



2023:DHC:8764



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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**  
+ CS(COMM) 421/2023, I.A. 11325/2023, I.A. 17900/2023 &  
I.A. 18703/2023

HAVELLS INDIA LIMITED ..... Plaintiff  
Through: Mr. Sudeep Chatterjee, Mr.  
Kunal Vats, Mr. Sanyam Suri, Mr. Amir  
Vaid and Ms. Divitya Vyas, Advs.

versus

POLYCAB INDIA LIMITED ..... Defendant  
Through: Mr. Abhay Chattopadhyay, Mr.  
Abhishek Shrivastava, Ms. Yashi Agrawal  
and Mr. Abhinav Bhatt, Advs.

**CORAM:**  
**HON'BLE MR. JUSTICE C. HARI SHANKAR**

**J U D G M E N T ( O R A L )**

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**06.12.2023**

**I.A. 11325/2023 & I.A. 18703/2023**




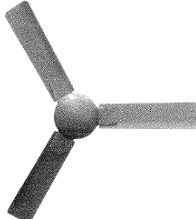
1. The plaintiff Havells India Ltd alleges infringement, by the defendant Polycab India Ltd, of three designs, registered in the plaintiff's favour by the Controller of Patents and Designs ("the Controller"). These registrations were granted with effect from 19 February 2016, 28 January 2021 and 2 February 2022. Each registration pertains to a ceiling fan. The ceiling fans manufactured and sold as per the registrations dated 19 February 2016, 28 January 2021 and 2 February 2022 were of the ENTICER, BIANCA ART and BIANCA ART – SANGANER models. For the sake of convenience,



this order would alternatively refer to them as the 2016, 2021 and 2022 suit designs. Novelty was certified, in respect of the 2016 suit design, as residing in its shape and configuration; in respect of the 2021 suit design in its shape, configuration and surface pattern and in the 2022 suit design in its surface pattern.

2. The various views of the aforementioned fans, as registered by the 2016, 2021 and 2022 registrations, may be provided thus:

2016 ENTICER design (Novelty residing in shape and configuration)



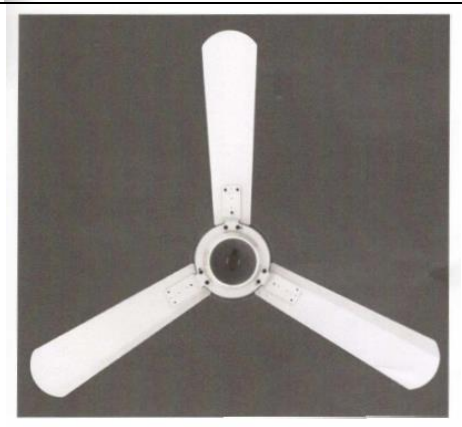
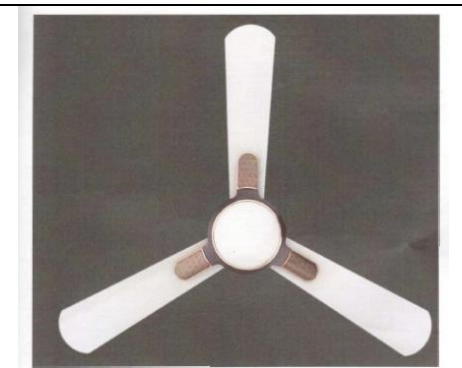
BOTTOM VIEW	
PERSPECTIVE VIEW	
SIDE VIEW	
TOP VIEW	



2023:DHC:8764






2021 BIANCA ART design (Novelty residing in shape, configuration and surface pattern)

FRONT VIEW	
BACK VIEW	
TOP VIEW	
BOTTOM VIEW	



2023: DHC: 8764








RIGHT SIDE VIEW	
LEFT SIDE VIEW	
PERSPECTIVE VIEW	

2022 BIANCA ART-SANGANER suit design (Novelty residing in surface pattern)

FRONT VIEW	
BACK VIEW	







TOP VIEW	
BOTTOM VIEW	
RIGHT SIDE VIEW	
LEFT SIDE VIEW	
PERSPECTIVE VIEW	

3. The plaintiff does not make any specific assertion with respect to any fan of the defendant which infringes the 2021 suit design. An omnibus allegation has been made to the effect that the defendant's ELEGANZ PLUS range of fans infringe the 2021 as well as 2022 suit designs. However, when one peruses the plaintiff and the documents









filed with the plaint with respect to actual comparisons, comparisons have been made only between the 2016 ENTICER suit design and the defendant’s ELANZA range of fans, and between the 2022 BIANCA ART-SANGANER suit design and the defendant’s ELEGANZ PLUS range of fans, to allege that the latter, in each case, infringes the former. To wit, para 7 of the plaint reads thus:

““7. That the Defendant, with an ulterior motive to come close to the Plaintiff, has blatantly copied all the essential features of the Plaintiff’s design including entire get-up, lay-out, colour scheme, patterns, ornamentation (trims), overall appearance, etc. A comparison chart between various fans of the Plaintiff and the impugned fans of the Defendant is reproduced below:

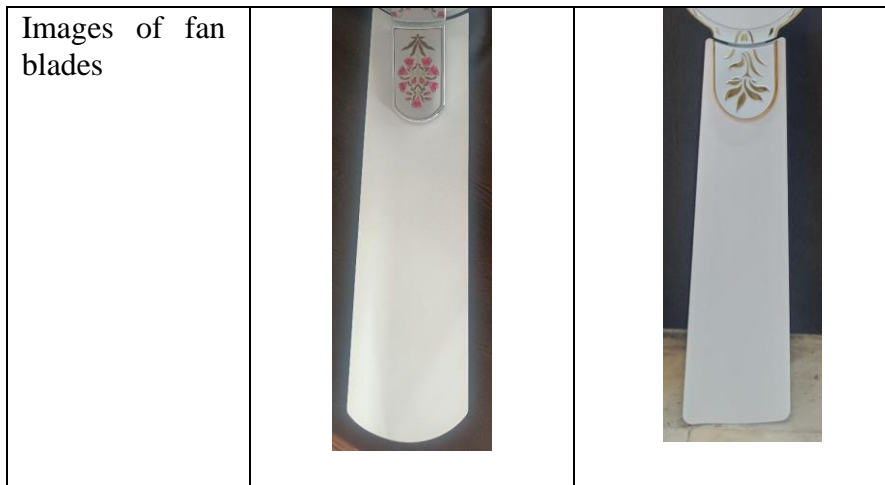
DESCRIPTION	PLAINTIFF’S ENTICER	DEFENDANT’S ELANZA
Ceiling Fan		
Images of fan motor		



<p>Images of fan blades</p>		
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DESCRIPTION	PLAINTIFF'S <u>BIANCA</u> <u>ART-</u> <u>SANGANER</u>	DEFENDANT'S <u>ELEGANZ PLUS</u>
<p>Ceiling Fan</p>		
<p>Images of fan motor</p>		





The defendant's ELANZA and ELEGANZ PLUS ranges of fans, corresponding to the 2021 and 2022 suit designs, are markedly different in appearance, with the BIANCA ART range of fans being entirely devoid of ornamentation, whereas the BIANCA ART-SANGANER range of fans have a marked surface pattern on the central motor as well as the blade projections. The BIANCA ART range of fans correspond to the 2021 suit design whereas the BIANCA ART-SANGANER range corresponds to the 2022 suit design. The 2021 suit design has been certified as having novelty in shape, configuration and surface pattern, whereas the 2022 suit design has been certified as having novelty only in the surface pattern. The comparative table above – which is the only comparison forthcoming in the plaint or the documents filed with it – compares the defendant's ELANZA fans with the plaintiff's 2016 ENTICER suit design and the defendant's ELEGANZ PLUS fans with the plaintiff's 2022 BIANCA ART-SANGANER suit design, but there is no comparison of any fan of the defendant with the 2021 BIANCA ART suit design. Mr Lall contends that, therefore, while the prayer in the plaint seeks injunctions against piracy of the 2016, 2021 and 2022 suit designs of





the plaintiff, factual foundation, in the plaint, is forthcoming only in respect of the 2016 and 2022 suit designs. Without comparing any fan of the defendant with the 2021 suit design, Mr Lall's contention is that no prayer for injunction against piracy of the said design can be maintained.

4. Mr. Darpan Wadhwa, learned Senior Counsel for the plaintiff clarified, during arguments, that the plaintiff was not asserting passing off for the purposes of the present application and was restricting its claim to piracy.

5. Predicated on the aforesaid allegations of piracy, the plaintiff, in the present suit, has sought a decree of permanent injunction, restraining the defendant from manufacturing, marketing or selling the ELANZA and ELEGANZ PLUS range of fans, which are alleged to infringe the 2016, 2021 and 2022 suit designs of the plaintiff, apart from delivery up, rendition of accounts and costs and damages.

6. IA 11325/2023, under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC) accompanied the plaint. *Vide* order dated 2 June 2023, this Court while issuing summons in the suit also issued summons in IA 11325/2023 and granted *ad interim* relief, by directing the defendant not to deal with the impugned fans or with any other design which was identical or deceptively similar to the 2016, 2021 and 2022 designs registered in the plaintiff's favour. That *ad interim* order continues to remain in operation till date.

7. on till date.



8. The defendant has filed a response to IA 11325/2023 and has independently filed IA 18703/2023 under Order XXXIX Rule 4 of the CPC, seeking vacation of the interim order dated 2 June 2023. The plaintiff has filed a response to the said application.

9. Both sides have been heard at length on IA 11325/2023 as well as on IA 18703/2023.

10. Mr. Darpan Wadhwa, learned Senior Counsel argued on behalf of the plaintiff and Mr. Lall, learned Senior Counsel addressed arguments on behalf of the defendant.

11. Impact of the *ad interim* order

11.1 I may, at the very outset, dispose of a somewhat surprising submission which was advanced by Mr. Wadhwa, learned Senior Counsel for the plaintiff, essentially with respect to the prayer for interim relief sought in respect of the 2021 and 2022 suit designs. Mr. Wadhwa sought to contend that, as a Coordinate Bench had already expressed a *prima facie* view in its order dated 2 June 2023, this Court ought not to take a different view in the matter.

11.2 The submission is obviously meritless. The view taken on 2 June 2023 was on the very first date, when summons were issued in the suit and the defendant did not even have an opportunity to place its response on record. The entire demographics, quite obviously, change once the defendant's reply is on record and both stands are, therefore, before the Court.



**11.3** Even otherwise, an order passed under Order XXXIX Rules 1 and 2 of the CPC is an interim order, which only expresses a *prima facie* view and does not bind the Court on later dates. The very purpose of Order XXXIX Rule 4 of the CPC is to enable the defendant to make out a case for vacation of the order passed under Order XXXIX Rules 1 and 2 of the CPC. While adjudicating an Order XXXIX Rule 4 application, therefore, the Court cannot afford to be influenced, to any extent whatsoever, by the *ad interim* order passed while issuing summons in the suit.

**11.4** As such, the submission of Mr. Wadhwa that the Court should be circumspect in adopting a view different from that which is reflected in the *ad interim* order of 2 June 2023, is rejected.

**12.** Insofar as the merits are concerned, it would be appropriate to examine the prayer for injunction with respect to each of the design registrations held by the plaintiff independently.

### **13. Certain basic principles**

**13.1** Piracy of a registered design is covered by Section 22 of the Designs Act. Sub-section (1)<sup>1</sup> thereof delineates the circumstances in

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<sup>1</sup> **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; or
  - (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
  - (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.



which piracy can be said to occur. Clause (a) deals with application, to an article in the class of articles in which the design is registered, of the said design, or of any fraudulent or obvious imitation thereof. Where such fraudulent or obvious imitation take place without the license or written consent of the proprietor of the registered design, piracy within the meaning of Section 22(1)(a) takes place. On the scope and ambit of the expressions “obvious imitation” and “fraudulent imitation” the following passages from the decision of Ruma Pal, J (as she then was, sitting as a Single Judge of the High Court of Calcutta) in *Castrol India Ltd v. Tide Water Oil Co. (I) Ltd*<sup>2</sup> are taken as expounding the correct legal position:

“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.**<sup>63</sup> 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.**<sup>63</sup> the essential part of the registered design*

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<sup>2</sup> (1996) 16 PTC 202



*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**<sup>61</sup>, and **Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd**<sup>3</sup>.)*

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.**<sup>4</sup>, where the article to which registered design was applied was a chair. Russel L.J. said:

*“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.”*

**13.2** Clause (b) of Section 22(1) deals with import and Clause (c) deals with publication, or exposing for sale, an article to which an obviously infringing design is applied to the knowledge of the person so exposing the article for sale. Admittedly, Clauses (b) and (c) of Section 22(1) would not apply in the present case. The aspect of design piracy has to be examined within the four corners of Section 22(1)(a).

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<sup>3</sup> (1931) 48 RPC 268, 281

<sup>4</sup> 1974 RPC 429



**13.3** “Design” is itself defined in Section 2(d) as meaning “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”, and excludes, statutorily, “any mode or principle of construction or anything which is in substance a mere mechanical device”, ... 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”. Though “new” is not defined in the Designs Act, the expression “original” is defined in Section 2(g) as meaning, in relation to a design, “originating from the author of such design”. Designs which are old in themselves and new in their application are also covered within the ambit of the definition of “original” designs.

**13.4** Section 19(1) renders a registration of a design liable to cancellation if the design has been previously registered in India [*vide* clause (a)], or if it has been published in India or elsewhere prior to the date of registration [*vide* clause (b)], or if it is not a new or original design [*vide* clause (c)], or if it is not registrable under the Designs Act [*vide* clause (d)], or if it is not a design within the meaning of Section 2(d) [*vide* clause (e)]. Clauses (d) and (e) refer, in the latter expressly and in the former by implication, to Section 4 and Section 2(d).



**13.5** Section 19(1)(d) envisages non-registrability of a design as one of the grounds on which its registration can be cancelled. The grounds on which a design would not be registrable are to be found in Section 4, which is titled “Prohibition of registration of certain designs”. Section 4 contains four clauses, numbered (a) to (d). They proscribe registration of designs which are not new or original [clause (a)], have been disclosed to the public by publication either in India or in any other country prior to the date of filing of the registration [clause (b)], are not significantly distinguishable from known designs or combinations of new known designs [clause (c)] or comprise scandalous or obscene matter [clause (d)]. If a design is not registerable for any one of these reasons, therefore, by application of Section 19(1)(d), the registration of such design would be liable to be cancelled.

**13.6** It is also well settled that, at the stage of consideration of the prayer for interlocutory relief, in order to avoid an injunction against use of its design, on the ground of piracy, a defendant is only required to lay a credible challenge, showing that the design of the plaintiff is vulnerable to invalidity. The challenge has nonetheless, to be credible, not incredible. Division Benches of this Court have applied this principle in the case of patents<sup>5</sup>, and there is no reason why it would not apply, *mutatis mutandis*, in the case of designs as well.

**13.7** There is only one authoritative pronouncement by the Supreme

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<sup>5</sup> Refer **F. Hoffmann La Roche Ltd v. Cipla Ltd**, ILR 2002 Supp (2) Del 551,





Court on the aspect of design piracy, which is *Bharat Glass Tube Ltd v. Gopal Glass Works Ltd*<sup>6</sup>. The following passages from the said decision merit reproduction:

“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. It has also laid down that if a design is not new or original or published previously then such design should not be registered. It further lays down that if it has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration then such design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known designs, then such designs shall not be registered. It also provides that registration can be cancelled under Section 19 of the Act if proper application is filed before the competent authority i.e. the Controller that the design has been previously registered in India or published in India or in any other country prior to the date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as defined in clause (d) of Section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has already been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. *These prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time. The new and original design when registered is for a period of ten years. Such original design which is new and which has not been available in the country or has not been previously registered or has not been published in India or in any other country prior to the date of registration shall be protected for a period of ten years. Therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is evident from the Statement of Objects and Reasons and from various provisions of the Act.* In this background, we have to examine whether the design which was registered on the application filed by the respondent herein can be

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<sup>6</sup> (2008) 10 SCC 657



cancelled or not on the basis of the application filed by the appellant. In this connection, Law of Copyright and Industrial Designs by P. Narayanan (4th Edn.), Para 27.01 needs to be quoted.

**“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.”*



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31. In the present case, the complainant relied on the correspondence of the German Company which produced the rollers and sold it to the respondent herein and it gave the proprietary right to the present respondent Company. “Proprietor” as defined in Section 2(j) of the Act means that any person who acquires the design or right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired. Therefore, this right to reproduce this design on an article has been given by the German Company to the respondent. But again the question is whether the complainant had discharged their burden to show that this design is not new or original. For this purpose, they only banked upon the letter of the German Company which prepared these rollers and there is no evidence to show that the design which was reproduced on glass sheets was either produced by any other agency. Therefore, *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.*

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33. What is required to be registered is a design which is sought to be reproduced on an article. This was the roller which was designed and if it is reproduced on an article it will give such visual feature to the design. *No evidence was produced by the complainant before the Assistant Controller that anywhere in any part of the world or in India this design was reproduced on glass or it was registered anywhere in India or in any part of the world.* The German Company only manufactured the roller and this roller could have been used for bringing a particular design on the glass, rexine or leather but we are concerned here with the reproduction of the design from the roller on glass which has been registered before the registering authority. Therefore, this design which is to be reproduced on the article i.e. glass has been registered for the first time in India and the proprietary right was acquired from the German Company. We have gone through the letter of the German Company and it nowhere says that this was reproduced on a glass sheet. *No evidence was produced by the complainant that this design was reproduced on a glass sheet in Germany or in India.* The contents of the letter are very clear. It shows that it was designed in 1992 and was marketed in 1993. *But there is no evidence to show that this design was reproduced on glass sheet anywhere in Germany.*



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36. Similarly our attention was also invited to Para 27.07 of Law of Copyright and Industrial Designs by P. Narayanan (4th Edn.) which reads as under:

**“27.07. Design as a conception or idea.** – *‘Design means a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied to an article by some manual, mechanical or chemical means mentioned in the definition clause. It is a suggestion of form or ornament to be applied to a physical body’. It is a conception, suggestion or idea, and not an article, which is the thing capable of being registered. It may according to the definition clause, be applicable to any article whether for the pattern or for the shape or configuration or for the ornament thereof (that is to say of the article) or for any two or more of such purposes. *The design, therefore, is not the article, but is the conception, suggestion, or idea of a shape, picture, device or arrangement which is to be applied to the article, by some one of the means to be applied to a physical body.**

*A design capable of registration cannot consist of a mere conception of the features mentioned in the definition, or in the case of an article in three dimensions, of a representation of such features in two dimensions. It must, in such a case, in order to comply with the definition, consist of the features as they appear in the article to which they have been applied by some industrial process or means. An applicant for registration of a design has to produce a pictorial illustration of the idea or suggestion which he has to establish as new or original.”*

*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.”*

37. *In the present case, the design has been reproduced in the article like glass which is registered. This could have been*



*registered with rexin or leather. Therefore, for registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied. As in the present case the design sought to be reproduced on a glass-sheet has been registered and there is no evidence to show that this design was registered earlier to be reproduced on glass in India or any other part of the country or in Germany or even for that matter in United Kingdom, therefore, it is for the first time registered in India which is new and original design which is to be reproduced on glass sheet. Therefore, the submission of learned Senior Counsel for the appellant, Mr Gupta cannot be accepted that this design was not new and original.*

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40. The question of eye appeal came up for consideration in *Interlego AG v. Tyco Industries Inc.*<sup>7</sup> In that case Their Lordships have laid down important test in the matter of visual appeal of the eye. It was observed as follows: (All ER pp. 959g-960a)

“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. (No. 2)*<sup>8</sup>, *Stenor Ltd. v. Whitesides (Clitheroe) Ltd.*<sup>9</sup> and *Amp Inc. v. Utilux Pty. Ltd.*<sup>10</sup>, and in the more recent Irish case of *Allibert S.A. v. O—Connor*<sup>11</sup> in all of which the claim to registration failed. It was one which was present in *Kestos case*, where the claim to the validity of the design succeeded. It is present in the instant case. One starts with the 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.*<sup>12</sup>:

<sup>7</sup> 1989 AC 217 : (1988) 3 WLR 678 : (1988) 3 All ER 949 : (1988) 16 RPC 343 (PC)

<sup>8</sup> [(1927) 44 RPC 503

<sup>9</sup> 1948 AC 107 : (1947) 2 All ER 241 : (1948) 65 RPC 1 (HL)

<sup>10</sup> 1972 RPC 103 (HL)

<sup>11</sup> [(1981) FSR 613

<sup>12</sup> (1987) FSR 283



‘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.’ ”

41. *One has to be very cautious, unless two articles are simultaneously produced before the court then alone the court will be able to appreciate. But in the present case no design reproduced on glass sheets was either produced before the Assistant Controller or before the High Court or before us by the appellant to appreciate the eye appeal. The appellant could have produced the design reproduced on glass sheet it manufactured in the United Kingdom or Germany. That could have been decisive.*

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45. The next evidence which was led by the appellant was a website (*sic*) which had been downloaded from the website of the United Kingdom Patent Office depicting patterns that may be applied to glass sheets. *No evidence has been produced to show that M/s Vegla Vereinigte Glaswerke GmbH had manufactured this design in glass sheet or not. It is only a design downloaded from the website of the Patent Office in UK and it is not known whether it was reproduced on glass sheet in UK or not.* In this connection, the Assistant Controller has only observed that he has made a visual comparison of UK registered Design No. 2022468 with the impugned Design No. 190336 and he was satisfied that both the designs make same appeal to the eye and there was sufficient resemblance between the two designs. Therefore, the Assistant Controller held that the impugned design was prior published and it could not be said to be new or original. The Assistant Controller further observed that the proprietor of this design had not been able to make a difference between the UK design and the present design. This was not accepted by the learned Single Judge of the Calcutta High Court and for the good reason. It was observed by the learned Single Judge as under:

“The illustrations in the form of drawings downloaded from the website of the United Kingdom Patent Office depict the patterns that may be applied to glass sheets. The patterns may be same but the illustrations do not give the same





visual effect as the samples of the glass sheets produced by the appellant in Court. There are also no clear unmistakable instructions or directions for production of glass sheets of the pattern illustrated.

The visual effect and/or appeal of a pattern embossed into glass sheets by use of embossing rollers could be different from the visual effect of the same pattern etched into glass sheets manually. Respondent 1 has not considered these factors.

The order impugned considered with the materials on record, including in particular the computer printouts clearly reveals that Respondent 1 has only compared the pattern and/or configuration and considered the visual appeal thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, Respondent 1 has not considered the visual appeal of the finished product.

There are no materials on record to show that the design had previously been applied to glass sheets. On the other hand, an affidavit was sworn on behalf of the appellant by a Liaison Executive affirming that he had ascertained that the proprietor of the design registered in the United Kingdom had never manufactured glass sheets of the design registered.”

From this it appears that in fact the pattern of the design which is reproduced on the glass sheet and the design and the pattern which was reproduced on the glass sheet in the United Kingdom was not common.

46. The affidavit sworn on behalf of the respondent herein, the Liaison Executive that he had ascertained from the proprietor of the design registered in the United Kingdom that they have never manufactured glass sheet of the design registered. This affidavit evidence of the Liaison Executive of the respondent Company has remained unrebutted. Secondly, the learned Assistant Controller has not properly compared the two designs that on what comparison he found that the same configuration or pattern are identical with that of the impugned design. Simply by saying visually one is liable to commit the mistake but if the comparison is to be judged whether the pattern of the United Kingdom and that of the present pattern is three dimensional or not. Both the designs were placed before us as was done before the High Court also. The learned Single Judge recorded its finding after seeing both the





designs that there is distinguishable difference between the two. Similar attempt was made before us to show that both the designs i.e. one that is published in the United Kingdom and the impugned design are identical.

47. We have seen the original glass pattern produced before us and the photograph of the pattern produced on record. *If the complainant was serious about the same, it could have produced the pattern which was reproduced on the glass sheet in the United Kingdom and the pattern which is reproduced on the glass sheet by the rollers of the design produced before us. If these two glass sheets were placed before the learned Single Judge or before us we would have been able to record the finding.* The finding recorded by the Assistant Controller is most inconclusive and it does not give us any assurance that it was a proper comparison of the two patterns by the Assistant Controller. The learned Single Judge of the Calcutta High Court had occasion to go through both the patterns and found that there is no comparison. Likewise, the glass sheets were placed before us with all dimensions along with a copy of the printout of the United Kingdom design and we are of the opinion that there is no comparison between the two. From the visual appeal placed before us, the learned Single Judge has rightly concluded that there is no comparison of pattern or configuration of the two designs. We fully agree with the view taken by the learned Single Judge. Hence on this count also the view taken by the Assistant Controller does not appear to be correct and the view taken by the learned Single Judge of the Calcutta High Court is correct.”

(Emphasis supplied)

**13.8** These passages elucidate the following important principles which, if applied, would simplify, to a great extent, the exercise of determining whether piracy does, or does not, exist in a given case:

- (i) The Designs Act protects the idea, not the article. The idea cannot, however, be abstract, but has to be one which is to be applied to an article. It cannot be a mere conception shape, or size, or configuration. Where the article to which it is to be applied is three dimensional, the design cannot be a mere two



dimensional concept.

(ii) Principles of invention are protectible under the Patents Act, not the Designs Act.

(iii) The idea, to be entitled to protection, must be new and original.

(iv) In deciding whether the design is new and original, the Court must visualize the design as applied to the article.

(v) The matter has to be examined on the basis of eye, or visual, appeal. Emphasis has to be on the visual image conveyed by the manufactured article. The visualization has, therefore, to be of the design as applied to the article to which it is intended to be applied, and not of the design in abstract. If there is no prior application of that design to the article to which it is intended to be applied, the design is not invalid for prior publication, or for want of novelty or originality.

(vi) Novelty and originality have to be decided on the basis of whether *that design* – and not merely one which is confusingly or deceptively similar – has earlier been applied to the article to which it is intended to be applied.

(vii) *Thus, there is a significant difference between the test to be applied while assessing the validity of a registered design as being novel or original, and that to be applied when examining whether another design infringes it. Novelty and originality has*



*to be tested by examining whether that design has earlier been applied to the article to which it is intended to be applied.*

(viii) (This test was clarified in later decisions which hold that it is not permissible to replicate a prior published designs with mere minor or ordinary “trade variants”, and claim novelty and originality. The test is ultimately of visual appeal. When assessing novelty and originality *vis-à-vis* prior art, the matter is to be assessed from the point of view of the instructed eye, which is aware of the prior art. As against this, when assessing similarity for the purposes of infringement, or piracy, the eye is “uninstructed”, and merely compares one design with another.)

(ix) The Court must ideally have, before it, the two articles, i.e., the article bearing the design under consideration and the article on which the design is stated to have been applied prior in point of time, and which, therefore, is cited as “prior art”.

**13.9** Thus, what is protected by the Designs Act is the novelty and originality which resides in the registered design. If, *vis-à-vis* prior art, there is no novelty or originality in the suit design, it becomes incapable of protection. If the defendant’s design is an obvious or a fraudulent imitation of the suit design within the meaning of Section 22(1), the plaintiff becomes entitled to an injunction against the continued use of the said design.

**13.10** This Court has also, through two Full Bench judgments, in



*Carlsberg Breweries A/S v. Som Distilleries & Breweries Ltd*<sup>13</sup> and *Reckitt Benckiser Ltd v. Wyeth Ltd*<sup>14</sup> thrown considerable light on the Designs Act, and its salient features.

**13.11 *Carlsberg Breweries***, rendered by a Bench of five Hon'ble Judges, held 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 for registration,

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<sup>13</sup> AIR 2019 Del 23 (FB): 256 (2019) DLT 1 (FB)

<sup>14</sup> AIR 2013 Del 101 (FB): 198 (2013) DLT 521 (FB)



- (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.

**13.12** The decision in *Reckitt Benckiser* is of greater significance, 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.

**13.13** A Division Bench of this court held, in *Dabur India Ltd. v. Amit Jain*<sup>15</sup>, 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 was referred to a Full Bench of three learned Judges for examination, resulting in the judgment in *Reckitt Benckiser*.

**13.14** 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

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<sup>15</sup> (2009) 39 PTC 104



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.

**13.15** 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*, 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)

**12.16** The Full Bench, thereafter, went on to refer to the judgment of the Supreme Court in *Bharat Glass Tube* 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 a 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.”

**12.17** 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.** (infra)].”*

(Emphasis supplied)

The Supreme Court, in **Bharat Glass Tube**, it was observed, held that “the documents downloaded through Internet from the website of the U.K. Patent Office did not add that amount of clarity for the same to be said to be prior publication for seeking cancellation on the basis of such alleged prior publication of a design registered in India”.

**12.18** The 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**:

*“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**<sup>42</sup>. 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 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 pre-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.*<sup>16</sup> 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

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<sup>16</sup> 1957 RPC 239 (CA)





Westbury in *Hills v. Evans*<sup>17</sup>: ‘The antecedent statement 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*<sup>18</sup> 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.*<sup>19</sup>, and again (when delivering the judgment of the Judicial Committee) in *Pope Alliance Corporation v. Spanish River Pulp & Paper Mills Ltd.*<sup>20</sup> 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.”*

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<sup>17</sup> (1862) 31 LJ (Ch) 457

<sup>18</sup> (1908) 25 RPC 428

<sup>19</sup> (1928) RPC 1

<sup>20</sup> (1929) 46 RPC 23



(Italics supplied; underscored in original)

**12.19** 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 :—

(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.*<sup>21</sup> 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.”

## **12.20** The Full Bench of this Court in *Reckitt Benckiser Ltd v. Wyeth*

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<sup>21</sup> *Dabur India Ltd v. Amit Jain*, (2009) 39 PTC 104 (Del)



*Ltd*<sup>22</sup> has analogised the principles of obvious and fraudulent imitation, as envisaged in Section 22(1) with the principles of confusing and deceptive similarity which find place in the Trade Marks Act. In the case of the Designs Act, however, this aspect has to be examined keeping in mind the definition of design as contained in Section 2(d) and the law enunciated in ***Bharat Glass Tube***. The entire integrity of a design, as defined in Section 2(d) lies in its visual or eye appeal. As such, whether examining the aspect of piracy of the plaintiff's design by the defendant's design or novelty or originality of the plaintiff's design *vis-à-vis* prior art, the Court has to examine the matter from the point view of visual aspect or eye appeal, keeping in mind the features of the plaintiff's design which have been certified as novel and original while granting registration to it.

**12.21** Ordinary or minor trade variants are required to be ignored while examining either the aspect of piracy of a registered design by another or novelty of a registered design *vis-à-vis* prior art. Further, while examining the aspect of novelty of a registered design *vis-a-vis* prior art, the matter has to be viewed from the point of view of the instructed eye, which is aware of prior art. The following passages from the judgment of the Division Bench of this Court in ***B. Chawla & Sons v. Bright Auto Industries***<sup>23</sup> encapsulate the legal position in this regard:

“8. In ***Le May v. Welch***<sup>24</sup>, Bowen L.J. expressed the opinion:

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<sup>22</sup> AIR 2013 Del 101 : 198 (2013) DLT 521 (FB) : 2013 (54) PTC 90 (FB)

<sup>23</sup> AIR 1981 Delhi 95

<sup>24</sup> (1884) 28 Ch. D. 24



“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 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 v. Mathieson and Cold*<sup>25</sup>, 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”.

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<sup>25</sup> (1911) 28 RPC 486 at 494



10. In *Phillips v. Harbro Rubber Company*<sup>26</sup>, 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 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

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<sup>26</sup> (1920) 37 RPC 233



trade and right of those engaged therein to share common knowledge be also protected.”

**13** One may now proceed to deal with the individual suit designs which, according to the plaintiff, have been infringed by the defendant.

**14.** Re. 2016 ENTICER suit design:

**14.1** Mr. Wadhwa has drawn my attention to the tabular comparison between the plaintiff’s ENTICER fan which corresponds to the 2016 design registration and the defendant’s ELANZA fan, as contained in para 7 of the plaint, as reproduced in para 3 *supra*. He has also produced, before me, physical samples of the central motor head as well as the blades of both the fans, to demonstrate that they are nearly identical. All relevant features of the 2016 ENTICER suit design have, according to Mr. Wadhwa, been replicated in the defendant’s ELANZA series of fans and, even if there are any minor differences, they are merely in the nature of ordinary trade variants. Mr. Wadhwa points out, particularly, that the USP of the plaintiff’s ENTICER series of fans is their minimalism and the fact that they provide a seamless overall canvas with a metallic frame, both of which features stand replicated in the defendant’s ELANZA series of fans.

**14.2** Responding to Mr. Wadhwa’s submissions, Mr. Lall contends, in the first instance, that the Court cannot decide the aspect of design piracy by comparing the defendant’s products to the plaintiff’s products. He submits that the comparison has to be between the defendant’s products, containing the allegedly infringing designs, with





the suit designs. In other words, the comparison has to be product-to-design based and not product-to-product based.

**14.3** I may straightaway note that this contention, as put over by Mr. Lall, is not entirely correct. Though, unquestionably, the aspect of design piracy has to be decided by comparing the design of the allegedly infringing defendant's product with the registered suit design (and, therefore, to that extent product-to-design based), the Court is not prohibited from viewing the actual product corresponding to the suit design while examining the aspect of piracy. If there is no dispute that the product of the plaintiff corresponds to the suit design then, in fact, the decision of the Supreme Court in *Bharat Glass Tube* advocates actual viewing of the product by the Court when arriving at a decision on the aspect of design piracy. The reason is, quite obviously, that pictorial or photographic depictions may not, in every case, enable the Court to arrive at a correct visual impression of the suit design. The Court, while examining the aspect of design piracy, is not to consider the suit design in abstract, but as applied to an article. Of course, viewing of the products can only be undertaken if there is no dispute that the product produced before the Court corresponds to the design registration.

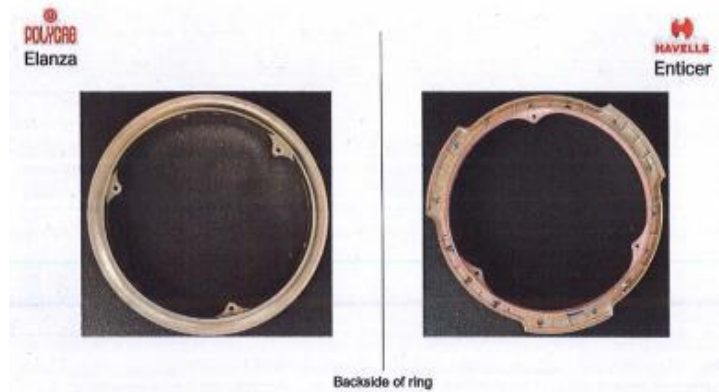
**14.4** On the aspect of similarity between the 2016 suit design and the defendant's ELANZA range of fans, Mr. Lall has drawn my attention to the following paragraphs from the reply from the written statement filed by the defendant by way of response to the plaint:

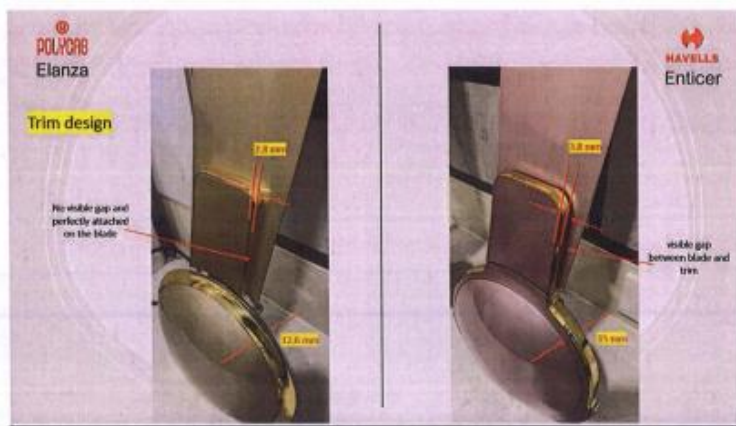
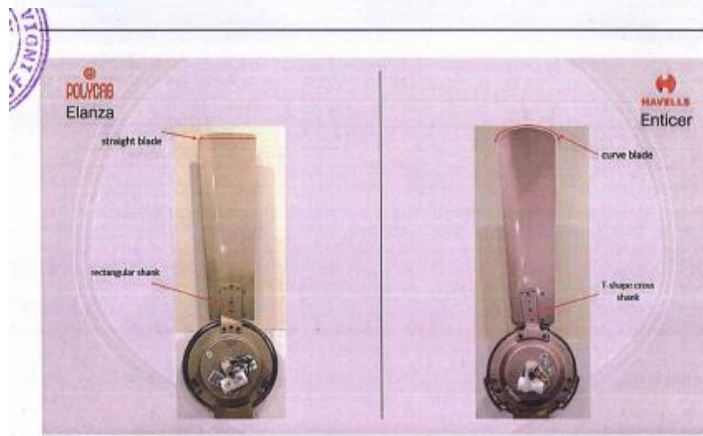
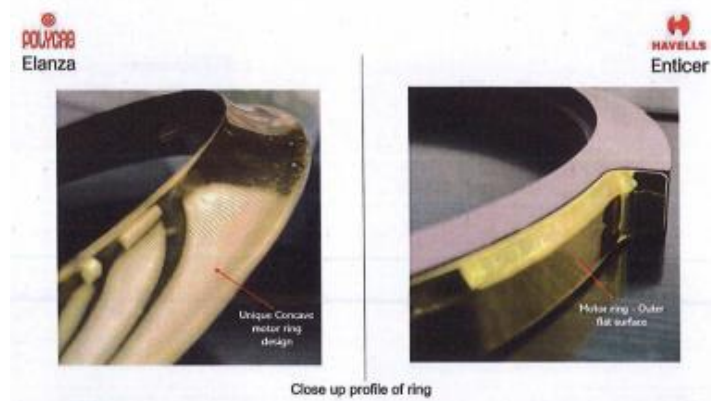
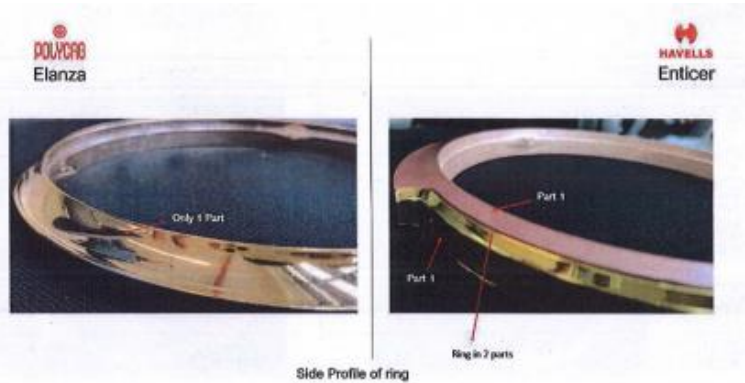
“b. It is respectfully submitted that the overall shape,



configuration and visual appeal of Defendant's 'Elanza' series of fans are substantially different and visually distinguishable from the Plaintiff's 'Enticer' series of fans. It is submitted that the Plaintiff has failed to compare essential and characterizing features of 'Elanza' and 'Enticer'. A comparison of the essential and characterizing features of the Defendant's 'Elanza' and Plaintiff's 'Enticer' is provided hereinbelow:











Mr. Lall has particularly drawn my attention to three facts, to demonstrate the differences between the 2016 suit design and the design of the defendant's ELANZA range of fans. In the first place, he submits that the central motor head of the 2016 suit design is not a perfect circle, but contains three protrusions, which seamlessly blend into the blades of the fan. As against this, he submits that the central motor head of the ELANZA range of fans are perfect circles without protrusions and are, therefore, clearly distinguishable from the motor heads of the 2016 suit design. Secondly, he submits that the blades of the fan in the suit design are tapering, whereas the blades of the ELANZA range of fans are not tapering. The third difference that Mr. Lall seeks to point out is that the outer edge of the blades of the fans comprising the 2016 suit design are straight, whereas the blades of the ELANZA range of fans are curved at the outer edge.

**14.5** Mr. Wadhwa seeks to submit, *per contra*, that on a visual appeal, there is no difference whatsoever between the 2016 suit design of the plaintiff's ENTICER range of fans and the design of the defendant's ELANZA range of fans. The differences to which Mr.



Lall draws attention, he submits, are ordinary trade variants which do not impact the overall visual appeal of the two fans. A glance at the fans would reflect that all essential features of the plaintiff's ENTICER range of fans are replicated in the defendant's ELANZA range of fans. Both fans are minimalistic, with limited design features. Even the shape and contour and colour combinations used on the protrusions, from the central motor head to the wings, of the ELANZA range of fans are nearly identical to those which are found in the 2016 suit design relating to the ENTICER range of fans of the plaintiff. He submits that the striking resemblance between the two designs would be apparent from the table reproduced in para 3 *supra* and that in the face of such striking resemblance, there can be no question of the plaintiff being disentitled to an injunction as sought.

**14.6** Having perused the 2016 suit design *vis-à-vis* the defendant's ELANZA range of fans, and having also seen physical samples of the plaintiff's ENTICER and the defendant's ELANZA range of fans, I find that, when viewed from the point of view of eye/visual appeal, there is hardly any difference between the two fans. The differences which are sought to be highlighted in the paragraph from the written statement of the defendant, reproduced in para 14.4 *supra*, are miniscule differences, often are restricted to differences in length or width in millimetres. When examining the aspect of design piracy from the point of view of visual appeal, the Court does not proceed with a foot rule in hand, to measure the length and breadth of the various features of the suit design *vis-à-vis* the alleged infringing design of the defendant. The overall impression of the design of the



defendant's product, *vis-à-vis* the suit design, is what matters. Mild differences in the lengths, widths, thickness, etc of the defendant's ELANZA range of fans, *vis-à-vis* the suit design, as highlighted in the afore-extracted paragraph from the written statement are, therefore, of no relevance whatsoever.

**14.7** Equally, the fact that the central motor head in the 2016 suit design may contain projections, whereas the central motor head of the defendant's design contains no projections and is a perfect circle, cannot really make a difference. This distinction, too, hardly strikes the eye, when one views the fan as a whole.

**14.8** It has to be borne in mind that the certificate of registration of the 2016 suit design certifies novelty as residing in the overall shape and configuration of the fan. What has to be seen, therefore, is whether, when examined from the point of view of eye/visual appeal, the shape and configuration of the defendant's ELANZA range of fans is, or is not imitative, within the meaning of the expression as clarified in *Castrol*, of the shape and configuration of the suit design. To reiterate, it is the overall shape and configuration which matters. The Court is not supposed to fragment the shape or configuration of the suit design into minor individual elements and start measuring lengths and breadths in order to arrive at a finding regarding imitation/similarity.

**14.9** The features pointed out by the defendant in the afore-extracted paragraph from the written statement as distinguishing the 2016 suit design from the design of the defendant's ELANZA range of fans, in





fact, defeat, rather than support, the case of the defendant. It is clear, from a reading of the said passage, that the defendant is seeking to distinguish the design of its ELANZA range of fans from the suit design of the ENTICER range of fans of the plaintiff only on the basis of miniscule differences of length and breadth or of other features which do not impact the overall visual appeal or impression of the two designs, i.e. the suit design and the design of the ELANZA range of the defendant's fans. These differences, therefore, cannot mitigate the aspect of piracy.

**14.10** Mr. Wadhwa has also sought to point out, from the brochures of the plaintiff and defendant which the plaintiff has placed on record, that the defendant has named the colours of its ELANZA range of fans using the same expressions which are used by the plaintiff for its ENTICER range of fans, i.e. Espresso Brown, Pearl White Gold and Rose Gold. He submits that this indicates an intent, by the defendant, to imitate the plaintiff's ENTICER range of fans.

**14.11** *Prima facie*, the submission has merit, especially as the only response, by the defendant, is that the said names of colours are standards in the industry. However, this assertion in the written statement is not supported by any material whatsoever to indicate that these are standard expressions used for colours. I find, therefore, *prima facie* substance in Mr. Wadhwa's submission that there has been a conscious attempt by the defendant, in their ELANZA range of fans, to imitate the ENTICER range of fans of the plaintiff.

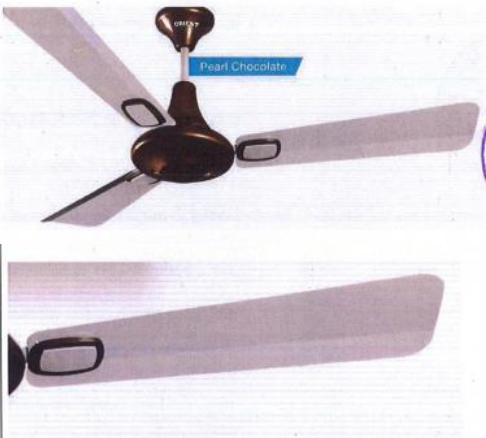
**14.12** I am, therefore, unable to accept Mr. Lall's submission that



there are any such distinguishing features between the design of the defendant’s ELANZA range of fans and the suit design of the plaintiff’s ENTICER range of fans, as can mitigate the aspect of obvious or fraudulent imitation. *Prima facie*, the two designs are starkly similar to each other and, when examined from the point of view of visual appeal, the design of the defendant’s ELANZA range of fans, *prima facie*, constitutes an obvious imitation of the 2016 ENTICER suit design.

**14.13** Mr. Lall has, however, also invoked the defence available under Section 22(3) of the Designs Act, to contend that the 2016 design registration is vulnerable to invalidity both on the ground of want of novelty and originality as well as on the ground of prior publication. He has drawn my attention, in this context, to the following paragraph from the written statement filed by the defendant:

“c. For ease of reference, illustrative examples of fans with either the same or substantially similar designs to those being claimed by the Plaintiff are provided hereinafter:

Fans similar to Enticer launched prior to 2016	
Orient Amara fan released by Orient in 2013. A copy of Orient Catalogue of 2013 is filed with the Written Statement.	



<p>Orient Adrian fan featured in 2013 catalogue</p>	
<p>USHA E-Series fan launched in 2014. (Video of the fan uploaded on YouTube on 06.10.2014. URL: <a href="https://www.youtube.com/watch?v=5gUigOpu0oI">https://www.youtube.com/watch?v=5gUigOpu0oI</a>)</p>	
<p>Orient Ecogale fan launched in 2015 (Video of the fan uploaded on YouTube on 16.04.2015. URL: <a href="https://www.youtube.com/watch?v=zesE9Bd6nz8">https://www.youtube.com/watch?v=zesE9Bd6nz8</a>)</p>	



Mr. Lall submits that, even in para 22 of IA 18703/2023, moved by the defendant under order XXXIX Rule 4 of the CPC, attention has been drawn to the above examples and fans which had almost similar designs or, at the very least, which contain the very features which were claimed by the plaintiff to be distinguishing and novel features of the 2016 design registration, in respect of fans which were in the market prior to 2016.


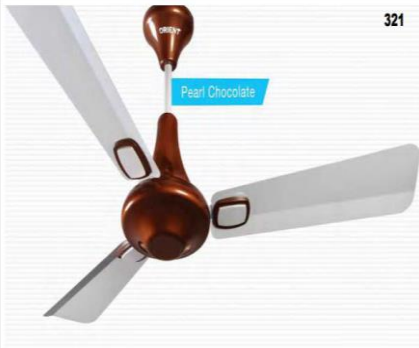








**14.14** If the 2016 suit design was novel *vis-a-vis* such prior art, Mr. Lall's contention is that the design of the defendant's ELANZA range of fans is equally novel *vis-a-vis* the 2016 suit design of the plaintiff's the ENTICER range of fans.

**14.15** At a plain glance, this argument cannot be accepted.

**14.16** There are glaring differences in the overall visual appearance of the four fans which have been cited by Mr. Lall as prior art, *vis-a-vis* the 2016 suit design. Without having to proceed to detail these distinguishing features, the visual dissimilarity between the suit design and the design of the fans which have been cited as prior art are



immediately apparent when once sees them side by side, as under:






Fan/Part	Fan corresponding to suit design	Prior art
	<b>ENTICER</b>	<b>ORIENT AMARA</b>
Fan		 321
Ornamentation on the blade		
Motor head		
Canopy		
Blades		
	<b>ENTICER</b>	<b>ORIENT ADRIAN</b>



Fan		
Blade Ornamentation		
Motor head		
Canopy		
Blades		
	<b>ENTICER</b>	<b>ORIENT ECOGALE</b>
Fan		





Blade Ornamentation		
Motor head		
Canopy		
Blade		
	<b>ENTICER</b>	<b>USHA E-SERIES</b>
Fan		
Blade Ornamentation		





Motor head		
Canopy		
Blade		

**14.17** Examined from the point of view of visual/eye appeal, it cannot be said either that the 2016 suit design is lacking in novelty and originality *vis-à-vis* the designs of the fans cited by Mr. Lall as prior art, or that the defendant’s ELANZA range of fans, or that the prior arts constitute prior publication of the 2016 suit design.

**14.18** For the said reason, I am unable, *prima facie*, to accept Mr. Lall’s contention that the 2016 suit design is vulnerable to invalidity as lacking in novelty or originality *vis-a-vis* the prior arts cited by Mr. Lall or that the said prior art constitutes prior publication as would render the 2016 suit design vulnerable to invalidity.

**14.19** In view of the aforesaid, a *prima facie* case of design piracy, by the defendant’s ELANZA range of fans, of the 2016 suit design of the



plaintiff, is seen to exist.

## 15. Re. 2021 BIANCA ART suit design

**15.1** The 2021 suit design relates to the plaintiff's BIANCA ART range of fans. Mr. Lall is correct in his contention that there is no comparative assessment made, either in the plaint, or in the documents accompanying the plaint, between the 2021 suit design and any of the defendant's fans, so as to enable the court to arrive at the *prima facie* conclusion of piracy or deceptive similarity. In this context, Mr. Lall has drawn my attention to para 34 of the plaint, which reach thus,

“34. It is submitted that the Plaintiff, in the year 2022, launched its ‘BIANCA ART/ BIANCA-SANGANER’ series of fans which bear the following features:

- Rounded curvaceous ornamentation on the blade
- Sloping edge along with a concave curve of the rounded/curvaceous ornamentation on blade towards
- Motor body with three curvaceous elongated/protrude edges (sleeves) which merge with the curvaceous bottom of the blade trims

That a tabular chart detailing the essential features of Plaintiff's BIANCA ART/ BIANCA ART – SANGANER fan is being filed along with the suit.”

Mr. Lall submits that the plaint could not have bracketed its BIANCA ART and its BIANCA ART – SANGANER range of fans into one group in order to allege deceptive similarity of piracy, as novelty and originality have been certified to reside, in the concerned design certificates, in different features of each design. While novelty and originality was certified as residing in the 2021 suit design in its shape, configuration and surface pattern, novelty was certified as



residing in the 2022 suit design only in the surface pattern. He submits that, therefore, the plaintiff could not make out a combined case of design piracy, by the defendant's fan, of both the 2021 and 2022 suit designs.

**15.2** The submission is correct. Novelty and originality have indeed been certified as residing in the 2021 suit design in its shape, configuration and surface pattern, whereas novelty and originality have been certified as residing, in the 2022 suit design, only in the surface pattern. Any allegation of infringement or piracy, by the defendant would, therefore, have to be individually addressed with respect to the 2021 and 2022 suit designs.

**15.3** There is no specific material placed on record to indicate that any particular fan of the defendant was deceptively similar in design to the plaintiff's 2021 suit design. As already noted, the plaintiff compares the defendant's ELANZA range with the plaintiff's ENTICER range of fans, and the defendant's ELEGANZ PLUS range with the plaintiff's BIANCA ART SANGANER range of fans. There is no comparison attempted between the plaintiff's BIANCA ART range of fans – which is different in appearance from the BIANCA ART SANGANER range of fans – with any fan of the defendant.

**15.4** On the basis of the material on record, therefore, and for want of necessary pleadings, this court cannot return a finding, even *prima facie*, of infringement or piracy of the 2021 suit design of the plaintiff by any of the fans of the defendant. The ELEGANZ PLUS range of fans of the defendant is alleged specifically to be infringing, in design,



of the BIANCA ART SANGANER range of fans of the plaintiff, which corresponds to the 2022 suit design.

**15.5** Mr. Lall is also correct in his contentions that none of the distinguishing features of the BIANCA ART/BIANCA ART SANGANER range of fans of the plaintiff, as delineated in para 34 of the plaint are contained in the defendant's ELEGANZ PLUS range of fans. Para 34 of the plaint asserts that the USP of the plaintiff's BIANCA ART/BIANCA ART SANGANER range of fans are (i) the rounded curved ornamentation on the blade, (ii) a sloping edge with a concave curve ornamentation on the blade towards the motor body and (iii) a motor body with three curved elongated/protruding sleeves which merge with the curved bottom of the blade trims. As Mr. Lall correctly points out, none of these three features, which according to the plaintiff itself constitute the USP of its 2021 as well as its 2022 suit designs, are to be found in the defendant's ELEGANZ PLUS range of fans.

**15.6** As such, the prayer for interim injunction, insofar as it relates to the 2021 suit design of the plaintiff, cannot be granted.

**16. Re. 2022 BIANCA ART SANGANER suit design**

**16.1** The 2022 suit design of the plaintiff has been certified as possessing novelty and originality only in respect of the surface pattern. Inasmuch as the Designs Act affords protection only to the novelty and originality of the registered suit design, the court would have to compare the surface pattern of the 2022 suit design with the



2023:DHC:8764



ELEGANZ PLUS range of the defendant's fans, to examine whether any obvious or fraudulent imitation exists.

**16.2** The 2022 suit design, and the BIANCA ART SANGANER fans to which it corresponds, are strikingly different in appearance from the ENTICER and BIANCA ART fans of the plaintiff. They contain artistic floral surface patterns on the motor head as well as on the projections from the motor head onto the blades of the fan. It is in these surface patterns that, according to the certificate of registration of the 2022 suit design, novelty resides. In fact, the plaint itself specifically states that the unique feature of the plaintiff's BIANCA ART SANGANER range of fans was the floral design.

**16.3** There is no doubt about the fact that the defendant's ELEGANZ PLUS range of fans also contains a design on the projections from the central motor head on to the blades of the fans. The *idea* of a floral design may, therefore, *perhaps* have been borrowed, in the defendant's ELEGANZ PLUS fans, from the plaintiff's 2022 suit design. That, however, is not the case that the plaintiff has chosen to make out. It is not the plaintiff's case that the plaintiff has a monopoly over having a design on the central motor head or on the projections from the central motor head onto the blades of the fan. The certificate of registration certifies novelty as residing in the surface pattern of the suit design. The Court has, therefore, to compare the surface pattern on the projections in the 2022 suit design with the surface pattern on the projections in the defendant's ELEGANZ PLUS range of fans, *on the basis of eye/visual appeal*.



**16.4** When one compares these two surface patterns, they are obviously very different. In fact, the defendant's surface pattern is not even floral in nature, but is an arrangement of leaves. Further, it is in green monochrome, whereas the design of the surface patters in the 2022 suit design is in luxurious multicolour.

**16.5** The certificate of the 2022 suit design certifies novelty as residing only in the surface pattern. The surface pattern of the plaintiff's BIANCA ART - SANGANER range of fans being clearly different from the defendant's ELEGANZ PLUS range of fans, even as per the table contained in para 7 of the plaint and reproduced in para 3 *supra*, it cannot be said that the surface pattern on the defendant's ELEGANZ PLUS range of fans is imitative of the surface pattern of the 2022 suit design.

**16.6** The allegation of design piracy, by the defendant's ELEGANZ PLUS range of fans, of the 2022 suit design of the plaintiff cannot, therefore, *prima facie*, succeed.

**17** Both sides have referred to certain judicial authorities. However, as I have arrived at my *prima facie* findings above on the basis of the law laid down by the Supreme Court and by Full Benches of this Court, reference to other decisions appears, at this stage, to me to be superfluous.

## **Conclusion**

**18** For the aforesaid reasons, the interim injunction granted by this





2023:DHC:8764



Court *vide* the interim order dated 2 June 2023 is maintained in so far as it relates to the defendant's ELANZA range of fans *vis-a-vis* the plaintiff's 2016 suit design. However, the injunction, insofar as it has been granted against the defendant's ELEGANZ PLUS range of fans, *vis-a-vis* the plaintiff's 2021 suit design and 2022 suit design is vacated. Inasmuch as the plaintiff has not been able to make out a *prima facie* case of design piracy, by any of the defendant's fans, either of the 2021 or the 2022 suit design, the prayer for interim injunction against infringement of the said designs cannot be granted.

**19** I.A. 18703/2023 stands partly allowed in the aforesaid terms and the I.A. 11325/2023 stands partly rejected in the aforesaid terms.

**C.HARI SHANKAR, J**

**DECEMBER 6, 2023**

ar/sds

*Click here to check corrigendum, if any*