



C.M.A. Nos. 2881 and 2883 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 22.04.2024

THE HONOURABLE MR. JUSTICE K. RAJASEKAR

C.M.A. Nos. 2881 and 2883 of 2021

and

C.M.P. Nos. 16565 and 16574 of 2021

C.M.A. No. 2881 of 2021

1. Baskar
2. Suresh ... Appellants / Respondents / Defendants

Vs.

1. G. Raghu Babu ... Respondent / Petitioner / Plaintiff
2. R. Sudhakaran ... Respondent / 3rd Respondent / 3rd Defendant
(Second respondent is given up in this appeal)

Civil Miscellaneous Appeal filed under Order 43 Rule 1 of Civil Procedure Code against the Order and Decreetal Order of Ad-injunction dated 25.01.2021 in I.A. No.2 of 2019 in O.S. No.197 of 2019 on the file of the IV Additional District Judge, Thiruvallur at Ponneri.

For Appellants : Mr. P. Raja

For R1 : Mr. Antara Balaji
(For Mr. S. Diwakar)



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C.M.A. No.2883 of 2021

1. Baskar
2. Suresh ... Appellants / Respondents / Defendants

Vs.

1. G. Raghu Babu ... Respondent / Petitioner / Plaintiff
2. R. Sudhakaran ... Respondent / 3rd Respondent / 3rd Defendant
(Second respondent is given up in this appeal)

Civil Miscellaneous Appeal filed under Order 43 Rule 1 of Civil Procedure Code against the Order and Decreetal Order of Ad-injunction dated 25.01.2021 in I.A. No.3 of 2019 in O.S. No.197 of 2019 on the file of the IV Additional District Judge, Thiruvallur at Ponneri.

For Appellants : Mr. P. Raja

For R1 : Mr. Antara Balaji
(For Mr. S. Diwakar)

COMMON JUDGMENT

These Civil Miscellaneous Appeals have been filed by the defendants against the Order and Decreetal Order of Ad-injunctions dated 25.01.2021 in I.A. Nos.2 and 3 of 2019 in O.S. No.197 of 2019 on the file of the IV



Additional District Judge, Thiruvallur at Ponneri.

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2. For the sake of convenience, the parties are referred herein according to their litigative status before the Trial Court. The brief facts leading to filing of this appeal is as follows:

3. The Plaintiff herein was involved in designing and manufacturing of various Mechanical appliances. He came up with a creative design for a forklift vehicle, by applying novel industrial design to a conventional tractor. It can be used by farmers and small industries for loading of any Agricultural products, immersible motor in the borewell, transporting any material on the field and for any outdoor commercial purposes. This form of forklift can be used for any different types of farming operations and this design is novel and innovative, and it is not subjective to any previous inventive design. He has spent a huge sum to develop the same. This design has been named “Forklift Vehicle” and his application is registered as Design No.297504 in clause 12-05, dated 13.09.2017 and he is awaiting for the approval of appropriate Authorities.



4. In the month of December 2018, he came to know that the Respondent is also “Passing off” very same design and all the respondents are trying to apply for registration of the design, since the respondents are involved in imitation of the Plaintiff's design and they are now infringing the right of the Plaintiff. The Plaintiff also issued notice to the respondents dated 28.12.2018, to stop making use of the design. The first respondent have sent a vague reply questioning the right of the Plaintiff and the second respondent has agreed to utilise the services of the Plaintiff, hence he has come forward with the relief of injunction in I.A.Nos.2 and 3 of 2019, injunctioning the respondents from using the design of the Plaintiff, passing off any vehicle that is identical or similar or colourable imitation of the petitioner's forklift vehicle.

5. The respondents filed counters and contended that the Tractor and the forklift are two differed types of motor vehicles and by integrating both the vehicles, the Plaintiff has created a different vehicle used for farming sector. This design is not an innovative one and the same is already been used in various countries. The respondent is running a lathe, doing tinkering and welding works to the farmers and stated that the plaintiff has



attempted to register the design of the tractor, which is attached with the forklift, it is a fraudulent design, since the first respondent is running a lathe and assisting the farmers, he used to fix whenever the tractor requires attachment in front of their tractor, including the forklift, hence the act of the respondent could not fall within the definition of 'passing off'. There is no *prima facie* case made out by the Applicant/ Plaintiff and the balance of convenience is also in favour of the respondents. Hence, the respondents have reiterated that the Applicant / Plaintiff has no manufacturing office of facility either to manufacture conventional tractors or forklifts or even the pallets used in forklifts.

6. The Trial Court after considering the pleadings and the Exhibits marked, has held that, since there is registration of design in favour of the plaintiff, he has *prima facie* established the fact that he is the registered owner, using this design. The vehicle modifications done by the first respondent for the second respondent was identical with the registered design of Petitioner / Plaintiff and it is an infringement of his right. Based on the reply issued under Ex.P.6, the Court has held that the respondents are having intention to manufacture the above vehicle designed by the Plaintiff.



Thereby, accepting the *prima facie* case, Ad-interim injunction against the respondents/defendants have been Ordered. Aggrieved over injunction ordered against the defendants, they have filed the Civil Miscellaneous Appeals.

7. The Learned counsel for the Defendants submitted that the design registered by the plaintiff / petitioner is not a novel or a new design and it is a modification of a tractor. The tractor attached with pallet or forklift is already in use for several years, the tractor being attached with various types of tillers and other agricultural machines for multiple purposes such as tilling, ploughing, planting, harvesting, transporting etc., That being so, the plaintiff's act of attaching the forklift in front or back of tractor is not unique design. He further submitted that the appellant no.1 herein is running a lathe and used to fit various machines and other agricultural tools with the tractor, he could not be prevented by way of injunction, from continuing his act of fitting the agricultural or machinery tools, including the forklift for the benefit of the agriculturists and prays to set aside the Order of the injunction passed against him.



8. The learned counsel for the respondent / plaintiff submitted that, the plaintiff has produced sufficient documents including the 'Certificate of Registration' to show that his design has been registered. Since the respondents have violated and continuing the violation, the Trial Court has rightly Ordered injunction against the respondent, hence prays to confirm the same.

9. I have considered the submissions made on both sides and perused the materials available on record. The design registered by the plaintiff herein is given below:

DESIGN NUMBER	257524	
CLASS	12-05	
G. RAGHU BABU, SEEMAPURAM VILLAGE & POST, PINNERITAIJUR, THIRUVALLUR-601203, TAMIL NADU, INDIA		
DATE OF REGISTRATION	12/09/2017	
TITLE	FOKRLIFT VEHICLE	
PRIORITY NO.		

10. On careful analysis of the pleadings and documents marked, it shows that the design claimed by the plaintiff is that, he is attaching the forklift to the rear portion of the Tractor and he has obtained Certificate of Registration under the Designs Act, 2000. It is admitted by both sides that



WEB COPY this design is used by the Tractor owners for the purpose of doing agricultural work. Apart from that, this design is also used for various other purposes. Admittedly, the petitioner / plaintiff is not the manufacturer of either the forklift or the Tractor. Both the tractor and forklift are independent vehicles, which are compulsorily to be registered under the Motor Vehicles Act, 1989. The using of any vehicle which falls within the definition of “Motor Vehicle” shall be governed by provisions of Motor Vehicles Act. Section 52 of the Motor Vehicles Act deals with alteration of Motor vehicles. It provides that any alteration of the vehicle relating to the particulars contained in the registrations shall be permissible, if the alteration made only on the prior permission of Registering Authorities.

11. Admittedly, the manufacturers of the Tractor and the Forklift are different, the plaintiff has registered the design with the tractor attached with the forklift on the rear side, as if this design is being manufactured by him. If he claims that the design belongs to him then he must be the manufacturer of such design, instead he is doing the service of attaching the forklift with the tractor and claiming registration of the above design depicting the design that “Tractor attached with Forklift” by naming it as



“Forklift vehicle”. The relevant provisions of the Designs Act arises for

consideration are as follows:

"Section 2(d):

“(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);

Section 4:

4. Prohibition of registration of certain designs.—A design which—

- (a) is not new or original; or*
- (b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or*
- (c) is not significantly distinguishable from known designs or combination of known designs; or*
- (d) comprises or contains scandalous or obscene matter, shall not be registered.*

Section 19:

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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- (a) that the design has been previously registered in India; or
- (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
- (e) that it is not a design as defined under clause (d) of section 2.

(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.

Section 22(1) & (4):

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 license 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.

(4) Notwithstanding anything contained in the second proviso to sub-section (2), where any ground or which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence under sub-section (3) in any suit or other proceeding for relief under sub-section (2), the



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suit or such other proceedings shall be transferred by the Court, in which the suit or such other proceeding is pending, to the High Court for decision. "

12. The defendants claim that, the first defendant is running a lathe and he used to help the farmers for attaching various agricultural tools with the Tractor. That being so, this act of attaching shall not be infringement of design. To establish the prima facie case, in the case of this nature, the petitioner / plaintiff has to establish that his design has been violated or infringed. It is admitted case that every tractor is being used with attachments depending upon the nature of work carried out in the agricultural field or any other place. By obtaining Registration, the plaintiff herein has succeeded in injuncting the respondents from attaching forklift machine in the Tractor brought to the lathe of the appellant no.1, for that purpose. Section 4 of the Designs Act, 2000, 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 22(4) of the Designs Act, 2000, provides that even if the registration of design continues to exist as a registered design, the



defendants in the suit can contest and establish that, design registered by the plaintiff is not one capable of being registered and the plaintiff is not entitled to any relief.

13. The Hon'ble Apex Court in ***Bharat Glass Tube Limited Vs. Gopal Glass Works Limited [(2008) 10 SCC 657]***, has considered the meaning of the words “New and Original design” and in paragraph 26, held as follows:

"26. In fact, the sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act. It has also laid down that if a design is not new or original or published previously then such design should not be registered. It further lays down that if it has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration then such design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known



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



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

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

‘Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but the appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will increase sales.’ The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods. The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable (sic protectable) at



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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.” "

14. 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.

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15. The registered design must be an intellectual property right created after application of sufficient time, labour, effort etc., and there must be sufficient newness or originality, i.e., existence of requisite innovation and that trade variations of known design cannot result in newness and originality.

16. In this case, the design registered is the forklift attached with the Tractor and it is not the case of the plaintiff that he manufactures or sells the Tractor and forklift together as per the registered design. He sells the forklift as an attachment to the conventional tractor with other external modifications. That being the case, this Court is of the view that the forklift model, which is to be attached with the tractor alone ought to have been registered as a design under the Designs Act if it satisfies that the Design is not prohibited under Section 4 of the Designs Act. But registered design depicts that as if the Tractor with the forklift has been designed by the plaintiff and is being manufactured and sold by him to the customers.



17. As admitted by the plaintiff that the Tractor is attached with various heavy machinery tools for the purpose of tilling, ploughing, harvesting, planting, transporting etc. For each activity, very same Tractor used but by different attachments. Similarly, the plaintiff is selling the attachment called forklift and he cannot claim that no other person shall attach the forklift to the Tractor. He can only claim that if a person manufactures or passing off the forklift, as designed by him, then it is an infringement.

18. In this case, the Design registered by the petitioner is not a novel or innovative design, the act of attaching various agricultural tools in the tractor could not be termed as an innovative design, hence, this Court is of the view that the appellants/defendants, who are involved in assisting the agriculturalists for attaching the Forklift in the Tractor, are not violators or infringing the registered Design of the plaintiff.

19. For granting injunction, the person who seeks the relief shall establish *prima facie* case and balance of convenience in his favour. In this case, the plaintiff eventhough claims that he has registered the design in the



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name and style of 'Forklift Vehicle', *prima facie* he has not established that his design is “new and original” and the design registered only shows that, it is not significantly distinguishable from known design or combination of known designs. This Court is of the view that the balance of convenience is not in favour of the plaintiff/petitioner herein. Since the plaintiff/petitioner has failed to establish the *prima facie* case and the balance of convenience in his favour, the injunction ordered against the appellants/defendants is not valid and the same is hereby set aside. The above observations made herein regarding the validity of the registered design is only for the purpose of deciding the injunction petition and the same will not preclude the parties to contend validity of the registration during the trial.

20. In the result, the Order and Decreetal Order of Ad-Injunction passed in I.A. Nos.2 and 3 of 2019 in O.S. No.197 of 2019 dated 25.01.2021 on the file of the IV Additional District Judge, Thiruvallur at Ponneri is hereby set aside. Accordingly, these Civil Miscellaneous Appeals are allowed. No costs. Consequently, connected miscellaneous petitions are closed.

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Index: Yes/No

Speaking Order: Yes/No

Neutral Citation Case: Yes/No

To:

1. IV Additional District Judge,
Thiruvallur at Ponneri.
2. The Section Officer,
V.R.Section,
High Court, Chennai.



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K. RAJASEKAR, J.

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