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

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Date of Order: 26.02.2019

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F.A.O. No.75/2019 & C.M. Nos.8780-8781/2019

KENT RO SYSTEMS LTD & ANR Appellants

Through: Ms. Rajeshwari H. & Mr. Kumar
Chitranshu, Advocates.

Versus

VIKRAM JEET & ANR Respondents

CORAM:

HON'BLE MR. JUSTICE VINOD GOEL

ORDER

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26.02.2019

F.A.O. No.75/2019 & C.M. No.8780/2019 (for stay) & C.M. No. 8781/2019 (for appointment of Local Commissioner)

1. The impugned order dated 20.02.2019 passed by the court of learned Additional District Judge-02, West District, Tis Hazari Courts, Delhi ('ADJ') in Civil Suit being TM No.08/2019, dismissing two applications of the appellants/plaintiffs; one under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 ('CPC'), and another under Order XXVI Rule 9, is the subject-matter of challenge in this appeal.

2. As per the factual matrix, the appellants' company has been in the business of manufacturing and selling Mineral RO Water Purifier System since the year 1999. The appellant No.2 is the Chairman-cum-Managing Director and proprietor of the registered design forming the subject-matter of the suit. They have been manufacturing and selling several products including water purifiers, air purifiers, vegetable and fruit purifiers, water softeners and automatic water pressure boosting systems, etc., in India and abroad under the mark KENT. The appellant No.1 is one of the market leaders in the sector and all the business activities are undertaken by them under the trade name KENT. The appellants also hold copyright in respect of the logo and label KENT. The product KENT has become synonymous with offering purity and durability and is known for its technological performance and innovative path breaking technologies and attractive designs. It is claimed that appellant No.1 ranks amongst the major water purifier companies in India and amongst the first in the sector in India.
3. The appellant No.2 has invested time, money and effort and created new and aesthetic designs for water purifiers. The designs created by him are novel, unique and eye-catching/eye-appealing. On 19.05.2014, he was granted the design registration No.262661 for the product forming the subject-matter of the suit. It is claimed that uniqueness of the design lies in the provision of an almost rounded body with provision

of transparent indicator as well as the overall appearance of the product. The registered design has been licensed to appellant No.1 by appellant No.2. It is pleaded that on account of registration of the said design, no person can use the same either for manufacture of cabinets or for finished products (purifiers) or in any other manner, including sale, etc.

4. The appellants claimed that their products including the product KENT PRIME TC have become trendsetting due to their unique design, unmatched and remarkable quality coupled with high efficiency and cost effectiveness. Its products have been used continuously, extensively and exclusively throughout India and abroad on a very large scale and the products sold under the said mark have resultantly acquired a reputation of being extremely sound and reliable by virtue of adherence to strict quality standards maintained by them. The appellants have given the sale figures of their product under the mark KENT PRIME TC during the financial years from 2014-15 to 2017-18, as under: -

KENT PRIME TC		
Year	Sales in quantity	Sales in value in Rs. Lacs (Approx.)
2014-15	7079	1380.40
2015-16	11270	2197.65
2016-17	10988	2142.66
2017-18	8070	1573.65

5. The appellants pleaded that they have won several awards and accolades including:

- i. Asia's Most Promising Brand-Kent RO -2012-2013;
- ii. Asia's Most Promising Leader (Mahesh Gupta-Chairman-Kent RO) 2012-13;
- iii. Child Most Popular Award 2013- Most Popular Safe Water Equipment' by Child Magazine in the year 2013;
- iv. Best Domestic Water Purifier- Distinguishable Water Purifier-Kent Pearl (Reverse Osmosis) - 2012, The water Digest supported by UNESCO;
- v. Best Commendable Water Purifier Non Electric- Kent Gold-2012, the water Digest supported by UNESCO;
- vi. India's most admirable consumer durable brand- 2011, awarded by 4P's;
- vii. Excellence Award, 2008;
- viii. Best Domestic Water Purifier RO-UV 2006-2007, The water Digest supported by UNESCO;
- ix. Best Domestic Water Purifier RO-UV 2007-2008, The water Digest supported by UNESCO;
- x. Indian Most Trusted Brand Consumer Validation, 2015;
- xi. The Admired Brand of Asia, 2015;
- xii. Best Domestic Water Purifier Asia Water Leadership Awards, 2015;
- xiii. Asia's most Promising Brands validate by Consumers & Industry-2014;

6. The appellants pleaded that the defendant is the proprietor of M/s. Jet Aqua Filtration Company which is in the business of manufacture and sale of water purifiers, cabinets and spare parts of water purifiers. Further, he claims that the respondents are infringing upon their registered design No.262661 by selling their product under the mark JET AQUA JIO and JET AQUA SUPERLINE. The appellants claimed that the respondents have been selling the said infringing goods with *mala fide* and dishonest intention to ride upon their goodwill and reputation in order to derive unfair gains for themselves.
7. By the impugned order, the learned ADJ while dismissing the application under Order XXXIX Rule 1 and 2 CPC observed as under:-

*“7. I had an occasion to closely examine the products of both the parties and find myself unable to agree with the submissions made by Ld. Counsel for plaintiff. There are wide and clear differences between the two products with almost nil or little similarity **except in the shape of cabinet where some resemblance can be observed.** The products are quite different from each other without there being any likelihood of practice of deception upon the intending purchasers and therefore in my view the designs/product of the defendant do not infringe the designs of the plaintiff company. **Water is almost always associated with blue colour, therefore, it is but natural for both the parties to use white and blue colour on the designs of their products.***

*8. Therefore, I am of the prima facie view that the sale of water purifier by the **defendant is not even likely to dilute the brand of plaintiff and adversely affect the***

*sale of its products. Therefore, I am not inclined to grant ex-parte interim injunction in favour of the plaintiff as sought for restraining the defendants from manufacturing/selling/advertising/dealing in any water purifier under the marks **JET AQUA JIO** and **JET AQUA SUPERLINE** as they are not in any way deceptively similar to the plaintiff's products **PRIME TC KENT** nor infringed plaintiff's design no. **262661**, as seen prima facie at this stage."*

8. Learned counsel for the appellants has brought their own product and the impugned products of the respondents for the court to examine. The product of the appellants, from the perspective of an ordinary consumer and in a purely non-technical terminology, could be said to have been designed to be divided in two halves, wherein the upper transparent part of the body of the water purifier is separated from the opaque lower part of the body of the purifier. The product of the respondents i.e. JET AQUA JIO, which is allegedly an imitation of the Appellants' product, is also designed in a similar manner wherein the upper transparent part of the product is separated from the lower opaque part. This design wherein the body of the purifier is divided into two halves stands at the forefront of an analysis that would require this Court to look into the design, shape and configuration of the products in question. While analyzing an infringement of the design the color scheme of the products and 'brand' of the parties has no relevance.
9. The court does not find any *prima-facie* similarity in the shape, design and configuration of the other product of the respondents

i.e. JET AQUA SUPERLINE and the Ld. Counsel for the does not press relief in respect of JET AQUA SUPERLINE.

10. The law in regard to similarity, which constitutes infringement and consequently attracts an order of injunction has been explained by this court in *J.N. Electricals (India) v. President Electricals*, ILR 1980 (1) Delhi 215 wherein it was explained that the 'sameness' of features does not necessarily mean that the two designs must be identical on all fronts and should differ on none. They have to be substantially the same. It was reiterated by this Court in *Alert India v. Naveen Plastics*, 1996 SCC OnLine Del 710 and the relevant paragraph reads as under:-

"35. 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."

11. Further, the Calcutta High Court, in the case of *Castrol India Ltd. v. Tide Water Oil Co. (I) Ltd.*, 1994 SCC OnLine Cal 303 canvassed the meaning of the word 'imitation' as it has been understood judicially over the years in cases of design infringement. The said Court while relying on a plethora of cases came to the conclusion that the word 'imitation' does not mean 'duplication' in the sense that the copy complained of need not be an exact replica and that the Court while contrasting

the impugned design with the registered design must view the article in its totality. Therefore, the test, as laid down by the court, is that the two products must be compared and contrasted with the features of shape and configuration shown in the totality observable from the representation of the design as registered and then decide if the design adopted by the defendants is substantially different from the registered design. The Court added that in order to decipher, if it's a case of substantial infringement, the Court must look into the aspect of whether the impugned design is an 'obvious' or 'fraudulent' imitation. The said court while referring to the case of *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd.*, (1931) XLVIII RPC 268 set out the distinction between 'obvious' and 'fraudulent' imitation. The Court observed that “‘obvious’ means something which, as soon as you look at it, strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.” whereas “fraudulent imitation seems to me 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". Thus, the scope of design infringement is not just limited to cases of 'obvious' imitations but also includes cases where the imitation is cleverly and deviously made.

12. On a *prima-facie* view of the product of the appellants and that of the respondents (JET AQUA JIO), the Court observed that the two products have been designed similarly whereby the upper transparent part of both the purifiers/cabinet is separated by the lower opaque part. On a closer examination, it is found that the wavy shape of the transparent part of the appellants' cabinet/purifier has been imitated by the respondents while designing their product. This Court also observes that the upper part of the appellants' cabinet/purifier appears to be crowned on the lower part with the help of a rectangular tape-like connector. This connector that runs around the body at the point where the upper body and the lower body connect is exactly the same in both the cabinet/purifiers in terms of shape and configuration. On the right-side and left-side of the appellants' product, at the point where the transparent part joins the opaque part, the inside part, which is visible, appears to have been cut in the form of a right-angle triangle on both the sides and the respondents too

have designed the cut on either side of their product in the exact same fashion. Even the curves on the top-right and top-left sides of the respondent's product are similar to that of the appellants. Additionally, the appellants have placed the water-level indicator on the lower-opaque part of their purifier distinctly in the sense that there is a distinctive bulge in the area surrounding the water-level indicator and the respondents too have, on their product, very cleverly tried to place their water-level indicator with a surrounding bulge. Further, on the left side of both the products (when viewed from the front side) a provision for inlet and outlet of water has been provided and the manner of cutting the transparent sheet around the inlet and outlet points is exactly the same in both the purifiers. Though, the shape of the bottom of the impugned product is not rounded at both corners like in that of the appellants' product, yet, the rest of the cabinet/body of the purifier of the respondents when viewed in totality has substantial resemblance and imitation with the shape and configuration of the appellants' product. The respondents have deviously tried to tweak the design of their product by nominally increasing the size of their product and by cutting their transparent sheet in a 'U' shape in the middle but that doesn't suffice, in the eyes of this court, as substantial change. This court finds substantial resemblance in the design, shape and configuration of the cabinets/purifiers of the appellants and of the respondents.

13. This Court in the case of *Kama Ayurveda Private Limited v. RWL Helathworld Ltd. & Ors.*, 2018 SCC OnLine Del 12685 held that 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.
14. At the stage of considering the application for grant of ex-parte temporary injunction, the court is required to examine as to whether the plaintiff has a prima-facie case; whether the balance of convenience of the case is in his favour; and whether the non-grant of ex-parte temporary injunction would cause an irreparable loss and injury to the plaintiff.
15. *Prima facie*, the appellants have been able to show that the appellant No.2 was granted registration of the design No.262661 on 19.05.2014 in respect of shape and configuration of the cabinet for the water purifier. The appellants have *prima-facie* shown that the respondents have infringed upon their registered design substantially in their product which is being manufactured and sold by them under the name and style, JET AQUA JIO.
16. The appellants have *prima facie*, established their reputation and goodwill in the business which is reflected from the sale figures for the last more than four years. The adoption of the design of the appellants by the respondents would undoubtedly cause irreparable loss and injury if the respondents are not

restrained from continuing their offending acts. The balance of convenience, in the interest of justice and equity, lies in favour of the appellants. Of course, the public at large may be literate or semi-literate but by virtue of the adoption of the said registered design of the appellants by the respondents, any person with ordinary prudence, would be persuaded to believe that the said products of the respondents are associated with that of the appellants. It also appears to the court that if ex-parte temporary injunction is not granted to the appellants, they shall suffer irreparable loss and injury. The court is of the view that the order passed by the learned ADJ dismissing the ex-parte ad-interim injunction application is not sustainable in law. As such, the impugned order dated 20.02.2019 declining the ex-parte ad-interim injunction to the appellants against the respondents from adopting and selling their product by imitating the product of the appellants is set aside. Accordingly, the respondents, its agents, partners, servants, associates, assigns, representatives, successors, distributors and others acting for and on his behalf, are hereby restrained from using the appellants' registered design for manufacturing, selling, offering for sale, advertising or displaying, directly or indirectly or dealing in any other manner or mode in its products or business till the disposal of the application under Order XXXIX Rule 1 and 2 read with Section 151 CPC on merits after hearing both the parties.

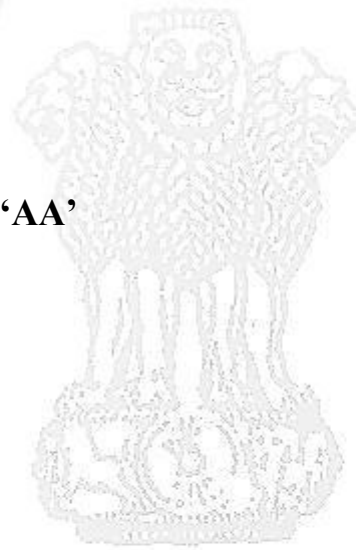
17. Compliance of Order XXXIX Rule 3 CPC be made by the appellants.
18. The trial court shall dispose of the application under Order XXXIX Rule 1 and 2 CPC after hearing both the parties on merits without being influenced by the observation of this court in this order.
19. The appeal along with application, being C.M. No.8780/2019, is disposed of accordingly.
20. The appellants seek appointment of a Local Commissioner. Learned counsel for the appellants submits that there are two shops as reflected from the memo of parties from where their design is being misused by the respondents.
21. In view of the above said reasons, this court considers it appropriate to appoint Mr. Desh Raj Chaudhary, Deputy Registrar (Mobile No.9650197473) of this court as Local Commissioner.
22. The Local Commissioner is directed to visit the premises of the respondents, and to take into custody all the incriminating material including the bill books, stationary items, vouchers, carry bags, the impugned and infringed designs and cabinets/water purifiers imitating the designs of the appellants.
23. The Local Commissioner shall be empowered to have the assistance of the SHO of the area concerned, if so required. In case such assistance is asked for by the Local Commissioner, the same shall be provided forthwith by the concerned SHO.

The respondents are also directed to cooperate with the Local Commissioner. The representatives of the appellants are also allowed to assist the Local Commissioner. The Local Commissioner shall be paid a fee of Rs.1,00,000/- apart from the actual expenses. He shall file his report in the Registry which shall be transmitted to the trial court immediately.

24. The application, being C.M. No.8781/2019, stands disposed of.
25. *Dasti* under the signature of the Court Master.

FEBRUARY 26, 2019/‘AA’

**(VINOD GOEL)
JUDGE**



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