

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 06.02.105

Date of verdict: 17.03.2015

CORAM

THE HONOURABLE MR. **JUSTICE R.SUBBIAH**

Original Application Nos.861 and 862 of 2014

in

C.S.No.701 of 2014

1.Bharat Balar

2.White Lion Trading Private Ltd.,
rep. by its Managing Director
Mr.Bharat Balar.

... Applicants in
both the applications

vs.

1.Rajendra Distributors

2.Sha Mahendra Kumar Asuram,
Director,
Rajendra Distributors.

3.Sha Asuram Madaji,
Director,
Rajendra Distributors.

... Respondents in
both the applications.

The application in O.A.No.861 of 2014 has been filed to grant an interim injunction restraining the respondents, by themselves, their heirs, legal representatives, men, servants, agents, distributors, stockists, wholesalers, retailers, representatives or any one claiming through them from in any manner passing off and enabling others to

pass off their containers with or without idly plates as and for applicants' Unitary Multilayer Container and idly plates by using the identical shape and configuration for their products or any other products which are identical to that of or an obvious imitation of the applicants' Unitary Multilayer Container and idly plates respectively and amount to product passing off or in any other manner whatsoever pending disposal of the suit.

The application in O.A.No.862 of 2014 has been filed to grant an interim injunction restraining the respondents, by themselves, their heirs, legal representatives, men, servants, agents, distributors, stockists, wholesalers, retailers, representatives or any one claiming through them from in any manner infringing the applicants' copyright in the registered design by manufacturing, assembling, sale and distribution of containers with or without idly plates with identical designs for their products or any product which is an imitation of the applicants' copyright in the registered design No.256062 dated 27.8.2012 in Class 07-02 for Unitary Multilayer Container and idly plates or in any other manner whatsoever pending disposal of the suit.

For applicants : Mr.Arun C.Mohan,
in both the applications.

For Respondents : Mr.M.S.Krishnan, SC,
for M/s.Surana & Surana,
for R.1 and R.2

COMMON ORDER

The application in O.A.No.861 of 2014 has been filed to grant an interim injunction restraining the respondents, by themselves, their heirs, legal representatives, men, servants, agents, distributors, stockists, wholesalers, retailers, representatives or any one claiming through them from in any manner passing off and enabling others to pass off their containers with or without idly plates as and for applicants' Unitary Multilayer Container and idly plates by using the identical shape and configuration for their products or any other products which are identical to that of or an obvious imitation of the applicants' Unitary Multilayer Container and idly plates respectively and amount to product passing off or in any other manner whatsoever pending disposal of the suit.

2. The application in O.A.No.862 of 2014 has been filed to grant an interim injunction restraining the respondents, by themselves, their heirs, legal representatives, men, servants, agents, distributors, stockists, wholesalers, retailers, representatives or any one claiming through them from in any manner infringing the applicants' copyright in the registered design by manufacturing, assembling, sale and distribution of containers with or without idly plates with identical

designs for their products or any product which is an imitation of the applicants' copyright in the registered design No.256062 dated 27.8.2012 in Class 07-02 for Unitary Multilayer Container and idly plates or in any other manner whatsoever pending disposal of the suit.

3. The applicants are the plaintiffs and the respondents are the defendants in the suit in C.S.No.701 of 2014.

4. For the sake of convenience, the parties will be referred to as per their ranking in the civil suit.

5. The case of the applicants as could be seen in the affidavits filed in support of the said applications, in brief, are as follows:-

(a) The first plaintiff is a well reputed manufacturer and marketer of electric kitchen appliances and has been trading under the name and style of White Lion Trading Private Limited, the second plaintiff herein. The first plaintiff, owing to his rich experience in the household electronic appliances for the past several years, has designed several electronic appliances and utensils which are user friendly, innovative

and has more utility compared to other electric appliances available in the market. The first plaintiff has its manufacturing facility in China, wherein electric kitchen appliances are manufactured based on the design and technical inputs given by the first plaintiff to suit the needs of the end customers. Thereafter, the second plaintiff imports the said electric kitchen appliances manufactured in China as per the design and technical inputs given by the first plaintiff and markets the same in the Indian market.

(b) During the course of business, the plaintiffs have invented and designed several electric kitchen appliances and utensils that are novel, innovative and utility oriented. One such innovative / invention of the plaintiffs is the Flutter Electric Cooker with Unitary Multilayer Container and idly plates. The plaintiffs have been manufacturing and marketing electric cookers under the trade mark Flutter since the year 2013. The plaintiffs' electric cooker under the trade mark Flutter has attained immense reputation and goodwill among the trade and public.

(c) Keeping in mind the needs of the working women and to aid them to do their daily chores with much ease, in the year 2013, the plaintiffs designed a novel Unitary Multilayer container and idly plates

to make idly which is a typical, prominent and stable food in south India. The Unitary Multilayer container and idly plates designed, manufactured and marketed by the plaintiffs is novel and eye appealing. Till date, no one has ever designed or even thought of designing Unitary Multilayer container and idly plates for cooking idlies. The plaintiffs in order to protect the novel and eye catchy design in the Unitary Multilayer container and idly plates, have applied for and obtained registration of the copyright in the said design under the Designs Act, 2000 under No.256062 and the said registration is valid and subsisting. The plaintiffs have launched their novel and eye catchy Unitary Multilayer container and idly plates in the market in the year 2013 and have been marketing the same on a trial basis to study the reception of the said product among public. The unique shape and configuration of the Unitary Multilayer container and idly plates have earned great reputation and goodwill among trade and public in a short span of time as the plaintiffs' Unitary Multilayer container and idly plates is a unique and novel product.

(d) The plaintiffs are the registered proprietor of the shape and configuration of the Unitary Multilayer container and idly plates under No.2560602 dated 27.8.2013 in Class 07-02. The intellectual property

rights for the above shape and configuration and copy right in the design vests exclusively with the plaintiffs and any substantial imitation without any authorization from the plaintiffs would amount to infringement of plaintiffs' copyright in the registered design. The plaintiffs have also extensively advertised their Unitary Multilayer container and idly plates bearing unique design extensively through all the print and electronic media. By virtue of the continuous and extensive use, the plaintiffs' Unitary Multilayer container and idly plates with unique, aesthetic and eye appealing design has gained and enjoys great reputation and goodwill all over India.

(e) While so, recently, in the year 2014, the plaintiffs came to know that the defendants are manufacturing and selling Unitary Multilayer container and idly plates, which is an exact imitation of the plaintiffs' registered design. On further investigation, it was revealed that the first defendant is importing and marketing identical Unitary Multilayer container and idly plates as that of the plaintiffs. The defendants 2 and 3 are the Directors of the first defendant. Upon enquiry, the plaintiffs came to know that the defendants have given job work to manufacturers in China to manufacture containers and idly plates identical to that of the plaintiffs Unitary Multilayer container and

idly plates. The defendants' container and idly plates are manufactured in China based on the dimension, technical inputs and design provided by the defendants. Hence, the plaintiffs being aggrieved by such blatant imitation, issued a cease and desist notice dated 9.10.2014, calling upon the defendants to refrain from their illegal activities. The said notice was served on the defendants on 13.10.2014. On 27.10.2014, the defendants gave an evasive reply and did not bother to comply with the plaintiffs' notice. Further, in order to protect their intellectual rights, the plaintiffs have also issued public caution notice in the newspapers. In spite of the same, the defendants are continuing their infringing activities. The plaintiffs are the prior adopters of the unique and novel design in respect of Unitary Multilayer container and idly plates and prior to them, no one in the world has used such a design.

(f) The overall impression of the defendants' product will conclusively prove beyond doubt that it is a substantial reproduction of the plaintiffs' products for which the plaintiffs hold a valid registration. The class of customer in respect of both the plaintiffs' and the defendants' goods belong to all walks of life and every customer may not be prudent and would be deceived by the defendants' imitative and

substandard products. The defendants have deliberately copied the design of the plaintiffs' Unitary Multilayer container and idly plates. It is not possible for an ordinary person to make out any difference between both the plaintiffs' and defendants' products. Hence, the plaintiffs have filed the present suit for the following reliefs:-

(i) For permanent injunction restraining the defendants, by themselves, their heirs, legal representatives, men, servants, agents, distributors, stockists, wholesalers, retailers, representatives or any one claiming through them from in any manner infringing the plaintiffs' copyright in the registered design by manufacturing, assembling, sale and distribution of containers with or without idly plates with identical designs for their products or any product which is an imitation of the plaintiffs' copyright in the registered design No.256062 dated 27.8.2012 in Class 07-02 for Unitary Multilayer Container and idly plates or in any other manner whatsoever;

(ii) For permanent injunction restraining the defendants, by themselves, their heirs, legal representatives, men, servants, agents, distributors, stockists, wholesalers, retailers, representatives or any one claiming through them from in any manner passing off and enabling others to pass off their containers with or without idly plates as and for plaintiffs' Unitary Multilayer Container and idly plates by using the identical shape and configuration for their products or any other products which are identical to that of or an obvious imitation of the plaintiffs' Unitary Multilayer Container and idly plates respectively and amount to product passing off or in any other manner whatsoever;

(iii) The defendants be ordered to surrender to the plaintiffs for destruction, all moulds, blocks, dyes, brochures and all other materials used for the manufacture and marketing of containers and idly plates which are identical to or an obvious imitation of the plaintiffs' copyright in the registered design.

(iv) For a preliminary decree be passed in favour of the plaintiffs directing the defendants to render account of profits made by imitating imitation of the plaintiffs' copyright in the registered design in respect of Unitary Multilayer Container and idly plates and a final decree be passed in favour of the plaintiffs for the amount of profits thus found to have been made by the defendants after the latter have rendered accounts.

(v) the defendants be ordered and decreed to pay to the plaintiffs a sum of Rs.5,00,000/- as damages for acts of design infringement and passing off committed by the defendants by manufacture and sale of containers and idly plates bearing the shape and configuration and design of the plaintiffs.

(vi) for costs of the suit.

Pending suit, the plaintiffs have filed the present applications for the reliefs stated supra.

6. In the said applications, the defendants have filed a common counter affidavit, which contains the following facts:-

(a) The contentions of the plaintiffs that they have been in the business of manufacturing, marketing and trading the household electrical appliances since last many years, are absolutely false, baseless and without any merits. The plaintiffs have also made absolutely false contentions that they have invented and designed several electric kitchen appliances including the alleged Unitary Multilayer Container and have been selling the same since 2013. In fact, the documents filed by the plaintiffs clearly state that the alleged container was for the first time imported by the plaintiffs in India only in June, 2014. Since the plaintiffs have not come to this Court with clean hands, they are not entitled for any indulgence of this Court.

(b) The defendants are a reputed and respected manufacturer, importer and seller of kitchen wares and cook wares for more than 25 years. The defendants have been marketing and selling multipurpose cookers, including electric cookers with rice and idly containers for several years. By virtue of the quality of their products and the long and extensive tenure of their business, the defendants have earned

enormous reputation and goodwill.

(c) The alleged Unitary Multilayer Container claimed by the plaintiffs lacks any novelty in respect of its shape and / or configuration. The shape of the alleged container is not bona fide and/or novel as claimed by the plaintiffs. The alleged design is conventional and has been used by many other entities for several years. The claim of the plaintiffs that they have for the first time come up with the innovative idea of making a single container for cooking rice as well as idly, is also highly fictitious and bizzare. The alleged design No.206062 of the plaintiffs is invalid on the basis of lack of newness or originality by virtue of its prior publication. The same is not new or original and is not registrable under the provisions of the Designs Act, 2000. In fact, the defendants have taken appropriate steps to file petition for cancellation of the said design. The design of alleged Unitary Multilayer Container has been disclosed by way of publication prior to the filing date. Hence, the said design is not capable of registration and thereby is prohibited from registration.

(d) The plaintiffs' alleged design is a mere imitation / copy of already known designs. There are no substantial variations /

differences from the designs which are known or are published prior to the date of application filed by the plaintiffs. There is no novelty in the shape or design of the alleged container. The visual effect and the appeal of the picture illustration of the alleged design is similar to that of those which are prior published. Hence, the alleged design of the plaintiffs has been already anticipated by virtue of being pre-published, by virtue of which the design is neither new nor original. The plaintiffs cannot claim any protection for the said design under the provisions of the Designs Act, 2000. The alleged design has also been applied over many conventionally known idly cookers and other articles and such articles can be found in almost all south Indian hotels, restaurants, food stalls, tea stalls, etc. A mere look at the said idly cookers / articles sold / used by many entities for several years would reveal that the said design of layers in the inner and outer wall of the container has been used in a container / vessel / pot of the article for several years and therefore, there is no novelty or originality in the alleged design of the plaintiffs.

(e) The alleged container is merely one of the parts that is sold along with the electric cooker and is not sold separately as a single unit. The defendants have been selling electric cookers with idly and

rice pot / containers for several years under its proprietary brand 'SURABHI'. The alleged container design has been sold atleast since 2012 by the defendants along with the electric cooker. The alleged container design has never been sold separately but is always sold as one of the parts along with several others with the electric cooker. The plaintiffs with mala fide intentions, registered the alleged design on 27.8.2013, much subsequent to the adoption and use by the defendants and they are illegally claiming design proprietary ship over the alleged container design which is conventionally known and which is prior published and is used by the defendants and several others much earlier than the plaintiffs.

(f) The documents annexed by the plaintiffs would clearly reveal that their alleged electric cooker is marketed and sold under the trade mark Flutter, whereas the defendants' electric cooker is marketed and sold under the proprietary registered trademark Surabhi. The defendants have been manufacturing / importing / selling rice cum idly maker cooker for long time and they are reputed and respected manufacturers, importers and sellers of kitchen wares and cook wares for more than 25 years. By virtue of the quality of their products and the long and extensive tenure of their business, the defendants have

earned enormous reputation and goodwill. All the products of the defendants are sold under their proprietary brands, including the brand Surabhi. The name and products of the defendants carry immense goodwill in the market. On the contrary, the details and evidence provided by the plaintiffs only show that the alleged design was put to use only recently in 2014, contrary to the use claimed since 2013. There is no question of any confusion or deceptive similarity, as the products of the plaintiffs and defendants are sold under totally different trade mark / name viz., Flutter and Surabhi respectively. Thus, they sought for the dismissal of the applications.

7. (A) Learned counsel appearing for the plaintiffs submitted that the plaintiffs are the manufacturers and marketers of electric kitchen appliances and during the course of their business, they have invented and designed several electric kitchen appliances and utensils. One such innovation / invention of the plaintiffs is Flutter Electric Cooker with Unitary Multilayer Container and idly plates. The shapes and configuration of the Unitary Multilayer container and idly plates adopted by the plaintiffs were registered under the Designs Act, 2000 under No.256062 on 27.8.2013 in Class 07-02. While so, recently, in the year 2014, the plaintiffs came to know that the defendants are

also adopting the design of the Unitary Multilayer container and idly plates adopted by the plaintiffs. Since the plaintiffs are the prior adopters of the unique and novel design in respect of the Unitary Multilayer container and idly plates and moreover, since the plaintiffs had already registered their design under the Designs Act, 2000, except them, no one is entitled to use such design. In this regard, learned counsel appearing for the plaintiffs has invited the attention of this Court to Section 5 of the Designs Act, 2000 which deals about the registration of designs and Section 13 of the Patents Act, 1970 and submitted that under Section 13(4) of the Patents Act, 1970 there is no warranty of validity of patent merely because, the Examiner of Patents conducts an examination and investigation for anticipation by previous publication and by prior claim. Section 13(4) of the Patents Act, 1970 was conspicuously omitted under Section 5 of the Designs Act, 2000 which would show that once the design is registered under the Designs Act, the said registration is valid unless and until it is specifically set aside. In support of his contention, learned counsel appearing for the plaintiffs has relied upon a decision of this Court reported in **MANU/TN/ 0103/2014 - M.C.Jayasingh v. Mishra Dhatu Nigam Limited (MIDHANI) rep. by its Managing Director, Apollo Hospitals, Apollo Hospitals Enterprise Limited and**

Cancer Institute (W.I.A.) (Regional Cancer Centre), wherein it has been held as follows:-

" 246. On the first question, as I have already pointed out, the defendants have not chosen to challenge the validity of the registered design of the plaintiff, despite the fact that Section 22(3) enables the defendants to raise, as a defence, any of the grounds available under Section 19. Therefore, I have to take it that the validity of the plaintiff's design is not under challenge.

247. The defendants also have one more advantage. Under Section 13(4) of the Patents Act, there is no warranty of validity of the patent, merely because the Examiner of Patents conducts an examination and investigation for anticipation by previous publication and by prior claim. This is why the certificates of registration of patent (Ex.P.1 etc.) also contain a disclaimer to the effect that the validity of the patent is not guaranteed. Therefore, onus probandi is on the plaintiff, who claims to be registered proprietor of the patent, to establish before

court, novelty, non obviousness and usefulness, before seeking a decree of declaration and injunction.

248. But, the Designs Act, 2000 stands in contrast to the Patents Act, 1970. First of all, there is no provision in the Designs Act, 2000, which is analogous to Section 13(4) of the Patents Act, 1970. Similarly, the certificates of registration of design Ex.P.7, Ex.P.8, Ex.P.9 and Ex.P.7A, Ex.P.8A and Ex.P.9A also do not contain any disclaimer as is found in the certificates of registration of patents (Ex.P.1, Ex.P.2, Ex.P.3, etc.)

249. Therefore, it is clear that the strict rigours contained in the Patents Acts, 1970 with regard to the validity of a patent, are not to be found in the Designs Act, 2000. In the background of this legal position, in the absence of any averment in the written statement of the defendants challenging the validity of the registered design of the plaintiff, it is not possible for me to call upon the plaintiff to establish that the registered design in his favour is also valid.

250. I must also take note of the fact that every application for registration of a design is scrutinised by an Examiner, under the proviso to Section 5(1) of the Act, to see whether such design is capable of being registered under the Act and the Rules made thereunder. Section 5 of the Designs Act, 2000 does not contain a provision, which is analogous or similar to Section 13(4) of the Patents Act.

251. Therefore, on the first question, I have no option but to conclude that the registered design of the plaintiff is valid. This is despite the fact that in paragraph 22 of its decision, this Court held in The Pilot Pen Co., that registration cannot be deemed effective unless the design or configuration sought to be protected is new and original and not of the pre-existing common type. The decision in the Pilot Pen Co. arose under the 1911 Act that was common for both patents and designs. The law has travelled a long way from the said decision and hence, I hold on the first issue that the design of the plaintiff is

valid. Therefore, I shall move on to the next question namely as to whether there was infringement."

Thus, by relying upon the above dictum laid down by this Court, learned counsel appearing for the plaintiffs submitted that as on date, the plaintiffs' design is a registered one and hence, no one else except the plaintiffs is entitled to use the novel design invented by them in respect of Unitary Multilayer container and idly plates.

(B) Further, the learned counsel appearing for the plaintiffs by inviting the attention of this Court to Section 22(1) of the Designs Act, 2000, submitted that during the existence of copyright in any design, it shall not be lawful for any person to use the same 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. If there is any violation in respect of the registered design, the remedy is available under Section 22(2)(b) of the Designs Act, 2000 to file a suit for recovery of damages and also for injunction. In the instant case, the plaintiffs' design is a registered one and since the defendants are imitating the registered design of the plaintiffs in their Unitary Multilayer container and idly plates, the plaintiffs are entitled for

interim injunction.

(C) Further, the learned counsel appearing for the plaintiffs by inviting the attention of this Court to para 12 of the counter affidavit filed by the defendants, submitted that in para 12 of the counter affidavit, the defendants have stated that they are not selling containers separately and it is always sold as one of the parts along with several others with the electric cooker. But, the invoices produced by the defendants as found in page No.105 of the typed set of papers, would show that they are selling the inner parts separately. Thus, the learned counsel submitted that the defendants have not come with true facts.

(D) Further, learned counsel appearing for the plaintiffs by relying upon the judgment reported in **2013 (1) M.L.J. 197 - Whirlpool of India Ltd. v. Videocon Industries Ltd.**, submitted that if the defendants are imitating the registered designs of the plaintiffs by merely using some different colour scheme and putting some different lines or having some different ornamentation, but imitating the basic shape and configuration or the plaintiffs' design, it would amount to infringement of plaintiffs' statutory rights.

(E) Further learned counsel appearing for the plaintiffs by relying upon the decision reported in **1996 PTC (16) - Castrol India Ltd. v. Tide Water Oil Co. (I) Ltd.**, submitted that while dealing with the injunction application, the Court must address its mind as to whether the design adopted by the defendants was substantially different from the design which was registered.

(F) Further, the learned counsel appearing for the plaintiffs has relied upon the decision of this Court reported in **2002-1-L.W.85 - S.A.Safiullah, A.R. v. Umaidchamd Singhni & others** in support of his contention that if the defendants are using the registered copyright and design of the plaintiffs by manufacturing identical or deceptively similar product, that would suffice to grant interim injunction. Thus, the learned counsel appearing for the plaintiffs submitted that since there is a valid registration as on date, the plaintiffs are entitled to interim injunction.

(G) Further, learned counsel appearing for the plaintiffs submitted that unlike the Trademarks Act, the plaintiffs need not establish the prior user or good will or reputation and if there is valid

registration, that would suffice to grant interim injunction in favour of the plaintiffs. Thus, he sought for interim injunction.

8. (A) Per contra, learned senior counsel appearing for the defendants submitted that it is incorrect to state that the plaintiffs have invented and designed several electric kitchen appliances including the alleged Unitary Multilayer Container. In fact, the container is one of the parts of the electric cooker that cannot be sold separately, which has to be used as inner part of the cooker. It is not a novel or original design. In fact, the alleged design No.206062 is not liable to be protected under the Designs Act, 2000. The alleged design has also been applied over many conventionally known idly cookers and other articles and such articles can be found in almost all south Indian hotels, restaurants, food stalls, tea stalls, etc. In this regard, learned senior counsel has also invited the attention of this Court to Section 4 of Designs Act, 2000 and submitted that Section 4 speaks about the prohibition of registration of certain designs. As per Section 4, if the design is not new or original or has been disclosed to the public anywhere in India or in any other country by publication in tangible form or if it is not significantly distinguishable from known designs, the same cannot be registered.

(B) Further, the learned senior counsel appearing for the defendants has also produced a bunch of invoices before this Court commencing from 2.2.2011 to 9.7.2013 and submitted that the defendants are selling their cooking articles bearing the alleged design right from the year 2011, whereas the plaintiffs' firm was incorporated only in the year 2012. The first invoice raised by the supplier at China to the plaintiffs is only on 22.3.2014. Learned senior counsel has also invited the attention of this Court to several publications viz., Tamil Nadu Stainless Steel Merchants Association Member's Directory, 2009, etc. and submitted that the alleged design has also been published by several traders, manufacturers even prior to the registration of the plaintiffs' design, which would show that already the design is in public domain. But, suppressing all these facts, the plaintiffs had registered the design. In this regard, learned senior counsel appearing for the defendants has also invited the attention of this Court to United States Design Patent No.US D522,809 dated 13.6.2006 and United States Design Patent No.US D545,137 dated 26.6.2007 and submitted that the alleged design has already been registered in the United States and under Section 19 of the Designs Act, 2000, if the design has been published in India or any other country prior to the date of registration, the said registration could be cancelled. In this regard,

learned senior counsel appearing for the defendants has also invited the attention of this Court to the petition filed by the defendants in Form 8 for cancellation of the registration of the Design No.256062 in Class 07-02 before the Controller of Designs, Calcutta. He has further submitted that if a person has a registration for a design, which has already been in a public domain and if the said person brings a suit against any other person based on the registration of the said design, the said suit can be defended under Section 22(3) of the Designs Act. Thus, the learned senior counsel appearing for the defendants submitted that it is incorrect to state that if a design is registered, the defendants have no defence in the suit. The learned senior counsel has also relied upon the following decisions:-

(i) (2005) 4 M.L.J. 294 - Metco Polymers Private Limited and another v. Madhu Inflatables Private Limited, Chennai and another.

(ii) 2005-3-L.W.598 - Metro Polymers Pvt. Ltd. & another v. Madhu Inflatables Pvt. Ltd. and another.

(iii) MANU/MH/0693/2005 - Taparia Tools Limited v. Ambica Overseas and Anr.

(iv) **MANU/DE/0525/2014 - Steelbird Hi-Tech India Ltd. v. S.P.S.Gambhir & Ors.**

Thus, he sought for the dismissal of both the applications.

9. In reply to this, learned counsel appearing for the plaintiffs submitted that the list of publications as well as United States Design Patent Nos.US D 522,809 and US D545,137 produced by the defendants have no significance to decide the issue involved in this case and since there is a valid registration under the Designs Act, 2000 in favour of the plaintiffs, the defendants are not entitled to use the said design. Hence, the plaintiffs are entitled for an interim injunction.

10. I have heard the submissions made on either side and perused the entire materials available on record.

11. It is the case of the plaintiffs that they have been manufacturing and marketing electric kitchen appliances for several years. During the course of business, they have designed a novel Unitary Multilayer container and idly plates. The said design was registered with the Controller General of Patents, Designs and Trade

Marks in Design No.256062. While so, recently, in the year 2014, the plaintiffs came to know that the defendants are also manufacturing and selling Unitary Multilayer container and idly plates, which is an exact imitation of plaintiffs' registered design. It is the further case of the plaintiffs that unlike the Trademarks Act, the plaintiffs need not establish the prior usage or good will or reputation and if there is valid registration, that would suffice to grant interim injunction in their favour. Per contra, according to the defendants, the design adopted by the plaintiffs is not a new and original one and hence, the same ought not to have been registered. In fact, the defendants have also filed a petition in Form 8 for cancellation of the registration of the Design No.256062 in Class 07-02 before the Controller of Designs, Calcutta. In this regard, learned senior counsel appearing for the defendants by inviting the attention of this Court to the list of publications, submitted that similar design was adopted by several other manufacturers much earlier to the registration of the plaintiffs. Therefore, the said design has already been in public domain. When a design has already been in public domain, registration of such a design is prohibited under Section 4 of the Designs Act. Even if it is registered, on filing a petition by any person interested on any one of the grounds available under Section 19 of the Designs Act, the said

registration could be cancelled. Further, as per Section 22(3) of the Designs Act, the ground available under Section 19 of the Designs Act to cancel the registration of a design could also be taken as a defence by the defendant, if a suit is brought by a person as against any other persons based on the said registration. In view of the said submission made by the learned senior counsel appearing for the defendants, it would be appropriate to extract Sections 4 and 19 of the Designs Act, 2000 and the same are extracted hereunder:-

" Section 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. 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:-

(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. "

As per clause 4(b) of Designs Act, 2000, if the design 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, the same shall not be registered. In the instant case, from the documents produced on the side of the defendants, I find that the design of layers in the inner and outer wall of the plaintiffs' container was already in public domain. Further, a perusal of the Tamil Nadu Stainless Steel Merchants Association Member's Directory, 2009, would show that already the design was in public domain and further from the United States Design Patent Nos.US D 522,809 and US D545,137 produced by the defendants, it could be seen that the said design was already registered in United States. Under such circumstances, I am of the opinion, the design is not liable to be registered and the same is liable to be cancelled under Section 19(1)(a) and (b) of the Designs Act, 2000. But, it is the submission of the learned counsel appearing for the plaintiffs that since the said design is registered, unless the said registration is set aside, the defendants cannot oppose the grant of

interim injunction. But, I am not inclined to accept the said submission made by the learned counsel appearing for the plaintiffs. Under Section 22(3) of the Designs Act, 2000, the defendants can defend a suit if it is brought on the ground of infringement of design against them on any one of the grounds mentioned in Section 19 of the Designs Act, 2000. Section 22(3) of the Designs Act, 2000 reads as follows:-

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

The ground mentioned in Section 19 of the Designs Act, 2000 is available as a defence to the plaintiffs in the present suit. Therefore, I am of the opinion, it is not necessary for the defendants to wait till the registration of the design to be set aside.

12. In this regard, a reference could be placed in the judgment reported in **2005-3-L.W.598 - Metro Polymers Pvt. Ltd. & another v. Madhu Inflatables Pvt. Ltd. and another**, wherein

this Court as held as follows:-

" 15. By incorporating Sub Section (3) of section 22 of the Designs Act, the registration of a design may be cancelled on every ground available as a ground of defence. The grounds on which the registration of a design can be cancelled have been enumerated in section 19 of the Act. If a design is a conception, suggestion or idea of a shape is not an article. If it has already been anticipated, it is not new or original. If it has been pre published, it cannot claim protection as publication before registration defeats the proprietor's right to protection under the Act. Thus, looked at from any angle from the documents placed on record, the designs registered by the plaintiffs have been pre-published and therefore they cannot claim protection, since the registration of the designs are only few years later than the publication of the designs by the respondents / defendants. The grounds of defence as mentioned in Section 19 can be taken by the respondents / defendants pursuant to sub section (3) of Section 22 of the Designs Act and therefore

no injunction can be granted as there is a serious dispute with regard to the validity of the designs to be tried in the suit. Hence, the applicants / plaintiffs are not entitled for an injunction. Therefore, this original application is liable to be dismissed and the same is hereby dismissed. No costs. "

The dictum laid down in the above judgment would show that if the design is already in public domain, the same cannot be registered. If such a design is registered, the same can be cancelled. Even before cancellation of the design, if a suit is brought against a person for infringement, the same can be defended by the defendant under the grounds available under Section 19.

13. In yet another decision reported in **MANU/MH/0693/2005 - Taparia Tools Limited v. Ambica Overseas and Anr.**, the Bombay High Court has held as follows:-

" 21. I am, prima facie, of the view that plaintiff's design of Wrench is published in India and other countries prior to the date of registration by them. Although,

Mr. Shah would contend that the statement in the affidavit in reply to the aforesaid effect is not supported by any materials, in my view, a perusal of exhibits to the affidavit in reply and the further reply would go to show that the designs of Wrenches have been published in India prior to the registration in favour of plaintiffs. The exhibits are not mere extracts of information available on inter-net. There is an extract of the certificate of ISI. The information may be available on inter-net/web-site but when the same contains statements about parties using such designs from 1984-85, it cannot be brushed aside straight away. The truth and veracity of such statements in addition to the assertions on affidavit will have to be decided at the trial. Even the plaintiff could have filed further affidavit but that opportunity is not availed off. Further, several Wrenches available in the market were produced for my perusal. When I saw each one of them it is clear to the naked eye that their shape and configuration is common to that of the plaintiff. Even the scale marking appears to be common. Thus, insofar as the scale marking is concerned, there does not appear to be any novelty. Even as regards

the shape and configuration of the Wrench, there is ample material produced by the first defendant to prima facie negative the pleas of plaintiff."

14. In yet another decision reported in **MANU/DE/1429/2001 : 2002 (24) PTC 449 (Del.) - Rotela Auto Components Pvt. Ltd. v. Jaspal Singh and Ors.**, it has been held as follows:-

" 28. As far as present Act is concerned, the legislature in its wisdom by incorporating Sub-section (3) of Section 22 of the Act has made every ground, on which registration of a design may be cancelled, available as a ground of defense. The ground on which cancellation can be sought of registration are enumerated in Section 19 of the Act. It may be noticed that the design is a conception, suggestion or idea of a shape and not an article. It has already been anticipated, it is new or original. if it has been pre-published, it cannot claim protection as publication before registration defeats the proprietor's rights to protection under the Act."

In the instant case, several materials are produced by the defendants to show that the design alleged to have been invented by the plaintiff, was already in public domain. When it is already in public domain, it is a valid ground for cancellation of the registration. When the ground for cancellation of the design is established before this Court, this Court cannot grant interim injunction. In this regard, learned counsel appearing for the plaintiffs by relying upon the decision of this Court reported in **MANU/TN/ 0103/2014 - M.C.Jayasingh v. Mishra Dhatu Nigam Limited (MIDHANI) rep. by its Managing Director, Apollo Hospitals, Apollo Hospitals Enterprise Limited and Cancer Institute (W.I.A.) (Regional Cancer Centre)**, submitted that if there is a valid registration, the plaintiffs are entitled for interim injunction. A reading of the said judgment would show that in that case, the defendant therein had not challenged the registration of the design. In fact, the learned Judge has observed in that judgment that since the defendant had not challenged the registration, it has to be taken that the validity of the plaintiff's design was not under challenge. But, in the instant case, the defendant has already challenged the registration by filing necessary application. Therefore, the said decision cannot be made applicable to the facts of the present case.

15. On the whole, I am of the opinion, since the registered design was already in public domain, the registration of the said design is liable to be cancelled under Section 19 of the Designs Act. When that being so, the question of granting injunction does not arise in this case merely for the reason that the plaintiffs' design was registered under the Designs Act.

16. For all the reasons stated above, I am of the opinion, the plaintiffs have not made out any prima facie case to grant interim injunction in their favour. Therefore, the present applications are liable to be dismissed.

17. Accordingly, both the applications are dismissed.

17 .03.2015

Index:Yes
Internet:Yes
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R.SUBBIAH, J

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**Pre-delivery order
O.A.Nos.861 and
862 of 2014
in
C.S.No.701 of 2012**

DATED: 17.03.2015