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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of decision: 25th May, 2022
+ **CS(COMM) 384/2018**

VIKAS JAIN Plaintiff
Through: Ms. Richa Bhargava and Ms. Vaishali
Mittal, Advocates. (M: 9999954489)
versus

AFTAB AHMED AND ORS Defendants
Through: Mr. S.K. Bansal and Mr. Ajay
Amitabh Suman, Advocates.
(M:9990389539)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The present suit was filed seeking permanent injunction restraining infringement of registered design bearing no. 194631 dated 23rd February, 2004 in class 21-01 in respect of a 'BOOM SCOOTY', as also reliefs for passing off, delivery up, damages rendition of accounts, etc. The case of the Plaintiff was that the Defendants were infringing the said Scooty design, and had imitated various features of the same including the shape, configuration, and arrangement of features.
3. Defendant No.1/Mr. Aftab Ahmed is stated to be the main manufacturer of the Scooty and the other Defendant Nos. 2-5 were engaged in the business of manufacturing plastic toys. Defendant nos. 6&7 were stated to be the owners of the moulding machine used to manufacture the impugned design. The reliefs sought in the suit are as under:



“a) An order for permanent injunction restraining the defendants through their partners or proprietor as the case may be, their servants, wholesalers, retailers, dealers, distributors and vendors from manufacturing, selling, offering for sale, directly or indirectly dealing in toy scooters, which are an infringement or imitation of plaintiff s registered design No. 194631 including any of the features set out in the table in paragraph 9;

b) An order for permanent injunction restraining the defendants through their partners or proprietor as the case may be, their servants, wholesalers, retailers, dealers, distributors and vendors from manufacturing, selling, offering for sale, directly or indirectly dealing in toy scooter, which are identical to or deceptively similar in their shape, configuration, and arrangement of features to the plaintiff’s toy scooter sold under the mark Boom Scooty or do any other thing as would result in confusion and deception amounting to passing off of the defendants’ goods as and for those of the plaintiff.

c) an order of rendition of account of profit illegally earned by the defendants on account of use of the impugned design of the toy scooter and a decree be passed in favour of the Plaintiff of the amount so ascertained;

d) An order for delivery up for purposes of destruction and/or erasure of all the impugned material including the scooters, whether finished or unfinished, blocks, dies and all other implements used by he defendants in aid of its infringing scheme,

e) An order for costs in the proceedings, and proper in the facts and circumstances of this case.”



4. Written statements were filed on behalf of all Defendants except Defendant No.2. Vide order dated 11th August, 2005 an *ex parte* order of injunction was granted in the following terms:

“ Heard the learned counsel for the plaintiff and perused the averments and allegations made in the application, plaint and the documents obtaining on record. It would show that the plaintiff got the design of its toy scooter registered under the design No. 194631 and defendant has stalled manufacturing and selling identical or similar toy scooters of similar shape and configuration which prima facie amounts to infringement of the plaintiff's registered design. This Court is satisfied that there is an urgent need to pass ex-parte orders so as to contain the said infringement.

Issue notice to the defendants for the date fixed i.e., 21st September, 2005. Till the next date of hearing the defendants itself or through their partners or proprietor, agents, servants, wholesales, retailers, dealers, distributors and vendors are restrained from manufacturing, selling, offering for sale, directly or indirectly dealing in toy scooters, which are identical or deceptively similar in their shape, configuration with the plaintiff's toy scooter which is the subject matter of the plaintiff's registered design No.194631.”

5. The injunction order was, thereafter, confirmed during the pendency of the suit, vide a detailed judgment dated 4th July, 2007. The relevant portion of the said order reads as under:

“Consequently, in view of the foregoing discussion, the plaintiff has been able to establish an excellent prima facie case and the balance of convenience also lies in confirming the interim injunction granted on 11.08.2005 till the disposal of the suit. The defence of prior publication taken by the defendants is also not,



prima facie, available to them. Accordingly, IA No.6155/2005 is allowed by confirming the order dated 11.08.2005 till the disposal of the suit. IA No.6349/2005 is dismissed.”

6. Subsequently, the suit proceeded to trial and the following issues were framed vide order dated 8th April, 2008:

“(i) Whether the plaint has been instituted, signed and verified by the proper and authorized person? OPP

(ii) Whether the plaintiff is the proprietor of the registered design under registration no.194631? OPP

(iii) Whether the defendants have infringed the plaintiff's design rights under the registration no.194631? OPP

(iv) Whether the plaintiff's design registration under the registration no. 194631 is liable for cancellation on grounds of it lacks novelty and originality? OPD

(v) Whether the plaintiff is entitled to damages and if so to what extent? OPP

(vi) Whether the defendant is passing off his goods as that of the plaintiff ? OPD

(vii) Relief.”

7. On behalf of the Plaintiff, the evidence by way of affidavit was filed by Mr. Vikas Jain. On behalf of the Defendant No.1 and Defendant No.1 to 5- Mr. Aftab Ahmed filed the evidence by way of affidavit. The cross-examination was also conducted. While evidence was being led in the matter, an appeal filed against the judgment dated 4th July, 2007 was also decided by the Division Bench vide order dated 19th August, 2010 in **FAO(OS) 300/2007**, which directed expedited trial in the matter to dispose of the suit itself. Accordingly, the evidence was concluded and the matter



was listed in the category of ‘finals’ vide order dated 11th January, 2011.

8. The Defendants had also challenged the validity of the design of the Plaintiff under Section 19 of the Designs Act, 2000. The case of the Defendants was that the design was prior published. Vide order dated 2nd May, 2011, the proceedings in the suit were adjourned *sine die* awaiting the decision of the Controller in the cancellation petition. Subsequently, as the cancellation petition had not been decided even after sometime, vide order dated 7th February, 2013, the Division Bench directed the suit to be listed for final hearing. The suit remained pending for final arguments. Recently, after constitution of the IP Division, final matters in which evidence was concluded were directed to be listed and the matter came up before this Court on 8th March, 2022 for directions.

9. On the previous date of hearing being 16th March, 2022, as also today, ld. counsel for the Plaintiff submits that despite repeated efforts, they are unable to contact the Plaintiff for receiving instructions.

10. It is noticed that the design registration itself has lapsed during the pendency of the present suit and the same has fallen into public domain in 2019. The period between the grant of the registration and the grant of the *ex parte* injunction is 23rd February, 2004 to 11th August, 2005 which is about 17 to 18 months. After the grant of the *ex parte* injunction order, the Defendants claim to have not manufactured the toy scooters due to the injunction order. The injunction has operated throughout from 2005 till date i.e., for a period of 18 years. The prayer in this case is for permanent injunction and rendition of accounts. Under such circumstances, this Court is of the opinion that the suit has become infructuous due to lapse of the design registration. The injunction order having operated during the entire



period of the suit till the lapse of the registered design, the suit no longer deserves to be continued.

11. The suit, along with all pending applications, is disposed of as infructuous. It is made clear that this Court has not gone into the merits and the validity of the design registration or the infringement thereof.

PRATHIBA M. SINGH
JUDGE

MAY 25, 2022
dj/ms

