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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI***Reserved on: 24.01.2023**Pronounced on: 03.07.2023*

+ CS(COMM) 580/2022, I.A. 13422/2022, I.A. 13425/2022

JAYSON INDUSTRIES AND ANR. .... Plaintiffs  
Through: Mr. M.K. Miglani, Mr. Aditya  
Mathur and Mr. Arpit Dudeja, Advs.

versus

CROWN CRAFT (INDIA) PVT. LTD. .... Defendant  
Through: Mr. Sushant M. Singh, Mr. Ajay  
Amitabh Suman, Ms. Geetika Kapur and  
Mr. S.K. Bansal, Advs.

**CORAM:****HON'BLE MR. JUSTICE C. HARI SHANKAR****J U D G M E N T****03.07.2023**

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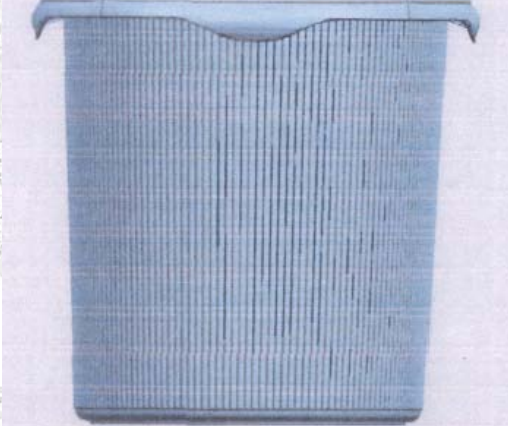
**Facts**

1. A bucket, a mug and a tub – humble and unassuming items of everyday domestic use – form subject matter of the dispute in the present suit.


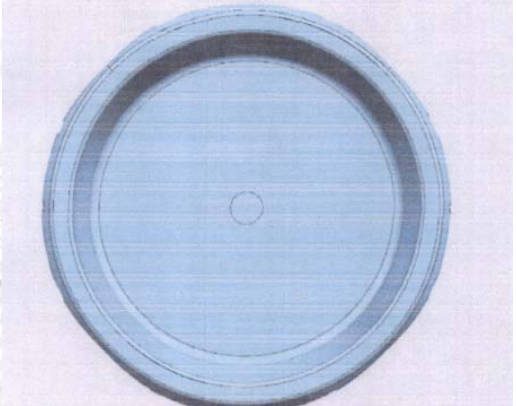
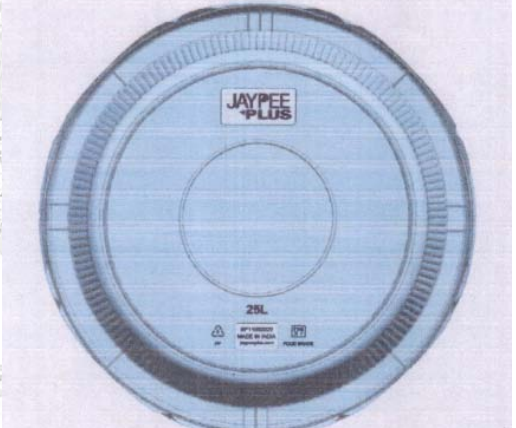
2. Plaintiff 1 is the proprietor of Registrations 326707, 326883 and 326882, in respect of a bucket, a mug and a tub, w.e.f. 1 February 2020, 6 February 2020 and 6 February 2020 respectively, in Class 1 of the Locarno Classification. Plaintiff 2 manufactures and markets the products bearing registered designs with the permission of Plaintiff 1.




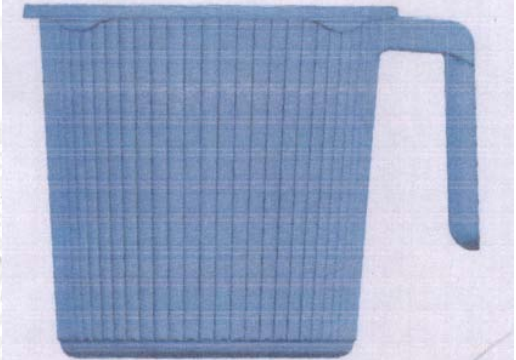
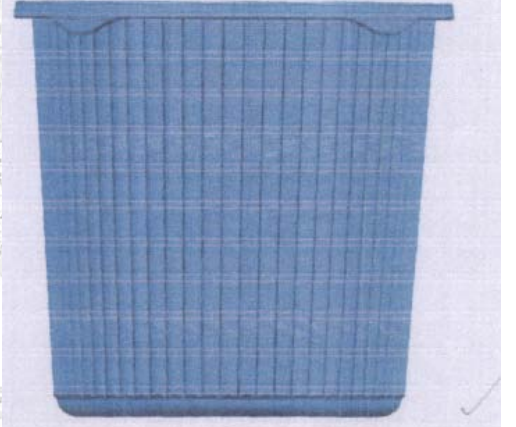

The various views of these items, with respect to which they have been granted registration, may be presented thus:

Items	View	Pictures
Bucket	Perspective	
	Front and back	



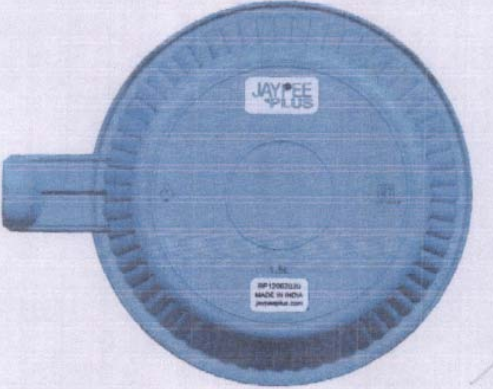


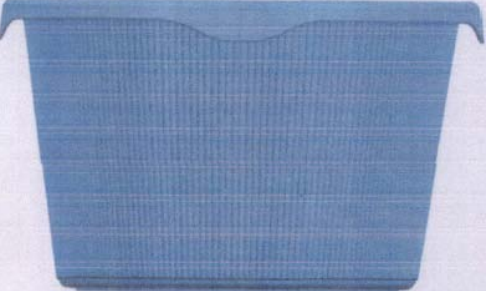
	<p>Left side and right side</p>	 A side view of a blue plastic trash bin with vertical ridges and a slightly flared top edge.
	<p>Top</p>	 A top-down view of the blue plastic trash bin lid, showing a circular shape with a central hole and a raised rim.
	<p>Bottom</p>	 A bottom-up view of the blue plastic trash bin lid. It features a central circular area with a smaller hole, surrounded by concentric ridges. Text on the lid includes "JAYPEE PLUS" at the top, "25L" in the center, and "MADE IN INDIA" at the bottom. There are also small recycling symbols.

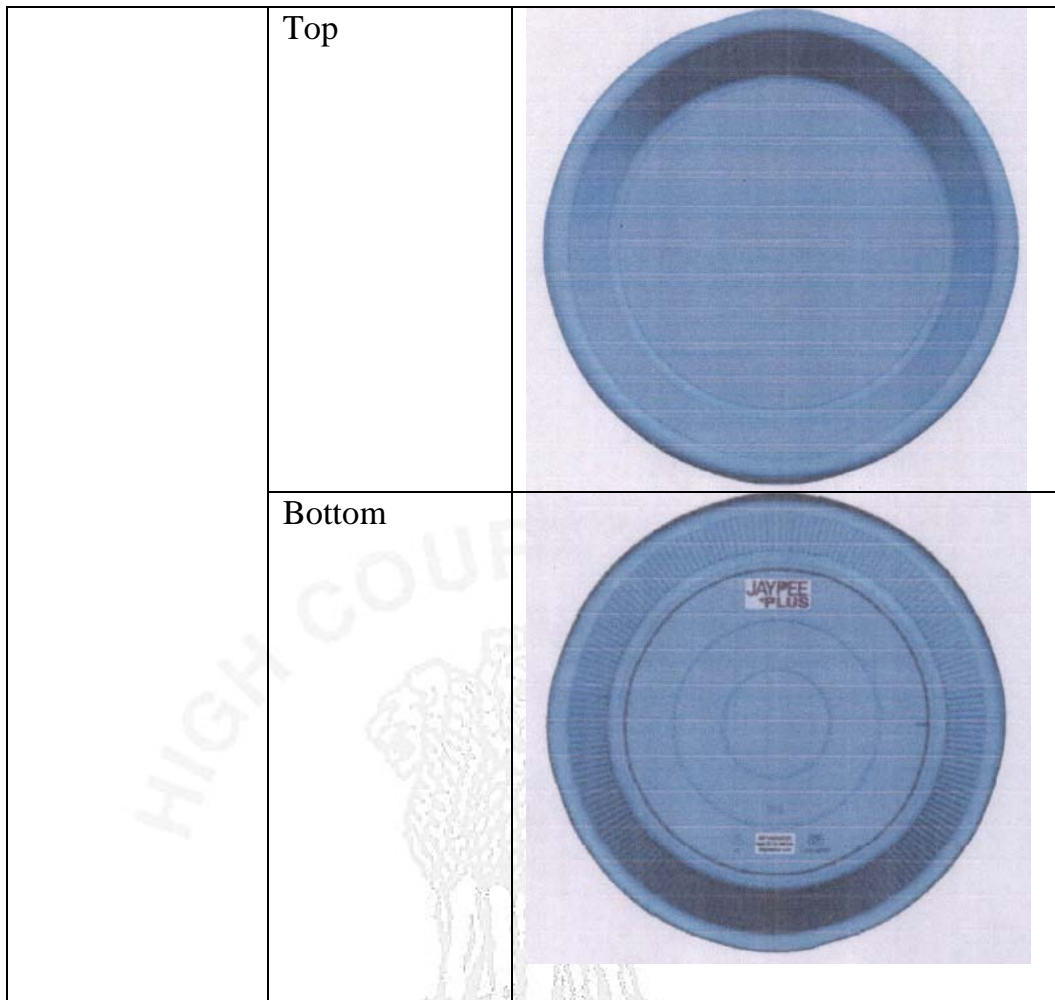


Mug	Perspective	
	Front and back	
	Left side and right side	
	Top	







	Bottom	
Tub	Perspective	
	Front and back	
	Left side and right side	

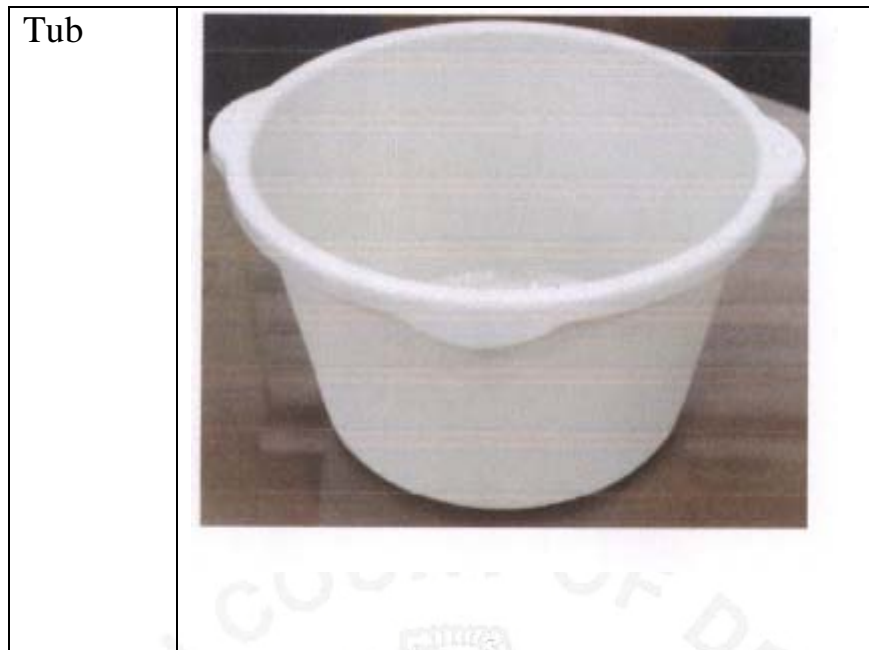


3. In each case, novelty has been certified as residing in the shape, configuration and surface pattern of the bucket, mug and tub respectively, in their respective certificates of registrations.

4. The photographic representations of the impugned products of the defendant – which faithfully replicate their actual views, as physical samples were produced before the court – are as under:



Items	Pictures
Bucket	 A photograph of a white plastic bucket with a pouring spout on the right side. The bucket is empty and sits on a white surface.
Mug	 A photograph of a white plastic mug with a handle on the left side. The mug is empty and sits on a white surface.



5. The plaintiffs' contention is that the design of the defendant's bucket, mug and tub are obvious and fraudulent imitations of the suit designs and that, therefore, the defendant has committed piracy of the registered designs of the plaintiffs, within the meaning of Section 22(1)<sup>1</sup> of the Designs Act, 2000. In this context, para 8 of the plaint merits reproduction:

"8. That during the course of its business in January 2020 the plaintiff no.1 created and developed a new and original design of bucket, mug and tub. That the said bucket, mug and tub have been designed in a unique manner and contains elongated vertical ribs on the surface of both the articles with two fangs like structure on the semicircle carrying handle.

<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.





That the plaintiff No. 1 has designed its products in such a manner so that the said product are highly novel and unique and has instant ocular appeal and attention of the prospective consumer. That the said products are part of the Ribbed range of accessories and are sold under the trademark JAYPEE PLUS and are called Rib Bath Bucket, Mug and Tub. These products incorporate not only technically sound and efficient quality and features, but also comprises inter alia of overall unique and novel shape, configuration and surface patten having attractive and aesthetic eye appeal. The object being to provide a product with an overall aesthetically attractive appearance which should be pleasing to eye of the consumer who has to use it day to day.”

6. The present plaint was originally instituted before the learned District Judge (Commercial Court), Central (hereinafter “the learned Commercial Court”) as CS (Comm) 1384/2022. As the defendant, in its written statement, pleaded invalidity of the suit designs as a ground of defence under Section 22(3)<sup>2</sup> of the Designs Act, the learned Commercial Court, *vide* order dated 12 August 2022, transferred the suit to this Court under Section 19(2)<sup>3</sup> of the Designs Act. The suit has subsequently been re-numbered CS (Comm) 580/2022 by the Registry of this Court.

7. The plaintiffs filed, along with the suit, an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC), along with certain applications with which are not concerned for the present.

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

<sup>3</sup>(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.



8. By order dated 8 June 2022, the learned Commercial Court granted *ex parte ad interim* injunction in favour of the plaintiffs and against the defendant, restraining the defendant and all others acting on its behalf from selling, marketing, distributing or supplying the impugned bucket, mug and tub, recording, in the process, a *prima facie* view that the designs of their products were deceptively similar to the registered designs of the plaintiffs. Additionally, the learned Commercial Court appointed a local commissioner to visit the premises of the defendant and to seize and inventorize the offending/infringing goods found therein.

9. The aforesaid *ex parte* interlocutory injunction continues to remain in force till date. In the meanwhile, pleadings in the suit were completed. Apart from filing written statement by way of response to the plaint, and a separate reply to the application under Order XXXIX Rules 1 and 2 of the CPC filed by the plaintiffs, the defendant independently filed an application under Order XXXIX Rule 4 of the CPC, seeking vacation of the *ex-parte* injunction dated 8 June 2022 granted by the learned Commercial Court.

10. Consequent to transfer of the proceedings to this Court, the applications under Order XXXIX Rules 1 and 2 filed by the plaintiffs and Order XXXIX Rule 4 by the defendant stand numbered as IA 13422/2022 and IA 13425/2022.



11. Detailed arguments were heard by me on these two applications. Orders were reserved thereon. By the present judgment, I propose to dispose of these two applications.

12. Arguments on behalf of the plaintiffs were advanced by Mr. M.K. Miglani and arguments on behalf of the defendant were advanced by Mr. Sushant Singh, learned Counsel.

### **Rival contentions**

13. Drawing my attention to physical samples of the plaintiffs' and the defendant's products, as well as the pictorial photographic representations thereof as filed with the plaint, Mr. Miglani contends that, quite simply, the designs of the defendant's bucket, mug and tub are fraudulent imitations of the suit designs, registered in favour of Plaintiff 1. He points out that, in the written statement, the defendant has acknowledged that they commenced manufacture of the impugned bucket, mug and tub only in 2021, prior to which the suit designs already stand registered in favour of Plaintiff 1 w.e.f. 1/6 February 2020. On the aspect of imitation, Mr. Miglani reiterates the stand, taken in the plaint, that the essential and distinctive features of the suit designs are the ribbed nature of the body of the vessel in question and the flange-like extensions on the rim thereof. Both these features, he submits, stand replicated in the impugned designs of the defendant's products. Clearly, therefore, in Mr. Miglani's submission, the defendant has committed piracy within the meaning of Section 22(1)



of the Designs Act, resulting in a clear case being made out for injuncting further piracy of the suit designs under Section 22(2)<sup>4</sup>.

**14.** In its written statement, the defendant has, besides, faintly contending that the designs of the bucket, mug and tub are not imitative of the suit designs, essentially questioned the validity of the suit designs, as is permissible under Section 22(3) of the Designs Act. The challenge to validity of the suit designs is, therefore, the principal ground of defence taken by the defendant in response to the charge of design piracy labeled by the plaintiffs.

**15.** Arguing on behalf of the defendant, Mr. Sushant Singh, learned Counsel, submits that the Designs Act does not contain any provision analogous to Section 31(1)<sup>5</sup> of the Trade Marks Act 1999, which statutorily presumes the validity of a registered trade mark. There is, therefore, he submits, no statutory presumption of validity, for a registered design. Registrations of designs, he submits, are, unlike trade marks, granted on a self-declaration basis. In other words, the applicant seeking registration of a design himself declares what, according to him, are the novel and original features of the design and,

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<sup>4</sup> (2) If any person acts in contravention of this section, he shall be liable for every contravention –  
 (a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or  
 (b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:  
 Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:

Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.

<sup>5</sup> **31. Registration to be prima facie evidence of validity. –**

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.



subject to satisfaction of the Registrar of Designs in that respect, the design is accordingly registered. There is, therefore, no scope for any pre-grant opposition before registration of a design.

**16.** Mr. Sushant Singh has invited my attention to the statement of objects and reasons of the Designs Act. The purposes that the Designs Act intend to achieve are thus set out in the statement of objects and reasons:

“Since the enactment of the Designs Act, 1911 considerable progress has been made in the field of science and technology. The legal system of the protection of industrial designs requires to be made more efficient in order to ensure effective protection to registered designs. It is also required to promote design activity in order to promote the design element in an article of production. The proposed Design Bill is essentially aimed to balance these interests. It is also intended to ensure that the law does not unnecessarily extent protection beyond what is necessary to create the required incentive for design activity while removing impediments to the free use of available designs.”

Mr. Sushant Singh submits that, therefore, the object and purpose of the Designs Act is encouragement of innovation. A non-innovative design, therefore, is *ex facie* ineligible for registration.

**17.** Mr. Sushant Singh did not dispute the identity of the designs of the defendant’s bucket, mug and tub with the suit designs. He, however, submits that the suit designs themselves are liable to be cancelled both on the ground of want of novelty and originality as well as on the ground of prior publication. In other words, Mr.





Sushant Singh has invoked Section 19(1)(b), (c) and (d)<sup>6</sup> and clauses (a) and (b) of Section 4<sup>7</sup> of the Designs Act 2000.

**18.** In this context, Mr. Sushant Singh initially drew my attention to para 8 of the plaint, which already stands reproduced *supra*. He points out that the avowed stand of the plaintiffs, as set out in para 8 of the plaint, is that novelty and originality, in the suit designs, rests in the ribs on the body contained in the receptacles and the flanges on the lids thereof. Both these features, submits Mr. Sushant Singh, are to be found in any number of similar buckets, mugs and tubs, which were freely in distribution and sale much prior to the registration of the suit designs. He has, in this context, particularly drawn my attention to the following documents, filed with the written statement:

(i) Mr. Sushant Singh invited my attention to a 2018 Brochure of Migeplastics, a plastic injection mould manufacturer. Among the goods figuring in the said Brochure is the following bucket:

<sup>6</sup> **19. Cancellation of registration. –**

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

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

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

(d) that the design is not registrable under this Act; or

<sup>7</sup> **4. Prohibition of registration of certain designs. – A design which –**

(a) is not new or original; or

(b) has been disclosed to the public any where in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or

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shall not be registered.



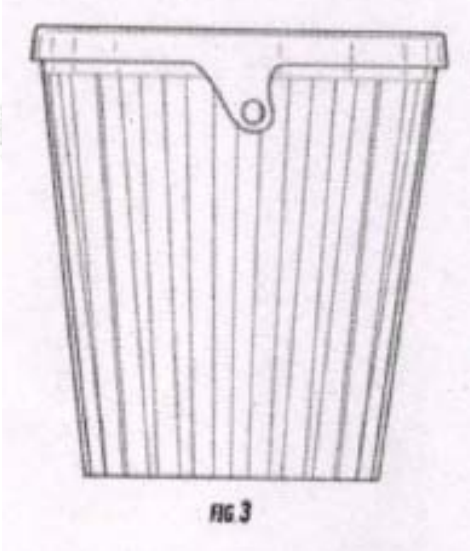


Mr. Sushant Singh submits that the above bucket, which is one of the items reflected in the Brochure of Migeplastics, contains vertical ribs throughout its body as well as flanges on its rim, similar to those found in the suit designs and in respect of which the plaintiff claims novelty and originality.


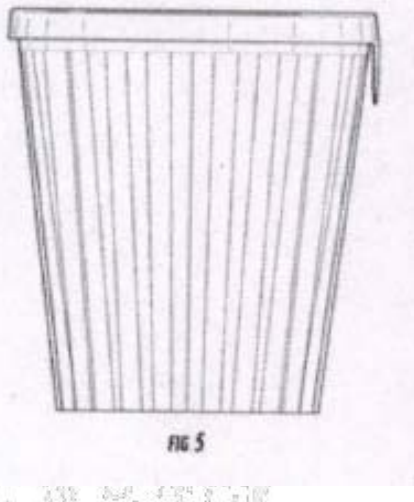

(ii) The second document on which Mr. Sushant Singh relies is the design for a bucket liner registered in the US as Design D-784645 w.e.f. 9 March 2016, granted on 18 April 2017, in Class 7 of the Locarno Classification in favour of David A Richardson. The various views of the said design, as contained in the certificate of registration, are as under:

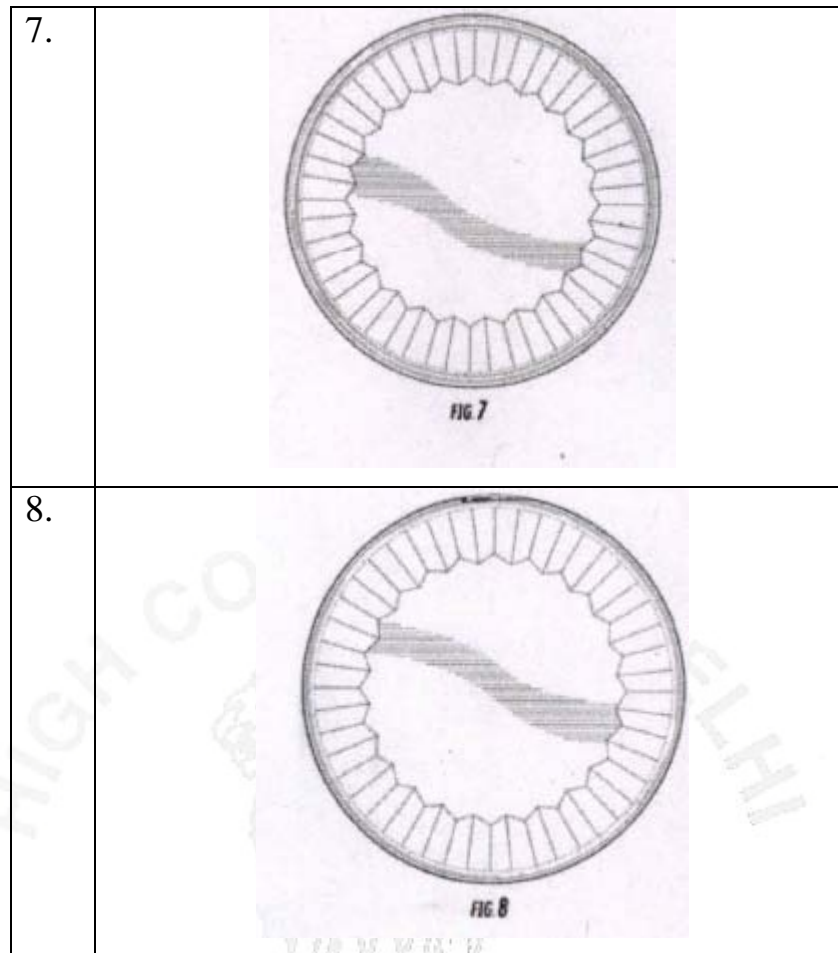
Sr. No.	Views of the design
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1.	 <p>FIG 1</p>
2.	 <p>FIG 2</p>
3.	 <p>FIG 3</p>



4.	
5.	
6.	



In this context, Mr. Sushant Singh relies on the judgment of a Division Bench of this Court in *Aashiana Rolling Mills Ltd. v. Kamdhenu Ltd.*<sup>8</sup>, to contend that though the mere drawing of a design may not be sufficient to constitute prior art, the drawing of the article with the design is sufficient in that regard. If all drawings were to be excluded from the prior art, Mr. Sushant Singh submits that it would unreasonably limit the concept of “publication” under the Designs Act. He relies, for this purpose, on Section 2(d)<sup>9</sup> of the Designs Act, to

<sup>8</sup> 253 (2018) DLT 359 (DB)

<sup>9</sup> (d) “design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by an industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the





contend that even two dimensional features of shape or configuration would constitute a “design”. He has also cited para 3.10 of Russell-Clarke on Industrial Designs (6<sup>th</sup> Edn.) which reads thus:

“3.10. According to section 1 of the RDA, four kinds of features may constitute a design, namely, shape, configuration, pattern and ornament. For all practical purposes, however, these may be reduced to two categories of features, those in two dimensions and those in three. In a classic statement of what constitutes a design (at that time according to the definition in the Patents and Designs Acts 1907 to 1939), Lord Wright in *King Features Syndicate Inc. and Belts v. O. & M. Kleemann Ltd*<sup>10</sup> (the Popeye case) said:

“... thus a design may be the shape of a coal scuttle, a basin, a motor car, a locomotive engine or any material object, it may be the shape embodied in a sculptured or plastic figure which is to serve as a model for commercial production, or it may be a drawing in the flat or a complex pattern intended to be used for the manufacture of things such as linoleum or wallpaper.”

Referring to the definition of “original” in relation to a design, as contained in clause (g) of Section 2<sup>11</sup> of Designs Act, Mr. Sushant Singh submits that mere trade variants of existing prior art cannot be treated as “original” within the meaning of the said clause. If, therefore, the court is presented with such trade variants, a *prima facie* triable issue arises for consideration. He has further referred, in this context, to para 3.153 of Russell Clarke, which reads thus:

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finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957;

<sup>10</sup> (1941) 58 R.P.C 207 at 219

<sup>11</sup> (g) “original”, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;



“3.153. Whether or not “or” in the phrase “new or original” is used in the disjunctive sense was considered in *Aspro-Nicholas’ Application*<sup>12</sup>. Graham J. held that it was not so used. The phrase was changed from “new and original” to “new or original” in an amendment made to Section 50(a) of the Patents and Designs Act 1907 by the Patents and Designs Act 1919, section 20. In *Carr’s Design Application*<sup>13</sup>, however, it would appear that the RDAT, relying upon words of Lord Simonds in *Stenor Ltd. v. Whitesides (Clitheroe) Ltd.*<sup>14</sup> favoured the opposite point of view, though Whiteford J. refrained from expressing a concluded view upon the matter. The possible distinction was also considered as arguably giving rise to considerations under the head of “originality” analogous to questions of obviousness under the patent system.”

In the same context, Mr. Sushant Singh has relied on the decision of House of Lords in *Stenor*<sup>14</sup>.

These, as well as the designs of other buckets, mugs and tubs, filed with the written statement of the defendants, submits Mr. Sushant Singh, entirely divest the suit designs of all novelty and originality, and render them liable to be cancelled on the ground of prior publication as well.

**19.** Mr. Sushant Singh submits that, except for the fact that there may be a slight difference in the shape of the flange on the rim of the bucket/tub, the suit design is an obvious imitation thereof. He submits that, in order to divest a design from novelty *vis-à-vis* prior art, it is not necessary that the design is identical to the design forming subject matter of prior art. Even if they are deceptively similar, he submits that the design in question would stand invalidated. He relies, for this

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<sup>12</sup> [1974] R.P.C 645

<sup>13</sup> [1973] R.P.C. 689

<sup>14</sup> (1947) 65 RPC 1 at 11



purpose, on paras 25, 26, 31, 32 and 38 of the judgment of a learned Single Judge of this Court in *Dart Industries v. Techno Plast*<sup>15</sup>.

**20.** Mr. Sushant Singh submits that, in any event, in view of prior art cited by him, it cannot be said that the plaintiffs have a *prima facie* case, meriting a grant of interlocutory injunction. At the least, he submits that a serious question has been raised by him, amounting to a credible challenge to the validity of the suit designs, which would require to be resolved only consequent on trial.

**21.** Mr. Sushant Singh has also referred to the following garbage household trash can, available for sale on amazon.in as far back as on 14 March 2019 which, according to him, also has a ribbed body, identical to the suit designs:



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<sup>15</sup> 141(2007) DLT 777



He has further referred to the following mug, also available for sale on Amazon since 10 July 2015, which has, not only a ribbed body but also flanges on the lid:



**22.** Thus, submits Mr. Sushant Singh, neither can the flange on the rib, nor can the ribs on the body of the suit design, be treated as entitled to registration, as they lack novelty and originality and are also bad for prior publication.

**23.** Apropos the designs of the articles cited by Mr. Sushant Singh and shown hereinabove, he submits that the differences in the suit designs, which may perhaps relate to the number of flanges or other minor changes in shape or contour, are merely trade variants. They cannot, therefore, confer either novelty or originality to the suit designs.

**24.** Where, thus, the defendant has thrown up a credible challenge to the piracy of the suit design, evidencing a serious triable issue, Mr. Sushant Singh submits, relying on *Niki Tasha India Pvt. Ltd. v.*



*Faridabad Gas Gadgets Pvt. Ltd.*<sup>16</sup>, that injunction cannot be granted by the court. Moreover, he submits that the suit design is of recent date, which, too, would militate against grant of an injunction, applying the principle enunciated in para 19 of *Niki Tasha*<sup>16</sup>.

25. Mr. Sushant Singh has also cited, in this context, the decision of a Division Bench of this Court in *B. Chawla and Sons v. M/s Bright Auto Industries*<sup>17</sup>, the decision of the Chancery Division in *Phillips v. Harbro Rubber Company*<sup>18</sup> and the judgment of a learned Single Judge of this Court in *Steelbird Hi-Tech India Ltd. v. S.P.S. Gambhir*<sup>19</sup>.

26. Applying the principles contained in these decisions, Mr. Sushant Singh submits that changes in the number and shape of the flanges on the rim of the suit designs, *vis-à-vis* prior art, are merely workshop improvements, insufficient to confer novelty and originality.

27. Mr. Sushant Singh further submits that it was in full awareness of the fact that the defendant has, in its written statement, even while acknowledging the fact that it had applied for registration of the impugned designs under the Designs Act, undertaken to withdraw the said registrations, as it has realized that the designs are neither new nor original. Having been permitted, by the Registrar of Designs, to withdraw his application, Mr. Sushant Singh submits that the

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<sup>16</sup> ILR 1984 (2) Del 530

<sup>17</sup> AIR 1981 Del 95

<sup>18</sup> (1920) 37 RPC 233

<sup>19</sup> 2014 (58) PTC 428 (Del)





defendant cannot be estopped from contesting the validity of the suit designs. Even otherwise, he submits, there can be no estoppel against a right *in rem* for which purpose he relies on para 26 of the judgment of a coordinate Bench of this Court in *Philips Lighting Holding B.V. v. Jai Prakash Aggarwal*<sup>20</sup> and para 24 of the judgment of an earlier coordinate single Bench of this Court in *Babbar Wreckers Pvt. Ltd. v. Ashok Leyland Ltd.*<sup>21</sup>

28. In conclusion, Mr. Sushant Singh has again referred to Section 22(3) read with clauses (b) and (c) of Section 19(1) and clause (c) of Section 4 to submit that the suit design is neither novel nor original, nor sufficiently distinguishable from designs which constitute known prior art. A triable challenge having thus been raised by the defendant to the validity of the suit designs, Mr. Sushant Singh submits that the plaintiffs are not entitled to any interlocutory injunction.

29. Arguing in rejoinder, Mr. Miglani submits that none of the designs shown by Mr. Sushant Singh as representing prior art contain flanges on the rim of the cup/bucket/tub, which are similar to the flanges contained on the rim of the suit designs. That apart, he submits that, apropos the design constituting subject matter of registration D-784645 granted to David A Richardson, there was no evidence that the said design had ever been applied to any article or sold. In the absence of any such evidence, Mr. Miglani submits that the said design cannot constitute prior art and relies for the said purpose, on para 45 of the judgment of the Supreme Court in *Bharat*

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<sup>20</sup> 293 (2022) DLT 185

<sup>21</sup> 2010 (120) DRJ 517



***Glass Tube Ltd. v. Gopal Glassworks Ltd.***<sup>22</sup>. Besides, he submits that the flange on the rim of Design D-784645 is totally dissimilar to the flange on the lid of the plaintiffs' suit designs.

30. Mr. Miglani has, in conclusion, relied, on the aspect of estoppel, on paras 5, 7, 12 and 13 of the judgment of a Division Bench of this Court in ***Pentel Kabushiki Kaisha v. Arora Stationers***<sup>23</sup>, and, on merits, on the following decisions:

(i) paras 36, 37, 42 and 44 of the judgment of the High Court of Bombay in ***Selvel Industries v. Om Plast (India)***<sup>24</sup>.

(ii) para 37 of the judgment of the High Court of Calcutta in ***Castrol India Ltd. v. Tide Water Oil Company (I) Ltd***<sup>25</sup>.

(iii) para 18 of the judgment of this Court in ***Dabur India v. Amit Jain***<sup>26</sup>.

(iv) paras 29 and 33 of the judgment of this Court in ***Diageo Brands B.V. v. Great Galleon Ventures Ltd.***<sup>27</sup> and

(v) paras 80 and 81 of the judgment of this Court in ***Havells India Ltd. v. Panasonic Life Solutions India Pvt. Ltd***<sup>28</sup>.

## Analysis

<sup>22</sup> 2008 (10) SCC 657

<sup>23</sup> (1996) 16 PTC 202

<sup>24</sup> 2016(67) PTC 286 (Bom)

<sup>25</sup> 1996 (16) PTC 202 (Cal)

<sup>26</sup> 2009 (39) PTC 104 (Del)

<sup>27</sup> 2022 SCC OnLine Del 2350

<sup>28</sup> 2022 SCC OnLine Del 1662



**31.** That the design of the mug, tub and bucket of the defendant is identical to the suit designs has not been seriously disputed by Mr. Sushant Singh. However, Mr. Sushant Singh disputes the entitlement, of the suit designs, to registration. He submits that the suit designs are neither novel nor original and are, additionally, published prior in point of time to their registration. Thus, he submits that the suit designs are liable to be cancelled under clauses (b), (c) and (d) of Section 19(1) read with Section 4(a) and (b) of the Designs Act. At the least, submits Mr. Sushant Singh, his submissions make out a credible challenge to the validity of the suit designs, which is sufficient to justify rejection of the prayer for interlocutory injunction.

#### The law

**32.** In order to understand the scope of the concept of a “design” under the Designs Act and the extent to which it is entitled to protection, one has to refer to the relevant provisions of the Designs Act in conjunction with the judgment of the Supreme Court in *Bharat Glass Tubes*<sup>22</sup>, which is the only authoritative pronouncement from the Supreme Court on the point.

**33.** The expression “design” is defined, essentially, in clause (d) of Section 2 of the Designs Act, as the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article, whether in two dimensional or three dimensional or in both forms, by any industrial process or means which, in the finished



article appeal to and are judged solely by the eye. The definition expressly excludes “any mode or principle of construction or anything which is in substance a mere mechanical device”.

**34.** The following features of the definition of “design”, as contained in the Designs Act, are of significance:

(i) The application of the features of shape, configuration, pattern, etc. to an article, in order for it to constitute a “design” may be two dimensional, three dimensional or both. No article, in its physical form, is two dimensional. Howsoever slim an article may be, it is, per definition, three dimensional. By extending the definition of “design”, to the application of shapes, configuration, patterns, etc. to articles even in two dimensional forms, the statute makes it clear that even a two dimensional representation of the application of features or shape, configuration, pattern etc. to an article would constitute a “design”.

(ii) The design is to be judged “solely by the eye”. The test to decide whether a particular application of shape, configuration, pattern, etc. to an article constitutes a design is, therefore, essentially ocular/visual.

(iii) Judged thus in an ocular/visual manner, the application of the shape, configuration, pattern, etc., to the article must appeal to the eye. Thus, it is not mere ocular assessment, but *ocular*



*appeal*, which is necessary for a particular application of shape, configuration, etc. to an article, to constitute a “design”. *Sans* ocular appeal, there can be no design. Thus, unlike the Patents Act, which deals with inventions and judges their patentability on the basis of whether they involve inventive steps, the application of shape, configuration, etc., to an article, in order to constitute a “design”, must have ocular appeal, irrespective of whether it is inventive, or is or is not functionally superior to prior art.

(iv) The definition, as already noted, excludes any mode or principle of construction or any thing which is in substance a mere mechanical advice. This expression, quite frankly, is not easy to comprehend. However, a Full Bench of this Court has, in *Mohan Lal v. Sona Paint & Hardwares*<sup>29</sup>, held thus:

“15. Before one proceeds further, it may be relevant to indicate here some well accepted principles which operate in the field of designs law. Design as is generally understood refers to the features of shape, configuration, pattern or ornament when applied to an article. It is for this reason that designs such as these are described as Industrial Designs. It is these designs which are covered under the Designs Act. Designs can be two dimensional or three dimensional. While pattern or an ornament would ordinarily be applied to an article; shape and configuration, become the article itself. *Designs in that sense relate to the non-functional features of the article. Therefore, by necessary corollary, a design which has functional attributes cannot be registered under the Designs Act. This is the essence of Section 2(d) of the Designs Act.* The protection under the Designs Act is granted only to those designs which have an aesthetic value or otherwise appeal to the eye. *There may be, however, cases where the design while fulfilling the test of being appealing to the eye, is*

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<sup>29</sup> (2013) 200 DLT 322 (FB)





*also, functional.* [See judgment in the case of *Cow (P.B.) & Coy Ld. v. Cannon Rubber Manufacturers Ld.*<sup>30</sup>]. In this case the diagonal ribs on a hot water bottle were both appealing to the eye as well as functional. They were functional in as much as they permitted the heat to be radiated without singeing the user. The conundrum of functionality was resolved by taking note of the fact that it would make no impact on the articles functionality if, the ribs on the hot water bottle were either horizontal or vertical or even diagonal formations.”

(Emphasis supplied)

In other words, if the feature, which distinguishes the finished article from prior art is merely functional, with no ocular appeal, it cannot constitute a “design”. At the same time, if the article, compared *vis-à-vis* prior art, has both ocular and functional appeal, then it would qualify as a “design”.

(v) “Article” is defined, in Clause (a) of Section 2, as “any article of manufacture...”. Thus, an “article” has to be a tangible entity. A design which merely exists in the mind of its creator, and is not to be applied to any article of manufacture is, therefore, no “design” within the meaning of the Designs Act. Abstract concepts are not registerable as designs.

**35.** The following passage from P. Narayanan’s Law of Copyright and Industrial Design, which sets out the object of registration of a design, was quoted, with approval, by the Supreme Court, in *Bharat Glass Tubes*<sup>22</sup>:

“**27.01. Object of registration of designs.** - The protection given by the law relating to designs to those who produce new and

<sup>30</sup> (1959) RPC 347



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.”*

(Emphasis Supplied)

Thus, one should not confuse the principle of “ocular appeal” or “visual appeal” with “attractiveness”. “Appeal” is a highly subjective concept, and beauty lies in the eyes of the beholder. Often, as Narayanan says, strange and bizarre designs may also appeal. Dali captivates as much as Da Vinci. What matters is, therefore, whether the design is unique, *vis-à-vis* prior art, and whether the unique



features of the design, *vis-à-vis* prior art, attract the eye. If they do, and the difference is not merely mechanical or functional in nature, the Court has to view the matter objectively, and not from the subjective point of view of a connoisseur of the arts.

**36.** What the Designs Act protects is, however, an idea which is to be applied to an article, and not a mere idea *in vacuo*. An idea, which is not intended for temporal manifestation, by application of industrial process, cannot, therefore, be protected under the Designs Act. That much is clear even from Section 2(d), which envisages every “design”, under the Designs Act, being applied to an article. To quote from Narayanan, as approved in *Bharat Glass Tubes*<sup>22</sup>, “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.” What the finished article would look like, is primordial to the issue. Thus, when considering whether the features of shape, configuration, etc., when applied to an article, constitute a “design” within the meaning of Section 2(d) of the Designs Act, one has to visualize, in the mind’s eye, the finished article, after the features have been applied to it. If the features, when applied to an article, appeal to the eye, and the eye alone, then the features constitute a “design”. Thus, a “design” constitutes of features of shape, configuration, etc., applied, or meant to be applied, to an article of manufacture by industrial process which, when so applied, appeal when judged solely by the eye, and must not be purely functional in nature. This is the somewhat nuanced concept of a “design”, under the Designs Act.



37. Designs which are not “new or original” cannot be registered, by virtue of the proscription contained in clause (a) of Section 4 of the Designs Act.

38. The Designs Act does not define “new”. The expression “original” is, however, defined in Clause (g) of Section 2, *vis-à-vis* a design, as originating from the author of the design. In other words, the feature of shape, configuration, pattern, etc. which is sought to be regarded as “design” must have its origin in the originator of the design. At the same time, the definition includes “cases which though old in themselves yet are new in their application”. Features of shape, configuration, pattern, etc. which may already existed in prior art may, nonetheless, qualify as original, within the Section 2(g), if, the manner in which they are applied is new.

39. The jurisprudential contours of a “design”, as well as the expression “new” used in the context thereof, were thus identified by the Supreme Court in *Bharat Glass Tube*<sup>22</sup>:

“ “Design” has been defined in Section 2(d) which means that a feature of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process. That means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal. The definition of “design” as defined in Section 2(d) read with application for registration and Rule 11 with Form 1 makes it clear that the design which is registered is to be applied to any finished article which may be judged solely by eye appeal. A conjoint reading of these three provisions makes it clear that a particular shape or a particular configuration is to be registered which is sought to be produced on any article which will have visual appeal.



Such design once it is registered then it cannot be pirated by any other person. But the question is whether it is new or original.”

(from para 30)

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

(from para 34)

“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.”

(from para 36)

“The question of eye appeal came up for consideration in *Interlego AG v. Tyco Industries Ltd*<sup>31</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:

‘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>32</sup>, *Stenor Ltd. v. Whitesides (Clitheroe) Ltd*<sup>33</sup>, and *Amp Inc. v. Utilux Pty. Ltd.*<sup>33</sup>, and in the more recent Irish case of *Allibert S.A. v. O-Connor*<sup>34</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

<sup>31</sup> (1988) 3 All ER 949

<sup>32</sup> (1927) 44 RPC 503

<sup>33</sup> 1972 RPC 103 (HL)

<sup>34</sup> 1981 FSR 613





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>35</sup> :

‘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.’”

(from para 40)

**40.** The Supreme Court held, in *Bharat Glass Tube*<sup>22</sup>, that the burden to show that a registered design suffered from want of novelty and originality was on the person who so alleged or asserted. While so holding, the Supreme Court explained the expression “new or original”, as it figures in Clause (a) of Section 4 of the Designs Act, thus:

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

**41.** The aspect of novelty and originality of a registered design *vis-à-vis* prior art was also considered by a Full Bench of this Court in *Carlsberg Breweries A/S v. Som Distilleries And Breweries Ltd*<sup>36</sup>, in which it was observed as under:

<sup>35</sup> 1987 FSR 283

<sup>36</sup> AIR 2019 DEL 23 (FB) : 2056 (2019) DLT 1 (FB)



“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 off 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.”

42. Thus, held the Full Bench,
- (i) the registration of a design *facially* indicates satisfaction of the test of novelty and absence of prior publication, but
  - (ii) to be eligible to registration,
    - (a) the article in question must be unique or novel in regard to elements such as shape, configuration, pattern, ornament or composition of lines of colours applied to it and
    - (b) it has to have visual, i.e. aesthetic, appeal.

43. While *Carlsberg Breweries*<sup>36</sup> examined the aspect of novelty and originality, prior publication of the design is also one of the grounds on which it is rendered vulnerable to cancellation on the



ground of invalidity. The Designs Act does not, however, define “publication”. A Full Bench of this Court examined the matter in *Reckitt Benckiser Ltd. v. Wyeth Ltd.*<sup>37</sup>. *Reckitt Benckiser*<sup>37</sup> was rendered by a Full Bench to which the aspect of “prior publication” have been referred by an earlier Division Bench who, in turn, doubted the correctness of an earlier Division Bench decision in *Dabur India Ltd. v. Amit Jain*<sup>26</sup>. *Dabur India*<sup>26</sup> held that publication abroad by existence of the asserted design in a suit in the records of Registrar of designs which was open to public inspection constituted “prior publication”.

**44.** The Full Bench noted that, by virtue of Section 19(1)(b) of the Designs Act, prior publication of a design could either in India or abroad, unlike prior registration of a design, which had necessarily to be in India, under Section 19(1)(a), in order to constitute a ground to cancel a subsequent registered design. Thereafter, on the aspect of publication, the Full Bench went on to hold thus:

“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

<sup>37</sup> AIR 2013 DEL 101 (FB) : 198 (2013) DLT 521 (FB)



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)

**45.** After holding that, in *Bharat Glass Tube*<sup>22</sup>, the Supreme Court had held that prior publication was required to possess sufficient clarity, in that it had to be capable of being completely understood for its effect when actually put on an article, the Full Bench in *Reckitt Benckiser*<sup>37</sup> went on to explain, in para 19, the concept of “publication in a tangible form”, as envisaged in Section 4(b) of the Designs Act:

“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.”*

(Emphasis supplied)

46. The principles in *Bharat Glass Tube*<sup>22</sup> were held, by the Full Bench, to be reinforced by the following passages from Russell-Clark and Howe on Industrial Design:

*“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>38</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

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<sup>38</sup> 1893 RPC 29



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>39</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 Westbury in *Hills v. Evans*<sup>40</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

<sup>39</sup> 1957 RPC 239

<sup>40</sup> (1862) 4 DeG., F&J. 288





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>41</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>42</sup>, and again (when delivering the judgment of the Judicial Committee) in *Pope Alliance Corporation v. Spanish River Pulp & Paper Mills Ltd.*<sup>43</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.’*

(Italics supplied; underscored in original)

47. If the differences between prior art and the suit design are merely trade variants, the suit design cannot aspire either to novelty or to originality. On what is a “trade variant”, this Court has consistently been following the principles laid down in *Phillips v. Harbro Rubber Co.*<sup>18</sup>, which was thus distilled by a Division Bench of this Court in *B. Chawla*<sup>17</sup>:

<sup>41</sup> (1908) 25 RPC 428

<sup>42</sup> (1928) 45 RPC 1

<sup>43</sup> AIR 1929 PC 38



“In *Phillips v. Harbro Rubber Company*<sup>18</sup>, Lord Moulton observed that while question of the meaning of design and of the fact of its infringement are matters to be judged by the eye, 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 that 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 any man does not make a new and original designs 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 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 distinguished from that 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 tender 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.”

### Applying the law to the facts

**48.** When the aforesaid legal position is applied to the suit designs, *vis-à-vis* the prior art to which Mr. Sushant Singh has drawn attention, this Court is unable to convince itself that the suit designs can be treated as, *prima facie*, novel and original *vis-à-vis* prior art. The only two features of the suit designs, in which novelty and originality are





claimed by the plaintiffs, are the vertical ribs along the length of the suit designs and the flanges on the rim. The various prior arts to which Mr. Sushant has alluded clearly indicate that vertical ribs along the length of the bucket/tub/mug in question, from apex to base, as well as extended flanges at the rim of the concerned vessel, are not features which have originated from the plaintiff, but have been in use and application even prior thereto. The vertical ribs in the designs are identical to the vertical ribs in the designs constituting prior art. Insofar as the flanges on the rim are concerned, no doubt, there may be minor variations regarding their shape, number, the extent of their protrusion from the rim, and other such minor features. The plaintiffs have not been able to convince us these changes make any substantial difference to the flanges. These minor changes, therefore, in my considered opinion, constitute merely trade variants within the meaning of the expression as understood in *Phillips*<sup>18</sup>.

**49.** The following prior published designs (as applied to specific articles), in my view, make out a credible challenge to the validity of the suit designs:

- (i) Bathroom tub as uploaded by Sara China Bona Mould on 18 June 2019:



(ii) Mug, as uploaded by Sara China Bona Mould on 18 June 2019:



(iii) Tub No. BN2103169 invoiced by Bona Mould to Crown Craft, Jaipur on 26 June 2019:



(iv) Mug No. BN2103170 invoiced by Bona Mould to Crown Craft, Jaipur on 26 June 2019:



(v) Bucket from the catalogue of Migeplastics:



(vi) Design 784645 registered in favour of David A. Richardson

(vii) SeMius Durable Practical Solid Geometric Shape Storage Garbage Household Trash Can available on amazon.in since 14 March 2019:





These designs constitute legitimate prior art so as to constitute prior publication within the meaning of Section 4(b) read with 19(d), and 19(b), as well as to divest the suit designs of novelty and originality within the meaning of Section 4(a)/19(c) of the Designs Act.

**50.** I am, therefore, *prima facie* of the opinion that the defendant has succeeded in launching a credible challenge to the suit designs as suffering from lack of novelty and originality vis-à-vis prior published designs both with respect to the ribs along bodies of the suit designs as well as the extensions/flanges on the rim.

**51.** As I have arrived at the aforesaid conclusion on a visual appreciation of the suit designs, *vis-à-vis* prior art, it is not necessary to examine, in detail, the various judicial precedents on which learned Counsel sought to place reliance. Suffice it to state that, insofar as the aspect of estoppel is concerned, no registration having been obtained by the defendant in respect of the impugned designs, and Mr. Sushant Singh having, on instructions from his clients, undertaken to withdraw the application seeking registration, it cannot be said that the defendants are estopped from questioning novelty and originality of the suit designs *vis-à-vis* prior art.

**52.** As a result, the plaintiffs' prayer for interlocutory injunction has necessarily to be rejected, in view of Section 22(3) of the Designs Act.

**53.** Accordingly, I.A. 13422/2022 is dismissed and I.A. 13425/2022 is allowed.



**54.** The *ad interim* interlocutory injunction granted by the learned Commercial Court on 8 June 2022 stands accordingly vacated.

**C. HARI SHANKAR, J.**

**JULY 3, 2023**

*dsn/ar*

HIGH COURT OF DELHI



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