



A.No.1863 of 2023
in
C.S.(Comm.Div).No.60 of 2022

ORDERS RESERVED ON:03.08.2023

ORDERS PRONOUNCED ON: 17.10.2023

P.T.ASHA, J,

The application which is placed for the consideration of this Court is one filed under Order XIII A of the Code of Civil Procedure as amended by the Commercial Courts Act 2015 to issue summary judgment against the respondents/plaintiffs, dismiss the suit filed by the respondents/plaintiffs, and cancel the registered license issued to the plaintiff bearing Nos. 310835 and 310836 dated 11.10.2018.

2. Before proceeding to discuss the application, it is necessary to briefly set out the respective pleadings of the plaintiffs and defendant. The parties, for the ease of understanding, are referred to in the same array as in the suit.



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3. The plaintiffs have filed the suit seeking an injunction against the defendant from infringing the first plaintiff's registered licenses in respect of two designs bearing Nos.310835 and 310836 in any manner and to render accounts for the manufacturing, distribution, and sales of the deceptively similarly designed bottles manufactured by the defendant and for a declaration that the defendant is infringing upon the first plaintiff's copyright in respect of these two designs and for damages.

4. It is the case of the plaintiffs that the two designs, which have been registered and bearing Registration Nos.310835 and 310836, are the unique and novel designs of the plaintiffs. The plaintiffs' bottle has a unique shape configuration, tube, alignment, color, and surface pattern.

5. The configuration of the bottle is such that, in the case of design No. 310836, the body of the bottle is divided into two separate parts, and from two different tubes the product is pushed out through a single nozzle at the top. A mere look at the bottle would indicate that the two nozzles /



tubes are merged into one at the top of the bottle. As regards design No.310835, the novelty of the bottle is in its shape and configuration. The view of the bottle would indicate that there are two chambers and the product comes out of a single nozzle.

6. It is the case of the plaintiffs that they have been marketing and selling their products since 2017. Their application for registration has been made on 11.08.2018 and the certificate of Registration has been granted in respect of design No. 310836 on 03.12.2018 and in respect of design No.310835 on 09.01.2019. The design that has been created by the plaintiff has been a contributing factor in its increased sale and consequently, its goodwill and reputation.

7. While so, the plaintiffs had come across the sale of the defendants' product which has been packed in containers identical to the plaintiffs and therefore, the plaintiffs have come forward with the above suit.



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8. The defendant has entered appearance and filed their written statement and a counterclaim to declare that the registered designs bearing Nos. 310835 and 310836 are invalid and direct the design registration to be expunged from the Register of Designs.

9. The main crux of the defendant's case is that the plaintiffs had marketed their designs even prior to their applying for registration of the designs, and therefore, as per Section 4(b) of the Designs Act, they cannot register the designs. Further, the registration in respect of the design 310836 is merely a mechanism which is purely functional, and therefore, the same cannot be termed a design under Section 2(d) of the Designs Act. They would further contend that the design of the plaintiffs' bottles does not have any novel shape nor configuration. They would submit that this has also been accepted by the plaintiffs themselves in their plaint document No.7, which gives the key facts and description, i.e., the structure, design, and functions of the bottles, and a comparison of both the first plaintiff's and defendant's bottle designs. It is also the contention



of the defendant that they are sourcing their products (packaging bottles) from M/s.Guangzou Chenbin Packaging Material Private Limited, China, who has a prior registration, and therefore, they have sought to have the suit dismissed.

10. After the filing of the written statement, the defendant has come forward with this application, which is now placed for the consideration of this Court. The plea for summary judgment has been made on the following grounds:

a) The designs that are registered have been used prior to the registration and are therefore liable to be cancelled under Section 19 of the Designs Act.

b) The designs are neither novel nor new.

c) The designs are purely functional and, therefore, excluded from being a design.

d) The defendant's vendor has a design patent registration even prior to the plaintiffs' registration.

e) Design No.310836 is for a mechanism and not



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a design as contemplated under Section 2(d) of the Designs Act.

f) Design No. 310835 is neither unique nor novel and therefore, requires cancellation.

11.The plaintiffs have filed a reply to the above application *inter-alia* contending that the application for registration has been made as early as on 11.10.2018 and registration was granted on 03.12.2018 and 09.01.2019. The registration relates back to the date of application for registration. The plaintiffs have set out the unique features of the design as follows:

i. A unique shape, configuration, tube, alignment, colour and surface pattern.

ii. The configuration of the bottle is such that it appears as if the body of the bottle is divided into separate parts for delivery through two nozzles from two different tubes.



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iii. *The surface pattern of the bottle has a unique type of distinct cylindrical shape curve, which looks aesthetically attractive.*

iv. *Minimal yet clean and bold graphic elements make the Bottle stand out in cluttered market place/against the competition.*

v. *The two nozzle/tube merged into one at the top of the bottle also appears that it has divided into two parts.*

vi. *Dual Outflow Tubes with dual chamber body and a combined Nozzle with a spring pump dispenser.*

vii. *The surface of bottle has a shining effect, with black colour which gives elegant effect to the Plaintiffs' Bottle.*

viii. *The main body of the bottle as also its unique translucent cap contains a unique colour combination of two colours.*

The suit has been filed in view of the infringement of this design by the defendants.



12. The plaintiff would submit that there is a difference in the language of Section 4 and Section 19 of the Designs Act, and therefore, the contention of the applicant/defendant seeking the summary judgment has to be rejected. The plaintiff would further submit that the prior usage has been attributed only to one design, whereas with reference to the other, no such contention has been raised or proved. Therefore, it is their contention that the application cannot be allowed in part. That apart, as regards the novelty and functionality of the designs, the same has to be proved through evidence, and the plaintiffs cannot be shut out from showing proof by filing this application seeking a summary judgment. Therefore, the plaintiff would seek to have the application dismissed.

13. Mr. P. S. Raman, learned senior counsel appearing for Mr. R. Sathish Kumar, learned counsel for the applicant / defendant would submit that even prior to the application for registration of design, the plaintiffs have been marketing the products through the visual media and in support of the said argument have filed a typed set of documents showing the plaintiffs' advertisements in Youtube for their VIP Hair



Colour shampoo. The advertisements which are displayed in Youtube would indicate that the plaintiffs have been marketing the same on 03.08.2018 which is even prior to the application for registration, which was made on 11.10.2018. The learned senior counsel would also draw the attention of this Court to the advertisements for design No.310835 on 28.03.2018. He would therefore submit that this design cannot be registered in the light of the prohibition contained in Sections 4 (a) and (b) of the Designs Act. He would also draw the attention of this Court to the very pleadings of the plaintiffs in paragraph 17 of the plaint, wherein they have clearly and categorically admitted that the 2nd plaintiff has been marketing these design bottles since 2017. Therefore, he would submit that since the product has not been registered and as the same has been put to use more than 50 times, it has lost its value. He would rely upon the judgment of this Court reported in **2017 (2) CTC 742 [M/s.Maya Appliances Private Limited and Others Vs. Butterfly Gandhimathi Appliances Ltd]**. He would draw the attention of this Court to paragraphs 5.1 and 5.2 of the judgment, which clearly talk about the prohibition of registration and the effect of a prior publication. He would



therefore submit that the application should be allowed, the suit dismissed and the counter claim decreed.

14. Mr.Aravind Pandian, learned senior counsel appearing for Mr.Ramaswamy Meyyappan, learned counsel for respondents/plaintiffs, would submit that the answer to the defense taken by the plaintiffs under Section 4(b) and Section 19 of the Designs Act is the judgment of the Hon'ble Supreme Court reported in *2008 (10) SCC 657 [Bharat Glass Tube Limited vs Gopal Glass Works Limited]*, with particular reference to paragraphs 12, 26, and 33. It is also the argument of the learned senior counsel that the Designs Act was enacted pursuant to the agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Therefore, the terms of the TRIPS Agreement would be the basis on which the current enactment has been envisaged. Many of the signatory countries have amended their domestic laws to bring them in tune with the TRIPS Agreement. He would rely upon the provisions of Articles 25 and 26 of the TRIPS agreement which talk about the requirement for provision in respect of the industrial design as also the



protection of the design from third parties infringing on it. It is his contention that these two articles have to be read into Sections 4 and 19 of the Designs Act. He would rely upon the judgment of the Delhi High Court reported in **2013 SCC Online Del 1016 [Reckitt Benkiser India Ltd Versus Wyeth Ltd]** and would draw the attention of the Court to Paragraph 23 therein, where the Full Bench of the Delhi High Court has laid down the conditions. He would further submit that novelty, uniqueness, etc., of the products have to be proved through evidence, and even the reference to the bar under Section 4 of the Designs Act has to be examined in the light of the provisions of the TRIPS Agreement. Therefore, he would pray that the application be dismissed and the plaintiff be permitted to prove their case without non-suiting them at the threshold.

15. Heard the learned counsels on either side and perused the materials available on record.



16. The two grounds on which this application for a summary judgment has been filed are:

a) The design of the plaintiffs has been published even prior to the date of filing of the application and therefore, under Section 4 (b) of the Designs Act, the same cannot be registered and is therefore liable to be cancelled as per Section 19 of the Act.

b) The design is neither new nor novel and is purely functional and therefore does not come within the definition of design.

17. In order to consider this application, it is necessary to extract certain provisions of Designs Act. Section 2(d) of the Design Act defines the word “design” as follows:

(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 (14 of 1957);

When the definition is examined in detail, it indicates that the design includes shape, configuration, pattern, ornament, or composition of lines or colours that are applied to any article. Such an application can be either in two-dimensional or three-dimensional form or in both forms and applied so by an industrial process or means. Such industrial process could be manual, mechanical/ commercial, either individually or in



combination with the above. The finished article has to be judged only visually. However, the definition excludes the following:

a) A design will not include any mode / principle of construction or otherwise which is nothing but a mechanical device.

b) (i) 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)

(ii) property mark as defined in section 479 of the Indian Penal Code (45 of 1860) and

(iii) any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957);

18. Section 4 talks about the circumstances in which registration is prohibited. Section 4 reads as follows:-

4. Prohibition of registration of certain designs.

A design which—

(a) is not new or original; or

(b) has been disclosed to the public anywhere in India or in any other country by publication in



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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.

19. Once again, if this section is analysed in detail, the following are the circumstances where registration is prohibited:

a) The design is not a new one.

b) It is not an original design.

c) The design has not been disclosed to the public

either:

(i) By publication in India or in any other

Country in a tangible form;

(ii) By putting it to use; or

(iii) In any other form it is disclosed to the public.

d) The design is not distinguishable from a known



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design or a combination of known designs.

e)The design comprises of scandalous or obscene matter.

Therefore a design cannot be registered in the aforesaid circumstances.

20. Section 5 of the Designs Act talks about an application for registration of designs and Section 7 of the Designs Act talks about the publication of registered designs.

21. Section 19 of the Designs Act sets out the circumstances in which the registration of a design can be cancelled. Section 19 reads as follows:-

19. 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:—



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(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 registerable 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.

22. From a reading of the above provision, it is clear that a petition for cancellation can be filed by any person who is interested before the Controller. The above Section sets out the grounds on which a registration can be cancelled.

a) That the design has already been registered in India.

b) The design has been published in India or any



other country prior to its registration.

c) That it is not a new or original design.

d) That the registration of the design is prohibited under the Act.

e) If the design does not conform to the definition of Section 2 (d) of the Act.

23. The word “*publication*” has not been defined under the Act therefore its import and meaning has to be garnered from out of the provisions of the Act and judicial pronouncements in this regard. It is necessary to do so since the main fulcrum of the defendant's argument is that the plaintiff has already published the design prior to its registration. The defendant has relied upon the youtube photographs to contend that the registration granted to the plaintiffs is liable to be cancelled as it has already been published and disclosed to the public.



24. In this regard if we were to consider the youtube photographs, the same only brings to the notice of the general public the availability of a Hair Colour Shampoo which helps to get rid of gray hair in an easy and simple way and that the shampoo contains no Ammonia, gives instant colour and there is no staining. These advertisements only talk of the shampoo and not the container in which it is stored. In fact, nowhere in the pictures filed is there a description of the container. In this context, if the provisions of Section 19 is perused, what is contemplated is the publication of the “design” in order to constitute a ground for cancellation of the registration. As discussed supra the registered design (container) does not feature in the advertisement and the contents of the container are brought to the notice of the public. Therefore, the contention of the defendant that the registration is liable for cancellation and that too by way of a summary judgment cannot be countenanced. It is well open to the defendants to let in evidence to prove the same.



25. The issue regarding what is publication had been dealt with by a learned single Judge of the Calcutta High Court in the judgment reported in **2006 33 PTC 434 [Gopal Glass Works Ltd Versus Assistant Controller of Patents & Designs and Others]**. This was the case where the design in question was registered in India with respect to glass. This design was purchased from a German Company. Further, this design was sold to Indian owner, which was also registered in United Kingdom. When the drawings were downloaded from the website of the United Kingdom Patent Office, it depicted that the design may be applied to glass sheets. However, it was found that the illustrations did not give the same visual effect to conclude that the designs of both parties were identical. The learned single Judge held that a mere existence of the papers downloaded from the United Kingdom Parent Office would not amount to prior publication as they did not have the necessary clarity to have been applied to any article. The learned Judge has observed as follows in paragraphs 41, 42 and 43 in the above judgment.

“41. To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication would have to be, in



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tangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article, with the same visual effect would be sufficient.

42. When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration.

43. If the visual effect of the pattern, the shape or the combination of the pattern, shape, dimension, colour scheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design.”

Ultimately, the learned Judge has held that the publication in the United Kingdom Patent Office did not amount to prior publication as contemplated under Section 4(b).



26. This order was taken up on appeal to the Hon'ble Supreme Court and the judgment is reported in **(2008) 10 SCC 657 [Bharat Glass Tube Limited Vs Gopal Glass Works Limited]**. The Hon'ble Supreme Court has observed as follows in paragraph 45:

“45. The next evidence which was led by the appellant was a website (sic) which had been downloaded from the website of the United Kingdom Patent Office depicting patterns that may be applied to glass sheets. No evidence has been produced to show that M/s Vegla Vereinigte Glaswerke GmbH had manufactured this design in glass sheet or not. It is only a design downloaded from the website of the Patent Office in UK and it is not known whether it was reproduced on glass sheet in UK or not. In this connection, the Assistant Controller has only observed that he has made a visual comparison of UK registered Design No. 2022468 with the impugned Design No. 190336 and he was satisfied that both the designs make same appeal to the eye and there was sufficient resemblance between the two designs. Therefore, the Assistant Controller held that the impugned design was



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prior published and it could not be said to be new or original. The Assistant Controller further observed that the proprietor of this design had not been able to make a difference between the UK design and the present design. This was not accepted by the learned Single Judge of the Calcutta High Court and for the good reason. It was observed by the learned Single Judge as under:

“The illustrations in the form of drawings downloaded from the website of the United Kingdom Patent Office depict the patterns that may be applied to glass sheets. The patterns may be same but the illustrations do not give the same visual effect as the samples of the glass sheets produced by the appellant in Court. There are also no clean unmistakable instructions or directions for production of glass sheets of the pattern illustrated.

The visual effect and/or appeal of a pattern embossed into glass sheets by use of embossing rollers could be different from the visual effect of the same pattern etched into glass sheets manually. Respondent 1 has not considered these factors.

The order impugned considered with the materials on record, including in particular the computer printouts



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clearly reveals that Respondent 1 has only compared the pattern and/or configuration and considered the visual appeal thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, Respondent 1 has not considered the visual appeal of the finished product.

There are no materials on record to show that the design had previously been applied to glass sheets. On the other hand, an affidavit was sworn on behalf of the appellant by a Liaison Executive affirming that he had ascertained that the proprietor of the design registered in the United Kingdom had never manufactured glass sheets of the design registered.”

From this it appears that in fact the pattern of the design which is reproduced on the glass sheet and the design and the pattern which was reproduced on the glass sheet in the United Kingdom was not common.”

27. In the instant case also, the publication of the design is sought to be put forward through youtube photographs which as discussed does



not refer to the product but only refers to the shampoo. Further, the design per se is not clear from the advertisement. This judgment of the Hon'ble Calcutta High Court has also been referred to with approval by the Full Bench of the Delhi High Court in the case of ***Reckitt Benkiser India Ltd Vs Wyeth Ltd [AIR 2013 Del 1096]***. Therefore, from the above judicial pronouncements, it can be held that the defendant has not proved that the plaintiff has published the design as contemplated under Section 4(b) and 19 of the Designs Act.

28. The other argument which has been put forward by the learned Senior counsel appearing for the applicant/defendant is that the design was purely functional and therefore would not come within the definition of Design as contemplated under Section 2(d) of the designs Act. In the judgement relied upon by the applicant / defendant reported in ***2017(2) CTC 742 [Maya Appliances Pvt.Ltd Vs Butterffly Gandhimathi Appliances Ltd]***, the learned Judge has discussed the impact of functionality. The learned Judge had discussed that where functionality is raised as a defense, it is for the defendant to plead and prove the same.



The learned Judge would observe as follows in paragraph 10.4 of the judgment:

“10.4. Being a defence available, it is for the defendant to plead and prove. The incidental overlapping qua functionality which is not predominant in a product, will not affect the right of the plaintiff under the [Designs Act, 2000](#). The onus to prove otherwise, a defence to be established by the defendant. In such a case, the defendant also will have to prove that the functionality has come into being only through a particular design registered in favour of the plaintiff and therefore, it cannot be used through any other means.

29. Under Section 4 of the Designs Act, there is a prohibition of registration of certain designs where the design is not new or original or where it is not distinguishable from known designs, nowhere in the pleadings, either in the written statement or in the application for



summary judgment has the defendant submitted that the design of the respondents/ plaintiffs is not new or is common to the trade.

30. The defendant has pleaded prior publication only with reference to 310365, not with reference to design No.310835. Therefore, there cannot be a summary judgment in respect of a portion of the relief claimed by the plaintiffs and to relegate the parties to trial with reference to the latter part. Therefore, on this ground also, the defendant /applicant is not entitled to a summary judgment.

31. As an upshot of the above reasoning, the application filed for summary judgment has to be dismissed and is accordingly dismissed. Considering the fact that the written statement has been filed as early as on 01.04.2022, the parties shall submit their draft issues by 01.11.2023. Post the matter on 01.11.2023.

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Index : Yes/No
Speaking order/non-speaking order
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Pre-delivery order in
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