

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% **Date of decision: 28th May, 2018**

+ **CS(COMM) 55/2018 & IAs No.1193/2018 (u/O XXXIX R-1&2 CPC) & 1194/2018 (u/O XXVI R-9 CPC)**

RAJESH KALRA **..... Plaintiff**

Through: Mr. Sanjeev Singh and Mr. D.K. Yadav, Advs.

Versus

SAFEOPS. SURGICAL CARE & ANR **..... Defendants**

Through: Mr. Ankit Jain, Amicus Curie/Adv.
with Mr. Divij Soni, Adv.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

1. The plaintiff, as per the amended plaint dated 27th January, 2018, has instituted this suit for permanent injunction restraining infringement of registered design and copyright inhering in its 'Pre-Cut Eye Drape' and passing off and of ancillary reliefs of rendition of accounts, damages etc., pleading:

(i) that the plaintiff is carrying on business of manufacturing, marketing, distribution and sale of medical and surgical, dental, veterinary apparatus and instruments and artificial limbs and eyes in the name and style of M/s Surgitech Innovation;

(ii) that the plaintiff, in its effort to cater to emerging needs and/or high expectations of Ophthalmologists and patients, designed a unique shape and configuration of 'Pre-Cut Eye Drape' with novel technology, unique shape, size and configuration; the plaintiff faced

great difficulties in adjusting a pre-cut aperture on the polyurethane film with the sterile ophthalmic drape and adjusting drainage bag and lid holder and it is only after repeated efforts of the plaintiff that the product was successfully invented and designed;

(iii) that the shape, size and configuration of the design of the 'Pre-Cut Eye Drape' are novel, which makes the design of the aforesaid Eye Drape novel;

(iv) that the plaintiff applied for and the design in the shape, size and configuration of 'Pre-Cut Eye Drape' is registered under Design Registration No.291917 dated 22nd March, 2017 in class 24-04 and under Design Registration No.291915 dated 22nd March, 2017 in class 24-01;

(v) that the said design of 'Pre-Cut Eye Drape' bears unique and novel shape, size and configuration and has greatly appealed to the eyes of public and there is always a rush for the said product bearing the said registered design;

(vi) that 'Pre-Cut Eye Drape', owing to its quality, has successfully established its identity in the industry and corporate sector engaged in the research and development combined with the brand promotion activities and advertisements; the said registered design of the plaintiff has become distinctive, eye catching and associated with the plaintiff and plaintiff's product;

(vii) that the defendant No.1 SafeOps. Surgical Care, Surat, Gujarat is also engaged in trade and business of manufacturing and sale of medical, surgical, dental, veterinary apparatus and instruments and is

also manufacturing and marketing Eye Drapes bearing the impugned design;

(viii) that the defendant No.2 Parth Brahmabhatt trading as Nine Vision at Pune is acting as trader of defendant No.1 and marketing the products manufactured by the defendant No.1;

(ix) that the defendants are commercially and in the course of trade using the shape, size and configuration of 'Pre-Cut Eye Drape' which is a copy of the plaintiff's registered design; the defendants have copied in entirety the said registered design of the plaintiff and are thus committing piracy of the registered design of the plaintiff;

(x) that the defendants have also copied the entire scheme and business model of the plaintiff and illegally using the same shape and configuration of Pre-Cut Eye Drape with unique pattern and adjustment of pre-cut polyurethane film, drainage bag and lid holder;

(xi) that the plaintiff, in July, 2017, on learning of the infringement by the defendants, got served a cease and desist notice dated 27th July, 2017 on the defendants; the defendant No.1 vide its reply dated 11th August, 2017 denied any infringement and the defendant No.2 did not reply to the notice;

(xii) that though the plaintiff is based at Karnal, Haryana but this Court has territorial jurisdiction to entertain the suit as the defendants are soliciting clients/customers of the plaintiff at Delhi and the defendant No.1 is selling its goods to defendant No.2 at Delhi.

2. The suit came up before this Court for admission on 29th January 2018, when the following order was passed:

“CS(COMM) 55/2018, IA No.1193/2018 (under Order XXXIX Rules 1&2 CPC) & IA No.1194/2018 (under Order XXVI Rule 9 CPC)

3. *The suit is listed for admission.*

4. *None appears for defendants.*

5. *The order dated 25th January, 2018 was passed when the lawyers were abstaining from work and the presence of proxy counsel for the defendant has been wrongly recorded by the Court Master.*

6. *The plaintiff has instituted this suit to restrain infringement of design “Pre-Cut Eye Drape” and for ancillary reliefs.*

7. *From the Registration Certificate of the design filed by the plaintiff, the product could not be understood. The plaintiff otherwise has not filed the product to which design relates.*

8. *The counsel for the plaintiff in the Court has handed over the product and after understanding from the counsel for the plaintiff, it transpires that the product is but a sheet used during eye surgery to cover the face of the patient. On enquiry as to what is the novelty therein, the counsel for the plaintiff states that the sheet of the plaintiff comes with a pre-cut aperture from where the surgeon can operate and further comes with an attached pouch in which the fluids draining out from the eye during the eye surgery can be collected. On enquiry, as to what is otherwise being used during eye surgeries, the counsel for the plaintiff states that the surgeon covers the face of the patient with any sheet available and cuts an aperture therein and keeps a beaker or a pouch to collect the fluids flowing out of the eye during the eye surgery.*

9. *I have asked the counsel for the plaintiff to show the other products available in the market.*

10. *The counsel for the plaintiff seeks adjournment. He also states that an application has also been filed for amendment of the plaint but which has not been listed yet.*

11. *I may record that the product of the plaintiff handed over in the Court though has a pre-cut 'square' in the centre thereof but covered with plastic and it appears that the surgeon, instead of cutting the sheet of any other material, in the sheet of the plaintiff will have to cut the plastic to approach the eye.*

12. *I have also asked the counsel for the plaintiff as to how the aforesaid qualifies as a 'design' under the Designs Act, 2000, for a suit to be entertained.*

13. *The definition of 'design' in Section 2(d) of the Designs Act means 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.*

14. *There is no explanation in the plaint as to how the product in question qualifies as two dimensional or three dimensional, to fall in the definition of 'design'.*

15. *A perusal of the Registration Certificate also shows disclaimers with respect to inter alia any mechanical or other action or of principle of construction of the product and with respect to colour or colour combination of the product.*

16. *The counsel for the plaintiff seeks adjournment to address on the said aspects also.*

17. *List on 12th March, 2018."*

3. Thereafter, the amended plaint aforesaid was taken on record and on 12th March, 2018, the following order was passed:

"1. This order is in continuation of the earlier order dated 29th January, 2018.

2. *The counsel for the plaintiff seeks adjournment to answer as to how the product in question qualifies as two-dimensional. Though he has brought copy of **Bharat Glass Tube Ltd. Vs. Gopal Glass Works Ltd.** (2008) 10 SCC 657 and copy of Chapter 27 (pages no.390 to 398) of Narayanan's textbook 'Copyright in Industrial Designs' but is unable to point out the queries raised and recorded in the order dated 29th January, 2018.*
3. *Last opportunity is given to the counsel for the plaintiff to study the matter, else the suit would be dismissed.*
4. *List on 23rd April, 2018. "*

and on 23rd April, 2018, the following order was passed:

- "1. This order is in continuation of the earlier orders dated 29th January, 2018 and 12th March, 2018.*
- 2. The counsel for the plaintiff, though on earlier dates was disputing that for a thing to qualify as a three dimensional, has to have all three elements of length, width and height, today agrees to the same. He further contends that though a piece of paper would be two dimensional but the subject product is three dimensional because of the plastic pouch attached to the aperture and which adds height, even if of micro millimetres, to the subject product.*
- 3. On enquiry, whether a sheet of paper with the cello tape affixed thereto would also qualify as three dimensional, though the counsel initially answered in the negative but now states that it would so qualify.*
- 4. It is deemed appropriate to appoint an amicus curie to assist on the question which has arisen.*
- 5. Mr. Ankit Jain, Advocate present in Court has graciously agreed to assist the Court on the legal issue.*
- 6. The counsel for the plaintiff to supply a complete paper book to Mr. Ankit Jain, Advocate today itself along with copies of the orders passed in the suit.*

7. *List for hearing on 28th May, 2018.*”

4. Mr. Ankit Jain, learned Amicus Curie and the counsel for the plaintiff in response have been heard.

5. Mr. Ankit Jain, Amicus Curie has argued:

(a) That the definition of ‘design’ in Section 2(d) of the Designs Act, 2000 excludes a mere mechanical device and to qualify as a design it should be appealing to the eye and not appealing to the function which it performs.

(b) That functional change if any made in an article cannot be registered as a design.

(c) That the definition of ‘design’ under the Designs Act is the same as that which existed in United Kingdom (UK) earlier.

(d) That an Ophthalmologist will not buy an Eye Drape because of how it looks but will buy it for its use.

(e) That the word ‘mechanical’ as earlier existed in the UK Law has now been substituted with “functional”.

(f) That the House of Lords in ***AMP Incorporated Vs. Utilux Proprietary Limited*** [1972] R.P.C. 103 has *inter alia* held that the phrase “which in the finished article appeal to and are judged solely by the eye” in the definition of ‘design’ in Section 19 of the Patents and Designs Act, 1919 (UK) is to be read as importing some limitation to the expression “features of shape, configuration, pattern or ornament” and that not all of such features constitute a design; the

emphasis is on external appearance, but not every external appearance of an article constitutes a design; there must be in some way a special, peculiar, distinctive, significant or striking appearance—something which catches the eye and in this sense appeals to the eye.

(g) That the Full Bench of this Court, in ***Mohan Lal Vs. Sona Paint and Hardwares*** AIR 2013 Delhi 143, has held that designs relate to non-functional features of the article; therefore, by necessary corollary, a design which has functional attributes cannot be registered under the Designs Act—this is an essence of Section 2(d) of the Designs Act; the protection under the Designs Act is granted only to those designs which have an aesthetic value or otherwise appeal to the eye.

(h) That the High Court of Calcutta in ***Castrol India Ltd. Vs. Tide Water Oil Co. (I) Ltd.*** 1996 (16) PTC 202 (Cal) held that all novel designs are not protected; novel designs which are purely functional cannot found an action for infringement; the object of the Designs Act is to protect shape but not a functional shape and if shape and configuration are dictated solely by function, it is not registrable as a design.

(i) That this Court in ***Carlsberg Breweries A/s Vs. Som Distilleries and Breweries Limited*** 2017 (70) PTC 413 (Del), though appeal thereagainst is pending, has held that the words “judged solely by the eye” must be intended to exclude cases where a customer might choose an article of that shape not because he thought that the

shape made it more useful to him but because on viewing the product/article it stands out or strikes as novel; indentations and grooving on a bottle, in that case, though were found to be novel, inasmuch as bottles of other manufacturers were not having identical indentations and grooving but it was held that the indentations and grooving appeared to serve the purpose of providing a space where the label could be affixed and providing a frame to the label and were thus functional.

(j) That though the Full Bench of this Court in *Mohan Lal* supra has held that a suit for passing off of a design is also maintainable but the plaintiff has not sued therefor.

(k) That a perusal of the Certificates of Registration filed by the plaintiff show registration to be only with respect to shape and configuration.

(l) That though Rule 11(4) of the Design Rules, 2001 permits an applicant for registration to also state the purpose for which the article is used but the Certificate of Registration filed by the plaintiff does not state any purpose;

(m) That Rule 12 of the aforesaid Rules titled “Statement of Novelty” permits the applicant for registration to, if required by the Controller, endorse on the application and each of the representations, a brief statement of the novelty he claims in his design but there is no such statement also and nothing can be gathered from the Certificates of Registration, as to what is novel.

(n) That the House of Lords, in *Phillips Vs. Harbro Rupper Company* 1920 (37) R.P.C. 233, in the context of the Patents, Designs and Trade Marks Act, 1883, noted that though the statute requires that the application should contain a statement of the nature of the design, and the rules made under that statute permit the applicant to lodge a statement of the novelty claimed for the design, but the applicant therein had not availed himself of the permission and held that the Court themselves had to decide the question of originality or novelty of the design and infringement only on the basis of its own appreciation of the article by the test of eye; hope was expressed that the Controller of Designs would freely avail himself of this power as under Rule 12 supra of the Designs Rules and/or in any case where doubt is likely to arise, as otherwise, the only safe course for a Court to take will be to insist on absolute identity between the infringing and the registered design.

(o) That this Court also, in *Dabur India Limited Vs. Rajesh Kumar* 2008 (37) PTC 227 (Del), held that the plaintiff had not got any peculiar feature of the bottle registered as a design and it got the whole bottle registered as a design and that a plastic bottle is not a new thing.

(p) That the plaintiff in the present case did not claim any novelty in the aperture in the Eye Drape.

6. On query, whether the design claimed is two dimensional, the learned Amicus Curie stated that since the Eye Drape as well as an aperture therein has length and width, it would qualify as two dimensional.

7. The counsel for the plaintiff, in response has handed over in Court Certificates, purportedly issued by various hospitals, to the effect that they were earlier using regular drapes, without cut and found the ‘Pre-Cut Eye Drape’ of the plaintiff “very good and useful”. The counsel for the plaintiff also referred to *Bharat Glass Tube Limited Vs. Gopal Glass Works Limited* (2008) 10 SCC 657 citing with approval *Interlego A.G. Vs. Tyco Industries Inc.* [1988] 16 R.P.C. 343 and *Interlego A.g. Vs. Alex Folley (Vic) Pty. Ltd.* [1987] F.S.R. 283 holding that a designing designs toys is expected to have the question of appeal of the toy to the eye, even in the case of a functional toy—a design has to be such that the article to which it is applied makes an immediate visual appeal to the person buying the same. The counsel thus contended that merely because the cut/aperture in the Eye Drape is functional, does not make it any less appealing to the eye.

8. On a consideration of the pleadings, documents and contentions, I remain of the opinion that the design claimed by the plaintiff does not qualify as a ‘design’, as defined in Section 2(d) of the Designs Act and which is a ground provided in Section 19 of the Act for seeking cancellation of registration of a design and which is also a defence available under Section 22(3) of the Act to an action for infringement. I am further of the view that if the Court, at the outset, itself finds so, the Court is not compelled to admit the suit and wait for the defendants to take such a defence under Section 22(3) of the Act. A plaintiff approaching the Court for infringement of a design, before having the suit admitted, has to satisfy the Court that the design is new or original or is registrable under the Act and which the plaintiff in the present case has failed to satisfy. It cannot be lost sight of that both the defendants impleaded, are situated outside Delhi

and issuance of summons/notice puts them to inconvenience and expense. Appointment of amicus was considered necessary merely to assist the Court and not to replace the defendants.

9. The Registration Certificate No.291915 in favour of the plaintiff comprises of two sheets showing the front view and the back view of the design as under:



and with both sheets having the following endorsement:

“ENDORSEMENT OF NOVELTY

*The novelty resides in the shape & configuration of **SURGICAL EYE DRAPES** as illustrated.*

ENDORSEMENT OF DISCLAIMER

- 1. No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism whatever or in respect of any mode or principle of construction of the article.*
- 2. No claim is made by virtue of its registration in respect of colour or colour combination appearing in the design.*
- 3. No claim is made by virtue of registration to any right to the exclusive use of words, trademarks/name, letters and numerals appearing in the design.*
- 4. No claim is made with regard to extraneous matter appearing in the design.”*

10. The Registration Certificate No.291917 also comprises of two sheets showing the front view and back view as under:





and both sheets with same endorsement as aforesaid minus the word ‘SURGICAL’

11. The actual product, which the counsel for the plaintiff during the hearing handed over, comprises of a blue colour sheet of **non-woven sms** material admeasuring 80 cm X 70 cm and with a rectangular slit admeasuring 7 cm X 9 cm thereon with a transparent plastic pouch admeasuring 19 cm X 16.5 cm pasted thereon with a cello tape.

12. The plaintiff, not only in the application for registration did not state, though could have, the novelty claimed, in the plaint also has not pleaded so except for stating as already recorded in one of the orders reproduced above, that “the sheet of the plaintiff comes with a pre-cut aperture from where the surgeon can operate and further comes with an attached pouch in which the fluids draining out from the eye during the eye surgery can be collected. On enquiry, as to what is otherwise being used during eye surgeries, the counsel for the plaintiff states that the surgeon covers the face of the patient with any sheet available and cuts an aperture therein and

keeps a beaker or a pouch to collect the fluids flowing out of the eye during the eye surgery.” However, the cut or aperture with which the Eye Drape of the plaintiff comes has no element of a design within the meaning of Section 2(d) of the Act. It is not as if the cut or aperture has any peculiar eye catching boundaries. The cut/aperture is in a straight-line.

13. The emphasis in the arguments of the counsel for the plaintiff also, was on the utility to the Ophthalmologist of the Eye Drape with a pre-cut, again meaning that the feature of the product in which the plaintiff claims novelty is a functional feature and which will be bought by the consumers thereof owing to the functional utility thereof instead of owing to the beauty as aesthetic or eye catching nature. The plaintiff, in the plaint also, in para 3 has described himself as engaged in inventing new products “which can meet out the emerging need of the Ophthalmologists”. In fact, the plaintiff in the plaint has pleaded having applied for registration also as a patent.

14. Thus, as per the admission of the plaintiff himself, there is no novelty. The plaintiff admits that the pre-cut or aperture provided by him in his Eye Drape, if were not to be there, would be made by the Ophthalmologist or his paramedic at the time of surgery. Thus, all that the plaintiff has done is that instead of the cut/aperture being made in the course of the surgery, the Eye Drape is coming with an already existing cut/aperture. The same is an admission of there being nothing novel in the cut or aperture.

15. In my opinion, therefore, there is nothing non-obvious, novel or unique in terms of shape, size, configuration, pattern and composition of

lines in the Eye Drape of the plaintiff, save for the functional utility of not requiring the Ophthalmologist or the paramedic to, before using the same, make a cut or an aperture therein for accessing the eye-socket to be operated upon. A functional shape and configuration which is dictated solely by functionality is not registrable under the Designs Act as a design. Once, the overall appearance is dictated by function, it cannot be registered as a design and the registration, if any, is invalid. This is not a case where some features of a design may have a functional purpose. Here, as aforesaid, the design of 'pre-cut' is only functional and has no ornamental value.

16. The suit thus fails and is dismissed.

17. No costs.

18. Decree sheet be drawn up.

The Court expresses its gratitude to Mr. Ankit Jain, Amicus Curie/Advocate for the useful assistance rendered.

RAJIV SAHAI ENDLAW, J.

MAY 28, 2018

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(corrected & released on 13th June, 2018)