

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 28.04.2018

CORAM:

THE HON'BLE MS.JUSTICE INDIRA BANERJEE, CHIEF JUSTICE
AND
THE HON'BLE MR.JUSTICE ABDUL QUDDHOSE

O.S.A.Nos.82 and 83 of 2018
and C.M.P.Nos.4947 and 4948 of 2018

M/s.Maya Appliances Pvt Ltd.,
No.10/5, Royal Enclave,
Besant Avenue, Adyar,
Chennai - 600 020. ... Appellant in both OSA

also having factory at 3/140
I.T. Highway, Oggiyam
Thoraipakkam, Chennai 600 097.

Vs.

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

Previously at
Technopolis Knowledge Park
Mahakali Caves Road
Chakala, Andheri East
Mumbai 400 093, India

Also having corporate office at
Furtura Tech Park, Q4, 4th Floor
Block B, 334 Rajiv Gandhi Salai (OMR)
Sholinganallur, Chennai 600 119
Rep by it authorised Signatory
C. Ramanathan.

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

... Respondents in both OSA

Prayer: Original Side Appeal filed under Order XXXVI Rule 9 R/w Clause 15 of the Letter Patent Act, against the order dated 01.03.2018 made in O.A.No.31 of 2018 in C.S.(Comm.)No.26 of 2018, passed by the learned Single Judge of this Court.

Prayer in O.A.No.31 & 32/2018:

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 Respondents/Defendants their men agents or persons acting on their behalf from in any manner infringing the Applicant/Plaintiffs copyright in design Nos.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 tripod shaped base unit design for mixer grinders pending disposal of the suit.

For Appellant : Mr.P.S.Raman
Senior Counsel for
Mr.T.K. Bhaskar
For Respondents : Mr.M.S.Bharath For R1
No appearance For R2

COMMON JUDGMENT

These appeals are against a common order dated 1.3.2018 passed by the learned Single Judge allowing two Interlocutory Applications being O.A. Nos.31 and 32 of 2018 in a Suit being C.S. (Comm) No.26 of 2018 filed by the Respondent No.1 [hereinafter referred to as the plaintiff respondent], against the Appellant [hereinafter referred to as the defendant appellant] and the Respondent No.2 [hereinafter referred to as the defendant respondent] for inter alia infringement of copyright in design and passing off.

2. In the said suit, apart from damages, the plaintiff respondent claimed inter alia,

(a) Grant a permanent injunction restraining the Defendants, their men, agents, or persons acting on their behalf, from in any manner infringing the Plaintiff's copyright in design Nos.276216 granted on 01/10/2015 in respect of its tripod shaped base unit for its 'Preethi Zodiac' series of mixer grinders by manufacturing, or offering for sale of selling any mixer grinders under the name VIDIEM V-STAR SERIES or under any other name with features

identical or any manner similar to the Plaintiff's tripod shaped base unit design for mixer grinders;

(b) Grant a permanent injunction restraining Defendants from in any manner passing off the Plaintiff's tripod shaped base unit for its mixer grinders marketed and sold under the name 'Preethi Zodiac' series by using identical/or deceptively similar tripod shaped base unit design, shape or configuration, and marketing and selling any model under the brand name VIDIEM V-STAR SERIES or under any other name in any manner whatsoever.

3. The plaintiff respondent filed two Interlocutory Applications in the said Suit being O.A. Nos.31 and 32 of 2018 praying for the following orders:

(a) Grant an ad-interim injunction restraining the Respondents/ Defendants, their men, agents, or persons acting on their behalf, from in any manner infringing the Applicant/Plaintiff's copyright in design Nos.276216 granted on 01/10/2015 in respect of its tripod shaped base unit for its 'Preethi Zodiac' series of mixer grinders by manufacturing, or offering for sale or selling any 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 grinders;

(b) Grant an ad-interim restraining Respondent/ Defendants from in any manner passing off the Applicant/ Plaintiff's tripod shaped base unit for its mixer grinders marketed and sold under the name 'Preethi Zodiac' series by using identical/or deceptively similar tripod shaped base unit design, shape or configuration, and marketing and selling any model under the brand name VIDIEM V-STAR SERIES or under any other name in any manner whatsoever;

(c) Any other relief as this Hon'ble Court may deem fit, in the circumstances of the case, in the interests of justice and equity.

4. Both the defendant appellant and the plaintiff respondent are engaged in the manufacture and sale of kitchen appliances and are competitors in the market.

5. In the plaint, it is stated that in March 2016, the plaintiff respondent, a subsidiary of Koninklijke Philips N.V., of the Netherlands launched a multifunctional user-friendly mixer grinder 'Preethi Zodiac'.

6. The multi utility and/or multifunctional features of the 'Preethi Zodiac' mixer grinder and/or the user-friendliness thereof are not relevant to the issues involved in these Appeals.

7. The plaintiff respondent claims that the base unit of the said 'Preethi Zodiac' mixer grinder has a unique design in the form of a tripod as depicted below:



8. According to the plaintiff respondent, the said design has duly been registered under the Designs Act with effect from 1st October 2015 under Registration No.276216.

9. In the plaint, it is pleaded that the defendant appellant, erstwhile owner of the brand 'Preethi' which had later been sold to the holding company of the plaintiff respondent, started manufacturing and selling kitchen appliances under the new brand name 'Vidiem'.

10. The plaintiff respondent has alleged that in December 2017, the plaintiff respondent came to learn that the defendant appellant had been manufacturing mixer grinder under the brand name "Vidiem V Star series" with a tripod shaped base unit, which was a fraudulent and obvious imitation of the registered design of the plaintiff respondent.

11. According to the plaintiff respondent, there is similarity in the overall appearance of the base unit of the plaintiff respondent's 'Preethi' mixer grinder and the base unit of the defendant appellant's mixer grinder sold under the brand name "Vidiem V star series".

12. It is not in dispute that the design of the base unit of the defendant appellant's mixer grinder sold under the brand "Vidiem V Star series" is also registered under the Designs Act 2000 under Registration No.292910 with effect from 17th April 2017. Of course, the design of the plaintiff respondent was registered earlier. It may also be pertinent to note the pleading of the plaintiff respondent in paragraph 28 of the plaint asserting that the plaintiff respondent does not claim any monopoly on the tripod shape.

13. The learned single Judge, after perusing the pleadings and the materials on record and after hearing counsel appearing on behalf of the parties, found that the defendant appellant had infringed the Copyright of the plaintiff respondent in its registered design and granted a blanket order allowing both the interlocutory applications. All the prayers in the two interlocutory applications have been allowed, including the prayer for blanket injunction restraining the defendant appellant from marketing or selling any model under the brand name Vidiem V Star series or under any other name, in any manner whatsoever.

14. Mr.P.S.Raman, Senior Advocate appearing on behalf of the defendant appellant, submitted that compared as a whole, the base unit of the mixer grinders of the defendant appellant is different from and not an obvious or fraudulent imitation of the base unit of the 'Preethi' mixer grinders of the plaintiff respondent.

15. Mr.Raman further submitted that the base units of the defendant appellant's Vidiem V star series were manufactured in accordance with the Design Registration No.292910. Mr.Raman argued that the Patent Office registered the design of the base unit of the defendant appellant's mixer grinder under the Designs Act 2000, after due examination on being satisfied of its novelty and originality.

16. Mr.Raman argued that the tests to be applied to determine whether use of a design would amount to piracy under Section 22 of the Designs Act 2000 would be:

- (i)whether the impugned design varied substantially from the registered design and, if so,
- (ii)whether, notwithstanding difference and/or variation, the impugned design is still to be considered obvious or fraudulent imitation.

17. The Preethi mixer grinder of the plaintiff respondent and the Vidiem V Star series mixer grinder of the defendant appellant were brought to this Court and Mr. Raman demonstrated the differences between the base units of the mixer grinder of the plaintiff respondent and the defendant appellant, by physically comparing the two base units and also by comparison of the pictorial depiction of the base unit in the plaint and other documents, including documents obtained from the Patent Office.

18. Mr.Raman demonstrated that the base unit of the plaintiff respondent had a protruding front whereas the base unit of the defendant appellant had a non-protruding front with a concave curve between the two legs on either side.

19. Mr.Raman also pointed out that in the plaintiff respondent's design, all the four legs are visible, if seen from the front, but that is not so in the defendant appellant's design. In the defendant appellant's design, only two legs can be seen from the front but not the third leg.

20. Mr.Raman next pointed out that the top view and the bottom views of the two base units are substantially different in that the design of the respondent plaintiff though triangular shaped, is six sided from the top and from the bottom, whereas the design of the defendant appellant is a three sided triangle with curved edges. Mr.Raman further pointed out that the rear view of the base unit of the plaintiff respondent shows a concave curve between two legs on either side whereas the base unit of the defendant appellant shows all three legs with the third leg protruding at the back.

21. Mr.Raman also pointed out that the base unit of the plaintiff respondent was more rounded and/or circular above the legs whereas the defendant appellant's base unit was more aquiline with ridges on the side starting from the top to bottom along the legs of the base unit.

22. Mr.Raman argued that the above matters were not considered before granting injunction restraining the use of a design on the ground of infringement and/or piracy.

23. Mr.Raman submitted that the learned single Judge fell in error in holding that four out of six features on comparison of the plaintiff respondent and the defendant appellant were identical. The conclusion, according to Mr.Raman, is a generalisation which ignores obvious details, features and the interpretation of features which are different.

24. Mr.Raman proceeded to argue that even assuming that four features are similar, the notable difference in the bottom view was vital, more since the plaintiff respondent did not claim infringement on the feature of the protruding legs. When the bottom view was different, obviously the contours of the base unit of the defendant appellant resting on the edifice of the bottom plate of the base unit would also differ.

25. Mr.Raman argued that the learned single Judge should not have ignored the difference in the bottom view and the top view on the ground that the consumer would not be able to make out the difference. In judging a design, an article had to be viewed as a whole.

26. Mr.Raman pointed out that another vital feature of the design of the defendant appellant was the tristar shaped backplate and the switch knob which could not be placed anywhere on the body of the base unit, given the need for a flat frontal surface. This highlights the very inspiration of the overall design.

27. Mr.Raman emphasised that the noticeable differences in these features would clearly establish that the defendant appellant did not use the base unit of the plaintiff respondent as a basis for its design. The difference in individual element shows that the defendant appellant's design is novel and original, a design conceived by the defendant appellant on its own.

28. Mr.Raman argued that the Hon'ble Single Judge failed to note that the plaintiff respondent had made an attempt to rearrange the configuration of the product of the defendant appellant in an attempt to display similarity. Both the defendant appellant and the plaintiff respondent have design registrations for both shape and configuration and the products would have to be compared for their overall similarity 'as they are' and not by removing any of the elements of the configuration.

29. Citing the judgment of a Single Judge of the Bombay High Court in Whirlpool of India Pvt. Ltd. v. Videocon Industries Ltd., reported in (2014 (60) PTC 155 (Bom)), Mr.Raman argued that the Single Bench should have considered the rival

designs as a whole to see whether the impugned design was substantially different from the design sought to be enforced. The learned Single Bench patently erred in holding that on comparison of the designs of the plaintiff respondent and the defendant appellant, the same would be found identical. Such finding is a general finding which ignores obvious details and features of the two designs, which were obviously different.

30. Mr.Raman argued that the law does not protect any specific features but the representation of such features as a whole referring to the single Bench Judgment of this Court in Britannia Industries Ltd. v. Sara Lee Bakery, reported in AIR 2010 Mad 49.

31. Mr.Raman argued that in judging an article solely by the eye, the Court is to see whether the infringement of the design is an obvious and/or a fraudulent imitation. Mr. Raman also argued that learned Judge overlooked the argument of the defendant appellant that the base unit of the grinder mixer of the defendant appellant was inspired by a combination of tristar and Ninja Throwing stars and not the design of the Plaintiff Respondent.

32. Mr.Raman also argued that the design of the plaintiff respondent was only a trade variant of the designs that already existed in the market and there was no novelty in the market and there was no novelty in the said design. However, since the design of the plaintiff respondent was registered before the defendant appellant's design was registered and the defendant appellant has later also registered tripod shaped design, it is not open to the defendant appellant to question the novelty of the plaintiff respondent's registered design.

33. Mr.Raman finally argued that there were many mixer grinders in the market with tripod shaped base. The plaintiff respondent was not the first to introduce a tripod shaped mixer grinder. Furthermore, the plaintiff respondent is not claiming monopoly over the tripod shape but is contending that the novelty of its base unit lies in the feature of its three protruding legs in the base unit of the mixer grinder and the concave shape of the bottom of the plate.

34. In support of his submission that the protection of the Designs Act, 2000 is invoked for the entire design that appears upon the register and is applicable not to specific features, but the exact copy of the design registered, Mr. Raman cited the decisions in Harish Chhabra v. Balaji Electricals Ltd., reported in 2005 (3) Mh.L.J 962 and Samsung Electronics (UK) Ltd. v. Apple Inc., reported in (2012) EWHC 1882 (Pat).

35. Mr.Raman concluded that the product of the defendant appellant was more streamlined and aquiline with sharp and unique dimensions as compared to the thick and stubby base unit of the mixer grinder of the plaintiff respondent. He submitted that the learned Single Bench has not only overlooked the striking differences, but has also ignored the principles for grant of equitable interim relief of injunction, that is the strength of the prima facie case made out by the applicant for grant of interim injunction, balance of convenience and irreparable injury to the applicant for injunction as a consequence of refusal to grant injunction.

36. Mr.Bharath appearing on behalf of the plaintiff respondent submitted that the object of design registration was to ensure that the originator of a profitable design was not deprived of his reward by others applying it to their goods. In support of his submission, Mr.Bharath cited Bharat Glass Tube Limited v. Gopal Glass Works Limited, reported in (2008) 10 SCC 657.

37. Mr.Bharath argued that when a consumer visits a store to buy a product like a mixer grinder, the choice is made by looking at the mixer grinder placed on shelves. A consumer would not turn the mixer grinder upside down to look at the bottom and examine if there was any difference. The dissimilarity of the bottom view of the base unit was, therefore, inconsequential, since the bottom surface of the mixer grinder is invisible to a user.

38. Citing the decision of the Delhi High Court in Alert India v. Naveen Plastics, reported in 1997 (17) PTC 15 (Del), Mr.Bharath argued that for determining if two designs were identical or not, it was not necessary that two designs should be exactly the same, similarity in the broad features of shape, configuration, pattern would amount to imitation of the design of one by the other.

39. In support of the submission that sameness of features does not necessarily mean that the two designs must be identical in every respect, Mr.Bharath also cited Dabur India Ltd. v. Amit Jain, reported in 2009 (39) PTC 104 (Del).

40. Mr.Bharath argued that to judge whether there has been any infringement, a design has to be looked as a whole. Mr.Bharath argued that considering the commercial angle of design protection, differences on the surface or at the top, not noticeable by a consumer, were inconsequential. It was the overall visual appearance which was material.

41. Mr.Bharath argued that minor differences in placement of the switch etc would also not save a design that was an imitation of an earlier registered design. The creator or designer has the right to explore his creativity commercially.

42. Referring to Whirlpool of India Ltd. v. Videocon Industries Ltd., supra, Mr.Bharath argued that trivial and minor differences would not save a later design from infringement, as otherwise it would be impossible for any plaintiff to succeed, as a skillful infringer would invariably make some cosmetic and minor changes in the design of its products. A mere dissimilarity in the placement of switches is inconsequential. The defendant appellant has replicated the plaintiff respondent's design with trivial changes to inessentials such as the switch design.

43. Mr.Bharath cited Videocon Industries Limited v. Whirlpool of India Limited, reported in 2012 (6) Bom. CR. 178, where a Division Bench of the Bombay High Court held that merely be placing certain ornamentations, changing position of knobs or adding colour scheme, Videocon has not made any difference to its product so as to give it look of a completely different shape than the product marketed by Whirlpool.

44. Mr.Bharath submitted that design registration and/or infringement action in respect of registered design attracts the principle of "imperfect recollection" of a consumer. The consumer is guided by the principle of "appeal to the eye" at the first instance, followed by the principle of "imperfect recollection".

45. Mr.Bharath referred to the affidavit of the defendant appellant in support of the stay petition and particularly paragraph 6.2 thereof, where the defendant appellant has stated that "the current market is evolving at a fast pace and designs are transient". Taking cue from the aforesaid averment of the defendant appellant, Mr.Bharath argued that the life of a design was short-lived and as such the plaintiff respondent's prior and earlier registered design had to be protected.

46. Mr.Bharath further submitted that the plaintiff respondent and the defendant Appellant were not strangers in the market. The plaintiff respondent was part of the defendant appellant until 2011 following which the defendant appellant entered into a Slump Sale Agreement with Koninklijke Philips, NV, The Netherlands. Mr.Bharath argued that the defendant appellant and the plaintiff respondent being siblings in the industry, the defendant appellant was well aware of the prior registered eye-catching design of the plaintiff respondent and should have been cautious not to adopt the same.

47. Mr.Bharath next argued that it is an established principle of law that injunction can be obtained against a registered design holder in a case of design infringement. In support of his contention, Mr.Bharath cited Micolube India Limited v. Rakesh Kumar Trading as Saurabh Industries and Others, reported in 2013 (55) PTC 61 (Del), where a Full Bench of the Delhi High Court observed that a plaintiff was entitled to approach the Court and plead that his registered design was unique and the defendant registrant had obtained registration which was neither new nor significantly distinguishable when compared to the plaintiff's registered design.

48. Mr.Bharath also cited Alert India, supra, for the proposition that a design registered later would not be entitled to protection against first or prior registered proprietor of design and Vikas Jain v. Aftab Ahmed, C.S.(OS) No.1109 of 2005, where the Delhi High Court observed that prior registration would entitle the registered proprietor to prevent infringement of its registered design by a subsequently registered holder of the design.

49. Mr.Bharath also cited the decision of the Bombay High Court in Whirlpool of India Ltd., supra, wherein it was held that a defendant proprietor, who holds a subsequent registration, cannot plead his subsequent registration in defence to an action under Section 22, since a subsequent registration is no defence within the meaning of Section 22(3) read with Section 19 of the Designs Act.

50. Mr.Bharath argued that the defendant appellant was seeking to get the interim injunction vacated by misleading submissions, wrong modes of comparison and taking inconsistent and/or contradictory stands.

51. Mr.Bharath further argued that the defendant appellant had only sold 37468 mixer grinder units, which included all the variants of the "Vidiam V Star" mixer grinders, despite important festivals of Diwali, Christmas, etc.

52. Mr.Bharath also argued that the defendant appellant had not made any application for cancellation of the registered design of the plaintiff respondent.

53. Citing a Full Bench judgment of the Delhi High Court in Metro Plastic Industries v. Galaxy Footwear, reported in 2000 (20) PTC 1, Mr.Bharath argued that in the absence of an application for cancellation of the design, such a right cannot be enforced and no defence can be taken based on a ground of cancellation.

54. The propositions of law enunciated in the judgments cited by Mr. Bharath are unexceptionable and they are not dealt with separately. However, whether there is infringement of registered design or not is a question of fact and each case for infringement has to be decided on its own merits. Observations made in the context of an Ipad in the case of Samsung Electronics (UK) Ltd. v. Apple Inc., supra, cannot be applied in the case of washing machines or, for that matter, other dissimilar product. Paragraphs and sentences in a judgment cannot be read out of context, and have to be construed having regard to the facts and circumstances of the case. A judgment is a precedent for authority of law which is raised and decided and not that which can logically be deduced therefrom.

55. The Designs Act 2000, which repeals and replaces the Designs Act 2000, aims to ensure effective protection of designs registered by the Controller General of Patents, Designs and Trademarks, hereinafter referred to as the Controller, by making the system of the protection of industrial designs more efficient.

56. As held by the Supreme Court in Bharat Glass Tube Limited v. Gopal Glass Works Limited, supra, cited by Mr. Bharath, the sole purpose of the Designs Act 2000 is to protect designs devised to be applied to particular articles which might be manufactured and marketed commercially.

57. The whole purpose of the Designs Act is to secure the rights of the creator of an original and novel design to commercially exploit the design and to prevent imitation thereof without approval. Once a design is registered under the Designs Act 2000, a right accrues to the registered proprietor of the design to prevent manufacture and sale of any article of the same or similar design.

58. The relevant provisions of the Designs Act 2000 are set out herein below for convenience.

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

(a) "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately;

(b) "Controller" means the Controller-General of Patents, Designs and Trade Marks referred to in section 3;

(c) "copyright" means the exclusive right to apply a design to any article in any class in which the design is registered;

(d) "design" means only the features of shape, configuration, pattern, ornament or composition of

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

(e) "High Court" shall have the same meaning as assigned to it in clause (i) of section 2 of the Patents Act, 1970 (39 of 1970);

(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;

(h) "patent office" means the patent office referred to in section 74 of the Patents Act, 1970 (39 of 1970);

(j) "proprietor of a new or original design",-

(i) where any author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed;

(ii) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(iii) in any other case, means the author of the design; and where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

4. Prohibition of registration of certain designs.-A design which-

(a) is not new or original; or

(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form 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.

5. Application for registration of designs.-(1) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act: Provided that the Controller shall before such registration refer the application for examination, by an examiner appointed under sub-section (2) of section 3, as to whether such design is capable of being registered under this Act and the rules made thereunder and consider the report of the examiner on such reference.

(2) Every application under sub-section (1) shall be in the prescribed form and shall be filed in the patent office in the prescribed manner and shall be accompanied by the prescribed fee.

(3) A design may be registered in not more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Controller may decide the question.

(4) The Controller may, if he thinks fit, refuse to register any design presented to him for registration; but any person aggrieved by any such refusal may appeal to the High Court.

(5) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(6) A design when registered shall be registered as of the date of the application for registration.

6. Registration to be in respect of particular article.-(1) A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.

(2) Any question arising as to the class within which any article falls shall be determined by the Controller whose decision in the matter shall be final.

(3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall

not be refused, nor shall the registration thereof invalidated-

(a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in India or in any other country, by reason only that it has been applied to article in respect of which it was previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

(4) Where any person makes an application for the registration of a design in respect of any article and either-

(a) that design has been previously registered by another person in respect of some other article; or

(b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article, with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application, the applicant had been the registered proprietor of that design.

7. Publication of particulars of registered designs.-The Controller shall, as soon as may be after the registration of a design, cause publication of the prescribed particulars of the design to be published in such manner as may be prescribed and thereafter the design shall be open to public inspection.

9. Certificate of registration.- (1) The Controller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Controller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

10. Register of designs.- (1) There shall be kept at the patent office a book called the register of

designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matter as may be prescribed and such register may be maintained wholly or partly on computer floppies or diskettes, subject to such safeguards as may be prescribed.

(2) Where the register is maintained wholly or partly on computer floppies or diskettes under subsection (1), any reference in this Act to any entry in the register shall be construed as the reference to the entry so maintained on computer floppies or diskettes.

(3) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(4) The register of designs shall be prima facie evidence of any matter by this Act directed or authorized to be entered therein.

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

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

22. Piracy of registered design.-(1) During the existence of copyright in any design it shall not be lawful for any person-

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, 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; or

(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or

(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any

article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention-
(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or
(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:

Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any Court below the Court of District Judge.

(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.

(4) Notwithstanding anything contained in the second proviso to sub-section (2), where any ground on which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence and sub-section (3) in any suit or other proceeding for relief under sub-section (2), the suit or such other proceeding shall be transferred by the Court, in which the suit or such other proceeding is pending, to the High Court for decision.

(5) When the Court makes a decree in a suit under sub-section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs.

59. Design has been defined in Section 2(d) to mean only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to an article whether in two or three dimensional or in both forms, by any industrial process or mean, be it manual, mechanical or chemical, separate or combined, which, in the finished article, appeal to and judged solely by the eye.

60. Whether the designs of two articles are identical, whether the design of an article is a fraudulent imitation of some other design is to be judged by the visual effect of the designs in issue.

61. The article is to be judged as a whole, as argued by Mr. Bharath. Under the Designs Act, a right has been conferred on the original creator of a design. Section 4 thus prohibits the registration of a design which is not new or original or has been disclosed to the public anywhere in India or in any country by publication in tangible form or by use or in any other way prior to the date of filing of an application for registration and once a design is registered, the registration takes effect from the date of filing of the application for registration as provided under sub-Section (6) of Section 5 of the Designs Act.

62. In *Gopal Glass Works v. Assistant Controller of Patent Designs and others*, reported in 2006 (33) PTC 434 (Cal), cited by Mr. Bharath, one of us (Indira Banerjee, CJ) held that mere publication of designs, specific drawings and/or demonstrations in connection with an application for registration would not, in itself, amount to publication that would render a design registered in India liable to cancellation.

63. To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication would have to be in tangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article with the same visual effect would be sufficient.

64. However, when the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration. If the visual effect of the pattern or shape or the combination of the pattern, shape, dimension, colour scheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, in the absence of clear and unmistakable directions to make an article of the design which is the same or similar enough to the picture illustrations.

65. Once a design is registered, the registered proprietor of the design has copyright in the design for a period of ten years from the date of registration which may be extendable for a subsequent period of 5 years from the date of expiration of the original period of 10 years.

66. In view of Sub-section (4) of Section 10 of the Designs Act, the registration of the design establishes prima facie evidence of any matter, which by the Designs Act, 2000 is directed or authorised to be entered therein. Thus, once a design is entered in the register, the registration shall be prima facie evidence of originality and novelty of the design and there will be a presumption that the design had not previously been published.

67. However, such presumption is rebuttable. Once a design is registered, the onus is on the person who questions the right of the holder of Certificate of Registration to commercially exploit the design, to substantiate his claim to relief.

68. Section 19 of the Designs Act 2000 provides for cancellation of a registered design, on a petition of an interested person, subject to the following conditions:

- (a) that the design has been previously registered in India; or
- (b) that it has been published in India or in any other country prior to the date of registration; or
- (c) that the design is not a new or original design; or
- (d) that the design is not registrable under this Act; or
- (e) that it is not a design as defined under clause (d) of section 2.

69. Fraudulent imitation of a registered design constitutes infringement and piracy under Section 22 of the Designs Act, 2000. If there is infringement and/or piracy, injunction has to follow in terms of Section 22 (2) of the said Act.

70. To attract Section 22, the resemblance between the designs need not be identical, as long as it is a planned and an obvious imitation, although it may be different from the original in some respects.

71. In Dabur India Ltd., supra, a Division Bench of the Delhi High Court followed inter alia an earlier judgment of the same High Court in Alert India Ltd., supra, and held that:

"17. The law in regard to similarity which constitutes infringement and which in turn attracts an order of injunction has been explained by this Court in Alert India Ltd (supra). Reference in the said case has been made to an earlier decision in J.N. Electricals (India) v. President Electricals, ILR 1980 (1) Delhi 215 where it was explained that 'the sameness' of features does not necessarily mean

that the two designs must be identical on all points and should differ on none. They have to be substantially the same

"36. Thus for determining whether two designs are identical or not, it is not necessary that the two designs should be exactly the same. The main consideration to be applied is whether the broad features of shape, configuration, pattern etc. are same or nearly the same and if they are substantially the same, then it will be a case of imitation of the design of one by the other"

18. Likewise, in Castrol India Ltd, the Calcutta High Court explained that "the word 'imitation' does not mean 'duplication' in the sense that the copy complained of need not be an exact replica. "Reference was made to the earlier decision of the said High Court in Best Products Ltd. V. F.W. Woolworth & Company Ltd 1964 RPC where it was held that "it is the article as a totality that must be compared and contrasted with the features of a shape and configuration shown in the totality observable from the representation of the design as registered. It was said that the Court must address its mind as to whether the design adopted by the defendants was substantially different from the design which was registered". The decision in Dunlop Rubber Co Ltd. V. Golf Ball Developments Ltd (1931) XLVIII RPC 268 is also a pointer to the approach to be adopted by the Court when a complaint is made by a plaintiff of fraudulent imitation of its design by a Defendant. It was observed "a fraudulent imitation seems to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement". As explained in Hindustan Sanitaryware if the Court is able to find that, "there is substantial and sufficient resemblance between the allegedly infringed designs and the Appellant's registered designs", an injunction should follow."

72. There can be no doubt that injunction can be granted against any subsequently registered proprietor. However, as observed above, registration is prima facie evidence of existence of the conditions precedent for registration and the onus is on the one who challenges the subsequent registration, to establish that the subsequent registration was not a legal and/or valid registration in law.

73. An impugned design ought to be compared with features of shape and configuration shown in totality in the design registration certificate. It is also true that the two designs need not be identical. The word 'imitation' does not mean duplication. It does not have to be an exact replica. It has to be seen whether the essential part of the impugned design is similar to the essential part of the alleged infringing design.

74. A comparison of the base unit of the mixer grinders of the defendant appellant and the base unit of the mixer grinders of the plaintiff respondent from the pictorial depictions thereof in the written notes of submissions submitted by Mr. Bharath makes it amply clear that even though there may be some similarity, the designs are not so similar so to be considered as fraudulent copy of the other.

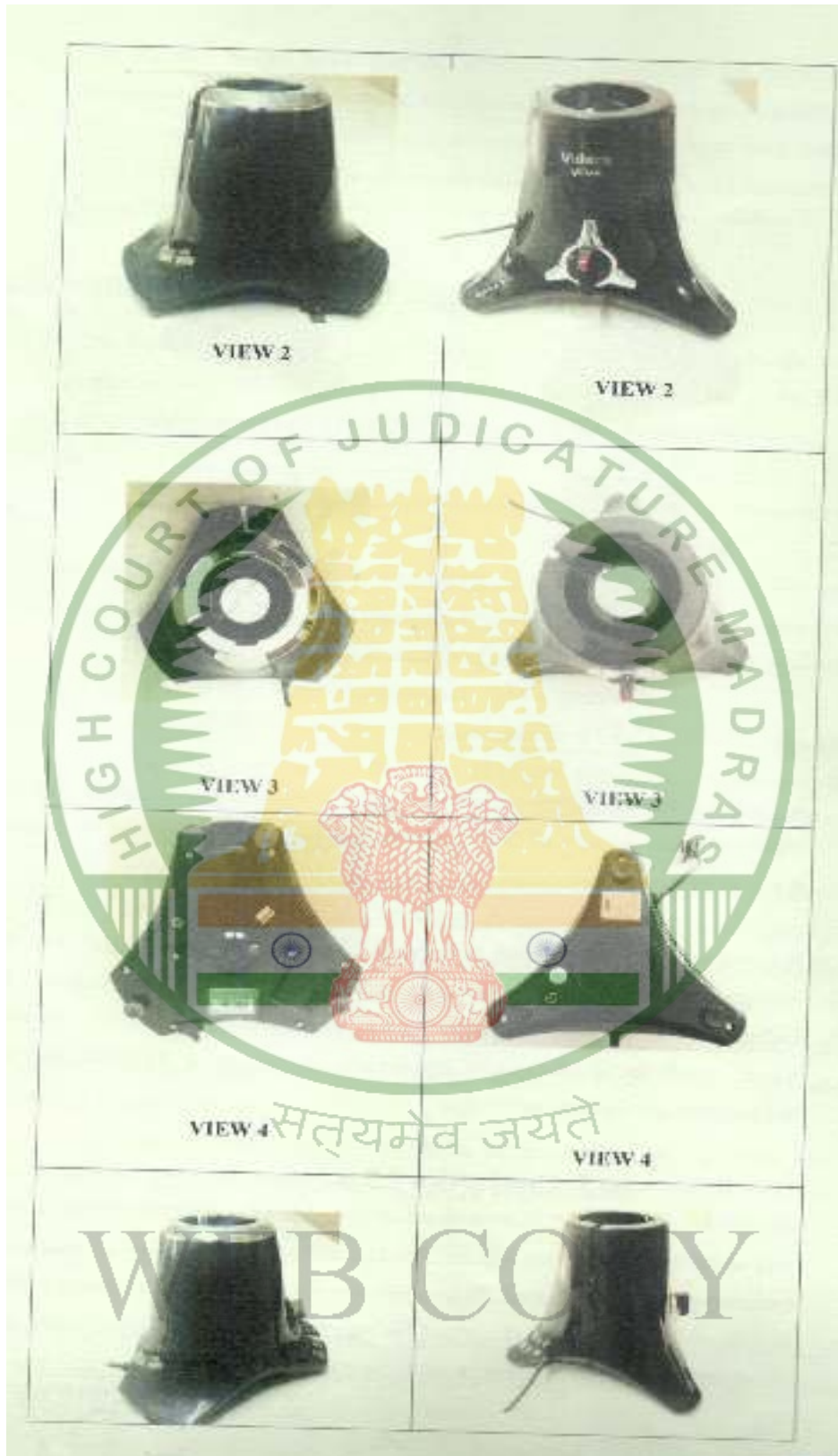
75. As argued by Mr. Raman, there are notable differences in the designs. Moreover, as observed above, the plaintiff respondent does not claim monopoly in the tripod shape. Whenever two designs are in conflict, the conflict has to be decided having regard to the facts and circumstances of the case. There cannot be cast iron formula for determining if there is substantial similarity. The courts have to apply the visual appeal test.

76. The respective registered designs of the base unit of the 'Preethi Zodiac' mixer grinder of the plaintiff respondent and the Vidiem V Star Series of the defendant appellant is illustrated with pictures herein below.

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77. In *Gorham v. Company v. White*, 81 US.14 Wall.511 (1871), the United States Supreme Court held:

"the question is not whether one design will be mistaken for another by a person who examines the two so carelessly as to be sure to be deceived, but whether the two designs can be said to be substantially the same when examined intelligently side by side. There must be such a comparison of the features which made up the two designs. As against an existing patented design, a patent for another design cannot be withheld because, to a casual observer, the general appearance of the latter design is so like that of the earlier one as to lead him, without proper attention, to mistake the one for the other. The same test must be applied on the question of infringement."

78. We are in full agreement with the view taken by the United States Supreme Court. The question is whether the two designs can be said to be substantially the same when examined

intelligently side by side. On a careful look at the illustrations of the two registered designs, we do not find substantial similarities which could be considered as fraudulent or obvious imitation.

79. At the cost of repetition, it is reiterated that both the plaintiff respondent and the defendant appellant are registered proprietors of their respective designs. The plaintiff respondent does not claim any propriety on the tripod. If the tripod is ignored, there is no similarity at all. The shape of the three legs of the tripod is distinctly dissimilar, in that tripod of the defendant appellant is triangular, whereas the tripod of the plaintiff respondent is six sided. The outer end of the three protrusions at the base of the plaintiff respondent's mixer grinder are squarish, whereas those of the defendant appellant are more pointed. The illustrations of the respective designs depicted herein above do not indicate such striking similarities as to fall within the mischief of obvious and fraudulent imitation. There does not also appear to be any real possibility of confusing the base unit of the defendant appellant for that of the plaintiff respondent.

80. In considering a prayer for interim relief, this Court has to consider three important factors, prima facie case, the balance of convenience and whether pecuniary compensation would afford the applicant for injunction, adequate relief.

81. There being no challenge till today to the defendant appellant's registration, we have to proceed on the prima facie basis that the design of the defendant appellant is original, novel and had not been published prior to the date of application for registration. The balance of convenience was also against the interim orders being prayed for in the petition. If the plaintiff respondent ultimately succeeds in the Suit, it would get necessary injunction orders as also compensation for wrongful use of the registered design in question. The compensation might be computed by taking into account the sales of the defendant appellant. However, if the suit ultimately fails, the harm caused to the defendant appellant would be irreparable as it would be difficult to compute the compensation. The balance of convenience was against the passing of interim orders as prayed for in the petition.

For the reasons discussed above, the appeals are allowed and the impugned judgment dated 1.3.2018 is set aside. There shall be no order as to costs. Consequently, connected miscellaneous petitions are closed.

-s/d-
Assistant Registrar(CS-IV)

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Sub-Assistant Registrar

bbr/sasi

To

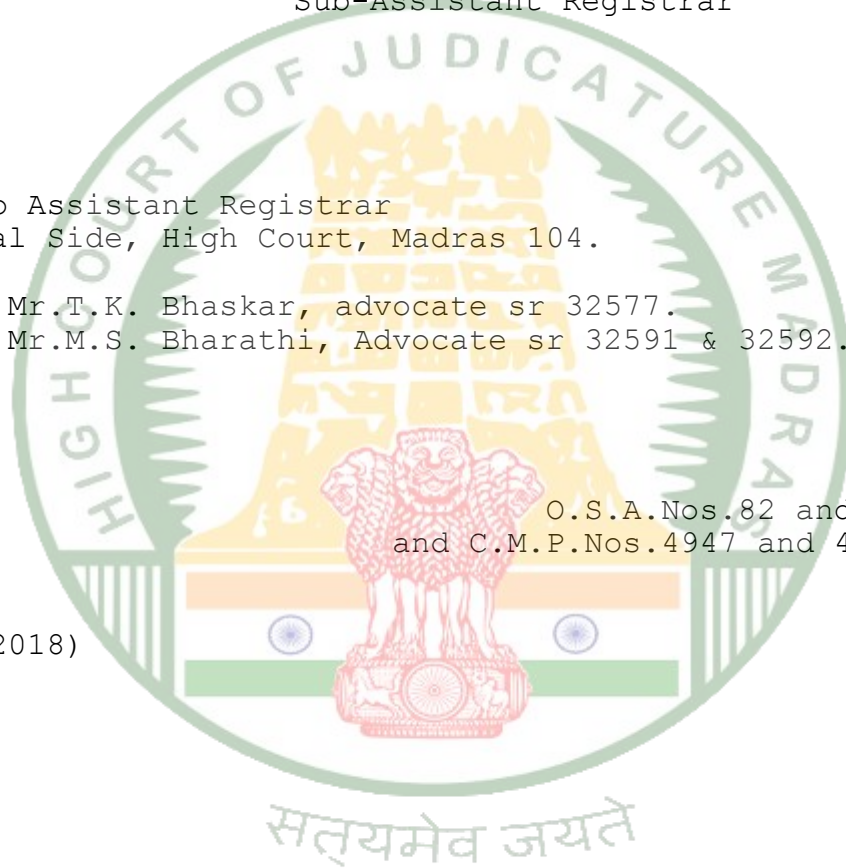
1. The Sub Assistant Registrar
Original Side, High Court, Madras 104.

+2 CCs to Mr.T.K. Bhaskar, advocate sr 32577.

+4 Ccs to Mr.M.S. Bharathi, Advocate sr 32591 & 32592.

O.S.A.Nos.82 and 83 of 2018
and C.M.P.Nos.4947 and 4948 of 2018

RSK(CO)
SP(15/05/2018)



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