

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

COMMERCIAL APPEAL NO. 133 OF 2017

IN

Notice of Motion No. 2195 of 2016

in

Suit No. 742 of 2016

- | | | |
|--|---|------------------|
| 1. Kalpesh R. Jain, |) | ... Appellants. |
| carrying on business under the name |) | (Org.Defendants) |
| & style of Hariom Metals & Tubes, |) | |
| a Sole Proprietorship, office at 287/6-12, |) | |
| B-2, Hariom Compound G.I.D.C., |) | |
| Umbergaon, Valsad, Gujarat-396 171. |) | |
| |) | |
| 2. Ravi Raut, |) | |
| carrying on business at 287/6-12, |) | |
| B-2, Hariom Compound G.I.D.C., |) | |
| Umbergaon, Valsad, Gujarat-396 171. |) | |
| |) | |
| 3. Ketan Panchal, |) | |
| carrying on business at 287/6-12, |) | |
| B-2, Hariom Compound G.I.D.C., |) | |
| Umbergaon, Valsad, Gujarat-396 171. |) | |

V/s.

Mandev Tubes Private Limited,	)	... Respondent.
A company incorporated under the	)	(Org.Plaintiff)
Companies Act, 1956, having its registered	)	
office at 1/13 Bhaskar Bhavan Sitaram	)	
Poddar Marg, Fanas Wadi, 1 st Floor,	)	
Mumbai - 400 02.	)	

Mr. Rashmin Khandekar a/w. Mr. Shilpan Gaonkar & Ms. Sana Khan i/by Bhagwati Trivedi Advocate for the Appellants.

Mr. Rohan Kadam, a/w. Ms. Rajashri Karande i/by Joseph Vankasery for the Respondent.

**CORAM : S. C. DHARMADHIKARI AND
SMT.BHARATI H. DANGRE, JJ.**

DATE : 20th FEBRUARY, 2018

**[Judgment Reserved on : 14.12.2017]
[-- “ --Pronounced on : 20.02.2018]**

JUDGMENT : (Per Smt.Bharati H. Dangre, J.)

1 The present Appeal is filed by the Appellants (original defendants), being aggrieved by the order and judgment delivered by the learned single Judge of this court (Coram : G.S. Patel,J.) on 06.12.2016 in Notice of Motion No. 2195 of 2016 filed in Suit No. 742 of 2016, thereby recording the finding that the Plaintiff therein has demonstrated a prima facie case and that the Hon'ble Court is persuaded to grant the said notice of motion in terms of prayer clauses (a), (b) and (c).

 The present appellants were impleaded as Defendants/ Respondents in the Suit No. 742 of 2016 which was filed by the plaintiff Company - Mandev Tubes Pvt. Ltd.,

seeking protection of its registered design and alleging infringement and passing off.

Commercial Suit No. 742 of 2016 was filed by the Private Limited Company i.e. Mandev Tubes Pvt. Ltd., having its registered office at Mumbai, claiming that it manufacture / sells metal / copper tubes with diversified use and are often employed in household air-conditioning, medical gas delivery pipelines and indoor plumbing. It is the case of the plaintiff-company in the suit, mentioned above, that it is engaged in the business of manufacturing, supplying and distributing the copper tubes for the last 45 years and during this period, it had developed a substantial goodwill and enjoys a sufficient reputation in the copper tube industry. The plaintiff gave details of its clientel, which included several companies and reputed institutions like Bhabha Atomic Research Centre to Sigma Meditech Services Pvt. Ltd. etc.. According to the plaintiff, it conceived of a unique, novel and original shape and configuration for its tubes and the uniqueness and

novelty in its design lies in one end of the tube, possessing an expanded bell-shaped like ending and that it conceived of such a shape, as it was aesthetically pleasing to the eye. Pursuant to such configuration, the plaintiff had applied for registration of this novel and original design under the Designs Act, 2000 and on 4th March, 2010, the concerned Registrar issued a certificate of registration in favour of the plaintiff. The plaintiff had placed on record the said registration certificate in relation to Design No. 224751 and the respective representation sheets, which have described the designs in the following manner.

FRONT/ BACK VIEW | TOP / BOTTOM VIEW

“Novelty resides in the shape and configuration of the “METAL TUBE” particularly in the portions marked as “a” & “b” in Sheet No. 1 as illustrated.

No claim is made by virtue of this registration in respect of any Mechanical or other action of the Mechanism, what so ever, or in respect of any mode or Principle of Construction of the Article.

No claim is made in respect of descriptive matter, words, letters, Trade Mark, colour or Colour Combination and numerals as appearing in the Design.

No claim is made in respect of extraneous matter, which is not forming the integral part of the Design.”

2 In the suit, it is the claim of plaintiff that pursuant to the said registration, the plaintiff applied its unique and novel design to the copper tubes manufactured by it and those copper tubes were marketed and sold under the trademarks “MT ECO SELF CONNECT” and “MT MEDI SELF CONNECT PLUS”. The plaintiff promoted/ advertised its product extensively and acquired a good market through various industry magazines and due to the said advertisement, it had generated enormous sales and that the plaintiff was able to capture a significant market share. According to the plaintiff in or about February, 2015, the plaintiff learnt from trade sources that there was a fraudulent and obvious imitation of their product being sold in the market and on an enquiry, it was revealed by the plaintiff that these goods were marketed in uncanny resemblance to that of the plaintiff's self connect tubes and the deception was apparent to the eye. The plaintiff

learnt that one - Hariom Metal and Tubes i.e. the defendant no.1, was manufacturing the said tubes which infringed the plaintiff's rights. Resultantly, the plaintiff issued notice through his counsel to the defendant no.1, who is appellant before us in this appeal, asking / directing the defendant to cease and desist from infringing its registered designs and passing off as the plaintiff's self connect tubes. Defendant no. 1 denied the claim of the plaintiff and informed the plaintiff that it had obtained the registration in respect of its product.

3 The plaintiff was aggrieved by the said act of the defendants and claimed that the "differences" sought to be emphasized by the defendant are trivial and meaningless and a close comparison of the products revealed that the defendant had copied the essential feature of the Plaintiff's design in the expanded bell-shaped ending. According to the plaintiff, deception is further aggravated by the use of identical colour for the caps used on the defendant's tubes. The plaintiff also moved an application for cancelling / rectifying the defendant

no.1's registered design before the Controller of Designs, Kolkata and the said proceedings are pending. Left with no other effective remedy, the plaintiff filed the suit, claiming that the defendants have infringed the designs of the plaintiff and deceptively similar tubes manufactured by the defendants are being sold through the stockist market. The plaintiff had placed on record the evidence to that effect including the dealers invoices and delivery challan, depicting the pictures of the goods purchased under the said invoice. The plaintiff, thus was aggrieved by the unlawful and illegal manufacturing and about the supply and sale of the infringed copper tubes by the defendants and was also aggrieved and apprehensive of the irreparable loss and injury being caused to the goodwill of the business of the plaintiff. The plaintiff, therefore, prayed for a perpetual order and injunction, restraining the defendants from infringing in any manner the plaintiff's registered design and in any manner passing off of its design and tubes as those of the plaintiff. The plaintiff prayed for a decree in its favour and against the defendants

for a sum of Rs.20,00,000/- by way of damages for the alleged act of infringement and passing off on the part of the defendants. The plaintiff also sought a temporary order of injunction, restraining the defendants from infringing the plaintiff's registered designs during the pendency of the said suit.

4 A Notice of Motion No. 2195 of 2016 was taken out by the plaintiff in the aforesaid suit, praying for grant of temporary order and injunction, restraining the defendants from infringing in any manner the plaintiff's registered designs, but not limited to the sale of the infringing copper tubes or any other deceptively similar designs. By the said notice of motion, the plaintiff also sought a temporary order, appointing the court receiver to visit the defendant's factory and to take inspection and make inventory of the goods lying therein which infringed the plaintiff's registered design or passing them off, as they are deceptively similar to that of the plaintiff.

5 In response to the said Notice of Motion, the defendants (present appellants) filed their reply, alleging that that the suit was an abuse of process of law and had been filed with an attempt to stall the business of the defendants. The appellants (original defendants) invited attention to the notice of motion which was earlier filed by the plaintiff in suit no. 143 of 2016, claiming the identical reliefs, and set out the details of the said proceedings. The defendants sought dismissal of the suit filed by the plaintiff under Order VII Rule 11 of the Civil Procedure Code for lack of jurisdiction. The said notice of motion was also opposed on the ground that the defendants had invented a new design on their own and the novelty, configuration and ornamentation in its appearance and other interior linings and intellectual acts and accordingly, the entire design is the brain child of their hard, creative work and efforts in bringing the impugned design into existence. The defendants have also filed an application and obtained registration certificate for the said design and they are the registered proprietor of the said design. The

defendants attempted to distinguish the product of the plaintiff by giving description of their product in paragraph 8 (d) of their reply at page 51 of the paper book, which is reproduced as under :

“8 (d) It is submitted that the Defendants product is a copper tube and upper portion of the said tube is used to join two different tubes, hence it becomes coupling free copper tube. The said copper tube is used for distribution of air / gas and cooling for refrigeration purpose. While comparing the upper portion of the article of Plaintiff and Defendant it can be seen that the upper portion used to join two different tubes are different which is appealing to eye. It is well settled principal that it is not necessary that the whole of the design should be new. It is sufficient if some part of it is new or original. It is observed in various judgment that

“The novelty or originality of the particular part may be sufficient to impart the character of novelty and originality to the whole”

“Where a designer sets out to produce an article that would perform a particular function, but where in producing it has added or applied some features of shape that are additional or supplementary to what is functionally needed, with the result that in the finished article there are features that appeal to the eye there may be a design which is registerable within the statutory definition”

6 Another defence was taken by the defendants in the reply by contending that the plaintiff had obtained the registration of the said design by misleading the Controller of Designs and it was alleged that the plaintiff did not disclose to the Registrar that the said design applied by him is prior known and published design and the product was not novel, still the registration was procured. The defendants, therefore, raised a plea by placing reliance on section 19(b) and (c) of the Designs Act, 2000, by alleging that the design of the plaintiff's product was published prior to the registration and that in terms of section 19 of the Designs Act, 2000, the

registration of the plaintiff is required to be cancelled. Thus the defendants opposed the notice of motion.

7 The said notice of motion was heard by the learned single Judge. The learned single Judge allowed the notice of motion in terms of prayer clauses (a), (b) and (c) and also directed the court Receiver to make an inventory of the invented goods in the defendants premises and issued direction to sell them.

 The learned single Judge considered the claim of the plaintiff and also the Say of the defendants, as set out in the reply to the notice of motion and then made reference to the relevant provisions in the Designs Act, 2000. The learned single Judge recorded a finding that no doubt the design has been applied to the copper tubes manufactured by the plaintiff and the learned single Judge also took a note of the fact that plaintiff's sale was in excess of Rs. 4.33 crores and took into account the statement of sale and expenses for the period of 2014-2015. As regards the question of similarity,

the learned single Judge concluded that there was no “difference”, though in the affidavit in the Notice of Motion, the defendants had claimed that the curvature of the bell-ending in the plaintiff's product is of 90 degrees; whereas in the case of the defendants' product is at 45 degrees. The learned single Judge was of the opinion that the distinction is without difference. The learned single Judge was not impressed by the minute distinction and did not take into consideration the defences raised in the suit about the invoices placed on record by the plaintiff, which were attempted to be falsified by the defendants by filing the affidavit from the company, who had issued the invoices that they are forged and are not invoices in reality. The learned single Judge also took note of the fact that the defendants had connection with the plaintiff and in fact defendant nos. 2 and 3 worked for the plaintiff after registration of the plaintiff's design in the suit, and the defendant no. 1 was in fact the Production Manager of the plaintiff and defendant no.3 was In-charge of the marketing. On the basis of the entire discussion, the learned single Judge

recorded a finding that prima faice, it appears that the defendants had done nothing but pirated the plaintiff's design. As regards the question of passing off, the learned single Judge noted that by the time the plaintiff's claimed to have entered the market their sales was in excess of Rs. 4.31 crores.

The learned single Judge had an opportunity to have a look at the samples of the two products placed before him and recorded a finding that he was not able to notice any difference nor was able to identify as to which product belong to whom. He proceeds to record a finding that applying the ultimate test, the court looking at the rival products is of the opinion that for the purposes of design, infringement and passing off was sufficient. As regards the defence of functionality to the design, the learned single Judge rejected it outright. Since the plaintiff had claimed no exclusivity in any functional element and it was observed by the learned single Judge that only exclusivity claimed is in the

capriciousness or whimsicality of design, which made the design both novel and original. Further the learned single Judge also concluded that there was no material to show prior publication or lack of novelty. In these circumstances, the learned single Judge was impressed by the fact that there is an undeniable novelty and originality to the plaintiff's design and, since no functionality was demonstrated by either side, nor the plaintiff claimed any rights to any functionality and in absence of defendants, being unable to show any use by them or anybody else prior to the plaintiff, the plaintiff was found to have made a prima facie case. The learned single Judge found the balance of convenience in favour of the plaintiff and expressed that an irreparable prejudice would be caused if the injunction is refused. In these circumstances, by the impugned order dated 06.12.2016, the learned single Judge was pleased to allow the notice of motion and made it absolute.

8 It is this order, which is impugned in the present appeal.

9 The question that falls for our consideration in the present appeal is whether the order passed by the learned single Judge can be sustained within the framework of the Designs Act, 2000 and whether the finding recorded by the learned single Judge, holding a prima facie case in favour of the plaintiff and allowing the notice of motion, can be faulted with.

10 It would be appropriate to refer to certain provisions of the Designs Act, 2000. The Designs Act, 2000 is an act to consolidate and amend the law relating to protection of designs. The said Act defines the term “design” in section 2 clause (d) as under :

“S.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 the Copyright Act, 1957 (14 of 1957);

Another important definition or connotation under the Act is find in section 2(g) which defines the term “Original”. As under :

S.2(g) “original”, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;

The Chapter-II of the said Act contains the provision of Registration of designs and confers authority on the Controller General of Patents, Designs and Trademarks. Section 4 prohibits registration of certain designs 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

On registration of the design by the Controller of Designs, the registered Proprietor of the design is entitled to have a copyright in the design during 10 years from the date of the registration in terms of section 11 of the Designs Act. Section 19 of the Designs Act, 2000 provides for cancellation of the registration and it reads as under :

“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) 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.

Another important provision in the enactment which relates to the legal proceedings is contained in Chapter V of the Act

and sub-section (3) of section 22 needs a reproduction below which :

“22.(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.”

11 We have to examine the present case in the light of the aforesaid scheme of the Designs Act, 2000. The defendant in present Appeal (original plaintiff) has obtained registration in respect of design which according to him is an unique, novel and original for its tubes. According to the him the uniqueness and novelty in its design for copper tubes lies in one end of the tube possessing an expanded bell-shaped ending. The plaintiff did not rely on the functionality of the designs but according to the plaintiff the said shape was conceived since it was aesthetically pleasing to the eye. It is with this design, the plaintiff approached the Controller of Designs and obtained its trade- mark and obtained a

certification of registration on 17.9.2009. The design has been registered in view of its novelty in its shape and configuration and particularly in the portion marked as “a” and ”b” so depicted in the “representation sheet”. The plaintiff did not make any claim in respect of the description, importance of words “trade-marks, colour or colour combination or numerical” appearing for the design. The plaintiff harps on the shape and configuration of the copper tubes and specially expanded bell-shape like ending it at one end of the tube.

Perusal of the definition of “design” in the enactment, admits the “design” of the plaintiff in the copper tubes since under the Designs Act, 2000, the term “design” means the features of shape, configuration, pattern, by any industrial process or means, whether manual, mechanical or chemical, separate or combined in the finished article and or one which appeal to and are judged solely by the eye.

12 The learned counsel for the appellants Mr. Rashmin Khandekar, who prayed for setting aside of the order passed by the learned single Judge, would argue that the registration under the Designs Act, 2000 is not conclusive. He would also argue that by virtue of provisions contained under section 22(3) of the Designs Act, the defendants could plead every ground available under section 19, as a ground of defence in a suit or proceedings for relief. According to the learned counsel, the appellants had already approached the Competent Authority for cancellation of the registration granted in favour of the plaintiff. The learned counsel for the appellants would vehemently argue that the defences taken in response to the suit of the plaintiff are premised on section 19 which pertains to cancellation of the registration and any person interested may present the petition for cancellation of the registration of design at any time after its registration, to the Controller on the grounds mentioned in section 19 and each of the grounds from (a) to (c), according to the learned counsel, are independent and separate defences available to

the defendants. Shri Khandekar would argue that the appellants have raised all the defences and he specifically pressed the defence under section 19(1)(e), namely that the design of the plaintiff is not a design as defined under clause (d) of section 2 and according to him the design which is being sought to be enforced by the plaintiff would grossly fail to stand the test of section 2(d). According to Shri Khandekar, essential ingredients of the design would feature shape, configuration, pattern etc., which would appeal to and are judged solely by the eye. According to the learned counsel this would exclude any mode or principle of construction or anything which is in substance a mere mechanical device. Shri Khandekar would argue that the requirement of visual appeal, which has to be solely judged by the ocular test and according to him if there is no visual appeal, the enquiry ends there. He also laid emphasis on the principle that a visual appeal is required to be judged by the court, keeping in mind the customer of the article, who puts the design to use. According to him, the design of the plaintiff namely, copper

pipes lack visual appeal of whatsoever nature. He would argue that it is even more apparent when one considers the customer of the pipes in question being manufactures of air conditioner, namely, electrical or/and plumbing, which would not consider anything distinctive whatsoever about the said pipe, as being distinctive or having a visual appeal. He would argue that the design claimed by the plaintiff is not something which is significantly distinguishable from known designs since it is a pipe which is to be used in air-conditioning, medical gas pipelines system and indoor plumbing useful in transmitting air, electricity etc.. According to the learned counsel to depict other defences available under section 19, namely prior publication and lack of novelty, the appellant had sufficient material. Further, the counsel for the appellant concedes that unfortunately the said material was not placed before the trial court. However, he was armed with the material which would demonstrate that the design of the plaintiff is hit by the case of prior publication and lack of novelty/originality and the plaintiff had suppressed the prior

publication on its own accord as back as in November / December, 2008. The learned counsel would argue that the material sought to be relied upon, ought to be allowed under Order 41, Rule 27 of the CPC, since this is a case of infringement and passing off and public interest is at stake. He placed reliance on the judgment in the case of **APL Apollo Tubes Ltd. vs. Surya Roshni Limited**, reported in 2011 (5) Bom. C.R 456. He also placed reliance on the judgment in the case of **AMP Incorporated vs. Utilux Proprietary Ltd.**, reported in 1972 (5) R.P.C. 103 (judgment of House of Lords). Reliance is also placed on the judgment in the case of **Maya Appliances Pvt. Ltd., Chennai & Ors. vs. Butterfly Gandhimathi Appliances Ltd.**, (Madras High Court), reported in MIPR 2017 (1) 0373 and the case of **Carlsberg Breweries vs. Som Distilleries and Breweries Ltd.**, delivered by the Delhi High Court in I.A.No. 10972/2015 in CS (OS) No.1485/2015.

13 Per contra, the learned counsel for the respondents Shri Rohan Kadam, who has supported the order passed by the learned single Judge, emphasized on the object of the Designs Act, 2000 and he would argue that the purpose of the Act is to protect the intellectual property right of the original design for a period of 10 years and to benefit a person for his research and labour put in by him to evolve a new and original design. According to Shri Kadam his clients were already engaged in manufacturing of copper tubes for diverse and varied applications including household air conditioning, medical gas pipelines and indoor plumbing etc.. According to Shri Kadam, the plaintiff conceived of a unique, novel and original shape and configuration for its tubes and the uniqueness and novelty in its design lied in one end of the tube possessing and expanded bell-shape like ending and this shape was conceived since it was thought to be aesthetically pleasing to the eye. According to Shri Kadam, since the design was original and new and not being available in the country, it had obtained a registration on the said design, which entail

the consequences of conferring a copy- right of the design on his client during 10 years from the date of the registration or for further extendable dates. According to Shri Kadam on such registration being obtained, he enjoyed the protection of his intellectual property right and his claim of exclusivity in the design of the copper tube and the use of the said design conceived by the plaintiff, by the defendants is an infringement of his right by reproducing the same design and manufacturing the tubes, which were deceptively similar to that of the plaintiff and marketing the same, resulted in passing them off as defendants' product. Shri Kadam would argue that once the design has been registered, it is deemed to be an original design, which has not been disclosed to the public any where in India or in any other country by publication in tangible form or by using any way prior to the date of the application for registration. According to Shri Kadam the burden to show that the design was not original or was not new, was on the defendants and it is to be

discharged by demonstrating that the plaintiff was not entitled for registration under the Designs Act, 2000.

14 Learned counsel Shri Kadam has also invited our attention to the material placed on record in relation to the design applied by the respondent no.1- Kalpesh R. Jain, who was employed by the plaintiff in the past to transport its goods by a lorry and according to Shri Kadam, in view of this relationship, he had ample access to the manufacturing work of the plaintiff and was provided with the modes and methods while applying to the registration of his product. Shri Kadam in support of his arguments relied upon following four judgments i.e. :

- i. *2012 (5) Maharashtra Law Journal 548: Asian Rubber Industries, New Delhi vs. Jasco Rubbers Calicut and Anr.*
- ii. *(2008) 10 Supreme Court Cases 657 : Bharat Glass Tube Ltd., vs. Gopal Glass Works Ltd.,*
- iii. *2014 SCC Online Bom 565 : (2014) 5 AIR Bom R.396 : Whirlpool of India Ltd., vs. Videocon Industries Ltd.*
- iv. *(2004) 10 Supreme Court Cases 598 :*

Ram Bali vs. State of Uttar Pradesh.

15 We have perused the material placed on record by the appellants and the respondent (original plaintiff) and also the impugned judgment delivered by the learned single Judge. The appellants have placed on record the design on which the plaintiff / present respondent has obtained registration and has also annexed the pictures of the plaintiff's self connect tubes, upon which the registration was granted. The appellant has also placed on record his own product and images of the product and side-by-side comparison of the Respondent's product. We also had an opportunity of having glimpse of the product of the appellants and the respondent/original plaintiff. The learned single judge has rightly observed that when both these two products were placed before him, he was not able to spot any difference with his naked eyes and an attempt on our part also resulted into the same conclusion, namely, we could not find any material difference in the two products. Though the learned Advocate Shri Kadam for the respondent /

plaintiff insisted upon the uniqueness in its design and its novel shape and emphasized that the tubes of his client has expansion of 90 degree; whereas that of the appellants/defendants which was edged 45 degrees. Another distinction, according to Shri Kadam is the smoothness of the outer and inner surface of the expansion in the product of his client; whereas roughness of the inner and outer surface of the respondent tubes expansion. However, we are unable to spot such a difference and we could only observe that the product of the plaintiff has been reproduced by the defendants. The matter on the representation sheet presented by the appellant (original defendant), on which registration has been obtained, reveals that novelty to the design resides in the shape and configuration of the metal tube of airs and this distinction is represented in the front rear top side perspective view of the product of the appellant. The design the original plaintiff posed, on which the registration has been granted is in the form i.e. in the shape and configuration of the metal tube particularly in the portions marked as 'a' and 'b' in the

representation sheets and the portion 'b' is a expanded bell-shape and it is this design on which the registration has been granted. We are conscious of the fact that the defendants in the defence have posed a challenge to the registration of the design of the plaintiff, which they are permitted to do by virtue of section 22 (3) of the Designs Act, 2000 and the defendants by way of defence have taken a ground that the design of the plaintiff is not a design as defined under clause (d) of section 2, as it lacks appeal to the eye and cannot be so recognized. Whether the design of the original plaintiff is lacking in novelty or originality is not to be judged at this stage since the appellant had not produced any material before the learned trial Judge so as to enable the trial Judge to appreciate the said contention. The original plaintiff in suit had not put a case, claiming exclusivity of the functional element in the design and the only exclusivity claimed by the plaintiff is in the capriciousness or whimsicality of design and it is the claim of the plaintiff that it is this element in the design which makes it both novel and original. Here it is an attempt on behalf of

the appellants to canvass that the features which are to be found in the finished article must appeal and or judged solely by the eye in order to satisfy that it falls within the definition of design and the visual appeal by an eye is the eye of the customer. Since the pipes are to be used inside the air-conditioning, the appearance of the article must be relevant factor and the test is not to be applied by taking into consideration the eye of the person, who is going to put and use those tubes/pipes, which are to be put in the air-conditioners and the choice must be only because of the shape / configuration. It may be because of the fact that they would more fruitfully serve the purpose and they would be more functional.

16 The claim of the original plaintiff in the suit is about the uniqueness of its design applied to copper tubes and the registration was granted on this design. The protection which the plaintiff had claimed in the suit was the protection of his new or original design with reference to the copper

tubes to which it was applied. The concept of design is that a particular figure / shape conceived by its designer, in his mind and it is reproduced in some identifiable manner and is sought to be applied to an article. Whenever any registration is sought for, a configuration has to be chosen for registration to be reproduced in any article. The original plaintiff had approached the court, seeking injunction and sought protection of his design applied to copper tubes. It is not the case of the plaintiff that the copper tubes were in existence earlier or were put to the use the way they are being put to use including its use in air- conditioner but the plaintiff came up with a design which he claimed to be a new and original and as per the plaintiff, it was already manufacturing the copper tubes with varied applications for a considerable long time but in the year 2009 it conceived of a unique, novel shape, configuration for its tubes and applied this uniqueness and novelty on copper tubes and this uniqueness lied in the expanded bell-shaped ending to the copper tube. It is this idea applied to the copper tubes which was registered and the

plaintiff sought its protection. As the Hon'ble Apex Court has observed in case of **Bharat Glass Tube Ltd., vs. Gopal Glass Works Ltd.**, reported in 2008 (10) Supreme Court Cases 657 in paragraphs 36 and 37 in the following words :

“36. Similarly our attention was also invited to para 27.07 of the law of Copyright and Industrial Designs by P. Narayanan (Fourth Edition) which reads as under :

27.07. Design as a conception or idea "Design means a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied to an article by some manual, mechanical or chemical means mentioned in the definition clause. It is a suggestion of form or ornament to be applied to a physical body". It is a conception, suggestion or idea, and not an article, which is the thing capable of being registered. It may according to the definition clause, be applicable to any article whether for the pattern or for the shape or configuration or for the ornament thereof (that is to say of the article) or for any two or more of such purposes. The design, therefore, is not the article, but is the conception, suggestion, or idea of a shape, picture, device or arrangement which is to be applied to the article, by some one of the means to be applied to a physical body.

A design capable of registration cannot consist of a mere conception of the features mentioned in the definition, or in the case of an article in three dimensions, of a representation of such features in two

dimensions It must, in such a case, in order to comply with the definition, consist of the features as they appear in the article to which they have been applied by some industrial process or means. An applicant for registration of a design has to produce a pictorial illustration of the idea or suggestion which he has to establish as new or original;"

Therefore, the concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. therefore, whenever registration is required then those configuration has to be chosen for registration to be reproduced in any article. The idea is that the design has to be registered which is sought to be reproduced on any article. therefore, both the things are required to go together, i.e. the design and the design which is to be applied to an article."

"37 In the present case, the design has been reproduced in the article like glass which is registered. This could have been registered with rexin or leather. therefore, for registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied. As in the present case the design sought to be reproduced on a glass-sheet has been registered and there is no evidence to show that this design was registered earlier to be reproduced on glass in India or any other part of the country or in Germany or even for that matter in United Kingdom, therefore, it is for the first time registered in India which is new and original design which is to be reproduced on glass sheet. therefore, the submission of learned senior counsel for the appellant, Mr. Gupta cannot be accepted that this design was not new and original."

17 Though the appellants before us would vehemently argue that the design conceived by the original plaintiff of which the registration was granted to him, was not novel and original, the learned single Judge has rightly observed that no material was brought by the defendants on record showing any prior publication or lack of novelty. The defendant had sought to raise the defences permissible under section 19 of the Designs Act, alleging that the design is not new or original and it was not entitled to be registered. It is to be noted that the plaintiff is not claiming to be an inventor of the copper tubes with multiple use but he is claiming exclusivity in the capriciousness or whimsicality of the design. Even the defendant, who is in the process of manufacturing of the copper tubes, has applied the design to the tubes and obtained registration by claiming it to be exclusively his. It is not in dispute that the plaintiff's had obtained registration of his design on 04.10.2010 and since then he is applying the design to the copper tubes manufactured by it. The

contention of the present appellants is that the plaintiff could not have claimed any exclusivity in the design. That is not sustainable in view of the fact that appellant himself also applied a shape and configuration to the copper tubes and has obtained registration, which is subsequent in point of time to that of the plaintiff. It is the plaintiff, who had approached the Civil Court by filing a suit, claiming protection of his design since according to the plaintiff, it was the defendant, who was a part and parcel of the plaintiff, has applied its design to its product i.e. the copper tubes and has claimed that it amounted to an infringement and passing off the plaintiff's registered design as applied to the copper tubes.

We are not able to accept the contention raised by the present appellants that there was no uniqueness in the design of the plaintiff and he had taken defences available to him while responding to the said suit filed by the plaintiff and claimed that the design is not a design as defined under clause (d) of Section 2 nor it is a new or original design. The learned

single Judge has rightly observed that no material has been brought on record by the plaintiff to that effect and though the appellant has filed an application under Order 41, Rule 27 of C.P.C., bringing additional material on record, the said material can be looked at the time of the decision of the suit and what is to be seen at the stage of the notice of motion, praying for stay, is a prima facie case being made out by the plaintiff and the learned single Judge being convinced that the prima facie case was made out and the balance of convenience is being in favour of the plaintiff, was perfectly justified in allowing the notice of motion, on the admitted premise of novelty and originality of the plaintiff's design and in the backdrop of the fact that the defendant was unable to show use of the said product by any one else prior to the plaintiff, we do not find any infirmity or illegality in the impugned judgment and order passed by the learned single Judge, allowing the notice of motion.

18 The learned counsel for the appellants placed heavy reliance on the judgment of House of Lords in the case of **AMP Incorporated**, cited supra, to demonstrate the functionality aspect of a design. He specifically relies upon the following paragraph at page 106 of the said judgment :

“In deciding whether features are “dictated solely by function” the word “features” does not merely mean “parts” but further includes the shapes of the parts. If there is any feature not necessary to perform the functions the design is valid since a designer has freedom of choice. The exclusion is a narrow one; Stenor v. Whitesides (1948) 65 R.P.C. 1: it applies only if there is in effect a monopoly of the function. In the design in suit there are a number of features which can be varied without there being failure to perform the function. The defendants should not be allowed to copy the design in suit when they can perform the function required without copying. The history of the legislation on registered designs shows that only the first Registered Designs Act (of 1842) was concerned merely with matters of ornament. Since 1843 the definition of “design” has extended beyond

“ornamental” designs and the courts have not been troubled with matters of “eye appeal”, nor was this matter an issue in Stenor v. Whitesides (supra). Enquiries into the motive or intention of the designer are equally undesirable and would cause great difficulty in practice. There is no justification for a conclusion that a new and original design for any article should be denied protection under the Act in circumstances when others are free to fulfil the market in the article without being forced to copy it, nor that others should in such a case be free to copy such a design with impunity.”.

We have noted the said judgment of the House of Lords but fail to understand as to how it supports the appellants. The House of Lords in fact recognized the principle that the registered design which consists of sketches of the terminal from different angles with the statement “the novelty resides in the shape or configuration of the article as shown in the representations” and it takes note of the definition of the word “design” and the House of Lords accepted the principle that the words “judged solely by the eye”, must be intended to

exclude cases where a customer might choose an article of that shape not because of its appearance but because, he thought that the shape made it more useful to him. However, the plaintiff in the suit has not claimed any functionality in his design, as we do not find that in designs of the bell-shape ending of the tube, the copper tubes which are used by the plaintiff in the air-conditioners or in any other electrical instruments, cannot serve its purpose but it is the aesthetic sense of the design, which the plaintiff has admitted that he has conceived.

19 The Judgment relied on behalf of the Appellants by Advocate Shri Khandekar in the case of **APL Apollo Tubes Ltd.**, cited supra, of the Delhi High Court, is distinguishable on facts since the defendant therein, in the written statement, had averred that the impugned design's registrations have been obtained by the plaintiff in respect of pre-published designs and the defence was premised on the existence of prior art in respect of the designs in question. It was also the

defence put-forth that identical frames were easily available in the wooden form / shape and on account of the scarcity of the wood, innovations were done to replace the wood with concrete and metal for manufacturing of door frames and the defendant had set out the details of the manufacturers / dealers, who have been operating since 1962 and are dealing in hollow metal door frames. Thus the defence was based on the material placed before the court and use of the design of the plaintiff was prior in point of time and, therefore, the whole judgment proceeds on granting relief on the premise that the defendant had sufficiently established that the design of the plaintiff was not original but was infested by existence of the prior art.

In any case, the present appellants have sufficient opportunity to demonstrate during the course of the proceedings in the suit and demolish the case of the plaintiff by rendering sufficient evidence before the court to demonstrate his defence that the plaintiff's registration of design is liable to be cancelled on account of the grounds available under

section 19 of the Designs Act and apparently establishing that the design is not new or original and/or that it is not the design as defined under section (d) of section 2 of the Act. At present, we are called upon only to examine the order/judgment passed by the learned single Judge on 06.12.2016 in the notice of motion and the learned single Judge, after taking into consideration the prima facie case and after recording the conduct of the defendants, in not producing any material to demonstrate that the plaintiff's design lacked novelty, arrived at a conclusion that the defendants had done nothing but pirated the plaintiff's design and as regards passing off also, the learned single Judge has recorded that by the time the defendant claims to have entered the market, the sale of the plaintiff was already in excess of Rs. 4.31 corers. In such circumstances, considering the fact that the judgment delivered by the learned single Judge is on a Notice of Motion and since all the parameters for grant of injunction in favour of the plaintiff were satisfied by the plaintiff in the suit, no fault can be found with the order/ judgment passed by

the learned single Judge. We are not convinced by the arguments advanced by Shri Khandekar to disturb the said findings at the stage of Notice of Motion. More so, considering the fact that the plaintiff was first in point of time to obtain the registration and the defendants had started manufacturing the said pipes/tubes, on their own showing, subsequent to that of the plaintiff.

Reliance placed by Shri Kadam on the judgment of this court in the case of **Whirlpool of India**, cited supra, is aptly applicable to the case in hand, where the learned single Judge rejected the contention of the defendant in regard to the lack of novelty. The Hon'ble learned single Judge of this court (Coram : S.J. Kathawalla, J.) in paragraph 42 of the judgment observed thus :

“42. As held by the Hon'ble Division Bench of this Court (Coram : Mohit Shah, C.J. & Jamdar, J) in Asian Rubber Industries Ltd., Vs. Jasco Rubber, a Defendant who claims that its design has novelty cannot then contend that prior identical design of another is lacking in novelty. The Defendant

therefore, can hardly be heard to urge a lack of novelty in the Plaintiffs design since the Defendant themselves claim to be registered proprietors of the design. An attempt is made by the Defendants to distinguish the said decision by submitting that in that case the Defendant had procured design registration in relation to footwear under the Act, which was subsequently cancelled by the Assistant Controller of Patents and Designs and in the alternative by also contending that the decision is per incurium as it failed to take into account the statutory provisions i.e. section 22(3) read with Section 19 of the Act. In my view, both the submissions are untenable and cannot be accepted."

We have noted the fact that the defendant himself has obtained registration of his design in form "tubes for air" on 01.09.2014 and he claims exclusivity in the said design. In fact, when the design of the appellant is registered, copper tubes were already in vogue and being put to use and still he was able to obtain an registration of his design, which according to him, is novel. The appellant alleges that the plaintiff's design is not entitled to be registered since there was a prior work in existence. If it is so, then the defendant's work was also not liable to be registered since definitely at that time the plaintiff's design was already registered,

circulated through various material in form of exhibition and was well-known to the public at large. It would be useful to refer to para nos. 17 and 18 of the judgment of the Division Bench of this High Court (Coram : Mohit S.Shah, C.J. & Ranjit More, J.) in the case of **Asian Rubber Industries, New Delhi, vs. Jasco Rubber, Calicut**, where the court observed in the said paragraphs as under :

“17. What is important to note is that the defendants themselves sought registration of their “look and feel” in Padukas and therefore it is not open for the defendants to say that the plaintiff cannot claim exclusivity. The defendants themselves procured design registration in relation to footwear under design Registration No. 223556 in June, 2009, which was subsequently cancelled by the Assistant Controller of Patents and Designs on 20th December, 2011. In these circumstances it cannot lie in the mouth of defendants to contend that the plaintiff's design is not new or original or there is no novelty. We also find merit in the plaintiff's contention that there is no footwear in the market having unique features of stud and strap like that of plaintiff. So far as the plaintiff's designs are concerned, novelty lies in the shape, configuration and pattern of the footwear and there is no product in the market having similar design.”

“18. From the documents annexed to the plaint and to the notice of motion, it is abundantly clear that the plaintiff is in continuous business since 2000. The plaintiff has widely advertised its product and the same are widely available. This fact is corroborated by the annual turnover of their products given by the plaintiff. The conduct of the defendants is also worth taking note of. In June 2009, the plaintiff having become aware about the defendants' infringing footwear, issued caution notice. Thereafter, the infringing goods disappeared from the market. However, after grant of design registration in their favour, the defendants' infringing goods flooded the market and the same again disappeared after plaintiff filed proceedings for cancellation of design registration of the defendants.”

20 In the result, we refuse to interfere with the order/
judgment passed by the learned single Judge dated
06.12.2016 in Notice of Motion No. 2195 of 2016 in Suit No.
742 of 2016. Resultantly, the present Appeal is dismissed. No
order as to cost.

(SMT.BHARATI H.DANGRE,J.) (S.C.DHARMADHIKARI,J.)

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