

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

IPDAID/43/2024

ARS STEELS AND ALLOY INTERNATIONAL PRIVATE LIMITED
VS
THE CONTROLLER OF PATENTS AND DESIGNS AND ORS.

For the appellant	:Mr. Ratul Das, Advocate Mr. R. Chandrasekhar, Advocate Mr. Vivek Gupta, Advocate Mr. S. K. Gupta, Advocate
For the Controller (respondent nos.1 & 2)	:Mr. Swatarup Banerjee, Advocate Mr. Sunil Singhania, Advocate Ms. Priti Jain, Advocate Mr. Shankharit Chakraborty, Advocate
For the private respondent no.3	:Mr. Ranjan Bachawat, Senior Advocate Mr. Avirup Chatterjee, Advocate Mr. Shantanu Guchhait, Advocate
Heard	: 23.02.2026
Judgment	: 07.05.2026

Ravi Krishan Kapur, J.:

1. This is an appeal against an order dated 10 April 2023 passed by the respondent no.2, the Deputy Controller of Patents and Design. By the impugned order, an application under section 19 of the Designs Act 2000 for cancellation of the registered design for 'Construction Rod' under class 25-01 bearing number-257980 in favour of the respondent no.3, Souvik Steels Private Limited has been rejected.

2. Both the appellant and the respondent no.3 are engaged in the business of *inter-alia* manufacturing TMT Bars. On 6 November 2013, the impugned design comprising of a double “XX-Rib” shape on the surface of construction rods was registered in favour of the respondent no.3. Subsequently, in early 2016, the respondent no.3 issued a notice to the appellant alleging infringement of the impugned design which ultimately culminated in the appellant filing an application for cancellation of the impugned design. There is also a suit for infringement of the impugned design filed by the respondent no.3 pending before the District Court at Bengaluru.
3. By the impugned order, it has been held that there has been no prior publication and the impugned design was not in public domain. The respondent no.2 rejected all the documentary evidence relied on by the appellant and concluded that the publications relied on by the appellant did not constitute prior publication. The contention that the impugned design was purely functional has also been rejected. On the contrary, it was held that the impugned design had an aesthetic eye appeal and was not a mere mechanical design. In such circumstances, the impugned design was registered as a design under the Act.
4. The grounds of challenge on which revocation of the impugned design was sought for are as follows: (a) The impugned design had been previously registered in India. (b) The impugned design had been published in India prior to the date of its registration. (c) There is nothing new nor original about the impugned design. (d) The impugned design is purely functional in nature. In such circumstances, the impugned design was liable to be cancelled. In support of such contentions, reliance was placed on the

decisions in *Gopal Glass Works Limited Vs. Assistant Controller of Patents and Designs and Ors.* 2005 SCC OnLine Cal 413, *Bharat Tubes Limited vs. Gopal Glass Works* (2008) 10 SCC 657, *SRMB Srijan Limited vs. Triveni Industries Pvt. Ltd. and Anr.* 2011 SCC OnLine Cal 1935 and *Lucky Exports vs. Controller of Patents and Designs and Others* 2019 SCC OnLine Cal 9125.

5. On behalf of the private respondent no.3, it is contended that the impugned order is reasoned and is not liable to be interfered with. The appellant had failed to disclose any materials whereby any design similar to the impugned design had been published prior to the registration. The finding in the impugned order that the registered design is not functional *per se* also warrants no interference. In passing the impugned order, the Controller has also considered the aspect of functionality and eye appeal and found that the impugned design was not a mere mechanical device. In this background, the appeal be dismissed. In support of such contentions, the respondent no.3 relied on the decisions in *KK Suwa Seikosha's Design Application* [1982] R.P.C 166, *TTK Prestige Ltd. vs. KCM Appliances Private Limited* 2023 SCC OnLine Del 2129, *KRBL Limited Vs Vikram Roller Flour Mills Limited* 2023 SCC OnLine Del 219 and *Cryogas Equipment (P) Ltd. v. Inox (India) Ltd.* (2025) 10 SCC 317.
6. On behalf of the Controller, it is submitted that the impugned order does not warrant any interference. The appellant has failed to demonstrate prior publication or any prior disclosure which is substantially similar to the impugned design. There was also nothing relied on by the appellant to prove priority. All the contentions raised by the parties have been fully considered in the impugned order. In support of such contentions, reliance

was placed on *Khaitan Ltd. Vs. Metropolitan Appliances* 1994 PTC 170 and *Hello Mineral Water Pvt. Ltd. v. Thermoking California Pure* 2000 PTC 177.

7. For convenience, the relevant provisions of the Designs Act 2000 are as follows:

2(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).

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 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. 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.

8. The crux of the grievance of the appellant was that the impugned design was liable to be cancelled on the ground of prior publication and that the design was neither new nor original. In this context, the appellant had relied on diverse documentary evidence in its Affidavit of Evidence. All these documents suggested that both X-Rib and XX-Rib designs were available in the market long prior to the date of registration of the impugned design. There were also numerous publications including inter-alia in the Indian

Concrete Journal published in 2004, 'Business Line' dated 8 September 2004 and 'The Hindu' 18 June 2011 all of which indicated that the X-Rib design was published and available in the market. Additionally, there were invoices relied on which suggested sales as far as back as in March 2003 and April 2003 for the 'X-Rib' TMT design Rods. The appellant also furnished evidence [Exhibit A-7 – M/s I Steel (since 2013) Exhibit A- 8 & 9 Indus Steel and Alloys Limited (since 2012) and M/s Blue Steel (since 2013)] to demonstrate that TMT Bars with the XX-Rib design were available and being used in the market.

9. In *Gopal Glass Works Limited Vs. Assistant Controller of Patents and Designs and Ors. (Supra)*, it has been held as follows:

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

10. Similarly, in *Bharat Tubes Limited vs. Gopal Glass Works (Supra)*, it has been held as follows:

“26. In fact, the sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act. It has also laid down that if a design is not new or original or published previously then such design should not be registered. It further lays down that if it has been disclosed to the public anywhere 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 then such design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known designs, then such designs shall not be registered. It also provides that registration can be cancelled under Section 19 of the Act if proper application is filed before the competent authority i.e. the Controller that the design has been previously registered in India or published in India or in any other country prior to the date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as defined in clause (d) of Section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has

already been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. These prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time. The new and original design when registered is for a period of ten years. Such original design which is new and which has not been available in the country or has not been previously registered or has not been published in India or in any other country prior to the date of registration shall be protected for a period of ten years. Therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is evident from the Statement of Objects and Reasons and from various provisions of the Act. In this background, we have to examine whether the design which was registered on the application filed by the respondent herein can be cancelled or not on the basis of the application filed by the appellant. In this connection, *Law of Copyright and Industrial Designs* by P. Narayanan (4th Edn.), Para 27.01 needs to be quoted.

“27.01. Object of registration of designs.—The protection given by the law relating to designs to those who produce new and original designs, is primarily to advance industries, and keep them at a high level of competitive progress.

‘Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but the appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will increase sales.’ The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods.

The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable (sic protectable) at all, ought to be made the subject-matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. Thus the primary concern, is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of articles of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.”

11. As a legal proposition, a design previously published is incapable of registration and is liable to be cancelled under section 4(a), 19(b) and (c) of the Act. This is because the design is already in public domain and on the date of application for registration there is nothing new nor original about the design. In order for a

document to constitute prior publication, the reader of it possessed of ordinary knowledge of the subject must from his reading of the document be able to at least see the design in his mind and should not have to depend on his own originality to construct the design from the ideas which the document may put in his head. In such circumstances, it was obligatory on the respondent no.2 to elaborately enquire into the aspect of whether there had been prior publication or not and whether the impugned design could be described as new or original. In passing the impugned order, the respondent no. 2 has failed to deal with all the evidence and disregarded the same including the publications relied on in examining whether such design or combination was available in the market prior to the date of registration. [*Super Smelters vs. SRMB Private Limited* (2020) 81 PTC 101 @ 52, *Kamdhenu Limited vs. Aashiana Rolling Mills Ltd.* (2021) 86 PTC 501 @ paras 42 to 47].

12. 'Original' means originated or conceptualized. "New" means different than what has gone before. In such circumstances, it was necessary for the respondent no.2 to consider and look at the two designs in question with an instructed eye and observe whether there is any such substantial difference or not. In such cases, the most important matter being what the various designs look like. Sometimes, a small variation in the details of the design may be enough to make a design different whereas in some cases even large alterations in details may make the two designs different. There must be a mental conception expressed in a physical form which did not exist before. This is what was required to be examined in the context of the definition of 'design' which is an idea or conception as to features of shape, configuration, pattern or ornament applied to an article. The introduction of ordinary trade variants into an old design does not make it new or original (*Phillips vs. Harboro Rubber Company* (1920) 37 RPC 233). This is a

serious infirmity in the impugned order inasmuch as the respondent no.2 has circumvented the issue of originality and novelty by relying purely on ocular impression. These are separate and distinct concepts having different legal implications. The conclusion of newness and novelty in the impugned order does not deal with the documentary evidence on record including the fact that the X-Rib design was in use by the SRMB Group since 2003 and Raipur Alloys since 2002. There has been no assessment of the 'X-Rib' design being common to the trade or being used in single, double or triple pattern in the impugned order. There has also been no reference to the 'state of the art' or "what was available in the market" before passing of the impugned order. This required a comparison of the impugned design with the existing designs and whether one would get a different overall impression when comparing the two designs. To this extent, it was necessary to examine whether the impugned design was unique and had any individual character *vis-a-vis* the prior arts. [*Western Engineering Company vs. Paul Engineering Company* AIR 1968 Cal 109, *Anuradha Doval vs. The Controller of Patents and Designs and Ors.* 2017 (71) PTC 288(Cal), *Shree Vari Multiplast India Pvt. Ltd. Vs. Deputy Controller of Patents & Designs* 2018 SCC OnLine Cal 5820, *Jayson Industries and Another vs. Crown Craft (India) Pvt. Ltd.* 2023 SCC OnLine Del 3750].

13. The impugned order is also selective in dealing with the decision in *SRMB Srijan Limited vs. Triveni Industries Pvt. Ltd. and Anr.* (Supra). This decision involved cancellation of a registered design i.e. X-Rib design in respect of TMT Rods which is the same category of goods. In the said decision, it was held that there was no novelty nor originality, insofar as the X-Rib design was concerned. On the aspect of prior publication, it was held on the basis

of the available materials, the design X-Rib had been published and was available in the market as far back as in 2001-2002. In those circumstances, the X-Rib design was found to be incapable of registration both on the ground of novelty and prior publication.

14. On the aspect of functionality, it is true as contended by the private respondent that a design which has both functional and aesthetic attributes is registrable (*Cow (P.B.) & Co. Ltd. vs. Cannon Rubber Manufacture Ltd. 1959 RPC 347*). Nevertheless, this required an assessment whether anything other than purely functional considerations could have been relevant when a specific feature was chosen. A design would only be excluded in totality where the design as a whole is dictated by function. In any event, this aspect ought to have been examined more fully in the background of the finding in *SRMB Srijan Limited vs. Triveni Industries Pvt. Ltd. (Supra)* that the X-Rib design was not functional. This also required fuller consideration in the impugned order and the conclusion arrived at on this aspect is bereft of any reasoning.

15. In view of the above, the finding of the Controller that there was 'no scope of enquiry' regarding similar products being available in the market is perverse and ignores all the documentary evidence relied on by the appellant including the decision rendered in *SRMB Srijan Limited vs. Triveni Industries Private Limited & Anr. (Supra)*. To this extent, the respondent no. 2 also failed to apply the correct legal tests in examining the question of novelty or originality of the impugned design. Thus, both on the issue of prior use and publication and whether the impugned design was new or original, the impugned order is unsustainable. In such circumstances, the

lacunae in the impugned order cannot be filled by submissions now raised at the appellate stage.

16. For the above reasons, the impugned order is set aside. The matter is remanded to a different Officer to hear the application for rectification afresh and after giving an opportunity of hearing to both parties. The entire exercise should be completed within three months from the date of communication of this order of the respondent no.1 Controller. It is made clear that all the findings on the merits are tentative in nature and shall not bind the Officer when re-examining the matter afresh. To the above extent, IPDAID/43/2024 stands allowed.

(Ravi Krishan Kapur, J.)