

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD**R/CIVIL SUITS NO. 2 of 2021****With
R/CIVIL SUITS NO. 3 of 2021****FOR APPROVAL AND SIGNATURE:****HONOURABLE MR. JUSTICE BHARGAV D. KARIA**

1	Whether Reporters of Local Papers may be allowed to see the judgment ?	NO
2	To be referred to the Reporter or not ?	NO
3	Whether their Lordships wish to see the fair copy of the judgment ?	NO
4	Whether this case involves a substantial question of law as to the interpretation of the Constitution of India or any order made thereunder ?	NO

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MITA ASHOK KAPOOR THROUGH POA PARESH AJITKUMAR KAPOOR
Versus
RAJ COOLING SYSTEM PRIVATE LIMITED

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Appearance:

for the Defendant(s) No. 10,11,5,6,7,8,9
MR SN SOPARKAR, SENIOR ADVOCATE WITH DR RAJESH H ACHARYA,
ZAHID SHAIKH, POOJA ACHARYA, JAYENDRA MODI, DYUTI MEHTA,
NILESH NAYAK, JAGRUTI BHAVSAR(2233) for the Defendant(s) No. 1,2,3,4
BIREN J PANCHAL(9300) for the Plaintiff(s) No. 1,2
MR MIHIR THAKORE, SENIOR ADVOCATE WITH MR HARSHIT S
TOLIA(2708) for the Plaintiff(s) No. 1,2
MR TEJAS S TRIVEDI(5692) for the Plaintiff(s) No. 1,2

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CORAM: HONOURABLE MR. JUSTICE BHARGAV D. KARIA**Date : 29/10/2021****CAV JUDGMENT**

ORDER BELOW EXH.6- APPLICATION FOR INTERIM INJUNCTION

1.Heard learned Senior Advocate Mr.Mihir Thakore and learned advocate Mr.Harshit Tolia for the plaintiffs and learned Senior Advocate Mr.S.N. Soparkar assisted by learned advocates Dr. Rajesh H. Acharya, Mr.Zahid Shaikh, Ms. Pooja Acharya, Mr. Jayendra Modi, Ms. Dyuti Mehta, Mr. Nilesh Nayak and Ms. Jagruti Bhavsar for the defendants.

2.The plaintiffs have filed these suits under the provisions of the Design Act, 2000 for infringement of the design of the plaintiffs by the defendant No.1.

3.The Civil suit No.2 of 2021 is filed on the ground that the plaintiff No.1 is the registered proprietor of a design being registration No.324986-017 w.e.f. 24th December, 2019 and valid upto 23rd December, 2029 in Clause-23-04 in respect of the product of frill for air-cooler. The plaintiffs have alleged that the defendants are pirating the registered design of the plaintiffs and have started manufacturing/using/

selling their product of grill for air-coolers by applying the registered design and/or its fraudulent or its obvious imitation to their product of grill for air-coolers.

4. Whereas Civil suit No.3 of 2021 is filed for the infringement of the design of the back side of the same grill of the air cooler and hence applications Exh.6 filed for interim injunction in both the suits were heard analogously and the same are disposed of by this common order. For sake convenience, the facts and documents produced o record of Civil Suit No.2 of 2021 are considered.

5. According to the plaintiffs, the plaintiff No.1 is doing its business including the activity of research and development of novel and unique designs of air-cooler and its components like grill for air-cooler and manufacturing, marketing, selling and exporting the air-coolers and its components like grill for air-cooler across the country and to several foreign countries also. The plaintiff No.1 is the proprietor of the plaintiff No.2 in whose name there

is a registered design.

6.It is the case of the plaintiffs that in the year 2019, the plaintiff No.1 invented and developed one novel design in respect of the grill for air-cooler applied to the product of the plaintiff's air-cooler, which are being sold under different model names and the plaintiffs have developed a novel and unique shape, surface, pattern and configuration of the entire grill for air-cooler from all the six sides of the product.

7.As per the plaintiffs, after the rigorous scrutiny and examination as provided under the provisions of the Design Act, 2000 the competent authority was satisfied that the design of the plaintiffs is new, original, novel and unique and therefore, the same was registered.

8.According to the plaintiffs, after registration of the design, the plaintiff No.2 started manufacturing, marketing, using, selling and exporting the product of grill for air-cooler into the market on the large scale and the

grills are sold separately as well as applying on the product of different air-cooler by the plaintiff on various models manufactured by the plaintiff No.2.

9. According to the plaintiffs, the design of the grill for air-cooler is of higher quality, attractive and appealing to the eye and capable to satisfy all the ingredients of the design within the meaning of Section 2(d) of the Design Act, 2000 as the same is new and original design.

10. As per the plaintiffs, no one was available to copy the product with the registered design of the plaintiffs at any level including the commercial level.

11. The plaintiffs came to know in the year 2020 that the defendant No.1 who is also the manufacturer of air-cooler including the grills has started infringing the design of the plaintiffs and accordingly, the plaintiffs filed Civil Suit No.106 of 2021 before the District and Sessions Judge, Jaipur Metro-II, Jaipur with regard to the

registered design of the plaintiffs bearing registration No.233559 in respect of the article of air-cooler falling in Class-23-04 under Section 22 of the Design Act, 2000 along with an application under Order 39 Rule 1 and 2 of the Code of Civil Procedure, 1908 (for short "the Code"), wherein the Court granted ex-parte ad-interim injunction against the defendant Nos.1 to 4 restraining them from infringing the registered design.

12. It is the case of the plaintiffs that the defendant No.1 has also started imitating the registered design of the plaintiffs, which is the subject matter of the suit, by applying the same to its grill for air-cooler and selling the same in the market. Upon inquiry made by the plaintiffs in the market, it came within the knowledge of the plaintiffs that the defendant No.3 who is the Director of the defendant No.1 Company Raj Cooling System Pvt. Ltd. has copied and fraudulently applied for registration of one design vide registration No.325587-001 w.e.f. 6th January, 2020 which is same as

registered design of the plaintiffs as per the registration No.324986-017 registered w.e.f. 24th December, 2019.

13. The plaintiffs have therefore, filed an application before the controller of Designs for cancellation of the registration of the design in the name of the defendant No.1.

14. The plaintiffs thereafter came to know that the defendants are marketing the grill for air-coolers which is similarly copied as that of the plaintiffs in the market and committed the act of infringement of the registered design of the plaintiffs. The plaintiffs thereafter found brochure of the defendant No.1 Company wherein the photographs of various business activities and products of the financial year 2018-19 and 2019-20 were published, wherein, the disputed grill for air-cooler was not shown. It is therefore, the case of the plaintiffs that the defendants have not started manufacturing of the disputed grill for marketing. However, the plaintiffs came to know about the disputed grill i.e.

article in question and infringement made by the defendants. When the plaintiffs have made an inquiry in the market, they found that the defendant Nos.5 to 11 are getting the article in question manufactured from defendant Nos.1 to 3 and selling the same in their separate names within the territorial jurisdiction of the Court at Dholka and surrounding areas. The plaintiffs therefore, filed the suit before the District Court, Ahmedabad at Dholka, which was registered as Trade Mark Suit No.1 of 2021.

15. The 10th Additional District Judge, Ahmedabad passed an order on 1st May, 2021 granting ex-parte ad-interim injunction against the defendants. Thereafter, the defendants filed an application under Order 7 Rule 11 of the Code on 13th May, 2021 and after considering the reply of the plaintiffs, the District Court rejected the application of the defendants under Order 7 Rule 11 of the Code. Thereafter, the defendants filed a written statement-cum-reply along with the documents with the pleadings of

invalidity of the registered design of the plaintiffs by way of prior publication on 19th May, 2021.

16. In view of the written statement filed by the defendants raising defense of invalidity of the registered design of the plaintiffs by way of prior publication, the plaintiffs filed an application under Section 22(4) of the Design Act, 2000 on 1st June, 2021 transferring the suit to the High Court.

17. The District Court after considering the reply filed by the defendants passed the order on 8th June, 2021 to transfer the suit.

18. This Court passed the following order on 18th August, 2021 :

"Both the captioned suits have been transferred to this Court on 11.8.2021. Following order was passed by this Court.

"In view of the request of learned advocate, the Office shall prepare submission in writing mentioning details about the orders which may have been passed earlier and presently subsisting by the Court below in the present suit

which now have been transferred to this Court and have been received by Post to be accordingly posted today. Such submission shall be made available on the next date. Stand over to 18.8.2021."

2. Pursuant to the aforesaid order, the office has put up Note dated 17.8.2021 which accompanies the papers of the suits and they are placed on board today. The Note provides the chronology of orders which were passed by the Court below. It appears that the ad-interim injunction granted on 29.4.2021 came to be continued for such time till the matter is transferred and first listed before the High Court. This was the order lastly passed on 8.6.2021 by the Court below.

3. In view of the above, the interim order passed by the Court below on 8.6.2021 and which came to be continued by interim order passed by the Court below from time to time and continued as above, shall continue to operate from the date when the suits came to be listed first before this Court that is 11.8.2021 till the present suits are placed before this Court for hearing.

The suits may be listed by Registry after three weeks upon ascertaining the appearances which may be filed."

19. Thus, the interim order passed by

the trial Court was ordered to be continued to operate from time to time. Thereafter, the hearing of the application Exh.6 filed by the plaintiffs under Order 39 Rule 1 and 2 of the Code was fixed for hearing on 30th September, 2021 and the same was heard on the said date and on the next date on 1st October, 2021.

SUBMISSIONS OF THE PLAINTIFFS

20. Learned advocate Mr. Tolia for the plaintiffs as well as learned Senior Advocate Mr.Mihir Thakore jointly made submissions on behalf of the plaintiffs.

21. Learned advocate Mr. Tolia submitted that the defendants have copied the registered design of the grill for the air-coolers of the plaintiffs and referred to page nos.1 to 7 of the documents produced along with the list with the suit to point out that the plaintiffs have registered their design on 24th December, 2019 bearing design No.324986-017 with regard to the design of the grill for air-coolers so far as the novelty resides in the shape, surface, pattern and configuration of

the "Grill for Air Cooler" as illustrated on the representation sheet filed before the Controller of Patent and Designs at the competent officer. The registration is granted with regard to all the six sides of the grill of the air-cooler.

22. Learned advocate Mr. Tolia thereafter showed replica of the design of the plaintiffs in a miniature form with that of the plaintiff together with the photographs produced side by side to show that the look and aesthetics of the product of the plaintiffs as well as the defendants are almost similar. Attention of the Court was also invited to the photographs which are from page nos.10 to 19 of the suit.

23. Learned advocate Mr. Tolia thereafter, referred to page nos.20 to 49 to point out the similarity of the design in question with regard to total number of ribs, side height dimension, side length dimension, side diagonal dimension, side border length dimension, side border height dimension, distance between two height side border holes,

distance from top to bottom side hole,
distance from top to corner side hole,
distance between first circle to top,
distance between second circle to top,
distance between third circle to top,
distance between forth circle to top,
distance between fifth circle to top,
distance between sixth circle to top,
front side length inner dimension, front
side height inner dimension, front side
rib thickness, front side logo circle
diameter, rear side length dimension,
rear side height dimension, rear side
length inner dimension, rear side height
inner dimension, rear side border height
dimension, rear side border length
dimension, rear side circle diameter,
rear height side hole distance, rear
height side distance between two holes,
rear height side bottom hole distance.

24. From the photographs of the various sides and designs particulars, it was pointed out that the defendants have copied each aspect of the registered design of the plaintiffs in every manner to the exact perfection as that of the plaintiffs' design. It was pointed out and shown from the above photographs

that as such there is no difference in any manner whatsoever between the grill for air-cooler which is registered having registered design of the plaintiffs as that of the grill of air-cooler which is registered design of the defendant.

25. Learned advocate Mr. Tolia thereafter submitted that the brochure at page no.51 of the list of the plaintiff No.2 clearly shows the design of the grill of the air-cooler on the cooler of the air-cooler manufactured by the plaintiff No.2.

26. Learned advocate Mr. Tolia referred to the certificate issued by the Chartered Accountants M/s. Sachin Dani and Associates dated 14th March, 2021, wherein the advertisement and marketing expenses and transportation and travelling expenses for the plaintiffs in the year 2018-19 and 2019-20 are certified. Learned advocate Mr. Tolia has also referred to the details of the design in question being sold by the plaintiffs on various air-coolers supplied and sold. It was also submitted

that the plaintiffs are in the business of manufacturing and marketing of air-coolers since last more than 10 years.

27. Learned advocate Mr. Tolia, with a view to show that the defendants are in the habit of infringement of the designs, referred to Civil Suit No.106 of 2021 filed by the plaintiff No.2 and one Paresh Ajitkumar Kapoor before the District and Sessions Court, Jaipur Metro-II, at Jaipur with regard to the infringement of the design of the plaintiff No.2 bearing No.233559 the product of air-cooler of the plaintiff No.2. Reference was also made to the order dated 26th February, 2021 of the District Court, Jaipur granting injunction in favour of the plaintiffs against the defendants with regard to the use of the design bearing No.233559. Learned advocate Mr. Tolia also referred to the order passed by the 10th Additional, District and Sessions Judge, Ahmedabad (Rural) at Mirzapur dated 6th March, 2021 below Exh.-5 in Trade Mark Suit No.5 of 2021, restraining the defendants from using the trade mark "Winter" and/or "Winter Cool" bearing

Registration No.1326899 and 3056554 as well as such similar order dated 8th March, 2021 passed in Trade Mark Suit No.6 of 2021 from using the trade mark "Strom" and/or "Strom Cool" bearing Registration No.2111571 and 3056542 of another manufacturer in the trade name 'Symphony'. It was therefore pointed out that the defendants are habitual in copying and infringing the designs of other competitors and manufacturers of air-coolers.

28. Learned advocate Mr. Tolia invited that attention of the Court with regard to the application filed by the plaintiffs for cancellation of the registered design of the defendants before the Controller of Patent and Design, which is pending for adjudication.

29. Learned advocate for the plaintiffs also referred to the invoices for sale of the various air-coolers using grill prior to its registration as well as after the date of the registration from 7th February, 2019 till 1st October, 2020 to submit and show that the plaintiffs

are in business of selling the air-coolers. It was submitted by learned advocate Mr. Tolia that the air-cooler bearing No.TK09GB is sold by the plaintiff No.2 in order to demonstrate that the plaintiffs are in the business of selling such air-coolers on the basis of the invoices.

30. In view of the above facts and documentary evidence produced on record along with the complaint, it was submitted that there is a strong prima facie case in favour of the plaintiffs as the plaintiffs have registered their business in respect of the disputed grills in prior point of time and the same is being used by the plaintiffs in manufacturing, marketing the same across the country since then. It was pointed out that from the photographs produced on record, the exact similarity between the design in question manufactured and registered by the plaintiffs as that of the defendants from page nos.20 to 49 of the record clearly show that the defendants have copied the design registered by the plaintiffs and therefore, the balance of convenience is

also in favour of the plaintiffs and the court below has rightly passed the ex-parte injunction on 29th April, 2021 by allowing the application Exh.-6.

31. It was also further pointed out that ex-parte interim injunction granted by the Court below is not extended or confirmed by this Court during the pendency of the suit and irreparable loss would be caused to the plaintiffs if the defendants are permitted to use registered design of the grill of the air-cooler as it would take considerable time to finally dispose of the suit by this Court.

32. In support of his submissions, learned advocate Mr. Tolia has relied upon the following decisions :

i) In case of **Whirpool of India Ltd. v. Videocon Industries Ltd.** reported in 2014 SCC OnLine Bom 565, wherein the Bombay High Court has held as under :

"23. For the reasons discussed above, I am of the considered view that a registered proprietor of a design can under [Section 22](#) of the Act file a suit for infringement

against a registered proprietor of a design.

27. The principle which clearly emerges from the above is that the test in deciding such matters is: "judged solely by the eye are the essential features present or are the two substantially different".

ii) In case of **Win Plast Ltd. v. Symphony Ltd.** (judgment dated 27.07.2015 in O.J. Apepal No. 32/2015 and allied matter), wherein this Court has held as under :

"35. A useful reference can also be made to the judgment reported in 1990 Supp. 1 SCC 727 in the case of Wander Limited v. Antox India Private Limited, relied upon by learned Sr. Counsel Shri Thakore.

36. Further, the approach while considering the application for injunction or exercise of discretion has to be regarding balancing the two conflicting rights or obligations. One more aspect which is considered is comparative hardship. Further, while considering the provisions of the statute like Designs Act or such laws for the intellectual property rights, the legislature has itself balanced such right of creating monopoly over a limited period and providing for the business consideration. However, by judicial interpretation it has been well accepted that if such registered proprietor or the owner

of the mark, whether it is under the Trade Marks Act or it is under the Designs Act, prima facie establishes infringement of the mark, the injunction would follow.

37. A useful reference can be made to the judgment of Hon'ble Apex Court reported in AIR 1965 SC 980 in the case of Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories regarding the provisions of the Trade Marks Act. Though it is with reference to the Trade Marks Act, on analogy, the same principle would apply when the infringement of the mark under the Designs Act is also complained of."

iii) In case of **Paresh D. Patel & anr. v. Smit N. Parmar** (judgment dated 20.07.2012 in Civil Suit No.4 of 2012), wherein this Court has held as under :

"65. It is pertinent to note that the defendant has not filed any application for cancellation of the registered design of the plaintiffs before the Controller. It is the say of the plaintiffs that they became aware of the imitation of their design by the defendant on 6th, 7th and 8th January, 2012, that is, after filing the application for registration of the design on 29.07.2010, and grant of the Certificate of Registration on 19.01.2011.

Considering the rival submissions, statutory provisions and judicial pronouncements cited by the respective parties and as there is an obvious and striking similarity in the design of the plaintiffs and that used by the defendant, and as there does not appear to be cogent material on record to indicate that the defendant has been using the same design prior to the date of application by the plaintiffs, and for the reasons stated hereinabove, this Court is of the considered view that the plaintiffs have made out a *prima facie* case for grant of temporary injunction.

66. The balance of convenience is also found in favour of the plaintiffs, who would suffer irreparable loss to their business and goodwill in the market if their design is not protected. Moreover, no prejudice to the business of the defendant would be caused if an injunction is granted, as the defendant is free to use any other design than the registered design of the plaintiffs."

iv) **Symphony Ltd. v. Wim Plast Ltd and others** (order dated 05.05.2015 in Civil Suits No. 2 of 2015), wherein this Court has held as under :

"13. The Court, therefore, proposes

to advert the definition of design itself as it is mentioned in the Designs Act. Section-2(d) of the Designs Act reads as under:-

"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 © of section 2 of the Copyright Act, 1957 (14 of 1957);"

14. The plain and simple reading of the definition of design would include the following:- (1) the features of shape; (2) configuration that means arrangement, fixations or broadly giving its shape; (3) pattern; (4) ornament and/or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms. The process is prescribed to be an industrial process or means whether manual,

mechanical or chemical, separate or combined, which in furnished article will have appeal to the eye, meaning thereby the aforesaid features of shape, configuration, pattern, ornament or composition of lines or application of colours by way of process being manufacture or otherwise so as to make article appealable to the eye, is the process of design article. The second part of the definition provides exclusion which would obviously include any mode and principle of construction or anything which is in substance 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 or property mark as defined in Section 479 of the Code or any artistic work as defined in clause (c) of section-2 of the Copyright Act. Meaning thereby the piece of article for shape of article, created would surely not be following as per specification. The test therefore is to be canvassed to the design which is not interpreted with the aspects of the trade-mark or copyright article, is covered by these Acts. In other-words to make it from simple answering of the article looks or article appeal to the consumer and/or user without being it in any manner part of the process of functionality or answering the functionality, otherwise, required to be essential would be protected under the Designs Act. In other-words, it can well be said that providing a water mark in a water

cooler is a functional requirement prescribed by BIS standard. Therefore, water mark or window to get the water level is a functional requirement which is bound to be there in water cooler. The averments thereof on a body of water cooler, other location would fall under the design. The specification thereof with colour, style and shape would fall under the design part which can be protected. Therefore, bearing this definition of design in mind now let me think the decisions relied upon by the learned counsel for both the sides in support of their rival contentions.

19. The close perusal of these decisions cited herein above persuade this Court to say that what is important is the design appealed to the consumers' eye. The Court is unable to accept the submission made on behalf of the defendants that 'trained eye' or 'deserving eye' is required to be applied for examining the design. As those judgment cited on their behalf, if perused closely, would show that there was a stage when the Court was called upon to examine the design in comparison with the earlier designs. In the instant case, unfortunately for the defendants, they have not produced any materials to indicate that there exists design prior to the design registered by the present plaintiff. Therefore, in absence of any such materials, the Court would not be in a position to accept the plea of 'deserving eye' or 'trained eye', as sought to be made out by the counsel for the defendants to

adjudge the claim of originality or duplication or replication. If one looks at two sets of designs applied by the plaintiff on their articles and on the defendants of their products then, the Court has to accept the submission of learned counsel for the plaintiff that two consumers eye difference is absolutely not desirable and therefore, at this stage, prima-facie to accept there is a substance and what has been contended on behalf of the plaintiff's article, is 'obvious imitation' of the design, which has been registered long back by the plaintiff. This observation of the Court is prima-facie and shall have no bearing of the examination of the issue at large when the evidences are adduced in its totality at the hearing of the suit stage. But suffice to it say that so far as the documents produced viz.brochures of the other products then, the perusal of the brochures would also leave no room of doubt in saying that there is marked similarity between the design of the plaintiff and those of the defendants, which has been assailed to be imitation by the plaintiff. The Court is also not impressed by the findings and point of difference pointed out on behalf of the defendants to suggest their existence difference in continuing small detailing as the court is of the considered view that what is to be borne in mind is the word "obvious imitation". The "obvious imitation" attempted to be a vital on account of small meaning and answer features of distinctive. But,

those features of distinctive, if are not capable to readily notice to the consumers, then the same will have to be treated as merely imitation and those fine difference will have to be treated as incorporated merely to avoid the charge of imitation. Therefore, prima-facie, this court has to record that the designs of the defendant in respect of four articles appear to be "obvious imitation" than the design registered by the plaintiff. Having come to the prima-facie conclusion based upon the examination aspects and hearing of the counsel, this Court will have to consider the other contention raised on behalf of the defendants for registering the suit, as per prayer made in the suit. This will have to be considered on the maintainability aspect of the preliminary issue raised by the defendants that continuation suit on passing off design, is not maintainable and it was contended that both the action i.e. infringement and passing off would not be available and therefore, the reliance is placed upon the decision of the Supreme Court in case of 'Dhodha House Vs. S.K. Maingi' reported in 2006 (9) SCC 41. This judgment is based upon the aspect of nonavailability of peculiar clause which canvassed the right upon the plaintiff to bring at the place of ordinarily business.

The decision cited at bar in the case of 'Paragon Rubber Industries (Supra)' would clearly indicate the jurisdictional power of court. This

plea is considered as to whether the defendants' counsel is justified in submitting that there exists no cause of action for bringing in action or filing of the suit in Ahmedabad as it was merely on apprehension. But the Court is persuaded to hold that the counsel for the plaintiff is justified in submitting the action, which is based upon qua-timet action. In absence of specific plea which obviously could not have been opened the product intended to sell in Ahmedabad. The link established from the website of the 'cellocooler.com' would indicate that such intention was obvious and therefore, the said pleadings when has not been controverted, the same cannot be brushed aside merely holding to its perception based upon the threat.

The decision of Delhi High Court in the case of 'Pfizer Products Inc Vs. Rajesh Chopra & Ors.' reported in 2006 (32) PTC 301. The said decision would support the aforesaid proposition. Therefore, the action cannot be said to be wholly based upon the apprehension or like any base. On the contrary, the chain of functioning leading to filing of the suit and the documentary evidence produced on record, indicate that their existence based for genuine apprehension qua the infringement and passing off in Ahmedabad. Therefore, the Court is unable to accept the submission canvassed on behalf of the defendants in this behalf. This brings the Court to consider the second submission in

respect of the action being not available for piracy, infringement or registered designs against the holder of registered design. The counsel for the defendants submitted that the majority view of 'Micolube India Limited Vs. Rakesh Kumar Trading & Ors.' coupled with the Calcutta High Court Judgment be treated as guiding the principle. This Court is unable to accept this submission as the peculiar provision of this Act would indicate that the action is permitted the registered design owner on the ground mentioned thereunder and one of the ground is ground on which it can be argued that the design originally could not have been registered on account of difference being not original or new."

v) In case of **Laxmikant V. Patel v. Chetanbhai Shah and another** reported in (2002) 3 Supreme Court Cases 65, wherein the Apex Court has held as under :

"14. In the present case the plaintiff claims to have been running his business in the name and style of Muktajivan Colour Lab and Studio since 1982. He has produced material enabling a finding being arrived at in that regard. However, the trial court has found him using Muktajivan as part of his business name at least since 1995. The plaintiff is expanding his business and exploiting the reputation and goodwill associated with Muktajivan in the business of Colour Lab and

Photo by expanding the business through his wife and brother-in-law. On or about the date of the institution of the suit the defendant was about to commence or had just commenced an identical business by adopting word Muktajivan as a part of his business name although till then his business was being run in the name and style of Gokul Studio. The intention of the defendant to make use of business name of the plaintiff so as to divert his business or customers to himself is apparent. It is not the case of the defendant that he was not aware of the word Muktajivan being the property of the plaintiff or the plaintiff running his business in that name though such a plea could only have indicated the innocence of the defendant and yet no difference would have resulted in the matter of grant of relief to the plaintiff because the likelihood of injury to the plaintiff was writ large. It is difficult to subscribe to the logic adopted by the Trial Court, as also the High Court, behind reasoning that the defendants business was situated at a distance of 4 or 5 Kms. from the plaintiffs business and therefore the plaintiff could not have sought for an injunction. In a city a difference of 4 or 5 Kms. does not matter much. In the event of the plaintiff having acquired a goodwill as to the quality of services being rendered by him a resident of Ahmedabad city would not mind travelling a distance of a few kilometers for the purpose of availing a better quality of services. Once a case of passing off

is made out the practice is generally to grant a prompt ex-parte injunction followed by appointment of local Commissioner, if necessary. In our opinion the trial court was fully justified in granting the ex-parte injunction to the plaintiff based on the material made available by him to the court. The Trial Court fell in error in vacating the injunction and similar error has crept in the order of the High Court. The reasons assigned by the Trial Court as also by the High Court for refusing the relief of injunction to the plaintiff are wholly unsustainable.

17. We are conscious of the law that this Court would not ordinarily interfere with the exercise of discretion in the matter of grant of temporary injunction by the High Court and the Trial Court and substitute its own discretion therefor except where the discretion has been shown to have been exercised arbitrarily or capriciously or perversely or where the order of the Court under scrutiny ignores the settled principles of law regulating grant or refusal of interlocutory injunction. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by

the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial courts exercise of discretion [(see [Wander Ltd. v. Antox India P.Ltd](#) : 1990 (Supp) SCC 727 and [N.R. Dongre v. Whirpool Corporation and another](#): (1996) 5 SCC 714)]. However, the present one is a case falling within the well accepted exceptions. Neither the Trial Court nor the High Court have kept in view and applied their mind to the relevant settled principles of law governing the grant or refusal of interlocutory injunction in trade mark and trade name disputes. A refusal to grant an injunction in spite of the availability of facts, which are prima facie established by overwhelming evidence and material available on record justifying the grant thereof, occasion a failure of justice and such injury to the plaintiff as would not be capable of being undone at a latter stage. The discretion exercised by the Trial Court and the High Court against the plaintiff, is neither reasonable nor judicious. The grant of interlocutory injunction to the plaintiff could not have been refused, therefore, it becomes obligatory on the part of this Court to interfere.

18. For the foregoing reasons these appeals are allowed. An ad-interim injunction under Rules 1 and 2 of Order 39 of the CPC shall issue in favour of the plaintiff-appellant restraining the defendant-

respondents from using directly or indirectly the word Muktajivan in their trade name associated with the business and services of colour lab and studio and any other similar word or name which may be identical or deceptively similar to the plaintiffs trade name. The plaintiff-appellant shall be entitled to costs throughout incurred upto this stage."

vi) In case of **Ramdev Food Products (P) Ltd v. Arvindbhai Rambhai Patel and others** reported in (2006) 8 Supreme Court Cases 726, wherein the Apex Court has held as under :

"122. Thus, when a prima facie case is made out and balance of convenience is in favour of the appellant, it may not be necessary to show more than loss of goodwill and reputation to fulfil the condition of irreparable injury. In fact, if the first two pre-requisites are fulfilled, in trade mark actions irreparable loss can be presumed to have taken place.

123. The expression "irreparable injury" in that sense would have established injury which the plaintiff is likely to suffer."

vii) In case of **Midas Hygiene Industries (P) Ltd and another v. Sudhir Bhatia and others** reported in (2004) 3

Supreme Court Cases 90, wherein the Apex Court has held as under :

"5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest."

viii) In case of **M/s. Hindustan Pencils Private Limited v. M/s. India Stationery Products Co. & another** reported in AIR 1990 Del 19, wherein Delhi High Court has held as under :

"27. It appears difficult for me to comprehend the distinction which the Courts have sought to make between the grant of interim injunction and permanent injunction. If on the facts which are clearly discernible from the record it appears that after trial a permanent injunction is likely to be granted, notwithstanding the delay on the part of the plaintiff in approaching the Court, there appears to be no reason as to why temporary injunction should be refused."

ix) In case of **M/s. Videocon Industries**

Limited v. M/s. Whirlpool of India Limited reported in 2012 SCC OnLine Bom 1171, wherein the Bombay High Court has held as under :

"35. We do not find any merit in the contention that the learned trial Judge ought not to have granted the relief of injunction at the ad-interim stage and ought to have deferred the decision regarding it till the conclusion of the trial. Once it is clear that the registered design has been infringed and the goods are being passed off, then, in view of the object for which the Act is enacted, it is necessary to restrain the infringer forthwith unless exceptional grounds are made out for refusal. After coming to a prima-facie conclusion that there is infringement of registered design, the injunction cannot ordinarily be deferred till the conclusion of the trial. To do so, will make the protection granted under the Act, illusory. Once a prima-facie case was made out in this case that the registered design of Whirlpool was infringed, then the balance of convenience was in restraining the Videocon from benefiting from the infringement. Thus, the learned trial Judge was right in injuncting the Videocon from manufacturing and marketing the impugned product at the ad-interim stage. Even otherwise, the Videocon had full opportunity of presenting its case before the order and had in fact filed a detailed affidavit in

reply.M/S. Videocon Industries Limited v. M/S Whirlpool of India Limited."

x) In case of **S.D. Containers Indore v. Mold-Tek Packaging Limited** reported in (2021) 3 Supreme Court Cases 289, wherein the Apex Court has held as under:

"19. The Bombay High Court in Whirlpool of India was dealing with a suit against the Defendant for infringement of the registered designs; passing off; and the damages. The defendant never sought the cancellation of the registration granted to the plaintiff but relied upon the registration granted to it. In these circumstances, the High Court held as under:

"19. In support of its contention that the Defendant's registered design can only be challenged by proceedings under [Section 19](#) of the Act before the Controller, the Defendant would argue that the availability of a remedy under [Section 19](#) of the Act for cancellation of a registered design amounts to a negation and exclusion of remedy under [Section 22](#) of the Act. This is plainly incorrect. [Section 19](#) and [Section 22](#) of the Act operate independently in different circumstances. [Section 19](#) of the Act is invoked to seek cancellation of a registration of a design. [Section 22](#) of the Act is invoked where a registered design of a proprietor is infringed by any person and the

registered proprietor seeks reliefs in the form of damages, injunction, etc. against the infringer. Such relief can be sought even against a registered proprietor of a design by questioning his registration. The Defendant too can submit that the Plaintiff is not entitled to any relief in terms of damages, injunction etc. by questioning the registration of the Plaintiff's on grounds available under [Section 19](#) of the Act for cancellation of a registration. Again, [Section 19](#) entitles a party to move the Controller for cancellation of a design even where the registered proprietor is not using the design. [Section 19](#) therefore affords a cause of action where a mere registration is considered objectionable and a mere factum of registration affords a cause of action. In marked contrast, [Section 22](#) of the Act affords a cause of action only where a registered design is being applied or caused to be applied to any article for the purposes of sale or in relation to or in connection with such sale. Consequently, if a registered proprietor does not apply his design to an article for sale or in connection with such sale, another registered proprietor cannot have recourse to [Section 22](#) of the Act. The remedy under [Section 22](#) of the Act is only available where the impugned design is being used. A further distinction between [Section 19](#) and [Section 22](#) of the Act, as correctly pointed out on behalf of the Plaintiff is that while [Section 19](#) is applicable to 'any person interested', [Section 22](#) is available only to a small

segment of such person viz. registered proprietors. The remedy under [Section 19](#) and the remedy under [Section 22](#) are therefore very different. They apply to different persons in different circumstances and for different reliefs."

SUBMISSIONS OF THE DEFENDANTS

33. On the other hand, learned Senior Advocate Mr. Soparkar for the defendants submitted that Section 22 of the Designs Act, 2002 refers to piracy of design and Sub-section (3) of Section 22 permits or allows the defendants to take every ground on which the registration of the design may be cancelled under Section 19 as a ground of defense.

34. It was submitted by Mr. Soparkar that the defendants have made an application to place on record additional documents which are otherwise forming part of the documents submitted by the defendants along with the written statement under Order 8 Rule 1(a)(3) of the Code, which were submitted after the suit was transferred to this Court.

35. It was submitted that under the

provisions of the Design Act, 2000 without separately seeking cancellation of the registration of the design under Section 19 of the Act, in a suit for infringement filed under Section 22(2) (b), the defendants can raise validity of registration as a ground of defense under Section 22(3) of the Act, separate and independent application for cancellation under Section 19 would not lie.

36. In support of his submission, reliance was placed on the following decisions :

i) In case of **Alloys Wobben and another v. Yogesh Mehra and others** reported in (2014) 15 Supreme Court Cases 360.

ii) In case of **Pravinbhai Jagjivandas Mehta v. Officine Lovato S.P.A.** reported in (2002) 25 PTC 161 (Guj).

iii) In case of **Rotela Auto Components (P) Ltd. & anr. v. Jaspal Singh & ors.** reported in (2002) 24 PTC 449 (Del).

37. It was pointed out that the defendants have raised the plea that the

design registered by the plaintiffs is not valid in view of the provisions of Section 19(1)(b) of the Design Act, 2000.

38. It was submitted that according to the defendants, the plaintiffs have published the registered design of the grill of the air-cooler in India prior to the date of registration. In response of such submission made on behalf of the defendants, reliance was placed on the additional documents produced along with an application under Order 8 Rule 1(A) (3) of the Code. The said application filed by the defendants is objected by the plaintiffs. The plaintiffs have filed a rejoinder objecting such application. As of now, such application is not decided to take such documents on record. However, the documents produced along with such application are as referred by the learned Senior Advocate Mr. Soparkar and therefore, the same are considered for the purpose of deciding this application under Order 39 Rule 1 and 2 of the Code as an affidavit-in-rejoinder is filed on behalf of the plaintiffs, wherein, veracity of the

documents relied on behalf of the defendants are explained and objected in detail.

39. Learned Senior Advocate Mr. Soparkar referred to the copy of the screen-shots regarding invitation to the exhibition at New Delhi in august, 2019 along with the photographs of the exhibition as well as the copy of the screen-shots of the exhibition at Jaipur, copy of the Amazon Web pages containing details of plaintiffs' product, wherein, registered design of the grill of the air-cooler of the plaintiffs is shown as part of the air-cooler "Coolstar TK12GB Cooler-125 L, White", the compact disk containing video of the exhibition, wherein the plaintiffs have participated, is also attached with the aforesaid application.

40. It was submitted by learned Senior Advocate Mr. Soparkar that the documents produced along with the plaint by the plaintiffs include invoices from page no.377 to 387 which are prior to the date of application made by the plaintiffs showing that the plaintiffs have sold the air-coolers prior to the

date of the application for registration of the design made on 24th December, 2019.

41. It was therefore, submitted by learned Senior Advocate that the aforesaid documents prima facie show that the plaintiffs have published the registered design of grill of the air-cooler prior to the registration and therefore, the same is invalid as the plaintiffs have displayed the registered design in the trade-fair on the website of Amazon web site and actually sold in the market which is prima facie evident from the record produced by the defendants including the plaintiffs. Reference was made to paragraph at page no. 70 of the plaint to submit that the documents produced with separate list included copies of invoices of the plaintiffs for products - subject matter of the suit which is also referred to at serial number 19 in the list. It was therefore, submitted that prima facie the defendants are able to show that the plaintiffs have published the design prior to the date of registration and therefore, the registered design is

invalid, liable to be cancelled.

42. Learned advocate Mr. Soparkar submitted that mere registration of the design is not the proof of its validity, more particularly, when such design is recently registered. It was submitted that various courts have held that where validity of the registered design is challenged, the injunction would be refused.

43. In support of his submissions, learned Senior Advocate Mr. Soparkar has relied on the following decisions :

i) In case of **M/s. Niki Tasha India Pvt. Ltd. v. M/s. Faridabad Gas Gadgets Pvt. Ltd** reported in AIR 1958 Del 136.

ii) In case of **Garware-wall Ropes Ltd. v. M/s. Techfab India and ors.** reported in 2008 SCC OnLine Guj 80.

iii) In case of **Galatea Ltd. v. Diyora and Bhanderi Corporation** (order dated 26.03.2018 in R/Civil Suit No.2 of 2017).

iv) In case of **Galatea Ltd through authorised signatory Gilad Hissad v. Diyora and Bhanderi Corporation through partner Pravin Dharamshibhai Lakhani** reported in 2018 SCC OnLine Guj 1886.

44. Relying upon the above decisions, it was submitted that the plaintiffs have not denied the fact of prior publication even in the rejoinder affidavit, wherein in paragraph 12 thereof it is stated that "in fact, the said sales turnover is not only with respect to the impugned design in question." It was therefore, pointed out that the plaintiffs have neither agreed nor denied the fact of sale of the registered design product prior to the date of registration by making such vague submissions.

45. It was submitted that once the defendant raised the ground of defense with regard to the validity of the registered design on the ground that the design could not have been registered contrary to the provisions of Section 4(b) which provides the registration of certain design which has been disclosed

to the public anywhere in India by publication under any form or by use or in any other way, prior to the date of filing of the registration, then such design cannot be registered more particularly under Section 19(1)(b) of the Design Act, 2000. The design which has been published in India prior to the date of its registration is liable for cancellation. Clause (d) of Sub-section (1) of Section 19 also prescribes that the design cannot be registered and registration is liable to be cancelled.

46. Learned Senior Advocate Mr. Soparkar has relied upon the following decisions in support of the above submissions :

i) In case of **The Wimco Limited v. M/s. Meena Match Industries** reported in 1983 SCC OnLine Del 390.

ii) In case of **Dart Industries Inc. & anr. v. Techno Plast & ors.** reported in 2007 SCC OnLine Del 892.

iii) In case of **Bharat Balar & another v. Rajendra Distributors & others**

reported in 2015 SCC OnLine Mad 8834.

iv) In case of **Anuradha Doval v. The Controller of Patents and Designs & Ors.** reported in 2017 SCC OnLine Cal 2920.

47. Learned Senior Advocate Mr. Soparkar thereafter, submitted that the plaintiffs have made suppression in the plaint, more particularly, in paragraph 32 of the plaint with regard to the suit filed by the plaintiffs in the District Court at Jaipur and further pleaded that the plaintiffs came to know about the infringement of the registered design only during the course of pleadings before the District Court, Jaipur. It was therefore, submitted that the plaintiffs have suppressed the aspect of knowledge of the registered design of the defendants in the plaint and for that purpose reference was made to the letter dated 9th November, 2020 addressed to the advocate of the plaintiffs by the Assistant Controller of Patent and Design forwarding the copy of the registered design of the defendants. It was therefore, submitted that the

averments made in the plaint that the plaintiffs came to know about the registered design in the plaint when the suit was filed before the District Court at Jaipur, in the year 2021, is not true and correct.

48. Learned Senior Advocate Mr. Soparkar submitted that there is a delay of about six months in preferring the suit by the plaintiffs as the plaintiffs were aware about the registered design of the defendants in the month of November, 2020, whereas, the suit is filed in the month of April, 2021. It was submitted that there is no explanation of such delay in the plaint and as such the plaintiffs are not entitled to any injunction in view of the delayed action being taken by the plaintiffs. It was also submitted that the learned Additional District and Sessions Judge, Ahmedabad (Rural) after filing of the suit did not think it fit to issue notice to the defendants before passing the order dated 29th April, 2021 granting ex-parte injunction in favour of the plaintiffs without considering the delay in filing the suit. In support of the

submissions of delay reliance was placed on the following decisions :

i) In case of **S.P. Chengalvaraya Naidy (Dead) by Lrs. v. Jagannath (Dead) By Lrs. And others** reported in (1994) 1 SCC 1.

ii) In case of **M/s. Standipack Pvt. Ltd and another v. M/s. Oswal Trading Co. Ltd and etc.** reported in AIR 2000 Del 23.

49. Learned Senior Advocate Mr. Soparkar therefore, submitted that the in view of the above facts, plaintiffs have failed to prove prima facie case, balance of convenience and irreparable injury as the ex-parte injunction could not have been granted and further submitted that unless the plaintiffs prove all the three factors, the plaintiffs are not entitled to the order of injunction. Reliance was placed on the following decisions :

i) In case of **M/s. Niki Tasha India Pvt. Ltd.** (supra) .

ii) In case of **Pravinbhai Jagjivandas Mehta** (supra).

50. It was therefore, submitted that no prima facie case is made out by the plaintiffs as the design is vulnerable and therefore, there is no case made out also for having the balance of convenience in favour of the plaintiffs resulting into irreparable loss if no injunction is granted. It was submitted that the suit was filed with false averments, suppression and delay with regard to the infringement of the design which is liable to be cancelled on the ground of validity in view of the violation of the provisions of Section 4(b) read with Section 19(1)(b) and (d) of the Design Act, 2000.

REJOINDER OF THE PLAINTIFFS

51. In rejoinder, the learned Senior Advocate Mr.Mihir Thakore and learned advocate Mr.Tolia submitted that though Section 4(b) of the Design Act, 2000 prohibits the registration of the design which 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, prior to date of application for registration, there is no material on record to prima facie show violation of Section 4(b) of the Design Act, 2000. It was submitted that merely placing on record the screen-shots of the website and photographs of some person is not enough to attract the provisions of Section 4(b) of the Design Act, 2000 so as to deny the injunction to the plaintiffs when there is an admitted copy of the registered design of the grill of the air-cooler of the defendants.

52. It was submitted by learned Senior Advocate Mr. Thakore that the defendants have not made any application under Section 19 of the Design Act, 2000 before Controller of Patent and Design for cancellation of the registered design of the plaintiffs for alleged violation of Section 4(b) on the ground that as per clause (b) of Sub-section (1) of Section 19 that the registered design of the plaintiffs has been published in any other country prior to the date of

application. It was submitted that Sub-section (2) of Section 19 of the Design Act, 2000 provides that an appeal shall lie from any order of the Controller under the provisions of Section 19 to the High Court. It was therefore, submitted that unless and until an application is made by the defendants under Section 19 for cancellation of the registered design of the plaintiffs, merely by raising ground of defense as stated in Sub-section (3) of Section 22 of the Design Act, 2000, the defendants cannot plead for refusing the injunction only on the ground of raising defense with regard to the validity of the registered design of the plaintiffs.

53. Learned Senior Advocate Mr. Thakore submitted that there is no dispute raised by the defendants that the registered design of the plaintiffs is not new, original and novel which is registered on 24th December, 2019 and such product stated in paragraph 8 and 15 of the plaint. It was submitted that the data given in the plaint with regard to the turnover as well as the number of models sold by the plaintiffs pursuant

to the air-coolers manufactured by the plaintiffs. It was submitted that the defendants are habitual in copying the design which is prima facie apparent from the material produced on record by the plaintiffs as number of suits are filed against the defendants for infringement of the registered design of other products of the plaintiffs as well as other similar manufacturers.

54. It was therefore, submitted by Mr. Thakore that the plaintiffs have shown prima facie case in their favour to the effect that the registered design of the grill of the air-cooler is prior in point of time and there is no material evidence on record to show the prima facie breach of the provisions of Section 4(b) read with Section 19(1)(b) because the invoices produced on record do not refer to the grill products of registered design i.e. grill for air-cooler either sold separately or otherwise. It was submitted that the invoices referred to the sale of the air-cooler which specifically show the design of the grill attached to such air-coolers. Mr. Thakore relied upon the

following decisions in support of his submissions to point out that there is no prior publication of the registered design of the plaintiffs in the facts of the case :

i) In case of **Bharat Glass Tube Limited v. Gopal Glass Works Limited** reported in (2008) 10 Supreme Court Cases 657, wherein the Apex Court has held as under:

"41. One has to be very cautious unless two articles are simultaneously produced the Court then alone the Court will be able to appreciate. But in the present case no design reproduced on the glass-sheets was either produced before the Assistant Controller or before the High Court or before us by the appellant to appreciate the eye appeal. The appellant could have produced the design reproduced on glass-sheet it manufactured in United Kingdom or Germany. That could have been decisive.

45. The next evidence which was lead by the appellant was a website had been downloaded from the United Kingdom Patent Office effecting patent 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 U.K. and it is not known whether it was reproduced on glass-sheet in U.K.

or not. In this connection, the Assistant Controller has only observed that he has made a visual comparison of the U.K. 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 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 U.K. design and the present design. This was not accepted by learned Single Judge of the Calcutta High Court and for the good reason. It was observed by 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. The respondent no.1 has not considered these factors.

The order impugned considered with the materials on record, including in particular the computer print outs clearly reveals that the respondent no.1 has only compared the pattern and/

or configuration considered the visual appeal thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, the Respondent No.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 of the United Kingdom was not common."

ii) In case of **Gopal Glass Works Ltd. v. Assistant Controller of Patents & Design and others** reported in 2005 SCC OnLine Cal 430, wherein Calcutta High Court has held as under :

"1. The Court: This appeal under Section 19(2) read with Section 36 of the Designs Act, 2000, hereinafter referred to as the said Act, is from an order dated 20th September, 2004 of the Assistant Controller of Patent and Designs, being the respondent No. 1, directing cancellation of Design No. 190336 registered in the name of the appellant.

28. It is significant that prior

to the enactment and enforcement of the 2000 Act prior registration or publication of the design in India was a ground for cancellation of a registered design, but not prior registration or publication abroad. Parliament in its wisdom deemed it expedient to add prior publication in a country other than India as a ground for cancellation of a registered design, but not registration in a country other than India.

29. Parliament has thereby consciously differentiated between prior registration in India and prior registration abroad. No such difference has, however, been made in the case of prior publication. Prior publication either in India or abroad is a ground for cancellation of a registered design.

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.

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.

44. In the case of *Rosedale Associated Manufacturers Ltd. v. Airfix Ltd.*, reported in 1957 RPC 239, Lord Evershed M.R. held as follows:

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 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.

45. 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 clear unmistakable instructions or directions for production of glass sheets of the pattern illustrated.

46. 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. The respondent No. 1 has not considered these factors.

47. The order impugned considered with the materials on record, including in particular the computer print-outs clearly reveals that the respondent No. 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, the respondent No. 1 has not considered the visual appeal of the finished product.

48. There are no material 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 Liason 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.

49. For the reasons discussed above, the impugned order cannot be sustained. The appeal, therefore, allowed and the impugned order is set aside and quashed."

iii) In case of **Asian Rubber Industries, New Delhi and others v. Jasco Rubbers, Calicut and another** reported in 2012 SCC OnLine Bom 355, wherein the Bombay High Court has held as under :

"The plaintiff has filed Appeal (L) No.97 of 2012 app - 62/12 challenging the order dated December 9, 2011 by which the learned Single Judge had declined to grant ad-interim injunction on the basis of infringement of the plaintiff's registered design for the same footwear.

For the sake of brevity and convenience, the parties are referred to by their nomenclature in the suit.

2. On December 15, 1999 the plaintiff obtained registration under Designs Act, in relation to a footwear design, being registration No.181088. The registration mentioned that novelty resides in the shape, configuration and pattern of the "Footwear" as illustrated. It further indicated that the design is neither restricted to any colour or combination of colours, nor is any claim made by virtue of this registration to the exclusive use of the particular colour or combination of colours as illustrated in the representations. Similarly on December 29, 1999, the plaintiff obtained registration under the Designs Act in relation to footwear, being registration No. 181193 and third registration under the Designs Act in relation to another footwear on March

7, 2000 vide registration no.181829. The products are named by the plaintiff as "Methiyadi Yodhha", "Methiyadi Yoga" and "Methiyadi Export-SwamisZ". The plaintiff has been selling these products from 2000 onwards in the open market. Following is the chart showing annual turnover of the plaintiff.

Accounting Year	Amount
2006-2007	53,27,359
2007-2008	38,32,503
2008-2009	1,21,37,480
2009-2010	2,13,52,355
April-2010 to Jan-2011-	1,54,88,787

3. It is the plaintiff's case, and not seriously disputed by the defendants that, upon coming to learn about infringement of the registered designs of the plaintiff, the plaintiff issued caution notice on June 14, 2009 and thereupon the infringing goods disappeared from the market. Thereafter on June 22, 2009, the defendants made an application for design registration identical to that of plaintiff. Prayer made in the said application for design registration was allowed and the defendant was granted design registration on December 14, 2009 vide registration No.223556. When the plaintiff became aware that the defendants' design is registered, the plaintiff filed proceedings for cancellation of Registration No.223556 in October 2010. Again the infringed goods appeared in the market in October 2011. Therefore, the plaintiff filed present suit along with Notice of Motion seeking injunction against defendants on October 18, 2011. The defendant filed affidavit-in-reply to the Notice of Motion and pleaded, inter alia, the following defences :

i) The impugned design of the footwear registered by the plaintiff was not new and original. Even according to the plaintiff, his design was developed from "Padukas" which design has been commonly available since time immemorial. Therefore, the design of plaintiff cannot be said to be new or original;

ii) The plaintiff's footwear is a pattern which is normally used in the trade with a functional aspect. People at large and persons in the trade including the defendants have used the said pattern even prior to registration of the plaintiff's design. The plaintiff's design is not significantly distinguishable from known designs and/or is a combination of known designs. The plaintiff relied upon advertisements in the footwear news magazines;

iii) The design of stud of the plaintiff's footwear and defendants' footwear are different and distinct from each other. The top of the stud in the defendants' footwear has a surface pattern of circles within circle while the top of the stud in plaintiff's footwear has no surface pattern and is plain;

iv) The design of the plaintiff's footwear is duly registered on June 26, 2009 and the plaintiff has filed cancellation of the defendants' registered design. The proceedings were still pending before the Controller of Designs as the arguments were heard but the orders were not yet pronounced. Therefore, the defendants being the app - 62/12 registered proprietor of the registered design, should not be

restrained till the design in his favour is cancelled through proper process of law. The suit was an attempt to overcome the Controller of Designs.

4. After hearing learned counsel for the parties at the ad- interim stage, the learned Single Judge passed an order dated December 9, 2011 declining to grant ad-interim relief on the basis of plaintiff's registered designs.

5. Thereafter the plaintiff filed Notice of Motion seeking injunction against the defendants on the basis of passing off. The hearing of the Notice of Motion was concluded on December 19, 2011. When the learned Single Judge dictated the order in the open Court on December 23, 2011, the plaintiff pointed out that the Assistant Controller of Patents and Designs had passed an order dated December 20, 2011 cancelling defendant's design. The plaintiff, therefore, submitted that injunction may be granted, both on the basis of infringement of the registered design and also on the basis of passing off. The learned Single Judge passed the impugned order dated December 23, 2011 granting injunction on the basis of passing off after giving the following reasons :-

a) The defendant's rubber footwear seen as a whole indicates an intention on the part of the defendants to pass off their app - 62/12 products as those of the plaintiffs. The shape, configuration and the placements of components are identical. The products are likely to be sold not merely in the same shop but are likely to be displayed on the same shelf, thus enhancing the probability of confusion;

b) The defendants had relied upon

certain brochures but none of the items in the brochures indicate any similarity with the plaintiff's products;

c) The defendants had not offered any explanation as to how they conceptualized their products;

d) The defendants' conduct also supported plaintiff's case that the defendants were trying to pass off their goods as that of the plaintiff. When the plaintiff noticed the defendants' products in June 2009, the plaintiff issued a seize and desist notice in the newspapers as they were not aware of manufacturer of such products.

Thereupon, the infringing products disappeared from the market and they appeared again at the end of the year but with a registration number.

6. Being aggrieved by the aforesaid order dated December 23, 2011, the defendant nos.1 to 4 have filed Appeal No.62 of 2012. The plaintiff has filed cross-objections insofar as learned Single Judge did not accept the plaintiff's prayer for grant of ad-interim app - 62/12 injunction on the basis of infringement of the plaintiff's registered designs.

16. The main thrust of Dr.. Tulzapurkar's arguments is that originality of plaintiff's designs themselves is doubtful, and keeping aside the defendants' claim for registration of design, in the first place the plaintiff could not have been granted design registrations. Undoubtedly, the existence of Padukas in ancient times cannot be denied. However, in the recent past, it is not

known that said feel and look of Padukas with the modification of strap to support the foot has been applied by any person to footwear. Application of design of Padukas - of its "look and feel", to footwear by the plaintiff in the recent past certainly falls within the meaning of "Original" as defined in section 2(g) of the Act to the extent of "and includes the cases which though old in themselves yet are new in their app - 62/12 application".

17. What is important to note is that the defendants themselves sought registration of their "look and feel" in Padukas and therefore it is not open for the defendants to say that the plaintiff cannot claim exclusivity. The defendants themselves procured design registration in relation to footwear under design registration No. 223556 in June 2009, which was subsequently cancelled by the Assistant Controller of Patents and Designs on 20th December 2011. In these circumstances it cannot lie in the mouth of defendants to contend that the plaintiff's design is not new or original or there is no novelty. We also find merit in the plaintiff's contention that there is no footwear in the market having unique features of stud and strap like that of plaintiff. So far as the plaintiff's designs are concerned, novelty lies in the shape, configuration and pattern of the footwear and there is no product in the market having similar design."

iv) In case of **M/s. Bhatia Enterprises v. Sh. Subhash Arora** reported in 2016 SCC OnLine Del 363, the Apex Court has held as under :

"1. This application for pentente lite injunction has been filed by the plaintiff in its suit alleging infringement of the registered design CS(OS) No. 2471/2012 Page 1 of 15 no.235010 dated 7.3.2011. The design which has been registered is a design for a water jug. As per Section 11 of the Designs Act, 2000 (hereinafter referred to as 'the Act') on registration of the design, the owner of the design from the date of the registration has exclusive rights for a period of 10 years to use the registered design.

2. Defences to a suit claiming infringement of a registered design are basically under Section 19 of the Act and as per which essentially prior publication is a ground which will defeat a suit claiming infringement on the ground of registration of a design.

7. Before I proceed to the discussion with respect to the decision of this application seeking interim injunction during the pendency of the suit, it is extremely relevant to note that the defendant had applied for cancellation of the registration of the design of the plaintiff, but this petition for cancellation of the registration was dismissed by the Assistant Controller of Patents and Designs vide Order dated 19.5.2014. More or less the issues which are argued by the defendant before this Court, may be except one, are already the subject matter of the discussion and decision in the order of the Assistant Controller of Patents and Designs and therefore let me reproduce

the operative part of the Order dated 19.5.2014 rejecting the petition of the defendant herein for cancellation of the registration of the design of the plaintiff, and the same reads as under:-

"The evidences submitted by the petitioner in support of ground of prior publication of the impugned design were scrutinized as detailed below:

(a) Petitioner, in Para 11 of statement of case, stated that the impugned product of the respondent is common to trade and pictorial representation of various water jugs used by various parties like Bajrang Plastic, Hello Polymer, Royal Plastic, Milton were submitted. None of these pictures reveals date of publication or use of the article shown in the pictures.

(b) Petitioner also submitted pictorial representations of his design of water jug (pages 9-10) but those were not substantiated with date of publication or sale.

(c) Alleged prior & pre published design of other party (pages 13-14) also does not show any date of publication or date of its sale to decide the period of the disclosure to public.

(d) The screen shots of website www.indiamart.com (pages 15-20 of evidences) showing water jugs of companies like Bajrang Plastics and Milton offers some designs of water jugs. These designs are not similar to the impugned design. Further the date appearing in the screen shots of the website refers to 24/12/2011 and

26/12/2011 which is later than the date of registration of the impugned design.

(e) Other pages from website www.santoorplastic.in (pages 21-22, 24, 25, 28 of evidences) were also having date appearing as 24/12/2011 which is later than the date of registration of the impugned design. The water jugs shown therein do not resemble to the impugned one.

(f) Pages from website www.chocolateboxes.com (Pages 23, 26, 27, 29 of evidences) also show some water jugs where the date appeared as 24/11/2012. These pictures also do not depict the impugned design.

(g) Similar is the case for website print outs submitted by the petitioner in pages 30 to 42 of the evidences. The designs of water jugs revealed in those print outs are not similar to the design of the water jug of the respondents.

Petitioner also submitted the same set of documents of evidence along with submission under Rule 29(4), discussion of which are not repeated as those were basically same documents as discussed above. From the foregoing analysis, it is seen that those evidences of publication do not substantiate that the impugned design was published prior to its date of registration.

In view of above findings that the impugned design was not published prior to its date of registration and as well as the visual impression of the impugned design is different from that of the cited designs of the petitioner, I construe that the subject design is new. As per Section 2(g) of the Designs Act, 2000, "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'. Petitioner could not also substantiate that the design is not originating from the author of such design or it is a known design. Thus, I opine that the impugned design is new and original. The visual effect of the picture illustrations of published designs and that of the impugned designs are different. The features of designs in registered design no.235010 are not insignificant from the known designs cited by the petitioner. Hence there is nothing to suggest that the impugned design is not registrable under Section 4 of the Designs Act, 2000. Counsel for the petitioner also pled that the impugned design of the respondent was disclosed to the public prior to its date of registration as evident from the dates of bills/vouchers submitted by the respondent. Upon scrutiny of those vouchers of respondent, it is seen that respondent claimed to be in the trade since 1989 by way of selling of Mayur water filters, water jugs etc. It is further observed that respondent is having registration of trade mark 'Mayur' since 2002. The same was also registered under Copyright in 2003. Respondent also produced a search certificate regarding the expression '5o C'. All these documents suggest that respondent is bonafide user of these. Vouchers indicating sale of Mayur water jugs before the date of registration of the impugned design does not necessarily mean that the impugned design was sold prior to its date of registration. Further none of the bills and vouchers depicts design of the products sold there through. Hence these bills cannot be considered as document evidencing prior sale/use

of the article bearing impugned registered design. Another contention of petitioner was that the impugned design is mere mechanical device and hence is not a design as defined under clause (d) of Section 2 of the Act. It was stated that as per submission of respondent in Para 9 of page 7 of the counter statement as well as Para 7 of the affidavit, the impugned design is functional. A mere mechanical device is a shape in which all the features are dictated solely by the function or functions which the article has to perform [Amp Inc vs. Utilux Pty. Ltd 1972 RPC 103]. At the same time, it is observed from the petitioner's evidences that there are variety of water jugs having distinctive features of shape and configuration. The article of the impugned design is an article under Section 2(a) of the Act. The article has certain design features of shape and configuration applied to it. The article is not a mere mechanical device and the features of the impugned design are not solely dictated by the function the article has to perform. There is no bar as to being the impugned design under the definition of 'design' as defined in clause (d) of Section 2 of the Act. Upon consideration of the Statement of Case, Counter Statement, evidences, and submissions of both the parties and after careful analysis of the documents submitted by both the parties in the instant case as above, I decide that the petitioner could not establish the grounds of prior publication of the registered design no.235010 and therefore I decide that the design no.235010 is new and original and registrable under the provisions of the Act." (emphasis added)

v) In case of **Godrej Sara Lee Limited v. Reckitt Benckiser Australia Pty. Limited and another** reported in (2010) 2 Supreme Court Cases 535, wherein the Apex Court has held as under :

"25. In contrast to the provisions of [Section 51A\(1\)\(a\)](#) of the 1911 Act, [Section 19\(1\)](#) of the 2000 Act, which also deals with cancellation of registration, provides for a petition for cancellation of registration of a design to be filed before the Controller and not to the High Court. On a comparison of the two provisions of the two enactments, it will be obvious that under the 2000 Act the intention of the Legislature was that an application for cancellation of a design would lie to the Controller exclusively without the High Court having a parallel jurisdiction to entertain such matters. It is also very clear that all the appeals from any order of the Controller under [Section 19](#) of the 2000 Act shall lie to the High Court."

vi) In case of **Metro Plastic Industries (Regd) v. M/s. Galaxy Footwear New Delhi** reported in 2000(52) DRJ 183 (FB, wherein the Delhi High Court has held as under :

"31. It is also settled law that the provisions of a statute should be read harmoniously. [Section 51-A](#) provides for cancellation of registration on certain grounds. Once an Application for cancellation of registration has been made or filed then the validity of

registration itself has been questioned. If the validity of registration has already been questioned, then it would be anomalous and would amount to defeating the provisions of [Section 51-A](#) to say that in a Suit under [Section 53](#) the defense of validity cannot be taken. It would then amount to saying that a person whose right is questioned, can in spite of such challenge keep on enforcing his right merely because delays of law do not permit such Applications to be disposed of expeditiously."

vii) In case of **Smit N. Parmar v. Paresh D. Patel** (judgment dated 27.11.2012 in O.J. Appeal NO. 41 of 2012), wherein this Court has held as under :

"8. The learned Counsel for the appellant next contended that when the design prior to the registration was already published, it could not be registered by the concerned authority and, therefore also the same would stand covered by the ground available under Clause (b) of Section 19 by way of defence in the present suit to the defendant. It was submitted that as per the averments made by the plaintiff in the plaint, the advertisement was made of the design and the plaintiff has procured the business based on the same. When the publication was made, then the registration was not made available and, therefore, it could not be considered as a valid design conferring the benefits to the plaintiff for the interim injunction. In furtherance to the submission, the learned Counsel for the appellant relied upon the averments made at paragraphs 11, 12 and 13 of the plaint,

whereas, as per the original plaintiff respondent herein, the figure shown is composite in nature since the plaintiff was already in business and the process of advertisement was for various purposes. It was submitted that it is no publication, which prohibits the registration and, therefore, the learned Counsel for the respondents submitted that the discretion has been properly exercised by the learned Single Judge.

9. In our view, as such the publication presupposes the publication to be made by making known to the public at large and more particularly the consumers thereof. It is true that the figures of advertisement expenses are mentioned and a general statement is made for expenses incurred for advertisement, including the design, but no material has come on record showing the publication, in any manner, like that of a circulation through pamphlets or any paper advertisement or otherwise. It deserves to be recorded that when the design is registered by the Registering Authority, who is considered as an expert in the field the normal presumption would be that the registration is made in proper manner. If one is contending by way of defence that the registration was not available for one reason or another, the burden would be upon the party so asserting. If the defendant is raising the contention of prior publication, the burden would be open the defendants. No material is produced by the defendants for such purpose. The contention raised on the basis of the averments made by the plaintiff in the plaint, per se, cannot be said as publication, which is barring the registration. In our view, unless a full-fledged fact finding inquiry is

undertaken and parties are allowed to lead the evidence, it is not possible to conclude that there was publication of the design as required under the Act prohibiting the registration of the design. Be it noted that it is not a matter where the suit is to be concluded after an elaborate evidences led by the parties, but we have to consider the matter at the stage when the interim application for temporary injunction is considered by the learned Single Judge and the matter is to be examined in appeal. Therefore, prima facie material is only to be taken into consideration as available on record. If prima facie once the design is registered and no reliable material has come on record showing the publication by making it known to the public at large or the consumers of an article, it cannot be said that there was publication of an article with new design prohibiting the registration of the design on the date when the registration was applied. Therefore, the said contention does not deserve to be accepted."

viii) In case of **Kalpesh R. Jain and others v. Mandev Tubes** reported in (2018) 2 AIR Bom R 658, wherein the Bombay High Court has held as under :

"25. The claim of the original plaintiff in the suit is about the uniqueness of its design applied to copper tubes and the registration was granted on this design. The protection which the plaintiff had claimed in the suit was the protection of his new or original design with reference to the copper Borey tubes to which it was

applied. The concept of design is that a particular figure / shape conceived by its designer, in his mind and it is reproduced in some identifiable manner and is sought to be applied to an article. Whenever any registration is sought for, a configuration has to be chosen for registration to be reproduced in any article. The original plaintiff had approached the court, seeking injunction and sought protection of his design applied to copper tubes. It is not the case of the plaintiff that the copper tubes were in existence earlier or were put to the use the way they are being put to use including its use in air- conditioner but the plaintiff came up with a design which he claimed to be a new and original and as per the plaintiff, it was already manufacturing the copper tubes with varied applications for a considerable long time but in the year 2009 it conceived of a unique, novel shape, configuration for its tubes and applied this uniqueness and novelty on copper tubes and this uniqueness lied in the expanded bell-shaped ending to the copper tube. It is this idea applied to the copper tubes which was registered and the Borey 33/47 spb/comapeal-133-17R.doc plaintiff sought its protection. As the Hon'ble Apex Court has observed in case of [Bharat Glass Tube Ltd., vs. Gopal Glass Works Ltd.](#), reported in 2008 (10) Supreme Court Cases 657 in paragraphs 36 and 37 in the following words :

"36. Similarly our attention was also invited to para 27.07 of the law of Copyright and Industrial Designs by P. Narayanan (Fourth Edition) which reads as under :

27.07. Design as a conception or idea
"Design means a conception or suggestion or idea of a shape or of a

picture or of a device or of some arrangement which can be applied to an article by some manual, mechanical or chemical means mentioned in the definition clause. It is a suggestion of form or ornament to be applied to a physical body". It is a conception, suggestion or idea, and not an article, which is the thing capable of being registered. It may according to the definition clause, be applicable to any article whether for the pattern or for the shape or configuration or for the ornament thereof (that is to say of the article) or for any two or more of such purposes. The design, therefore, is not the article, but is the conception, suggestion, or idea of a shape, picture, device or arrangement which is to be applied to the article, by some one of the means to be applied to a physical body.

A design capable of registration cannot consist of a mere conception of the features mentioned in the definition, or in the case of an article in three dimensions, of a representation of such features in two Borey 34/47 spb/ comapeal-133-17R.doc dimensions. It must, in such a case, in order to comply with the definition, consist of the features as they appear in the article to which they have been applied by some industrial process or means. An applicant for registration of a design has to produce a pictorial illustration of the idea or suggestion which he has to establish as new or original;"

Therefore, the concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. therefore, whenever

registration is required then those configuration has to be chosen for registration to be reproduced in any article. The idea is that the design has to be registered which is sought to be reproduced on any article. therefore, both the things are required to go together, i.e. the design and the design which is to be applied to an article."

"37 In the present case, the design has been reproduced in the article like glass which is registered. This could have been registered with rexin 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 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."

ix) In case of **Rosedale Associated Manufactures Ltd. v. Airfix Products Ltd.** reported in 1957 (10) RPC 239, wherein it is held as under :

"But assuming all this, does it follow that the Respondents' design can be sad

to have been "published" by Clarice Jones? To my mind the question must sensibly be answered negatively. As was observed by Farwell, J., in Morton's Design (1900) 17 R.P.C. 117, at p. 121: "... what you have to see is whether, "tested by the eye, the design is novel or original . . .". Applying this test it is essential to bear always in mind that the Respondents' design is a particular appearance or shape to be judged by the eye alone. So regarded it represents a bucket of specific and distinct characteristics including a handle of Particular, type at the top and a sharply narrowing body with its distinct base. I have been quite unable to find any such design anywhere presented to the eye or described in Clarice Jones' specification so that the mind's eye can see it, That Specification is nowhere related to a bucket at all. I agree that in the Respondents design the handle may be of less distinctive importance than other features in the design. Still, bucket handles take more than one form; and this handle is a part and a necessary part of the design as a whole."

55. Relying upon the aforesaid decisions, it was submitted that the Supreme Court in case of Bhatia enterprise (Supra) has held in the facts of the case before it that when the bills and vouchers did not depict the design of the product, hence such bills cannot be considered as documents evidencing prior sale/use of the article bearing impugned registered design. It

was therefore, submitted that merely because the plaintiffs before the Delhi High Court sold some products earlier and filed invoices, the same would not mean that there is a prior publication as there is no depiction of the invoice of the design of the plaintiffs in the said case prior to the date of registration of the design. It was submitted that the ratio in the case of Metro Plastic Industries (Supra) could not apply when there is no evidence of prior publication of the design and merely designs placed by the defendants on the copies of the screen-shots of the website is not enough to prima facie show that there is a prior publication of the design of the plaintiffs.

56. It was therefore, submitted by Mr. Thakore that the defendants have failed to substantiate the ground of questioning the validity of the registered design by prior publication either by invoices or by showing it on website of Amazon or face book. It was further submitted that the plaintiffs have also filed an affidavit of the person Niraj Kumar Soni whose picture is

shown in the screenshots produced on record of the defendants, wherein, it is categorically stated by the deponent Mr. Soni that front grill of the air-cooler shown in the picture is completely different and can be significantly distinguished from the registered design of the plaintiffs as the shape, surface and configuration shown in the screenshots taken from the Face book account of Mr. Soni is also different from the registered design of the plaintiffs.

57. It was therefore, submitted that the reliance placed by the defendants to question the validity of the registered design is the subject matter of oral and documentary evidence to be led before the Controller of Patent and Design but, however, as the defendants have not made any averment for cancellation of the registered design of the plaintiffs, such defence cannot be considered at the stage of granting of interim injunction, more particularly, when the defendants have copied the registered design of the plaintiffs.

58. In rejoinder, Mr. Tolia submitted

that the defendants have not argued at any point of time before this Court that they have not copied the design of the plaintiffs which is new and original design of the grill of the air-cooler. It was reiterated by Mr. Tolia that the Controller of Patent and Design has granted registered design of the grill of the air-cooler that left to shape, surface and configuration only. Therefore, it was submitted that the registered design of the grill of the air-cooler of the plaintiffs is new and original design which could not have been infringed by the defendants by relying upon the material to question the validity of the registered design on the ground of prior publication which is the subject matter of the evidence to be led before the Court.

59. It was therefore, submitted that the plaintiffs have proved the prima facie case in their favour and if the defendants are permitted to manufacture and sell products of the registered design of the grill of the air-cooler registered by the plaintiffs, then there would be irreparable loss to the

plaintiffs and the consumers in the market would be affected as they would purchase the air-cooler having grill similar to the plaintiffs, manufactured by the defendants. It was thus in the interest of the consumers at large also that the injunction prayed by the plaintiffs is granted while issuing the notice by the Court could be continued till the final disposal of the suit.

60. It was also pointed out by the learned advocate Mr. Tolia that the balance of convenience is also in favour of the plaintiffs as the defendants have never denied that the registered design of the grill of the air-cooler is not copied by them. It was also not in dispute that the defendants have registered such design after the registration of the design by the plaintiffs. It was pointed out that while granting registration of the design, the Controller of Patent and Design has not published any prior intimation as it is shown in the trade mark. It was therefore, submitted that if the defendants are objecting to the registration of the design, then the

defendants are required to challenge the same by preferring an application under Section 19 of the Design Act, 2000. It was pointed out that the provisions of the Patent Act and the Design Act are different and the reference was made to Section 54 of the Patent Act to point out that the Patent Act specifically provides for filing a counter claim by the defendants changing the validity of the design, whereas, under the provisions of the Design Act, the defendants can only raise the ground under Sub-section (3) of Section 22 of the Design Act, 2000 and therefore, when there is no provision for filing the counter claim as provided under the Patent Act, the decisions relied on behalf of the defendants would not apply to the facts of the case under the Design Act, 2000 when such decisions are rendered under the provisions of the Patent Act.

61. It was therefore, submitted that raising a defence with regard to the validity of the registered design cannot be equated to that of counter claim filed by the defendants. It was

therefore, submitted that all the three ingredients for granting interim injunction along with prima case, balance of convenience and irreparable loss are in favour of the plaintiffs and the injunction granted and is in operation should be continued during the pendency of the suit filed by the plaintiffs.

ANALYSIS

62. I have heard the learned advocates for the respective parties and after perusing the material on record and having considered the judgments cited at bar, before analysing the rival submissions, it would be germane to refer to the relevant provisions of the Design Act, 2000:

"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. Decision of Controller.—The decision of the Controller containing the | grounds and materials used by him in arriving at the decision at such hearing as aforesaid shall be communicated in writing to the applicant or his agent.

22. Publication of the particulars of registered design under section 7.—On acceptance of the design filed in respect of an application, the Controller shall direct the registration and publication of the particulars of the application and the representation of the article to which the design has been applied, in the Official *{Journal referred to in section 145 of the Patents Act 1970 (39 to 1970)}. When publishing in the [Journal referred to in section 145 of the Patents Act 1970 (39 to 1970)], the Controller may select one or more views of the representation of the design, which, in his opinion, would depict the design best.”

63. The submission on behalf of the plaintiffs is that the design of the grill of the air cooler is a new and original one which has never been disclosed to public anywhere in India or in any other country before the date of filing the application for registration, as it was submitted that the design developed by the plaintiffs is registered prior in point of time then the registration of the design of the defendants who have been alleged to have copied. It was also the case of the plaintiffs that on comparison of the design of the plaintiffs as well as the defendants, both are same which can be

judged solely by the eye.

64. Whereas on the other hand, the defendants have not denied and/or submitted that they have not copied the design of the grill for air cooler as registered by the plaintiffs with effect from 24.12.2019. The crux of the case of the defendants is that the design registered by the plaintiff could not have been registered at all in view of the provisions of section 4(b) read with section 19(1)(b) of the design Act, 2000 on the ground that the design of the grill for air cooler registered by the plaintiffs has been published prior to the date of making the application for registration and for that the defendants have relied upon the following aspects:

- i) the averments made in the plaint
- ii) invoices placed on record by the plaintiffs
- iii) screenshots from web sites of Amazon and Face book

65. Thus the controversy is as to whether there is a prima facie case or

not in favour of the plaintiffs and whether in view of the allegations of prior publication of the design by the plaintiffs, can the interim injunction which was granted by the trial Court ex-parte and which is extended from time to time till date can be further extended during the pendency of the suit or not?

66. In the present case, applying the test to the design used by the defendants, it is clear to the eye that it is essentially the same as the registered design of the plaintiffs in almost all respect.

67. Therefore, the question as to whether the design of the plaintiffs has been published prior to the date of filing of the application for registration is only required to be considered.

68. It has been contended by the learned Senior Advocate for the defendants that there is an admission in the plaint with regard to the prior publication of the design of the plaintiffs, more particularly, the

copies of invoice pertaining to the period prior to the date of registration as well as the invoices of the period after the date of registration contains the same description of the product upon which reliance is placed by the plaintiffs. It was also pointed out that the air cooler manufactured by the plaintiffs using the registered design was displayed in various exhibitions as well as on the web site of Amazon and Face book and as such, there is prior publication of the design before the date of making the application for registration. In such circumstances, it was contended that once there is a prior publication of the design, the same is prohibited to be registered as per section 4(b) read with section 19(1)(b) of the Design Act, 2000.

69. However, this defence of the defendants is not accepted by the plaintiffs and it was contended that the invoices only refer to the model of the air cooler and does not give any description of the design of the grill used in such air cooler and therefore, on the basis of such invoices, it cannot

be presumed that there is prior publication. Similarly, it was submitted that the design of the grill of the air cooler which was shown in the screenshots from the website of Amazon and Face book cannot be considered at this stage as it requires leading of the evidence by both the sides. It was therefore, submitted that it cannot be said that there is admission on part of the plaintiffs with regard to prior publication. Reference was also made to the affidavit of the person Niraj Soni denying the fact of selling the grill for the air cooler.

70. It is pertinent to note that the defendants except producing the screenshots from the website of Face book page of Mr. Niraj Soni and copy of the screenshots regarding the exhibition at Jaipur as well as Amazon web page containing the details of the product and video CD containing the video of exhibition wherein the plaintiffs had participated, cannot be said to be a cogent evidence so as to come to the prima facie conclusion that the registered design of the plaintiffs has

been used by the plaintiffs prior to the date of registration or publication in India or any other part of the world before that date as such material is required to be proved by the defendants by leading evidence. Therefore, the following decisions relied upon on behalf of the defendants cannot be pressed into service at this stage of deciding as to whether to extend the interim relief granted in favour of the plaintiffs till the final disposal of the suit or not.

i) In case of **Alloys Wobben and another** (supra), wherein Apex Court has held as under :

"10. Having extracted the relevant provision dealing with the revocation of a patent, relied upon by the learned counsel from the Patents Act, we shall endeavour to deal with the submissions advanced at the hands of the learned counsel for the appellants. In our considered view, even though some of the submissions were differently worded, they were premised on exactly the same legal contentions, namely, that the defendant in an "infringement suit", having raised a "counter-claim" seeking revocation of a patent, the validity of such a challenge can be determined only at the hands of the High Court, i.e., while dealing with the "counter-claim". And that, the

"Appellate Board" would thereafter (after the filing of the "counter-claim" in the "infringement suit"), cease to have the jurisdiction to adjudicate upon the validity of the patent. The different submissions advanced at the hands of the learned counsel for the appellants, on the instant aspect of the matter, are being summarized hereunder:

10.1 Firstly, it was submitted, that where a "counter-claim" is instituted in response to a suit for infringement of a patent in the High Court, there can be no further proceeding in the "revocation petition" filed before the "Appellate Board". In this behalf it was further contended, that it would make no difference, whether such proceedings had been instituted prior to, or after the filing of the suit for infringement.

10.2 Secondly, it was contended, that the jurisdiction of a High Court to decide a "counter-claim" for revocation, was exclusive, and could not be taken away, by initiating proceedings simultaneously, before the "Appellate Board". In this behalf it was sought to be explained, that the proceedings before the High Court in furtherance of the "counter-claim", would negate all similar proceedings against the same patent, on the same grounds, before the subordinate forum (the "Appellate Board"), for the simple reason, that the inferior forum would have to make way for the superior forum.

10.3 Thirdly, it was submitted, that the jurisdiction vested with the High Court, to decide a "counter-claim" seeking revocation of a patent in a suit for infringement, could not be

taken away by an independent petition for revocation, of the same patent, and on the same grounds, pending before the "Appellate Board". In this behalf it was submitted that the "Appellate Board" was only an administrative tribunal, which was neither superior to the High Court nor vested with a coequal status (as that of the High Court). Accordingly it was submitted, that the determination by the "Appellate Board" which could even otherwise be corrected by the High Court (in an appropriate case, through writ proceeding) could not be allowed to derail the plea of revocation raised through the "counter-claim", before the High Court.

10.4 Fourthly, it was contended that once a "counter-claim" for revocation was instituted, the High Court alone would be vested with the charge for determining the merits of the plea of revocation. Placing reliance on the proviso to Section 104 of the Patents Act, it was sought to be asserted that once a "counter-claim" had been filed in a suit for infringement, the same was liable to be transferred to the High Court for determination.

20. The defendant party to a suit for infringement, who seeks to repudiate the charge of infringement, is allowed to raise a "counter-claim", so as to enable him to raise a challenge, to the validity of the patent assigned to the author of the suit (under Section 64 of the Patents Act). This is so, because a "counter-claim" can be filed only by such person, against whom a suit for infringement has been filed (by the patent-holder). The grounds of such challenge have already been enumerated above.

25. A "counter-claim" for all intents and purposes, must be understood as a suit, filed by one who is impleaded as a defendant. A "counter-claim" is essentially filed to obstruct the claim raised in a suit. A "counter-claim" is tried jointly, with the suit filed by the plaintiff, and has the same effect as a cross-suit. Therefore, for all intents and purposes a "counter-claim" is treated as a plaint, and is governed by the rules applicable to plaints. The court trying a suit, as well as, the "counter-claim", has to pronounce its judgment on the prayer(s) made in the suit, and also, those made in the "counter-claim". Since a "counter-claim" is of the nature of an independent suit, a "counter-claim" cannot be allowed to proceed, where the defendant has already instituted a suit against the plaintiff, on the same cause of action. The above conclusion is drawn on the basis of the accepted principle of law crystallized in Section 10 of the Code of Civil Procedure, 1908 (hereinafter referred to as, the CPC) read with Section 151 of the CPC. Both the above provisions are being extracted hereunder:-

"10. Stay of suit.- No Court shall proceed with the trial of any suit in which the matter in issue is also directly and substantially in issue in a previously instituted suit between the same parties, or between parties under whom they or any of them claim litigating under the same title where such suit is pending in the same or any other Court in India having jurisdiction to grant the relief claimed, or in any Court beyond the limits of India established or continued by the Central Government and having like jurisdiction, or before the Supreme Court.

Explanation- The pendency of a suit in a foreign Court does not preclude the Courts in India from trying a suit founded on the same cause of action.

151. Saving of inherent powers of Court.- Nothing in this Code shall be deemed to limit or otherwise affect the inherent power of the Court to make such orders as may be necessary for the ends of justice or to prevent abuse of the process of the Court." Therefore, where an issue is already pending adjudication between the same parties, in a Court having jurisdiction to adjudicate upon the same, a subsequently instituted suit on the same issue between the same parties, cannot be allowed to proceed. A similar question arises for consideration before this Court, in the present controversy. If the respondents in their capacity as "any person interested", had filed a "revocation petition" before the institution of an "infringement suit", they cannot be permitted to file a "counter-claim" on the same cause of action. The natural conclusion in the above situation would be, the validity of the grant of the patent would have to be determined in the "revocation petition". Therefore, in the above situation, while the "revocation petition" will have to be permitted to be pursued, the "counter-claim" cannot be permitted to be continued. Therefore, in the above eventuality, it is apparent that the situation would be resolved, in the same manner, as it would have been resolved in cross-suits filed by the rival parties, before different jurisdictional courts. In our considered view, the above conclusion is imperative for a harmonious interpretation of the relevant

provisions of the Patents Act.

26. In cases where the "infringement suit(s)" was/were filed by the appellant herein (as plaintiff in the "infringement suit"), before the "revocation petition(s)" was/were filed by the respondents (as defendants in the "infringement suit"), the respondents had the right to file "counter-claim(s)" to seek revocation of the patent, under the strength and authority emerging from Section 64(1) of the Patents Act. Having once filed a "counter-claim", in response to the "infringement suit(s)", on the same analogy as has been recorded above, it would not be open to the respondents herein (the defendants in the "infringement suits") to file "revocation petition(s)", as they would likewise be barred by the rule of res judicata. As such, "revocation petitions" filed later in point of time, than the institution of the "infringement suit", would be unsustainable in law. In such cases, the prayer for revocation of the patent shall be adjudicated, while disposing of the "counter-claim" filed by the respondents. Therefore, in the above situation, while the "counter-claim" will have to be permitted to be pursued, the "revocation petition" cannot be permitted to be continued."

ii) In case of **Pravinbhai Jagjivandas Mehta** (supra) this Court has held as under :

"22. Before quoting those provisions, the controversy may briefly be set out as under:-

In Niky Tasha India Pvt. Ltd. (supra) the Division Bench of the Delhi High Court had taken the view that the Court will not grant an interlocutory injunction at the instance of a party holding a registered design where the design is of a recent date and there is a serious question as to the validity of the design to be tried in the suit and the application for cancellation has been made. Where a person is entered as a proprietor of a registered design under the Act, that is no conclusive proof that the plaintiff is the proprietor of the design but it is only a prima facie evidence that he is, the proprietor. It will be odd to hold that on the strength of a recent registered design, the plaintiff can claim an absolute right to restrain everyone else from carrying on his business unless and until the registered design of the plaintiff is cancelled in appropriate proceedings by a competent court of law.

On the other hand a Division Bench of the Calcutta High Court in the case of Rotomac Pens Limited v. Milap Chand & Co., IPLR (1999) April 149 : 1999 PTC (19) 757 (Cal) (DB) held that the view of the Delhi High Court in Niky Tasha Pvt. Ltd. (supra) was not the correct view and that though there may be an application for cancellation of registered design under Section 51A of the old Act, till such time the cancellation takes place the registered holder of a design can under Section 53 of the old Act prevent any one from acting contrary or pirate the design, which stands registered with the Registrar. The Calcutta High Court further held that the defendants' claim of the invalidity of the plaintiffs registration on grounds of lack of

originality and pre-publication were outside the purview of the Court under Section 53 of the old Act.

24. That decision of the Full Bench was rendered on 10th December 1999. Sections 19 and 22 of the Designs Act, 2000, contain similar provisions which were to be found in Sections 51A and 53 of the old Act; but Act of 2000 has incorporated the following additional provisions in Sub-sections (3) and (4) in Section 22:-

"22. Piracy of registered designs-

1) xxx xxx

2) xxx xxx (3) In any suit or any other proceedings 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 under 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."

25. It is thus clear that the Legislature has not only accepted the principle laid down by the Full Bench of the Delhi High Court in Metro Plastic Industries' Case (supra) but has gone a step further and it is provided that every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence in a

suit under Section 22 of the Act complaining about piracy of the registered design. The Designs Act, 2000 does not provide that the defendant can plead any ground of cancellation as a defence only after filing an application for cancellation under Section 19 of the Act. However, it is not necessary to pursue the discussion further in as much as in each of the five suits, the first defendant has filed an application for cancellation of the registration in favour of the plaintiff and such applications under Section 19 of the Act before the Controller of Designs at Calcutta are pending before the said authority.

26. In view of the above quoted clear-cut statutory provisions of Sub-section (3) of Section 22, it is not possible to accept the contention urged by the learned counsel for the plaintiff that the factum of registration of designs in favour of the plaintiffs by itself is sufficient to entitle the plaintiff to get interim injunction against the defendants. As laid down by the Full Bench of the Delhi High Court, the Court must take into consideration all relevant facts, which would include the grounds urged by the first defendant for cancellation of the registered designs in favour of the plaintiff. The Court must decide whether or not to grant injunction in favour of registered owner. Such a decision must be made judicially and in such cases the Court would apply the principles which govern grant of injunction under Order 39 Rules 1 and 2, CPC."

iii) In case of **Rotela Auto Components (P) Ltd. & anr.** (supra), the

Delhi High Court has held as under :

"13. Mr. V.P. Singh further contended that the defense available pursuant to Sub-section 3 of Section 22 read with grounds available for cancellation of registration under Section 19 of the Act be read together and if the same are available to the defendants, injunction as prayed for by the plaintiffs cannot be granted. Mr. Singh contended that Section 107 of the Patents Act is paramateria with Section 22(3) of Designs Act and Section 64 of the Patents Act is paramateria with Section 19 of the Designs Act. A Division Bench of this Court had the occasion to deal with Section 107 read with Section 64 of the Patents Act and if both are read in conjunction, the plaintiffs would not be entitled for injunction. In Franz Xaver Huemer v. New Yash Engineers a Division Bench of this Court held:-

"The defendant has taken out a large number of other pleas to bring the case under Section 64 of the Act which read with Section 107, could be grounds of defense irrespective of whether the defendant has applied for revocation or not."

26. From the Full Bench decision in Metro Plastic Industries (Regd.)'s case (supra) it was urged before me by Mr. Bhardwaj that as the defendants have not filed an application under Section 19 of the act before the Controller of Designs in view of Full Bench decision, the grounds mentioned in Section 19 of the Act cannot be taken in defense by the defendants.

27. I am afraid in view of new Designs Act, 2000 the Full Bench

decision in Metro Plastic Industries (Regd.)'s case (supra) will not be of any held to the applicants-plaintiffs. Under the Designs Act, 1911, Section 53 did not have any provision like Sub-section (3) of Section 22, therefore, when the Full Bench of this Court was dealing with the provisions of Designs Act under the Act of 1911, it was in that context that the Full Bench held that if there was no application for cancellation of design made, no defense can be taken based on grounds as available in the grounds for cancellation of registration of a design. As far as present Act is concerned, the legislature in its wisdom by incorporating Sub-section (3) of Section 2 of the Act has made every ground, on which registration of a design may be cancelled, available as a ground of defense. The ground on which cancellation can be sought of registration are enumerated in Section 19 of the Act. It may be noticed that the design is a conception, suggestion or idea of a shape and not an article. If it has already been anticipated, it is not new or original. If it has been pre-published, it cannot claim protection as publication before registration defeats the proprietor's rights to protection under the Act."

71. Similarly, the decisions relied on behalf of the defendants can also not be considered, more particularly, in view of the fact that the defendants have not

raised any contention that there is no similarity of the design between the registered design of the grill for air cooler of the plaintiffs and the defendants. As per the well settled law, it is the eye of the customer which is the most relevant factor by comparing the designs in front of the eyes. Therefore, merely production of the photographs to show the prima facie case is not material. Therefore, the following decisions which are relied upon on behalf of the defendants with relevant paragraphs thereof are not applicable in facts of the case :

i) In case of **M/s. Niki Tasha India Pvt. Ltd.** (supra), the Delhi High Court has held as under :

"(2) These are the facts. The Plaintiffs (the present appellants). M/s. Niky Tasha India Private Limited brought a suit for permanent injunction against the defendants (the present respondents). M/s. Faridabad Gas Gadgets Private Limited complaining of infringement of their registered design No. 152986 dated 11-4-1983 pertaining to the product known as a Kitchenette which is a combination of gas burner, grill and oven. The plaintiffs got registration with regard to shape and configuration in this product of theirs. It is alleged that the

defendants under the name of Navjyoti are manufacturing, selling and advertising Lpg gas cooking range similar in design to the registered design of the plaintiffs.

(9) In England, as in India, it is open to a plaintiff at any time after the institution of the suit to move for an interlocutory injunction to prevent the defendant from infringing his design between then and the date of trial. In *Smith vs. Grigg Limited* (1924) 41 RPC(149)(3), it was held that same principles apply to the case of a design as are applicable in the case of a patent. The plaintiff must show that he has a prima facie case, both that his design is valid and that it has been infringed by the defendant. The mere fact that the plaintiff is in possession of a patent or of a registered design is not of itself necessarily prima facie evidence of validity. On the contrary, where it appears that the design has only recently been registered, and where it appears that there is a substantial issue to be tried, an interlocutory injunction will not be granted. (Ruse II Clarke page 121).

(10) In *Smith vs. Grigg Limited* (1924) 41 Rpc 149. Scrutton, L.J., said :

"FROM the authorities which have been cited to us, and from my own personal inquiries from sources competent to give me information, there is in patent cases a well recognised rule of practice in the courts which deal with patent cases as to interlocutory injunctions, and it is this : That where the patent which you are seeking to enforce is a recent patent, an interlocutory injunction is not granted where there is a genuine case to be

decided. Parker, J. put it very shortly in *Trautoer v. Patmore* (1912) 29 Rpc 60 at 63 : 'I cannot grant an interim injunction. It is very unusual if the patent has not been established.' It is put at greater length by the Court in the case of *Jackson vs. Needle*, which was decided just after the Patents, Designs and Trade Marks Act, 1883 where both Baggallay, L. J. and Cotton, L. J. State that, where it is a new patent, or a recent patent, the court is not in the habit of granting these injunctions until the title has been established. I take the principle that underlies that to be this, that the court leans against monopolies. Where you find a respectable and old established monopoly which has been in existence for years and not challenged, there is no reason for the court to lean too hardly against it, but when you find a recent monopoly which there has not yet been time to challenge sought to be enforced, the Court is inclined to take the view as a general rule, unless there are special circumstances to overcome it, that the title to the monopoly must be established before it interferes by interlocutory injunction. It is not a universal rule : there may easily be facts which will lead the court in a particular case to depart from it, but as a general rule that is the practice of the court". *Atkin, LJ.* at page 154 said : "I think the reason for the principle which has been adopted in respect of a person claiming an interlocutory injunction restraining the infringement of a patent is that the plaintiff has always to establish at any rate a *prima facie* case of having a right which has been infringed by the defendant, and according to our patent law, which in this respect I think differs from that of some other countries. the mere fact of the

granting of a patent is not in self an indication that the plaintiff has established to the satisfaction of any authority that he has the right to the monopoly which he claims. In the case of a patent, therefore, the mere fact that a patent has been granted does not show that those conditions have been performed which alone entitle a plaintiff to a conclusive right, and therefore the courts, when they are approached by a plaintiff who says : 'I am the owner of a patent and the defendant has infringed if, say where the patent is of recent date : 'Your right is not established sufficiently by the mere fact that a patent has been granted to you'; and unless there is some kind of substantial case evidenced before the court that there is in fact a valid patent, then the court refuses to a grant an injunction. I think the same thing must apply in the case of a person who claims under a registered design".

(11) SMITH'S case was followed by the Court of Appeal In, Zaldener vs. Barrisdale Engineers Ltd. : 1968 Rpc 488 (4) Willmor, L. J. at page 495 said:

"It is naturally with reluctance that I differ from the view of so experienced a Judge but I cannot think this is a proper case in which to grant the relief of an interlocutory injunction. The grant of such relief can be a very serious matter, especially if it leads to the closing down of the defendants' works for an indeterminate period, with the possibility of throwing a number of people out of employment. In the circumstances of this case I do not see that, in the absence of an interlocutory injunction, there is the slightest chance of the plaintiff

suffering any irreparable injury. I see no reason why damages should not afford an adequate remedy, assuming that the plaintiff ultimately succeeds in the action. We have not been informed as to the scale on which the defendants are operating, but if it turns out that they are operating on a large scale then no doubt, if the plaintiff succeeds in the action, she will recover substantial damages. But equally on that basis there should be no doubt as to the ability of the defendants to pay them. If, on the other hand, the defendants are operating on only a small scale, then I venture to think that any injury to the plaintiff will be almost minimal". Lord Denning in *Hubbard vs. Vosper* (1972) 2 Wlr 389 (396) (5) said: "In considering whether to grant an interlocutory injunction, the right course for a judge is to look at the whole case. He must have regard not only to the strength of the claim but also to the strength of the defense and then decide what is best to be done. Sometimes, it is best to grant an injunction so as to maintain the status quo until the trial. At other times it is best not to impose a restraint upon the defendant but leave him free to go ahead. For instance in *Fraservs. Evans* (1969) 1 Qb 349, although the plaintiff owned the copyright, we did not grant an injunction, because the defendant must have a defense of fair dealing. The remedy by interlocutory injunction is so useful that it should be kept flexible and discretionary. It must not be made a subject of strict rules".

(12) I take it to be well settled, both in India and in England that an interlocutory injunction will not normally, be granted where damages will provide an adequate remedy should the claim succeed. Furthermore, I have

always understood the rule to be that the court will not grant an interlocutory injunction unless satisfied that there is a real probability of the plaintiff succeeding on the trial of the suit. Where the design is of a recent date, as in this case, no injunction should be granted. More so, when there is a serious question as to the validity of the design to be tried in the suit and an application for cancellation has been made. Where a person is entered as a proprietor of a registered design, that is under the Act no conclusive proof that the plaintiff is the proprietor of the design, but only a prima facie evidence that he is the proprietor. The plaintiff has this advantage that if no evidence at all is given then the certificate is sufficient evidence that he is the proprietor. Mohd. Abdul Karim Vs. Mohd. Yasin, Air 1934 All. 798 (6) (D.B.).

(21) The principles are clear. The difficulty lies in their application. On the recent design in this case the plaintiffs cannot be granted an injunction when there is a serious question to be tried in the suit. If there is any real dispute on the questions as to infringement or validity of the registered design the court will, as a general rule, refuse an interim injunction. Damages will afford a sufficient remedy. The defendants are prepared to give an undertaking as to damages.

(22) I cannot accept the argument that the plaintiffs on the strength of the registration certificate have absolute right, a right which is good even against independent designers. "The Court is not in the habit of granting injunctions until the title has been

established". "The Court leans against monopolies". The certificate does not establish a conclusive right. It has to be tried and tested in the laboratory' of courts. We must not forget that the registered design of the plaintiffs is of a very recent date. In case of a recent monopoly which is seriously . disputed on various grounds such as prior publication, lack of originality trade variation etc. it will not be proper to grant an injunction. There is a serious question to be agued as to whether the design is valid or not, and on the facts lam not satisfied that the balance of convenience requires an interim injunction, particularly in view of the undertaking which the defendants are prepared to give."

ii) In case of **Garware-wall Ropes Ltd.** (supra), this Court has held as under :

"39. While rejecting the interim injunction application preferred by the appellant, the Learned Single Judge has given several reasons, which inter alia, include that in the suit for infringement of the patent, the plaintiff must make out a strong prima facie case for grant of temporary injunction and that when serious controversy exists as to whether or not the invention made by the plaintiff is a new or it involves inventive skills, the Court should not grant injunction in favour of plaintiff and that if the patent is new and its validity is not established in judicial proceedings and the defendant's endeavour is to show that the patent

ought not to have been granted, ordinarily, the Court should not issue a temporary injunction. While declining the interim relief to the appellant, the Learned Single Judge has placed reliance on the judgment reported in (1) in the case of Manika Thevar v. Star Plough Works (2) in the case of Hindustan Lever Ltd. v. Godrej Soaps Ltd. (3) in the case of Standipack Pvt. Ltd. v. Oswal Trading Co. Ltd. (4) in the case of Ram Narayan Kher v. Ambassador Industries, PTC (Suppl) (1) 180 (Del.). The Learned Single Judge has further observed that when the validity of the patent has been challenged on the ground that patent has been obtained by fraud, there is no new invention of a new product, but it is simply an extension of what was earlier used or was known to the world, then, the extra burden lies upon the plaintiffs to show to the Court that their work or invention of the product is not simply an extension. The Learned Single Judge has further observed that when the defendants come out with a case that patent is illegal and deserves to be revoked, then, obviously there would be a triable issue in favour of the defendants and not in favour of the plaintiffs. With regard to the process of the plaintiff's product, the Learned Single Judge has observed that the plaintiffs cannot be allowed to say that the method of weaving is the only statement in the application, but, they can refer to any other method of manufacture. According to the Learned Single Judge, weaving is a different process than the process

of intermeshing and textile experts know that what is weaving and what is the difference between weaving and intermeshing. The defendants are not using any weaving process in manufacturing the gabions, their process is certainly intermeshing. The Learned Single Judge was also of the view that if the gabions made of different materials were used to avoid or protect soil erosion for more than 7,000 years, then the innovation of a gabion cannot be said to be a new inventive invention, no research was required to be made in something which was publicly known. It is further recorded that rope gabions and polymer gabions are being used in Maharashtra and Bihar since 1991 and 1987. If Nylon Crates and gabions are used by the Governments for long many years and are being manufactured by Netlon and other companies, then the plaintiff would not be entitled to say that they have separate existence of a new product which was not known. The Learned Single Judge further took the view that patent may not be granted in favour of some one, who very cunningly make an application to the authority for grant of patent without even disclosing that what is new in its item and how it was not known to the public previously. It is further observed by the Learned Single Judge that Nylone, which is also used for manufacturing the gabions, is a strong polymer/material and if that use is known to the world, then, simply by replacing nylone by some other synthetic material, the plaintiff

would not be allowed to claim that they have invented a product. The Learned Single Judge has also given specific finding to the effect that the defendants are successful in showing that their product is something different than what has been registered in favour of the plaintiffs. The product manufactured by the defendants, in the considered opinion of the Learned Single Judge, is not same or similar to what is patented in favour of the plaintiffs. Ultimately, the Learned Single Judge has come to the conclusion that the product of the plaintiff is neither new nor a result of the research, nor it is cheaper, nor it is something, which, for the first time, came into existence and was not known in the field.

47. The Court finds some substance at this stage in the submission that no interim injunction protecting the patent and restraining the defendant from continuing the manufacturing and marketing of products in dispute would be granted if the patent is new, its validity has not been upheld in any judicial proceedings and serious controversy raised regarding its validity either by filing an application in revocation or claiming revocation and counter claim in the suit. The defendant's contention may not be brushed aside at this stage that the grant of patent is no proof of its validity and principles laid down in American Cyanamid does not govern the field of law in India. Reliance is placed on the decision in the case of Bishwanth Prasad Radhey Shyam v. Hindustan Metal Industires, 1982 SC

1444, in the case of Metro Plastic Industries (Regd.) v. Galaxy Footwear New Delhi , in the case of Manika Thevar v. Star Plough Works , in the case of Rotomac Pens Ltd. v. Milap Chand & Co. 1999 PTC (19) 757.

48 . So far as the present case is concerned, the patent application had been originally submitted on 22.06.1999. It was returned by the Registry on 30.12.2002 and resubmitted only on 29.03.2004. It was published on 04.02.2005 and the patent was sealed only on 13.05.2005. The suit was filed on 17.10.2005. The patent is thus new and its validity has not been upheld in judicial proceedings and as is being pointed out, serious controversy is raised regarding its validity in the counter claim and the records produced. Since patent was granted only in May 2005, its validity could not have been challenged and decided earlier. The Learned Single Judge has adequately protected the interest of the plaintiff by directing the defendant to maintain account and directing the defendant to secure their claim for damages. The plaintiff has not shown how and why payment of compensation is not an adequate remedy."

iii) In case of **Galatea Ltd.** (supra), this Court has held as under :

"73. In the case of TVS Motor Company Limited Vs. Bajaj Auto

Limited, vide judgment dated 18.5.2009 rendered in O.S.A. nos. 91 and 92 of 2008, the Hon'ble Madras High Court has observed thus:

"69. When we refer to the various decisions relied upon by the learned senior counsel for the respective parties the following principles emerge viz.,

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iii) If the patent is a new one, mere challenge at the Bar would be quite sufficient for the refusal of an interim injunction as compared to a fairly old patent.

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(v) Irrespective of the examination and investigation made under Sections 12 and 13 of the Patents Act, no presumption can be drawn as to the validity of the patent and whether the application for revocation of patent is pending and when serious controversy exist as regards the existence of an invention based on prior art, the Court should be slow in granting the injunction.

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74. In the case of Standipack Private Limited & Anr. Vs. M/s. Oswal Trading Co. Ltd., vide judgment dated 26.5.1999 rendered in I.A. no. 11829 of 1998 and allied matters, the Hon'ble Delhi High Court observed thus:

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15. It has been held in a series of judgments that no presumption of validity attaches to a patent granted by the Controller under the Act notwithstanding examination and investigation made under Sections 12 and 13. In this connection reference may be made to a decision in Bishwanath Prasad Vs. Hindustan Metal Industries; , Hindustan Lever Ltd. Vs. Godrej Soaps Ltd. and M/s. Niky Tasha India Pvt. Ltd. Vs. M/s. Faridabad Gas Gadgets Pvt. Ltd. reported in AIR 1985 Delhi 136 at 138. In Surendra Lal Mahendra Vs. M/s. Jain Glazers & Others, reported in ILR 1981(1) Delhi 257, the Delhi High Court relying upon the judgment in Smith Vs. Grigg Ltd., 41 RPC 149(1) held that despite all the safeguards and circumspection contemplated in C/CS/2/2017 ORDER various provisions of the Act against grant of patent in respect of a spurious, purloined or fake invention, the Legislature minced no words in clarifying its intendment that no presumption of validity would attach to a patent granted by the Controller under the Act, notwithstanding examination and investigation made under Sections 12 & 13 thereof.

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76. In the case of Ten XC Wireless Inc & Anr. Vs. Mobi Antenna Technologies (Shenzhen) Co. Ltd. vide judgment dated 4.11.2011 rendered in CS (OS) nos.1989 of 2010, the Hon'ble Delhi High Court

observed thus:

"32. It is noteworthy that the grant and sealing of the patent, or the decision rendered by the Controller in the case of opposition, does not guarantee the validity of the patent, which can be challenged before the High Court on various grounds in revocation or infringement proceedings. It is pertinent to note that this position, viz. the validity of a patent is not guaranteed by the grant, is now expressly provided in Section 13(4) of the Patents Act, 1970. In the light of this principle, Mr. Mehta's argument that there is a presumption in favour CS(OS) Nos.1989/2010 & 1993/2010 Page 39 of 78 of the validity of the patent, cannot be accepted."

(Emphasis Supplied)

7.2 In M/s. Niky Tasha India Pvt. Ltd. v. F.G. Gadgets Pvt. Ltd., AIR 1985 Delhi 136, the Division Bench of this Court held that the registration of a patent does not establish a conclusive right in favour of the C/CS/2/2017 ORDER plaintiffs to be entitled to an injunction and the plaintiffs have to establish before the Court that the patent is valid. Where the patent is of a recent date, no injunction should be granted. More so, when there is a serious question as to the validity of the patent to be tried. The patent has to be tried and tested in the laboratory of the Courts. The Courts lean against monopoly as a general rule unless there are special circumstances to overcome it.

The findings of this court are reproduced hereunder:

"9. In England, as in India, it is open to a plaintiff at any time after the institution of the suit to move for an interlocutory injunction to prevent the defendant from infringing his design between then and the date of trial. In *Smith v. Grigg Limited* (1924) 41 RPC 149(3), it was held that same principles apply to the case of a design as are applicable in the case of a patent. The plaintiff must show that he has a *prima facie* case, both that his design is valid and that it has been infringed by the defendant. The mere fact that the plaintiff is in possession of a patent or of a registered design is not of itself necessarily *prima facie* evidence of validity. On the contrary, where it appears that the design has only recently been registered, and where it appears that there is a substantial issue to be tried, an interlocutory injunction will not be granted.

22. I cannot accept the argument that the plaintiffs on the strength of the C/CS/2/2017 ORDER registration certificate have absolute right, a right which is good even against independent designers. "The Court is not in the habit of granting injunctions until the title has been established". "The Court leans against monopolies". The certificate does not establish a conclusive right. It has to be tried and tested in the laboratory of courts. We

must not forget that the registered design of the plaintiffs is of a very recent date. In case of a recent monopoly which is seriously disputed on various grounds such as prior publication, lack of originality trade variation etc. it will not be proper to grant an injunction. There is a serious question to be argued as to whether the design is valid or not, and on the facts I am not satisfied that the balance of convenience requires an interim injunction, particularly in view of the undertaking which the defendants are prepared to give.

53. The plea of the plaintiff that since there is a multi-layered, multi-level examination of the opposition to the grant of patent it should accorded the highest weightage, is not entirely correct. The contention that there is a heavy burden on the defendant to discharge since it has to establish that it has a stronger prima facie case of the plaintiff is contra indicated of the decisions in the context of Section 13(4). Reference may be made to the decisions in Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 : PTC (Suppl) 731 (SC), Standipack Pvt. Ltd. v. Oswal Trading Co.

C/CS/2/2017 ORDER Ltd., AIR 2000 Delhi 23 : 1999 PTC (19) 479 (DEL), Bilcare Ltd. v. Amartara Pvt. Ltd., 2007 (34) PTC 419 (Del), Surendra Lal Mahendra v. Jain Glaziers, (1979) 11 SCC 511. In Beecham Group Ltd. v. Bristol Laboratories Pty Ltd.,

(1967-68) 118 CLR 618 and Australian Broadcasting Corporation v. O'Neill, (2006) 229 ALR 457 it was held that the defendant alleging invalidity bears the onus of establishing that there is "a serious question" to be tried on that issue. In Hexal Australai Pty Ltd. v. Roche Therapeutics Inc. 66 IPR 325 it was held that where the validity of a CS(OS) Nos.1989/2010 & 1993/2010 Page 48 of 78 patent is raised in interlocutory proceedings, "the onus lies on the party asserting invalidity to show that want of validity is a triable question." In Abbot Laboratories v. Andrx Pharmaceuticals Inc. decision dated 22nd June 2006 of the U.S. Court of Appeals for the Federal Circuit 05-1433 the Court of Appeals followed its earlier ruling in (Helifix Ltd. v. Blok-Lok Ltd. 208 F.3d 1339 where it was held (at 1359): In resisting a preliminary injunction, however, one need not make out a case of actual invalidity. Vulnerability is the issue at the preliminary injunction stage, while validity is the issue at trial. The showing of a substantial question as to invalidity thus requires less proof than the clear and convincing showing necessary to establish invalidity itself. (emphasis supplied) In Erico Int'll Corprn v. Vutec Corprn (U.S. Court of Appeals for the Federal Circuit, 2007-1168) it was held that the C/CS/2/2017 ORDER "defendant must put forth a substantial question of invalidity to show that the claims at

issue are vulnerable.

7.4 In M/s Standipack Pvt. Ltd. v. M/s Oswal Trading Company Ltd., AIR 2000 DELHI 23, the plaintiff sought an injunction against the defendants from manufacturing or using the patented pouch for storing/dispensing liquids which was defended on various grounds inter alia that the claimed invention was not novel and the application for revocation was pending. The injunction application was dismissed by this Court. Dr. M.K. Sharma, J., as he then was of this Court, held as under:

"15. It has been held in a series of judgments that no presumption of validity attaches to a patent granted by the Controller under the Act notwithstanding examination and investigation made under Sections 12 and 13. In this connection reference may be made to a decision in Bishwanath Prasad v. Hindustan Metal Industries, reported in (1979) 2 SC 511 at p.521: AIR 1982 SC 1444 : 1979 All LJ 290 at p.296, Hindustan Lever Ltd. v. Godrej Soaps Ltd., reported in AIR 1996 Cal 367 at p.381 and M/s. Niky Tasha India Pvt. Ltd. v. M/s. Faridabad Gas Gadgets Pvt. Ltd., reported in AIR 1985 Delhi 136 at p.138. In Surendra Lal Mahendra v. M/s. Jain Glazers & Others, reported in ILR 1981 (1) Delhi 257, the Delhi High Court relying upon the judgment in Smith v. Grigg Ltd. 41 RPC 149, held that despite all the safeguards and circumspection

contemplated in C/CS/2/2017 ORDER various provisions of the Act against grant of patent in respect of a spurious, purloined or fake invention, the Legislature minced no words in clarifying its intendment that no presumption of validity would attach to a patent granted by the Controller under the Act, notwithstanding examination and investigation made under Sections 12 & 13 thereof.

16. When the conditions referred to in Section 64 are examined and applied to the facts and circumstances of the present case in the light of the observations made herein before, it is clear that the use of the pouches for packaging purposes of the nature of the one used by the plaintiff and in respect of which patent has been granted was widely prevalent. The same is also an admitted position when the plaintiff has stated that the storage of liquid products other than liquid in a pouch does not constitute a novel idea. Some of the defendants have filed applications for revocation of the patent granted in favor of the plaintiff under section 64 of the Patents Act. There are cases where it is held that when an application is filed seeking for revocation of the patent and questioning the validity of the patent the court should not grant an injunction. It is settled law that in an action for infringement of a patent an injunction would not be granted where the validity of the patent itself has been questioned and a revocation petition has been filed. In this

connection reference may be made to a decision of the Madras High Court in V. Manicka Thevar v. M/s. Star Plough Works, AIR 1965 Mad 327 at p.328, wherein it was held that if from the objections raised by the defendant it is clear that a serious controversy exists as to whether or not the invention involves any new inventive skill having regard to what was known or used prior to the date of the patent; courts would not grant an injunction restraining the defendant CS(OS) Nos.1989/2010 & 1993/2010 Page 52 of 78 from pursuing his normal business activity. It was also held that an interim injunction would not be granted if the defendant disputes the validity of the grant. In M/s. Niky Tasha India Pvt. Ltd. Vs. M/s. Faridabad Gas Gadgets Pvt. Ltd. AIR 1985 Delhi 136 at p.140 (supra) it was observed by this court that no injunction should be granted when there is a serious question of the validity of the design to be tried in the suit and an application for cancellation has been made."

85. The principles for grant of injunction have been succinctly discussed in American Cyanamide Co.'s case (supra) which have been accepted and followed in the case of Franz Xaver Huemer v. New Yash Engineers, AIR 1997 Delhi 79 wherein it was held in paras 28, 31 and 32 as under:

It is true that earlier, in the well known case in American Cyanamid v. Ethican (interlocutory) 1975 RPC 513 (at 541, 542), it

was observed that it was sufficient if a 'triable issue' was there. According to Lord Diplock, the Court must also be satisfied if there is a "serious C/CS/2/2017 ORDER question to be tried": therefore it should not try to assess relative merits by looking into prima facie case in the affidavit evidence but CS(OS) Nos.1989/2010 & 1993/2010 Page 56 of 78 should instead turn at once to the balance of convenience; if damages to be awarded at the trial can adequately compensate plaintiff and the defendant could pay them, injunction could be refused; if not, injunction could be refused; if not, injunction could be granted; if defendant could be compensated by way of damages later by plaintiff, injunction by way of damages later by plaintiff, injunction could be granted; where there is doubt about the adequacy of damages to one or both ; any factor which may affect balance of convenience is to be considered. If the balance is even, the relative strength of the case is to be considered.

31. It is said that in the law of patents, it is not sufficient merely to have registration of a patent. The Court must look at the whole case, the strength of the case of the patentee and the strength of the defence such as those falling under Section 107 read with Section 64.

32. The need to establish prima facie has been emphasized in

recent cases in England and in India. The Court has to consider whether there is prima facie proof of infringement (Lord Denning M.R. & Megaw LJ Hubbard v. Vosper(1972) 1 All ER 1023. Prima facie proof of validity is different from prima facie proof of infringement as stated by Sultan Singh, J. in NRDC Co. v. DCM Ltd. AIR 1980 Delhi 132. In that case, the learned Judge quoted Terrel on the law of Patents (12th Ed. Para 830) : (at p 135 of AIR):

The plaintiff must first establish such facts as will satisfy the Court that there are strong prima facie reasons for acting on the supposition that the patent is valid. The most cogent evidence for this purpose is either that there has been a previous trial in which the patent has been held to be valid, or that the patentee has worked and enjoyed the patent for many years without dispute or may be that as between the CS(OS) Nos.1989/2010 & 1993/2010 Page 57 of 78 parties the plaintiff is relieved from the onus of establishing validity, as where the defendant has admitted it or is so placed in his relationship to the plaintiff as to be estopped from denying it."

87. As I have already stated that the defendants have raised substantial, tenable and credible challenge to the patent which raises a triable dispute, therefore, the plaintiff has failed to make out a prima facie case for the grant of ad interim injunction. Considerable doubt has been

raised by this Court about the working of the patent in commercial sense and on the other hand, the defendants are stated to be in the business of manufacturing mirrors since the year 1993."

(iii) If the patent is a new one, mere challenge at the Bar would be quite sufficient for the refusal of C/CS/2/2017 ORDER an interim injunction as compared to a fairly old patent.

(iv) Even in IPR cases, apart from prima facie case, balance of connivence and irreparable injury, the mere registration of the patent alone would not be sufficient and the Court must look at the whole case i.e. the strength of the case of the plaintiff and the strength of the defendant.

(v) Irrespective of the examination and investigation made under Sections 12 and 13 of the Patents Act, no presumption can be drawn as to the validity of the patent and whether the application for revocation of CS(OS) Nos.1989/2010 & 1993/2010 Page 60 of 78 patent is pending and when serious controversy exist as regards the existence of an invention based on prior art, the Court should be slow in granting the injunction.

7.10 The well settled principles for grant of interim injunction in patent matters laid down by the Courts in the aforesaid judgments are summarized as under:

7.10.1 The registration of a patent per se does not entitle the plaintiffs to an injunction. The certificate does not establish a conclusive right.

7.10.2 There is no presumption of validity of a patent, which is evident from the reading of Section 13(4) as well as Sections 64 and 107 of the Patents Act.

7.10.3 The claimed invention has to be tested and tried in the laboratory of Courts.

7.10.4 The Courts lean against monopolies. The purpose of the legal regime in the area is to ensure that the inventions should benefit the public at large.

7.10.5 The plaintiff is not entitled to an injunction if the defendant raises a credible challenge to the patent. Credible challenge means a serious question to be tried. The defendant need not make out a case of actual invalidity. Vulnerability is the issue at the preliminary injunction stage whereas the validity is the issue at trial. The showing of a substantial question as to invalidity thus requires less proof than the clear and convincing showing necessary to establish invalidity itself.

7.10.6 At this stage, the Court is not expected to examine the challenge in detail and arrive at a definite finding on the question of validity of the patent. That will have to await at the time of CS(OS) Nos.1989/2010 & 1993/2010 Page 62 of 78 trial. However, the Court

has to be satisfied that a substantial, tenable and credible challenge has been made. 7.10.7 The plaintiff is not entitled to an injunction, if the patent is recent, its validity has not been established and there is a serious controversy about the validity of the patent."

94. As held by Delhi High Court in the case of Ten XC Wireless Inc & Anr. (Paragraph 72) (supra), mere grant of patent does not tantamount to its validity and the same is not guaranteed by the grant and in facts of this case, the Suit Patent is a new patent and the validity of the same is to be examined in the Suit in the full-fledged trial and merely because the plaintiffs have been granted similar patent in other countries is of no consequences considering the provisions of the Act. In light of the aforesaid therefore, the judgment of this Court in the case of Rajnikant Devidas Shroff (supra) is not applicable to the case on hand. Even if the opinion of Anand and Anand, Advocates is ignored, in opinion of this Court, the same does not take the case of the plaintiffs any further.

99. Consequently therefore, the plaintiffs have not been able to prima facie prove that the machines used by the defendants amounts to infringement of the machines of the plaintiffs. It is a matter of record that the Suit Patent is new in the sense that it is granted on 22.2.2016 and its validity is yet to be adjudicated. The patents which are granted to

the plaintiffs in other countries cannot be made basis of an action of infringement in India. The defendants are also in business since long and even prima facie considering the Commissioner's report, it cannot be said that any apparatus is found in C/CS/2/2017 ORDER the machine of the defendants which would in any manner infringe the Suit Patent which is protected under the provisions of the Act by grant of patent in favour of plaintiff no.1. The same has to be tested and after considering the whole set of evidence only, it can be determined whether the same amounts to infringement of Suit Patent or not.

100. In light of the aforesaid therefore, the plaintiffs have failed to prove three essentials for grant of an interim relief i.e. prima facie case, balance of convenience and irreparable loss and injury. Considering the pleadings on record, contentions raised by both the sides as well as the judgments cited by both the sides, in facts of this case, the plaintiffs have not been able to prove the prima facie case. The defendants have declared before this Court, even during the course of argument, that they do not use any vacuum pump or any apparatus for removal of bubbles and therefore, only because the end result of the two machines is the same, the same in prima facie opinion of this Court would not constitute infringement of the Suit Patent. As discussed hereinabove, the apparatus and the method of the same is protected

under the Suit Patent and not the end result."

iv) In case of **Galatea Ltd through authorised signatory Gilad Hissad**, (supra), this Court has held as under :

"18. On the other hand, learned counsel Shri Soparker submitted that the learned Single Judge committed no error in refusing injunction for the following reasons :

1) Patent is a new patent. Same is also subjected to counter claim and revocation. No injunction on the basis of such patent can be granted.

2) Patent is not valid in law and cannot be enforced.

3) The defendants had pointed out that the method claimed by the plaintiffs to be innovative was already known to the world at large.

4) Even if the patent is valid, it is granted on the basis of the claim of vacuum pump which in any case defendant is not using. No argument is raised by the plaintiffs that the defendants are using vacuum pump.

5) Balance of convenience, prima facie case and irreparable loss are all in favour of the defendants.

6) The appellate Court would not lightly overturn the findings of the Single Judge in appeal. In any case, the issues are extremely complex. Complicated considerations of scientific nature are presented. At the interim stage, the Court would not undertake such exercise.

7) In support of his contentions, counsel relied on the following judgments :

1) Decision in case of Monsanto Company By their Patent Agent, De Penning and De Penning v. Coramandal Indag Products (P) Ltd. reported in (1986) 1 Supreme Court Cases 642, in which the Supreme Court observed as under:

".....Under Section 64(1) (d), a patent may be revoked on the ground that the subject of any claim of the complete specification is not an invention within the meaning of the Act. Under section 64(1) (e), a patent may be revoked if the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known as publicly used in India before the date of the claim, etc. Under sec. 64(1)(f), a patent may be revoked if the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step having regard to what was publicly known or publicly used in India or what was published in India before the priority date of the claim (the words "or elsewhere" are omitted by

us as the patents in the present case were granted under the Indian Patents and Designs Act, 1911, i.e., before the Patents Act 1970). "Invention has been defined by Section 2(j) as follows:

" Invention" means any new and useful

(i) art, process, method or manner of manufacture;

(ii) machine, apparatus or other article;

(iii) substance produced by manufacture, and includes any new and useful improvement of any of them, and an alleged invention."

It is clear from the facts narrated by us that the Herbicide CP 53619 (Butachlor) was publicly known before Patent Number 125381 was granted. Its formula and use had already been made known to the public by the report of the International Rice Research Institute for the year 1968. No one claimed any patent or any other exclusive right in Butachlor. To satisfy the requirement of being publicly known as used in clauses (e) and (f) of sec. 64(1), it is not necessary that it should be widely used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of knowledge of the patented product or process either as men of science or men of commerce or consumers. The section of the public who, as men of science or men of commerce, were interested

in knowing about Herbicides which would destroy weeds but not rice, must have been aware of the discovery of Butachlor. There was no secret about the active agent Butachlor as claimed by the plaintiffs since there was no patent for Butachlor, as admitted by the plaintiffs. Emulsification was the wellknown and common process by which any Herbicide could be used. Neither Butachlor nor the process of Emulsification was capable of being claimed by the plaintiff as their exclusive property. The solvent and the emulsifier were not secrets and they were admittedly not secrets and they were ordinary market products. From the beginning to the end, there was no secret and there was no invention by the plaintiffs. The ingredients, the active ingredient, the solvent and the emulsifier, were known; the process was known, the product was known and the use was known. The plaintiffs were merely camouflaging a substance whose discovery was known through out the world and trying to enfold it in their specification relating to Patent Number 125381. The patent is, therefore, liable to be revoked. We do not think that it is necessary for us to go into the various questions of law so carefully and meticulously argued by Mr. Chellaswamy. The questions were no doubt interesting and arose for the first time. But we desire to keep our interest purely academic and within bounds. So we do not pronounce upon those questions. The appeal is dismissed with costs."

2) Decision in case of M/s. Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries reported in

(1979) 2 Supreme Court Cases 511, in which it was observed that the object of Patent Law is to encourage scientific research, new technology and industrial progress. It was further observed that grant and sealing of the patent, does not guarantee the validity of the patent, which can be challenged before the High Court on various grounds in revocation or infringement proceedings.

3) Decision in case of Novartis AG v. Union of India & ors. reported in MANU/SC/0281/2013 in which the Supreme Court observed as under :

"139. The dichotomy that is sought to be drawn between coverage or claim on the one hand and disclosure or enablement or teaching in a patent on the other hand, seems to strike at the very root of the rationale of the law of patent. Under the scheme of patent, a monopoly is granted to a private individual in exchange of the invention being made public so that, at the end of the patent term, the invention may belong to the people at large who may be benefited by it. To say that the coverage in a patent might go much beyond the disclosure thus seem to negate the fundamental rule underlying the grant of patents."

4) Decision in case of GarwareWall Ropes Ltd. v. Techfab India and 5 ors. reported in MANU/GJ/0272/2008, in which the Division Bench of this Court observed that there was some substance in the submission that no interim injunction protecting the patent

could be granted, if the patent is new, its validity has not been upheld in any judicial proceedings and serious controversy raised regarding its validity either by filing an application for revocation or claiming revocation and counter claim in the suit. The defendant's contention may not be brushed aside at this stage that the grant of patent is no proof of its validity.

5) Decision in case of TEN DC Wireless Inc and Anr. v. Mobi Antenna Technologies (Shenzhen) Co Ltd reported in MANU/DE/4436/2011, in which learned Single Judge of Delhi High Court referred to and relied upon the observations of the previous Division Bench of the High Court that the grant of such patent to plaintiffs would not ipso facto entitle them to interim injunction, if defendant was able to satisfy the Court that there was a serious question to be tried as to validity of patent.

6) Decision in case of TVS Motor Company Limited v. Bajaj Auto Limited (supra), in which the Division Bench of Madras High Court summarized the principles in paragraph no. 69 of the judgment, relevant portion of which reads as under :

"69. When we refer to the various decisions relied upon by the learned senior counsel for the respective parties the following principles emerge viz

(i) The validity of a patent can be challenged in a suit on various grounds

of revocation as set out under Sections 64 and 107 of the Patents Act.

(ii) For the grant of interim injunction in a patent matter, the prima facie validity of the patent should be shown and also the prima facie infringement should be proved apart from the availability of balance of convenience and irreparable loss.

(iii) If the patent is a new one, mere challenge at the Bar would be quite sufficient for the refusal of an interim injunction as compared to a fairly old patent.

(iv) Even in IPR cases, apart from prima facie case, balance of convenience and irreparable injury, the mere registration of the patent alone would not be sufficient and the Court must look at the whole case i.e the strength of the case of the plaintiff and the strength of the defendant."

7) Decision in case of V. Manioka Thevar v. Star Plough Works, Melur reported in AIR 1965 Mad 327, in which learned Single Judge of Madras High Court observed as under :

"6. Secondly, the patent is very recent one and I find that the decisions have uniformly taken the view that any patent which is less than six years old is regarded as a recent one. The statement of the law in Terrel on Patent, 9th Edn pages 318320 shows that a patentee should show undistributed possession of the

enjoyment of the patent atleast for a period of six years before the controversy arose.

In Boots pure Drug and Co. (India) Ltd v. May and Baker Ltd., MANU/WB/0212/1947 : 52 CWN 253, this rule that there should be proof of actual user of the patent for more than six years was applied in India. Thirdly there is also a serious controversy about the validity of the grant of the patent touching the originality or the inventive genius of the plaintiff or as to how far the prior knowledge holding the field would disentitle the plaintiff to the grant of the patent. The defendant is certainly not a new entrant in the field but he has himself been a dealer, manufacturer and seller of ploughs of various patterns. For all these reasons I entirely agree with the order of the learned District Judge holding that the plaintiff has not made out any case for the grant of an interim injunction.

"23. The legal position on the interpretation of the said provisions as it broadly emerges from the judgments cited at bar would be thus :

1) Mere grant of patent would not give an indefeasible right to the plaintiffs to enforce the patent in a suit and to claim the interim injunction pending such suit. Though grant of patent would be one of the considerations, would not be the sole consideration.

2) If the patent is old time tested one, existing since long, the Court

would consider it with due regard and would lean in favour of enforcing it in absence of any other reason to the contrary. On the other hand, if the patent is relatively new, the Court would be slow in enforcing it at the interim stage, unless shown to be beyond vulnerability.

3) In the context of patent being new or old, the Courts have often employed a yardstick of six years time. Though counsel for the respondent could not bring to our notice source of selection of this cutoff line of six years, it was argued they agree that same has been employed by several Courts in the past.

Division Bench of this Court in case of GarwareWall Ropes Ltd.(supra), as noted, observed that no interim injunction was granted by the Court, if patent is a new one and its validity has not been upheld in judicial proceedings and serious controversy is raised regarding its validity. Likewise the learned Single Judge of Delhi High Court in case of TEN DC Wireless Inc and Anr.(supra) referred and followed the observations of the Division Bench that grant of patent to the plaintiff will not ipso facto entitle them to interim injunction.

Division Bench of Madras High Court in case of TVS Motor Company Limited(supra), observed that patent is a new one. Mere challenge at bar would be quite sufficient for refusal of interim injunction as compared to a fairly old patent.

Learned Single Judge of Madras High Court in case of Manioka Thevar(supra), observed that patent in the said case was a recent one and decisions of the Courts uniformly take a view that any patent which is less than six years old is regarded as a recent one.

4) We have however noticed some of the recent decisions of the Courts where this principle of recent patents not being readily enforced at the interim stage is questioned. Learned Single Judge of Madras High Court in case of Bajaj Auto Ltd., State of Maharashtra rep by S. Ravikumar(supra) granted injunction noticing that patent was in existence since about five years. Division Bench of Madras High Court in case of Mariappan and ors.(supra) rejected the contention that patent being less than six years old, injunction should not be granted observing that the view held in Manioka Thevar(supra) has lost its significance in view of latest developments in the field of science and technology. Now that the patent life is very short in view of new innovations and inventions which are frequently taking place, wherein a new product is using its significance and market very quickly. Likewise in case of Metro Plastic Industries (supra), Full Bench of Delhi High Court agreed to the suggestion that merely because a registration is recent is by itself no ground for refusing an injunction. That also would be a factor which can be taken into consideration by the Court.

5) In the suit for infringement of

patent, the fact that the patent granted is not previously tested in the judicial proceedings and in respect of which revocation application is pending could be a matter of valid consideration. Likewise the defence of the defendants in such a suit challenging the validity of the patent would also be a relevant factor.

6) At the interim injunction stage, it will be sufficient for the defendants to demonstrate vulnerability of the patent.

7) Thus while deciding to grant or to refuse injunction in a patent suit, some of the factors that Court would consider are :

a) Whether patent is an old time tested one or a recent one?

b) Whether the person interested have either applied for revocation of the patent or opposed the patent in the suit?

c) Whether in such proceedings the defendants have made out a prima facie case of vulnerability of the patent on any of the grounds otherwise available for revocation of the patent such as lack of any innovative step or existence of prior art?"

v) In case of **The Wimco Limited** (supra), Delhi High Court has held as under :

"7) The cancellation of registration is provided by section 51-A of the Act reading as follows :

"CANCELLATION of registration (1)Any person interested may present a petition for the cancellation of the registration of a design

(a)at any time after the registration of the design, to the High Court on any of the following grounds, namely :

(i)that the design has been previously registered in India, or

(ii)that it has been published in India prior to the date of registration; or

(iii)that the design is not a new or original design; or

(b)within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of clause (a).

(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."

The cancellation is sought in the petition on the grounds that the design has been published in India prior to the date of its registration and that the design is not a new or original design. The registration of the design is on the application of any person

merely claiming to be the proprietor of any new or original design not previously published in India. Under the scheme of the Act there is no provision for notice to the public regarding the registration of a design or for opposition by the public to the registration of the design. Even an inspection of the Register of Designs is not open for a period of two years from the date of registration thereof. It is manifestly impossible for the Controller when registering a design to know of every possible publication which may anticipate a design. It is for this reason that protection is afforded under Section 51-A to the other manufacturers or persons aggrieved against the abuse of the Act, and acquisition of mischievous monopolies for designs. Any person interested may avail himself of this section and apply for the cancellation of the registered design.

(8) The word "published" used in Sections 43 and 51-A of the Act has not been defined in the Act. Publication within the meaning of the Act means the opposite of being kept secret. It is published if. a design is no longer a secret. There is publication if the design has been disclosed to the public or the public has been put in possession of the design. Russell-Clarke in Copyright in Industrial Designs, Fourth Edn. (Pages 41-42) says :-

".....IT is sufficient, and there will be publication if the knowledge was either

(1) Available to members of the public;
or

(2) Actually in fact shown and disclosed to some individual member of the public

who was under no obligation to keep it secret.

It is not necessary that the design should have been actually used. There will just as much be publication if it is shown that it was known to the public, without ever having been actually put into use. Thus, publication may be of two types :

(a) Publication in prior documents.

(b) Publication by prior user."

(9) The first material unimpeachable evidenced the publication of the design in India prior to the "date of registration is contained in the Government of India publication of the Patent Office, Calcutta; Specification No. 29046, dated 17-9-1942 (accepted 3-4-1943) relating to improvements in or relating to container for match boxes. It is Annexure SM-2 with the affidavit dated May 25, 1981 of Shri S. Maheshwaran. He deposes that in figures No. 1 and 2 of the drawing attached to the said specification the igniting surface is shown and marked as 17 which amounts to prior publication and knowledge. The said specification particularly describes and ascertains the nature of the invention and the manner in which the same is to be performed. The invention relates to improvements in the containers for match boxes the design of which is also published. It says this. The object of the invention is to provide a casing for a match box which will protect the match box whilst it is carried in the pocket. The casing itself will be made of leather or leather substitute which will be stiff enough to act as a protection and would be a sufficiently wear-resisting nature to give prolonged

life to the match box and indeed to a succession of match boxes. The container casing will also preferably have an aperture or apertures at the side or sides to expose the match striking and igniting surface carried by the match box. Improvements in the container are then specified. It then states that in placing the match box into position in this container the slide is removed from the matchbox with the contained matches and the outer sheath of the match box is slipped into the space between the front and the back of the casing, with the elastic spring inside the match box sheath. The match box outer sheath is pushed down until its lower edge is against the inner side of the bottom of the container casing. The match box slide containing the matches is then pushed in and its lower edge engages the loop of the elastic. The elastic is stretched as the slide is pressed home. It then mentions that the match box may be struck against the striking and igniting surface which shows at each side of the match box."

vi) In case of **Dart Industries Inc.** (supra), the Delhi High Court has held as under :

"Russell-Clarke on Industrial Designs (Sixth Edition) also throws some light on the manner in which prior publication is to be found. Relevant portion from the said book containing discussion on this aspect can be reproduced below:

3.89. ...In practical terms, there are two main ways in which a design can be published by prior use of the design, by selling or displaying to the public articles to which the

design has been applied, and by paper publications of one sort or another.

3.92. Prior publication of a design by prior use can be said to take place when the design has been applied to articles and those articles have been used in such a way that the design becomes disclosed to the public before the date of application for registration of the design in suit. It should be noted that it is sufficient if the design is used on any kind of article, and it need not be the same article, or even in the same category, as the article in respect of which the design is registered or sought to be registered.

3.93. In general there will be publication if articles to which the design is applied are manufactured, displayed or used in such a way that members of the public will or might see them. It is not necessary that the articles should have been sold.

3.95. Thus, if the use was in such a position and in such circumstances that some members of the public would be likely to have seen the design, there will be publication, even though it is not proved that anyone did examine it.

3.96. The disclosure of the prior use need not be to a large number of the public. If there has been a disclosure of the design to any individual member of the public....

3.121. ...However, there is no restriction on the manner in which the design comes to be published and the disclosure could even be purely oral. In general, there will be publication if the design is disclosed to any individual member of the public who is not under any obligation to secrecy. Disclosure to merely one such person will be sufficient to constitute publication....

3.147. What is a trade variant was explained by Lord Moulton in *Philips v. Harbro Rubber Co.*.... It is necessary with regard to the question of infringement and still more with regard to the question of novelty and originality that the eye should be that of an instructed person i.e. that he should know what was common trade knowledge and usage in the

class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original. For example, if it is common practice to have or not to have spikes in the soles of running shoes, a man does not make a new or original design out of an old type of running shoe by putting spikes into the soles.

3.181. In order to ascertain what the registered design is, so that it may be compared with the alleged infringement, it is necessary to examine the representation of the design on the register. A copy of this is in practice attached to the certificate of registration...although if this course is adopted care should be taken to avoid introducing further features which are not present on the representation on the register....

3.182. A registration, if valid gives to the registered proprietor an exclusive right in relation to article to which the registered design, or a design not substantially different from it....

26. It is not in dispute that even if the plaintiff possesses registration of designs in question, defendant can, in an action by the plaintiff brought in the suit, plead that the designs in question were no new or original. This Court in *Niky Tasha India Pvt. Ltd. v. Faridabad Gas Cadgets Pvt. Ltd.* AIR 1985 Delhi 136 clarified this legal position when it observed as under:

...Where a person is entered as a proprietor of a registered design, that is under the Act he conclusive proof that the plaintiff is the proprietor of the design but only a prima facie evidence that he is the proprietor. The plaintiff has the advantage that if no evidence at all is given then the certificate is sufficient evidence that he is the proprietor. *Modh. Abdul Karim v. Mohd. Yasin.*

Para 14. Design is a conception, suggestion or idea of a shape and not an article. It has been already

anticipated it is not new or original. "If it has been pre-published it cannot claim protection. Publication before registration defeats the proprietor's right to protection under the Act."

23. Counsel for the plaintiffs says that the effect of Section 53 of the Act is to grant statutory right to the person who happens to have got registered and that the person has an absolute statutory right until the registration is set aside. I do not agree. The reason is that it really does not matter much in this case whether the defendants' defenses are considered in the infringement suit or in the cancellation application.

30. At this stage, we are only to look into the matter giving our opinion on prima facie basis. There appears to be a serious dispute as to the validity of the design to be tried in the suit. In the case of Rotela Auto Components (P) Ltd. and Anr. v. Jaspal Singh and Ors. 2002 (24) PTC 449, the injunction was revised while observing as under:

"29. Looking it from any angle from the documents placed on record the design has been pre-published and, therefore, it cannot claim protection. In view of the fact that registration of design is of recent date, the design having been published earlier the ground of defense as mentioned in Section 29 can be taken by the defendants pursuant to sub section (3) of Section 22 of the Design Act, 2000, therefore, no injunction can be granted as there is a serious dispute as to the validity of the design to be tried in the suit. Before closing the arguments affidavit has been filed by the defendants before the appropriate authority. The applicants are not entitled to the injunction. I,

therefore, vacate the injunction order granted earlier...."

vii) In case of **Bharat Balar & another** (supra), the Madras High Court has held as under :

"11. It is the case of the Plaintiffs that they have been manufacturing and marketing Electric Kitchen Appliances for several years. During the course of business, they have designed a novel Unitary Multilayer Container and Idly Plates. The said design was registered with the Controller General of Patents, Designs and Trade Marks in Design No. 256062. While so, recently, in the year 2014, the Plaintiffs came to know that the Defendants are also manufacturing and selling Unitary Multilayer Container and Idly Plates, which is an exact imitation of Plaintiffs' registered design. It is the further case of the Plaintiffs that unlike the Trademarks Act, the Plaintiffs need not establish the prior usage or good will or reputation and if there is valid registration, that would suffice to grant Interim Injunction in their favour. Per contra, according to the Defendants, the design adopted by the Plaintiffs is not a new and original one and hence, the same ought not to have been registered. In fact, the Defendants have also filed a Petition in Form 8 for cancellation of the registration of the Design No. 256062 in Class 07-02 before the Controller of Designs, Calcutta. In this regard, learned Senior Counsel appearing for the Defendants by inviting the attention of this Court to the List of Publications, submitted that similar

design was adopted by several other manufacturers much earlier to the registration of the Plaintiffs. Therefore, the said design has already been in public domain. When a design has already been in public domain, registration of such a design is prohibited under Section 4 of the Designs Act. Even if it is registered, on filing a petition by any person interested on any one of the grounds available under Section 19 of the Designs Act, the said registration could be cancelled. Further, as per Section 22(3) of the Designs Act, the ground available under Section 19 of the Designs Act to cancel the registration of a design could also be taken as a defence by the Defendant, if a Suit is brought by a person as against any other persons based on the said registration. In view of the said submission made by the learned Senior Counsel appearing for the Defendants, it would be appropriate to extract Sections 4 & 19 of the Designs Act, 2000 and the same are extracted hereunder:

"Section 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."

"Section 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."

As per Clause 4(b) of Designs Act, 2000, if the design 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, the same shall not be registered. In the instant case, from the documents produced on the side of the Defendants, I find that the design of layers in the inner and

outer wall of the Plaintiffs' container was already in public domain. Further, a perusal of the Tamil Nadu Stainless Steel Merchants Association Member's Directory, 2009, would show that already the design was in public domain and further from the United States Design Patent Nos. US D 522,809 and US D545,137 produced by the Defendants, it could be seen that the said design was already registered in United States. Under such circumstances, I am of the opinion, the design is not liable to be registered and the same is liable to be cancelled under Section 19(1)(a) & (b) of the Designs Act, 2000. But, it is the submission of the learned Counsel appearing for the Plaintiffs that since the said design is registered, unless the said registration is set aside, the Defendants cannot oppose the grant of Interim Injunction. But, I am not inclined to accept the said submission made by the learned Counsel appearing for the Plaintiffs. Under Section 22(3) of the Designs Act, 2000, the Defendants can defend a Suit if it is brought on the ground of infringement of design against them on any one of the grounds mentioned in Section 19 of the Designs Act, 2000. Section 22(3) of the Designs Act, 2000 reads as follows:

"(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."

The ground mentioned in Section 19 of the Designs Act, 2000 is available as a defence to the Plaintiffs in the present Suit. Therefore, I am of the opinion, it is not necessary for the Defendants to wait till the registration of the design to be set

aside.

12. In this regard, a reference could be placed in the judgment reported in Metro Polymers Pvt. Ltd. & another v. Madhu Inflatables Pvt. Ltd. and another, 2005 3 LW 598, wherein this Court as held as follows:

"15. By incorporating sub-section (3) of Section 22 of the Designs Act, the registration of a design may be cancelled on every ground available as a ground of defence. The grounds on which the registration of a design can be cancelled have been enumerated in Section 19 of the Act. If a design is a conception, suggestion or idea of a shape is not an article. If it has already been anticipated, it is not new or original. If it has been pre published, it cannot claim protection as publication before registration defeats the proprietor's right to protection under the Act. Thus, looked at from any angle from the documents placed on record, the designs registered by the Plaintiffs have been pre-published and therefore they cannot claim protection, since the registration of the designs are only few years later than the publication of the designs by the Respondents/Defendants. The grounds of defence as mentioned in Section 19 can be taken by the Respondents/Defendants pursuant to sub-section (3) of Section 22 of the Designs Act and therefore no injunction can be granted as there is a serious dispute with regard to the validity of the designs to be tried in the Suit. Hence, the Applicants/Plaintiffs are not entitled for an injunction. Therefore, this Original Application is liable to be dismissed and the same is hereby dismissed. No costs."

The dictum laid down in the above judgment would show that if the design is already in public domain, the same cannot be registered. If such a design is registered, the same can be cancelled. Even before cancellation of the design, if a Suit is brought against a person for infringement, the same can be defended by the Defendant under the grounds available under Section 19.

13. In yet another decision reported in Taparia Tools Limited v. Ambica Overseas and Anr., : , the Bombay High Court has held as follows:

"21. I am, prima facie, of the view that Plaintiffs design of Wrench is published in India and other countries prior to the date of registration by them. Although, Mr. Shah would contend that the statement in the affidavit in reply to the aforesaid effect is not supported by any materials, in my view, a perusal of Exhibits to the Affidavit in reply and the further reply would go to show that the designs of Wrenches have been published in India prior to the registration in favour of Plaintiffs. The exhibits are not mere extracts of information available on inter-net. There is an extract of the Certificate of ISI. The information may be available on inter-net/web-site but when the same contains statements about parties using such designs from 1984-85, it cannot be brushed aside straight away. The truth and veracity of such statements in addition to the assertions on affidavit will have to be decided at the trial. Even the Plaintiff could have filed further Affidavit but that opportunity is not availed off. Further, several Wrenches

available in the market were produced for my perusal. When I saw each one of them it is clear to the naked eye that their shape and configuration is common to that of the Plaintiff. Even the scale marking appears to be common. Thus, insofar as the scale marking is concerned, there does not appear to be any novelty. Even as regards the shape and configuration of the Wrench, there is ample material produced by the First Defendant to prima facie negative the pleas of Plaintiff."

14. In yet another decision reported in *Rotela Auto Components Pvt. Ltd. v. Jaspal Singh and Ors.*, 2002 24 PTC 449, it has been held as follows:

"28. As far as present Act is concerned, the legislature in its wisdom by incorporating sub-section (3) of Section 22 of the Act has made every ground, on which registration of a design may be cancelled, available as a ground of defense. The ground on which cancellation can be sought of registration are enumerated in Section 19 of the Act. It may be noticed that the design is a conception, suggestion or idea of a shape and not an article. It has already been anticipated, it is new or original, if it has been pre-published, it cannot claim protection as publication before registration defeats the proprietor's rights to protection under the Act."

In the instant case, several materials are produced by the Defendants to show that the design alleged to have been invented by the Plaintiff, was already in public domain. When it is already in public domain, it is a valid ground for cancellation of the registration.

When the ground for cancellation of the design is established before this Court, this Court cannot grant Interim Injunction. In this regard, learned Counsel appearing for the Plaintiffs by relying upon the decision of this Court reported in M.C. Jayasingh v. Mishra Dhatu Nigam Limited (MIDHANI), rep. by its Managing Director, Apollo Hospitals, Apollo Hospitals Enterprise Limited and Cancer Institute (W.I.A.) (Regional Cancer Centre), : , submitted that if there is a valid registration, the Plaintiffs are entitled for Interim Injunction. A reading of the said judgment would show that in that case, the Defendant therein had not challenged the registration of the design. In fact, the learned Judge has observed in that judgment that since the Defendant had not challenged the registration, it has to be taken that the validity of the Plaintiffs design was not under challenge. But, in the instant case, the Defendant has already challenged the registration by filing necessary Application. Therefore, the said decision cannot be made applicable to the facts of the present case.

viii) In case of **Anuradha Doval** (supra), Calcutta High Court has held as under :

"35. The aforesaid judgment was considered by a Full Bench of the Delhi High Court in Reckitt Benkiser India Ltd. v. Wyeth Ltd. reported at AIR 2013 Delhi 101 (FB) in Paragraphs 21 and 22

of the report which read:-

"21. We have reproduced a large number of paragraphs both of the judgments, of the learned Single Judge in Gopal Glass work's case, and of the Supreme Court in the appeal from the judgment of Gopal Glass Work's case in Bharat Das Tools Ltd. because, it is only on the reading of these paras it becomes clear that the Supreme Court in no manner laid down an absolute rule that there can never be prior publication although in the public record of the Registrar of Design abroad a particular design is found to be registered. The Supreme Court in fact has specifically held that facts in each case have to be very minutely examined and Courts have to be extremely cautious by thoroughly scrutinizing the evidence in each case for deciding whether the public record available in Registrar of Design abroad could or could not be taken as prior publication, and in the peculiar facts of the case before the Supreme Court when we refer to paragraphs 45 to 47 it becomes clear that the Supreme Court approved the view of the learned Single Judge of the Calcutta High Court in Gopal Glass Work's case because even the Supreme Court found that sufficient evidence was not led on behalf of the objector to the registered design and that the documents downloaded through internet from the website of U.K. Patent Office did not add that amount of clarity for the same to be said to be prior publication for seeking cancellation on the basis of such alleged prior publication of a design registered in India.

22. What has been observed by the Supreme Court in the case of Bharat Das Tools Ltd. is reinforced by the following paragraphs of Russell-Clarke

and Howe on Industrial Designs VIIIth Edition:

What counts as "published" for the purpose of calling into question the novelty of a later design registration? This is broader than the word at first suggests. It is by no means limited to the publishing of a design in a printed publication, although it includes that. In practical terms, there are two main ways in which a design can be published: by prior use of the design, by selling or displaying to the public articles to which the design has been applied; and by paper publications of one sort or another. It is not, in fact, necessary that publication should be on paper; an oral disclosure, provided it is non-confidential, will amount to publication.

Re-registration of the same design for different articles, or a similar design for same or different articles.

A special exception existed to the general rule that the novelty of a design will be destroyed by the prior registration or publication of that design as applied to any kind of article. By S.4(1) of the RDA(A), the proprietor of a registered design was entitled to apply for registration of the same design, or a design with modifications or variations not sufficient to affect its identity, in respect of another article. His own previous registration, or the publication of his design as registered, does not then destroy the novelty of his new design registration in respect of the new article, but his term of protection is limited to the term of the original design. This, in effect, gave the proprietor of a design registration the ability to extend the

scope of the registration during its lifetime to cover further articles, although in formal terms each application to protect his design on a new article will be a separate application leading to a separate design registration. It appears that his application for registration of the design on the new article must precede his actual use of the design on the new article. This is because, if he uses the design on an article which falls outside the scope of his earlier registration, then that will not count as a publication "of the registered design", which is all that s.4(1) of the RDA(A) shields him against as regards the novelty of his new application.

A person who makes an application to register a design and finds that it has previously been registered in respect of a different article was allowed to buy up the earlier design registration while his own application was still pending, and if he did so he could take advantage of this rule in the same way as if he had himself been the owner of the earlier registration all along.

The same rule applied to the registration (whether in respect of the same article or a different article) of a design which is not exactly the same as the earlier registered design, but has "modifications or variations not sufficient to alter the character or substantially to affect the identity thereof". However, this provision has been interpreted narrowly so that practically any significant change or difference between the earlier and later design will destroy the protective effect of this provision. For an applicant to rely on s.4(1)(b), the subject of his application must

have substantial identity with his prior published design.

In Sebel Ltd's Application (No.1), it was held that substitution in the old design of a different stand did substantially alter the identity of the article (a rocking horse), and that the subsection did not apply. Since the stand had already been published in an advertisement showing it applied to another horse, it was held that design failed to qualify for novelty under s.1, the said stand being a mere trade variant. In Sebel Ltd's Application (No.2), a design was held not to fall within s.4 because the character of the design was different from the character of the applicant's earlier design. Thus it seems that the applicant's own earlier design may be sufficiently similar to destroy the novelty of his later application for protection of his modified design, and yet too different to allow him to take advantage of the protection of RDA(A) s.4(1). This is an odd and unfortunate result if it is indeed correct.

Publication in documents In cases of publication of a design by prior use as applied to an article, normally the only questions which arise are whether it has been published at all (i.e. whether the articles to which it has been applied have been disclosed to the public), and whether the design is similar enough to the design in suit to destroy the latter's novelty. But where the novelty of a design is tested against a prior published document, a number of additional questions can arise which do not arise in the case of a prior use.

First, it may not be clear whether or not the document discloses a design as

applied to an article at all. A trade catalogue containing photographs or illustrations of articles to which a design has been applied may be a clear enough case.

But the publication in a document of a pattern or picture does not as such destroy the novelty of a design which consists of applying that pattern or picture to an article. For it to destroy the novelty of such a design, the paper publication must suggest explicitly or implicitly by context that the pattern or picture should be applied to an article.

Secondly, the pattern (if it is two-dimensional) or shape (if it is three-dimensional) of the design may not be clear from the document. Particularly in a case where it involves a written description rather than an explicit picture or illustration, there may be room for argument as to the precise nature of the design which the document discloses, before one can go on to ask whether or not it is similar enough to the later design to destroy novelty.

Thirdly, a paper publication may be shielded from destroying the novelty of a later design registration by the special provisions of subss.6(4)-(5) of the RDA(A). These provisions allowed the owner of copyright in an artistic work to exploit his work so long as he did not apply it industrially to an article, without his own exploitation of it counting against the novelty of his own later application for a design registration covering the artistic work as applied to an article.

Does the document disclose a design applied to an article?

In order to destroy the novelty of a design registration, an earlier design must be published "in respect of the same or any other 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 it is less easy to envisage cases where the publication of a shape does not implicitly convey the article to which that shape is to be applied. Thus, novelty may reside in the application of an old shape or pattern to new subject-matter. This was first laid down in the leading case of *Saunders v Wiel*. There, the design consisted of the handle of a spoon made to represent Westminster Abbey seen from a particular point of view. The design had actually been copied from a photograph of the Abbey.

The validity of the design was upheld, Bowen L.J. saying "It seems to me that the novelty and originality in the design, within this section, is not destroyed by its being taken from a source common to mankind...The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all the world may resort. Otherwise, it would be impossible to take any natural or artistic object and to reduce it into a design applicable to an article of manufacture, without also having this consequence following, that you could not do it at all in the first place unless you were to alter the design so as not to represent exactly the original; otherwise there would be no novelty in it, because it would be said that the thing which was

taken was not new. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew, nor an elephant unless you drew it and carved it of a kind which had never been seen. An illustration, it seems to me, that may be taken about this is what we all know as the Apostles spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking the figures of the Apostles, but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles figures so that they should be applicable to that particular subject-matter. How does a building differ from that? In no sense it seems to me.

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 registrations 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 pictures 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? 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 it discloses? 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.

This was laid down in *Rosedale Associated Manufacturers Ltd v Airfix Ltd*. Lord Evershed M.R. 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 sub-sequent 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 3-123 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." On the same point Romer L.J. 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 Corporation v 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 anticipation of inventions, but it seems to me that they apply by analogy to alleged anticipation by "paper publications" of registered designs."

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."

72. In view of the above facts and case law, it is pertinent to note that the defendant has not filed any application for cancellation of the registered design of the plaintiff before the Controller and the submission of the defendant that without separately seeking cancellation of the registration of the design under section 19 in a suit for infringement of the design, defendants can raise the defense challenging the validity of the registration as a ground of defence under section 22(3) of the Act is true but at the same time the material fact remains that the defendants have chosen not to challenge the registered design of the plaintiffs and has raised its defence only on the ground that such defence can be raised under section 22(3) of the Design Act, 2000.

Therefore, the decisions relied upon by the defendants cannot be pressed into service as the same would be not applicable at the stage of deciding the interim injunction as such decisions are rendered in case of challenge to patents and provisions of Patents and Design Act are materially different. Whether the defendants chooses to challenge the registered design under section 19 of the Design Act, 2000 or not is not material inasmuch as the defendants are aware about the copy made by them of the registered design of the plaintiffs and after filing of the application for registration of the design of the plaintiffs, the defendants have filed the application which clearly shows that the intention of the defendants as it has come up on record prima facie that the defendants are in the habit of copying various designs as pointed out by the plaintiffs, as the plaintiffs have also filed the suit against the defendants in Rajasthan as well as litigation is also filed against the defendants under the Design Act, 2000 for copy of either design of the air cooler or for copy of the design of the

grill of the air cooler.

73. Considering the rival submissions, statutory provisions and judicial pronouncements cited by the respective parties and as there is an obvious and striking similarity in design of the plaintiffs and that of the defendants and there does not appear to be cogent material on record to indicate that the plaintiffs were using the same design prior to the date of application for registration and for the reasons stated here in above, this Court is of the considered view that the plaintiffs have made out a prima facie case for grant of temporary injunction.

74. The balance of convenience is also found in favor of the plaintiffs who would suffer irreparable loss to the business and goodwill in the market, if their design is not protected. Moreover, no prejudice to the business of the defendant would be caused if the injunction is granted as the defendants are free to use any other design and it is also not clear on record about the production and marketing of the grill of

similar design by the defendants.

75. The applications Exh.6 for interim injunction in both the suits are therefore, allowed. The defendants, their servants, agents, distributors and dealers are restrained by order of injunction from manufacturing, marketing and using the registered design of the grill of the air cooler of the plaintiffs till the final disposal of the suit or till such time as the registration thereof remains intact.

76. It is clarified that the observations and views expressed by this Court is prima facie in nature and none of the observations made in this order shall be construed to be an expression or opinion on any question of law and facts which will be decided on its own merits at the time of trial.

(BHARGAV D. KARIA, J)

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