



IN THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment delivered on: 05.08.2022

+ **RFA(OS)(COMM) 4/2021 and CM Nos. 21961/2021, 21962/2021 & 21963/2021**

KAMDHENU LIMITED

.....Appellant

Versus

AASHIANA ROLLING MILLS LTD

..... Respondent

Advocates who appeared in this case:

For the Appellant : Mr. Sudarshan Kumar Bansal, Mr. Kumar Shashwat & Mr. Nikhil Sonkar, Advs.

For the Respondent : Mr. Kapil Wadhwa, Ms. Surya Rajappan and Ms. Tejasvini Puri, Advs.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

HON'BLE MR. JUSTICE AMIT MAHAJAN

JUDGMENT

VIBHU BAKHRU, J

INTRODUCTION

1. The appellant (hereafter '**Kamdhenu**') has filed the present intra-court appeal impugning the judgement dated 12.05.2021 (hereafter '**the impugned judgement**'), whereby the learned Single Judge allowed the application filed by the respondent (hereafter '**Aashiana**') under Order XIII-A of the Code of Civil Procedure, 1908 (hereafter '**the CPC**') and dismissed the suit filed by Kamdhenu, being CS (COMM) 90/2018. The appellant had filed the said suit



alleging infringement of its registered design regarding the surface pattern on steel rods.

2. The learned Single Judge found that the design in question was a prior published design and held that the registration of the said design was contrary to Section 4 of the Designs Act, 2000 (hereafter '**the Act**'). Kamdhenu contends that the said finding is erroneous as the prior published design in question (British Standard B500C) is an industry standard and several surface designs are conceivable conforming to the said standard.

FACTUAL CONTEXT

3. Kamdhenu is engaged in the business of manufacturing and marketing steel bars and other allied goods under the name and trademark 'KAMDHENU'. Kamdhenu claims that it created and developed a unique design, having new and original features of surface pattern, comprising of double ribs applied to steel bars, in the year 2012-2013.

4. Thereafter, on 14.01.2013, Kamdhenu obtained a Design Registration bearing no. 250968 under Class 25-01 (hereafter '**the said design**'), in respect of 'Rod for Construction'. The Controller General of Patents, Designs and Trade Marks has issued a certificate dated 29.08.2014 evidencing registration of the said design in favour of Kamdhenu.

5. Kamdhenu states that the said design was applied to its 'best quality steel bars' under the name of 'KAMDHENU SS 10000 TMT';



a product which was launched on 18.06.2013. It achieved considerable commercial success and the monthly sales have been increasing since. The monthly sales of the product in question amounted to approximately ₹60 crores in the year 2013-2014; over ₹100 crores in the years 2014-2015 and 2015-2016; and, approximately ₹83 crores in the year 2016-2017.

6. Kamdhenu claims that in the month of June 2017, it discovered that Aashiana was selling steel bars with similar surface design under the name 'FRIENDS 500 HD TMT BARS' in several markets across South Delhi. Kamdhenu alleges that Aashiana applied/copied/adopted/imitated a surface design, which is similar to the said design.

7. On 12.06.2017, Kamdhenu filed a suit before the learned District Court, Saket, *inter alia*, seeking a permanent injunction to restrain Aashiana from using the said design. By an order dated 15.06.2017, the learned District Court, Saket granted an *ex parte* order of injunction and appointed a Local Commissioner to inspect the premises of Aashiana and seize the infringing goods and packing material. The said suit was subsequently transferred to this Court. This Court, by an order dated 03.11.2017, confirmed the interim protection granted to Kamdhenu by the order dated 15.06.2017.

8. Aashiana preferred an appeal [being FAO (OS) 309/2017] against the decision of the learned Single Judge restraining Aashiana from infringing the said design, which was registered in favour of Kamdhenu. The said appeal was allowed and by an order dated



23.08.2018, the Division Bench of this Court set aside the order dated 03.11.2017 passed by the learned Single Judge and held that the relevant and material circumstances with respect to prior publication were not taken into account and analysed in the proper perspective. Kamdhenu challenged the said order before the Supreme Court by filing a Special Leave Petition [being SLP (Civil) no. 32594/2018]. The said SLP was dismissed by the Supreme Court by an order dated 11.02.2019.

9. During the pendency of the appeal, Aashiana filed an application [being I.A. 647/2018] under Order XIII-A of the CPC seeking dismissal of the suit [CS (COMM) 90/2018] filed by Kamdhenu. Aashiana contended that the suit instituted by Kamdhenu has no real prospect of success and is therefore, liable to be dismissed summarily. The said application was allowed by the impugned judgment and the suit was dismissed.

THE IMPUGNED JUDGEMENT

10. By the impugned judgment, the learned Single Judge held that Aashiana has established that the said design was a prior published design and therefore, its registration in favour of Kamdhenu was contrary to the Act. The learned Single Judge also found that the suit could be disposed of on the basis of undisputed material placed on record and Kamdhenu has no real prospect of success in the suit. Accordingly, the Court exercised its powers under Order XIII-A of the CPC and dismissed the suit filed by Kamdhenu.



11. The learned Single Judge found that the said design of Kamdhenu was similar to the British Standard “*Steel for the reinforcement of concrete – Weldable reinforcing steel – Bar, coil and decoiled product – Specification*” (BS4449-2005), which was published in the year 2005. The said standard provided for a surface pattern of regular repetition of a set of two ribs at different acute angles with the axis and the variance of the two angles being at least 10 degrees. The Court found that the stipulations in the British Standard were not generic stipulations but enumerated the elements of the design in some detail. The Court found that Kamdhenu had claimed novelty of the said design residing in the elements, which were described in the standard (BS 4449-2005) with a reasonable degree of specificity and therefore, the said design could not be accepted as original or novel.

12. In addition to the above, the Court noted that Kamdhenu had categorically admitted that the said design was “*equivalent to British Standard B500C*”. The Court rejected the contention that a published standard could never be sufficient to constitute a prior publication of a design. The Court held that the said question would require to be considered based on the particular design and the published standards in question. The Court found that in the present case, the product standard cited by Aashiana prescribed the design of the surface pattern and therefore, did constitute prior publication on which the said design was based.



13. In view of the above, the Court found that the said design was not novel and therefore, incapable of registration.

SUBMISSIONS

14. Mr. Bansal, learned counsel appearing for Kamdhenu, has assailed the impugned judgment, essentially, on two grounds. First, he submitted that the Court had erred in not appreciating that there can be multitude of surface patterns complying with the given standard. Consequently, the Court had erred in proceeding on the basis that the said design was not novel as it conforms to the British Standard B500C.

15. Second, he submitted that the Court had erred in summarily dismissing the suit under Order XIII-A of the CPC without affording Kamdhenu any opportunity to lead evidence. He submitted that the question whether the design was novel was required to be determined on a visual examination by a person trained in the field. Thus, Kamdhenu could lead expert evidence to establish that the said design was novel, which could be appreciated by a trained eye. He contended that minor changes in the angles of the ribs would result in a different design.

16. Mr. Bansal also contended that the British Standard B500C, as referred to by the learned Single Judge, depicted a pattern of ribs by singular lines. However, the said design consisted of two lines and therefore, was different.



REASONS & CONCLUSIONS

17. The principal question to be addressed is whether the published standard – British Standard BS4449-2005 for B500C – constitutes a prior publication of the surface design, so as to render the registration of the said design contrary to Section 4 of the Act.

18. The image of the product manufactured by Kamdhenu is set out below:



19. In the present case, the surface patterns for Grade B500C bars are relevant. Admittedly, the said design conforms to the surface pattern as published in the British Standard (BS4449:2005). According to Kamdhenu, the surface pattern on its product is “*equivalent to British Standard B500C*” and is “*at par*” with the said standard.

20. It would be relevant to examine the British Standard for B500C. The relevant extract from the published standard is set out below:

“10.2 Identification of steel grade

The steel grade shall be identified by the product’s surface features (arrangement of the transverse ribs) as follows:



Grade B500A: xxxx xxxx xxxx

Grade B500B: xxxx xxxx xxxx

Grade B500C: bars shall have the same arrangement of rib series as for B500B. However, in each rib series, the ribs shall alternate between a higher and lower angle with respect to the bars axis. The difference between the angles of the different ribs and the bar axis shall be at least 10^0 . An example of rib pattern of grade B500C with two transverse rib series is given in Figure 4.

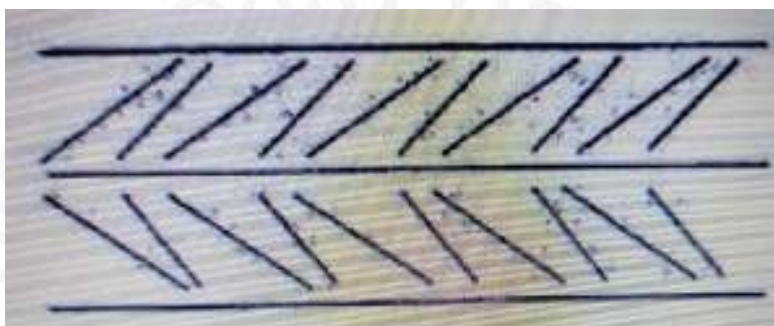


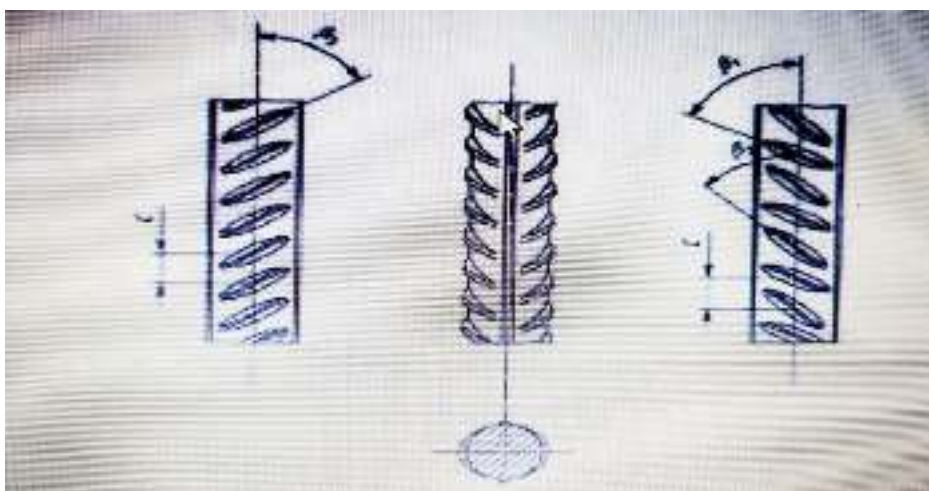
Figure 4 – Example of rib pattern for grade B500C”

21. Indisputably, the lines depict transverse ribs. As is apparent from the above, the surface pattern consists of a set of two transverse ribs, which are at acute angles to axis. The standard also specifies that the difference in the angles of the two ribs would be at least 10 degrees.

22. The contention that there is a distinction between the surface as depicted by singular lines and the said design, which consists of two lines, is insubstantial. Each transverse line, as set out in the standard for B500C, depicts a transverse rib. Kamdhenu has depicted the transverse rib by two lines to give a three-dimensional effect, however, that does not change the surface pattern in any manner.

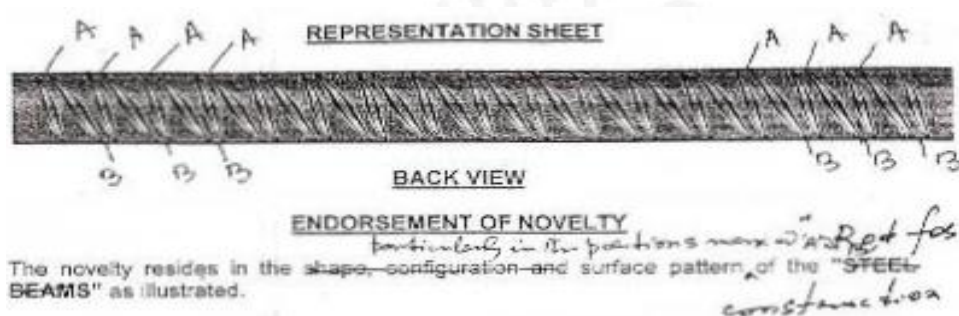
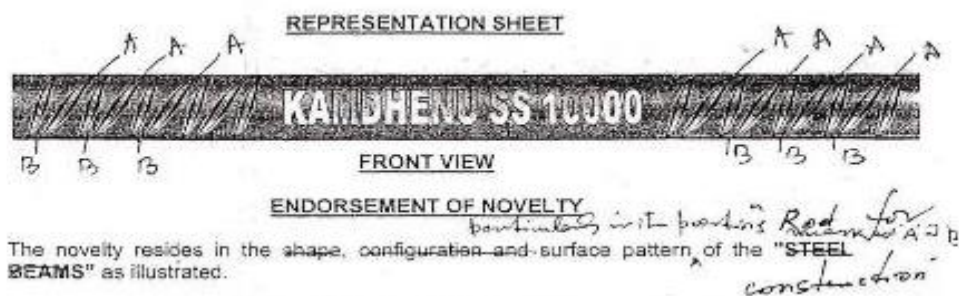


23. The standard published by the ISO (International Organization for Standardization) in respect of steel for reinforcement of concrete [ISO 6935-2:2007(E)] also provides that “*Ribbed bars shall have transverse ribs*”. The illustration of a bar with varying rib inclination, as set out in the said standard, is reproduced below:



24. It is apparent from the above that the surface pattern comprising a set of two transverse ribs with different angles was published prior to Kamdhenu adopting the said design or applying for its registration.

25. Having examined two of the published standards, it is now essential to examine the design registration granted to Kamdhenu in respect of the said design. The Representation Sheet annexed to the Certificate of Registration is set out below:



26. The Representation Sheet annexed to the Certificate of Registration in respect of the said design also bears a noting regarding the novelty of the design. The said noting reads as under:

"The novelty resides in the surface pattern particularly in the portions marked 'A' and 'B' of the 'Rod for Construction' as illustrated".

27. It is apparent from the above that Kamdhenu claims novelty in the pattern comprising a set of two transverse ribs with different acute angles. It is material to note that the Certificate of Registration does not indicate the degree of the two angles or any other special feature of the transverse ribs.



28. It is apparent that the surface pattern is precisely the standard that was published. It is correct that the published standard does permit a set of transverse ribs with different angles. However, the same has no material effect on the surface pattern.

29. Mr. Bansal's contention as to novelty, which is premised on the basis that a minute change in the angle of two transverse ribs would result in a different design, is unpersuasive. First of all, Kamdhenu has obtained the registration in respect of the said design by claiming novelty in the surface pattern of the two ribs without specifying the angles of the two ribs. Thus, the novelty claimed is not in respect of any specified angle but of a general pattern of the two transverse angular ribs, which were marked as 'A' and 'B' in the Representation Sheet. Clearly, such angular transverse ribs are not a novel design but are disclosed by the published standards.

30. Secondly, it is also material to note that the British Standard also specifies that the difference in the angles of two transverse ribs is required to be greater than 10 degrees. The transverse ribs are at an acute angle to the axis. ISO 6935-2:2007(E) also specifies that the angles of the ribs are to be greater than 35 degrees. Given these limited parameters, there are only a definite number of variations that are possible. A minuscule alteration in the angles would not in any manner change the pattern as visually discernible.



31. Clause (d) of Section 2 of the Act defines the term ‘design’ as under:

“2(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 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; 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 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).

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

33. The question of ‘eye appeal’ has been considered in a multitude of judgments. In ***Gaskell & Chambers Ltd. v. Measure Master Ltd.:*** **1993 RPC 76**, the learned Judge observed that “*the decision whether the registered design and the designs of the alleged infringements are substantially different is for the court and cannot be delegated to the*



opinions of the witnesses. It must be decided on a comparison of the features which appeal to, and are judged by, the eye. To do this, the court must adopt the mantle of a customer who is interested in the design of the articles in question as it is the eye of such an interested person, the interested addressee, which is relevant.”

34. In ***Steelbird Hi-Tech India Ltd. v. S.P.S. Gambhir & Ors.: 2014 SCC OnLine Del 821***, this Court observed that “*it is rightly held in the cases decided that in the matter of novelty the eye is to be the ultimate test and the determination has to be on the normal ocular impression*”. Furthermore, in the case of ***Western Engineering Co. v. Paul Engineering Co.: AIR 1968 Cal 109***, the Calcutta High Court observed that “*the definition itself lays emphasis on the fact that the sameness of the features is to be decided by the eye, that is to say, by seeing the two and getting a total synoptic view of the same. The sameness of features does not necessarily mean that the two designs must be identical on all points and differ on no point..... It is absurd to suggest that a slight variation between the earlier design and the subsequent design would make the two designs different...*”

35. As noticed above, the British Standard does give specifications for the pattern of the transverse ribs with some detail. Therefore, its application to the product is clearly comprehensive.



36. It is apparent that in substance, Kamdhenu has obtained registration of a surface pattern, which is the British Standard B500C as published.

37. It is material to note that the surface pattern as specified under the British Standard B500C is a marking for identification of the steel grade. Paragraph 10.2 of the British Standard: BS4449-2005 requires that Grade B500C bars carry the surface pattern in question as a mark of identification. The purpose, *inter alia*, is to identify that the steel bar is of a particular grade. It is difficult to accept that a pattern, which is a standard to identify a particular grade, can be registered as a design. The logical sequitur of accepting that Kamdhenu would have a monopoly over the surface pattern that is required to identify a particular grade of steel is that the product manufactured by Kamdhenu would be identified as the sole product of the specified grade. Clearly, the same cannot be accepted.

38. We concur with the view of the learned Single Judge that the said design is incapable of registration and therefore, is liable to be cancelled under Section 19 of the Act. In terms of Section 22(3) of the Act, the grounds as set out in Section 19 of the Act are available as a defence to any action for infringement of a design.

39. We also concur with the view of the learned Single Judge that there was no requirement for leading any further evidence and the material on record is sufficient to return the decision in the suit instituted by Kamdhenu. Given the factual matrix, testimony of an



expert witness would not further Kamdhenu's case. Kamdhenu had no real prospect in succeeding in the suit.

40. The appeal is unmerited and, accordingly, dismissed. All pending applications are disposed of.

41. The parties are left to bear their own costs.

AUGUST 05, 2022
gsr/RK

VIBHU BAKHRU, J

AMIT MAHAJAN, J