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

% *Judgement Reserved: 2nd November, 2018*
Judgement Pronounced: 28th May, 2019

+ **FAO (OS) (COMM) 29/2018**

PENTEL KABUSHIKI KAISHA & ANR. Appellant
Through: Mr. Chandar M. Lall, Sr. Advocate
with Mr. Saurabh Banerjee, Mr.
Afzal B. Khan, Mr. Debjyoti Sarkar,
Mr. Rupin Bahl and Mr. Bikram
Singh, Advocates.

versus

M/s ARORA STATIONERS & ORS Respondents
Through: Mr. Shailen Bhatia and Ms. Neelam
Pathak, Advocates.

CORAM:

HON'BLE MR. JUSTICE G.S.SISTANI

HON'BLE MS. JUSTICE SANGITA DHINGRA SEHGAL

G.S.SISTANI, J.

1. The present appeal has been filed under section 13 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015, read with order XLIII Rule 1(r) and section 151 of the Code of Civil Procedure, 1908 ('CPC') impugning the order dated 08.01.2018 passed by a Single Judge of this Court whereby the application of the appellants bearing I.A. 6056/2017 under Order XXXIX Rule 1 and 2 read with Section 151 of CPC in CS (Comm) 361/2017 has been dismissed.
2. The suit was filed by the appellants against the respondents alleging imitation of the design of appellants' ball point pen. Some necessary facts required to be noticed for disposal of this appeal are that

appellant no.1 had developed a design for a pen, which was registered in India as Design No.263172 ('172 design') dated 10.12.2013 claiming priority from its Japanese Design No.1515380. The said design was applied by the appellants to its Energel series of pen, in particular Pentel Energel BL-417, and was launched in India in August 2014.

3. It was alleged that in the month of October, 2016, the appellants came across the respondents' product 'Montex Mastani', which is alleged to be similar to the appellants' 172 design. Pursuant to the same, the appellants addressed a cease and desist letter dated 22.10.2016 to the respondent no.2. The respondents no.2 and 3, responded to the said communication vide letter dated 21.11.2016 on the common ground challenging the validity of appellants' 172 design. The appellants responded to the statements of the respondents no.2 and 3 vide letter dated 17.01.2007.
4. It is the case of the appellants that the respondents no.2 and 3 continued marketing, manufacturing and distributing the impugned product, i.e. Montex Mastani pens. In February, 2017, the appellants came across the respondent no.1, who was selling and distributing the respondents Montex Mastani pens. Thereafter, the appellants instituted suit bearing CS (Comm) 361/2017 against the respondents alleging fraudulent and slavish imitation of the appellants' rights in the 172 design along with I.A. 6056/2017 seeking an *ex parte* interim injunction restraining the respondents from manufacturing or trading in pens imitating the appellants' 172 design. When the matter came for hearing before the Single Judge, the Single Judge noticed the total

similarity between the products of the parties, however, refrained from passing any *ex parte* orders allowing the respondents to present their case.

5. On 26.05.2017, the counsel for the respondents appeared and contended that there was no novelty in the design of the appellant. The said contention was turned down by the Single Judge holding that the respondent no.3 itself having “*obtained registration of design of a writing instrument*” could not contend so and proceeded to grant *ad interim* orders against the respondents herein.
6. The respondents no.2 and 3 filed their written statement contending that they are also engaged in the business of manufacturing and marketing stationary items including ball pens. In para 7, they have detailed numerous trademark registrations obtained by them and claim their trademark ‘Montex’ to have become well-known. They also claim to have obtained registration of various designs in respect of pens/writing instruments. In response to the 172 design, the respondents contended that the said design was not new or novel, but a combination of various pre-published designs of the respondents sold under the trademarks Montex Melody, Montex Addict, Montex Liner, Montex Ferrari, Montex Haiwa and Montex Easy Flow. The respondents claimed that the 172 design was a mere combination of designs of pens already being manufactured by them.
7. During the pendency of the suit, respondent no.2 secured registration of the impugned design under registration no.282909 and accordingly, filed IA 646/2018 seeking amendment of the written statement. By

the said application, *inter alia* the following paragraph was sought to be inserted:

“13. That the Defendant is holding registration of the design which is complained by the Plaintiff under no.282909 in class 19-06 and the application was filed prior to the filing of the suit i.e. on 26.04.2016. The Design of the Defendant is valid and subsisting and the Defendant may be allowed to use the registered design. The Defendant seek to use the design which is subject matter of the said registration as the Controller of Designs after examining the factual positions has granted the registration to the Defendant’s design which is different from the Plaintiffs alleged registration.”

8. Thereafter, after hearing both the parties, the Single Judge finally dismissed the application vide order dated 08.01.2018 and vacated the interim order passed on 26.05.2017. The Single Judge after analysing the provisions of the Designs Act observed that one of the defences available to the defendants is that the design of the plaintiffs is not substantially novel. The Single Judge then proceeded to analyse the claim of novelty of the plaintiffs (appellant before us) and after examining the features alleged to be novel by the plaintiffs held that the same were not substantially new or original to have protection under the Designs Act. We deem it appropriate to reproduce the relevant portion herein:

“19. In the opinion of this Court the issue which arises squarely is whether paras 11 and 12 of the plaint which contain the cause of action of the plaintiffs of creation of features of designs and thus the ball point pen of the plaintiffs as a whole being entitled to exclusivity of the registered design yet the plaintiffs will have to satisfy this Court that the plaintiffs’ registered design of the ball point pens satisfies the requirements of newness and originality with the fact that the

so called newness or originality is not such so as not to be significantly distinguishable from the known designs features.

20. I must begin this reasoning portion by stating that a ball point pen is a ball point pen i.e every ball point pen normally has a refill with a nib, the refill is put in a lower casing called a barrel, over the barrel containing the refill and the nib there is a cap which is put, and such a cap obviously has a clip in order to fix/attach the ball point pen in the clothing of persons. In sum and substance therefore every ball point pen has common features of a lower casing/barrel in which lower casing/barrel there is a refill, the refill exists with a ball point pen nib, the cap covers the ball point pen nib portion with additional portion of the lower casing/barrel, and finally that the cap ordinarily contains a clip. In order for a design to be totally a new and original design with respect to a ball point pen, there will have to be significantly distinguishable features so as to make the ball point pen of which exclusivity and continuation of the registration is claimed by the plaintiffs, that such is a completely new and original ball point pen and that there is enough/substantial novelty and originality by application of labour whereby the ball point pen of the plaintiffs is distinguished from the aforesaid known features/designs in a ball point pen. When the facts of this case on the features and design of the ball point pen of the plaintiffs is examined along with ratios of the judgments of the Division Bench of this Court in the case of M/s B. Chawla and Sons (supra) and that of the Supreme Court in the case of Bharat Glass Tube Limited (supra), in my opinion the fact that the cap of the plaintiffs' ball point pen is alleged to be unique because of wedges at the point of holding of the ball point pen or the barrel is polygonal or there exists slightly curved tip or that barrel/lower casing goes into a knob etc are only trade variants and such features really cannot be said to be in my opinion such newness or originality so as to distinguish these features from the known shape or the different features which already exist in a ball point pen. The features given in para 11 of the plaint which are claimed to be unique and new are not such that it can be held that the

features in themselves or taken with other features will make the ball point pen of the plaintiffs as a completely unique new design having that much originality so as to be significantly distinguishable from the known features/design of a ball point pen. In fact the wedges in the grip portion in my opinion is in fact a functional feature because this wedges design created is for a better grip and in order to ensure that there is proper grip of the pen resultantly this being a mode or principal of construction applied with respect to a ball point pen and for ensuring a better grip of the ball point pen and which because of Section 2(d) of the Act defining design cannot be protected as a design.

...

22. In the opinion of this Court, this Court does not even have to go to the facts as stated by the defendants in their written statement of their having used the features claimed by the plaintiffs as unique/new features in the ball point pens of the defendants which are already in existence in earlier manufactured ball point pens by the defendants in different years from the year 2005 inasmuch as firstly the plaintiffs have to satisfy this Court that the design of which exclusivity and ownership is claimed by the plaintiffs is a completely new and original design and is not as to be containing mere variations or trade variants or some or the other differences from the known designs already existing in a ball point pen. In this regard, in the opinion of this Court, the plaintiffs have miserably failed of showing substantial newness/originality as required by the definition and meaning of newness and originality as stated in the Division Bench judgment in the case of M/s B. Chawla and Sons (supra) and the judgment of the Supreme Court in the case of Bharat Glass Tube Limited (supra), relevant paras of which are reproduced above.

(Emphasis Supplied)

9. Aggrieved by the said order of the Single Judge, the present appeal has been preferred by the appellant.
10. Mr.Lall, learned senior counsel for the appellant submitted that the Single Judge erred in appreciating the law relating to the design Act as

the intended subject of the protection is the novelty and originality of the design and not the article. He relied upon the judgments in *Asian Rubber Industries v. Jasco Rubbers*, 2013 (53) PTC 495 (Bom) (paras 14-17); *Harrison v. Taylor*, 157 ER 1064 (1859) (at pages 817-821); *Farmers Build Ltd. v. Carier Bulk Materials Handling Ltd.*, (1999) RPC 461 (at page 483). It was further submitted that the Single Judge has applied arbitrary standards of novelty and originality by applying standards of novelty applicable under patent law. As per Mr.Lal, the established standards while assessing the validity of the suit design is that of sufficient or enough novelty and originality as opposed to “complete” or “total” novelty. Owing to the incorrect standard applied by the Single Judge, the Single Judge has come to a conclusion regarding the lack of novelty or originality without comparison with any other design of the same field. Reliance was again placed on *Farmers Build Ltd. (Supra)* (at Pages 475-477 and 482).

11. Learned senior counsel further contended that the Single Judge erred in holding that “*a ball point pen is a ball point pen*”. He submitted that the subject matter of protection is the design of the article and not the article itself. According to him, the development of a completely new ball point pen fell within the domain of patent law.
12. Learned senior counsel next contended that the approach of the Single Judge to dissect each alleged novel features and then adjudge their novelty in isolation was impermissible. The design should be examined as a whole. It was contended that the mosaicing of suit design is not permitted and an attack on novelty can only succeed if

the design is disclosed as a whole in a single prior document. Similarly the approach of the Single Judge to isolate the grip portion and hold it to be functional was incorrect as the desired functionality could be achieved through multiple aesthetic methods. Reliance was placed on *Reckitt Benkiser India Ltd. v. WYETH Ltd.*, AIR 2013 Del 113 (para 21); *Videocon Industries Limited v. Whirlpool of India Limited*, 2012 (6) BomCR 178 (paras 14-16); *Cello Household Products v. Modware India*, 2017 (70) PTC 325 (Bom) (paras 17-18 and 28-31); *Whirlpool of India Ltd. v. Videocon Industries Ltd.*, 2014 (60) PTC 155 (Bom) (paras 39-43); *Faber-Castell Aktiengesellschaft v. Cello Pens Pvt. Ltd.*, 2016 (1) BomCR 129 (paras 8, 13, 14, 16-20 and 25); *Selvel Industries v. Om Plast (India)*, 2016 (67) PTC 286 (Bom) (paras 32-34, 36-37 and 42); and *Cow (P.B.) & Coy Ltd. v. Cannon Rubber Manufacturers Ltd.*, (1959) RPC 240 (at pages 243-246).

13. Mr.Lal contended that the finding of the Single Judge that the individual features were not novel was incorrect. He submitted that the features individually as well as the suit design as a whole was not commonplace. It was also submitted that even assuming the individual features were commonplace, the suit design as a whole may not necessarily be commonplace. Mr.Lal placed additional reliance of the decision of the Third Board of Appeal of OHIM (Trade Marks and Designs) in *Société Bic v. Beifa Group Co.Ltd.*, Case R 245/2014-3 dated 08.09.2015 (paras 27-30 and 36-37). Relying upon the said decision, learned senior counsel also submitted that novelty and originality will depend on the nature of the article and the degree of

freedom enjoyed by the designer. The degree of freedom of a designer maybe constrained as result of statutory requirements or technical function of the product or element thereof, which may results in standardization of certain features. The greater the constraint on the designers' degree of freedom, the more likely minor differences will be sufficient to produce a different overall impression.

14. It was next submitted that the respondents themselves having obtained registration of the suit design cannot be allowed to challenge the validity of the suit design of the appellant. Mr.Lal submitted that the respondents had first concealed the factum of respondent no.3 having applied for registration of the impugned design and then got the same registered themselves. It was submitted that the respondents could not be allowed to approbate and reprobate at the same time. Reliance was placed on *Asian Rubber (Supra)* (para 17); *Whirlpool (2014 SB) (Supra)* (paras 42-43); *Proctor & Gamble Manufacturing (Tianjin) Co.Ltd. v. Anchor Health & Beauty Care Pvt. Ltd., 211 (2014) DLT 466* [paras 6(II), 8(m), 10(xviii)]; *Astrazeneca UK Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd., 2012 (50) PTC 380 (Del.)* (paras 20-26); *Dart Industries Inc v. Polyset Plastics Pvt. Ltd., 2018 (75) PTC 495 (Del)* (paras 27-30, 33, 39 and 40); and *Vega Auto Accessories (P) Ltd. v. S.K.Jain Bros. Helmet (I) Pvt., 2018 (75) PTC 59 (Del)* (paras 26-29).
15. It was finally contended by Mr.Lal that the respondents' design being a fraudulent imitation of the suit design, the respondents ought to be enjoined from using the same. He had relied upon the decision in *Castrol India Ltd. v. Tide Water Oil Co. (I) Ltd., 1996 PTC (16) 202*

(Cal) (paras 22-27) to submit that where the design is to be applied to an object of purchase, the assessment has to be made through the eyes of the purchaser.

16. *Per contra*, Mr.Bhatia, learned counsel for the respondents, has supported the decision of the Single Judge and reiterated that the design of the appellant merits cancellation as it is neither new nor original.
17. It was next contended that the appellants having failed to point out any feature in which it claimed a monopoly before the Controller of Designs, could not be allowed to claim monopoly in the cap, grip and barrel of the pen. Reliance was placed on ***Hawkins Cookers Ltd. v. Zaverchand Liladhar Shah*, 2005 (31) PTC 129 (Bom)** (paras 5-7); ***Harish Chhabra v. Bajaj Electricals Ltd.*, 2005 (3) MhLJ 962** (paras 5-6); ***Carlsberg Breweries A/s v. Som Distilleries and Breweries Limited*, 2017 (70) PTC 413 (Del)** (paras 162-169, 178 and 179); and ***Dabur India Limited v. Rajesh Kumar*, 2008 (37) PTC 227 (Del)** (para 11).
18. It was also reiterated that there is no novelty or newness in the design of the appellant and the respondents are merely using features available in its own pens. Mr.Bhatia drew the attention of this Court to the photographs of other products being manufactured under the name Montex Melody, Montex Addict, Montex Easy Flow, Montex Ferrari, Cello Butterflow, Cello Liquiball, Montex Haiwa, Montex Tricon, and Montex Liner.
19. Mr.Bhatia also alleged that the case of the appellant is contrary to the majority view of a Full Bench of this Court in ***Mohan Lal v. Sona***

Paint & Hardwares, 2013 (55) PTC 61 (Del) (FC) (paras 15.1, 16.1, 17, 17.1). He further relied upon paragraph 28 of the minority view reported at 2013 (55) PTC 1 (Del) (FB). Relying upon the said decision, it was contended that the fact that the respondents had also got the same designed registered would be irrelevant. It was finally contended that none of the cases cited by the appellant were applicable to the present case.

20. Mr.Lal in his rejoinder arguments submitted that the *onus* to disprove the validity of appellant's design is upon the respondents. The registration of the appellant's design is a primary proof of the registration under Section 10(4) of the Designs Act. Mr.Lal submitted that the respondents have failed to make out a valid case to challenge the validity of the appellants' registration, instead have surreptitiously obtained similar registration in its name without disclosing it before the Single Judge. Mr.Lal finally contended that the novelty in any design may be of its shape and configuration.
21. We have heard the learned counsel for the parties and gone through the record and the order impugned before us.
22. The designs of the products of the parties are identical and registration for identical designs has been obtained by the parties. The sole defence of the respondents is that the design of the appellants was not substantially new or original and was a mere combination of the features of the pens already available in the market. In such a scenario, in case the design of the appellants is capable of protection under Design law, an injunction must follow. Thus, primary question arising for our consideration is whether the suit design is substantially

novel or original to make it significantly distinguishable from any known shape or features which already exist in ball point pens/writing instruments?

23. The Single Judge has rejected the application of the appellants herein holding that the distinctive features alleged by the appellants were insufficient to pass the test of substantial novelty and originality as required under Sections 4 and 19 read with Sub-section (3) of 22 of the Designs Act. Observing the same, the Single Judge was of the opinion that it was not necessary to go into the facts disclosed by the defendants (respondents before us) in their written statement as the appellants had miserably failed to discharge the *onus* upon them.
24. Though there cannot be any quarrel with the principle that in a suit for piracy of a design, every ground on which the registration of design may be cancelled is available to the defendant as a ground of defence. As per Section 19(1)(d), one such ground is that the design is not registrable under the Act. The prohibitions wherein the designs are not registrable are given in Section 4 of the Act. Sub-section (c) of the said provision states that any design which “*is not significantly distinguishable from known designs or combination of known designs*” is not entitled to registration.
25. However, we are of the opinion that the Single Judge has erred in ignoring the facts disclosed by the defendants as the suit remains a *lis* between private parties. One critical fact ignored by the Single Judge was that during the pendency of the suit, the respondents had also obtained registration of the very same design. Having done so, we are of the opinion that it was not permissible for the respondents to

challenge the design of the appellants on the ground that the design of the appellants was not new or original and thus, incapable of protection under law. The respondents having themselves sought registration of the design, have made a categorical assertion that the design in question is capable of registration, i.e. none of the grounds prescribed in Section 4 are attracted. They cannot be permitted to subsequently do a *volte face* and contend that the design is not registrable as not being new or original.

26. We are fortified in our view by the decision of the Division Bench of the Bombay High Court in ***Asian Rubber Industries (Supra)***, wherein the suit had been instituted alleging piracy of the design of the plaintiff in *paduka* (a type of footwear) and the Single Judge had refused to grant injunction based on infringement of plaintiff's registered design. At the same time, the Single Judge had enjoined the defendants on the basis of passing off. Before the Division Bench, it was contended by the defendants that the plaintiff's registrations had been wrongfully obtained as there was no novelty or originality, the argument was repulsed by the Bench and injunction granted on the basis of registered design holding as under:

"17. What is important to note is that the defendants themselves sought registration of their "look and feel" in Padukas and therefore it is not open for the defendants to say that the plaintiff cannot claim exclusivity. The defendants themselves procured design registration in relation to footwear under design registration No. 223556 in June 2009, which was subsequently cancelled by the Assistant Controller of Patents and Designs on 20th December 2011. In these circumstances it cannot lie in the mouth of defendants to contend that the plaintiff's design is not new or original or there is no novelty. We also find merit in the plaintiff's

contention that there is no footwear in the market having unique features of stud and strap like that of plaintiff. So far as the plaintiff's designs are concerned, novelty lies in the shape, configuration and pattern of the footwear and there is no product in the market having similar design.”

(Emphasis Supplied)

27. Mr.Bhatia had sought to differentiate the decision alleging that in the said case, the defendant's design had already been cancelled by the Controller. We are unable to see any difference the same would make. The principle that where the defendant himself applies for registration cannot subsequently allege absence of originality or novelty remains unaffected by the same. The paramount aspect remains the applying for registration and not the grant thereof.
28. The said view has been reiterated by the Bombay High Court in **Whirlpool (2014 SB) (Supra)** (paras 42-43), wherein it was observed as under:

“42. As held by the Hon'ble Division Bench of this Court (Coram: Mohit Shah, C.J. & Jamdar, J.) in Asian Rubber Industries Ltd. vs. Jasco Rubber Decision dated 6th March, 2012 in Appeal No. 62 of 2012 in Suit No. 371 of 2012 in CROL No. 1 of 2012 in Appeal No. 62 of 2012 2 with Appeal (ST) No. 97 of 2012 in Suit No. 371 of 2012 with Notice of Motion No. 568 of 2012, a Defendant who claims that its design has novelty cannot then contend that prior identical design of another is lacking in novelty. The Defendant therefore can hardly be heard to urge a lack of novelty in the Plaintiff's design since the Defendant themselves claim to be registered proprietors of the design. An attempt is made by the Defendants to distinguish the said decision by submitting that in that case the Defendant had procured design registration in relation to footwear under the Act, which was subsequently cancelled by the Assistant Controller of Patents and Designs and in the alternative by also contending that the decision is per incurium as it failed to take into account

the statutory provisions i.e. Section 22(3) read with Section 19 of the Act. In my view, both the submissions are untenable and cannot be accepted.

43. The Defendant's contention on lack of novelty is therefore untenable and baseless.”

(Emphasis Supplied)

29. Also see the decision of Bombay High Court in ***Kalpesh R.Jain v. Mandev Tubes Private Limited***, 2018 (73) PTC 591 (Bom) (para 19); and the Madras High Court in ***Dart Industries Inc. v. Cello Plastotech***, MANU/TN/1629/2017 (paras 37-38).
30. We may notice the decision of a Single Judge of this Court in ***Vega Auto Accessories (P) Ltd. (Supra)*** which is based on a similar factual matrix as the case before us. The plaintiff therein had instituted the suit alleging infringement of its registered design in helmets. The defendants had also obtained registration of the same helmet and had relying upon certain other products contended that the features of the helmet of the plaintiff were prior published. The said contention was rejected holding as under:

“26. I will first deal with the aspect, whether it is open to the defendant to oppose the interim injunction on the ground of invalidity of the design of the plaintiff and/or on the ground that the design of the plaintiff has been prior published.

...

28. I am unable to find any reason why the said principle of general law should not be made applicable to a defendant in a suit for infringement of design. Though there is a essential difference in registration of a trade mark and registration of a design i.e. while registration of a trade mark vide Section 31 of the Trade Marks Act gives rise to a presumption of validity of registration, it is not so qua registration of a design which as per Section 10(4) of the Designs Act is prima

facie evidence only of the matters directed or authorised to be entered in the Register, however the reason which prevailed in the judgments aforesaid was not of prima facie validity of the registration of trade mark. The reason which prevailed in the judgments aforesaid was, that if a party has taken up a specific stand at a particular stage of the Court proceedings, it should not be open for him to take a contrary position at a subsequent stage of litigation or in a different proceeding. The Full Bench of this Court in Rajneesh Kumar Singhal Vs. The State (National Capital Territory of Delhi) 89 (2001) DLT 511 held that the said principle serves well as it does not allow a litigant to blow hot and cold at successive stages of the same litigation or another litigation. It was held to be an elementary rule, that a party litigant cannot be permitted to assume inconsistent positions in Court, to play fast and loose, to blow hot and cold, to approbate and reprobate, to the detriment of his opponent. This wholesome doctrine was held to apply not only to the successive stages of the same suit, but also to another suit than the one in which the position was taken up, provided that the second suit grows out of the judgment in the first.

...

30. Another contention of the counsel for the defendant in this respect however remained to be recorded above. It was the contention of the counsel for the defendant that unlike under the Trade Marks law, under the scheme of Designs Act there is no requirement on the applicant for registration of a design to make an averment of the design being novel or new and having not been pre-published and no such declaration is required to be made in the forms prescribed for an application for registration of design.

31. I am however of the view that, notwithstanding the same, once an application for registration is made, in the light of the prohibition contained in Section 4 of the Designs Act that a design which is not new or original or which has been disclosed to the public anywhere in India or in any other country by publication or which is not significantly distinguishable from known designs or combination of known designs, shall not be registered, it is implicit that the

applicant for registration is making a declaration of the design of which registration is sought not falling in any of the clauses of Section 4 of the Act. In fact, the counsel for the defendant also subsequently stated that the prescribed form requires a declaration of newness and originality to be made.

32. Once, an applicant has claimed his design to be new or original and having not been prior published and being distinguishable from known designs, he cannot oppose the claim for infringement by a prior registrant, if his design is identical to that of the prior registrant, by contending that there is no newness or novelty in the design of the plaintiff and/or that the design of the plaintiff was prior published.

33. I therefore hold that the plea, of invalidity of registration of design of the plaintiff is not open to the defendant. The defendant having itself obtained registration of the impugned design; if the impugned design is found to infringe the design of the plaintiff registered prior to registration in favour of defendant, is estopped from taking the plea of invalidity of registration in favour of plaintiff.”

(Emphasis Supplied)

31. Similar view has been taken by another Single Judge of this Court in ***Dart Industries Inc (Supra)*** (paras 27-29).
32. We may note that such principle has also been consistently applied by this Court in respect of trademarks. Reference may be made to the decisions in ***Automatic Electric Limited v. R.K. Dhawan***, (1999) 77 DLT 292 (para 16); ***Indian Hotels Company Ltd. & Anr. v. Jiva Institute of Vedic Science & Culture***, 2008 (37) PTC 468 (Del) (DB) (para 40); ***Astrazeneca UK Ltd. (Supra)*** (paras 20-26); and ***Proctor & Gamble Manufacturing (Tianjin) Co.Ltd. (Supra)*** [paras 6(II), 8(m), 10(xviii)] and we find no reason as to why it should not apply to cases of piracy of designs.

33. Learned counsel for the respondents had relied upon the decision of the Full Bench of this Court in ***Mohan Lal (Supra)*** to contend that the said decisions are contrary to the majority opinion therein. In particular, the following passages were referred to by Mr.Bhatia:

“17.1 ...The suit for infringement seeks to assert the monopoly rights of the plaintiff based on the uniqueness, newness and the originality of his design qua the defendant registrant. The entry by the Controller of Designs in the Register of Designs, in our view, is only a prima facie evidence of any matter so directed to be done by the Designs Act or authorised to be entered in the Register of Designs. See Sections 10(4) and 38 of the Designs Act.

18. ...There is, thus, a marked difference in the language as contained in Sections 10(4) and 38 of the Designs Act as compared to Section 31 of the Trade Marks Act, which speaks of prima facie evidence of validity, once a trademark is registered.”

34. We are unable to accept the submission of Mr.Bhatia. It is settled law that every decision must be read in the context of the questions arising therein [See ***Krishena Kumar v. Union of India***, (1990) 4 SCC 207; ***Commissioner of Income Tax v. Sun Engineering Works (P) Ltd.***, (1992) 4 SCC 363; and ***Vidur Impex and Traders Pvt. Ltd. v. Pradeep Kumar Khanna***, 241 (2017) DLT 481]. Hence, the said passages cannot be read in isolation. The said observations were made by the Full Bench while deciding the following issue:

“I. Whether the suit for infringement of registered Design is maintainable against another registered proprietor of the design under the Designs Act, 2000?”

35. The issue before us was not even remotely being considered by the Full Bench and thus, the said decision cannot come to the aid of the

respondents. Even otherwise, the effect or presumption raised upon registration is not relevant to the present decision. What is relevant is the representation made by a party while applying for registration of a design. While doing so, a party necessarily represents that the design is capable of registration and thus, not hit by any prohibition under Section 4 of the Act including it not being significantly distinguishable from known designs or combination of known designs. The same is based on the maxim *quod approbo non reprobo* as any party to a litigation cannot be allowed to approve and reject or blow hot and cold at the same time.

36. Accordingly, the challenge of the respondents on the ground of lack of novelty/originality must fail. The other defences raised by the respondents must also be rejected for the very same reason. Having themselves applied for registration of the design, the respondents cannot raise the plea that it is merely a combination of known designs and thus, cannot be granted protection under the designs law.
37. Having held so, we find that the respondents have introduced their pen under the name Montex Mastani being identical to the registered design of the plaintiffs (appellants before us) and in such circumstances, a *prima facie* case of piracy is made out.
38. We also observe that when the written statement was filed by the respondents no.2 and 3 on 10.07.2017, the same was silent regarding the application for registration of design even though it had already been filed in April, 2016. It was only after the said registration was granted that the respondents disclosed the fact to the court by filing an

application seeking amendment of the written statement. Such conduct of the respondents must be deprecated.

39. The appeal is allowed and the impugned order dated 08.01.2018 is set-aside. The respondents, their partners, agents, proprietors, servants and/or all those actively in concert with them are restrained from manufacturing or marketing the pen/writing instrument under the name 'Montex Mastani' or any other name infringing the registered design no.263172 of the appellants during the pendency of the suit [CS (Comm) 361/2017] before the Single Judge.
40. We further clarify that all observations made in this order are in the context of a *prima facie* view and nothing should be construed as a final expression of opinion on the merits of the dispute. Nothing stated herein should be read to prejudice the claims/contentions of the parties in the trial of the suit.
41. In view of the order passed in the appeal, CM 6193/2018 is rendered infructuous and as such, is disposed of.

G.S.SISTANI, J.

SANGITA DHINGRA SEHGAL, J.

MAY 28th, 2019

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