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

Decided on: 12th May, 2021

+ **I.A. 647/2018 IN CS (COMM) 90/2018**

M/S KAMDHENU LIMITED

..... Plaintiff

Through: Mr. S.K. Bansal, Mr. Amitabh
Suman, Mr. Pankaj Kumar, Mr.
Kapil Kumar Giri & Mr. Vinay
Kumar Shukla, Advocates

versus

M/S AASHIANA ROLLING MILLS LTD.

..... Defendant

Through: Mr. Rajshekhar Rao, Mr. Kapil
Wadhwa, Ms. Deepika
Pokharia & Ms. Anamika
Mazumdar, Advocates

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CORAM:

HON'BLE MR. JUSTICE PRATEEK JALAN

J U D G M E N T

I.A. 647/2018 (Application on behalf of the defendant under Order XIII-A of the CPC, 1908)

1. The present suit has been filed by Kamdhenu Limited (“the plaintiff”) against Aashiana Rolling Mills Limited (“the defendant”), seeking an injunction against the defendant’s alleged infringement of its registered design in respect of steel bars. By way of an interlocutory application [I.A. 647/2018], the defendant seeks dismissal of the suit in exercise of the Court’s jurisdiction under Order XIII-A of the Code of Civil Procedure, 1908 [“CPC”].

Signature Not Verified

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NAGPAL

Signing Date: 13.05.2021

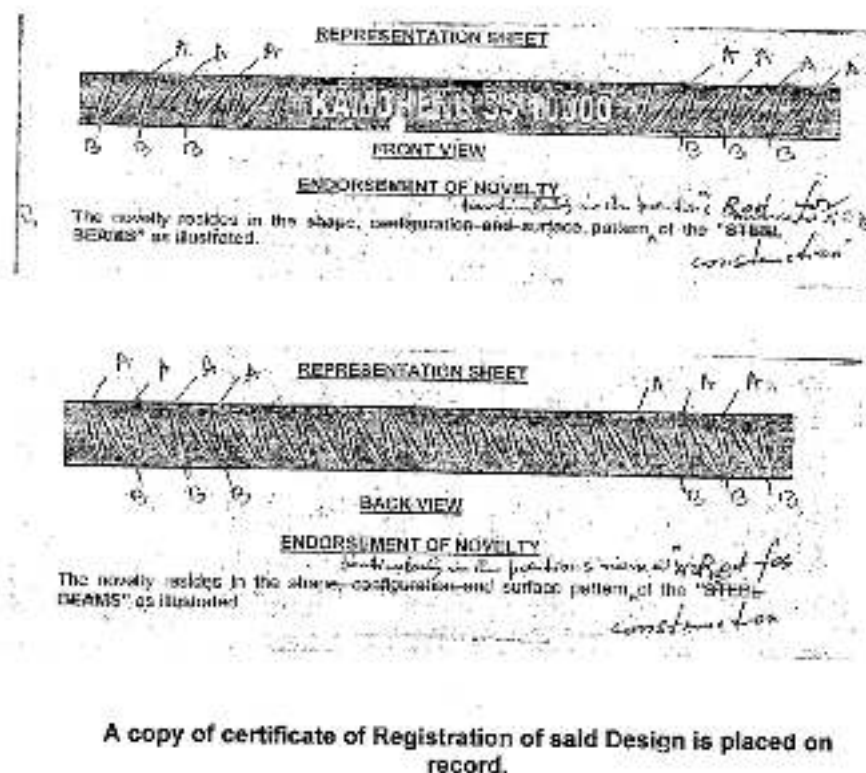
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I. Factual background

2. The plaintiff and the defendant both manufacture steel bars. The plaintiff claims to have created and developed a unique design in the period 2012-2013. The plaintiff's design, claiming new and original features in the form of surface pattern of double ribs, was registered under No.250968 in Class-25-01 with effect from 14.01.2013. The Controller General of Patents, Designs & Trade Marks ("the Controller") issued a certificate dated 29.08.2014 to this effect in favour of the plaintiff. Two 'representation sheets' were annexed with the certificate, which included pictorial representations of the front and back view of the goods in question, as follows:



3. Each of the sheets also contained an 'endorsement of novelty' in the following terms:

“The novelty resides in the surface pattern particularly in the portions marked A & B of the ‘rod for construction’ as illustrated.”

4. The plaintiff claims that its registered design is new, novel and original, and that after registration, it took steps for use and publication thereof, including application of the design on its best quality steel bars [Kamdhenu SS10000 TMT], which were launched on 18.06.2013. The case made out in the plaint is that the plaintiff has achieved considerable commercial success in the sale of steel bars of the aforementioned design. The monthly sales figures disclosed in the plaint reveal sales worth approximately ₹60 crores in FY 2013-2014, over ₹100 crores in 2014-2015 & 2015-2016 and approximately ₹83 crores in the year 2016-2017.

5. The plaintiff claims to have discovered, in June 2017, that the defendant is selling steel bars of an identical design under the name “Friends 500 HD TMT Bars”. The plaintiff alleges fraudulent imitation of the double ribbed design popularized by it, and consequent infringement of the registered design in which it has a statutory right to exclusivity under the Designs Act, 2000 [“the Act”].

6. The plaintiff therefore filed the present suit on 13.06.2017 in the District Court, Saket, which was subsequently transferred to this Court. The District Court granted an *ex parte* order of injunction on 15.06.2017, and also appointed a local commissioner to inspect the defendant’s premises and seize the infringing goods, packaging material and equipment used in manufacturing alongwith the defendant’s business records. The application for injunction was ultimately heard on contest after the transfer of the suit to this Court

and the *ex parte ad interim* order dated 15.06.2017 was confirmed by a learned Single Judge *vide* order dated 03.11.2017.

7. The defendant challenged the said order before the Division Bench in FAO(OS) 309/2017. The Division Bench considered the defendant's contention that the registration itself is invalid on account of numerous prior publications and, by its judgment dated 23.08.2018, set aside the order of injunction. In coming to this conclusion, the Division Bench held *inter alia* as follows:

“19. In the present case, the suit nowhere discloses – nor does the plaintiff/ Kamdhenu appear to have stated in its pleadings or in the documents filed before the court that the rods/ bars for which the registration was sought conformed to any particular standard at all. It is a matter of record that Aashiana averred to that the standard universally accepted and applied routinely by all manufacturers of the product had existed for almost three decades. It relied upon the last British Standards published in 2005, especially B500C. B500 C refers to B500 B (Figure 3). B500B while advertizing to B500A states that the bars would have two or more parallel transverse ribs. It thus, stated that for bars with two or three rib series “one of the series shall be contrary angle to the other and for bars with 4 ribs series, two of the series shall be at contrary angle”. The B500 C standard states that the bars for this particular standard would have the same arrangement of rib series as for B500B and then provides that “Further in each rib series, the ribs shall alternate between a higher and lower angle with respect to the bar excess. The difference between the angles of the different ribs and the bar excess shall be at least 10°.”

20. During the submission, it was pointed out by Aashiana that the bars necessarily had to be diagonal by at least 45° or more else that would end up as parallel rib

patterns and not serve the purpose intended. If that is taken into account, the standard indicates a limited range of possibilities for ribbing of the bars. For instance, if a ribbing at one surface is at 50°, the other would have to be at least at 60°. In this range, thus, there are limited options available to the manufacturer. Furthermore, these ribs would necessarily have to reflect a familiar pattern that the customers would choose, having regard to the peculiarity of the product. In these circumstances, the arguments that its adoption of 48° and 65° for the two transverse ribbing patterns, were unique and cannot be accepted. They merely reflected common standards – available in the public domain and applicable to the concerned product i.e. bars. As regards the contention that even though the products conformed to a known standard, they satisfied the test of novelty and uniqueness, is concerned, prima facie, this court is unpersuaded by the plaintiff's contention. The design (i.e. set of transverse ribs) is a part of known standards that are applicable and accepted by the industry and the manufacturers are familiar with this. Moreover, the range of possibilities, i.e. the limits of angularity of the ribs (given they are to be transverse and at least 10° apart) restrict the choices to an even greater extent. In these circumstances, this court holds that despite functionality, no distinct feature than can claim novelty was revealed, deserving design registration. This observation is prima facie and meant for the purpose of this judgment; all rights of parties to deal with it in the suit, are kept open.

21. The learned Single Judge, with respect to this, completely overlooked these salient aspects. In other words, a commonly applicable standard available in the public domain, used by the plaintiff – Kamdhenu to claim monopoly registration right, could not have been suppressed from the court or from the Controller. The registration of the design thus was suspect. This court does not wish to say anything further given that

proceedings for cancellation of the registration are said to have been taken out.”

8. The plaintiff approached the Supreme Court by way of SLP(Civil) No. 32594/2018, but the Supreme Court, by its order dated 11.02.2019, declined special leave to appeal.

9. In the meanwhile, the defendant filed its written statement on 16.07.2017, in which it was alleged that the plaintiff's registered design was not new or novel, but was itself copied from prior published standards, most significantly British Standard (BS 44449:2005, category B500C). It was further alleged that the plaintiff had suppressed the prior published designs both from the Controller and from this Court. The defendant placed on record the British Standard 2005 as well as several other internationally published standards to demonstrate that the plaintiff's design was in fact one that was well known and published since 1984. The defendant also alleged that the double ribbed pattern on the steel bars is in fact a functional element, used to create a strong mechanical lock between concrete and the reinforcement bars, thus making the concrete structures in which they are used stronger and more durable. On this basis, the case made out by the defendant was that the plaintiff's design was incapable of registration by virtue of Section 4(b) of the Act and was liable to be cancelled under Section 19 of the Act.

10. During the pendency of the appeal before the Division Bench, the defendant also filed the present application under Order XIII-A of the CPC. The contents of the application are substantially similar to the defence taken by the defendant. On this basis, the contention of the

defendant in the application is that the suit as constituted has no real prospect of success, and is therefore liable to be dismissed summarily under Order XIII-A of the CPC. The plaintiff has resisted the application contending that its design was different and distinct from the designs relied upon by the defendant.

11. In response to the present application, the case laid out by the plaintiff is that the specific angles of the double ribs in the plaintiff's design (*viz.* 48° and 65°) are not evident or revealed in any of the Standards relied upon by the defendant, whereas the defendant has, in fact, copied the very same angles. The argument in this context is that conformity or compliance with a published standard does not by itself denude the design of all novelty. The Standards contemplate a vast range of dimensions of angles which would fulfill the requirements thereof, and the choice of any particular pair of angles would render the design novel.

II. Statutory provisions

12. The relevant extracts of Order XIII-A of the CPC and the Act are reproduced hereinbelow.

Order XIII-A of the CPC [inserted by the Commercial Courts Act, 2015]:

“ORDER XIII-A - Summary Judgment

1. Scope of and classes of suits to which this Order applies. —

(1) This Order sets out the procedure by which Courts may decide a claim pertaining to any Commercial Dispute without recording oral evidence.

(2) For the purposes of this Order, the word claim shall include—

- (a) part of a claim;*
 - (b) any particular question on which the claim (whether in whole or in part) depends; or*
 - (c) a counterclaim, as the case may be.*
- (3) Notwithstanding anything to the contrary, an application for summary judgment under this Order shall not be made in a suit in respect of any Commercial Dispute that is originally filed as a summary suit under Order XXXVII.*

2. Stage for application for summary judgment.— *An applicant may apply for summary judgment at any time after summons has been served on the defendant:*

Provided that, no application for summary judgment may be made by such applicant after the Court has framed the issues in respect of the suit.

3. Grounds for summary judgment.— *The Court may give a summary judgment against a plaintiff or defendant on a claim if it considers that—*

- (a) the plaintiff has no real prospect of succeeding on the claim or the defendant has no real prospect of successfully defending the claim, as the case may be; and*
- (b) there is no other compelling reason why the claim should not be disposed of before recording of oral evidence.*

4. Procedure.— *(1) An application for summary judgment to a Court shall, in addition to any other matters the applicant may deem relevant, include the matters set forth in sub-clauses (a) to (f) mentioned hereunder:—*

- (a) the application must contain a statement that it is an application for summary judgment made under this Order;*
- (b) the application must precisely disclose all material facts and identify the point of law, if any;*
- (c) in the event the applicant seeks to rely upon any documentary evidence, the applicant must,—*
 - (i) include such documentary evidence in its application, and*

- (ii) identify the relevant content of such documentary evidence on which the applicant relies;
- (d) the application must state the reason why there are no real prospects of succeeding on the claim or defending the claim, as the case may be;
- (e) the application must state what relief the applicant is seeking and briefly state the grounds for seeking such relief.
- (2) Where a hearing for summary judgment is fixed, the respondent must be given at least thirty days' notice of:—
- (a) the date fixed for the hearing; and
- (b) the claim that is proposed to be decided by the Court at such hearing.
- (3) The respondent may, within thirty days of the receipt of notice of application of summary judgment or notice of hearing (whichever is earlier), file a reply addressing the matters set forth in clauses (a) to (f) mentioned hereunder in addition to any other matters that the respondent may deem relevant:—
- (a) the reply must precisely—
- (i) disclose all material facts;
- (ii) identify the point of law, if any; and
- (iii) state the reasons why the relief sought by the applicant should not be granted;
- (b) in the event the respondent seeks to rely upon any documentary evidence in its reply, the respondent must—
- (i) include such documentary evidence in its reply; and
- (ii) identify the relevant content of such documentary evidence on which the respondent relies;
- (c) the reply must state the reason why there are real prospects of succeeding on the claim or defending the claim, as the case may be;
- (d) the reply must concisely state the issues that should be framed for trial;
- (e) the reply must identify what further evidence shall be brought on record at trial that could not be brought on record at the stage of summary judgment; and

(f) the reply must state why, in light of the evidence or material on record if any, the Court should not proceed to summary judgment.

5. Evidence for hearing of summary judgment.—

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6. Orders that may be made by Court.—*(1) On an application made under this Order, the Court may make such orders that it may deem fit in its discretion including the following:—*

- (a) judgment on the claim;*
- (b) conditional order in accordance with Rule 7 mentioned hereunder;*
- (c) dismissing the application;*
- (d) dismissing part of the claim and a judgment on part of the claim that is not dismissed;*
- (e) striking out the pleadings (whether in whole or in part); or*
- (f) further directions to proceed for case management under Order XV-A.*

(2) Where the Court makes any of the orders as set forth in sub-rule (1) (a) to (f), the Court shall record its reasons for making such order.

7. Conditional order.—*(1) Where it appears to the Court that it is possible that a claim or defence may succeed but it is improbable that it shall do so, the Court may make a conditional order as set forth in Rule 6 (1) (b).*

(2) Where the Court makes a conditional order, it may:—

- (a) make it subject to all or any of the following conditions:—*
 - (i) require a party to deposit a sum of money in the Court;*
 - (ii) require a party to take a specified step in relation to the claim or defence, as the case may be;*
 - (iii) require a party, as the case may be, to give such security or provide such surety for restitution of costs as the Court deems fit and proper;*
 - (iv) impose such other conditions, including providing security for restitution of losses that any party is likely to*

suffer during the pendency of the suit, as the Court may deem fit in its discretion; and

(b) specify the consequences of the failure to comply with the conditional order, including passing a judgment against the party that have not complied with the conditional order.

8. Power to impose costs.—*The Court may make an order for payment of costs in an application for summary judgment in accordance with the provisions of sections 35 and 35A of the Code.]”*

Relevant provisions of the Designs Act, 2000:

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

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(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.o(14 of 1957)

xxxx xxxx xxxx

(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;

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

- (a) is not new or original; or
- (b) has been disclosed to the public any where in India or in any other country by publication in tangible form or 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.

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18. Cancellation of registration.- (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:-

- (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.

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

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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 subsection (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.”

III. Submissions on behalf of the applicant/defendant

13. The principal argument of Mr. Rajshekhar Rao, learned counsel for the defendant/applicant, was that the plaintiff's assertion of novelty and originality in paragraph 7 of the plaint, which is also a necessary element of a registered design, is belied by reference to various international standards for steel bars which are substantially similar to the design of the plaintiff's product. Mr. Rao referred to Sections 2(d) and 4 of the Act to submit that a design has to be original to entitle it to registration, and that its prior disclosure would render it non-registrable. He further submitted that a prior published design is vulnerable to cancellation by virtue of Section 19 of the Act, which point can also be taken in defence to an infringement suit as provided under Section 22(3) of the Act. According to Mr. Rao, the plaintiff's website (printouts of the relevant portion having been placed on record) itself claims that the plaintiff's design is equivalent to the British Standard B500C. Mr. Rao referred to the British Standard publication to show that the surface features, which form the basis of the plaintiff's claim of novelty, are based entirely upon the aforesaid Standards. In addition to the British Standard, which was published in 2005, Mr. Rao also relied upon the German Standard of 1984, Polish Standard of 2006, International Standard 6935-2 of 2007, the Turkish Standard of 2010 and the Colombian Standard of 2012. His

submission, based on these materials, was that the double ribbed surface pattern of the plaintiff's product did not demonstrate novelty or originality, and the plaintiff was, in fact, not entitled to registration of the design at all.

14. With regard to the plaintiff's assertion (as disclosed in the reply to this application) that the particular angles at which the ribs are placed on the plaintiff's product (48° & 65°) do not find place in any of the published standards, Mr. Rao submitted that the novelty claimed by the plaintiffs did not rest upon the specific angles of the ribs, but upon the placement of the double ribbed surface pattern consisting of longitudinal and transverse ribs. In any event, Mr. Rao submitted that the claim, if confined to the specific angles in question, would neither demonstrate significant difference from known designs, nor be discernable to the eye, and would thus fall foul of Sections 4(c) and 2(d) of the Act respectively.

15. Mr. Rao further submitted, in the alternative, that the novel feature relied upon by the plaintiff is in any event functional, as it is required for better grip of concrete on the rod and for identification of the grade of steel. He contended that the plaintiff's website and publications themselves refer to the transverse rib pattern as a "quality standard".

16. In support of his arguments, Mr. Rao cited the judgments of this Court in *Carlsberg Breweries A/S vs. Som Distilleries and Breweries Limited* 2017 (70) PTC 413 (Del), *M/s B. Chawla and Sons vs. M/s Bright Auto Industries* AIR 1981 Del 95, *Crocs Inc. USA vs. Liberty Shoes Ltd. & Ors.* 2018 SCC OnLine Del 7107 [CS(COMM)]

772/2016, decided on 08.02.2018], and *Crocs Inc. vs. Bata India Ltd & Ors.* 2019 (78) PTC 1 (Del). Mr. Rao also referred me to paragraphs 3-97, 3-100, 3-104 and 3-129 of *Russell-Clarke and Howe on Industrial Designs (9th ed.) (2005). London: Sweet & Maxwell.*

17. On the basis of these arguments, Mr. Rao urged that the plaintiff has no real prospect of success in the present suit, and that the suit is therefore liable to be dismissed under Order XIII-A of the CPC. He submitted that the insertion of Order XIII-A by the Commercial Courts Act, 2015 [“the 2015 Act”], subserves the legislative intent of expeditious disposal of commercial disputes. For this purpose, he also emphasized the preamble to the 2015 Act and the Statement of Objects and Reasons thereof. Mr. Rao pointed out that, despite the existence of several other provisions which permit the court to dispose of a suit without trial, the legislature considered it necessary to insert a specific provision for summary disposal of commercial suits. He drew my attention to several judgments of coordinate benches with regard to the scope of the provision, including *Jindal Saw Ltd. & Ors. vs. Aperam Stainless Services and Solutions Precision SAS & Ors.*, 263 (2019) DLT 235, *Venezia Mobili (India) Pvt. Ltd. vs. Ramprastha Promoters and Developers Pvt. Ltd.*, 259 (2019) DLT 13, *Mallcom (India) Ltd. & Ors. vs. Rakesh Kumar and Ors.*, 2019 (78) PTC 201 (Del), *K.R. Impex vs. Punj Lloyd Ltd.*, 2019 SCC OnLine Del 6667 [CS(COMM) 646/2016, decided on 08.01.2019], and *Su-kam Power Systems Ltd. vs. Kunwer Sachdev & Anr.* 264 (2019) DLT 326. According to Mr. Rao, the present case falls squarely within the provisions of Order XIII-A Rule 3 of the CPC, and its summary

disposal would lead not just to the disposal of this litigation, but also dissuade the plaintiff from similar litigation against other parties, pursuant to its misguided design registration.

18. Mr. Rao also cited the judgment of a coordinate bench in *Elder Projects Ltd. & Anr. vs. Elder Pharmacia LLP & Ors.* (2019) 259 DLT 485 as an example of a decision in which a suit (in that case, for infringement of trademark and passing off) was dismissed under Order XIII-A holding that the plaintiff had no real prospect of success. He also pointed out that the Court in that case awarded costs against the plaintiff therein.

IV. Submissions on behalf of the plaintiff

19. Opposing the application, Mr. S. K. Bansal, learned counsel for the plaintiff, claimed that the assertion of novelty in the plaintiff's product was not inconsistent with adherence to a published quality standard. The innovation in the plaintiff's product, according to Mr. Bansal, lies in the specific angles chosen out of the range of possibilities contemplated by the Standards. Mr. Bansal argued that the adoption of different specific angles or placement of the ribs sufficiently distinguishes the plaintiff's product and lends it novelty capable of registration under the Act.

20. Mr. Bansal cited the judgment of the Supreme Court in *Bharat Glass Tube Ltd. vs. Gopal Glass Works Ltd.* (2008) 10 SCC 657 to submit that the plaintiff's claim cannot be rejected under Order XIII-A of the CPC and that determination of the dispute requires adjudication upon evidence. He also cited the judgment of the High Court of

Justice (Chancery Division) in *The Matter of Wingate's Registered Design No. 768,611* (1935) 52 RPC 126 to urge that the Court has to examine the designs in question with an instructed eye to establish any difference between the prior and subsequent designs. Mr. Bansal also referred to the judgments of the Chancery Division in *A. Fulton Co. Ltd. vs. Grant Barnett & Co. Ltd.* (2001) 16 RPC 257 and *Kent and Thanet Casinos Ltd. vs. Bailey's School of Dancing Ltd.* (1965) RPC 482. He emphasized that there is no evidence in the present case of similar designs being commonplace or in widespread use, and that conformity with the Standard does not negate the novelty of a design. He argued that there was insufficient material in the present case to come to a summary conclusion that the suit was doomed to failure.

21. Mr. Bansal also cited the judgment of the Lahore High Court in *Kartar Singh Giani vs. Ladha Singh* AIR 1934 Lah 777 and of this Court in *The Chancellor of Masters and Scholars of the University of Oxford vs. Narendra Publishing House & Ors.* (2008) 38 PTC 385 to contend that publication of the British Standard ought not to foreclose the registration of the plaintiff's design.

22. Mr. Bansal relied upon the judgment of the Division Bench in *Clues Network Pvt. Ltd. Vs. L'oreal* 2019 (78) PTC 251 (Del) to submit that the plaintiff's claim cannot be rejected under Order XIII-A of the CPC and that determination of the dispute requires adjudication upon evidence. He argued that the power under Order XIII-A Rule 3 of the CPC is discretionary, and would arise only if the twin tests specified in Rules 3(a) and 3(b) are satisfied, the burden whereof rests upon the applicant. He reminded the Court of the note of caution

struck by the Division Bench in this regard in *Bright Enterprises Pvt. Ltd. & Ors. vs. MJ Bizcraft LLP & Ors.*, 2017 (69) PTC 596 (Del) [followed by a learned Single Judge in *Rockwool International vs. Thermocare Rockwool India Pvt. Ltd.*: CS (COMM) 884/2017, decided on 16.10.2018].

23. Mr. Bansal further submitted that the dismissal of the plaintiff's application for interlocutory injunction ought not to prejudice the Court while deciding whether the plaintiff is entitled to proceed to trial. He drew my attention in this context to the recent judgment in *CFA Institute vs. Brickwork Finance* [CS(COMM) 619/2018, decided on 06.10.2020] whereby, in a suit for infringement of trademark, passing off, etc., a coordinate bench has dismissed the plaintiff's application for injunction under Order XXXIX Rules 1 and 2 of CPC, and also declined the oral prayer for summary judgment made on behalf of the defendant. He submitted that Order XIII-A does not dispense with the process of framing of issues, and that dispensing of recording of evidence can only be done strictly in accordance with the procedure specified under Order XIII-A.

24. On the issue of functionality, Mr. Bansal relied upon the judgment of the Bombay High Court in *Whirlpool vs. Videocon* (2014) 5 AIR Bom R 396 to submit that the defence of functionality requires that the function can be achieved only by the particular design in question. He submitted that the fact that a function may be performed by the element in which the plaintiff claims novelty is not sufficient to decline registration. The registration would be declined only if the design element is such that it *per se* lends functionality to the product.

V. Submissions of parties in rejoinder:

25. Mr. Rao, in his submissions in rejoinder, reiterated the scope of an application under Order XIII-A as laid down in *Su-kam (supra)* and *Mehra Cosmetics vs. Ram Kumar Gulati & Ors* 265 (2019) DLT 348. He distinguished the judgment of the Supreme Court in *Bharat Glass (supra)* on the ground that the defendant in that case had failed to produce any evidence to show the use of the design upon the material upon which the plaintiff employed its registered design. According to Mr. Rao, the decision of the Supreme Court turns on its reasoning that the material upon which the design is used is also an element of the registered design. Mr. Rao countered the submission of Mr. Bansal regarding widespread public use of the design in question by reference to various documents showing third party manufacture of the product.

26. Mr. Rao further submitted that, in the facts and circumstances of the present case, there is no necessity for trial or for a physical comparison of the products of the plaintiff and the defendant, unlike in the case of *Bharat Glass (supra)* decided by the Supreme Court. According to Mr. Rao, the documents pertaining to the registration of the design, upon which the suit is based, themselves make the scope of the registration amply clear. He also submitted that the plaintiff's arguments in this regard are belied by the fact that the plaintiff has not placed samples of physical products of either party on record with the plaint. The provisions of Order XI of the CPC, as applicable to commercial cases, according to Mr. Rao, required the plaintiff, if it sought physical comparison of the products, to file them alongwith the plaint.

27. In response to Mr. Rao's submission in rejoinder regarding the scope of Order XI of the CPC, Mr. Bansal submitted that the production of the articles in question alongwith the plaint was not mandatory, as these articles are, in fact, required to answer the case set up by the defendant, and subsequent filing is therefore permissible under Order XI Rule 1(1)(c). He contended, in the alternative, that the plaintiff would also be entitled to make an application for taking additional evidence on record under Order XI Rule 1(5).

VI. Analysis

A. Principles of Order XIII-A of the CPC

28. Before dealing with the arguments of the parties on merits, it is necessary to appreciate the principles applicable to adjudication of an application under Order XIII-A of the CPC.

29. This Court has had occasion to deal with this in several judgments. Mr. Rao referred me to the decisions of coordinate benches in *Jindal Saw Ltd. (supra)*, *Venezia Mobili (supra)*, *Mallcom (India) (supra)*, *K.R. Impex (supra)*, *Su-kam (supra)* and *Elder Projects Ltd (supra)*. Mr. Bansal, on the other hand, relied upon the Division Bench decision in *Bright Enterprises (supra)*, *Clues Network (supra)*, *Rockwool (supra)*, and *CFA Institute (supra)*.

30. In *Bright Enterprises*, the Division Bench allowed the plaintiff's appeal against dismissal *in limine* of a suit for injunction against infringement of trademark, passing off, etc. The Division Bench held that, upon the institution of a suit, the issuance of summons to the defendant is mandatory, and that the power under Order XIII-A can be

exercised only upon an application being made after the service of summons and prior to framing of issues. In *Rockwool*, the learned Single Judge applied the judgment in *Bright Enterprises* and came to the conclusion that several of the issues arising in that case could not be decided without trial.

31. After the publication of the Delhi High Court (Original Side) Rules, 2018 [“the Rules”], a view has been taken in *K.R. Impex (supra)*, *Mallcom (India) (supra)* and *Jindal Saw Ltd. (supra)*, that Chapter XV-A of the Rules (which would override the provisions of the CPC by virtue of Section 129 thereof) permits disposal of a suit by summary judgment on any date of hearing. However, it is not necessary in the facts of the present case to enter into this controversy, as summons have indeed been issued in the present suit, and a formal application invoking the provisions of Order XIII-A has been filed by the defendant prior to framing of issues.

32. Mr. Bansal relied upon the judgment in *Clues Network (supra)*, wherein the Division Bench cited the judgment in *Bright Enterprises (supra)*, to hold that the procedure laid down therein has to be followed. In *Clues Network*, earlier applications filed under Order XIII-A of CPC had already been dismissed and there was no pending application for this purpose. It is in these circumstances that the Division Bench set aside an order of the learned Single Judge disposing of the suit under Order XIII-A, albeit after recording that counsel for the parties had consented to such disposal. The circumstances of the present application are entirely different. It has been instituted in writing after service of summons and prior to

framing of issues, as contemplated by Order XIII-A Rule 2. No argument has been raised by Mr. Bansal regarding the proper constitution or presentation of the present application, and the judgment in *Clues Network* is, in my view, of no assistance to him.

33. The circumstances in which an application under Order XIII-A ought to be allowed have been dealt with in *Su-Kam (supra)*. The Court considered the English Law pertaining to Rule 24 of Civil Procedure Rules, which is in *pari materia* to Order XIII-A of the CPC.

34. Rule 3 of Order XIII-A lays down the tests which must be satisfied in order to enter judgment under the said provision. With regard to the ‘real prospect of success’ limb of the test, the judgment of the Chancery Division in *Easyair Ltd vs. Opal Telecom Ltd.*, [2009] EWHC 339 (Ch) was cited before the Court in *Su-Kam*. In *Easyair*, the Chancery Court distilled the principles thus:

“i) The court must consider whether the claimant has a “realistic” as opposed to a “fanciful” prospect of success: *Swain v. Hillman* [2001] 1 All ER 91;

ii) A “realistic” claim is one that carries some degree of conviction. This means a claim that is more than merely arguable: *ED & F Man Liquid Products v. Patel* [2003] EWCA Civ 472 at [8];

iii) In reaching its conclusion the court must not conduct a “mini-trial”: *Swain v. Hillman*;

iv) This does not mean that the court must take at face value and without analysis everything that a claimant says in his statements before the court. In some cases it may be clear that there is no real substance in factual assertions made, particularly if contradicted by contemporaneous documents: *ED & F Man Liquid Products v. Patel* at [10];

v) However, in reaching its conclusion the court must take into account not only the evidence actually placed before it on the application for summary judgment, but also **the evidence that can reasonably be expected to be available at trial**: *Royal Brompton Hospital NHS Trust v. Hammond (No 5)* [2001] EWCA Civ 550;

vi) Although a case may turn out at trial not to be really complicated, it does not follow that it should be decided without the fuller investigation into the facts at trial than is possible or permissible on summary judgment. Thus the court should hesitate about making a final decision without a trial, even where there is no obvious conflict of fact at the time of the application, where reasonable grounds exist for believing that a fuller investigation into the facts of the case would add to or alter the evidence available to a trial judge and so affect the outcome of the case: *Doncaster Pharmaceuticals Group Ltd. v. Bolton Pharmaceutical Co. 100 Ltd.* [2007] FSR 63;

vii) On the other hand it is not uncommon for an application under Part 24 to give rise to a short point of law or construction and, **if the court is satisfied that it has before it all the evidence necessary for the proper determination of the question and that the parties have had an adequate opportunity to address it in argument, it should grasp the nettle and decide it.** The reason is quite simple: if the respondent's case is bad in law, he will in truth have no real prospect of succeeding on his claim or successfully defending the claim against him, as the case may be. Similarly, if the applicant's case is bad in law, the sooner that is determined, the better. If it is possible to show by evidence that although material in the form of documents or oral evidence that would put the documents in another light is not currently before the court, such material is likely to exist and can be expected to be available at trial, it would be wrong to give summary judgment because there would be a real, as opposed to a fanciful, prospect of success. However, it is not enough simply to argue that the case should be allowed to go to trial because something may turn up

which would have a bearing on the question of construction: ICI Chemicals & Polymers Ltd. v. TTE Training Ltd. [2007] EWCA Civ 725.”

(Emphasis supplied.)

35. With regard to the second limb of the test, [corresponding to Order XIII-A Rule 3(b) of the CPC], this Court in *Su-kam* has recorded the submission based upon the following observations in *Blackstone’s Civil Practice: The Commentary* with regard to ‘compelling reasons’, thus:

“(a) The respondent is unable to contact a material witness who may provide material for a defence.

(b) The case is highly complicated such that judgment should only be given after mature consideration at trial.

(c) The facts are wholly within the applicant's hands. In such a case it may be unjust to enter judgment without giving the respondent an opportunity of establishing a defence in the light of disclosure or after serving a request for further information. However, summary judgment will not necessarily be refused in cases where the evidence for any possible defence could only lie with the applicant if there is nothing devious or artificial in the claim.

(d) The applicant has acted harshly or unconscionably, or the facts disclose a suspicion of dishonesty or deviousness on the part of the applicant such that judgment should only be obtained in the light of publicity at trial.”

36. After a consideration of the Statement of Objects and Reasons of the 2015 Act and the English and Canadian judgments relating to similar provisions for summary judgment, this Court has held as follows:

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“42. Consequently, the new Rule, applicable to commercial disputes, demonstrates that trial is no longer the default procedure/norm.

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44. While deciding the test for summary judgment under Rule 24.2, House of Lords in Three Rivers District Council v. Governor and Company of the Bank of England, [2003] 2 A.C. 1, reiterated the observation in Swain v. Hillman, [2001] 1 All ER 91 that the word ‘real’ distinguishes ‘fanciful’ prospects of success and it directs the Court to examine whether there is a ‘realistic’ as opposed to a ‘fanciful’ prospect of success. The House of Lords in Three Rivers District Council (supra) also held that the Court while considering the words ‘no real prospect’ should look to see what will happen at the trial and that if the case is so weak that it has no reasonable prospect of success, it should be stopped before great expenses are incurred...

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45. The Supreme Court of Canada in Robert Hryniak v. Fred Mauldin, 2014 SCC OnLine Can SC 53 has also held that trial should not be the default procedure. In the said case, which was an action for civil fraud against the appellant and a corporate lawyer, who acted for the appellant, the allegation was that the appellant, through that company, had transferred more than US \$10 million to an offshore bank following which he claimed that the money had been stolen. That money had initially been transferred to the appellant's company, by the respondents therein, in respect of an investment opportunity.

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47. The Supreme Court of Canada, despite allegation of fraud, did not exercise the power to record oral evidence. Instead, the Court granted summary judgment in favour of the respondents/plaintiff on the basis of the material/pleadings already available with it. The Court

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held that there is no genuine issue requiring a trial when the judge is able to reach a fair and just determination on the merits on a motion for summary judgment. The Court further held that that is the case when the process allows the judge to make necessary findings of fact, allows the judge to apply the law to such facts and when such a process is proportionate, more expeditious and a less expensive means of achieving a just result. Consequently, when a summary judgment motion allows the judge to find the necessary facts and resolve the dispute, it would not be necessary to proceed to trial. In this regard the standard for fairness is whether or not the procedure involved in a summary judgment would give the judge the confidence to find necessary facts and apply the relevant legal principles to resolve the dispute...

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49. Consequently, this Court is of the view that when a summary judgment application allows the Court to find the necessary facts and resolve the dispute, proceeding to trial would generally not be proportionate, timely or cost effective. It bears reiteration that the standard for fairness is not whether the procedure is as exhaustive as a trial, but whether it gives the Court the confidence that it can find the necessary facts and apply the relevant legal principles so as to resolve the dispute as held in Robert Hryniak (supra).

50. In fact, the legislative intent behind introducing summary judgment under Order XIII A of CPC is to provide a remedy independent, separate and distinct from judgment on admissions and summary judgment under Order XXXVII of CPC.

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52. Consequently, this Court is of the opinion that there will be 'no real prospect of successfully defending the claim' when the Court is able to reach a fair and just determination on the merits of the application for summary judgment. This will be the case when the process allows the court to make the necessary finding of fact, apply the law to the facts, and the same is a

proportionate, more expeditious and less expensive means to achieve a fair and just result.”

(Emphasis supplied.)

37. In *Su-Kam*, the Court also explained an earlier judgment of the learned Single Judge in *Venezia (supra)*, wherein it was held that the principles under Order XII Rule 6 and Order XIII-A are similar, inasmuch as the Court is required to consider whether the defences raised by the defendants are a moonshine and sham. Under both provisions, judgment may be entered without trial, if the Court comes to the conclusion that the suit raises no genuine triable issues. This was clarified in *Su-Kam* to the extent that the remedies are independent, separate and distinct, but were considered in a composite manner in *Venezia* as the plaintiffs therein had filed separate applications under the two provisions.

38. Although the judgment of the learned Single Judge in *Su-Kam (supra)* has been carried in appeal [RFA(OS)(COMM) 1/2020], the Division Bench has not stayed the operation of the judgment.

39. The judgment of a coordinate bench in *Mehra Cosmetics (supra)* is also instructive as to the approach to be applied. The Court noticed that under the 2015 Act, a suit is supposed to be disposed of without trial, in the absence of any real prospect of success of either of the parties. In the context of a suit alleging infringement of trademark and design, the Court held as follows:

“15. This Court, in the interim order/judgment, on a perusal of the registered design, has already returned a finding, again though prima facie, that there is no novelty in the design of the container of the Petroleum Jelly,

against copying of which infringement is claimed, inasmuch as a large number of other products are available in the market in similar containers.

16. I have thus asked the counsel for the plaintiff, how the decision on the said aspect can be any different today and or what evidence would be led by the plaintiff to establish the novelty in the design, even if put to trial. The decision is unlikely to be before the expiry of the period of validity of the design.

17. The counsel for the plaintiff has contended that since the plaintiff has a certificate of registration of design, the same will be shown to establish novelty. It is also contended that the defendant no. 4 has since also obtained registration of a similar design and the same will be proved in evidence.

18. The process of registration of a design is materially different from that of a trade mark, where an opportunity is given to others to object. Merely because registration has been obtained, is no proof, even prima facie, of the validity of the design. Reference, if any required, in this regard can be made to observations in Mohan Lal, Proprietor of Mourya Industries v. Sona Paint & Hardwares 200 (2013) DLT 322, Aashiana Rolling Mills Ltd. v. Kamdhenu Ltd. (2018) 253 DLT 359 and Vega Auto Accessories (P) Ltd. v. S.K. Jain Bros Helmet (I) Pvt. Ltd. 2018 SCC OnLine Del 9381. Similarly, merely because the defendant no. 4 may have obtained registration of the same design would not make the design of the plaintiff novel.

19. A perusal of the certificate of registration of design at Pages 17 to 22 of Part IIIA File also shows the plaintiff to have claimed novelty “in the shape and configuration of container” without any particulars and the counsel for the plaintiff on enquiry has only contended that the novelty is in the ring at the centre of the container to handhold the same. To say the least, the same is not even claimed in the registration, particularly in respect of the

front side, back side, left side and right side view of the container.

20. Thus, no purpose will be served in putting the claim of the plaintiff for infringement of design also to trial and the same can be summarily dismissed.”

40. In view of the aforesaid judgments, I am required to consider whether a fair and just determination of the dispute is possible without trial, where the necessary facts can be determined without trial and legal principles applied to those facts, summary judgment would be available, rather than requiring the parties to incur the expenditure of time and resources required for a trial.

41. I may also note, in this context, Mr. Bansal's submission that the judgment of the Division Bench dated 23.08.2018, rejecting the plaintiff's application for injunction, is not conclusive of this issue. Mr. Bansal relied upon *CFA Institute (supra)* to demonstrate that the Court can take the view that an interlocutory injunction is unmerited, while also rejecting the defendant's application for summary judgment. In view of the fact that the determination of an injunction application turns only upon a *prima facie* assessment of merits, I accept Mr. Bansal's submission that the dismissal of the injunction application does not *per se* lead to a conclusion that the plaintiff does not have any real prospect of success for the purposes of summary judgment.

B. Authorities regarding novelty and prior publication

42. With regard to the principles of novelty in a registrable design, three of the judgments cited require somewhat detailed consideration.

43. The judgment in *Carlsberg Breweries (supra)*, relied upon by Mr. Rao, is a detailed judgment dealing with infringement of design. The Court considered the statement of novelty in respect of a registered design of a glass bottle and came to the conclusion that the shape of the bottle is in fact similar to most other bottles. With respect to various indentations/grooves found on the plaintiff's bottle, the Court returned the following findings regarding the question as to whether the plaintiff's bottle stands out, i.e., appeals to the eye:

*“172. In my view, the answer is ‘No’. **Though the indentations/grooving may be novel inasmuch, as, the bottles of other manufacturers may not have identical indentations/grooving, the idea of adopting a bottle design with indentation/grooving is not new in itself,** since there are scores of other bottles being used by other vendors of beer and other beverages, and other products, which too have indentations/groovings.*

*173. **In that sense, the indentations/groovings on the plaintiff's bottle in question can be described as “a different combination of familiar contrivances”.** (See *Gramophone (supra)*, where Lord Loreburn LC used the aforesaid expression while comparing the defendant's product - a cabinet, with that of the plaintiffs). The indentations on the plaintiff's bottle - and for that matter even on the defendant's bottle, appear to serve the only purpose of providing the groove, wherein the printed label is to be affixed. The grooving serves as a frame within which the label is affixed. In that sense, the indentations can also be described as functional. The grooves serve the purpose of accommodating, within the grooves, the label containing the mark of the manufacturer/plaintiff.”*

(Emphasis supplied.)

While undertaking a comparison of the bottles of the plaintiff and the defendant, the Court observed that the indentations/grooves do not

prima facie form an essential part of the novelty in the plaintiff's design.

44. To demonstrate that the question of originality of the design of the plaintiff would be relevant to a determination of a suit for infringement, Mr. Rao cited the judgment of the learned Single Judge in *Crocs Inc.* (2018) (*supra*) (paragraphs 19 and 20), which was carried in appeal, and decided by the Division Bench in *Crocs Inc.* (2019) (*supra*). The Division Bench, on the question of prior publication, held as follows:

“35. The registration granted to the plaintiff Crocs India Ltd. in India is effective from 2004. In the U.S. too, the design was registered on 28.5.2004 but in terms of the provisions of the Designs Act as applicable in U.S. the plaintiff will have the benefit of registration for one year prior to 28.5.2004 i.e. from 28.5.2003. Consequently, once the design of the footwear of the plaintiff is found in the public domain as evident from Holey Soles' website, prior to 28.5.2003, then clearly in view of Section 4(b) read with Section 19(d) of the Act the registration granted to Crocs Inc was facially faulty and was liable to be cancelled under Section 19 of the Act. Crocs Inc, in these circumstances cannot seek the benefit of its registered design for seeking reliefs in the present case.

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37. The court is satisfied that the appropriate test for prior publication was gone into. In this respect, it would be relevant to notice the decision in Rosedale Associated Manufacturers Ltd. v. Airfix Products Ltd. 1957 R.P.C. 239 for what constitutes a prior publication. The court held:

“Thus, approaching the matter, I have for my part come to the clear conclusion that the design was not published by Clarice Jones' specification. To conclude otherwise would, in my judgment, at least require that somewhere

*in the specification the design or something substantially the same as the design was described with reasonable clarity on a fair reading of the document. In this respect the test of prior publication of an alleged invention should, in my judgment, be no less applicable in the case of a registered design, and as regards the 'former, I venture to cite once more the oft-quoted language of Lord Westbury in Hills v. Evans (1862) 31 L.J. (Ch.) 457 at p. 463: "the antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments". By a like reasoning, to my mind, **if a document is to constitute prior publication then a reader of it, possessed of ordinary knowledge of the subject, must from his reading of the document be able at least to see the design in his mind's eye and should not have to depend upon his own originality to construct the design from the ideas which the document may put into his head....**"*

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41. Given the nature of the materials, this court is of the opinion that the analysis carried out in the impugned judgment with respect to prior publication and the existence of the Holey Soles' designs in the public domain, as undermining the plaintiff's claim in regard to the novelty of the design or the lack of any similar design in the public domain, is in consonance with the law and the facts of these cases."

(Emphasis supplied.)

45. In the decision of *B. Chawla (supra)*, after a consideration of the applicable precedents, the Division Bench held as follows:

"11. The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the

ultimate arbiter. However, the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.

12. Coming to the facts of the instant case the design in question as a whole consists in almost rectangular shape with rounded edges with sides curved or sloping with a further curve on either side in the sloping upper length side. The respondent produced in evidence Japan's Bicycle Guide, 1972, Vol. 22. At page Nos. 218 to 221, there are standard models of back mirrors besides branded models numbering 36. Models bearing Nos. 59-6, 62-1, 61-3, 66-1 and 70-1 would show back view mirrors rectangular in shape with sloping, widths or lengths. In some of these models there is curve in the upper length side. We have mentioned this fact simply to emphasise that back view mirrors resembling the one in question have been in the market for a long time. The appellants' case is that a further curve in the sloping upper length side makes their design new or original. We have already noted that the extent and nature of novelty was not endorsed by the appellants in the application for seeking registration and, therefore, it has to be taken only as regards the shape and configuration. In final analysis the matter would boil down to whether addition of further curve on either side makes the variation a striking one or a substantial so as to constitute a novelty meriting for registration. The learned single Judge after enunciating the legal position correctly used his eye for discerning if there was in fact a novelty and answered the question in the negative. We have once again gone through the same exercise and come to the same opinion. We fail to see the hard labour which the appellants claimed to have bestowed in creating the design they got registered. It is devoid of newness and equally devoid of

originality. An addition of curve here or their in a shape which is well-recognised shape of an article of common use in the market cannot make it an article/new or original in design. If it is made eligible for registration, it would certainly hinder the progress of trade without there being any justification, whatsoever.

13. Mr. K.L. Aggarwal has been at pains to impress that the addition of the further curve on either side as an appeal to the eye and therefore, it is the design of the appellants and on that basis has urged that the appellants are entitled to protection. We have no dispute with the contention subject to certain reservations. It is a design indeed within the meaning of the term as given in the Act, the matter, however does not end there. What the appellants were required to satisfy was that their design has a substantial novelty or a striking newness for the instructed eye. It is here they fail as every design is not registerable.”

(Emphasis supplied.)

46. The question of prior publication has also been dealt with in Russell-Clark and Howe on Industrial Designs (9th edition, 2016), as follows:

“Does the document disclose a design applied to an article?”

3–118 In order to destroy the novelty of a design registration, an earlier design must be published “in respect of the same article”. Mere publication of the pattern which constitutes the design was therefore not sufficient to destroy the novelty of a design registration, which consisted of the application of that pattern to an article. In principle, the same holds true of the publication of a shape, although is it less easy to envisage cases where the publication of a shape does not implicitly convey the article

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3-120 It should be recalled that under the 1949 Act, if a pattern (or shape) has been published in respect of any article, the publication will destroy the novelty of any design which consists of the application of that pattern (or shape) to an article of any kind, however different it is from the kind of article to which the publication suggests that the design should be applied. However, the publication will not invalidate such later design registration if it does not suggest the application of the pattern (or shape) to an article at all. Thus, a series of pictures published in a fine art catalogue would not destroy the novelty of a later design consisting of the application of one of those pictures to, say, the back of a chair, because a painting or picture simpliciter is not an “article”. But the same picture published in a catalogue of patterns for application to wallpaper would destroy the novelty of such a later design registration, because wallpaper is an article.

What design is disclosed by a prior published document?

3-121 Assuming that a prior published document does satisfy the requirement that it discloses a design, i.e. a shape or pattern, as applied or to be applied to an article, the next question may be **what is the shape or pattern which is disclosed? In some cases this will be clear, for instance where the publication contains explicit pictures or illustrations.** However, it may be less clear and the disclosure may consist in whole or in part of written text which needs to be interpreted, or general instructions which can be put into practice in a variety of ways. In such cases the test to be applied is that borrowed from the pre-1977 patent law of anticipation, i.e. that **the prior art document must contain “clear and unmistakable directions: to make an article with the shape or pattern which is the same as, or similar enough to the registered design in suit to deprive it of novelty.**

3-122 This was laid down in *Rosedale Associated Manufacturers Ltd. v Airfix Ltd.* Lord Evershed MR said:

*“In this respect the test of prior publication of an alleged invention should, in my judgment, be no less applicable in the case of a registered design, and as regards the former, I venture to cite once more the oft-quoted language of Lord Westbury in Hills v Evans: ‘the antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments.’ By a like reasoning, to my mind, **if a document is to constitute prior publication, then a reader of it, possessed of ordinary knowledge of the subject, must from his reading of the document be able at least to see the design in his mind’s eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head.**”*

3–123 On the same point Romer LJ said:

*“In Flour Oxidising Co. v Carr & Co. Parker J (as he then was) said: ‘Where the question is solely a question of prior publication it is not, in my opinion, enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result. **It must also be shown that the specification contains clear and unmistakable directions so to use it.**’ These observations by Parker J were cited with approval by Lord Dunedin in British Thomson-Houston Co. v Metropolitan-Vickers Electrical Co., and again (when delivering the judgment of the Judicial Committee) in Pope Alliance Corp. vs. Spanish River Pulp & Paper Mills Ltd.. In the latter case and at the same page Lord Dunedin posed the test as follows: ‘would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that Patent,*

if he had had the alleged anticipation in his hand, have said “that gives me what I wish”? It is true that these citations were related to anticipations of inventions, but it seems to me that they apply by analogy to alleged anticipations by “paper publications” or registered designs’.”

3–124 It is not permissible to make a mosaic of a number of prior documents for the purpose of attacking novelty. If the attack on novelty is to succeed, the design must be disclosed in the single prior document. If, however, one document contains a reference to another document, the two may be read together.”

(Emphasis supplied.)

C. Application to the present case:

47. The defendant has, in support of this application, relied upon several international standards, including the British Standard B500C, the German Standard of 1984, the Polish Standard of 2006, International Standard 6935-2 of 2007, the Turkish Standard of 2010 and the Colombian Standard of 2012. These Standards are pressed into service to contend that the plaintiff’s design is not an original design, but one which had been disclosed by publication prior to the date of the plaintiff’s application for registration, contrary to Section 4 of the Act.

48. The plaintiff’s design registration dated 14.01.2013 has been placed on record. The certificate of registration is in respect of the application of the design for ‘rod for construction’. Attached with the certificate are two representation sheets containing the ‘front view’ and the ‘back view’ of the product:



A copy of certificate of Registration of said Design is placed on record.

49. Beneath both these images, there is an ‘endorsement of novelty’ in the following terms:

“The novelty resides in the surface pattern particularly in the portions marked A & B of the ‘rod for construction’ as illustrated.”

(It appears from copies placed on record that the endorsement of novelty, as originally printed/typed, referred to the “*shape, configuration and surface pattern*” of the “*steel beams*”, but was amended in hand to read as quoted above.)

50. The British Standard upon which the defendant relies, is entitled “*Steel for the reinforcement of concrete – Weldable reinforcing steel – Bar, coil and decoiled product – Specification*” (BS4449-2005) published in 2005. The version of the British Standard placed on record by the defendant incorporates amendments until 30.04.2007, well before the plaintiff’s application for registration. Clause 1 of the

aforesaid document makes it clear that it applies to ribbed weldable reinforcing steel used for the reinforcement of concrete structures, which will be delivered in the form of bars, coils or de-coiled products. Different standards are prescribed for three grades of steel, B500A, B500B and B500C. The terms longitudinal rib and transverse rib are defined in clauses 3.3 and 3.4 of the British Standard as follows:

“3.3

longitudinal rib

uniform continuous protrusion parallel to the axle of the reinforcing steel

3.4

transverse rib

rib on the surface of the reinforcing steel other than a longitudinal rib”

51. The defendant’s claim is based upon the Standard of B500C bars which reads as follows:

“Grade B500C: bars shall have the same arrangement of rib series as for B500B. However, in each rib series, the ribs shall alternate between a higher and lower angle with respect to the bar axis. The difference between the angles of the different ribs and the bar axis shall be at least 10°. An example of rib pattern of grade B500C with two transverse rib series is given in Figure 4.

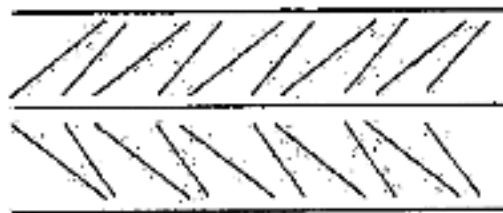


Figure 4 — Example of rib pattern for grade B500C ..

52. In addition to the aforementioned British Standard, the defendant has also placed on record the standards adopted in several other jurisdictions which, according to it, reveal similar prior publication of the design in question, and its application to steel bars. One of those was published by the International Standards Organization [“ISO”] in 2007 (ISO 69035-2) and is entitled ‘*Steel for the reinforcement of concrete – Part 2: Ribbed Bars*’. This was apparently circulated to all the members of the ISO. The foreword to this document mentions the Draft International Standards, adopted by its technical committee and circulated to its member bodies for voting, and that their publication as an International Standard requires approval of at least 75% of its voting members. The document lays down various specifications for ribbed bars to the plaintiff’s design.

53. Although the defendant has also relied upon the German Standard of 1984, the Polish Standard of 2006, the Turkish Standard of 2010, and the Colombian Standard of 2012, none of those documents are in the English language. I therefore do not propose, for the purposes of deciding this application, to rely upon them. Suffice it to say that Mr. Rao pointed out the images contained in these documents which, according to him, represented the design found in the plaintiff’s steel bars:

- German Standard: fourth image at Page 33 of the application folder;
- Polish Standard: image at Page 36 of the application folder;

- Turkish Standard: image marked ‘B500C’ at Page 109 of the application folder;
- Colombian Standard: last image at Page 143 of the application folder.

54. In addition to relying upon the aforementioned Standards, Mr. Rao has also drawn my attention to paragraph 10 of the plaint, in which the plaintiff had itself asserted that its product conforms to the “*quality standard at par with British Standard B500C*”. The relevant assertion in paragraph 10 of the plaint is as follows:

*“10. The Plaintiff’s KAMDHENU SS 10000 TMT bar under the aforementioned design has become well-known with respect to their surface pattern and designing. **The said design of the Plaintiff has become symbolic to its KAMDHENU SS 10000 TMT bar with quality standard at par with British Standard B500C** in such a way that it has gained phenomenal prominence and exclusivity in relation to its Steel Bar and the public/consumers associate the Steel Bars bearing the Plaintiff’s said registered design solely with the Plaintiff....”*

(Emphasis supplied.)

55. The defendant has also placed on record screenshots of the website of the plaintiff (www.kamdhenulimited.com). The following two statements on the plaintiff’s website are of relevance for the present purposes:

“Kamdhenu Steel, one among the largest TMT producers in India, is the first company in the country to introduce the unique double-rib pattern design in steel bars.

xxxx xxxx xxxx

Kamdhenu, one among the largest TMT producers in India, is the first company in the country to introduce the

unique double-rib pattern design equivalent to British standard B500C designed and manufactured from the latest UK based technology with international quality standards.”

(Emphasis supplied.)

56. As noted above, Mr. Bansal urged that conformity with published standards cannot render a design prior published. He submitted that such a finding would denude many registered designs of protection, by reason merely of compliance with acceptable standards for production of goods. His further response to the aforementioned Standards was to assert that the particular combination of angles employed in the plaintiff’s design confer upon it sufficient novelty as to enable its registration under the Act.

57. I am unable to accept Mr. Bansal’s contention that compliance with published standards can never be sufficient to constitute prior publication of a design. This would have to be determined upon a consideration of the particular design and the published standards. The significant factor to be noted in the present case is that the Standards cited by the defendant are in fact standards *of the design itself*. It is the surface pattern comprising of transverse and longitudinal ribs at an angle to each other that constitutes the standard in question. These are not generic stipulations, but give a detailed enumeration of the elements of the design. The product can be produced by reference to the design in question. The situation would have been different if the standard had been of a characteristic which was not related to the design but to some other feature of the product, for example, the length of the rod, its weight, etc. Where the novelty claimed by the

owner of the registered design resides in the very element which is described in the standard with a reasonable degree of specificity, the design cannot be said to be novel or original.

58. The adoption of a particular combination of angles is also not determinative. It may be noted at the outset that the plaintiff's registered design does not mention the particular angles of 48° and 65° at all. In fact, as noted above, it is in the 'surface pattern' marked in the images at A and B, that novelty is claimed to reside. Significantly, the word "configuration", which originally found place in the endorsement of novelty, was struck out prior to registration of the design. Further, the combination of angles available to a manufacturer is limited by the stipulation of BS500C that "*(t)he difference between the angles of the different ribs and the bar axis shall be at least 10°*". In any event, I am of the view that the plaintiff cannot claim the benefit of the specific angles in view of the definition of design in Section 2(d) of the Act and the prohibition contained in Section 4(c) thereof. The particular angles in the plaintiff's design, are not discernible by the eye alone, as required in Section 2(d) and are not significantly distinguishable from the published standard, contrary to Section 4(c).

59. To my mind, the case argued on behalf of the plaintiff, in fact, goes beyond the registered design of which the plaintiff seeks protection, and is in excess of the plaint filed in the suit. The certificate of registration, as mentioned above, does not refer to the angles in question, and neither does the plaint. In fact, in paragraph 10 of the plaint (set out in paragraph 54 hereinabove), the plaintiff itself

asserts its compliance with the Standards. The undisputed assertion on the plaintiff's website is even more categorical when it refers to the "*double ribbed pattern design equivalent to British Standard B500C*" (emphasis supplied). The equivalence between the plaintiff's product and the Standard is, even according to the plaintiff, an equivalence pertaining to *design*. It is also noteworthy that the plaintiff's assertions on the website suggest that the double ribbed pattern design itself is unique, and not any particular combination of angles therein. Further, the plaintiff does not claim originality in the design, but that it is the first company in India to introduce it. Such an assertion itself indicates the prevalence of the design elsewhere in the world, which is sufficient to attract the prohibition contained in Section 4(b) of the Act.

60. The above conclusion is also supported by the decisions cited above. Applying the judgment in *Carlsberg (supra)* to the facts of the present case, it is clear that the idea of longitudinal and transverse ribs at a given angle to each other is not new in itself, and the particular angles in the plaintiff's product are but a "*different combination of familiar contrivances*". In *B. Chawla (supra)*, a conclusion of this nature was reached, relying *inter alia* upon various standard models of bicycle mirrors published in *Japan's Bicycle Guide*. This is an authority therefore to suggest that publication of the design in a standard publication can constitute prior publication for the purposes of the Act. In the same judgment, the Court also noticed that the plaintiff's claim of originality was not borne out from the endorsement of novelty in the registered design. Drawing upon the judgment in

Crocs (2019) (*supra*), I am satisfied that an instructed reader of the Standards would have been able to imagine the design without recourse to his/ her own originality. The Standards contain illustrations of the design in question, as well as clear instructions for the reader.

61. The judgments cited by Mr. Bansal in this context do not persuade me to a contrary conclusion.

62. The principal judgment relied upon by Mr. Bansal is that of the Supreme Court in *Bharat Glass*. In that case, the prior published design was of a roller which could be used to produce the same pattern on various materials like plastic, rexine, glass, etc. The design of the roller was registered with the UK Patent Office and available on their website. The design registered under the Act in India applied the same pattern on glass sheets. The Supreme Court came to the conclusion that the UK registration of the roller was insufficient to render the design prior published. Coming to this conclusion, the Court observed *inter alia* as follows:

“37. In the present case, the design has been reproduced in the article like glass which is registered. This could have been registered with rexine or leather. Therefore, for registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied. As in the present case the design sought to be reproduced on a glass sheet has been registered and there is no evidence to show that this design was registered earlier to be reproduced on glass in India or any other part of the country or in Germany or even for that matter in the United Kingdom, therefore, it is for the first time registered in India which is new and original design

which is to be reproduced on glass sheet. Therefore, the submission of learned Senior Counsel for the appellant, Mr Gupta cannot be accepted that this design was not new and original.”

63. The Court cautioned that the simultaneous production of the two articles would be necessary for the Court to appreciate the similarity in the designs. Although it was contended that the same design had been applied upon glass sheets prior to registration in India, those glass sheets had not been produced. In fact, the Court noticed that the manufacture of the design on glass was not supported by any evidence at all (Paragraphs 41 and 45 of *Bharat Glass*). In the present case, the question of a difference in materials upon which the design is applied does not arise. The British Standard is for ribbed steel bars alone, and the plaintiff itself claims adherence to that standard. The judgment of the Supreme Court does not require that, *in every case*, the products must be physically produced for comparison. The purpose of physical production of the articles in question is to enable satisfactory comparison. In the present case, the question of comparison does not arise - the plaintiff's argument is not that the registered design is different from the British Standard, but that adherence to the Standard does not make the design non-registrable. This question does not turn on a comparison of the two products, i.e. the plaintiff's product and the product alleged to constitute prior publication.

64. Mr. Bansal also relied upon the judgment of the Chancery Division in *A. Fulton Co. (supra)* (paragraphs 54, 58 and 60). At the outset, it may be noted that the observations of the Chancery Division

in the aforesaid paragraphs concern the construction of the term ‘commonplace’ in Section 213(4) of the English Copyright Design and Patent Act, 1988. The Act does not use the same terminology. Mr. Bansal relied upon this judgment to emphasise the distinction between an article being commonplace (which does not render the design unprotected) and the design itself being commonplace (which does render it non-registrable). It was noted in *A. Fulton Co.* that even where the broad parameters of size and shape of an article may be commonplace, there is considerable scope for detailed design works to be undertaken within those parameters and for the creation of a shape or configuration which has its own special qualities. The Court also emphasised that differences which are relatively small in quantitative terms, and therefore not easily estimable without design expertise, may make a significant difference to the design itself. I am of the view that these questions do not arise in the facts of the present case. As mentioned hereinabove, neither the plaintiff’s registered design nor the plaintiff itself relies upon a particular combination of angles chosen. The registration is in respect of the double ribbed surface pattern *per se*, which was clearly disclosed in the Standard. This is not a case of broad parameters which would be applicable to every steel bar, within which the plaintiff has developed a particular design. The disclosed parameters included specifications of a range of angles and the plaintiff has adhered to those. There is no claim of variance from the disclosed design which might require expert evidence to discern.

65. Similarly, in *Kent & Thanet (supra)*, which was a case of infringement, the defendant argued that the registered design was

nothing more than a modification of a known design, and that too for functional purposes. The Chancery Division referred to the statement of novelty attached to the plaintiff's certificate of registration and rejected the contention that the generality of the statement would cover substantial variations from the illustrated design. The Court cautioned against a generalised reading of the statement of novelty. I am of the view that this judgment does not take the plaintiff's case any further. The plaintiff, in effect, seeks an interpretation of the statement of novelty, which includes the particular angles employed by it. This is not permissible on the plain terms of the endorsement of novelty; the question of an excessively generalized reading does not arise.

66. Mr. Bansal's reliance upon *Kartar Singh Giani (supra)* is also misplaced. The High Court of Lahore in that case, while dismissing an action of infringement of copyright, observed as follows:

"11. ...All laws which put a restraint upon human activity an enterprise must be construed in a reasonable and generous spirit. Under the guise of the copyright, a plaintiff cannot ask the Court to close all the avenues of research and scholarship and all frontiers of human knowledge..."

67. Mr. Bansal's reliance upon this judgment was to contend that the publication of the British Standard ought not to foreclose the registration of the plaintiff's design. However, the observations of the Lahore High Court are to exactly the opposite effect. It is the plaintiff, in an action for infringement such as the present one, which seeks to inhibit the defendant's production of the article in question. The matter therefore turns on the question of prior disclosure and the observations of the Lahore High Court do not provide any guidance on

that aspect. For similar reasons, I do not consider the judgment in *Chancellor of Masters and Scholars (supra)* to be of any relevance in deciding the present dispute.

68. In *Wingates (supra)*, the Court emphasised that the comparison between two designs would require the assistance of expert witnesses. However, as stated hereinabove, the present case does not require any such comparison as the scope of similarity and difference, between the plaintiff's product and the alleged prior publication, is undisputed.

69. In the light of the above discussion, I am of the view that the plaintiff's registered design was, in fact, not registrable in terms of Section 4 of the Act, and that this conclusion does not require evidence to be led.

D. Functionality of the plaintiff's design

70. The second ground upon which the defendant assails the plaintiff's registered design is that the design is, in fact, functional and, therefore, does not fall within the definition in Section 2(d) of the Act. In view of my conclusion on the point of prior disclosure, it is not necessary to decide this question at this stage.

VII. Conclusion:

71. In the facts and circumstances aforesaid, I hold that the defendant has established that the plaintiff's registered design was, in fact, a prior published design, and the registration is therefore contrary to Section 4 of the Act. I am further satisfied that the present case is a fit one for exercise of power under Order XIII-A of the CPC. The material upon which I have reached the above conclusion is

undisputed material which is already placed before the Court, and no further trial on this account is required. I therefore find that the plaintiff has no real prospect of success in the suit. There is also no other compelling reason to record oral evidence in the present case.

72. For the reasons aforesaid, I.A. 647/2018 is allowed, and summary judgment is entered, dismissing the suit. The application is disposed of in these terms.

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73. In view of the aforesaid judgment in I.A. 647/2018, the suit stands dismissed. Decree sheet be drawn accordingly.

PRATEEK JALAN, J.

MAY 12, 2021
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Signature Not Verified

Digitally Signed By: SHITU

NAGPAL

Signing Date: 13.05.2021

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I.A.647/2018 in CS(COMM) 90/2018

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