

Atul

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION (L) NO. 209 OF 2017
IN
SUIT (L) NO. 48 OF 2017

1. CELLO HOUSEHOLD PRODUCTS,

A registered partnership firm, having
its office at Cello House, Corporate
Avenue, B Wing, Sonawala Lane,
Goregaon (East), Mumbai 400 063
India

**2. CELLO PLASTIC INDUSTRIAL
WORKS,**

A registered partnership firm, having
its office at Cello House, Corporate
Avenue, B Wing, Sonawala Lane,
Goregaon (East), Mumbai 400 063
India

... **PLAINTIFFS**

~ **VERSUS** ~

1. MODWARE INDIA

having its office at 109, 2nd Floor,
Swadeshi Market, 316, K D Road,
Mumbai 400 002 and factory at No. 15
& 16, S.K-1 Compound, Lasudia Mori,
Dewas Naka, Indore 452 001, Madhya
Pradesh, India

2. PRAVEEN MURARKA,

C/o. M/s. Modware India, having
office at 109, 2nd Floor, Swadeshi
Market, 316, K D Road, Mumbai 400
002 and factory at No. 15 & 16, S.K-1

... **DEFENDANTS**

Compound, Lasudia Mori, Dewas
Naka, Indore 452 001, Madhya
Pradesh, India

APPEARANCES

FOR THE PLAINTIFFS	FOR THE DEFENDANTS
Mr VV Tulzapurkar, Senior Advocate, <i>with Hiren Kamod & Gautam</i> <i>Panchal, i/b Gautam & Co,</i>	Mr Harshit Tolia, <i>with Rajendra Bhansali, &</i> <i>Mandar Soman.</i>

CORAM: G.S. PATEL, J

DATED: 30th March 2017

ORAL JUDGMENT:

1. The action is in design infringement and passing off. There is also a prayer in the suit for relief in passing off in relation to packaging. The design in question is of a plastic water bottle. The Plaintiffs (collectively, “**Cello**”) claim to have designed a unique water bottle —in the words of the Designs Act 2000, one that has both novelty and originality. This claim is based on the bottle’s shape, configuration and surface ornamentation. Cello says the Defendants (collectively, “**Modware**”) illicitly brought into the market a product that is indistinguishable in every single respect, down even to the colours of the water bottles. Though Cello makes no claim in the colour or colour combinations, Mr Tulzapurkar for the Plaintiffs makes a reference to the two-tone colour scheme of the water bottles only to show the extent of copying. He also points out

that even the packaging adopted by Modware is so remarkably similar to Cello's that it cannot be a mere coincidence.

2. The facts lie in a narrow compass. Both Plaintiffs are partnership firms. They are part of the Cello Group of companies. They make various types of plastic insulated products such as bottles, bowls and so on. The 2nd Plaintiff owns the house mark **CELLO**. It controls this for other group companies. The 1st Plaintiff manufactures and markets these products bearing the house mark.

3. Paragraphs 4 and 5 of the plaint speak to the Plaintiffs' reputation and corporate track record. There is no dispute about this. Cello claims a high sales turnover and promotional expenses. I will accept this too as correct. There is no denial and no part of the defence is based on this.

4. The bottle in question is known as the **PURO** bottle. The Plaintiffs say it has a unique innovative, original and novel design. The novelty claimed is set out in paragraph 11 of the plaint and its sub-paragraphs:

“11. The feature of novelty in PURO Bottle design resides inter alia in its overall shape, configuration and surface pattern making the said design aesthetically appealing and attractive. The characteristic features used by the Plaintiffs to impart distinctive design to the PURO bottle along with the cap manufactured by them are highlighted herein below:-

- (1) The Plaintiffs' PURO bottle has a unique shape, configuration and surface pattern;
- (2) The configuration of the bottle is such that it appears as if the body of the bottle is divided into separate parts;
- (3) The surface pattern of the bottle has a unique type of oval/egg shape curve, which looks aesthetically attractive. Unsymmetrical places reversed oval graphics on main body gives contemporary and unique impression to a bottle.
- (4) Interplay of stepped up and stepped down surfaces creates unique surface pattern.
- (5) Minimal yet clean and bold graphic elements makes PURO Bottle stand out in cluttered market place/against the competition.
- (6) The flip cap of the bottle also appears that it has divided into two parts.
- (7) The surface of bottle has a shining effect, which gives elegant effect to the PURO Bottle.
- (8) The main body of the PURO bottle as also its cap contains a unique colour combination of two colours.

(All above features of PURO Bottle, are hereinafter collectively referred to as "the said features").

5. Cello says it created this bottle in-house in May 2016. It applied for registration with the Controller General of Patents, Designs and Trade Marks, who granted the application under Design Registration No. 283345 on 23rd August 2016 with a priority date of 12th May 2016.¹ Cello claims this bottle is unbreakable, leak-proof and, being BPA-free, safe. In paragraph 18 of the Complaint, Cello says the aesthetic (i.e., the non-functional or capricious) elements in the design, including the surface ornamentation and the other unique features referred to earlier, have never been used in such combination for any previous bottle. The PURO bottle is sold in various two-tone colour combinations in a distinctive packaging. It is one of Cello's most successful and popular products. A separate statement of sales from May 2016 to December 2016 for the PURO bottle, certified by the Chartered Accountants, is annexed,² as are sample invoices.³ Cello claims that in that very brief span of six months or so, it achieved PURO bottles sales in excess of Rs. 7 crores. Cello also says it was widely advertised.

6. Cello claims that it came upon Modware's rival bottle, under the name KUDOZ, in the third week of January 2017. The similarity is so exact, says Mr Tulzapurkar, that both infringement and passing off are self-evident.

7. In paragraph 21 of the complaint, Cello first sets out in a tabular fashion its product and compares it to Modware's. There follows a

1 Complaint, Exhibit "E", pp. 104-110.

2 Complaint, Exhibit "G", p. 112.

3 Complaint, Exhibits "H-1" to "H-31", pp. 113-143.

description of similarities. I will reproduce the images that are to be found in the plaint, as also those in paragraph 21 relating to the packaging:

Plaintiffs' PURO Bottle	Defendants' impugned KUDOZ Bottle
	
	



The Plaintiffs' PURO bottle has a unique shape, configuration and surface pattern	Identical shape, configuration and surface pattern has been adopted by the Defendants
The configuration of the bottle is such that it appears as if the body of the bottle is divided into separate parts	The configuration of the bottle is such that it appears as if the body of the bottle is divided into separate parts
The surface pattern of the bottle has a unique type of oval/egg shape curve,	The surface pattern of the bottle has similar type of oval/egg shape curve,
Interplay of stepped up and stepped down surfaces creates unique surface pattern.	Interplay of stepped up and stepped down surfaces creates similar surface

	pattern.
The bottle has a flip cap which has been divided into two parts.	The bottle has a flip cap which has been divided into two parts.
The surface of bottle has a shining effect	The surface of bottle has a shining effect
The main body of the PURO bottle as also its cap contains a unique colour combination of two colours.	The main body of the impugned bottle as also its cap contains a unique colour combination of two colours.

8. The packaging comparison images are from paragraph 22 of the plaint.

Plaintiffs' PURO Bottle Packaging	Defendants' impugned KUDOZ Bottle Packaging
FRONT SIDE 	FRONT SIDE 
The getup, colour combination and background of the packaging bag is very attractive and unique	The Defendants have used a similar getup, colour combination and background for its packaging.

BACK SIDE 	BACK SIDE 
	The placement of word like BPA Free, Insulated Water bottle, Break Free, Leak Proof etc. are copied from the Plaintiff's packaging.

9. I have reproduced these images not for a juxtaposed comparison myself, but because when the actual bottles and packaging were placed before me, my question to Counsel on both sides was “Which is whose?” I should imagine that in an action such as this, that is more than enough for the grant of interim relief. After all, this branch of law requires the test to be that of the Court’s impression, presumably on the footing that if a judge cannot tell the difference then more should not be demanded of the average consumer, he of average intelligence and imperfect recollection.

10. The tests for the reliefs in infringement and passing off often overlap. Similarity in the two products is undoubtedly common ground. If one should find, therefore, that Modware's product is confusingly and deceptively similar to that of Cello's registered design, ordinarily an injunction on the cause of action in infringement should follow. The defences are few and well-known. These would include saying that the design is known to the prior art; there is prior publication or, perhaps, that the plaintiffs' only claim, correctly read, is neither of novelty nor originality but of merely cobbling together several pre-existing known designs, or mosaicing. Indeed, these are the principal defences that Mr Tolia for Modware takes.

11. Slightly different considerations arise when assessing the claim in passing off. Here, as in any passing off action, a plaintiff must satisfy all three probanda of the so-called Classical Trinity: (i) reputation and goodwill in the goods; (ii) misrepresentation by the Defendants; and (iii) damage. This posits that similarity is demonstrated to begin with; that done, the question then is not so much whether it is confusing, but whether it is calculated to deceive. Passing off is an action in deceit; the deceit lies in the misrepresentation; and the misrepresentation must be as to source, i.e., to deceive the average consumer into believing the defendant's product is the plaintiff's. There need not be fraud, and intention is irrelevant. It is well-settled that actual damage does not have to be proved. The mere likelihood of damage, viz., that damage was reasonably foreseeable, suffices. Reputation and goodwill are also slightly different concepts. This has been the subject of some debate in international cases but this need not detain us today because Cello

claims both reputation and goodwill and does not seek to treat the two as synonymous. There is some authority for the proposition that there must be a sale, because without a sale there is no misrepresentation; and, too, for the proposition, that there must be some *prima facie* evidence of misrepresentation, this not being a presumption. That material can come in different forms, and one of this might be to show the extent of copying and its exactitude, or to show that elements *other* than those in which protection is claimed have also been copied.

12. The passing off alleged is not only of the bottle itself but also of the packaging. At this stage, I will note a few sections of the Designs Act 2000.

2(d) “**design**” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957);

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

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.”

13. Modware has made no application for cancellation of Cello's registered design.

14. Annexed to the plaint also, apart from the body of the plaint, are further comparisons. Cello's PURO bottle is shown in different colours at pages 100, 101, 102 and 103 and is contrasted with Modware's KUDOZ bottles in corresponding colours at pages 144, 145, 146 and 147.

15. Mr Tolia's defences are these. He says, first, that there is prior publication. He says this on the basis that Modware also manufactures bottles. His case is that a bottle is a bottle, by whatever name called. It is a container of liquid. Generally, it is taller than wider. Modware makes very many bottles. So do others. He shows me images of Modware's various bottles and those of other manufacturers. All these are just bottles, he says. Therefore, according to him, there is neither novelty nor originality in Cello's claim as to 'shape' or 'configuration'. Others have also made tall cylinders with screw top or flip top lids. Cello can claim no originality in these.

16. In paragraph 9 of the Affidavit in Reply, Modware claims that the shape of the PURO bottle is "the natural shape of any bottle" and this is millennia old. In paragraph 11 it then claims that the surface pattern or ornamentation has no novelty. This is 'merely' an ovoid shape embossed or recessed on the bottle's surface. Modware also suggests that the oval shape is functional to provide a better grip. Cello makes no such claim. There is no evidence of this at all.

17. As to the bottle in question itself, Mr Tolia says all that Modware did was to take the lid from one of its other products, *Kool Kruiser*, and apply it to the KUDOZ product. The *Kool Kruiser* bottle has been in the market in the past. Therefore the ‘design’ is known to the prior art. There is prior publication. In April 2014, Modware launched its *Kool Kruiser* bottle. In May 2009, it applied for registration of its *Kool King* bottle, another similar design, according to Mr Tolia. Mr Tolia insists Modware’s KUDOZ bottle is similar to its own earlier products, *Kool Kruiser*, *Kool King* and *Mario* in various regards — some in respect of shape, some in respect of configuration and some in respect of design. But all these, even from the images that are shown in the Reply, are entirely different from Modware’s impugned product, KUDOZ.

18. The difficulty in accepting any of this is graphically demonstrated at page 132 of the Notice of Motion paper book where Modware’s KUDOZ bottle is set next to its own *Kool Kruiser* bottle. The two are entirely different products. The *Kool Kruiser* is nothing at all like Cello’s PURO; but Modware’s KUDOZ bottle is almost exactly Cello’s PURO bottle. That is the totality of the case before me.

19. The a-bottle-is-a-bottle argument must be rejected. It is not possible to accept this submission that no vertical cylindrical fluid container can have either originality or novelty because it is, after all, vertical and cylindrical. That is an unacceptable oversimplification of the requirements of the Designs Act and of the law on the subject.

20. I find no explanation for Modware taking not only this registered design but its identical — or, at any rate, an extremely and certainly deceptively similar — packaging and the same two-tone colour combinations. These are all issues that will have to be considered in the context of the settled law on the subject. There is no manner of doubt in my mind that on all three aspects, i.e., shape, configuration and ornamentation, the Modware KUDOZ product is wholly indistinguishable from Cello's PURO bottle.

21. The first test to which Mr Tulzapurkar invites my attention is that set out in SJ Kathawalla J's order in *Whirlpool of India Ltd v Videocon Industries Ltd.*⁴ The decision covered a range of issues in the context of rival designs for washing machines. Paragraph 25 of the decision sets out the tests to be applied in deciding what constitute an obvious imitation and is actionable as such:

“26. The question of what tests are to be applied in deciding what constitutes an obvious imitation and/or is actionable is no longer *res integra*. This question has been considered in several judicial pronouncements. The leading decisions on the point are the decisions in the case of *Castrol India Limited vs. Tide Water Oil Co.(I) Limited* (1996 PTC (16) 202) and *Kemp & Co. vs. Prima Plastics Limited* (Vol. 101 (1) BLR 65). In both the decisions, the Kolkata High Court and the Bombay High Court have laid down the following propositions as constituting the test to decide whether there is obvious imitation and/or piracy of a registered design.

4 2014 (60) PTC 155 (Bom) : 2015 (1) Bom CR 137.

Castrol India Limited vs. Tide Water Oil Co.(l) Limited:(supra)

(i) The word 'imitation' does not mean 'duplication' in the sense that the copy complained of need not be an exact replica.

(ii) The Court is required to see in particular as to whether the essential part or the basis of the Plaintiff's claim for novelty forms part of the infringing copy.

(iii) The similarity or difference is to be judged through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser.

(iv) The Court must address its mind as to **whether the design adopted by the Defendant was substantially different from the design which was registered. The Court ought to consider the rival designs as a whole to see whether the impugned design is substantially different** from the design sought to be enforced. (The test laid down on *Benchchairs Ltd. C. Chair Center Ltd.* (1974 RPC 429) was cited with approval).

(v) 'Obvious' means something which, as soon as one looks at it, strikes one as being so like the original design/the registered design, as to be almost unmistakable. **Fraudulent imitation is an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than obvious imitation, that is to say, one may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render**

it not obviously an imitation may yet be an imitation perceptible when the two designs are closely scanned and accordingly amounts to infringement. (The test laid down in *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd.* ((1932) XLVIII RPC 279) was cited with approval.

Kemp & Co. vs. Prima Plastics Limited: (supra)

(i) **If the visual features of shape, configuration pattern designs are similar or strikingly similar to the eye, it is not necessary that the two designs must be exactly identical and same. The matter must be looked at as one of substance and essential features of the designs ought to be considered.**

(ii) In a given case, **where the registered design is made up of a pattern which has no one striking feature in it, but it appeals to the eye as a whole, it may very well be that another design may be an imitation of it which makes the same appeal to the eye notwithstanding that there are many differences in the details.** (The opinion of Farwell J. in *Dunlop Rubber Co. Ltd. vs. Golf Ball Developments Ltd.* ((1932) SLVIII RPC 279) was cited with approval).

(iii) In comparing rival designs the Court is required to see whether the impugned design/product is substantially different to the design which is sought to be enforced.

The aforesaid tests have been independently applied and/or followed in a series of judgments of various High Courts, including judgments in *JN Electricals (India) vs. M/s. President Electricals* (ILR 1980 (1) Del 215, paras 24-25); *Alert India vs. Naveen Plastics* (1997 PTC 17, para 36); *Hindustan Sanitaryware v. Dip Craft Industries* (2003 (26)

PTC 163 (Del), para 8), and *Dabur India v. Amit Jain & Anr.* (2009 (39) PTC 104 (Del) (DB)).”

(Emphasis added)

22. The approach is not, as the Court said, in identifying individual similarities or dissimilarities. These are not dispositive. The judicial assessment must be on an examination of the rival products, actually made available if possible. The products and designs must be seen as a whole, from the perspective of the common consumer. The test is of visual appeal, and the task is to see if the essentials of that which makes it visually appealing have been substantially, but not necessarily exactly, copied.

23. In this case too, one of the defences taken is that Modware took the lid from one its own other designs and applied it to the one Cello says is the infringing product. Mr Tulzapurkar’s submission is that once an explanation offered by Modware is found to be unworthy of credence, the inevitable conclusion must be that Modware copied Cello’s design. This is a submission hard to resist.

24. In *Whirlpool*, the defendants too alleged lack of novelty. This is how Kathawalla J dealt with that submission:

“40. The next defence which the Defendant has raised to the Plaintiff’s registration is the lack of novelty in the Plaintiff’s design. It has been contended that there is no new, novel or original shape in the Plaintiff’s design. The Plaintiff’s design is a combination of known designs. The Defendant urges that the Plaintiff has used designs (or parts thereof)

which were in the public domain and the aggregation thereof, in the form /shape of a present design, lacks novelty and/or originality. In support thereof, the Defendant had adduced extensive material which amounts to a virtual aggregation of almost all the available washing machines. If the machines depicted in the Defendant's material are considered, it is impossible to discern how a defence of lack of novelty or originality based on a plea of combination of known designs can be sustained. The Plaintiff's product has a design and/or shape which is very distinctive and is a novel combination of a distinctive circular shaped wash area, an equally distinctive rectangular shaped dry area and a uniquely placed and/or designed panel. In an attempt to discredit this combination the Defendant has placed on record washing machines which are largely rectangular in shape. Realizing that this material is not adequate, the Defendant in a further affidavit in reply dated 30th July, 2013, then sought to place reliance upon some products and/or registrations from China/Hong Kong (Pages 147-150 of further Affidavit in reply of the Defendant dated 30th July, 2013). **None of these have any similarity with the Plaintiff's product. In fact as submitted on behalf of the Plaintiff, each subsequent design/product relied upon by the Defendant has only been progressively and increasingly different.** The Defendant has in particular placed strong reliance on a US Patent office specification which contains the design of a semi automatic washing machine which is found at page 420 of the written statement which is reproduced herein below. ...

(Emphasis added)

25. This entirely covers the defences taken before me, too, including Mr Tolia's submission that Cello's product is a mere combination of known designs.

26. As to the question of passing off Kathawalla J held that there was no dispute before him — and indeed there is none before me — that under Section 2(z) of the Trade Marks Act, 1999, the definition of “mark” includes the shape of goods.

27. Mr Tulzapurkar also draws my attention to the order of the Division Bench in appeal from an earlier order in the same dispute, and in particular paragraphs 13 and 14. There, Mr Tulzapurkar for the Appellant took the very arguments that Mr Tolia takes today. Mr Tulzapurkar did not succeed. Neither can Mr Tolia, and for exactly the same reasons. Both decisions bind me, and particularly the finding that novelty and originality are to be tested in the context of aesthetic or visual appeal.

28. I must reject too Mr Tolia's argument of mosaicing. I believe it to be misapplied to this case. It is not a requirement of the law in infringement or passing off in relation to a design that every single aspect must be entirely newly concocted and unknown to the history of mankind. If that were so, we should never see any new or original design at all. It is a general rule that “mosaicing” of prior art, i.e., combining selected features in different prior art publications, is not permissible when assessing whether an invention is new. Conversely, mosaicing is also no defence to a charge of infringement of a registered design. Mosaicing contemplates taking known

integers or combinations and simply re-arranging them. In a situation like ours, it might for example apply if Cello laid claim to a very similar bottle with a similar shape, configuration and ornamentation but merely repositioned the ornamentation by setting it horizontally rather than vertically and doing not much else besides. That is not the case here.

29. Mr Tulzapurkar also refers me to my previous decisions in *Selvel Industries & Ors v Om Plast (India)*⁵ and *Faber-Castell Aktiengesellschaft & Ors v Cello Pens Pvt Ltd & Ors*⁶ but I will pass over these quickly, noting only that in this case, as in *Selvel*, I find no plausible explanation from Modware as to how it chanced upon this very design. In paragraph 27 of my decision in *Faber-Castell* I quoted a passage from *Johns v Hallworth*:⁷

“... I only refer to it as showing what the difficulty is; because there, the Court of Appeal, consisting of three learned Judges, all thought — their three pairs of eyes all thought — that the similarities were supreme, as the differences were of little moment. **The difficulty of the task imposed upon the Judge consists in what I have stated. One has to go through a certain process of induction; because in no case that ever I tried and in no case that I ever heard of was it not possible for the Defendant to say, “I am perfectly at liberty to make this article; I am at perfect liberty to call it so-and-so; I am perfectly at liberty to attach to it such-and-such a name,” and so on to the end of the chapter.** If you take — as, of course, Mr. Bigham, as an advocate, did take —

5 2016 (67) PTC 286 (Bom).

6 2016 (65) PTC 76 (Bom).

7 14 RPC 225.

the points of similarity in detail, it is often not very difficult — sometimes it is extremely easy — to show that in all those points of similarity the Defendant is perfectly right and has played the part of an innocent man. That applies directly to this case. No one contends that the Defendants are not entitled to manufacture and sell polishing cloths; nobody contends that they are not entitled to manufacture and sell polishing cloths of certain sizes, or to impress thereon by printing or otherwise certain words; nobody contends that they are not at liberty to make these of Egyptian or American cotton, and, if they make them of Egyptian cotton alone, or of Egyptian and American cotton mixed, not to produce them of a certain colour. Nobody contends that this fact pile velveteen is not open and common to the trade and suitable to the particular article; that it may not be singed; that it may not be scoured. All those things are perfectly common to the trade; every one of them may be done with perfect innocence. But, by an inductive process, one may come to this conclusion, that every one of those perfectly innocent things when combined in a series may produce something which is the reverse of innocent.”

(Emphasis added)

30. This is exactly true of the present case. Mr Tolia’s attempt to dismember the design into individual integers is futile. The configuration, shape and ornamentation used in both is such that is impossible to tell one from the other.

31. *Gorbatschow Vodka KG V John Distilleries Ltd*⁸ is a decision that relates to both Trade Marks Act and the Designs Act. On the question of passing off and honesty in adoption, Chandrachud J (as he then was) said in paragraph 25, citing the well-known case of *Slazenger & Sons v Feltham & Co.*⁹

“... There is sufficient nearness, sufficient neighbourhood, in the one word to the other, to justify me in coming to the conclusion that it is calculated to deceive. I shall, no doubt, be assumed to conclude and I make no secret that I do conclude that that finding is at least consistent with the honesty of the case.”

As Lord Justice Lindley held in that case:

Well, what is that for? **One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?**

(Emphasis added)

I might say the very same; and I do. There is no reason that we here today should be any more astute than Lord Justice Lindley, so as to

8 2011 (47) PTC 100 (Bom).

9 1889 RP Design 531

say that Modware is unlikely to succeed in doing that which it is evidently straining every nerve to do.

32. I am not impressed by Mr Tolia's argument based on Section 4(1)(c) of the Designs Act 2000 that the Plaintiffs' bottle is not significantly distinguishable from known designs or a combination of known designs. This is not demonstrated in the least. His argument is that since a bottle is a bottle, and is always only a bottle, only an expert that can tell one bottle from the other. I do not think this is remotely true. For some who claim familiarity with bottles — perhaps for reasons unrelated to their design — the differences are evident; many cylindrical liquid containers are instantly recognized as unique and as indicative of their contents. The expertise, usually borne of much experience, in such cases has not so much to do with the design of a bottle as its contents. No "expert" can add much more than that which is obvious to the naked eye.

33. Mr Tolia then says that the Plaintiffs' design was 'anticipated'. How, he does not say, nor by whom. Certainly it does not seem to have been "anticipated" by Modware, for it waited till the PURO bottle reached the market before embarking on production of its own competing product. Copying is not anticipation. However, it may very well be both infringement and passing off.

34. Mr Tolia places a very great deal of reliance on the decision of the House of Lords in *Phillips v Harbro Rubber Company*.¹⁰ This was

10 Vol. XXXVII RPC 233.

also a case of design infringement. It pertained to a surface pattern of India rubber pads or plates for heels or boots and shoes. Mr Tolia emphasizes this to suggest that it is not the eye of the layman that should be determinative but it should be that of an instructed person, one who would know what was common trade knowledge and usage in the class. I understood this submission, based on pages 239 and 240 of the report, to mean that it would require an expert or a person well versed in the trade to be able to say what was and what was not previously known to that trade; more particularly to prevent normal trade variants from being masqueraded as new or original. Where, for example, Mr Tolia says, it is not a question of a combination but merely an optional addition to the article then the tests of design registration are not met and no injunction should be granted. In the context of the items before me, he submits that there is nothing to show that the oval ornamentation — the “optional” element in our case — is unique. I would actually invert this. There is nothing before me to show that it was ever commonplace; certainly Modware has not brought forth any such material. I do not see how we can rely or demand the views of an expert to show us something that simply does not exist or is not shown to exist. It would be for Modware to show that such ornamentation is commonplace. What the argument overlooks, I believe, is that the House of Lords was duly instructed on the commonplace elements of trade use. We find this at page 241 of the report, placetum 5. I have no such ‘instruction’ and Mr Tolia is unable to offer any for reasons that I think that are obvious.

35. But what really fails Mr Tolia’s cause is the observation at page 243 of this very report at placetum 10 that the design must be

taken as a whole. In that case, the House of Lords may have found neither novelty nor originality but I do not think it is at all legitimate for Mr Tolia to expand this to suggest that the various integers in the bottle be segregated and each integer separately tested for novelty and originality. That is not even Cello's case. For a given bottle for, say, the manufacture of perfumes, fragrances or specialized liquor products, it is entirely conceivable that the bottle would take a completely unique shape, a never-seen-before combination of shape, configuration and ornamentation.

36. Mr Tolia is incorrect in saying that an expert view is the only test of novelty and originality. I believe Mr Tulzapurkar is justified in his reliance on the decision of the Court of Appeals in *Wright, Layman & Umney LD v Wright*.¹¹ This was in the context of passing off and the question was whether there was anything to clearly distinguish the defendants' product from the plaintiffs. That should be the determinant. In the present case, I am not shown anything to support any such distinction.

37. As to the question of reputation and goodwill, let us look at the distinct factors that the Plaintiffs have pleaded in support of their case. There is, first of all, largely uncontroverted, the material regarding evidence of sales. Paragraph 19 of the plaint says (and I will leave aside all sales figures) that in a six or seven month period, Cello achieved sales for this particular bottle in excess of Rs 7 crores. The answer to this is not what Modware suggests: that there are other bottles that are available in two tones, that there are bottle

11 LXVI RPC 149.

tops or lids others arguably of a similar shape although none are shown to have the combination Cello's bottle does. There is not, I find, a specific traverse of paragraph 19 of the plaint and perhaps that might be expecting too much. So when it comes to reputation the first factor we have is this large volume of sales. Then there is a statement by the Plaintiffs of the wide advertising done of the bottle. But the law on passing off requires that a reputation be established as to source, i.e., as to the Plaintiffs. This might be little more difficult where the manufacturer is a new entrant in the market. Cello is not. The reputation of the Cello house mark is already such that the Plaintiffs are an established name in direct relation to that mark. The question is not of identification of the brand, i.e., **PURO** and the Plaintiffs do not suggest that people necessarily buy a bottle by this name. What they do suggest is that people tend to prefer bottles with the **CELLO** mark, i.e., as identified as coming from the Plaintiffs' house or source; within that range of choice of Cello's products, this particular bottle has achieved a great deal of commercial renown. The question of establishing reputation for the purposes of passing off by identifying the product and its origin or source is thus answered.

38. This takes us to the second requirement of showing misrepresentation, and there, I imagine this must be a case of *res ipsa loquitur*. I can think of no tenable explanation for Modware to have adopted a shape, configuration and ornamentation so very nearly identical to that of Cello. Showing other bottles of the same height or girth does not take Modware the required distance. There is no explanation for the indistinguishable colours either, i.e., the exact same two-tone colour combination used by Cello. Modware did not

take merely a two-tone scheme but with different colours. Modware took exactly Cello's colours and colour combinations. This is true too of the packaging that Modware chose, and here again between the blue colour, the droplets of water and so on, the one is indistinguishable from the other.

39. What does this tell us? Everything points but in one direction that Modware was attempting to deceive consumers into believing that its products came from the house of Cello. This is, therefore, *prima facie*, an attempt calculated to deceive and the deception and misrepresentation is as to source or origin. These are the necessary requirements that must be met in a cause of action in passing off.

40. Modware also contends that this Court does not have territorial jurisdiction to entertain the Suit. I do not actually see how this can be raised because paragraphs 25 and 26 of the Reply do contain a statement that the label or printed matter on Modware's own product shows the address of one Lalitkumar Shah, a relative of the 2nd Defendant. That address is in Mumbai. In paragraph 27 the Defendants claim this address was only ever 'used for correspondence' and Shah has no connection with the Defendants. That is a submission that needs only to be stated to be rejected. Indeed I find it inconceivable that anyone would put a 'correspondence only' address on a physical object being offered for sale. This is usually found on letterheads and stationary but not on tangible product put to market. What is not denied, though, is that there is such a label; it is on Modware's product; and the address on that label is in Mumbai. The defence here is futile.

41. In my view, there is more than sufficient cause made out for the grant of interim reliefs. An ample *prima facie* case is made out and the balance of convenience is clearly in favour of the Plaintiffs, to whom irreparable injury would be caused in my view if the injunctions sought are denied.

42. On 2nd February 2017 I granted an ad-interim order in terms of prayer clause (a), (b) and (c). I will confirm that as the final order on this Notice of Motion.

43. The Suit, in my view, will need to be registered in the Commercial Division. The Registry will take the necessary steps in that regard acting on an authenticated copy of this order.

44. In view of the amendments to the Code of Civil Procedure 1908 brought by the Commercial Courts, Commercial Division & Commercial Appellate Division of High Courts Act 2015, and in particular the amendments to Section 35 and 35A of the Code of Civil Procedure 1908, this would mean that costs would follow the event, and an award of costs would have to be made against the Defendants. The amended Act requires me to give reasons for not awarding costs and, therefore, this: in view of the fair approach of Mr Tolia and Mr Soman throughout, and noting they have argued their case with admirable economy of time, I believe this is not a fit case for the award of costs.

45. The Motion is made absolute in these terms, with no order as to costs.

(G. S. PATEL, J.)