours and the placement of the label indicating the Maximum Retail Price (MRP),
- (iii) a Chinese Manufacturer had, vide letter dated 18 January 2019, stated that the strap of the footwear indicated in the suit design of Relaxo had been introduced in the market 7 to 8 years earlier and had been very popular since 2016 and
- (iv) the suit design was common to the trade.

38.5.2 The Division Bench held, on a visual comparison of the suit design asserted by Relaxo and the impugned design of the footwear of Aqualite, that the designs were almost identical. The only issue which remained for consideration, therefore, as noted by the Division Bench, was whether the suit design asserted by Relaxo was proscribed from registration under clauses (a) and (c) of Section 4 of the Designs Act. Before me, Section 4(c) has not been invoked. I do not, therefore, propose to refer to the findings of the Division Bench with respect to Section 4(c).

38.5.3 Apropos Section 4(a), i.e., on the aspect of novelty and originality, the Division Bench held that the learned Single Judge ought not to have directed, *suo motu*, a market survey to be conducted. Even if such a survey were conducted, held the Division Bench, the outcome would only indicate that the products were available in the market, and would not indicate on whether the design asserted by Relaxo lacked novelty and originality at the time when it was

registered. Paras 22 to 27 of the report proceed, thereafter, to hold thus:

“22. It is not unusual for small players to copy designs, which have become popular. It is not necessary for the proprietor of a design to pursue its remedies against each dealer/manufacturer selling infringing products. It is possible that the benefits of pursuing a particular infringer may not be commensurate with the cost and effort for doing so. It is understandable that a design holder would evaluate its options including on commercial considerations. A proprietor of a registered design does not forfeit its right merely because it has not enforced the same against all infringers. A design holder is not required to pursue the available remedies against all infringers in order to pursue its remedies against some infringers. It is open for the design holder to select the infringers that it wants to proceed against. The rights of a proprietor of a registered design is not diluted merely because there are multiple infringers; the design holder retains the right to interdict infringement of the registered design notwithstanding that it has not proceeded against some of the infringers.

23. In view of the above, this Court is unable to accept that a finding that the subject design lacked novelty and originality - which necessarily was required to be determined with reference to the date when the subject design was registered - could be arrived on the basis of the market survey without any evidence as to when the said products were introduced in the markets by their respective sellers.

24. The findings recorded in the impugned judgment indicate that apart from the market survey conducted by the parties, the learned Single Judge had also relied upon the letter produced from the Sales Manager of a Chinese manufacturer stating that the PVC strap used in the subject design was introduced seven to eight years ago. As noted above, *Relaxo had claimed novelty in the shape, configuration and surface pattern as illustrated in the images of the subject design. Relaxo had not claimed any novelty in respect of the strap of the footwear. The subject design indicates a surface pattern comprising of four parallels stripes on one half of the top surface. The central stripe runs at the center of the surface with three further stripes on one side. In addition, there is a white stripe running through a groove at center of the vertical surface of the footwear. The question whether the subject design is novel or original was required to be ascertained by determining whether it was published or available in public domain prior to the registration.*

25. *The letter/affidavit stating that the strap had been introduced in the market seven to eight years ago would be of little assistance in arriving at the prima facie finding in respect of the subject design as Relaxo had not claimed novelty in the design of*

the strap. Further, any letter or affidavit affirming the same, without any further material, would not be of much evidentiary value at this stage.

26. Aqualite had also claimed that a product bearing a similar design was available on the website (amazon.com) and therefore, the said design was available in the public domain prior to registration of the subject design. Aqualite had produced a printout of the screenshot from website (amazon.com) offering the aforementioned footwear (slippers) for sale. *A prima facie view of the said products does not indicate that the design of the said product is identical to the subject design. A plain view of the image of the product, as available, indicates that the configuration is not similar. The top surface of the slippers appears to be rough with a granular pattern; the sole is ventilated by several holes; the strap is completely different; and the top surface has only has two stripes in the center. It also does not appear that the vertical surface has any central groove or stripe.*

27. It is also important to note that the findings recorded by the learned Single Judge indicate that they are not premised on the printout from the website (amazon.com). In addition, it would also be essential for Aqualite to establish that the said product was available for sale prior to the registration of the subject design. Aqualite relies on a review by one of the customers dated 25-5-2017, hence, it was necessary to examine the evidentiary value of the said material as well.”

(Emphasis supplied)

38.5.4 Among the contentions advanced by Aqualite before the Division Bench was the plea that Relaxo’s design was merely a trade variant of designs prior known to trade. The Division Bench rejected the submission in the following passages from the report:

30. In terms of Section 4 of the Designs Act, a design, which is not new or novel or has been disclosed prior to registration or is otherwise not significantly indistinguishable from a known design or a combination of designs thereof, cannot be registered. For a design to be registered, it must be original and novel; not disclosed in any manner prior to registration; and it should be significantly distinguishable from a known design or a combination of known designs. Thus, a mere trade variant, which is a combination of known designs, would not be entitled to protection under the provisions of the Designs Act.

31. Indisputably, if a design is not significantly distinguishable from a known design or combination of designs, it cannot be registered by virtue of Section 4(c) of the Designs Act. However,

the market survey conducted by the parties would neither answer the question whether the subject design was original or novel at the time of registration, nor assist in determining whether the subject design was significantly distinguishable from the known designs at the time of registration of the subject design.

32. It is contended on behalf of Aqualite that the subject design is merely a trade variant. The learned counsel for Aqualite had placed strong reliance on the decision of the a Coordinate Bench of this Court in *Crocs*²² case . We are unable to accept the said contention.

33. In *Crocs*²², the court had noted that footwear generally, and sandals in particular, have a design constraint inasmuch as they have to necessarily cater to an irregular foot shape. The court had observed that the most constraining factor is the utility of footwear, which is dictated by comfort. And, given the constraints, footwear manufacturers have little play in creating new designs. Undoubtedly, there are constraints with regard to footwear design. Footwear designers have to function under the given constraints, however, the decision in *Crocs*²² cannot be read to mean that there can be no registrable design in respect of the footwear merely because they are fit to the shape of the foot. If the creative pursuits of footwear designers lead them to express themselves in novel designs that are merely discernable, there is no reason to assume that such designs would not be registrable. The decision in *Crocs*²² is pivoted on the prima facie finding of the court that the designs in respect of which the appellant (Crocs Inc.) claimed novelty were repetition of oldage footwear design with some variations, which apparently the court viewed as not significant. This is clear from the following observations made by this Court:

“44. What appears from the record is that the two designs, over which Crocs Inc claims novelty and originality are repetitions of age old designs, with some variations - in strap, etc. A design for an article that simulates a well known or naturally occurring object or person is unprotectible. Thus, a mere trade variation of an existing design does not entitle the originator of the design to protection through registration.”

34. The aforesaid observations cannot be read to mean that there can be no novel or original designs in respect of footwear and all designs would be merely trade variants.

35. The key question to be addressed is whether, prima facie, the subject design is indistinguishable from earlier known designs or combinations thereof. This Court is not persuaded to accept that Aqualite has produced sufficient material for this Court to conclude that the subject design is merely a trade variant and indistinguishable from known designs or a combination thereof.

36. The conclusion of the learned Single Judge is not based on the findings that the subject design is indistinguishable from designs that were known at the time of the registration. It is based on the, prima facie, opinion that there are products with similar designs currently available in the market. Thus the “prima facie” conclusion of the learned Single Judge is not well founded.

38.6 *Kamdhenu Ltd v. Aashiana Rolling Mills Ltd*⁴⁹

38.6.1 The design asserted by Kamdhenu Ltd (“Kamdhenu”, hereinafter), as the appellant before the Division Bench in this case pertained to a “Rod for Construction”. Registration was granted, for the said design, on 14th January 2013. Kamdhenu alleged that the respondent Aashiana Rolling Mills Ltd (“Aashiana”, hereinafter) had infringed the said design, in the rods made and sold by it. Aashiana filed an application under Order XIII-A of the CPC, as amended by the Commercial Courts Act, 2015, praying that Kamdhenu suit to be dismissed, as it had no real chance of success. This was predicated on the plea that the design asserted by Kamdhenu was bad for prior publication, as it was similar to British Standard BS 4449-2005, applicable to “Steel for the reinforcement of concrete – Weldable reinforcing steel – Bar, coil and decoiled product – Specification”, published in 2005, which provided for a surface pattern of regular repetition of a set of two ribs at different acute angles with axis and variation of the two angles being at least 10°. The elements in respect of which Kamdhenu had claimed novelty in the design asserted by it, it was submitted, were already residing in the elements described in BS 4449-2005 standard with a reasonable degree of specificity, thereby denuding Kamdhenu’s design of originality and novelty.

⁴⁹ 2022 (92) PTC 624

38.6.2 The learned Single Judge of this Court accepted Aashiana's submissions and dismissed, Kamdhenu's suit. Aggrieved, Kamdhenu appealed to the Division Bench.

38.6.3 The Division Bench identified the core issue arising for consideration before it as being "whether the published standard – British Standard BS 4449-2005 for B500C ("the BS design" hereinafter) – constituted prior publication of Kamdhenu design, so as to render the registration of the said design contrary to Section 4 of the Act". This being the controversy, the Division Bench held the surface pattern of the BS design to be relevant. The BS design, it was noted, depleted transverse release on the surface of the rod, attacked acute angles to the axis, with the angles of two ribs being at least 10°. These specifications, it was noted, were replicated in Kamdhenu's design, inasmuch as Kamdhenu claimed novelty in the pattern comprising a set of two transverse ribs with different acute angles, without indicating the degree of the two angles or any other special feature of the transfer ribs. The contention of Kamdhenu that a minute change in the angle of the two transverse ribs would alter the design was rejected as unpersuasive, as registration of the design had been obtained by Kamdhenu without specifying the inter-rib angles. Novelty has, thus, been claimed, not in respect of any specified angle between the ribs, but of a general pattern of two transverse angular ribs. In view of the BS design, the Division Bench held that such angular transverse ribs were not novel, but disclosed in prior existing standards.

38.6.4 Adverting to the aspect of "eye appeal" as relevant to appreciation of the design, the Division Bench held thus, in paras 32 to 34 of the report:

“32. It is apparent from a plain reading of the definition of the term “design” that features of shape, configuration or pattern as applied to an article are to be judged “solely by the eye”. In the present case, the finished article is a steel rod and the question whether the surface pattern is different from the patterns as published as a part of the British standard for B500C is required to be adjudged solely by visual examination.

33. The question of “eye appeal” has been considered in a multitude of judgments. In *Gaskell & Chambers Ltd. v. Measure Master Ltd.*⁵⁰, the learned Judge observed that “the decision whether the registered design and the designs of the alleged infringements are substantially different is for the court and cannot be delegated to the opinions of the witnesses. It must be decided on a comparison of the features which appeal to, and are judged by, the eye. To do this, the court must adopt the mantle of a customer who is interested in the design of the articles in question as it is the eye of such an interested person, the interested addressee, which is relevant”.

34. In *Steelbird Hi-Tech India Ltd. v. S.P.S. Gambhir*⁵¹, this Court observed that “it is rightly held in the cases decided that in the matter of novelty the eye is to be the ultimate test and the determination has to be on the normal ocular impression”. Furthermore, in *Western Engg. Co. v. Paul Engg. Co.* [*Western Engg. Co. v. Paul Engg. Co.*]⁵², the Calcutta High Court observed that “the definition itself lays emphasis on the fact that the sameness of the features is to be decided by the eye, that is to say, by seeing the two and getting a total synoptic view of the same. The sameness of features does not necessarily mean that the two designs must be identical on all points and differ on no point.... It is absurd to suggest that a slight variation between the earlier design and the subsequent design would make the two designs different....”

‘अस्यमेव जयम्’

38.6.5 Concurring with the learned Single Judge, the Division Bench, thus, proceeded to dismiss, Kamdhenu’s appeal.

38.7 *Pentel Kabushiki Kaisha v. Arora Stationers*⁵³

38.7.1 Pentel Kabushiki Kaisha (“Pentel”, hereinafter) sued Arora Stationers (“Arora”, hereinafter) alleging piracy, by Arora, of the

⁵⁰ 1993 RPC 76

⁵¹ 2014 SCC OnLine Del 821

⁵² 1967 SCC OnLine Cal 17 : AIR 1968 Cal 109

⁵³ 261 (2019) DLT 753 : (2019) 79 PTC 42 (DB)

design of Pentel's ballpoint pen, which stood registered in its favour *vide* registration dated 10th December 2013. It was alleged that the 'Montex Mastani' ballpoint pen of Arora infringed Pentel's design.

38.7.2 The Division Bench held, on seeing the two designs, that they were identical. The only question that remained to be considered, therefore, was "whether the suit design was substantially novel or original to make it significantly distinguishable from any known shape of features which already existed in ballpoint pens/writing instruments". On this, the learned Single Judge had held that the distinctive features alleged by Pentel were insufficient to pass the test of substantial novelty and originality, required by Sections 4 and 19 of the Designs Act.

38.7.3 The Division Bench, however, did not proceed to decide the issue of novelty and originality. The decision of the learned Single Judge was set aside on the sole ground that Arora, having itself applied for registration of the impugned design, which was identical to the suit design, could not be permitted to perform a *volte face* and contend that the suit design was not entitled to registration. The merits of the dispute regarding want of novelty and originality were not, therefore, addressed.

38.8 *Dart Industries Inc. v. Techno Plast*⁵⁴

38.8.1 Dart Industries ("Dart", hereinafter) sued Techno Plast ("TP", hereinafter), alleging piracy, by TP in its Signora range of products, of Darts registered design, held by it in respect of food grade plastic storage containers,. TP contested the validity of Dart's design on the

⁵⁴ 233 (2016) DLT 1 (DB) : 2016 (67) PTC 457 (DB)

ground of prior publication. This contention was accepted by the learned Single Judge who held that the design asserted by Dart contained merely trade variants over known shapes of similar articles and that, therefore, it lacked novelty and originality.

38.8.2 The Division Bench, in appeal, held that the onus to establish want of novelty and originality in Dart's design was on Arora. The division Bench approved the test, in this regard, postulated in *Rosedale*⁴³, according to which, "if a document is to constitute prior publication, then a reader of it, possessed of ordinary knowledge of the subject, must from his reading of the documents be able, at least, to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head". The Division Bench approved the test, enunciated by the learned Single Judge in the decision under challenge that "a person with ordinary prudence while seeing the designs/documents in question is able to relate, in his mind's eye, the same antecedents designs/statements without the necessity of making further experiments i.e. the moment he sees the design, he is able to at once say 'Oh! I have seen before'." The Division Bench went on to hold, on facts, that the learned Single Judge had painstakingly compared several designs which were subject matter of the dispute to conclude that the suit design, asserted by Dart, was part of public domain over which protection could not be claimed. The conclusion was found to be sustainable both on facts as well as in law.

38.9 *Telemechanique & Controls (I) Ltd v. Schneider Electric Industries SA*⁵⁵

⁵⁵ 94 (2001) DLT 865

38.9.1 This decision, rendered by a Division Bench of this Court, is irrelevant, insofar as the present controversy is concerned, only to the extent it deals with the contention, of the appellant Telemecanique, that the suit design asserted by the respondent was purely functional, with no aesthetic element. Paras 13 and 14 of the report deal with this aspect, thus:

“13. The third aspect to be considered arose out of the plea that functional shapes or mechanical devices cannot be subject matter of design registrations. Mr. Chidambaram, learned Senior counsel for the appellant, contended that the product in question has no aesthetic consideration and the products are purely functional in nature. These products are fitted in control panels and are thus claimed not visible and not having any aesthetic consideration. Reference was made in this behalf to Section 2(5) of the Designs Act, 1911 to contend that a design is defined not to include any mode or principle of construction or anything which is in substance a mere mechanical device. It is stated that the position remains the same under Designs Act, 2000 in terms of Section 2(d). This plea is being opposed by Mr. Mukul Rohatgi, learned senior counsel for the respondent contending that the respondent's product, in respect of which registration design exist, has features which are all visible when they are purchased and also when they are installed in the factories. The product is thus claimed to be visible to the naked eye. This design has existed for more than 8 years not only in India but in various countries of the world and has not been challenged for such a period. It is further contended on behalf of the respondents that in view of the observations in the case of *Moody v. Tree*⁵⁶ it is clear that Design Act was entitled to add to the Patents Act by making that which is not patentable the subject matter of the design.

14. The learned Single Judge has dealt with the proposition by reference to the judgments cited on behalf of the appellant *Stenor*³⁴ that the Design which is not visible cannot be registered. This judgment was sought to be distinguished both before the learned Single Judge and in the arguments before us by the learned Senior counsel for the respondent on the basis that the product in the present case is visible and does not require a magnifying glass to be seen as in the facts of that case. The other judgments cited and discussed before the learned Single Judge are *AMP Inc*³⁷ and *Niky*

⁵⁶ 9 RPC 333

*Tasha India P. Ltd. v. Faridabad Gas Gadgets P. Ltd.*⁵⁷. While considering the aforesaid two judgments the learned Single Judge has noted the contention advanced on behalf of the respondent herein that there has been no admission of the fact that the subject matter has no artistic conception. Another important aspect is that there is no claim of prior publication or user by the appellant and the Design has existed for a period of 8 years. The learned Single Judge, Therefore, in our considered view, rightly concluded that prima facie a case had not been made out at this stage of the respondents design registration being merely of functional shapes and devices. We have also been taken through the photographs on record and the contactors have also been produced before us. We are prima facie of the view that there are features in respect of the products which are visible to the eye and at this stage it cannot be stated without further scrutiny after evidence that despite the registration, the respondent should be disentitled to the benefits accruing from such registration.”

38.10 Crocs²²

38.10.1 Crocs possessed registrations in respect of designs for footwear which, according to it, were novel and original, with a unique shape, configuration, pattern, ornamentation and composition of lines. Crocs alleged that various other footwear manufacturers, who were respondents in the batch of appeals decided by the Division Bench of this Court, had pirated Crocs’ registered footwear designs, using designs which were so close to Crocs’ design that deliberate imitation was apparent.

38.10.2 The various respondents alleged the registration of Crocs’ design to be invalid. The respondents alleged that Crocs was claiming exclusivity in respect of the heel strap and the holed outsole. The holed outsole, it was contended, was a traditional water canal design, used in footwear down the ages, as the holes facilitated flow of water,

⁵⁷ AIR 1985 Delhi 136

imparting functionality and suitability, apart from providing air ventilation for the feet. The clog shaped design of the footwear, too, it was alleged, was traditional, dating back to an industrial shoe invented 80 years earlier. A third party, Bierk, was alleged to have adopted the said design in 1994 and to have made it available to the public since December 2002.

38.10.3 The matter came before a learned Single Judge of this Court, who held that, *prima facie*, Crocs' designs were in the public domain since 2002, prior to the priority date of 28th December 2003 claimed by Crocs. Crocs appealed to the Division Bench.

38.10.4 The Division Bench of this Court held the principles adopted by the Single Judge, i.e., firstly, that the design was required to be new and original; secondly, that it should not have been disclosed by means of prior publication to the public; and, thirdly, that it had to be significantly distinguishable from known designs or combinations of known designs, to be sound and acceptable.

38.10.5 Given the nature of the controversy, the Division Bench held that the Court was, in the circumstances, required to arrive at a *prima facie* conclusion regarding the aspect of prior publication. On this aspect, the Division Bench agreed with the Single Judge that, owing to the prior publication of Crocs' design in the UK, the grant of registration to the design in India was facially faulty and liable to be cancelled.

38.10.6 The reliance, by the Single Judge, from Crocs' own website, prior to the priority date of its design, was found to be justified.

38.10.7 The Division Bench also examined the aspect of vulnerability of Crocs' design to cancellation for want of novelty. The uniqueness of the design, noted the Division Bench, was in its ugliness. The Division Bench observed that the shape of the human foot is somewhat irregular, being narrow at the heel and broad at the toes and that, in having to cater to this irregular shape, footwear generally, and sandals in particular, have a design constraint. As such, there was limited play in creating new designs. Utility, dictated by comfort, was a predominant consideration in designing footwear.

38.10.8 The designs, over which Crocs claimed exclusivity, it was noted, were repetitions of age-old designs with some minor variations in strap etc. Such minor trade variations of existing designs did not render the changed design entitled to protection through registration. Knowledge, it was held, was incremental. Based on the materials relied upon by him, Division Bench held that the conclusion, of the Single Judge, that Crocs' design lacked novelty was reasonable.

38.10.9 The Division Bench, therefore, upheld the decision of the Single Judge.

38.11 *B. Chawla & Sons v. Bright Auto Industries*⁵⁸

38.11.1 The issue arising before the Division Bench of this Court in *B. Chawla*⁵⁸ was whether the decision of B. Chawla in respect of a mirror was a "new and original" design. Para 4 of the report identified the basis of the claim of novelty by B. Chawla in the design, thus:

"4. The novelty in the design in question, admittedly, is on account of the further curve in the sloping upper length side as it is not disputed that rear view mirrors, rectangular in shape with rounded

⁵⁸ AIR 1981 Del 195

edges, width side curved or slopping and the lower length side also slopping are commonly available in the market.”

38.11.2 In conjunction with the above, para 7 of the report identified the scope of inquiry before the court, on the aspect of novelty, thus:

“7. Akil Ahmed, partner of the respondent, and his witnesses, Jagjit Singh, Rajendra Singh and Sultan Singh submitted affidavits before the learned single Judge swearing that appellants' mirror was a common type rectangular mirror with a slight curve on the upper side and such like mirrors were available in the market. They also swore that there was no newness nor originality about the design. Mr. Anoop Singh, learned counsel for the respondents, has frankly conceded that no documentary or material evidence showing the availability of rectangular mirrors having a curve on either side in the slopping upper length side has been brought on the record and he would not press that mirrors of such like designs were actually available in the market at the time the appellants brought out their product in the market. Thus, *we are left with the only consideration whether a further curve on either side in the slopping upper length side makes the design in respect of rear view mirror a new or original design which the appellant were entitled to get registered and which is not liable to cancellation under Section 51-A of the Act*”

(Emphasis supplied)

38.11.3 Thereafter, paras 8 to 10 of the report read as under:

“8. In *Le May v. Welch*⁵⁹, Bowen L.J. expressed the opinion:

“It is not every mere difference of cut” - he was speaking of collars “Every change of outline, every change of length, or breadth, or configuration in a single and most familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry and to make the Patents, Designs and Trade Marks Act a trap to catch honest traders. There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article.”

And Fry L.J. observed:

“It has been suggested by Mr. Swinfen Eady that unless a design precisely similar, and in fact identical, has been used or been in existence prior to the Act, the design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne in mind that the Act may be applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families for

⁵⁹ [L.R.] 28 Ch. 24

their own use. It appears to me that such a mode of interpreting the Act would be highly unreasonable, and that the meaning of the words “novel or original” is this, that the designs must either be substantially novel or substantially original, having regard to the nature and character of the subject matter to which it is to be applied”.

9. *Similar view was expressed by Buckley L.J. on the question of quantum of novelty in Simmons*⁶⁰ at 494 in these words:

“In order to render valid, the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree”.

10. In *Phillips v. Harbro*⁶¹, Lord Moulton observed that *while question of the meaning of a design and of the fact of its infringement are matters to be Judged by the eye, (sic) it is necessary with regard to the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e., that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original. He went on to give the example saying, if it is common practice to have, or not to have, spikes in the soles of running shoes a man does not make a new and original design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants for use in any particular instance, and no patent and no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind. It was emphasized that it is the duty of the Court to take special care that no design is to be counted a “new and original design” unless it is distinguished from what previously existed by something essentially new or original which is different from ordinary trade variants which have long been common matters of taste workman who made a coat (of ordinary cut) for a customer should be left in terror whether putting braid on the edges of the coat in the ordinary way so common a few years ago, or increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design. On final analysis, it was emphasized that the use of the words ‘new or original’ in the statute is intended to prevent this and that the introduction or substitution of ordinary trade variants in a design is not only insufficient to make the design “new or*

⁶⁰ (1911) 28 RPC 486

⁶¹ (1920) 37 RPC 233

original” but that it did not even contribute to give it a new or original character. If it is not new or original without them the presence of them cannot render it so.”

11. *The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the ultimate arbiter. However, the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.”*

(Emphasis supplied)

38.11.4 From *B. Chawla*⁵⁸, therefore, the following principles emerge:

- (i) Trivial changes would not render the design new or original.
- (ii) Infringement and novelty are both to be tested by the instructed eye, which is aware of prior art.
- (iii) Introduction of ordinary trade variants did not render a design new or original.
- (iv) The court was required to strike a balance, by recognising the competing interests of novelty and originality being required to achieve statutory recognition and the interest of the trade and the rights of the person engaged in the trade, both of which were required to be protected.

38.12 *Castrol India Ltd v. Tide Water Oil Co. (I) Ltd*⁶²

⁶² (1996) 16 PTC 202

38.12.1 A decision which, owing no doubt in no small part to the intellectual eminence of its author, is regarded as authoritative on several aspects of design law and design piracy, is the decision of Ruma Pal, J., as a learned Single Judge of the High Court of Calcutta in *Castrol*⁶². In that case, Castrol India Ltd (“Castrol”, hereinafter) asserted the design of certain nonmetallic containers, in which it held registration, and in which it sold automotive lubricants. Castrol alleged that Tide Water Oil Co. (“Tide”, hereinafter) was also selling automotive lubricants in containers with a deceptively similar design. Tide contended, firstly, that the design of its containers was not similar to that of Castrol’s and, secondly, that the design of Castrol’s containers was neither novel nor original, as several manufacturers were selling oil in containers with similar designs. On the aspect of want of similarity, Tide contended that the colour, packaging and shape of the ridges on its container were different from those on Castrol’s.

38.12.2 Referring to the definition of “design” in Section 2(5) of the Designs Act, 1911 (with which it was concerned and which is *pari materia* with Section 2(d) of the Designs Act 2000), the High Court noted that the operative words in the definition word “shape, configuration, pattern or ornament” and that these were not protected in the abstract, but had to be applied to an article. Castrol’s suit design was described thus, in para 13 of the report:

“13. ... The statement of Novelty claimed originality in the shape, configuration and surface pattern particularly in the portion marked ‘P’ of the container. The design is of a container the body of which is rectangular in shape, the top of which is like a triangle, the tip of the triangle ending in the mouth of the container and the ‘back’ of the triangle supporting the handle. Just below the handle along the narrow side of the container are ridges which have been marked ‘p’ in the application. This is the design which has been registered.”

Para-16 of the report went on to compare the design of Tide's container with that of Castrol's:

“The respondent no. 1 sells some of its products in non-metallic containers the body of which is rectangular with a ridged side. The top is not quite as triangular as the petitioner's design. The top of the ‘triangle’ is flattened to a larger extent But like the petitioner's design the sloping side of the top supports the handle. The entire container is larger than the petitioner's and is capable of holding 5 litres as opposed to the 4 litres container of the petitioner. At the hearing the respondent no. 1 produced containers being utilised by Indian Oil Corporation Ltd. and Bharat Petroleum Corporation Ltd. The design of the container used by these two companies are similar in the sense that they have rectangular bodies with a ridged side, a triangle like top with a handle on the slope of the triangle and the top triangle ending in the mouth of the containers.”

Thereafter, the Court proceeded, in para 17 of the report, to observe:

“17. The difference in the petitioner's containers and the containers of the other concerns including the petitioner is primarily in the proportions of the rectangle and secondarily in the colours used. But broadly speaking there can be no doubt that the design of the respondent's container bears a ‘family resemblance’ to the petitioner's design (see : *Best Products Ltd. v. F.W. Woolworth & Company Ltd*⁶³ .). There can also be no doubt that the design used by the respondent in respect of the very class of goods in respect of which the petitioner's design is registered.”

38.12.3 Ruma Pal, J., went on to opine that, while adjudicating on a claim of design piracy, the court was first required to satisfy itself that protection was claimed in respect of the design, and not in respect of its method of manufacture (in which case the dispute would pertain to the realm of patent law, and not design law); secondly, to consider whether the design was in fact novel and not previously published and, thirdly, whether the design of the defendant's product was sufficiently similar to that of the plaintiffs, as to justify a finding of infringement or piracy. On this last aspect of piracy, the Court observed that every resemblance was not actionable at the instance of the proprietor of the registered design. The resemblance had to

⁶³ (1964) IX RPC 215

partake of the character of a fraudulent or obvious imitation, these being the definitive words employed in Section 22(1). On how “imitation” was to be gauged, paras 22 to 24 of the report are instructive:

“22. The next question is whether there is sufficient resemblance between the allegedly infringing copy and the petitioner's registered design to found an action for infringement under section 53 of the Act. *It is not every resemblance in respect of the same article which would be actionable at the instance of the registered proprietor of the design. The copy must be a fraudulent or obvious imitation. The word ‘imitation’ dose not mean ‘duplication’ in the sense that the copy complained of need not be an exact replica. The word has been judicially considered but not defined with any degree of certainty. In **Best Product Ltd.**⁶³ it was said in deciding the issue of infringement, it was necessary to break the article down into integers for descriptive purposes but in the ultimate result it is the article as a totality that must be compared and contrasted with the features of a shape and configuration shown in the totality observable from the representation of the design as registered. It was said that the Court must address its mind as to whether the design adopted by the defendants was substantially different from the design which was registered.*

23. *Apart from such overall resemblance in the design, the authorities have held that the Court is required to see in particular as to whether the essential part or the bases of the petitioner's claim for novelty forms part of the allegedly infringing copy. In **Best Products Ltd.**⁶³ the essential part of the registered design of a whistling kettle was found by the Court to be the shape of the spout and the cap applied to it. The Court said that the very form of the registration emphasised that it was in respect of the audible alarm characteristic that the application of the plaintiff's registered design found its intended exploitation. The audible alarm, according to the learned Judge necessarily assumed a primary significance. The difference between the audible alarm of the plaintiff's kettle and that of the defendant's kettle as being marked, the action for infringement was dismissed (see: also in the context **Phillips v. Harbro Rubber Company**⁶¹, and **Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd**⁶⁴.)*

24. The next task of the Court is to judge the similarity or difference through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser. Thus in the case of **Benchairs Ltd. v. Chair Center Ltd.**⁶⁵, where the article to which registered design was applied was a chair. Russel L.J. said:

⁶⁴ (1931) 48 RPC 268, 281

⁶⁵ 1974 RPC 429

“As we see it, our task is to look at these two chairs, to observe their similarities and differences, to see them together and separately, and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole: and apparently, though we do not think it affects our present decision, viewed as though through the eyes of a consumer or customer.”

Viewing the competing designs thus, the Court is required to examine whether the defendant's design is an obvious fraudulent imitation of the plaintiff's.

38.12.4 The Court went on, thereafter, to explain the concepts of “obvious” and “fraudulent” imitation, relying, for the purpose, on the decision of the Farwell J. in *Dunlop Rubber Co Ltd*⁶⁴, thus:

“26. In *Dunlop Rubber Co. Ltd.*⁶⁴, the meaning of the word ‘obvious’ and ‘fraudulent’ have been stated

“... ‘obvious’ means something which, as soon as you look at it, strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.”

27. In a later portion of the judgment it was said:

“...fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement.”

(Emphasis supplied)

38.12.5 Following the analytical sequence identified earlier in the decision, the High Court noted that there was no evidence, even *prima facie*, of the existence of any design, similar to Castrol's design, in the market, prior to its registration. Two similar containers, of Bharat Petroleum and the Indian Oil Corporation, cited by Tide, it was noted, were of later dates.

38.12.6 Thereafter, on the aspect of infringement, the High Court noted that Castrol had claimed novelty in respect of the shape, consideration and surface pattern, particularly the ridges on the container. No novelty having been claimed in respect of the shape of the colour of the container, the difference between the containers of Castrol and Tide with respect to these aspects were held to be immaterial to the issue of design piracy. Reliance was placed, for this proposition, on *Sommer Allibert (UK) Ltd v. Flair Plastic Ltd*⁶⁶.

38.12.7 Though Tide had not sought to contend that the design asserted by Castrol was purely functional, the High Court observed, in para 34 of the report, that "even if some function could be ascribed to the triangular top and handle the side ridges marked 'P' in the statement of Novelty is nothing more than ornamental". The High Court went on, in the succeeding para, to deal with the contention of Tide that a purchaser of the automotive lubricant sold in the container would not be influenced by the shape of the container in which the lubricant was sold. Ruma Pal, J. held, in para 35 of the report, that the matter was "not quite so simple":

"35. The respondents say that the purchaser would be interested in the oil and that the purchaser of lubricating oil would not be persuaded to buy a particular brand of oil by the shape of the containers in which the oil is sold. The matter is not quite so

⁶⁶ 1987 (25) RPC 599

simple. The fact that the design may not influence a purchaser of oil does not mean that the design plays no part the marketing of the product But if the argument of the respondent is taken to be correct there would be no scope for the Court assessing the matter from the point of view of the purchaser or customer.”

Thus, the High Court expressed the view that the issue of whether the purchaser of the product would be influenced by the design was not of particular relevance, as it did not imply that the design played no part in the marketing of the product. The import of this observation becomes clear from para 36 of the report, which squarely addresses the aspect of piracy, on facts:

“36. According to the statement of novelty filed by the petitioner along with its application for registration it would appear that the essential feature in the design was the ridged side. The other salient feature is the sloping top and positioning of the handle. The triangular top and ridged side are both striking features of the design which “catch and hold the eye”. Both these striking features have been included in the defendant's design in obvious and recognisable form.”

Replication of the essential features of the suit design, which confer novelty to it would, therefore, *ipso facto* indicate imitation. It was further significantly clarified, on this aspect, thus, in para 38 of the report:

“38. The test of deceptive similarity would be appropriate where the petitioner pleads passing off. But in cases of infringement of design the question is not whether the similarity has or is likely to cause confusion or deception of a purchaser but whether the similarity is an imitation of the registered design sufficient to destroy the exclusive right of user of the proprietor despite the fact that no confusion is or may be caused as to the source of the goods. Otherwise every registered design could be imitated with impunity merely by changing the colour of the two products thus obviating any confusion. In my view the respondents have so imitated the petitioner's design as to deprive the petitioner of the protection under the Statute.”

38.13 The takeaway

It would be useful to enumerate the principles which emerged from the decisions cited hereinabove, as a simple application of these principles is sufficient to arrive at a *prima facie* conclusion regarding the merits of the rival stands before me in the present case. As the definitive principles of law, which apply, are sufficiently clear from these decisions, I have avoided referring to interlocutory orders passed by Single Benches of this Court which, at best, can only have persuasive value in the interests of preserving consistency. The following principles, therefore, emerge:

- (i) The sole purpose of the Designs Act is protection of novel and original designs, for the benefit of the person who has expended time, research and labour in conceiving it.
- (ii) While ocular appeal is the definitive test of a valid design, what may appeal to one may appear bizarre to another. The corollary would, therefore, be that the Court, while examining the ocular appeal of a design, should not apply its own subjective standards.
- (iii) The Designs Act does not protect principles of operation or invention, which form subject matter of patent protection.
- (iv) A design, under the Designs Act, is not intended to stand on its own as an artistic work. It must be copied by embodiment in a commercially produced artefact. There can be no design, without an article to which it is applied. What matters is the visual image conveyed by the manufactured article. While applying these principles, the Court is required

to be guided by the definition of “article” and “design”, as contained in clauses (a) and (d) of Section 2 of the Designs Act.

(v) Clause (a) of Section 2 defines “article” as, *inter alia*, “any article of manufacture”. Any part of an article which is capable of being made and sold separately would be an article in itself.

(vi) “Design” is defined, in clause (d) of Section 2 as meaning *only the features of* shape, configuration, pattern, ornament or composition of lines of colours *applied to any article*. A design cannot, therefore, be a mere concept or idea. While it is true that the Designs Act protects the concept or idea, which is new or original, the right to such protection enures only when the idea becomes a “design” under the Designs Act, which requires its application to an article. *Sans* any article, therefore, there can be no design. The design must be intended to produce an article by industrial application, though the “design” is not the article itself, but “the conceptual design containing the features of a shape, configuration, pattern, composition of lines etc”.

(vii) The burden to show that a design is not entitled to registration for want of novelty originality is on the person so asserting. Novelty and originality necessarily predicate the absence of any prior publication of the design, or of the design having earlier been made known to the public.

(viii) Prior publication cannot be urged merely on the basis of a drawing or representation of a design, in the absence of any evidence to show that the said design, or drawing, had in fact

been applied to an article. The court has, therefore, to assess the existence of prior publication of the design asserted by the plaintiff, or its novelty and originality *vis-à-vis* prior art, on the basis of a design, published prior in point of time or known to the public prior to the registration of the suit design, which had been applied to an article. What was required to be visualised, in the minds' eye of the Court, while examining a plea of prior publication or want of novelty and originality *vis-à-vis* prior art is, therefore, not a prior design in abstract, but a prior design as applied to an article. The Court must, therefore, be able to visualise the article, as well as the design of the article, before coming to a conclusion on the aspect of prior publication or of novelty and originality *vis-à-vis* prior art. The “judging of the design” has, therefore, to be “in the form of the finished article solely by the eye”. It was for this reason that, in ***Bharat Glass Tubes***⁹, the Supreme Court upheld the view, of the learned Single Judge of the High Court, that prior publication, or want of novelty and originality *vis-à-vis* prior art, could not be urged on the basis of drawings or designs downloaded from the website of the UK Patent office, even if the said drawings or designs were substantially similar to the suit design.

(ix) Registration of a design amounts to facial satisfaction of the existence of novelty and originality in the design, as well as the absence of any prior publication thereof.

(x) Prior publication, in order to constitute a legitimate basis to challenge the validity of a design, had to be of the design itself. This is clear from the use of the words “that *it* has been published...”, employed in Section 19(1)(b) as well as the

words “a design *which has* not been disclosed to the public...” in Section 4 (a) of the Designs Act. Unless, therefore, the suit design itself has been earlier published, no case of invalidity of the suit design on the ground of prior publication is made out. Prior publication of a similar design, irrespective of the degree of similarity, would not suffice.

(xi) Publication must be “in a tangible form or use or in any other way”. Publication by use would arise where the design is translated into a finished article by an industrial process or means. The words “tangible form” and “any other way” are, however, of much wider import. Publication in a paper form, without the actual article being before the Court would also be subsumed within these expressions. However, the publication must be such as would enable the Court to visualise the article to which the design is intended to be applied. A publication which is wanting in clarity, and which requires actual application to an article for it to be completely understood cannot be regarded as “prior publication” on its own. “Tangible form” refers to a specific physical form or shape as applied to an article and not merely the ability to replicate, convert or give a physical shape of the design, though actual use of the article, to which the design supply, is not necessary. The design should not be on paper/document alone, but should be recognisable; in other words, it should have the same impact in the public as a finished article will, when judged solely by the eye. In other words, if the design is on paper then it must exist upon paper in such a way that the shape or other features of the article are made clear to the eye; the visual impact of the image should be

similar to that which would exist when the design is seen as applied to a physical object in tangible form.

(xii) “Publication” could, therefore, be either by prior use of the design, by selling or displaying articles to which the design has been applied or by paper publication of one sort or another.

(xiii) Prior publication of an earlier design of the proprietor of an existing design would not denude the existing design of novelty, or render it invalid for prior publication. The proprietor of a registered design is entitled to apply for registration of the same design, or of a design with modifications or variations not sufficient to affect its identity, in respect of another article. The later design does not get destroyed by the earlier design; however, the term of protection extended to both designs would be the same. Thus, evergreening of designs would be avoided. This legal position, recognised in *Reckitt Benckiser*³⁹, also finds place in Sections 6 (3) and (4) of the Designs Act

(xiv) A design which exists in the public domain, but the application of which, to an article, is new, would be novel. It is not necessary, therefore, that the design is “totally new”. An existing design, apply to an article in a new manner, in which manner it has not been earlier applied to any article, would also be entitled to registration. In order for prior publication to destroy novelty, it is essential that the publication must suggest, explicitly or implicitly by context that the design should be applied to an article. Further, the manner in which the design is

to be applied to the article should also be apparent from the representation of the design, cited as prior publication.

(xv) At the same time, the design, in order to be entitled to registration, *must* be new *vis-à-vis* prior art. The novelty must be substantial, not trivial or infinitesimal. Ultimately, it would be for the Court to compare prior art and the asserted design to determine whether the asserted design actually possesses novelty *vis-à-vis* prior art, or is merely the prior art with mild, trivial or trade variants.

(xvi) The test to assess whether the features of a design, which are not present in prior art, actually impart novelty or are mere trade variants, is the test enunciated in *Phillips*⁶⁷, which is that if it is common practice to have, or not to have, spikes in the soles of running shoes, a man does not make a new and original design out of an old type of running shoes by putting spikes into the soles.⁶⁷

(xvii) Prior publication, or novelty and originality of a design *vis-à-vis* prior art, has to be assessed on the basis of the features which impart, to the design, novelty and originality. Prior publication of stray features of the design, which do not impart novelty and originality to it, in an earlier document or at an earlier point of time, would not constitute “prior publication” or suffice to invalidate the design for want of novelty and originality.

⁶⁷ With greatest respect, the use of the words “or not to have” appears to defeat the test. If it is common practice *not to have* spikes in soles of running shoes, then, inserting spikes in soles of running shoes would definitely impart novelty. If, however, it is common practice *to have* spikes in the soles of running shoes, then the *Phillips* test would be correct, as insertion of spikes would merely be conforming to common practice, and not novel.

(xviii) Mosaicing of prior art designs is impermissible. Novelty cannot be attacked by combining individual elements of prior designs. The earlier design, cited as prior publication, and on the basis of which the novelty of the suit design is being questioned, must be disclosed in a single prior document, or more than one document, provided reference to one is contained in the other.

(xix) Registration of a design is article specific. What is protected is, therefore, not the artistic effort solely in the form of an idea, but as an embodiment in a commercially produced artefact.

(xx) While examining these aspects, the Court is required to be conscious of the fact that certain articles have, by nature of the function that they are required to perform, to necessarily possess common attributes as, for example, footwear. While it is difficult to envisage serious artistic improvements in the shape and configuration of footwear, given the fact that feet, as a rule, are similar in shape, footwear, which is otherwise novel in design is entitled to registration. In such cases, one cannot read the registration as invalid on the ground of want of novelty merely because, in respect of attributes which must necessarily be common to all such articles, there are prior examples. The Court has, therefore, in such cases, to discern the features which would lend, to such commonplace articles, novelty and originality, and examine whether those features have earlier been published in prior art.

(xxi) Imitation does not imply identity. In order to constitute piracy, a design need not be identical to another. The features which impart novelty to a design, in another article, would tantamount to infringement/piracy. The mere fact that, with respect to other, less significant details which do not impart novelty or originality to a design, there may be differences between the suit design and the impugned design, would not imply that the impugned design is not infringing in nature.

(xxii) While a purely functional design is not entitled to registration, a design which has both functional and aesthetic attributes, is so entitled.

(xxiii) While the perspective of the consumer, who views the suit design with an instructed eye which is aware of prior art, undoubtedly forms the definitive test to assess infringement, the issue of whether the customer would purchase the product for its aesthetic appeal for its utilitarian advantages is irrelevant. Where the suit design possesses aesthetic value, and the novel features that lend it such value are replicated in the defendant's design, piracy has taken place.

(xxiv) A defendant who seeks to register an identical design cannot question the validity of the design of the plaintiff, or its entitlement to registration.

(xxv) There is a subtle difference between the test which would apply when examining validity of the suit design *vis-à-vis* prior art and infringement of the suit design by the impugned design of the defendant. This difference arises essentially because the

validity of the suit design *vis-à-vis* prior art is being examined at a point of time prior to the registration of the suit design, whereas the aspect of infringement of the suit design by the defendant's design is examined *vis-à-vis* the certificate of registration of the suit design, and the features of novelty and originality which have been certified to be existing in the suit design. Prior publication would invalidate the suit design only if the suit design itself has been published prior in point of time. Invalidation on the ground of want of novelty and originality, on the other hand, does not require prior publication of the suit design itself. What it does require, however, is the existence of a prior design which, when applied to an article, would reveal that, except for trade variants, there is no difference between prior art and the suit design. While examining infringement, on the other hand, the Court is required to examine the design and the prior art *vis-à-vis*, as it were. The eye with which the aspect of infringement is examined is an instructed eye, which is aware of prior art and of the features which impart, to the suit design, novelty and originality *vis-à-vis* prior art. The comparison of the design of the defendant's product with the suit design has to be made from the perspective of such an instructed eye thus examined, if it is seen that the features which impart, to the suit design, novelty and originality *vis-à-vis* prior art, and as certified in the certificate of registration of the suit design, stand replicated in the design of the defendant, the defendant is guilty of piracy.

39. With this understanding of the law, we may proceed to examine the remaining issues with survive for consideration. For ease of understanding, perspective views of the lid of the (i) 8L *Svacch*

Deluxe Alpha pressure cooker (which is the shown design in the certificate of registration) (ii) the 5L *Svacch* Deluxe Alpha pressure cooker (iii) the 5L Impex Dripleless pressure cooker (iv) the YouTube Pressure Cooker, are provided thus:



8L *Svacch* Deluxe Alpha pressure cooker of plaintiff



5L *Svacch* Deluxe Alpha pressure cooker of plaintiff



5L Impex Dripleless pressure cooker of defendant



YouTube Pressure Cooker of plaintiff

40. The challenge to validity of the suit design on the ground of prior publication and want of novelty and originality

40.1 The only prior publication, cited by Mr. Jayant Bhushan, to justify invocation of Section 19(1)(b), is the YouTube video uploaded by the plaintiff on 11th November 2019. I have seen the video, and a physical sample of the pressure cooker covered by the said video has also been produced before the Court.

40.2 Section 19(1)(b) – and, equally, Section 4(b) – is completely inapplicable, as these provisions apply only where the suit design itself has been published prior in point of time to its registration. Prior publication is being sought to be asserted, by the defendant, on the basis of the pressure cooker advertised in the YouTube video. The design of the YouTube pressure cooker is not the same as the suit design. Once the two designs are different, irrespective of the degree of difference, no case of invalidity on the ground of prior publication within the meaning of Section 19(1)(b), can be said to exist.

40.3 Section 6(3): Section 6(3) of the Designs Act would also not apply, for the same reason. The provision applies only where the earlier design and the later design *are the same*. It provides that, if a design is registered in respect of an article, and the proprietor of the design applies to have *it* (meaning, the same design) registered in respect of one or more other articles in the same class, the registration *thereof* (again, meaning registration of the *same* design, albeit in respect of another article in the same class) shall not be invalidated on the ground of prior publication or want of novelty, on account of the earlier registration. As Section 6(3), on its terms, is inapplicable, no occasion arises to advert to the proviso thereto.

40.4 Section 6(4): The reliance, by Mr. Hemant Singh, on Section 6(4)(b) is also obviously misplaced. Section 6(4)(b) applies, expressly, where the design, of which registration is sought has either been itself registered *by another person* or consists of a registration previously registered *by another person* with minor modifications or variations. The provision has no application, therefore, where both registrations are by the same person, as in the present case.

40.5 Though neither Section 6(3), nor Section 6(4) would, therefore, apply, the plaintiff is, nonetheless, on *terra firma*. Even at a plain glance at the images of the lids of the Swachh Deluxe Alpha pressure cooker and the YouTube pressure cooker, provided in para 39 *supra*, reveals that they are completely different in shape. The list of the suit design is plateau shaped, with an upraised portion and flat sides. The upraised portion has a central circular depression extending almost to its outer edge, in which froth is to collect and evaporate. The lid of the pressure cooker advertised in the YouTube video is completely different in shape. The raised outer portion of the lid extends beyond

the surface of the lid and to the lower edge thereof. The lid is not plateau shaped and there is no flat outer base beyond the upraised wall of the plateau. Without meaning to be flippant, the shape of the lid of the pressure cooker advertised in the YouTube video resembles more a pizza than a plateau. The two designs are, therefore, different. Section 19(1)(b) cannot, therefore, apply.

40.6 For the same reason, the YouTube video cannot be cited as a basis to allege want of novelty and originality in the suit design. The difference in shape and configuration of the lid of the suit design, and the lid of the pressure cooker in the YouTube video is too marked to be attributed merely to trade variants. While it is true that there is a central depression in both the lids, for collection of froth, the outer surface of both the lids are completely different in shape. Where novelty has been certified to exist in the container with the lid as a set, and where the Court is conscious of the fact that novelty essentially exists in the lid, two lids, which are completely dissimilar in shape, cannot be regarded as justifying a finding of want of novelty and originality in the later lid, *vis-à-vis* the earlier. There has, clearly, being a conscious difference, effected in the shape of the lid, between the earlier pressure cooker which was advertised in the YouTube video, and the pressure cooker which is manufactured on the basis of the suit design. Bluntly put, the designs of the two lids are different. Indeed, they are so different – except for the central depressed portion – that the Court is satisfied, *prima facie*, that the change in design of the lid was a conscious act on the part of the plaintiff. It cannot be legitimately said, on a glance at the two lids, and on an ocular examination thereof, that, in designing the lid forming subject matter of the suit design, the plaintiff merely carried out certain trade variations *vis-à-vis* the lid which formed part of the pressure cooker

advertised in the YouTube video. *Vis-à-vis* the pressure cooker forming subject matter of the YouTube video, therefore, the Court is convinced, *prima facie*, that the pressure cooker forming subject matter of the suit design does not suffer from want of novelty or originality.

40.7 In arriving at its finding, the Court has kept itself mindful of the fact that what is being asserted, in the present suit, is a design, and not a patent. Functionally, it is quite possible that the lid of the pressure cooker in the YouTube video and the lid of the pressure cooker forming subject matter of the suit design, may perform identically. The spillage control capacity of both the lids might be equal. We are concerned, however, in design law, not with functional attributes, but with ocular attributes and eye appeal. Judged from the point of view of eye appeal, and applying the perspective of the instructed eye, which is aware of prior art, the difference in design of the lid of the pressure cooker forming subject matter of the suit design, and the lid of the pressure cooker advertised in the YouTube video, is starkly apparent. More so, this difference also partakes of the unique shape of the lid, designed to achieve optimum spillage control. In the most novel feature of the suit design, therefore, the suit design is clearly novel and original *vis-à-vis* the design of the pressure cooker forming subject matter of the YouTube video.

40.8 There is, therefore, *prima facie*, no substance in Mr. Jayant Bhushan's contention that the suit design is liable to be invalidated either on the ground of prior publication or on the ground of want of novelty and originality *vis-à-vis* prior art.

41. Re. allegation of functionality

41.1 The position in law, as it emerges from the judgments already cited hereinbefore, also serves to discountenance Mr. Jayant Bhushan's contention that the suit design is liable to be invalidated as it is purely functional in nature. A design is, as Mr. Hemant Singh correctly contends, capable of being both functional and utilitarian in nature. Its utilitarian attributes would entitle it to patent registration, and its aesthetic attributes would entitle it to design registration.

41.2 Mr. Bhushan sought to contend that a customer who desires to purchase a pressure cooker bearing the suit design would do so, not because of the aesthetic attributes of the lid, but because of its functional attribute in achieving spillage control. This precise argument, as advanced, was negated in *Castrol*⁶², by holding that the mere fact that the design had an overwhelming functional improvement over earlier designs, or a unique functional attribute, would not render it purely functional, or discredit its aesthetic attribute as one of the features which contributes to its saleability.

41.3 When compared with an ordinary flat lidded pressure cooker, the pressure cooker forming subject matter of the suit design has clear aesthetic attributes. To what extent it would appeal to the aesthete, may be a matter of debate. It is, after all, a pressure cooker lid, not a Picasso artwork. As already noted, in *Crocs*²², novelty, in the suit design of the footwear, was found to reside precisely in its ugliness! To the extent that the pressure cooker lid could have aesthetic features, I am convinced, on an examination both of the suit design as well as the actual pressure cooker to which the suit design has been applied, that it has aesthetic appeal, irrespective of the degree thereof.

From the point of view of eye appeal, which is the test to be applied as per Section 2(d), the suit design is entitled to registration.

42. The aspect of piracy/infringement

42.1 Mr. Jayant Bhushan contends that the design of the Impex Dripleless pressure cooker does not infringe the suit design. He submits that there are significant differences between the suit design and the design of the Impex Dripleless pressure cooker.

42.2 I am unable, *prima facie*, to agree.

42.3 The container of the defendants' Impex Dripleless Pressure Cooker is similar in shape to the container of the suit design. The shape of the lid of the pressure cooker forming subject matter of the suit design is also similar to the shape of the Impex Dripleless pressure cooker. Barring superficial differences in shape, there is no substantial difference between the two lids. The lid of the Impex Dripleless pressure cooker also has a central depressed portion, in which froth can collect and evaporate. Mr. Bhushan has not referred me to any earlier design, except the design of the pressure cooker in the YouTube video, which envisages such a central depressed portion for collection and evaporation of froth.

42.4 The differentiating features, as tabulated by the defendant in para 19 of the written statement and reproduced in para 17 *supra*, are clearly merely trade variants, or functional differences attributable to the different capacities of the pressure cookers. The heights of the lid and of the container are obviously because of the difference in capacity of the pressure cookers. If one compares the shape and

configuration of the lids of the 5 l and 8 l pressure cookers, except for the height of the containers and lids, there is no difference whatsoever. The same shape and configuration, but for insignificant trade variations such as the “width” of the raised wall of the lid, exist, between the suit design and the impugned design of the Impex Dripless Pressure Cooker of the defendant. All other differences, such as the “straight moulding of bakelite”, minor change in the shape of the handle, shape of the base, etc., are insignificant in the light of the overall shape and configuration of the pressure cooker itself, and, vis-à-vis the shape and configuration of the lid, which is the feature which mainly imparts novelty to the suit design, are even more inconsequential.

42.5 Most significantly, the defendant has clearly borrowed the idea of the central depressed portion of the lid for collection and evaporation of froth, thereby resulting in spillage control, from the idea devised by the plaintiff. No other source, from which the said idea was adopted by the defendant, has been brought to my notice. *Prima facie*, therefore, a clear case of piracy exists.

43. Conclusion

43.1 For all the above reasons, I am of the opinion that

- (i) the challenge to the validity of the registration of the suit design is, *prima facie*, devoid of substance,
- (ii) the suit design cannot be regarded as invalid even on the ground of being purely functional in nature and
- (iii) the design of the defendant’s Impex Dripless pressure cooker, *prima facie*, infringes the suit design, thereby making out a *prima facie* case of design piracy.

43.2 The defendant shall stand restrained, therefore, during the pendency of the present suit, from manufacturing or selling its Impex Dripleless range of pressure cookers or any other pressure cooker which, tested on the principles enunciated in this judgment, infringes, or results in piracy of, the suit design. All references to any such similar design, including the design of the Impex Dripleless Pressure cooker, shall forthwith be removed from all physical and virtual sites. The defendant shall also communicate with any e-commerce platforms on which pressure cookers bearing the impugned design are being put up for sale, directing them to forthwith discontinue such sale. All reasonable efforts, which could be made by the defendants towards that end, shall be made, and evidence in that regard shall be placed on record by way of affidavit within a period of two weeks from today.

43.3 IA 16467/2022 stands allowed accordingly.

43.4 Let this order be uploaded on the website of this Court within 24 hours.

C.HARI SHANKAR, J

APRIL 13, 2023

HJ