

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 13.02.2018

Delivered on : 01.03.2018

CORAM

THE HON'BLE MR.JUSTICE M.SUNDAR**Original Application Nos.31 and 32 of 2018**
in
C.S.No.26 of 2018

Preethi Kitchen Appliances Pvt. Ltd.,
 Having its registered office at
 C/o.Boomerang Unit No.506
 5th Floor, Wing B-2, Chandivali Farm Road
 Powai, Mumbai- 400 072 .. Applicant/Plaintiff

Vs.

1.Baghyaa Home Appliances
 Electronics & Furnitures
 Hameeda Shopping Mall
 #108 & 109 Triplicane High Road
 Near Post Office, Chennai – 600 005

2.M/s.Maya Appliances Private Limited
 No.10/5, Royal Enclave
 Besant Avenue, Adyar
 Chenani – 600 020 .. Respondents/Defendants

Application filed under Order XIV Rule 8 Original Side Rules read with Order XXXIX Rules 1 and 2 of Code of Civil Procedure to grant an order of ad interim injunction restraining the respondents/defendants, their men, agents, or person acting on their behalf, from in any manner infringing the Applicant/plaintiff's copyright in design No.276216 granted on 01.10.2015 in respect of its tripod shaped base unit for its 'Preethi Zodiac' series of mixer grinders under the name Vidiem V-Star series or under any other name with features identical or any manner similar to the applicant/plaintiff's tripod shaped base unit design for mixer grinder pending disposal of the suit.

For Applicant : Mr.M.S.Bharath

For 1st Respondent : Mr.Sudhir Ravindran

For 2nd Respondent : Mr.P.S.Raman,
Senior Advocate
Mr.K.Harishankar

COMMON ORDER

This common order will dispose of both these applications.

2.Sole plaintiff in the main suit is the lone applicant in both these applications. Defendant Nos.1 and 2 in the main suit are respondent Nos.1 and 2 respectively in both these applications. Parties in these applications are referred to by their respective ranks in the main suit for the sake of convenience and clarity.

3.A thumb nail sketch of facts essential for appreciating the instant common order is set out infra under the caption 'Factual matrix in a nutshell'.

4. FACTUAL MATRIX IN A NUTSHELL

4(i) Plaintiff and Defendant No.2 inter alia manufacture, market and distribute kitchen appliances. To be noted, Defendant No.1 is a dealer of defendant No.2. Considering the nature of the lis i.e., complaint of infringement of a registered design, Defendant No.1 is, for all practical purposes, a formal party. It follows that plaintiff and Defendant No.2 are real adversaries in this lis.

4(ii) Plaintiff and the second defendant can be described as 'siblings in industry or cousins in commerce' as they have an umbilical chord relationship. 'Preethi' was part of Defendant No.2 from 1978. More than three decades later, sometime in 2011, Koninklijke Philips, Netherlands acquired Preethi from Defendant No.2. Plaintiff company, i.e., Preethi Kitchen Appliances Pvt. Ltd., was incorporated as a company in India under the Companies Act, 1956 in 2011 and aforesaid Koninklijke Philips, Netherlands, is the parent / holding company. In other words, plaintiff company is a subsidiary of Koninklijke Philips, Netherlands.

4(iii) I am also informed that the entire acquisition referred to supra in 2011 is a slump sale. It is in the aforesaid context that I ventured to describe the adversaries as 'siblings in industry or cousins in commerce'. This much about the relationship between the adversaries.

4(iv) Moving on to the lis, plaintiff has come with the main suit complaining of infringement of its registered design in respect of tripod shaped base unit for mixer grinder and passing off. Nucleus of this lis is a registered design of the plaintiff company bearing registered Design No.276216 dated 01.10.2015 in class 31-00 with the title 'Base unit of a Mixer Grinder'. This registered design of the plaintiff company is in force for 10 years i.e., upto 01.10.2025. This registered design of the plaintiff company is hereinafter referred to as 'suit design' for the sake of brevity, convenience and clarity.

4(v) It is the case of the plaintiff that in March 2016, plaintiff launched the zodiac series of mixer grinders in the market in the name and style 'Preethi Zodiac', 'Preethi Taurus' and 'Preethi Aries' with the base unit based on the suit design. It is also the specific case of the plaintiff that conventional mixer grinder consists of rectangular, round, oval and square shaped base units and the plaintiff's launch of a mixer grinder with a tripod base unit based on the suit design was path breaking. It is the specific case of plaintiff that sometime in December 2017, it gained knowledge about the fact that the second defendant has been manufacturing and selling mixer grinder under the name and style of 'Vidiem V-Star series' with base units, which according to the plaintiff, are an obvious imitation/infringement of suit design. It is also averred by the plaintiff that second defendant has got a design registered vide Design No.292910 dated 17.04.2017. It is to be noted that the second defendant entered appearance and took the stand that design registration of second defendant is dated 17.04.2017, is in force upto 17.04.2027 and that the Vidiem V-Star series launched by them is pursuant to such design registration of the second defendant.

4(vi) Second defendant contended that their Vidiem V-Star products are not obvious imitation/infringement of suit design, but are products based on their aforesaid registered design.

4(vii) It was also contended that a comparison of suit design and second defendant's product would reveal that there is no imitation, much less obvious imitation or piracy. Defendants also alleged that there is no

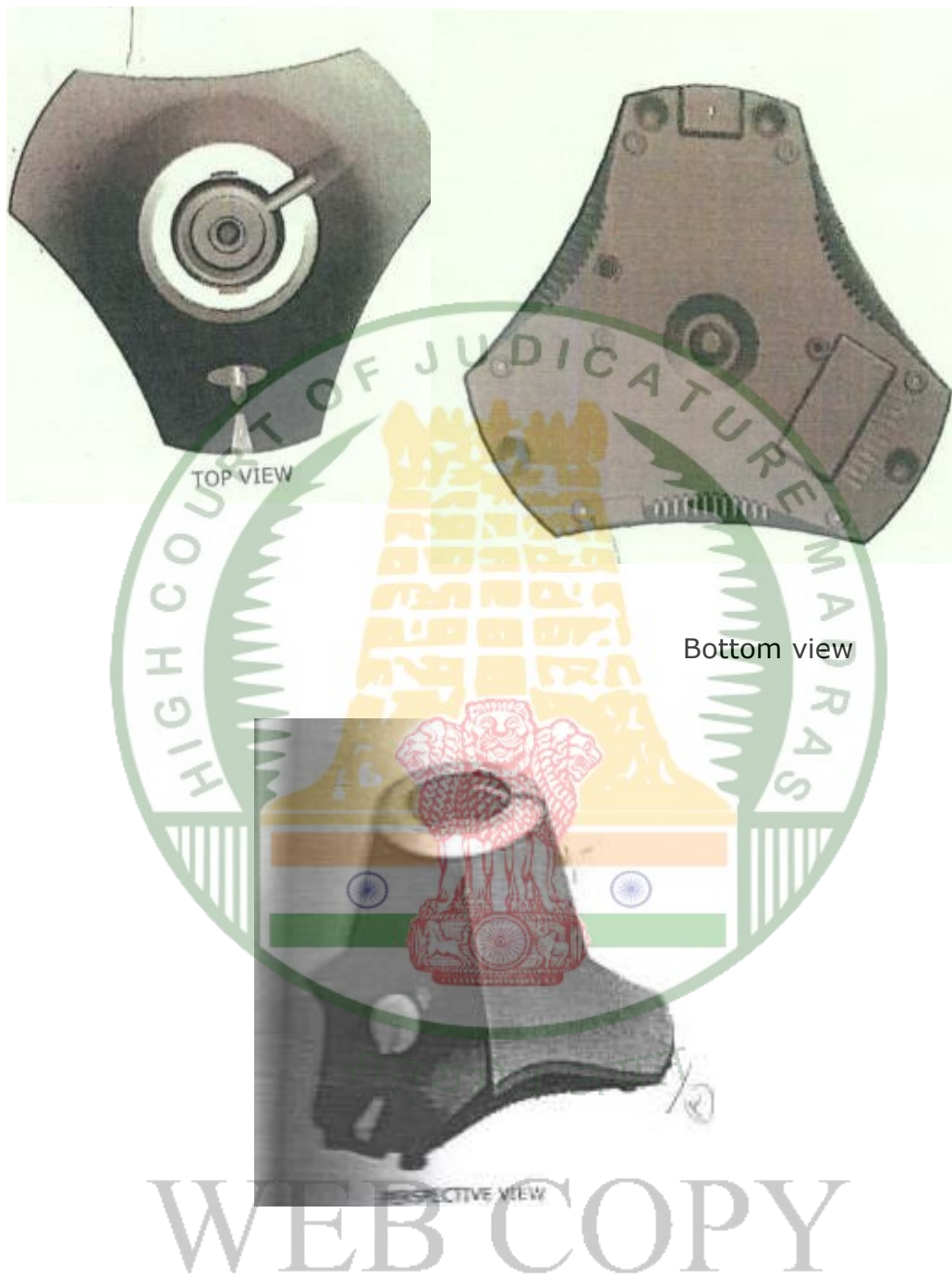
novelty in the suit design and that the registration of suit design ought not to have been granted. In other words, second defendant is also assailing the registration of the suit design.

The above is factual matrix in a nutshell and in the light of the same, I now proceed to discuss the lis under the caption 'discussion' infra.

5. Discussion

5(i) It is necessary for a meaningful discussion to understand with clarity what exactly is the suit design. For this purpose, I examined the plaintiff's design Registration Certificate. Plaintiff's design registration is in respect of 'shape' and 'configuration'. The suit design (registration certificate) consists of 6 views and one perspective view, which are as follows:





5(ii) I wanted to see the products of the plaintiff based on suit design. To be noted, the products are base units of a mixer grinder. The products were placed before me in the course of hearing. Two such products were marked as A-MO1 and A-MO2, by consent of both sides.

5(iii) I also noticed from the suit design that it is not restricted to any colour or combination of colours and does not confer any exclusive use of a colour or combination of colours. The electrical wire i.e, chord seen in the pictorial representations are not part of the registration of the design and there can be no claim over the same. A design is defined under Section 2(d) of the Designs Act, 2000 (Act No.16 of 2000) and from the definition of design it emerges clearly that there can be a design in six different aspects and they are follows:

- a) Shape
- b) Configuration
- c) Pattern
- d) Ornament
- e) Composition of lines and
- f) Colours applied to any articles.

5(iv) Though there are six aspects in which there can be a design registration, the suit design is with regard to shape and configuration as mentioned supra. To be noted, the terms 'shape' and 'configuration' are not defined in the Act and are not words of art. Therefore, with regard to shape and configuration, one has to necessarily turn to the dictionary meaning. As set out supra under the caption 'Factual Matrix in a nutshell', the second defendant has taken a stand that it has got registration of a design vide design Registration No.292910 dated 17.04.2017 and that their product Vidiem series is not an imitation/infringement or piracy qua suit design.

5(v) From the submissions made on either side, which have been set out partly under Factual Matrix and partly under Discussion supra, for the purpose of having focus qua deciding these applications, I deem it appropriate to make a enumeration of the questions that the rival stands bring up in these applications. They are as follows:

- I. Whether registration of suit design is valid or whether it deserves to be cancelled inter alia for lack of novelty?
- II. Whether registration of design obtained by second defendant will protect the second defendant in this design infringement action?
- III. Whether a comparison be made to come to a conclusion regarding whether or not there is imitation / piracy on the part of the second defendant?
- IV. Whether the second defendant is guilty of infringement/piracy of suit design.

5(vi) From the narration of the questions that fall for consideration in these applications, it requires no explanation to say that answers to these questions I and II will decide whether the remaining questions need to be gone into at all.

5(vii) With regard to the first question regarding validity of the suit design, Mr.M.S.Bharath, counsel on record for plaintiff, Mr.Sudhir Ravindran, counsel on record for first defendant and Mr.P.S.Raman, learned senior counsel leading Mr.T.K.Bhskar, counsel on record for

second defendant, submitted in unison before me that question regarding validity of the suit design and the plea that the suit design deserves to be cancelled can be left open for decision in the main suit. This puts an end to Question No.I. In other words, Question No.I is left open, by consent of all the learned counsel before me, for being tested in the main suit post trial.

5(viii) Though the aforesaid stand taken by all counsel in unison puts an end to the search for an answer to Question No.I, I deem it appropriate to record how it unfurls.

5(ix) In a suit for action complaining of infringement of registered design, a defendant has the statutory right to take the plea that the plaintiff's registration itself is invalid. The grounds on which a person can assail the registration of a design are enumerated under Section 19 of Designs Act, 2000 (hereinafter referred to as 'said Act' for brevity). By virtue of Section 22(3) of the said Act, right is conferred on defendant(s) in design infringement action to assail the design registration of the plaintiff on the grounds set out in Section 19 of the said Act. This is unlike the other Statutes in the IPR regime with the exception of Patents Act. In other words, such a course is not available to defendants in an action complaining of infringement of Trademarks, Copyrights or Geographical indications. To be noted, it is not available for defendants in an action for infringement of Trademark, copyright or geographical

indication. A controversy was raised by saying that this statutory option given to a defendant in a design infringement action is available only to a defendant, who has sought cancellation of plaintiff's design. However, it is not necessary to go into that aspect of the matter in this order disposing of these applications in the light of the common stand taken by all the counsel before me. For the purpose of abundant clarity, it is made clear that the issue of validity of suit design and as to whether the suit design deserves to be cancelled including the question as to whether it is open to the defendant to raise such a plea, without actually filing for cancellation, are all left open to be decided in the main suit. Further to be noted, this is by consent of all the counsel before me. This takes us to the next question.

5(x) With regard to the second question, this very question came up before the Delhi High Court. One learned Judge of the Delhi High Court had made a reference and pursuant to a reference, a Full Bench (including the Judge who made the reference) was constituted. Full Bench of the Delhi High Court by a 2:1 majority vide its judgment dated 15.05.2013 and what is now come to be known as Micolube case (***Micolube India Limited Vs. Rakesh Kumar Trading as Saurabh Industries and Ors. Reported in MIPR 2013 (2) 156***), answered the reference saying that holder of a registered design can institute a suit against a defendant who is also in possession of a registered design. The Full Bench of the Delhi High Court held so in the Micolube case by placing reliance on the

expression 'any person' occurring in Section 22 of the said Act. Full Bench took the view expression 'any person' occurring in the said Act would not exclude a subsequent registrant.

5(xi) In my considered view, in this case, the plaintiff is in a much better pedestal for the simple reason that the plaintiff is not a subsequent registrant, but a prior registrant. As would be evident from the 'Factual Matrix' supra and the 'Discussion' thus far, the plaintiff's registration is dated 01.10.2015 and the second defendant's registration was 1 ½ years later on 17.04.2017.

5(xii) To buttress and highlight that the issue of one registrant suing another registrant with regard to design infringement, it was submitted that it has not just been answered but has also been put in practice, as there have been several cases where injunction has been granted against a registered design holder in an action for infringement of design. In support of this proposition, three reported judgments and one unreported judgment were placed before me. Reported judgments are ***Alert India Vs. Naveen Plastics*** reported in **1997 PTC (17) 15** where a learned single Judge of the Delhi High Court granted injunction against a defendant holding a registered design. Judgment in ***A.R.Safiullah Vs. A.Sowkath Ali*** reported in **2013 (54) PTC 499 (Mad)** was placed before me and this is a case where a single Judge of this Court granted injunction against holder of a registered design. ***Whirlpool of India Ltd., Vs. Videocom Industries Ltd.,*** is another case reported in **2014 (60) PTC 155 (Bom)** where a single Judge of the Bombay High Court

granted injunction against a registrant of a design. One more order of the Delhi High Court in **Vikas Jain Vs.Aftab Ahmed** case where the Delhi High Court vide order dated 04.07.2007 had granted injunction against an entity which had design registration was also placed before me. In this order, which was authored by Hon'ble Justice Badar Durrez Ahmed.J., as his Lordship then was, the issue of defendant being a registrant and more so, the plaintiff being a prior registrant which is closer to the facts of this case was examined and articulated in Paragraph 13, which reads as follows:

"13.Furthermore, not much turns on the factum of the defendant being the registered proprietor of the design under the registration No.198624. Firstly, the registration of the plaintiff's design is prior in time. The plaintiff's design was registered on 23.03.2004, whereas the defendants' design was registered on 01.03.2005. The fact that the plaintiff's registration is prior in time to that of the defendants' would entitle the plaintiff to prevent its infringement by the defendants. In Alert India (supra), a learned single Judge of this Court held that a design registered later would not be entitled to protection against the first or prior registered proprietor of a design."

5(xiii)The above said simple but lucid articulation is closer to the facts of this case. No contra material was placed before me by the second defendant in this regard. Only aspect that was highlighted was that the aforesaid Full Bench judgement of the Delhi High Court in Micolube was a 2:1 majority. I also noticed one interesting feature in the micolube

judgment and I deem it appropriate to record the same here Hon'ble Judge, who made the reference was invited to be part of the Full Bench and that Hon'ble Judge did become part of the Full Bench is mentioned supra, but interestingly that Hon'ble Judge who made the reference wrote a separate dissenting judgment. I have perused that separate dissenting judgment also. There are two reasons why I would go with the majority view. One is notwithstanding it is a majority view, ultimately it becomes a judgment of a Full Bench. Another aspect is on facts, it does not appear to be a case where the plaintiff is a prior registrant unlike the instant case. All these leave me answering Question No.II by saying that a holder of a registered design can institute a suit against a defendant, who is also in possession of a registered design.

5(xiv) Answer to Questions I and II has now made it necessary to make a comparison and decide whether there is infringement as alleged. There is a very interesting principle that unfurls with regard to comparison in design infringement actions. Mr.M.S.Bharath, learned counsel for plaintiff, submitted that in a design infringement action, the design registration certificate of the plaintiff should be compared with the alleged offending product of the defendant. While not disagreeing with Mr.M.S.Bharath, Mr.P.S.Raman, learned senior counsel submitted that notwithstanding the position that if a comparison of the plaintiff's product and the alleged offending product of the second defendant are done, it will work to the disadvantage of the second defendant, in the instant case he would invite the Court to make such a comparison ie., comparison of the

plaintiff with the alleged offending design of the defendant notwithstanding the disadvantage that will be caused to the defendant.

5(xv) This makes my task simpler. The earliest case pertaining to comparison in a design infringement action is Dunlop company case (Dunlop Rubber Co. Ltd., Vs. Golf Ball Developmens Ltd., reported in 1931 XLVIII RPC 268). This is a judgment of the Chancery Division in England and Justice Farwell had authored the same. The product in the instant case is a Golf Ball. Decisions of foreign courts have only persuasive value. Notwithstanding this position, I am emboldened to look at Dunlop Company case for two reasons. One reason is the definition of design under the then UK Designs Act as contained in Section 93 of the UK Designs Act as well as the parameters for piracy as contained in Section 60 of the UK Designs Act are the same as the definition of design under Section 2(d) and piracy as contained in Section 22 of the Designs Act, 2000 in India are almost *in pari materia*. This is evident from two paragraphs in Dunlop Company case and these two paragraphs are as follows:

"Before I come to deal with the Designs themselves, I would just say one word or two with regard to the law on this matter, and for that purpose I must look at the Act. The first section of the Act to which I desire to refer is the definition Section, Section 93. In that Section the word "design" is defined in these terms: " 'Design' means only the feature of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the

finished article appeal to and are judged solely by the eye," I need not read the rest of that definition."

"I want to say one word with regard to Section 60. Section 60, so far as it is relevant for my purpose is in these terms: "During the existence of copyright in any design it shall not be lawful for any person (a) for the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied". There are three things there which a member of the public may not do with regard to a registered design. In the first place, he may not apply, to any article in the class of goods in which the design is registered the design itself. He may not, therefore, take the registered design and use it bodily for the purpose of an article of his own manufacture. That of course is not suggested in this case. "

5(xvi) The second reason for me to still look to Dunlop Company Case is, the principles culled out in Dunlop Company case has been consistently and continuously followed by the Indian Courts in a long line of authorities in J.N.Electricals (India) V. President Electricals of Delhi High Court reported in ILR (1980) 1 Delhi 215, Castrol India Ltd., V. Tide Water Oil Co.(I) Ltd., of Calcutta High Court reported in 1996 PTC (16) 202, Alert India Vs. Naveen Plastics of Delhi High Court reported in 1997 PTC (17) 15, Dabur V. Amit Jain of Delhi High Court reported in 2009 (39) PTC 104 and finally Darts Industries case of the Madras High Court was as late as in 2017 i.e., MIPR 2017(3) 0158.

5(xvii) To my mind, the manner in which the Hon'ble Judges who

authored these judgments starting from Dunlop Company case made comparison to decide a design infringement action is clear. A design registration certificate should be compared with the alleged offending product to decide a design infringement action. Eye of the Judge being the key appears to be the general drift. However, in the instant case, in the light of unanimity of view and consensual approach expressed by adversarial counsel that plaintiff's product can be compared with the defendant's product, I am not elaborating on this question of how a comparison should actually be made in a design infringement action further. This takes us to the last question i.e., question No.IV as to whether the second defendant is guilty of infringement / piracy of suit design.

5(xix) In the light of all that have been said regarding comparison in the instant design infringement action alluded to supra, I compared the plaintiff's products with the second defendant's products.

5(xx) To be noted, two of plaintiff's products were marked as two material objects on the plaintiff's side. Two of second defendant products were marked as two material objects on the second defendant's side. I have referred to material objects that have been marked in these applications. I have also set out supra that plaintiff's two products were marked as two material objects and second defendant's two products were marked as two material objects. I am giving the colours for clarity. Two of the plaintiff's products are such that one is black and the other is combination of Teal and white. Two of the defendants products are such

that one is black and the other is combination of sky blue and white.

5(xxi) Mr.M.S.Bharath, learned counsel for plaintiff submitted that the plaintiff is not claiming any monopoly regarding tripod mixer grinder base, but there is a definite feature for the plaintiff's product in protruding leg and arched feet. Learned counsel made it clear that these are highlighting features and the features of the design registration of the plaintiff i.e., suit design are not restricted to these two features. In support of his submission that the plaintiff is not attempting to monopolise tripod mixer grinder base, learned counsel for plaintiff drew my attention to several other tripod mixer/grinder bases in the market and submitted that the plaintiff is not aggrieved by those. The list placed before me is as follows:



5(xxii) As product to product comparison was agreed upon to decide the design infringement action, various Tripod/Triangular shaped mixer grinder base units including that of plaintiff's and defendants' were demonstrated in the hearing. To my eye, while defendants' product came across as a replication of plaintiff's product, the others appeared to be different from that of the plaintiff's and defendants' products. It has to be added that no discernment was necessary for this.

5(xxiii) Interestingly aforesaid scanned reproduction is part of the defendants typed-set. However Mr.M.S.Bharath relied on this only to buttress his submission that the plaintiff is not making any attempt to monopolise tripod /mixer grinder base. It was to buttress his complaint that the slavish imitation of the protruding legs and the arched feet which according to him are a clear case of infringement qua shape and configuration for which the plaintiff has registration i.e., suit design.

5(xxiv) Learned senior counsel Mr.P.S.Raman, pointed out that the product has to be compared as a whole. I have no disagreement on this. I will refer to this in greater detail infra in this order. It was also argued by learned counsel for plaintiff that the Regulator has been placed between the two legs in the second defendant's products. Therefore, to avoid confusion in addition to the material objects and the prefix, I have also referred to the products by colour. While making the comparison, as the names of the products are clearly written on the same, I also identified products by the name written on the products and compared. To be

noted, plaintiff clearly has 'Preethi' written thereon and second defendant's products have Vidiem written thereon. In any action for infringement, the plaintiff will argue on similarities and the defendant will argue on dissimilarities. This case is no exception.

5(xxv) Mr.P.S.Raman pointed out that so called protruding legs are flat in the plaintiff's products whereas it is not so flat, but pointed in the second defendant's product. It was also argued that the second defendant's products are taller. Furthermore, the bottom view of the products were exhibited to show that they are completely different.

5(xxvi) Per contra, Mr.M.S.Bharath, learned counsel for plaintiff highlighting on the similarities said the Regulator alone has been placed in a different position i.e., between two legs /above an arched feet in the second defendant's product to make it appear that it is different, he also pointed out that in the plaintiff's product, Regulator is placed above one of the three legs. Responding to this, Mr.P.S.Raman, learned senior counsel attempted to say that it is merely a question of placing the Regulator at a different place. Mr.Raman pointed out that the Regulator in the second defendant's product is star shaped unlike the Regulator in the plaintiff's product and because it is star shaped it cannot be placed along side a leg, and it has to be placed between two legs. Mr.Raman also showed photographs of some star shaped products to show what their inspiration was.

5(xxvii) I also had a very close look at the photographs of other

Tripod triangular shaped mixer grinder bases that were placed before me. To be noted those have been scanned and reproduced. Further to be noted, these were placed before me not by the plaintiff, but by the second defendant. To my eyes, it appears that while other tripod triangular shaped mixer grinder bases are clearly distinguishable from Plaintiff's product, the tripod shaped mixer/grinder base of the second defendant is not clearly distinguishable from that of the plaintiff's products and comes across as an infringement. If at all there is any difference, it is in the bottom view. This, according to me, is immaterial because the central theme of a design is appeal to the eye. Appeal to the eye can be only by seeing a product as one would normally look at it. Bottom view will be visible only when we are examining the product very closely. In the normal position when the product is placed, the bottom view is invisible. Therefore, the central theme of design being appeal to the eye i.e., judged 'solely by the eye' clearly clinches the issue in favour of the plaintiff.

5(xxviii) There is one more aspect of the matter.

5(xxix) As alluded to supra, while design registration can be obtained in six different aspects, in the instant case, design registration has been obtained only in shape and configuration. Shape and configuration in the suit design in three dimensional form in the finished product is the test. In this view of the matter also, I have no hesitation in coming to the conclusion that the suit design, at least four out of six views

is absolutely similar. The four views which are absolutely similar are front view, rear view, side view and opposite view as contained in the design registration certificate i.e., the suit design. Differences if any is visible to the eye only in top view and the bottom view. There again, there is not much of difference in the top view. Then, if one looks at the perspective view as contained in the Design Registration Certificate of the suit design, there is no doubt in my mind that the second defendant's product is a clear case of infringement/piracy. In other words, overall perspective are same. In this regard, I put it to the learned counsel on both sides as to whether there are any case laws pertaining to design infringement action, wherein some of the views as shown in the Design Registration Certificate are similar and some are not. Both learned counsel for plaintiff and learned senior counsel for second defendant fairly submitted that this principle is not blessed with authorities / precedents. It was also fairly submitted in unison that it is the overall perspective or product as a whole, which should be looked into and I have done exactly that.

5(xxx) I therefore lay down the principle that in design infringement actions, if some views in design registration certificate and alleged offending product are same/similar and when some other views are not same/similar, the overall perspective will be the clincher.

5(xxxi) In this regard, it is also necessary to look at the judgment

of Lord Farwell in the celebrated Dunlop company case, which I have referred to supra. I have also set out in detail the reasons why I am referring to an English law in this judgment. Lord Farwell has very elucidatively laid down that in a design infringement action, when we are taking about eye, it is the eye of the Judge. I went a step further. I examined it from the eye of a common man too. I examined it from the perspective of a man who may or may not be discerning. I have no hesitation in coming to the conclusion that the second defendant's products suffer from the vice of what is being referred to as 'sameness' even to the eye of a person who may not be very discerning. I had undertaken this exercise in tune with some of the judgments cited at the bar by the learned senior counsel for the second defendant. One such judgment is **Britannia Industries Ltd. vs Sara Lee Bakery** reported in **AIR 2000 Mad 497**. My attention was drawn to Paragraphs 38 and 41, which read as follows:

"38. The task of the Court is to Judge the similarity or difference 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. In judging the articles solely by the eye the Court shall see whether the infringing design is an obvious or a fraudulent Imitation.

41. One of the tests to find out the identity or sameness of the design is to find whether there are substantial differences between the design subsequently registered and the design which was earlier registered. These differences cannot be based on purely subjective or utilitarian or aesthetic considerations. The differences must be objective in its essential features. A

general view of the features of both the designs should be looked into to find out if the one design is as good as the other, and the conclusion is to be arrived at by visual examination of the two things. Similarity of device in external appearance may be a relevant factor in considering the substantial differences between the two but is certainly not a determining factor."

5(xxxii) Another judgment of the Bombay High Court in **Harish Chhabra Vs. Bajaj Electricals Ltd., and another** reported in **2005(3) Mh.L.J 962** was placed before me to say that the product as a whole has to be compared. A portion of paragraph No.5 of this judgment was relied on by learned senior counsel Mr.P.S.Raman. That portion of Paragraph 5 reads as follows:

"5.....On the other hand the learned counsel appearing for the respondent contended that what is invented design is an ornamental ring fitted on a fan and therefore a fan with such a feature is a design registered by the respondent No. 1 and therefore the design is rightly registered. However the learned advocate General appearing on behalf of the respondent No. 1 has fairly drawn my attention to the judgment of the House of Lords in the case of William J. Holdsworth and Ors. v. Henry C. M' crea reported in 1987 Vol. II English and Irish Appeal page 380 wherein it has been held as under :

"The only thing which it is here necessary to point out, as well for warning to inventors as for the protection of the public, is this, that if a design, as exhibited in a pattern is filed and registered by an inventor, without any farther limitation or description than that which is given by the design itself, it protects the entire thing and the entire thing only, and the protection cannot, at pleasure, be made

applicable one day to the entirety and another day to the separate integral parts or elements of the entire design. It must be considered that the protection of the statute is invoked for the entire thing that appears upon the register and is applicable to nothing but the exact copy of the thing so registered."

5(xxxiii) It is again reiterated that I have compared the products as a whole as set out supra. A judgment of House of Lords in ***Philips vs Harbro Rubber Company (1920 XXXVII RPC 233)*** was also placed before me. However, that was a case where the House of Lord returned a verdict that the design itself was not worthy of registration as it was lacking in novelty and originality. To be noted, the issue of validity of the design has been set apart for main suit in the instant case. An attempt was made to place before me a judgment of a learned single Judge of the Delhi High Court dated 18.01.2018 pertaining to duplication of pens. When pointed out that the said judgment has entered into arena of functionality of the product, learned senior counsel in his usual fairness submitted that it does not help further the case of the second defendant in the instant lis. Another judgement of a learned single Judge of the Bombay High Court in ***Hawkins Cookers Ltd. vs Zaverchand Liladhar Shah And Ors.*** reported in ***2005 (31) PTC 129 Bom*** was also placed before me to emphasise that whether there is novelty in the design itself is a matter which has to be decided by the eye. It was pressed into service to say that the question the Court has to address itself in a design infringement action is whether the two appearances are substantially the

same or not and that the design must be looked at as a whole. Relevant paragraph is Paragraph No.8, which reads as follows:

8. Looking at the aforesaid judgment, it is obvious that it is ultimately the court to ascertain whether design is different or similar by having a look at the same. Looking at the two handles which are supposed to be innovated by either parties, I am of the opinion that the said handles are not identical. The look and shape of the handles is different. The visual look of the two handles indicates that if the handle is the only matter where the petitioners are claiming to be the innovators then the handle of Respondent No. 1 is different and independent. The learned single Judge while hearing the motion in Suit No. 4226 of 1994 has also considered the aforesaid aspect and has set out a detailed distinction between the said two designs. The said suit was preferred by the plaintiffs against Respondent No. 2 herein. Respondent No. 2 is a marketing and distributing product manufactured by Petitioner No. 1. While considering the case of petitioners in the aforesaid suit prima facie the learned single Judge of this Court has held in para 6 as under:

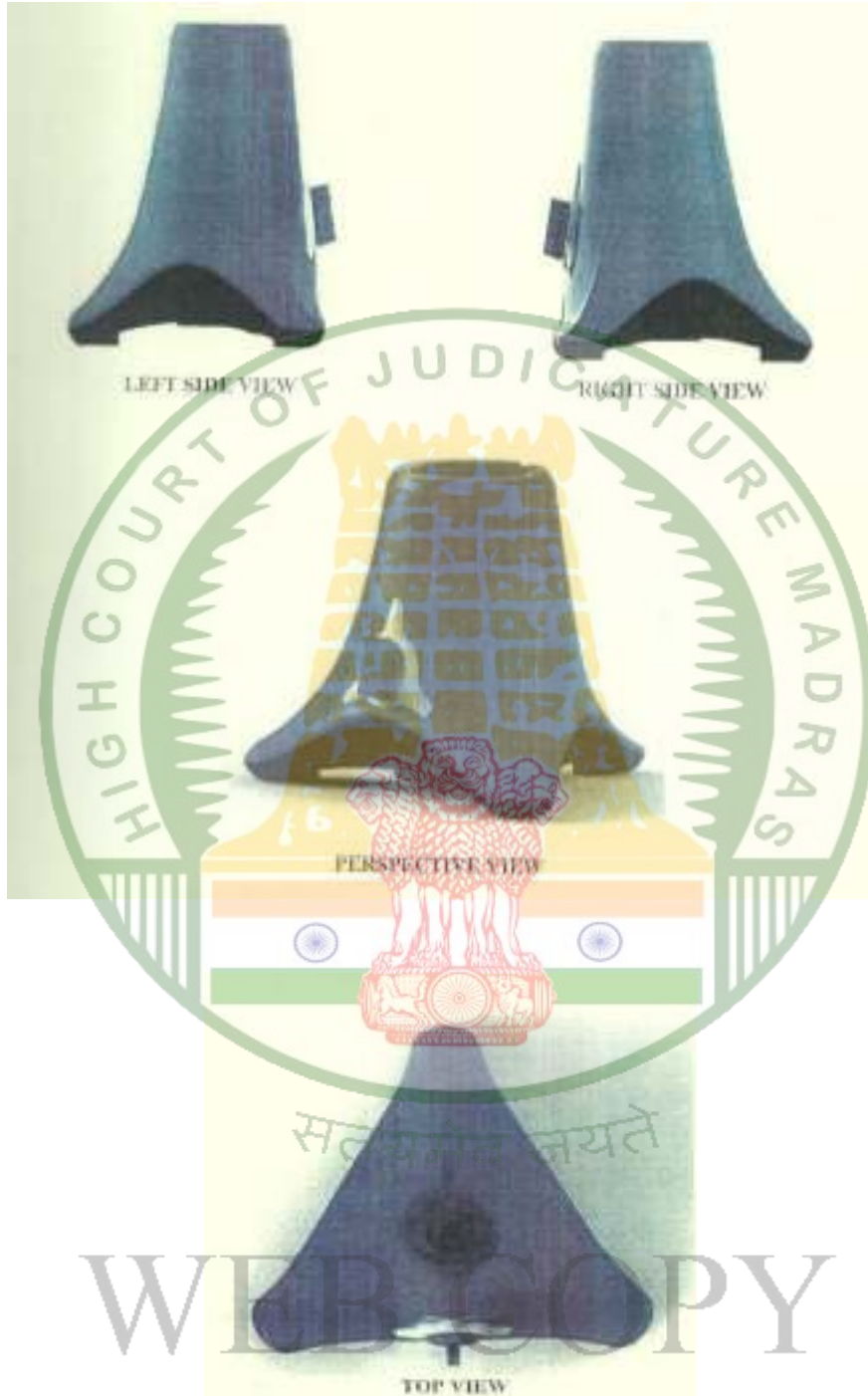
"6. Visual look of these two products will show that the case made out by the defendants will have to be accepted. Defendants product cannot be said to be in infringement of the registered design of plaintiffs. The design of defendants of Tava is altogether separate having independent handle and there is curve in the handle, while

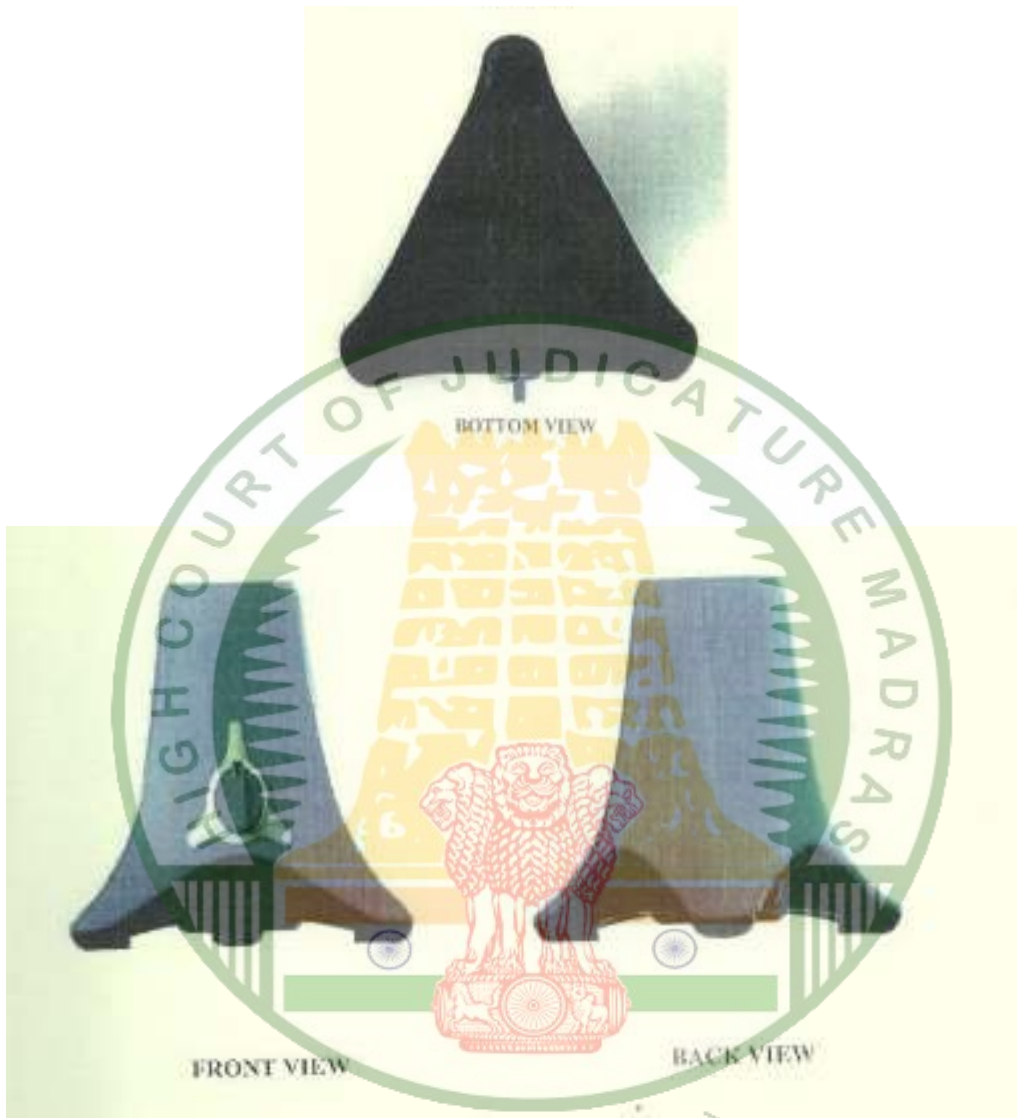
there is no curve in the handle of plaintiffs" produce. There is difference in the size of the handle. There is also difference in the thickness of Tavas. Length of handle also differs in both these products. Defendants' Tavas are very light in weight, whereas plaintiffs' Tavas are heavy. Defendants are manufacturing Tavas in three different sizes and in three different diameters, while plaintiffs are manufacturing Tavas of one size and one diameter. Defendants' own registered trade mark is "Armour-Finish", which has been embossed on their product. Defendants are marketing their product under the trade name "Meera", while plaintiffs' are marketing their product under the trade name "Hawkins". Respective design numbers are also embossed on the products. The visual look of both these products shows that defendants' case will have to be accepted and it cannot be held that defendants are infringing plaintiffs' product. Defendants' are manufacturing said product and using the registered design from 11.11.1992. Plaintiffs have given notice on 12.2.1993 to which reply was given on 3.3.1993. In spite of this, first time suit came to be filed on 11.10.1994. Thus, plaintiffs have slept over their rights. Delay in approaching the Court after the notice is not explained. In my judgment, this also disentitles plaintiffs from claiming any relief in this motion.?

5(xxxiv) I have no disagreement. I have done exactly that.

5(xxxv) For the purpose of completion of facts, I deem it appropriate to extract the 7 views and one prospective view in the Design

Registration Certificate of second defendant also. The same is as follows:





As in **Alert India** (supra) a later design registration would not be entitled to any protection qua a prior registrant, 2nd defendant's product being on the basis of aforesaid design registration certificate does not help the second defendant in this case as it is pitted against a prior registrant.

5(xxxvi) It is necessary to record the fact that the issue of whether a design infringement action and passing off action can be combined in one suit was brought up. In this regard, the aforesaid Full Bench judgment of the Delhi High Court i.e., Micolube case returned as an

answer to one of the references, that it cannot be done. However, as I am deciding the interlocutory applications, I am not expressing any opinion on the same. The reason is, Delhi High Court in the Microlube case has said that if a design infringement action suit and passing off suit are brought up simultaneously or in quick succession, it can still be tried together.

5(xxxvii) I deem it appropriate to leave this question open to be decided in main suit depending on the trajectory of the litigation.

5(xxxviii) I have come to an emphatic conclusion that there is infringement of suit design.

5(xxxix) To be noted, though I have followed Delhi High Court Full Bench Judgment with regard to infringement action against a registrant, with regard to combining design infringement action and passing off action, I leave the question open to be decided in the main suit as there is no disagreement before me that submissions in this regard will turn heavily on evidence and it is desirable to have that question left open at this interlocutory stage.

5(xl) With regard to the prayer for injunction qua passing off, undisputed facts as they unfurl before me from the pleadings and submissions is that the plaintiff launched their products being mixer grinder with tripod shaped base unit i.e., Preethi Zodiac Series in March 2016, whereas defendants (second defendant to be specific) launched their products being mixer grinders with tripod shaped base unit i.e.,

'Vidiem V-Star series' in September 2017. Furthermore, the design registration certificate of the plaintiff (Design Registration No.276216) is dated 01.10.2015 i.e., suit design. This Design Registration Certificate of Second Defendant (Design Registration No.292910) is dated 17.04.2017. Therefore, there is no dispute before me on facts that the second defendant is a subsequent registrant. To be noted, the second defendant is not only a subsequent registrant, but also a subsequent entrant in the market. The prayer regarding passing off is product passing off. The plaintiff seeks an injunction restraining second defendant from passing off its products being 'Vidiem V-Star series' as plaintiff's Preethi Zodiac Series. Therefore, when these aspects are seen in conjunction with and in the light of the narrative supra pertaining to infringement of suit design, it follows as an inevitable sequitur that the prayer for injunction qua product passing off also deserves to be acceded to.

5(xli) Therefore, as far as this common order is concerned, in the light of all that have been set out supra, prayers in both applications deserve to be acceded to and I do so.

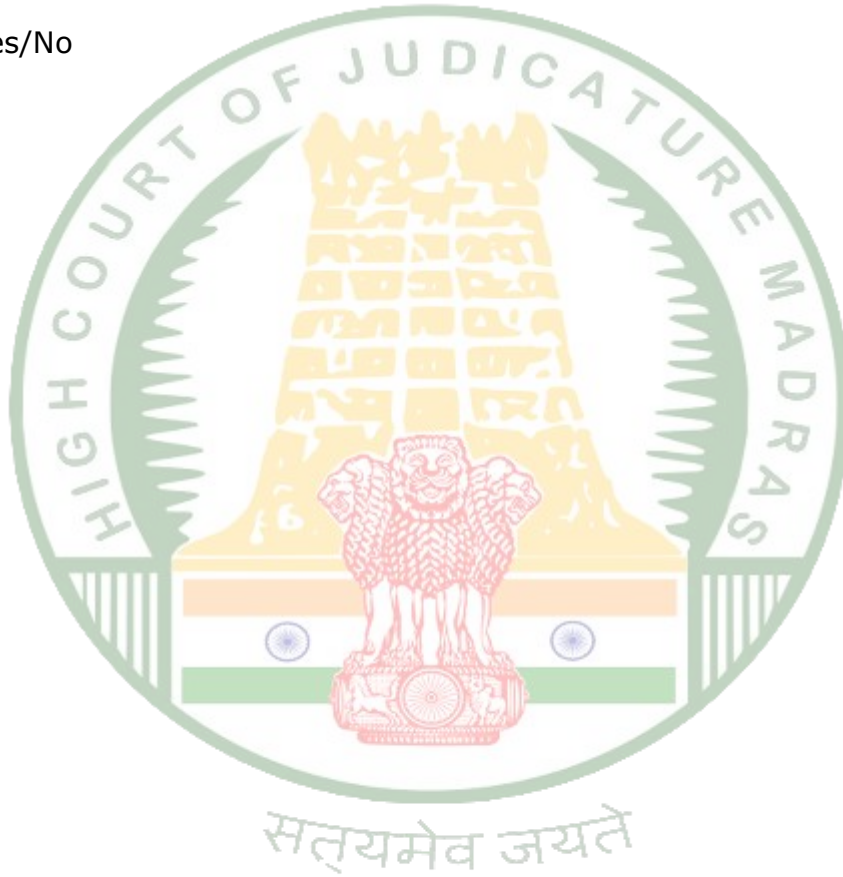
5(xlii) Before parting with case, I deem it necessary to place on record that the scanned reproductions in this order supra, are in black and white, but I had the benefit of comparing them in colour. This is notwithstanding the fact that the design registration does not include colour.

In other words, owing to the narrative supra, O.A.No.31 of 2018 and O.A.No.32 of 2018 are allowed. No costs in the light of the nature and trajectory of the litigation.

01.03.2018

Index: Yes/No

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Order in
Original Application Nos.31 and 32 of 2018 in
C.S.No.26 of 2018

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