

dik

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION**

**NOTICE OF MOTION NO. 2235 OF 2012
IN
SUIT NO. 2477 OF 2011**

Pranda Jewelry Pvt. Ltd. & Ors.

...Applicant/Plaintiffs

VS

Aarya 24 kt & Ors.

...Defendants

.....

Mr Iqbal Chagla Sr. Counsel a/w Naval Agarwal, Solicitor, Mr Rajesh Satpalkar, Mr Pinkesh Shah and Ms Madhuri Roa i/b Mulla & Mulla Craigie Blunt & Caroe for the Plaintiff.

Mr H.W.Kane, Sr. Advocate with Mr Aniruddha Sathe, Mr Hiren Kamod and Ms Aditi Kulkarni i/b Aniruddha Satge for the Defendants.

.....

**CORAM : S.C. GUPTE, J.
Order Reserved on : 18 December 2014
Order Pronounced on : 01 APRIL 2015**

JUDGMENT:

This Notice of Motion is taken out in a copyright infringement and passing off suit. The case of the Plaintiffs may be shortly stated as follows.

2 Plaintiff No.1 is in the business of branded jewellery. Plaintiff Nos.2 and 3, respectively, hold 49 % and 51 % equity in Plaintiff No.1. Plaintiff No.1 designs, markets and sells *inter alia* gold sheet articles of deities and religious symbols under the brand name 'Prima Art'. Plaintiff No.1 creates the drawings for each of these articles on computers using specialized softwares through qualified graphic designers in its employment. Based on these drawings, the articles are manufactured by Plaintiff No.3 in Thailand, and imported from Thailand and sold in India by Plaintiff Nos.1 and 2. The product drawings are claimed to be original artistic work within the meaning of the Copyright Act, 1957, and of which the Plaintiffs are owners. The Plaintiffs have produced these drawings along with the

plaint. The Plaintiffs claim to be entitled to reproduce this original artistic work in any material form including three dimensional depiction in any material. It is the Plaintiffs' case that in or about August 2010, the Plaintiffs learnt about infringement of the Plaintiffs' copyright in 22 product drawings by the Defendants. Defendant No.1, a partnership firm of which Defendant Nos.2 to 7 are partners, has been producing identical gold sheet articles of deities and religious symbols with the use of these designs. The Plaintiffs have shown brochures of the articles manufactured by the Plaintiff and Defendant No.1 in support of this claim of infringement. It is the Plaintiffs' case that one Deepak Pereira, who was the Plaintiff's Manager, Head Sales, is now the CEO of Defendant No.1 and around August 2010 the Defendants changed the original designs of their articles and started copying the Plaintiffs' artistic works.

3 If one has regard to their respective brochures and also the respective articles produced by the Plaintiffs and Defendants, it is quite clear that the Defendants' articles are a clear imitation of the Plaintiffs' articles. The main contest between the parties is, however, on whether or not the Plaintiffs can claim any copyright in the matter. The Defendants submit that the articles, in which the Plaintiffs seek to illegally claim a monopoly, are being manufactured and sold both in India and worldwide by various parties; these articles are manufactured by others in the same forms of expression and depiction; these figures and signs are well known and are generic. It is claimed that there is no assignment of copyright in these artistic works from their authors to the Plaintiffs. It is submitted that there is a delay of over one year in taking out the present Notice of Motion, which disentitles the Plaintiffs to any interim relief. Lastly, it is submitted there is no case of passing off of the Defendants' goods as those of the Plaintiffs.

4 At the hearing of the Notice of Motion, learned Counsel for the Defendants made the following submissions:

(a) The artistic works are common to the trade and generic, and there is no originality in the works to enable the Plaintiffs to claim any copyright in them;

(b) There is nothing to show that the designers, who purportedly designed these artistic works for the Plaintiffs, were engaged by the Plaintiffs; at any rate, the designs are made by a mechanical process;

(c) The artistic works referred to by the Plaintiffs are really designs, capable of being registered under the Designs Act, 2000, though not so registered and hence, under Section 15 of the Copyright Act, 1957, the copyright in the designs has ceased after the designs were applied more than fifty times by an industrial process by the Plaintiffs or any other person under their licence;

(d) The delay in bringing the action disentitles the Plaintiffs to any interim relief; and

(e) There is no case of passing off of goods.

Learned Counsel relied on judgments in the cases of **Microfibres Inc. Vs Girdhar & Co.**¹, **Mattel, Inc. & Ors. Vs Jayant Agarwalla & Ors.**², **Kiran Shoes Manufacturers Vs Registrar of Copyrights & Anr.**³, **Devendra Somabhai Naik Vs Accurate Transheat Pvt. Ltd.**⁴ and **R.G.Anand Vs M/s Delux Films**⁵, in support of his contentions.

5 Let us first dispose of the objections of the Defendant as to the Plaintiffs' entitlement to any copyright at all in the artistic works. The thrust of the Defendants' submissions is that there can be no copyright in the images of gods and religious signs; these images are generic and of common use, and when they are developed in different manners, the source being common, similarities are bound to occur and no piracy can thereby be alleged. The images of gods and goddesses and religious signs may be a matter of common use. Those are

1 2006(32) PTC 157 (Del.) & on appeal 2009(40) PTC 519 (Del.) (DB)

2 2008(38) PTC 416 (Del.)

3 2012(50) PTC 14 (Del.)(DB)

4 2005(31) PTC 172 (Guj.) (DB)

5 AIR 1978 SC 1613

in the realm of ideas. From the point of view of copyright what is still relevant is the form, manner of depiction, arrangement and expression of these figures and signs by the author of the copyrighted works. These latter aspects are unique to the creator of the works and can give rise to a copyright in the work. Once it is held that the author or owner has a copyright in the work, what is to be seen is whether the defendant's work is an imitation of the copyrighted work. If the copy is substantial and material one, then whether or not there are some variations here and there, the defendant would be guilty of piracy. And the surest test to determine such substantial and material copy is the test of a common reader, spectator or viewer, as in the case of, say, trade marks. The principles of law on the subject are succinctly culled out by the Supreme Court in the case of **R.G.Anand Vs M/s Delux Films** (supra). The relevant passage in the judgment is quoted below:

“46. Thus, on a careful consideration and elucidation of the various authorities and the case law on the subject discussed above, the following propositions emerge:

- (1) There can be no copyright in an idea, subject-matter, these, plots or historical or legendary facts and violation of the copyright in such cases is confined to the form, manner and arrangement and expression of the idea by the author of the copyright work.
- (2) Whether the same idea is being developed in a different manner, it is manifest that the source being common, similarities are bound to occur. In such a case the Courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. If the defendant's work is nothing but a literal imitation of the copyrighted work with some variations here and there it would amount to violation of the copyright. In other words, in order to be actionable the copy must be a substantial and material one which at once leads to the conclusion that the defendant is guilty of an act of piracy.
- (3) One of the surest and the safest test to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the the viewer after having read or seen both the works is clearly of the opinion and gets an

unmistakable impression that the subsequent work appears to be a copy of the original.

- (4) Whether the theme is the same but is presented and treated differently so that the subsequent work becomes a completely new work, no question of violation of copyright arises.
- (5) Whether however apart from the similarities appearing in the two works there are also material and broad dissimilarities which negative the intention to copy the original and the coincidences appearing in the two works are clearly incidental no infringement of the copyright comes into existence.
- (6) As a violation of copyright amounts to an act of piracy it must be proved by clear and cogent evidence after applying the various tests laid down by the case law discussed above.
- (7) Whether, however, the question is of the violation of the copyright of stage play by a film producer or a Director the task of the plaintiff becomes more difficult to prove piracy. It is manifest that unlike a stage play a film has a much broader perspective, wider field and a bigger background where the defendants can by introducing a variety of incidents give a colour and complexion different from the manner in which the copyrighted work has expressed the idea. Even so, if the viewer after seeing the film gets a totality of impression that the film is by and larger a copy of the original play, violation of the copyright may be said to be proved”.

6 Applying these tests, it is clear that the renderings of these images of deities and religious figures and signs by the Plaintiffs in the particular form, manner, arrangement and expression entitle the Plaintiffs to claim copyright in the artistic works. It is also clear *prima facie* that the Defendants have used substantial and material copies of the Plaintiffs' artistic works to reproduce the same in three dimensional form in gold plates whilst producing their articles. If one compares the photographs of the articles of the Plaintiffs and the Defendants juxtaposed with each other in Exhibits “J-1” to “J-20” of the plaint, it is clear that there is a virtual identity between them. The substantial and material features

which are copied by the Defendants are set out meticulously in Exhibit “J-21” of the plaint. Considering this material and even observing the articles themselves, there is no manner of doubt that the Defendants' articles are substantial and material copies of the Plaintiffs' artistic works. The averments made and the material produced by the Plaintiffs in their pleadings are sufficient at this *prima facie* stage to support the Plaintiffs' case of the authors of these artistic works being engaged on payment of compensation by the Plaintiffs and the Plaintiffs' ownership of the copyright thereby in the artistic works. It is immaterial whether the artistic works themselves are made by hand or using computer programs and software. They are original works capable of being protected as copyrighted works.

7 That brings us to the main contention of the Defendants in defence to the Plaintiffs' action of copyright infringement. The argument is based on Section 15 of the Copyright Act, 1957. It is submitted that the artistic works are capable of being registered as designs under the Designs Act, 2000 and not being so registered, the copyright in them ceases after more than fifty applications to a product by an industrial process. The argument calls for an analysis of several important aspects of the laws of copyright and designs so as to find answers to the following questions:

- (i) Whether the alleged artistic works are 'designs' within the meaning of the definition of 'design' under the Designs Act, 2000; and
- (ii) Whether the images of deities and religious figures and signs in gold plates are reproduction of the artistic works in a material form including depiction in three dimensions or articles “to which the design has been applied..... by an industrial process.”

This is of course apart from the factual inquiry as to whether or not there has been a reproduction of more than fifty times.

8 The Designs Act, 2000, defines a 'design' in Section 2(d). The

provision is quoted below:

“2. Definitions.- In this Act, unless there is anything repugnant in the subject or context.---

(a) ...

(b) ...

(c) ...

(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 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.”

The earlier law, viz. The Designs Act, 1911, on the other hand, defined a 'design' in the following terms

“2. Definitions

In this Act unless there is anything repugnant in the subject or context :

(1) ...

(2) ...

(3) ...

(4) ...

(5) "design" means only the features of shape configuration patterns or ornament applied to any article 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 or property marks as defined in section 479 of the Indian Penal Code; “

What is to be noted immediately is that unlike the definition in the Designs Act, 1911, the present definition in the Act of 2000 specifically excludes any artistic work as defined in Section 2(c) of the Copyright Act, 1957.

9 The Designs Act, 2000, contains provisions for registration of design and provides for copyright in registered designs. Chapter 3 contains provisions concerning copyright in registered design. Section 11 of the chapter is in the following terms:

“11.Copyright on registration.-- (1) when a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.”

10 Copyright Act, 1957, for its part, not only defines an artistic work and protects the exclusive right to reproduce the artistic work in any material form, but makes special provisions regarding copyright in designs capable of being registered under the Designs Act, but not so registered. These provisions may now be noted:

“2.Interpretation. In this Act, unless the context otherwise requires,-

(a)

(b)

(c) “artistic work” means,--

(i) A painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;

(ii) an (work of architecture); and

(iii) any other work of artistic craftsmanship;”

“14. Meaning of copyright.- (1) For the purpose of this Act “copyright” means

the exclusive right, subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:-

- (a) ...
- (b) ...
- (c) In the case of an artistic work,-
 - (i) To reproduce the work in any material form including-
 - (A) the strong of it in any medium by electronic or other means; or
 - (B) depiction in three-dimensions of a two-dimensional work; or
 - (C) depiction in two-dimensions of a three-dimensional work;
 - (ii) to communicate the work to the public;
 - (iii) to issue copies of the work to the public not being copies already in circulation;
 - (iv) to include the work in any cinematograph film;
 - (v) to make any adaptation of the work;
 - (vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (I) to (iv):”

“15. Special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 2000-

- (1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 2000 (16 of 2000)
- (2) Copyright in any design, which is capable of being registered under the Designs Act, 2000 (16 of 2000), but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his licence, by any other person.”

11 We must now take into account the interplay of the relevant provisions in the Copyright Act, 1957 and the Designs Act, 2000 for finding answers to our questions noted above. Firstly, it is important to bear in mind the distinction between a 'design' and an 'artistic work' and also copyright in a design within the meaning of both the Copyright Act, 1957 and the Designs Act, 2000, and the copyright in an artistic work within the meaning of Copyright Act, 1957. Whereas a “design” implies “features of shape, configuration, pattern, ornament or composition of lines or colours” applied to any article, an “artistic work”

includes a drawing, which includes a diagram or plan as also any work of artistic craftsmanship. The features of shape, configuration, etc. can always be reduced to a drawing including a diagram or plan, whereas such drawing can vice versa be used to create such features of shape, configuration, etc. But for that reason, designs and artistic works (in drawings) are not interchangeable concepts. They are still different. When an artist creates a sculpture, he applies features of shape, configuration, etc. to his material, but it is obvious that he is not thereby creating a 'design', but an 'artistic work'. So also, when a designer makes a diagram or a plan for creating a refrigerator or a mixer or better still, a textile, he is not creating an 'artistic work' but a 'design', though the drawing or diagram or plan can technically be subsumed under the definition of 'artistic work'. Thus, what is clear is that to avoid a potential conflict between what is a design and what is an artistic work, we need to draw lines to distinguish between the two by considering the interplay of the relevant provisions of the two Acts.

12 One of the keys to finding an answer is in the definitions of 'artistic work' and 'design' respectively under the Copyright Act, 1957 and Designs Act, 2000. An 'artistic work' is the drawing itself and the copyright of the artist consists in its reproduction in any medium and in any dimensions, whether two-dimensions or three dimensions. On the other hand, the features of shape, configuration, etc., which are elements of a design, are "applied to any article". When a sculpture of an artist is cast in a certain material, the artist is not applying the features of its shape, configuration, etc. to the material, but reproducing the very sculpture in a three-dimensional form. When we copy a painting, whether in hand or by print, we are not applying the features of shape, configuration, etc. to the canvas or the paper, but reproducing the very painting which is the copyrighted work of the artist. The sculpture or the painting is an artistic work, even though it may not have any artistic quality. This is distinctly different from applying the features of shape, configuration, etc. to, say, a refrigerator or a mixer or even applying a pattern to a textile. A refrigerator, a mixer or a textile piece are articles to which these features or patterns are applied. These features or patterns, though they are contained in drawings, diagrams or plans and though they may have artistic quality, are 'designs'. Such designs, when registered under

the Designs Act, 2000, give a copyright to the registered proprietor during ten years following their registration, extendable by further five years. That is under Section 11 of the Designs Act, 2000. When they are not so registered, but since they are capable of being registered as designs, they enjoy copyright for fifty one applications. After they are applied more than fifty times, the copyright in them is lost. That is under Section 15 of the Copyright Act, 1957.

13 The judgments relied upon by Mr. Kane, learned Counsel for the Defendant, are all cases of registered or registrable designs. The cases of **Devendra Somabhai Naik** (supra) and **Microfibres Inc.** (supra) were cases, respectively, of designs for a machine and an upholstery fabric, applied to the respective articles by an industrial process or means and accordingly, copyright in the designs was said to have ceased after more than fifty applications. On the other hand, the case of **Kiran Shoes Manufacturers** (supra) was a case of a registered design of a shoe.

14 The learned Single Judge of Delhi High Court, in **Microfibres, Inc.** (supra) had this to say :

“60. The work in question is no doubt the arrangement of motifs, flowers, leaves and shapes which have been arranged in a particular manner. There is, thus, element of labour and skill applied to have a particular pattern as observed in **Walter Vs. Lane's** case (supra). There is also little doubt that the defendants have copied the same. This would be apparent from the comparison of the designs of the fabrics of the plaintiff and the defendants. To illustrate this aspect, some of the original and alleged offending products are being reproduced herein below;

61.

62. In order for the work of the plaintiff to qualify as an 'artistic work', it must fall within the definition of sub-section (c) of Section 2 of the Copyright Act. A reading of the said provision would show that attempt of the plaintiff can only be to bring it within the concept of 'painting'. The comparison with the

painting of M.F.Hussain would be otiose as the work in question, in the present case, is not a piece of art by itself in the form of a painting. There is no doubt that labour has been put and there is some innovativeness applied to put a particular configuration in place. Such configuration is of the motifs and designs which by themselves would not be original. The originality is being claimed on the basis of the arrangement made. What cannot be lost sight of is the very object with which such arrangements or works had been made. The object is to put them to industrial use. An industrial process has to be done to apply the work or configuration to the textile. It is not something which has to be framed and put on the wall or would have any utility by itself. The two important aspects are the object with which it is made (which is industrial) and its inability to stand by itself as a piece of art. In fact, it has no independent existence of itself”.

When the matter went before the Division Bench of that Court, the Court put the matter thus:

“36. This clearly shows that the legislature intended that even if the artistic work such as a painting has been used as the basis for designing an industrially produced object for commerce, such as the furnishing in the present case, nevertheless the original painting would indeed enjoy full copyright protection, while the result of the industrial application of such painting, namely, the design used in the industrial production of the ultimate product shall enjoy lesser period of protection as stipulated under the Designs Act provided it is registered as a design under the Designs Act. Thus, we are of the view that an original artistic work initially acquires protection under the Copyright Act as an 'artistic work' or else the protection under the Designs Act qua the product created from the artistic work when industrially applied.

37.

38. Thus, while it is not open to the respondent to reproduce such paintings per se, which formed the basis of the design that was applied to the fabric, nevertheless, such protection qua the design imprinted on the product through industrial application is available only under the Designs Act, provided there is a registration. This is precisely why the legislature not only

limited the protection by mandating that the copyright shall cease under the Copyright Act in a registered design, but in addition, also deprived copyright protection to designs capable of being registered under the Designs Act, but not so registered, as soon as the concerned design had been applied more than 50 times by industrial process by the owner of the copyright or his licensee. This clearly indicates that the legislature intended to provide industrial and commercial application of an artistic work for commerce lesser protection”.

On the other hand, the Delhi High Court in **Rajesh Masrani Vs Tahiliani Design Pvt. Ltd**⁶. was concerned with drawings made in the course of developing garments and accessories by the Plaintiff, which were claimed as artistic works under Section 2(c)(i) of the Copyright Act, 1957. The contention of the Plaintiff was that 'artistic work' was distinct from 'design' and remains 'artistic work' per se distinct from the 'garment' to which it is applied and, therefore, covered under the exclusion contained in the definition of 'design' under Section 2(d) of the Designs Act, 2000. The Delhi High Court accepted the Plaintiff's contention, holding as follows:

“17. As mentioned earlier, under Section 15(2) of the Copyright Act, in case the copyright in any design which is capable of being registered under the Designs Act, 1911 but which has not been so registered, shall cease to exist as soon as any article to which the design has been applied has been reproduced more than 50 times by an industrial process. The definition of 'Design' in the Designs Act, 1911 is different from the definition of 'Design' in the Designs Act, 2000. Section 2(d) of the Designs Act, 2000 does not include any 'artistic work' as defined in clause (c) of Section 2 of the Copyright Act. It is clear from the meaning of the design under the Designs Act, 2000 that the artistic work as defined in Section 2(c) of the Copyright Act, 1957 is excluded if any party is able to bring his case within the framework of Section 2(c) of the Copyright Act, 1957 while claiming a copyright, then the suit for infringement of copyright is maintainable”.

The Delhi High Court distinguished this case from the case of **Microfibres Inc.**

(supra) in the following words:

“28. The above said case, in our view, is on an entirely different footing from the present case for the following reasons:-

(a) In the present case, as per the pleadings, the work in question has not been reproduced more than 50 times by an industrial process by the plaintiff. In the case of *Micro Fibre*, (2006 CLC 350) (supra), the court has specifically noticed and highlighted in para 62 of the said judgment, the fact that the intent of creating the design in question was to put them into industrial use and the production of the said work had occurred more than 50 times as mentioned in para 73 of the said Judgment.

(b) The court has also noticed in para 47 of the said judgment that the subject matter of the work in dispute are floral design which are applied upon fabric used for upholstery through the industrial process and the plaintiff has registered the subject matter of the work of design in United Kingdom and the said certificates of registration have also been placed on record.

(c) In para 72 of the judgment, it was further held that the plaintiff failed to register the designs which were capable of being registered under the Designs Act, therefore, the protection of copyright in the design was not available to the Plaintiff.

In the present case all the abovesaid aspects are absent and, therefore, the said judgment is not applicable to the facts and circumstances of the present case. Moreover as we have already come to the conclusion that the subject matter comes under Section 2(c) of the Copyright Act, this judgment does not help the case of the appellant”.

15 The emerging position from the above discussion is this. An 'artistic work' so long as it can qualify as an artistic work reproduced in any form shall continue to enjoy the copyright available to it under the Copyright Act, 1957. But when it is used as the basis for designing an article by its application by an industrial process or means, meaning thereby an article other than the artistic work itself in a two or three dimensional form, it would enjoy a lesser period of

protection of copyright under Section 11 of the Designs Act, 2000, if registered as a design under that Act, and if not so registered (despite being registrable), would cease to enjoy any copyright after more than fifty such applications, under Section 15(2) of the Copyright Act, 1957. Once again, as an original artistic work it would continue to enjoy the full copyright under the Copyright Act, 1957 and cannot be reproduced in any two or three dimensional form by anyone except the owner of the copyright. What it would cease to enjoy is the copyright protection in its industrial application for production of an article. I have already explained above what is meant by an 'article' and that it is different from the 'artistic work' itself. In practice, it works like this. If a painting, say Hussain's painting of a horse, is simply reproduced in any medium, i.e. on paper, canvass or even a cloth, and in any form, i.e. in two or three dimensions, whether by an industrial process or otherwise, it will continue to enjoy full copyright in such reproduction under the Copyright Act. But if the painting is used as a motif to produce, say, sarees, the industrial application, namely, use as a motif in a saree, would loose copyright protection, if not registered as a design under the Designs Act, 2000, after more than fifty applications. The difference between the former use and the latter use, is that what is reproduced is an artistic work itself in the former and what is produced in the latter case is an article, which is not by itself an artistic work.

16 Now applying this law to the facts of our case, what we find is that what is produced by the plaintiffs with the use of the artistic work contained in the original drawings is a reproduction in a particular material, namely, in gold plate and in a particular form, namely, a three dimensional form. What is produced is the artistic work itself. This work ought to enjoy a full protection under the Copyright Act. Besides, the images in gold plates are themselves artistic works in which the plaintiffs have a copyright, quite apart from the base drawings which are used to make them. Any imitation of these images in gold plates or indeed any material is clearly violative of the Plaintiffs' copyright in them.

17 Though I am convinced that what we are dealing with in the present case are artistic works and not designs, I must note that even as alleged designs,

an explicit case of more than fifty applications thereof by the Plaintiffs or anyone authorised by them, is not made out by the Defendants.

18 Considering the exclusive features of, and form and expression in, the works, though the Plaintiffs can be said to have a copyright in the works, it is difficult to believe at this *prima facie* stage that these features, form or expression have exclusively come to be associated with the Plaintiffs in the minds of the purchasing public and the Defendants' goods are likely to be confused as the Plaintiffs' goods so as to give rise to a claim for passing off. I, therefore, propose to restrict the relief to copyright infringement alone.

19 The Defendant contends that there is a delay on the Plaintiffs' part in approaching this court and, therefore, the Plaintiffs are not entitled to any interim reliefs. First of all, delay *per se* is never considered as a ground in itself to refuse relief in an action to protect intellectual property. The Defendant must allege a case of acquiescence or estoppel or special equities arising in favour of the Defendant as a result of such delay. That is not the case here. Besides, the adoption of these artistic works for producing their goods by the Defendants is *prima facie* suggestive of dishonesty. It is not believable that the similarities in the two works are a matter of chance. Besides, the Plaintiffs have an arguable case that the Defendants changed their designs later, after the Plaintiffs' Ex-Manager, Head Sales, joined the Defendants as the latter's CEO. The Supreme Court in **Midas Hygiene Industries (P) Ltd. Vs. Sudhir Bhatia**⁷ held as follows:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it *prima facie* appears that the adoption of the mark was itself dishonest”.

In **Express Bottlers Services Pvt. Ltd. Vs. Pepsi Inc.**⁸, the Court held as follows:

7 (2004) 3 Supreme Court Cases 90

8 1989 (7) PTC 14

“.....Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark”.

The Plaintiffs claim to have noticed the offending use of the artistic works by the Defendants in August 2010; they have caused issuance of a cease and desist notice to the Defendants thereafter; the Defendants have refused to comply and on the other hand, denied infringement; and the Plaintiffs have thereafter proceeded to file the present suit in September 2011. There is no case of any culpable delay and absolutely no case of intentional abandonment of the Plaintiffs' rights or acquiescence or any special equities. Besides, as noted above, the adoption by the Defendants in *prima facie* dishonest.

20 The Plaintiffs have, thus, made out a strong *prima facie* case. The balance of convenience is also clearly in favour of the Plaintiffs. The parties target the same market and the close similarity between the works causes serious and irretrievable prejudice to the Plaintiffs. On the other hand, the Defendants have changed their designs and have been imitating the Plaintiffs' artistic works only since 2010 and can always go back to their original designs or adopt new designs for similar images of deities and religious signs.

21 In that view of the matter, there is a clear case for grant of interim reliefs. Accordingly, there will be an interim injunction against the Defendants in terms of prayer clause (a) of the Notice of Motion. Costs to be the costs in the cause.

22 Learned Counsel for the Defendants applies for stay of this order. Since this order grants a preventive relief, after a detailed hearing of the case, I am not inclined to grant any stay. Application for stay is refused.

(S.C.GUPTA J.)

CERTIFICATE

Certified to be true and correct copy of the original signed
Judgment/ Order.