

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

% Judgment reserved on: 31.07.2012
Judgment pronounced on: 06.08.2012

+ CS(OS) 1841/2008

TARUN SETHI & ORS. Plaintiffs
Through: Mr. Tushar Malhotra, Adv.

versus

VIKAS BUDHIRAJA & ORS Defendants
Through: Mr. N.K. Kantawala, Mr. Rajesh
Sharma, Mr. Praven Sharma, Mr.
Satyender Chahar and Mr. Ritesh
Mehra, Advocates

CORAM:
HON'BLE MR. JUSTICE V.K.JAIN

V.K. JAIN, J.

1. Plaintiff No. 3, which is a partnership firm of plaintiff Nos. 1 and 2, is engaged in the business of manufacture and sale of hardware, such as door closers, spring hinges, etc. One of the products of the plaintiffs is a door spring which it is selling under the trademark 'YEN'. The design of the aforesaid door spring is

registered vide design registration No. 202794 dated 05.01.2006 which continues to subsist. The said design, according to the plaintiffs, consists of a unique capsule shape of the door spring and a thin and light handle which is made of iron and the arrangement of the two. The original, novel and essential feature of the said design is stated to be the shape and configuration of the door spring which is alleged to be distinctive and unique to the plaintiffs' door spring under the mark 'YEN'. Defendant No. 3 Ritz Metal Works is also engaged in manufacture and sale of door closer. The case of the plaintiffs is that the door closer being manufactured and sold by the defendants is identical to their door closer design which is registered since 05.01.2006 and, therefore, they are infringing plaintiffs' right in the aforesaid registered design. The following are comparative chart has been given in the plaint to illustrate the identical features of the two products:-



Capsule with Ring positioned in the centre. 2 Semi Circular Silver Caps on either side of the capsule. 2 Rectangular shaped hinge plates that are moulded into the body of the capsule shaped cylinder. Each Hinge Plate has 2 holes that are equidistant from one another. A the centre there is a chrome plated ring with 4 holes for fixing the rod of the door closer which divides the capsule into 2 equidistant halves. From the centre ring is a thin rod which can be fitted at any one of the holes of the ring. Sticker on both sides of the ring	Capsule with Ring positioned in the centre 2 Semi Circular Silver Caps on either side of the capsule. 2 Rectangular shaped hinge plates that are moulded into the body of the capsule shaped cylinder. Each Hinge Plate has 2 holes that are equidistant from one another. At the centre there is a chrome plated ring with 4 holes for fixing the rod of the door closer which divides the capsule into 2 equidistant halves. From the centre ring is a thin rod which can be fitted at any one of the holes of the ring. Sticker on both sides of the ring
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Back View	Back View
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Two uniquely shaped hinge plates with two holes each that are moulded from the body of capsule shaped cylinder and come outwards. The two hinge plates are separated from one another by the ring on the body of the capsule and remain a few centimeters apart when protruding outside the capsule. The rod appears to come from below and from between the Hinge Plates.	Two uniquely shaped hinge plates with two holes each that are moulded from the body of capsule shaped cylinder and come outwards. The two hinge plates are separated from one another by the ring on the body of the capsule and remain a few centimeters apart when protruding outside the capsule. The rod appears to come from below and from between the Hinge Plates.
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The plaintiffs have sought injunctions, restraining the defendants from making, selling, offering for sale or advertising door springs which are imitations of their registered design.

They have also sought delivery up of the infringing material and damages amounting to Rs 20 lakh. Rendition of account from the defendants has also claimed by them.

2. In their written statement, the defendants have taken a preliminary objection that there is no cause of action in favour of the plaintiffs since they are not proprietors of design, shape, configuration and pattern of capsule door closer/door spring registered at serial No. 202794 dated 05.01.2006. It has been further alleged that while obtaining registration of the aforesaid design, the plaintiffs were fully aware that capsule door closer/door spring with immaterial variations were available in the market much prior to the date of the application by them and the plaintiffs themselves had advertised capsule door/door spring in a magazine in September-October, 1999. It is further stated that on 18.04.2002, the plaintiffs had obtained design registration in respect of door spring vide registration No. 188784 which was also of capsule shape and the design registered at serial No. 202794 on 05.01.2006 is merely a trade variation and is not altogether different from the design registered at serial No. 188784. It is further alleged that

defendants are manufacturing and marketing capsule door closers/door springs since in the year 2000 and they had also advertised their products August, 2003 onwards.

3. The following issues were framed on the pleadings of the parties:-

- i) “Whether the suit is liable to be rejected under Order 7 Rule 11 (a) CPC? OPD
- ii) Whether the plaintiffs are the proprietors of the design registered under No. 202794 dated 05th January 2006 in respect of the *“shape and configuration of the door spring”*? OPP
- iii) Whether the defendant’s product is identical to the plaintiff’s product registered under No.202794 dated 05th January, 2006 and if so, whether it amounts to infringement of the plaintiff’s aforesaid registered design? OPP
- iv) Whether the defendant’s product/design is identical to the plaintiff’s product/design and hence its use by the defendants amounts to passing off its product/design as that of the plaintiffs’ product/design? OPP
- v) Whether the design of capsule door closer/door spring registered at No. 202794 is a pre-published design? OPP
- vi) Whether the defendants have been manufacturing and marketing the impugned

capsule door closure and door springs since the year 2000, if so, to what effect? OPD

vii) Relief.

4. Two witnesses each have been examined by both the parties.

5. **Issue No. (i)**

On a perusal of the plaint, it cannot be said that the plaint does not disclose any cause of action. It has been specifically stated in the plaint that the plaintiffs' design is registered vide design registration No. 202794. It is also alleged that the product of the defendants is identical to the product of the plaintiffs, design of which is registered vide design registration No. 202794. It is also alleged that the defendants are infringing the design of the plaintiffs by selling door spring, design of which is identical to the registered design of the plaintiffs. Even otherwise, no arguments were advanced on this issue. Hence, the issue is decided against the defendant and in favour of the plaintiffs.

6. **Issue No. (vi)**

There is absolutely no documentary evidence of the defendants manufacturing and/or marketing the capsule door closer/door springs having been the impugned design, since the year 2000. No magazine or newspaper showing any advertisement of the impugned product by the defendants at any time prior to 05.01.2006 has been filed by them. The invoices Ex.DW-1/6 to DW-1/19 pertain to sale of hydraulic door closers and door springs under the brand name Ritz, but there is no documentary evidence to prove that the door springs/door closers sold vide these invoices was identical to the products impugned in the present suit. No photograph of the product has been printed on the invoices. No customer has been produced by the defendants to prove purchase of impugned product prior to 05.01.2006. In these circumstances, there is no escape from the conclusion that the defendants were not manufacturing and/or selling the impugned product prior to 05.01.2006. The issue is decided against the defendants and in favour of the plaintiffs.

7. **Issue No. (ii)**

The registration No. 202794 in favour of the plaintiffs is Ex.PW-1/3. This document is sufficient to prove that the plaintiffs are registered proprietors of the design registered vide registration No. 202794 dated 05.01.2006. The issue is decided against the defendants and in favour of the plaintiffs.

8. **Issues No. (iii), (v) and (vii)**

‘Design’ is defined in Section 2(d) of the Designs Act, 2000 which, to the extent relevant for our purpose stipulates that “design” means only the 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 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 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 any artistic work as defined in clause 9c) of Section 2 of the Copyright Act, 1957.

Therefore, novelty factor may rest only in its shape, configuration, pattern, ornament or composition of lines or colours applied to any article.

Section 4 of the Designs Act, 2000, to the extent it is relevant, prohibits registration of a design which is not new or original or is not significantly distinguishable from known designs or from combination of known designs or has been disclosed in the public anywhere in India or in any other country by publication in a tangible form or by use or in any other way prior to the filing date.

Section 19 of the Designs Act provides that 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, *inter alia*, on the ground that the design is not a new or original design or has been published in India or in any other country prior to the date of its registration or that it is not design as defined under clause (d) of Section 2.

Sub-section (1) of Section 22 of the aforesaid Act, to the extent relevant for our purpose provides that during the existence of copyright in any design, it shall not be lawful for any

person, for the purpose of sale to apply to cause to be applied to any article or 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. Sub-section (2) of the said Act provides that if any person acts in contravention of that Section, he shall be liable, 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 and to be restrained by injunction accordingly. Sub-section (3) of the said Act provides that 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.

9. Whether a particular design has novelty in it or not is a matter of fact which needs to be decided primarily by the human eye. It is the settled proposition of law if a particular shape or pattern or a substantially similar shape or pattern has previously been published or used, the design incorporating such a shape or pattern cannot be said to be a novel design. Mere variations or

modifications which do not substantially alter a previously published shape or design, which any skill person can make, are not sufficient to bring novelty to the design.

10. A perusal of the registration in favour of the plaintiff would show that novelty was claimed by the plaintiff only in the shape and configuration of the door spring as illustrated in the registration. Thus, no novelty on account of pattern, ornament or colours applied to the door spring was claimed. Even the case set out in the plaint is that the registered design of the plaintiff consists of a unique capsule shape of the door spring and a thin and light handle, which is made of iron and the arrangement of the two. It is further alleged that the original, novel and essential feature of the plaintiff's design are the shape and configuration of the door spring. Therefore, the only question to be examined in this case is as to whether the shape and configuration of the door spring of the plaintiff were previously published or not. A perusal of the registered design of the plaintiff and the door closer being manufactured and sold by the plaintiff would show that the product comprises one capsule, two hinges having two capsule, four holes each, and an iron rod

which fits into one of the four holes in the round bar in the middle of the capsule. The round edges of the capsule are chrome plated and appear to have been separately fixed one each on both the sides. There is a chrome plated circular bar in the middle of the capsule. The product being manufactured and/or sold by the defendants is identical except to the extent that there are two chrome plated roller at the foot of the iron rod, in the product of the defendant. Also, there is an ornamental plastic part in chrome colour, fixed at the bottom of the iron rod in the product of the plaintiff. This, however, is not found in the product of the defendants.

11. Ex.DW-1/21 is the October 2009 edition of Hardware India. The capsule door closer published in this journal comprises a capsule with an iron rod in the middle of the capsule. There is a chrome plated round bar in the middle of the capsule and the rod fits into one of the four holes of the chrome plated bar. There are two hinges having two holes each at the backside of the capsule. Similar product is published in January/February 2004 issue of Hardware and Sanitary Use (Ex.DW1/23 to 27). Such product has also been published in September-October 2004

issue of sourcing hardware (Ex.DW-1/29-30). Yet another publication containing advertisement of capsule door closer is November/December, 2004 issue of Indian Hardware and Sanitary Use (Ex.DW-1/31 to 37).

12. The plaintiff is claiming registration since 05.01.2006. The above-referred publications being prior to 05.01.2006, there can be no dispute that capsule shaped door closer/door hinge were available in the market much prior to the registration vide design registration No.202794 in favour of the plaintiff. As noted earlier, the plaintiff, at the time of registration claimed novelty only in the shape and configuration of the door spring. There is no difference in the configuration of the door springs which were advertised prior to 05.01.2006 and the door spring design which is registered vide registration No.202794. The products which were available in the market prior to January 2006 as well as the products of the plaintiff comprises a capsule, two hinges with holes in them and an iron rod fitting into one of the holes of the round bar in the middle of the capsule. Therefore, it is difficult to say that the shape of the product of the plaintiff is materially

different from the shape of the products which were available in the market prior to 05.01.2006.

It is true that in the capsule which was available in the market prior to 05.01.2006, the whole of the capsule was painted with brown colour whereas in the product of the plaintiff, the edges of the capsule are chrome plated. A perusal of the design registration in favour of the plaintiff would show that no claim was made by the plaintiff to any right to the exclusive use of the colour or colour combination appearing in the design. Therefore, it was very much open to the defendants to use chrome on the sides of the capsule instead of applying the brown colour to the whole of the capsule. It is true that the edges on the sides of the capsule, in the product of the plaintiff appear to have been separately fixed which is not the case in the product which was available in the market prior to 05.01.2006 but, that, to my mind, a trade variant of the product and it cannot be said that an altogether new shape was brought out by the plaintiff merely by separately fixing the edges on the capsule. The shape was of a capsule in the products which were available in the market prior to 05.01.2006. Same is the shape of product which the plaintiff

is manufacturing and selling after 05.01.2006. A capsule does remain a capsule and its shape is not altered merely by separately fixing the edges on the capsule. In fact, the shape of the plaintiff's product would not be a capsule shape unless these edges are fixed on both the sides. As far as the bar in the middle of the capsule is concerned, as noted earlier, this was there in the products which were available in the market even prior to 05.01.2006. Therefore, to my mind, the design registered vide registration No.202794 cannot be said to be a design within the meaning of Section 2(d) of the Designs Act, 2000. In my view, an ornamental variation as is found between the product of the plaintiff and the product which was available prior to 05.01.2006, cannot be said to be a novelty which was capable of being registered as a design. Therefore, in view of the provisions contained in Section 4 of the Designs Act, the design of the plaintiff which was not a new or original design or in any case, was not significantly distinguishable from the designs already available in the market, could not have been registered and, therefore, is liable to be cancelled. Though the application filed by the defendants for cancellation of the design of the plaintiff is

still pending before the Controller, the ground on which design may be cancelled is available as a defence in view of the provisions in Section 22(3) of the said Act, the design of the plaintiff is liable to be cancelled for the reason is that it is neither a new or original design nor was it registerable under the Act.

It was contented by the learned counsel for the plaintiff that the placement of hinges in the product of the plaintiff is different from the placement in the product which was available in the market prior to 05.01.2006. In my view, mere change in the placement of the hinges would not result in altering the shape of the product which was essentially a capsule with two hinges and an iron rod, prior to 05.01.2006 and continues to be the same even thereafter.

13. In **Kestos Ld. v. Kempat Ld. & Vivian Fitch Kemp** (1936)53 RPC139, it was held that if the same shape or pattern, or one substantially similar, had previously been thought of in connection with the type of article in question and the idea published, that is, made available to the public) then the design was neither new nor original.

In **Allen West & Co, Ltd. v. British Westinghouse Electric and Manufacturing Co. Ltd.** (1916)33 RPC 137, it was observed that there must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article.

In **Ravinder Kumar Gupta Vs. Ravi Raj Gupta and Ors.** 1986 PTC 50, the tiles of the plaintiff was having sharp corners. The defendant started manufacturing and selling tiles with round corners. Noticing that tiles with sharp edges and corners were already in vogue prior to the registration of the impugned design, it was held by this Court, after examining both types of tiles, i.e., with sharp corners and round corners, that though the tile with round corners may look a different but it was not altogether a new or a different design. It was further held that merely because the round corner was conceived by the respondent, he could not get it registered as a new design as envisaged under Section 2(5) of the Designs Act, 1911. It was observed that the new design should be something like inventive and by making the corners from sharp to round, it cannot be said that a new design has been created from one's own mind and thought. New would

be something which is developed and is not earlier in existence. It should be striking new design. This Court observed that though round corner tiles may look fresh, it cannot be said that there was any new or novel idea involved in bringing out a tile with round corner.

The case of the plaintiff before this Court, is much weaker than the case of the plaintiff in the above-referred case. In the case before this Court, the shape of the products which were available in the market prior to 05.01.2006 was the same as is the shape of the product of the plaintiff, both primarily being capsule shaped with a rod in the middle of the capsule.

In **B. Chawla & Sons v. Bright Auto Industries** AIR 1981 Delhi 95, a Division Bench of this Court observed that what the appellants were required to satisfy was that their design had a substantial novelty or a striking newness for the instructed eye. In that case, the appellant had got design in respect of a mirror registered in its favour. The mirror of the appellant was a common type rectangular mirror with a slight curve on the upper side. The respondents sought cancellation of the registration on account of that such mirror were available in the market and

there was now newness or originality about the design of the appellant. No rectangular mirror having a curve on either side in the sloping upper length was available in the market. Therefore, the only question before the Court was whether a further curve on either side in the sloping upper length side made the design in respect of rear view mirror a new or original design which the appellant were entitled to get registered. The Division Bench referred to the view taken in **Phillips v. Barbro Rubber Company** (1920) 37 R.P.C. 233, wherein it was observed that introduction of ordinary trade variants into an old design cannot make it new or original. One example given in that case was spikes in the soles of running shoes. The Court was of the view that having spikes in the sole of running shoes does not make a new and original design. It was further observed 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 variant.

The following observations made by the Division Bench in the above-referred case are pertinent:-

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

As regards the case before it, the Division Bench noted that the design in question as a whole consisted rectangular shape with rounded edges with sides curved or sloping with a further curve on either side in the sloping upper length side. There were standard models of back mirrors which were rectangular in shape with sloping widths and lengths. In some of them, there was a curve in the upper length side. The appellants' case was that a further curve in the sloping upper length side made their design new or original. The Division Bench noted that the extent and nature of the novelty was not endorsed by the appellants in the application for seeking

registration and, therefore, it had to be taken only as regards the shape and configuration. The Court felt that addition of further curve on either side did not make the variation striking one or a substantial so as to constitute a novelty meriting registration.

14. In the case before this Court also, no novelty in the design was claimed on account of the placement of the hinges or on account of the edges of the capsules having been chrome plated and separately fixed. The novelty was claimed only in the shape and configuration. As regards configuration, I have already noted that there is no difference in the configuration of the products which were available in the market prior to 05.01.2006 and the product of the plaintiff. As regards shape, the same continues to be capsule shape even in the registered design of the plaintiff. Therefore, there is nothing so new or different in the design of the plaintiff, which would bring such a novelty factor as would qualify for registration of a new design.

15. For the reasons stated hereinabove, the issues are decided against the plaintiffs and in favour of the defendants.

ORDER

In view of my findings on the issues, the suit is hereby dismissed. There shall, however, be no order as to costs.

Decree sheet be drawn accordingly.

V.K.JAIN, J

AUGUST 06, 2012
'bg'/'sn'