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

Pronounced on: 24th March, 2023

\+ CS(COMM) 253/2021

KENT RO SYSTEMS PVT LTD & ANR. ..... Plaintiffs
Through: Ms. Rajeshwari H, Mr. Kumar Chitranshu & Mr. Sugandh Shahi, Advs.

versus

PUSHPENDRA & ORS. ..... Defendants
Through: Mr. Mohan Vidhani with Ms.Elisha Kumari & Mr. Amandeep Singh, Advs. for D-1
Ms. Shruti Dass, Adv. for D-2

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T

% 24.03.2023

I.A. 6940/2021(*under Order XXXIX Rules 1 and 2 of CPC*)

1. By this judgment, I proceed to dispose of IA 6940/2021, filed by the plaintiffs Kent RO Systems Ltd. under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).

2. Detailed arguments on this application have been advanced by learned Counsel Ms. Rajeshwari H. on behalf of the plaintiffs and by Mr. Mohan Vidhani on behalf of Defendant 1.

A Conspectus

3. The grievance of the plaintiffs is that Design No. 219309 dated 17th October 2008, which stands registered in favour of the plaintiff as its proprietor in respect of a "water purifier" has been infringed by

various entities, who sell water purifiers bearing allegedly infringing designs on the Flipkart website, owned and managed by Defendant 2 (hereinafter referred to as "Flipkart").

4. A tabular statement of the water purifiers bearing allegedly infringing designs and sold over Flipkart is provided in para 25 of the plaint. Of these, the water purifiers at serial nos. 3, 6 and 10 are manufactured by Defendant 1 Pushpender Yadav, as is also admitted by Defendant 1 in para 24 of the written statement filed by him by way of response to the plaint. Defendant 1 has, however, disclaimed any knowledge or connection with the water purifiers at serial nos. 1, 2, 4, 5, 7, 8, 9, 11 and 12.

5. This Court had, *vide* order dated 2nd August 2021, directed Flipkart to place on record the details of the persons whose water purifiers were being sold under the URLs at serial nos. 1, 2, 4, 5, 7, 8, 9, 11 and 12, as well as other products alleged to be imitatively similar in design to the suit design and figuring at pages 212 to 271 of the documents filed with the plaint. The said list has been provided by Defendant 2 under affidavit dated 10th August 2021. Subsequently, IA 11227/2021 has been filed by the plaintiff to implead 13 of the said sellers as Defendants 3 to 15 in the plaint. I have not been informed of any orders having been passed on the said application till date. In any event, the relief that the plaintiff can seek can only be, at the highest, against the said Defendants 3 to 15 whom the plaintiffs seek to implead in the present proceedings, apart from Defendant 1.

6. Arguments in the present case were addressed only by the Plaintiffs and Defendant 1. The proposed Defendants 3 to 15 had yet

to be arrayed as parties till the reserving of judgment in the present application. This order shall, therefore, be restricted to Defendant 1.

Facts

7. The plaint

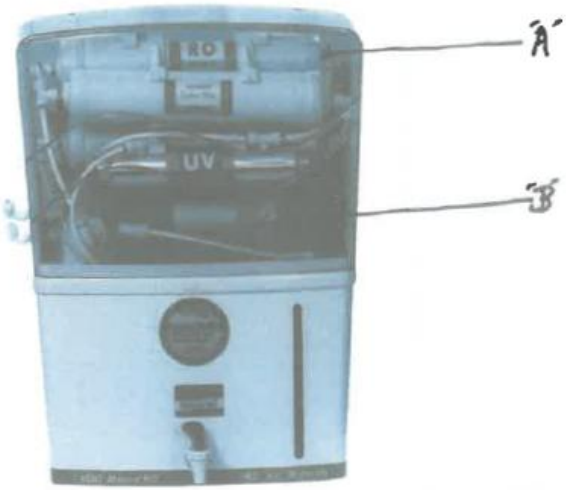
7.1 The case set up by the plaintiff may be set out thus.

7.2 Plaintiff 2 Mahesh Gupta adopted, on 9th February 1998, the KENT mark for oil/petroleum products. In 1999, Kent RO Systems was founded as a partnership firm by Plaintiff 2. Subsequently, the firm was incorporated as a public limited company M/s Kent RO Systems Ltd. by Plaintiff 2 in 1999.

7.3 Reverse Osmosis (RO) based water purifiers are asserted to have been introduced, in the Indian market, by the plaintiffs in 1999. Plaintiff 2 is stated to have devised and to be holding Copyright Registration No. A-97193/2013 dated 12th February 2013 in the KENT Mineral RO Water Purifiers logo, under which Plaintiff 2 was manufacturing and selling its RO based water purifiers. It is further asserted, in the plaint, that the aforesaid copyright registration was licensed by Plaintiff 2 to Plaintiff 1.

7.4 Subsequently, on 17th October 2008, the Controller of Designs issued Certificate No. 219309 under the Designs Act, 2000, registering the suit design in favour of Plaintiff 2 for a "water purifier". Registration was granted, as is usual, of all views of the

design, viz.



FRONT VIEW

BACK VIEW

TOP VIEW

BOTTOM VIEW

SIDE VIEW

7.5 Below each view, the following recital figured:

> "Novelty resides in the shape and configuration of the Water Purifier, and particularly at the portions marked 'A' and 'B', as illustrated.
>
> No claim is made by virtue of the registration in respect of any mechanical or other action of the mechanism whatsoever or in respect of any mode or principle of the construction of the article.
>
> No claim is made by virtue of registration of any right to the use of colour combination appearing in the design.
>
> No claim is made by virtue of registration to any right to the exclusive use of the words, letters, trade mark etc.:"

7.6 An aside: At this juncture, the Court is constrained to enter a comment. It has been seen, in case after case, that design registration is blankly given by certifying novelty to be residing in the "shape and configuration" of the design. The exact features of the shape and configuration, which were found by the Controller to be novel, are hardly ever mentioned, and the Court has, therefore, to resort to guesswork in that regard. The Designs Act protects novelty in a design, not a design *per se*. In the absence of novelty, a design is not

registerable. The novel features of a design must, therefore, be forthcoming and apparent from the registration certificate. Merely certifying novelty to be residing in the "shape and configuration" is of little use to any authority, or Court, which may be seized of a dispute which requires it to understand the design, and its novel features. It also leaves the Court with a sense of disquiet as to whether, before registering the design, there has been proper application of mind.

7.7 In the present case, for example, the certificate, as issued by the Controller, certifies novelty to be residing in "the shape and configuration, *particularly at the portions marked 'A' and 'B'.* I have tried my level best, but am unable to discern what 'A' and 'B' refer to. While I would have more to say on that later, such a design certification does little justice to the very purpose of certifying a design as novel.

7.8 The Controller of Designs is directed, therefore, to ensure that, in future, certificates granting design registrations are sufficiently clear as to the features of the design which are found to be novel, even if the reason for certifying novelty need not be forthcoming in every case (though it would undoubtedly be desirable). Mere certification of the "shape and configuration" as novel, in every case, should, if possible, be avoided unless it is impossible to pinpoint individual novel features.

7.9 The plaint asserts that the plaintiff was selling the water purifier under the suit design under the brand name KENT GRAND+. According to the assertions in the plaint, the novel features of the suit design are

(i) a transparent upper and an opaque lower half,

(ii) a curved top edge,

(iii) a distinctive middle band,

(iv) embossed waves on the opaque part of the front of the cabinet,

(v) a bulging middle,

(vi) an overall trapezoid shape, and

(vii) a water indicator towards the left side of the lower opaque portion.

7.10 The aforesaid design, it is asserted, has become a source identifier of the KENT GRAND+ water purifier manufactured and sold by the plaintiff.

7.11 The plaintiff does not possess any trademark registration for the mark KENT GRAND+ though an application, for that purpose, has been filed and is pending before the Registrar of Trade Marks.

7.12 The plaint also provides the turnover from sales of the KENT GRAND+ water purifier of the plaintiff from the years 2016-17 to 2018-19. In the year 2018-19, sales of the KENT GRAND+ water purifiers of the plaintiff resulted in inflow of approximately ₹ 270.9 crores.

7.13 The plaint has also set out various encomiums, awards, commendations and certificates that have been issued to the plaintiff, especially in the context of the KENT GRAND+ water purifiers. Though the written statement filed by Defendant 1, in a standard fashion, denies nearly each and every allegation in the plaint, Mr.

Vidhani did not choose, during the course of arguments, to question the reputation or goodwill of the plaintiff in the market.

7.14 According to the assertions in the plaint, the plaintiff came to know, in September 2020, of products being sold by Defendant 1 and by several other unknown defendants on Flipkart. The unknown defendants were, therefore, were collectively impleaded in the suit under the appellation "Ashok kumar/John Doe" as Defendant 3. Of the various such water purifiers which were being sold on Flipkart and which stand tabulated in para 25 of the plaint, Defendant 1 is the manufacturer and seller of the water purifiers at S. Nos. 3, 6 and 10. However, as is correctly pointed out by Defendant 1, S. Nos 3, 6 and 10 are three images of the same purifier. The parties are, *ad idem*, agreed that the actual products of the plaintiff and the defendant look like this:

Plaintiff's Product	**Defendant's Product**
 FRONT VIEW	 FRONT VIEW

7.15 The plaintiff had also instituted CS (Comm) 1469/2016 ***(Kent***

RO Systems Ltd. & anr. v. Pushpender Yadav & ors.) before this Court, alleging infringement, by Defendant 1, of the suit design. The said suit was decreed by this Court *vide* the following judgment and decree dated 19th December 2017, as corrected *vide* order dated 6th March 2018:

> "1. On 11th July, 2017, learned counsel for defendant no.8 undertook to remove any alleged infringing listing within two days of being informed by the plaintiffs specifying the details of such listing or other data, link or communication. The defendant no.8 also undertook to disclose the names and address of the infringing parties, who had uploaded the infringing material on their websites. He had further stated that in the event the plaintiffs informed the defendants of any alleged illegal listing on their e-mail ID, namely, legal@paytmmall.com, requisite legal action would be taken within 48 hours.
>
> 2. Today learned counsel for defendant no.8 reiterates the said undertaking. Learned counsel for the plaintiffs has no objection if the suit is decreed against defendant No.8 in accordance with the said undertaking. Consequently, the undertaking given on 11th July, 2017 by defendant no.8 is accepted by this Court and defendant no.8 is held bound by the same.
>
> 3. Learned counsel for defendant no.2, on instructions, also states that the said defendant is agree to suffer a decree qua Design Nos. 219309, 224813, 252225. The statement made by learned counsel for defendant no. 2 is accepted by this Court and defendant no.2 is held bound by the same.
>
> 4. Registry is also directed to prepare a decree sheet in accordance with the said statements/undertakings given by learned counsel for defendant nos.2 and 8.
>
> 5. Report of the Registry states that while defendant No.5 has refused to accept summons, service report of defendant No.3 is awaited and defendant No.1 is unserved.
>
> 6. Today, learned counsel for plaintiffs has handed over three affidavits of service. In the affidavit of Mr. Virender Kumar, it is stated that defendants No.1, 3 and 5 have been sent summons by speed post as well as approved courier. The tracking reports have also been enclosed. In the affidavit of Mr. Hardikbhai Labhubhai Lakhani, it is stated that defendant in Gujarat i.e. defendant No. 3 has refused service. In the affidavit of Mr. Vijay Kumar Sharma, it is stated that defendant No.l has been served. The said affidavits of service are taken on record.

7. Since none appears for defendants No.1, 3, 4, 5, 6 & 7 despite service, they are proceeded ex parte.

8. Learned counsel for the plaintiffs states that in view of the judgment of this Court in *Satya Infrastructure Ltd. & Ors. Vs. Satya Infra & Estates Pvt. Ltd.*, the present suit should be decreed qua the relief of injunction against the defendants No.1 and 3 to 7. The relevant portion of the judgment in *Satya Infrastructure Ltd. & Ors.* (Supra) relied upon by learned counsel for the plaintiffs is reproduced hereinbelow:-

> "I am of the opinion that no purpose will be served in such cases by directing the plaintiffs to lead ex parte evidence in the form of affidavit by way of examination-in-chief and which invariably is a repetition of the contents of the plaint. The plaint otherwise, as per the amended CPC, besides being verified, is also supported by affidavits of the plaintiffs. I fail to fathom any reason for according any additional sanctity to the affidavit by way of examination-in-chief than to the affidavit in support of the plaint or to any exhibit marks being put on the documents which have been filed by the plaintiffs and are already on record. I have therefore heard the counsel for the plaintiffs on merits qua the relief of injunction."

9. Learned counsel for the plaintiffs further states that she has instructions not to press for any other relief other than the relief of permanent injunction, as prayed for in prayer 46 (c) of the plaint. The prayer 46 (c) of the plaint is reproduced hereinbelow:-

> "46 (c). A decree for permanent injunction restraining the defendant nos.1-7, their distributors, dealers, stockists, retailers, servants, agents and all others acting for and on their behalf from manufacturing, selling, importing, offering for sale, advertising and directly or indirectly dealing in any products that bear the mark AQUA GRAND+, AQUA PRIME, AQUA PEARL, AQUA SUPREME and/or any other mark which are identical or deceptively similar to the plaintiffs' trademarks KENT GRAND+, KENT PEARL, KENT SUPREME, KENT PRIME and variants thereof;

10. The relevant facts of the present case as culled out in the order dated 27th October, 2016 are that the present suit has been filed for permanent injunction restraining infringement of designs, passing off, damages, rendition of accounts, delivery up and other related reliefs.

11. The plaintiff No.1 company has been in the business of manufacturing and selling mineral RO water purifier systems since the year 1999, through its predecessors. The plaintiff No. l carries

out its business activities exclusively under the well known trademark/name KENT. Plaintiff no.2, who is a technocrat from !IT, Kanpur, has founded the firm 'Kent RO Systems ' in the year 1999 with the vision of providing pure and healthy drinking water to Indian homes at affordable price. Plaintiff no.2 has been granted a patent for 'house hold RO based drinking water purifier having controlled natural mineral contents in generated purified water'.

12. It is averred in the plaint that the plaintiffs' products offer unique multipurification process of RO+UF+UV, which removes even dissolved impurities apart from bacteria and viruses and its TDS controller retains the essential natural minerals in the purified water. The plaintiff has extracted in para 13 of the plaint details with regard to the trademark KENT registered in India in various classes. Besides, the plaintiffs have some other applications pending registration. The plaintiffs have also successfully obtained registrations with regard to trade name/mark KENT in other countries, details of which have been extracted in para 14 of the plaint. The products of the plaintiffs such as KENT PEARL, KENT PRIME, KENT GRAND+, KENT SUPREME, etc. have been used continuously, extensively and exclusively throughout India and abroad on a large scale and the products sold under the said mark have resultantly acquired a reputation of being extremely sound and reliable by virtue of adherence to strict quality standards maintained by the plaintiffs. The plaintiffs have made substantial investments in market research, development of new technology, advertising and promotion of its unique and patented mineral water purifier under the trademark KENT. The plaintiffs have extracted details with regard to annual sales and amounts incurred in advertisement at para 19 of the plaint. The plaintiffs have also extracted the details with regards to accolades and the awards they have achieved.

13. Learned counsel for the plaintiffs submits that defendants No. 1 and 3 to 7 are traders and manufacturers of water purifier systems, whose shape, look and appearance are deceptively similar to the water purifiers of the plaintiffs. The said defendants sell their products, especially water purifiers to various customers across India through the website of defendant no. 8. Learned counsel for plaintiffs contends that defendants No. 1 and 3 to 7 are manufacturing and selling an identical product under the mark AQUA GRAND+ or AQUA GRAND. Similarly, the products KENT PEARL, KENT PRIME and KENT SUPREME are being sold as AQUA PEARL, AQUA PRIME AND AQUA SUPREME. Screenshots of some such infringing purifiers being advertised through defendant's No.8 website have been filed along with the plaint. The combination of the deceptively similar marks with identical look and feel of the products add to the confusion and leads to deception of the consumers. Learned counsel for plaintiffs has also drawn the attention of the Court to the comparison of the products of the plaintiff and the products of the defendant nos. 1

and 3 to 7, which have been filed along with the list of documents. Learned counsel for plaintiffs contends that the said defendants ' inaction and enabling sale of infringing products amounts to infringement of the plaintiffs' registered designs under the Designs Act, 2000.

14. It is contended by counsel for the plaintiffs that the goods being sold by defendants are inferior in quality and with the intent to ride upon the goodwill and reputation of the plaintiff to derive unfair gain. Learned counsel for plaintiffs also contends that the public at large is likely to be mislead that the goods being sold by the said defendants originates from the house of the plaintiffs.

15. On 27th October, 2016, this Court had restrained the defendants, their distributors, dealers, stockists, retailers, servants, agents and all others acting on their behalf from manufacturing, selling, importing, offering for sale, advertising and directly or indirectly dealing in any products:

i. That infringe the plaintiffs ' registered design nos.219309, 224813, 252225, 262661 and 220727;

ii. that bear the mark AQUA GRAND+, AQUA PRIME, AQUA PEARL, AQUA SUPREME and/or any other mark which are identical or deceptively similar to the plaintiffs' trademarks KENT GRAND+, KENT PEARL, KENT SUPREME, KENT PRIME and variants thereof;

16. In view of the averments made in the plaint, which remain uncontroverted, this Court is of the view that the plaintiffs are entitled to the judgment in terms of the relief claimed for in prayer 46 (c) of the plaint against defendant nos. 1 and 3 to 7. However, since the plaintiffs have not established the quantum of damages, no relief in this regard can be granted. As noted above, the learned counsel for the plaintiffs has also not pressed for the said relief.

17. In view of the above, the suit is decreed in favour of the plaintiffs and against the defendants No. 1 and 3 to 7 in terms of prayer clause 46 (c) of the plaint along with the actual costs. The plaintiffs are given liberty to file on record the exact cost incurred by them in adjudication of the present suit. Registry is directed to prepare a decree sheet accordingly. Consequently, the present suit and pending application stand disposed of."

7.16 According to the plaintiff, despite the aforesaid judgement dated 6th March 2018, Defendant 1 continues to sell water purifiers, bearing the impugned design, which infringes the suit design, under

the AQUA GRAND mark, in clear violation of the directions issued by this Court. It is alleged that Defendant 1 is now selling and advertising the infringing goods through a new firm M/s Earth RO Systems, with a new website www.earthrosystem.com and that the sales are effected across the platform of Defendant 2. The impugned design of the water purifiers sold by Defendant 2 are, it is alleged, obvious imitations of the suit design.

7.17 The plaintiff has provided the following comparison of the suit design, the KENT GRAND+ product of the plaintiff, the product of Defendant 1 which was impugned in CS (Comm) 1469/2016 and the product of the defendant impugned in the present case, thus:

Suit Design	**Plaintiff's Kent Grand+ Water Purifier**	**Impugned product in CS (Comm) 1469/2016**	**Impugned product in the present case**
			

7.18 It is in these circumstances that the plaintiff has approached the Court by means of the present suit, seeking a permanent injunction against the defendant dealing in water purifiers bearing the impugned design or any design imitative of the suit Design No. 219309. Further, an injunction has also been sought against the defendant using the mark AQUA GRAND+, AQUA GRAND or any other similar mark which would infringe the plaintiff's KENT GRAND+ mark.

8. Relevant orders passed in the present case

8.1 On 16th July 2021, this Court recorded the submission of Ms. Rajeshwari H., learned Counsel for the plaintiff, that, for the present, the plaintiff was restricting its claim to the aspect of design infringement, and was not pressing its claim of trade mark infringement. It was submitted by Ms. Rajeshwari, on the said date, that the finding of infringement, returned by this Court in its order dated 19th December 2017 as corrected on 6th March 2018 would apply *mutatis mutandis* to the design at Serial No. 3 of the table in para 25 of the plaint. The Court, therefore, queried of learned Counsel for the defendant in this regard, to which the response of learned Counsel was that, though he was not in a position to confirm that the design reflected at Serial No. 3 of the table in para 25 of the plaint was the design of the water purifier manufactured and sold by his client, the following photograph provided, by the plaintiff at page 321 of the documents filed with the plaint, was of the water purifier manufactured and sold by Defendant 1:

8.2 Subsequently, in compliance with the directions contained in the order dated 16th July 2021, Defendant 1 filed an affidavit dated 20th July 2021 under cover of which the following tabular statement was provided as Annexure D-1, in an attempt to indicate that the defendant's product was different in design to that of the plaintiff and that the design of the defendant's product could not, therefore be said

to be an obvious or fraudulent imitation of the suit design within the meaning of Section 22 of the Designs Act:

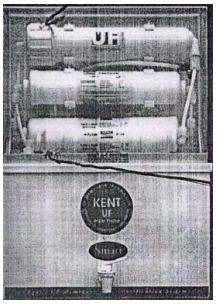
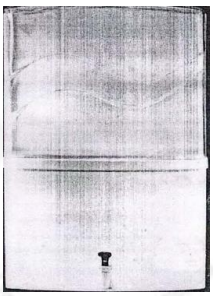
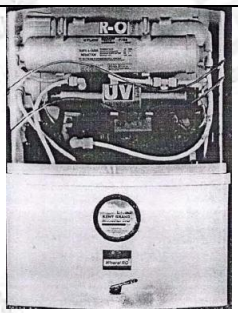
View	Suit Design and Plaintiff's Kent Grand + Product	Defendant's Aquagrand Product
Front and Perspective		
Side	 SIDE VIEW	 SIDE VIEW
Top	 TOP VIEW	 TOP VIEW
Bottom	 BOTTOM VIEW	 BOTTOM VIEW
Back	 BACK VIEW	 BACK VIEW

9. Written statement by Defendant 1

9.1 Defendant 1 had subsequently filed a written statement by way of response to the suit. In the written statement, Defendant 1 has questioned the *locus standi* of Plaintiff 1 to maintain the present suit. The suit design, it has been sought to be pointed out, was registered in favour of Plaintiff 2 and there is no license agreement on record, whereby the said registration has been licensed by Plaintiff 2 to Plaintiff 1.

9.2 The written statement further avers that, in the First Examination Report (FER) dated 3rd February 2009, objecting to Application No. 219309 filed by the plaintiff for registration of the suit design, the Controller of Designs had alleged that the proposed design was bad for want of novelty and that, in its response thereto, the plaintiff had restricted its claim to novelty to the features indicated at 'A' and 'B' in the certificate of design registration. These facts, it is alleged, have been concealed in the plaint. Having thus restricted its claim to novelty to the features at 'A' and 'B' in the design registration, Defendant 1 alleges that the plaintiff cannot seek, in the present suit, to claim novelty in respect of any other feature of the suit design.

9.3 It is further alleged, in the written statement, that the suit design is bad on account of prior publication of the design even by the plaintiff itself. The suit design, it is alleged, is an obvious imitation of the plaintiff's prior Design Nos. 198530, 200427, and 204308. The front views of the said Designs, as registered by the Controller of Designs, are as under:

Design No.	Front View
198530	
200427	
204308	

The same design, it is further alleged, was registered, earlier, in favour of Ranjit Singh, Super Engineering Works as Design 207629 dated 11th December 2006, the front view of which was as under:

Though the said registration was subsequently cancelled, consequent on a cancellation petition filed by Plaintiff 2, the written statement submits that, nonetheless, at the time when the plaintiff applied for

registration of the suit design, the application of Ranjeet Singh was already pending. Features 'A' and 'B', which were, even as per the certificate of registration of the suit design, the novel features of the suit design, are, it is alleged, visible even in Design no. 207629 of the plaintiff as well as in advertisements released by the plaintiff in newspapers, since 2007. It is further alleged, in this context, that, in cross examination conducted in CS(OS) 1574/2007 ***(Kent RO v. Ranjit Singh)***, Plaintiff 2 admitted prior publication of the suit design in 2002-03. As such, it is submitted that the present plaint is merely an attempt at ever greening design 200427 dated 26th July 2005, 204308 dated 23rd May 2006 and 207629 dated 12th December 2006, of the plaintiff itself.

9.4 The written statement further alleges that the suit design 219309 had been granted for ten years on 17th October 2008 and has, therefore, expired by efflux of time. It is pointed out that the plaint does not assert, at any point, that the suit design was subsequently revalidated. As the suit design stands expired, it is submitted in the written statement that there can be no case of infringement against the defendants.

9.5 Yet another objection to the present plaint is raised on the ground that an injunction already stands granted in favour of the plaintiff and against the defendants by this Court on 19th December 2017, as corrected on 6th March 2018, and that, therefore, the present suit is not maintainable, as the same relief is being sought all over again. The written statement seeks to point out, in this context, that the allegation in CS (Comm) 1469/2016 was also that the impugned design of Defendant 1 was identical to the suit design. The very same

allegation, it is pointed out, is contained in the present plaint. There cannot, submits Defendant 1, be two designs, which are identical to the suit design. Once an injunction already stands granted against a design which is identical to the suit design, the written statement seeks to submit that a second injunction cannot be sought by a separate suit for yet another design which is also stated to be identical to the suit design.

9.6 The written statement further denies the allegation of similarity between the suit design and the impugned design. It is submitted that there are several features between the two designs, which are different. For this purpose, the following tabular statement has been provided by the defendant:

PLAINTIFFS' DESIGN	**DEFENDANT'S DESIGN**
 **FRONT VIEW**	 **FRONT VIEW**
1. Sharp edges; 2. No ripple effect; 3. No inverted U shape; 4. Transparent top having wave pattern.	1. Tapered Left edge and top edge; 2. Ripple effect on right edge top to bottom; 3. Inverted U shape surrounding tap hole impressed at the center bottom; 4. Plain front wall without any wave pattern on the transparent

5. Straight design pattern at the juncture of transparent and opaque portion at the middle portion of the article.	top. 5. Unique design pattern at the juncture of transparent and opaque portion at the front middle of the article with wider right strip present over the rippled portion and uniformly narrowing down and running into a uniform flat strip towards left side and again widening (less than the width at right side) near left side.
 LEFT SIDE VIEW 6. Same width at top and bottom; 7. No curve;	 LEFT SIDE VIEW 6. Left wall having wider top and narrow bottom. 7. Left wall having concave curve.
 TOP VIEW 8. No ripple effect	 TOP VIEW 8. Front edge of top wall having curved front side with ripple at right end.
 BOTTOM VIEW	 BOTTOM VIEW

9. No cut and no ripple effect; 10. No cut at the central portion of front wall;	9. Front edge having a cut on the right wall and ripple effect on the left wall. 10. Cut portion at central portion of the front wall.
 RIGHT SIDE VIEW 11. Same width at top and bottom; 12. Bottom is rectangular in shape. 13. Falsely claiming the patent under No. 199716which was lapsed on 23 Nov, 2007.	 RIGHT SIDE VIEW 11. Top is wider than the bottom; 12. Bottom is trapezium in shape.

9.7 The plaint further alleges that the alleged novel features of the suit design, i.e., a transparent upper half and opaque lower half and a wave design on the opaque surface of the cabinet are all present in the prior designs 198527, 198528 and 198529. Nor, submits the written statement, can any novelty be said to vest in the trapezoid shape of the suit design or in the water indicator at the lower left of the opaque lower half of the suit design.

9.8 Detailed written submissions have also been filed by both sides.

Plaintiffs' written submissions

10. Written submissions dated 17th August 2021

10.1 The plaintiffs, in their written submissions, contend, relying on ***Castrol India Ltd v. Tide Water Oil Co. (I) Ltd***[1]***, Dabur India Ltd. v. Amit Jain***[2] and the judgment of this Court in ***Veeplast Houseware Private Ltd. v. M/s Bonjour International & Anr***[3]**,** that exact identity between the design of the defendants' product and the suit design was not necessary to make out a case of design piracy, and that substantial similarity of broad features of shape, configuration, pattern etc. was sufficient. What has to be seen, it is submitted, is whether the defendants' product as a whole is similar to the registered design of the plaintiffs, for which purpose the plaintiff places reliance on ***Alert India v. Naveen Plastic***[4] and ***Preethi Kitchen v. Bhagyaa Appliances***[5]**.**

10.2 The plaintiff contends that, *de hors* the aspect of infringement, the defendants are clearly passing off their products as that of the plaintiffs. The similarity in shapes of the defendants and the plaintiffs' water purifiers, coupled with the fact that the defendants are using the mark as AQUA GRAND/ 

, which is deceptively similar to the KENT GRAND+ mark are, it is submitted, sufficient to confuse the customer into believing the defendants products to be that of the plaintiffs. The allegation of passing off is further strengthened by the fact that the defendants are marketing the impugned product as

[1] **(1996) 16 PTC 202**
[2] **2009 (107) DRJ 17 (DB)**
[3] **Judgment dated 2nd June 2011 in CS(OS) No. 1181/2011**
[4] **1996 SCC OnLine Del 710**
[5] **2018 SCC OnLine Mad 637**

"KENT type" cabinets. For this purpose, the plaintiffs rely on ***Faber-Castell Aktiengesellschaft v. Cello Pens Pvt. Ltd.***[6] and ***Gorbatschow Wodka KG v. John Distilleries Ltd***[7]**.**

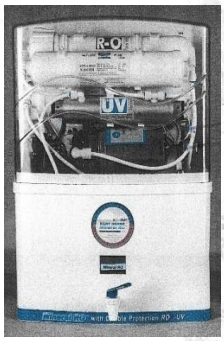
10.3 The plaintiffs also dispute the defendants' contention that the plaintiffs are entitled only to protection in respect of features 'A' and 'B' in the suit design, having claimed novelty in respect of the said features. The statement of novelty tendered with the application seeking registration of a design, it is submitted, is merely an indicator regarding the portion of the design to which greater weightage is to be given. It does not operate as a deemed disclaimer for the rest of the design. Section 2(d) of the Designs Act read with the disclaimer in the certificate of registration of the suit design disentitles the plaintiffs to claim any design registration in respect of the internal parts of the product. Even while accepting that novelty resided in 'A' and 'B' which represented the curved upper edge and the bulging "pot belly" like middle, the plaintiff contends that it was entitled to protection of the shape and configuration of the entire water purifier, as the design registration was for the entire product.

10.4 The plaintiffs also dispute the defendants' contention that the suit design is liable to be invalidated on the ground of prior publication. It is submitted that, for a plea of vulnerability to invalidity on the ground of prior publication to succeed, the defendants have to show that the suit design itself has been published prior to its registration, as was held in ***Vikas Jain v. Aftab Ahmed***[8].

[6] **2015 SCC OnLine Bom 6410**
[7] **2011(4) Mh. L.J**
[8] **2008 (37) PTC 288 (Del)**

10.5 Applying this test, the plea of invalidity of the suit design *vis-à-vis* prior art, as urged by the defendants, cannot, in the plaintiffs' submission, succeed. The plaintiffs have advanced submissions with respect to each of the prior art designs on which the defendants have placed reliance thus:

(i) Design No. 200427 pertained to the earlier KENT GRAND model of the plaintiffs, whereas the model relating to the suit design is KENT GRAND+. The plaintiffs have sought to demonstrate the difference between the Design No. 200427 and the suit design thus:

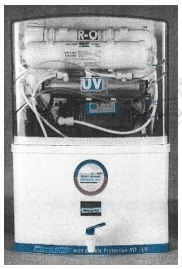
Kent Grand (Design No. 200427)	**Suit Design (Kent Grand +)**
	

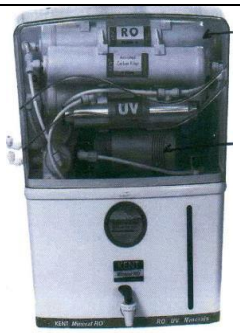
Design No. 200427 of the plaintiffs' earlier KENT GRAND model is, it is submitted, different from the suit design as (a) the KENT GRAND model has no water indicator, (b) the front portion of the KENT GRAND model is flat, rather than bulging, (c) the top of the KENT GRAND model does not have a substantial droop unlike the suit design and (d) the KENT GRAND model is square in shape, whereas the suit design is trapezoid.

(ii) Apropos Design No. 207629 granted to Ranjit Singh, the

plaintiffs submit that the said design registration was cancelled and that, as the cancellation dates back to the time of registration, the registration is non-existent *ab initio*. Even otherwise, on merits, the cancellation of Design 207629 was owing to similarity with the plaintiffs' Design 200427. Inasmuch as plaintiffs' Design 200427 had itself been shown to be dissimilar to the suit design, no reliance could be placed by the defendants on Design 207629 granted to Ranjit Singh.

(iii) Apropos Designs 207629, 204308 and 260986, the plaintiffs have sought to identify the differences between the said designs and the suit design in the following tabular fashion:

<table>
<tr><td>"Design 207629
  </td><td rowspan="2">Suit Design (219309)
  </td></tr>
<tr><td>Design 204308
  </td></tr>
<tr><td colspan="2">Design No. 207629 and Design No. 204308 have broad top, flat front, and broadly same appearance; Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom.</td></tr>
<tr><td>Design 260986</td><td></td></tr>
</table>

	
Design 260986 has opaque top and bottom, concave insert at the top; Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom."	

10.6 The plaintiffs also dispute the defendants' contention that, during the course of recording of evidence in CS (Comm) 881/2016, the plaintiffs had admitted that the suit design had been prior published. No such unequivocal admission, it is submitted, is forthcoming from the record of the said suit.

10.7 The orders passed in CS (Comm) 1469/2019, according to the plaintiffs, does not affect the maintainability of the present suit. The disputed product in CS (Comm) 1469/2019, it is submitted, is different from the defendants' product in the present case, as is apparent from the following tabular representation:

Design No. 219309 (suit design)	**Disputed product of Defendant in CS (Comm) No. 1469/2019**	**Disputed product of defendants in present case**
		

10.8 The plaintiffs also contend that, having been injuncted, by a final decree, against use of the mark AQUA GRAND+, the defendants could not now use the mark AQUA GRAND.

11. Written submissions dated 20th September 2021

11.1 The subsequent submissions dated 20th September 2021 tendered by the plaintiffs substantially reiterate the submissions contained in the plaint as well as the earlier tendered on 17th August 2021. The following additional submissions have, however, been made:

(i) The plea of invalidity of the suit design on account of prior publication has to meet the standards of "Oh I have seen this before", as exposited by this Court in its judgment in ***Dart Industries Inc. v. Techno Plast***[9]. That standard has not been met in the present case.

(ii) The brochures, on which the defendants place reliance are undated, and their origin is unknown. They cannot be relied upon as held in ***Hindustan Sanitaryware and Industries Ltd. v/s Dip Crafts Industries***[10]**.**

(iii) For a plea of prior publication to succeed, the defendants have to show that the entire suit design was published earlier in point of time. The mere prior publication of parts of the suit

[9] **2007 (35) PTC 285 Del**
[10] **2003 (26) PTC 163 (Del)**

design does not constitute prior publication within the meaning of Section 19(1)(b)[11] or Section 4[12] of the Designs Act.

(iv) The defendants have attempted to mosaic individual features of prior art designs to create a design which is similar to the suit design. Mosaicing of prior art is not permissible under the Designs Act as held in ***Cello Household Products v. Modware India***[13]**.** Unlike Section 2(1) (ja)[14] of the Patents Act, 1970, the definition of "design" in the Designs Act does not provide for splitting of the design into its parts. For this proposition, the plaintiff relies on the judgement of the High Court of Bombay in paras 15 and 16 of ***Videocon Industries Ltd v. Whirlpool of India Ltd***[15] which hold, *inter alia*, that the reference to "part" of a design in clauses (a) and (d) of Section 2 of the Designs Act refers to parts which are capable of being made and sold separately as independent articles.

12. Written submissions of Defendant 1

[11] **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.

[12] **4. Prohibition of registration of certain designs. –** A design which –
(a) is not new or original; or
(b) has been disclosed to the public any where in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or
(c) is not significantly distinguishable from known designs or combination of known designs; or
(d) comprises or contains scandalous or obscene matter,
shall not be registered.

[13] **(2017) 70 PTC 325 (Bom)**

[14] **2. Definitions and interpretation.—(**1) In this Act, unless the context otherwise requires,—
(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;

[15] **2012 (6) Bom CR 178**

12.1 Defendant 1, in his written submissions, dated 17th September 2021, contends thus:

(i) The suit design had lapsed on account of invalidity on 16th October 2018. There was no proof of renewal of the suit design. Though learned Counsel for the plaintiffs had, during arguments, produced a request for renewal of the suit design in Form 3 with a cash receipt, the said documents had been filed with IA 10824/2021, praying that the documents be taken on record. The said IA was still pending and had not been allowed. As such, there was no document indicating that the suit design had been renewed or that any valid request for renewal had been made by the plaintiffs.

(ii) The suit design was liable to be cancelled under Section 4(c) read with Section 19 of the Designs Act for want of novelty, as

(a) the wave design on the opaque portion of the suit design was also present in Design 198527 dated 16th February 2005,

(b) Design 198530 dated 16th February 2005 also contained a transparent upper and an opaque lower half, and was even otherwise substantially similar to the suit design,

(c) Design 200427 dated 26th July 2005 contained a transparent upper half, an opaque lower half, a curved top and a bulging mid section and was substantially similar to the suit design,

(d) Design 204308 dated 23rd May 2006 also contained a transparent upper half, an opaque lower half, waves on the opaque portion and a curved portion, and was substantially similar to the suit design.

(e) Design 207629 dated 12th December 2005 also had a transparent and upper and an opaque lower half, waves on the opaque portion, a curved top and a bulging mid section and was substantially similar to the suit design and

(f) Design 194743 dated 3rd March 2004 and 199214 dated 21st April 2005 contain a transparent upper and an opaque lower half.

(iii) The suit design was invalid on the ground of prior publication in the following forms:

(a) articles in newspapers at pages 52 to 56 of the defendants' documents,

(b) the record of cross-examination of PW-1 in CS (OS) 1574/2007 (***Kent RO Systems v. Ranjit Singh & ors***) to the effect that the suit design had been earlier published in 2002-2003,

(c) the sales figures for the suit design, provided since 2002-2003,

(d) brochures of various parties at pages 85 to 123 of the defendants' documents and

(e) admission, in CS(Comm) 762/2018, that the feature of the water indicator on the opaque portion of the suit design had earlier been published.

In such circumstances, the suit design was invalid on the ground

of prior publication, as held by this Court in ***Crocs Inc. USA v. Liberty Shoes Ltd.***[16]***, Glaxo Smithkline Consumer Healthcare GmbH and Co. Kg v. Anchor Health and Beautycare Private Limited***[17] and ***National Trading Co. v. Monica Chawla***[18].

(iv) During the course of examination of the plaintiffs' application for registration of the suit design, novelty had been claimed by the plaintiffs only in respect of the features 'A' and 'B'. The examination report, and the response of the plaintiffs thereto, have been held to be relevant by this Court in ***S.K. Sachdeva v. Shri Educare Ltd***[19]***, Mankind Pharma Ltd v. Chandra Mani Tiwari***[20] and ***Poly Medicure Limited v. Polybond India Pvt Ltd***[21]. As held in ***Vega Auto Accessories (P) LTD. v. S.K. Jain Bros. Helmet (I) Pvt. Ltd***[22] and ***Mohan Lal v. Sona Paint & Hardwares***[23], the existence of a registration certificate did not amount to *prima facie* validity of the design. The validity of the design could be challenged even at the stage of grant of interim injunction.

(v) There was no document on record evidencing grant of license by Plaintiff 2 to Plaintiff 1 with respect to ownership and use of the suit design. Even if any such license had been issued, it was not registered with the Controller of Designs as required by Section 30(3)[24] of the Designs Act and could not,

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[16] 247 (2018) DLT624 : (2018) 73 PTC 425(Del) : MANU/DE/0615/2018
[17] (2004) 29 PTC 72(Del) : MANU/DE/0533/2004
[18] (1994) 14 PTC 233(Del) : MANU/DE/0642/1994
[19] (2016) 65 PTC 614(Del) : MANU/DE/0182/2016
[20] 253 (2018) DLT 39, (2018) 75 PTC 8(Del) : MANU/DE/2363/2018
[21] MANU/DE/3395/2019
[22] (2018) 75 PTC 59(Del) : MANU/DE/2136/2018
[23] 200 (2013) DLT 322 : MANU/DE/1254/2013
[24] 30. Entry of assignment and transmissions in registers. –
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therefore, be admitted in evidence in view of Section 30(5). Besides, by analyzing with Section 53 of the Trade Marks Act 1999, licensee could not sue for infringement of a design. Reliance was placed, in this context, ***P.K. Sen v. Exxon Mobile Corporation***[25]**.**

(vi) There was no allegation in the plaint, of passing off, by the defendants, of the plaintiffs' trade mark. In any event, requisite ingredients for passing off had not been established in the present case. No goodwill in the plaintiff's trade mark or design was challenged or proved. No invoices have been filed. The turnover, as placed on record, was only from 2017-2018.

(vii) The trade marks of the plaintiffs and the defendants were different. The plaintiffs' trade mark was KENT GRAND+, whereas the defendants' trade mark is AG AQUA GRAND.

Oral Submissions

13. Learned Counsel reiterated, during oral arguments, the submissions which were, during hearing and after reserving of orders, provided in writing. The further submissions advanced orally before the Court, by learned Counsel, may be noted thus.

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(3) For the purposes of sub-section (1) or sub-section (2), an assignment of a design or of a share in a design, a mortgage, licence or the creation of any other interest in a design shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of an instrument embodying all the terms and conditions governing their rights and obligation and the application for registration of title under such instrument is filed in the prescribed manner with the Controller within six months from the execution of the instrument or within such further period not exceeding six months in the aggregate as the Controller on the application made in the prescribed manner allows:

Provided that the instrument shall, on entry of its particulars in the register under sub-section (1) or sub-section (2), have the effect from the date of its execution.

[25] **MANU/DE/0016/2017**

14. Submissions of Ms. Rajeshwari H, on behalf of the plaintiff

14.1 Ms. Rajeshwari submits that the design of the impugned product of the defendants violates the directions contained in the judgment and decree, dated 19th December 2017 read with order dated 6th March 2018 of this Court in CS (Comm) 1469/2016. She has invited my attention to para 28 of the plaint in CS (Comm) 1469/2016, which reads thus:

> "28. That, recently, in September, 2016, the Plaintiff was informed by its field forces that several entities are selling water purifiers that are identical in shape to the purifiers of the Plaintiff. The Plaintiff also learnt that these manufacturers/traders are manufacturing cabinets and/or finished purifiers and extensively advertising the same using the website of Defendant No. 8 herein as a medium. It is submitted that sale of such water purifiers amounts to infringement of the Plaintiff's rights under the Designs Act, 2000. As an example, is the product called KENT GRAND + which has a unique shape with a transparent top with waves and bottom is opaque. The Plaintiff has been granted Design No. 219309 in respect of the shape of this product and has the exclusive right to manufacture and sell purifiers bearing the said shape. However, entities such as Defendant No. 1-7 are manufacturing and selling an identical product under the mark AQUA GRAND + or AQUA GRAND."

Ms. Rajeshwari has also referred me to the screenshots accompanying the above recital in para 28 of the plaint in CS (Comm) 1469/2016. However, the screenshots are so dim and unintelligible that nothing substantial can be made out therefrom. Ms. Rajeshwari, however, submits that, in its judgment dated 19th December 2017 read with order dated 6th March 2018, this Court had clearly injuncted the defendants from making or using any design which was deceptively similar to, or infringed, the suit design. The presently impugned product of the defendants, she submits, also infringes the suit design and, therefore, violates the directions contained in the judgment of this Court in CS (Comm) 1469/2016.

14.2 Ms. Rajeshwari has relied on the definition of design piracy, contained in Section 22(1)[26] of the Designs Act, which includes any "obvious imitation" or "fraudulent imitation" of the suit design.

15. Submissions of Mr. Neeraj Grover and Mr. Mohan Vidhani, for defendants

15.1 Oral arguments, on behalf of the defendants, were initially advanced by Mr. Neeraj Grover, and later by Mr. Mohan Vidhani.

15.2 Mr. Grover disputed Ms. Rajeshwari's submission that the impugned product in CS (Comm) 1469/2016 was in any manner similar to that in the present case. He further submits that novelty having been claimed, by the plaintiff, in respect of the features at 'A' and 'B' in the design registration of the suit design, the plaintiff had to restrict the scope of the protection, to which it was entitled, to the said features.

15.3 Apropos the contention that the suit design had lapsed and that there was no evidence of it having been restored thereafter, Mr Vidhani relied on Sections 11 to 14[27] of the Designs Act. He submits

[26] **22. Piracy of registered design**. –
(1) During the existence of copyright in any design it shall not be lawful for any person –
(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

[27] **11. Copyright on registration**. –
(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

that, in fact, in the light of Section 14(2), the present suit was itself not maintainable on the date when it was instituted.

15.4 Mr. Vidhani has again stressed the aspect of want of novelty in the suit design, especially *vis-à-vis* prior art. In this context, he submits that, in the FER following the submission of application by the plaintiff for registration of the suit design, the Controller had required the plaintiff to amend the application and pinpoint any novel feature in the design, whereupon the plaintiff, in its amended application, confined novel to features 'A' and 'B'. Mr. Vidhani submits that there was, in fact, no novelty in features 'A' and 'B' and that the claim to novelty, of the plaintiff, was just an eyewash. The invalidity of the registration granted to the plaintiff in respect of the suit design, submits Mr. Vidhani, constitutes a valid ground of

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(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.

12. Restoration of lapsed designs. –

(1) Where a design has ceased to have effect by reason of failure to pay the fee for the extension of copyright under sub-section (2) of Section 11, the proprietor of such design or his legal representative and where the design was held by two or more persons jointly, then, with the leave of the Controller one or more of them without joining the others, may, within one year from the date on which the design ceased to have effect, make an application for the restoration of the design in the prescribed manner on payment of such fee as may be prescribed.

(2) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

13. Procedure for disposal of applications for restoration of lapsed designs. –

(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is satisfied that the failure to pay the fee for extension of the period of copyright was unintentional and that there has been no undue delay in the making of the application, the Controller shall upon payment of any unpaid fee for extension of the period of copyright together with prescribed additional fee restore the registration of design.

(2) The Controller may, if he thinks fit as a condition of restoring the design, require that any entry shall be made in the register of any document or matter which under the provisions of this Act, has to be entered in the register but which has not been so entered.

14. Rights of proprietor of lapsed design which have been restored. –

(1) Where the registration of a design is restored, the rights of the registered proprietor shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the benefit of applying the design between the date when the registration of the design ceased to have effect and the date of restoration of the registration of the design.

(2) No suit or other proceeding shall be commenced in respect of piracy of a registered design or infringement of the copyright in such design committed between the date on which the registration of the design ceased to have effect and the date of the restoration of the design.

defense against the allegation of design piracy, under Section 22(3)[28] of the Designs Act.

15.5 Mr. Vidhani has drawn attention to the claim to novelty of the suit design, as contained in para 10 of the plaint, thus:

> "10. That the KENT GRAND+ (protected by Design No. 219309) has unique design with eye-catching look with transparent top and opaque bottom where topmost part is slightly curvy and waves are embossed on the front part. The product has overall trapeze shape with a water indicator uniquely positioned on the left hand side of the bottom water tank."

In conjunction, Mr. Vidhani has also referred to para 19 of the rejoinder filed by the plaintiff in the present application, in which it is averred thus:

> "That the content of paragraph no. 5 are denied and disputed. It is denied that the Plaintiff is not entitled for relief as the comparison is shown from only one view. It is submitted that the Defendant No. 1 is completely misguided in stating that a Three dimensional (3-D) product is to be compared from all possible views. It is submitted that any design for the purpose of infringement is to be seen from the perspective of reasonable consumer. To a reasonable consumer is the front portion which is prominent and discernable. Also, water purifiers are installed in a way that the back side of the product is bolted on the wall, making it impossible for a reasonable person to look at the product in any manner other than to see its front portion. Due to this, the front portion becomes the sole and main source of visualization of the product for the consumer."

Referring, in the process, to clauses (a), (b) and (c) of Section 4 of the Designs Act, Mr. Vidhani has referred to the following photograph of the cabinet of the impugned product of the defendant (as filed with the list of documents dated 9th August 2021) to contend that it cannot be regarded as an imitation of the plaintiff's design:

[28] **22. Piracy of registered design**. –

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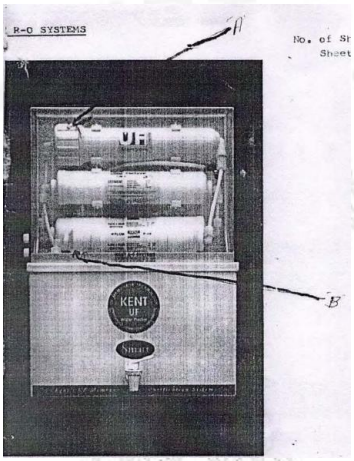
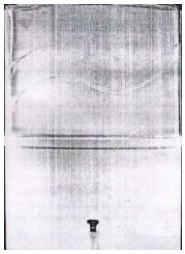
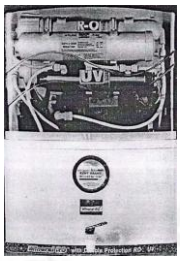
(3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence.

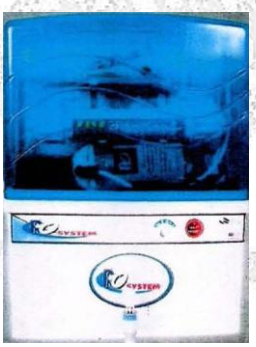
15.6 Mr. Vidhani has also referred to Registration No. 198530 dated 16th February 2005 issued by the Patent Office to the plaintiff for the following Water Purifier:



In this registration, too, the Certificate of Registration certifies novelty to be residing "in the shape and configuration of the water purifier and particularly at the portions marked A and B as illustrated". Thus, submits Mr. Vidhani, the transparent upper and opaque lower half are consistent features of all water purifiers. He has also referred, in this context, to the following design registrations granted to the plaintiff for water purifiers:

Regn No.	Date of registration	Design
200427	26th July 2005	
204308	23rd May 2006	

15.7 M/s Super Engineering Works was granted design registration of the following design for a Water Purifier, w.e.f. 11th December 2006:

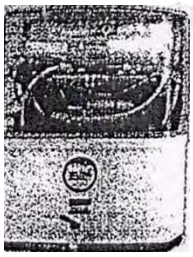


Mr. Vidhani submits that the above design has the same shape, configuration and a curved top, as has the suit design. He also relies on the following design registrations as having a transparent upper and a white opaque lower half:

Regn. No.	Date of Registration	Registrant	Design
194743	3rd March 2004	Eureka Forbes Ltd	

			
199214	21st April 2005	Eureka Forbes	

15.8 Mr. Vidhani also submits that the suit design is bad on account of prior publication, for which purpose he has relied on advertisements contained in the 2nd September 2006 issue of the Times of India (TOI) Ahmedabad and the 17th November 2006 issue of the Vijay Times. The advertisements, as filed by the defendant are, however, so blurred and indistinct that it is impossible to accept the submission that the water purifiers advertised therein are, in fact, bearing the suit design. The depictions of the advertised water purifiers are as under:

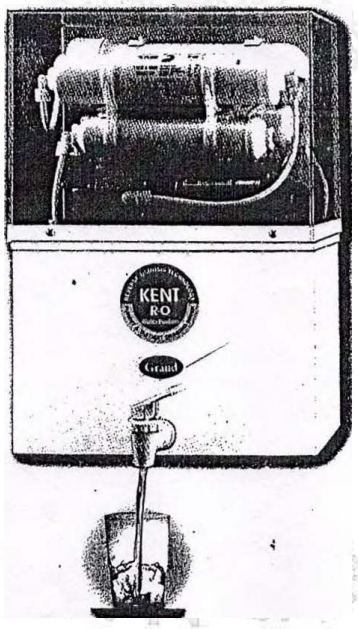


TOI dated 2nd September 2006

Vijay Times dated 27th July 2006

Mr. Vidhani also relies on the photographs of the plaintiff's water purifiers, as advertised by the plaintiff, which show Hema Malini promoting the following Kent water purifier:

15.9 Mr. Vidhani has also relied on the following picture of the water purifier, which was exhibited as Ex PW-1/5 in CS (OS) 1574/2007 (***Kent RO Systems v. Ranjit Singh & ors***):



Mr. Vidhani has also placed reliance, in this regard, on the following deposition in the record of cross-examination of Mahesh Gupta, Plaintiff 2, as PW-1 in CS (OS) 1574/2007:

> "Ex PW-1/5 is brochure for 'Kent Grand' and it is wrongly exhibited.
>
> Ex PW 1/5 does not contain any date. It was circulated in the year 2002 or 2003. Brochures are circulated in at least thousands."

Predicated on the above, Mr. Vidhani contends that the suit design was in circulation and, therefore, published, as far as back in 2002 or 2003.

15.10 Mr. Vidhani also relies on para 19 of the plaint in CS (OS) 1469/2016 (***Kent RO Systems Ltd v. Pushpendra Yadav***), the earlier suit between the parties in the present case, which provided year-wise sales figures of the plaintiff, for the years 2001-2002 till 2014-2015, "in respect of its products bearing the trademarks KENT PEARL, KENT GRAND +, KENT PRIME and KENT SUPREME and other variants of the Plaintiff's KENT RO purifiers". Thus, contends Mr. Vidhani the plaintiff had, in the said paragraph, admitted that KENT GRAND + water purifiers were being sold by it since 2001-2002, thereby making out a case of prior publication and want of novelty.

15.11 Mr. Vidhani also relies on para 13 of the plaint in CS (Comm) 762/2018 (***Mahesh Gupta v. Chetan Tapadia***), filed by Plaintiff 2 before the learned Trial Court, in which it is averred that "since 1988, the Plaintiff's products including products KENT SUPREME, KENT WONDER, KENT ACE and KENT SUPERB has become a trendsetting product due to its unique design, unmatched and remarkable quality coupled with high efficiency and cost effectiveness." This, according to Mr. Vidhani, amounts to admission, by the plaintiff, that water purifiers, having designs similar to the suit design, were being manufactured from as far back as 1988.

15.12 Mr. Vidhani contends that, as these designs are not significantly different from the suit design, the suit design could not have been

registered in view of the proscription contained in Section 4(c) of the Designs Act. In this context, Mr. Vidhani submits that the plaintiff cannot even claim the benefit of Section 6(3)[29] of the Designs Act, in view of the proviso thereto.

15.13 Mr. Vidhani has also questioned the *locus standi* of Plaintiff 1, on the ground that the licence, whereunder Plaintiff 2 had assigned rights in respect of the suit design to Plaintiff 1 has not been placed on record. He submits that though, after the rejoinder was filed, certain additional documents were brought on record by the plaintiffs, these, too, contain merely a deed of confirmation of the licence, dated 1st April, 2019, without placing the licence on record. Moreover, submits Mr. Vidhani, the licence was dated 1st April 2008, so that it could not cover the suit design, which was registered on 17th October, 2008. He has relied, in this context, on Section 30(2) and (3)[30] of the Trade Marks Act, the procedure for compliance with which is to be found in

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[29] **6. Registration to be in respect of particular article. –**

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(3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated –

(a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in India or in any other country, by reason only that it has been applied to article in respect of which it was previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

[30] **30. Entry of assignment and transmissions in registers. –**

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(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a registered design, he may make an application in the prescribed form to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of designs, with particulars of the instrument, if any, creating such interest.

(3) For the purposes of sub-section (1) or sub-section (2), an assignment of a design or of a share in a design, a mortgage, licence or the creation of any other interest in a design shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of an instrument embodying all the terms and conditions governing their rights and obligation and the application for registration of title under such instrument is filed in the prescribed manner with the Controller within six months from the execution of the instrument or within such further period not exceeding six months in the aggregate as the Controller on the application made in the prescribed manner allows:

Provided that the instrument shall, on entry of its particulars in the register under sub-section (1) or sub-section (2), have the effect from the date of its execution.

Regulation 32[31]. He further submits that Plaintiff 2 has never done any business in the suit design, and that Plaintiff 1 alone has exploited it.

15.14 "Design", it is submitted by Mr. Vidhani, is defined in Section 2(d) in terms of the "shape" and "configuration" of the article, and it is in respect of these two elements that the registration granted to the suit design certifies novelty to be present therein. The shapes of the plaintiff's design and defendant's product, he submits, are markedly different, the former being trapezoid and the latter rectangular. The transparent upper and opaque lower half, the curved top and the bulging midsection, submits Mr. Vidhani, is common to several water purifiers, and cannot be regarded as novel features. Similarly, adverting to paras 12 and 13 of the plaint in CS (OS) 762/2018, Mr. Vidhani submits that the water indicator on the right side of the lower white opaque half of the water purifier was a feature which was present even in the KENT ACE water purifier of the plaintiff, of which the plaintiff holds design registration w.e.f. 14th March 2014, and which the plaintiff, in para 13 of the said plaint, claimed to be in the market since 1988.

15.15 Mr. Vidhani reiterates, finally, that, as the suit design has expired in 2018, and there is no evidence of its having been renewed thereafter, the present suit is itself not maintainable.

15.16 In support of his submissions, Mr. Vidhani relies on the following passages from the judgement of a learned Single Judge of this Court in ***Crocs Inc. v. Liberty Shoes Ltd***[16]:

[31] **32. Registration of documents under sub-section (3) of Section 30. –** An application referred to in sub-section (3) of Section 30 shall be made in Form 10.

"19. The issue next to be examined is that what is the meaning of a design being new or original so that it becomes capable of being registered under the Act and for plaintiff to claim relief alleging piracy of the registered design under Section 22 of the Act and related to this issue would be the factual issue as to whether in fact the registered designs of the plaintiff are in fact new or original. The aspect of the registered designs having newness or originality, is a *sine qua non* requirement as per Section 4(a) of the Act, because it is clearly provided in Section 4 of the Act that in case a design is such that it falls within any of the four Sub-Sections (a) to (d) of Section 4 of the Act then such design would not be registered. Once the design is registered but is such that it could not have been registered because of the bars contained in the Sub-Sections of Section 4 of the Act, then Section 19(1)(d) of the Act comes into play providing that such a registered design is liable to be cancelled. Once a registered design is such which may be cancelled, then even if it is not cancelled, yet defences on the basis of which registered design can be cancelled are valid defences to a suit alleging infringement of the registered design/piracy in view of this being so specifically stated in Sub-Section (4) of Section 22.

20. I have recently in the judgment delivered in the case of ***Pentel Kabushiki Kaisha* v. *Arora Stationers***[32], CS (COMM) No. 361/2017 decided on 8.1.2018 had an occasion to consider the meaning of newness or originality which is the subject matter of Sub-Section (a) of Section 4 of the Act. By referring to the ratios of the Division Bench judgment of this Court in the case of ***B. Chawla & Sons v. Bright Auto Industries***[33] and of the judgment of the Hon'ble Supreme Court in the case of ***Bharat Glass Tube Limited v. Gopal Glass Works Limited***[34] , this Court has come to a conclusion that for a design to have entitlement of grant and continuation of registration under the Designs Act it is required that the design is such that it is an Intellectual Property Right. The Intellectual Property Right comes into existence if there is spent sufficient labour, effort, time, etc. whereby it can be said that consequently a new creation has come into existence i.e in essence there is required existence of innovation which is an Intellectual Property Right. It is because an Intellectual Property Right comes into existence that there is hence an entitlement to protection thereof and so that the creator of the design is granted monopoly with respect to use of the new/original design for a period of ten years plus five years as provided in Section 11 of the Act. It has been held by this Court in the case of ***Pentel Kabushiki Kaisha***[32] *(supra)* that mere variations to existing products which do not result in requisite amount of newness or originality cannot be considered as innovations having newness and originality for being granted monopoly for fifteen years. It has been held by this Court

[32] **(2018) 247 DLT 9**
[33] **AIR 1981 Delhi 95**
[34] **(2008) 10 SCC 657**

by reference to the Division Bench judgment of this Court and the judgment of the Supreme Court as stated above that trade variations to existing products will not entitle a person who has come out with a new product containing only trade variations to contend that there is newness and originality as required by Section 4(a) of the Act and that such products therefore cannot be called new and original and cannot be given the designation of an Intellectual Property Right and hence exclusivity for 15 years under the Designs Act. At this stage let me reproduce the relevant paras of the said judgment which read as under:-

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10. In ***Phillips v. Harbro Rubber Company***[35] , Lord Moulton observed that while question of the meaning of design and of the fact of its infringement are matters to be judged by the eye (sic), it is necessary with regard to the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e. that he should know that 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, He went on to give the example saying, 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 and original design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants for use in particular instance, and no patent and no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind. **It was emphasized that it is the duly of the court to take special care that no design is to be counted a "new and original design" unless it distinguished from that previously existed by something essentially new or original which is different from ordinary trade variants which have long been common matters of taste workman who made a coat (of ordinary cut) for a customer should be left in terror whether putting braid on the edges of the coat in the ordinary way so common a few years ago, or increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design.** On final analysis, it was emphasized that the use of the words "new or original" in the statute is intended to prevent this and that the introduction or substitution of ordinary trade variants in a design is not only insufficient to make the design "new or original" but that it did not even contribute to give it a new or original character. If it is not new or original without them the presence of them cannot render it so.

11. The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and

[35] **(1920) 37 R.P.C. 233**

novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the ultimate arbiter. However, the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.

12. … We fail to see the hard labour which the appellants claimed to have bestowed in creating the design they got registered. It is devoid of newness and equally devoid of originality. An addition of curve here or there in a shape which is well-recognised shape of an article of common use in the market cannot make it an article new or original in design. If it is made eligible for registration, it would certainly hinder the progress of trade without there being any justification, whatsoever."

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22. In view of the aforesaid position of law showing that it is necessary for protection of a registered design that the registered design must be an Intellectual Property Right created after application of sufficient time, labour, effort, etc, and that there must be sufficient newness or originality i.e existence of requisite innovation and that trade variations of known designs cannot result in newness and originality, let us now therefore examine the facts of the present case by applying the law as above stated to decide as to whether the registered designs of the plaintiff can be said to have newness or originality for having been validly granted registrations under the Act, and that even if registrations have been granted, once there is lack of newness/originality, then such registrations so granted are liable to cancellation in proceedings under Section 19 of the Act and accordingly such defences are valid defences under Section 22(4) of the Act for contesting the claim/reliefs by the plaintiff in the subject suits including of interim injunction reliefs.

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28.(i) With the aforesaid observations with respect to what is the law of design pertaining to newness and originality, and the concept of footwear itself being of different types, let us apply the aforesaid discussion to the facts of the present case as regards the registered designs of the plaintiff. In my opinion, one does not have to travel too far to understand that footwear of the plaintiff is nothing but a sandal. Sandal with open spaces are only trade variations of a sandal. Placing of the open spaces or perforation or gaps, and sandals being with or without straps at the back, are in the opinion of this Court merely only variations or trade variations of footwear. Trade variations of footwear/sandals cannot be and should not be given exclusive monopoly. Of course, every manufacturer who has done variations wants to earn maximum profit therefrom, and one of the ways to do so is by stifling competition by stopping the production of similar type of footwear

as being manufactured by the plaintiff, however that eventuality does not mean that courts will allow such a plaintiff/manufacturer to create a monopoly when the law does not sanction the same. In my opinion the features which have been argued on behalf of the plaintiff as existing in its sandals/footwear of mounds or humps or straps (or lack of them) or soles designs or perforations/open spaces etc., even when taken as a whole, or even individually for that matter, cannot be said to result in innovation or creation of newness or originality as is the intention of the legislature in terms of the Section 4(a) of the Act read with Section 19(1)(d) of the Act. It is therefore held that the registered design of the plaintiff with respect to its footwear, does not have the necessary newness or originality for the same to be called a creation or innovation or an Intellectual Property Right, and which must necessarily exist as stated by the Supreme Court in the judgment in the case of *Gopal Glass Works Limited (supra)*. In my opinion the registered design of the plaintiff is such which is liable to be cancelled as per Section 19(1)(d) of the Act read with Section 4(a) of the Act, and therefore such factual defences entitles the defendants to succeed in view of Sub-Section (4) of Section 22 of the Act to argue against grant of reliefs in the injunction applications which are subject matter of the present order. On this ground itself also therefore the interim applications of the plaintiff are liable to be and are accordingly dismissed."

(Emphasis in original)

15.17 Mr. Vidhani also relies on

(i) paras 5 and 6 of ***National Trading Co. v. Monika Chawla***[18],

(ii) paras 6 to 10, 12, 14, 16, 21 and 23 of ***Glaxo Smithline Consumer Healthcare v. Anchor Health & Beautycare Pvt Ltd***[17] and

(iii) ***Shri Gopal Engineering & Chemical Works v. POMX Lab***[36].

15.18 Apropos the trademark rights asserted by the plaintiff, Mr. Vidhani submits that there is no similarity between the plaintiff's and defendant's marks, as the plaintiff's mark is KENT GRAND +

[36] **AIR 1992 Del 302**

whereas the defendant's mark is AG AQUAGRAND, represented as  . He submitted that the plaintiff had admitted that the defendant was the assignee of the original registrant of the said mark, which the defendant had been using since 2009. As against this, submits Mr Vidhani, the KENT GRAND + mark was not registered in the plaintiff's favour as it was under oopposition. In fact, submits Mr. Vidhani, M/s Goldage Plastics and Chemical Industries (P) Ltd had applied for registration of the  mark claiming user prior to the user claim of the plaintiff for the KENT GRAND + mark for, *inter alia*, electrical apparatus and instruments, cash registers, conduit pipes, etc. He submitted that the plaint did not plead any goodwill in the KENT GRAND + mark, and provided sales figures only from 2016-2017. No invoice, manifesting sale of any water purifiers bearing the KENT GRAND + mark, had been placed on record. There was, therefore, he submits, no evidence of continuous user, as would lead the public to associate the KENT GRAND + mark indelibly with the plaintiff. In any event, submits Mr. Vidhani, the plaintiff had to establish existence of goodwill and reputation in 2009, when the defendant claimed to have adopted the AQUAGRAND trade mark.

15.19 Mr. Vidhani submits that the only licence of assignment of trade mark rights by Plaintiff 2 to Plaintiff 1, to which para 8 of the amended plaint filed by the plaintiff refers, is not for the mark KENT GRAND + but for the mark  . The said licence, too, is not on record. Besides, submits Mr. Vidhani, relying on ***P.K. Sen***[25], a

licensee cannot sue for infringement, in view of Section 53[37] of the Trade Marks Act, unless he is registered as a registered user of the mark.

15.20 Regarding user of the mark, Mr. Vidhani submits that the plaintiff's mark is unregistered, of which, without any documentary proof, the plaintiff claims user since October 2008, whereas the defendant's mark is registered since 2010. Besides, he reiterates, the plaintiff's mark is KENT GRAND +, whereas the defendant's mark is AG AQUAGRAND.

16. Submissions of Ms. Rajeshwari in rejoinder

16.1 Ms. Rajeshwari submits, in rejoinder, that Section 22 of the Designs Act defines piracy of a registered design as including both "obvious" as well as "fraudulent" piracy. She reiterates, relying on ***Castrol***[1], that the governing test of that of "substantial difference". Small differences *vis-à-vis* the suit design cannot, she submits, immunize the plaintiff's design from piracy, as the average customer would hardly notice such infinitesimal alterations. She relies, for this purpose, on paras 17 and 18 of the report in ***Dabur***[2].

16.2 On the aspect of trade mark infringement, Ms Rajeshwari submits, relying on para 125 of the judgement of a coordinate Single Bench in ***Luxembourg Brands SA RL v. G.M. Pens International***[38]**,** that a party, once restrained from using a particular trade mark, is required to maintain a safe distance from it, and not use another mark

[37] **53. No right of permitted user to take proceeding against infringement**. – A person referred to in sub-clause (ii) of clause (r) of sub-section (1) of Section 2 shall have no right to institute any proceeding for any infringement.

[38] **254 (2018) DLT 603**

which is merely cosmetically different. She also submits, relying on ***Pentel Kabushiki Kaisha***[32], that, having obtained registration for its design, the defendant could not plead invalidity of the suit design.

16.3 Ms. Rajeshwari further submits that copyright is granted, by Section 11[39] of the Designs Act, consequent on registration, on the *whole design*, and not on a part thereof. She also relies on the definition of "design", as contained in Section 2(d). The certificate of novelty, as contained in the design registration granted to the plaintiff in respect of the suit design, she points out, certifies that "novelty resides in the shape and configuration of the water purifier", only particularizing, in the process, the portions marked 'A' and 'B'. She relies on Section 10(4) of the Designs Act, which ordains that "the register of designs shall be *prima facie* evidence of any matter by this Act directed or authorized to be directed therein". She also relies on the decision of the UK High Court in ***Kevi A/S v. Suspa-Verein UK Ltd***[40], which holds thus:

> "A number of considerations have to be taken into account in trying to assess the 10 registered design, what are its features and what is the scope of the monopoly. First of all, one has to consider the statement of novelty. In this case the statement of novelty is in this form: "The novelty of the design lies in the shape or configuration of the article as shown in the accompanying representations". It is well settled (I need not refer to authority on this point) that in a case where a registered design *15* has a statement of novelty in that form one has to consider the whole design as constituting the registered design and not rely simply on one or more particular features as constituting the novelty in the design."

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[39] **11. Copyright on registration**. –
(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.
(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.

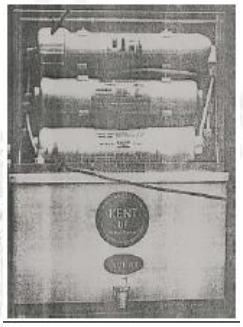
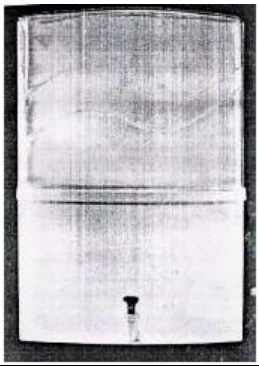
[40] **(1982) RPC 173 (UK)**

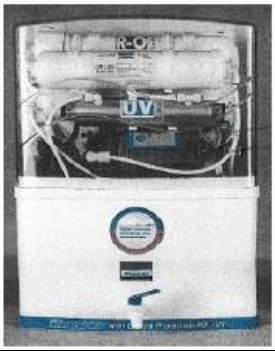
16.4 Ms. Rajeshwari emphasises the words "the design" as used in Clause (a) and (d) of Section 19(1). She submits, therefore, that these clauses would apply only where the very design of the applicant seeking registration has been published earlier. Prior publication of a similar design, irrespective of the degree of similarity, whether it is of the applicant or of somebody else, would not attract any of the clauses of Section 19(1). She submits that this position stands recognized in the following passage of the judgment of a Coordinate Single Bench of this Court in ***Vikas Jain***[8]:

> "11. So, on a comparison of the three designs, i.e., the Hong Kong design, the Plaintiffs design and the Defendants' design, I find that while there is identity between the Plaintiffs design and the Defendants' design, there is no such identity between the Plaintiffs design and the Hong Kong design. For the defence of prior publication taken by the Defendants to succeed, it must be shown that the very design that is utilised by the Plaintiff has been published in India or in any other country prior to the date of registration of the Plaintiffs design. While it is true that the magazine? TOYS? has apparently been published in Hong Kong in the year 2003, it cannot be said that the design indicated in the said magazine is the same as the design of the Plaintiffs toy scooter. Therefore, the Defendants cannot take the defence available for cancellation of a licence under Section 19(1)(b) in defence of the action of piracy brought by the Plaintiff in respect of its registered design. Moreover, what is referred to as? a prior publication? by the Defendants consists of a single page of a magazine and that page has 13 different products displayed on it as indicated in Annexure D-2 to IA No. 6349/2005 filed on behalf of the Defendants. It is also true that the so-called Hong Kong design appearing in the said document which has been isolated and magnified and printed earlier in this judgment, does not display the design from all angles. The test of ascertaining whether the two designs, i.e., the Hong Kong design and the Plaintiffs design are identical is that the designs have to be judged by the eye and each design has to be compared as a whole with all its component features, important and unimportant. [See: Rosedale Associated Manufacturers (supra)]. Applying this test, I do not see as to how at this prima facie stage the Hong Kong design can be regarded as a prior publication of the Plaintiffs design."

16.5 Apropos the design on which the defendants have placed

reliance, to contend that the suit design suffers from want of novelty, Ms. Rajeshwari has placed on record the following comparative statement, distinguishing the suit design from the alleged prior art:

No Novelty in view of Prior Registered Designs		
S. No.	**Design in suit**	**Registered Design (Date) (Pg.No.)**
1.	Design No. 219309 Dated 17.10.2008 	**Design No. 198530 dated 16.02.2005 at Pg. 19** of the Defendant No. 1's Documents 
Comment:	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom	Design 207629 has broad and flat top, flat front, wide bottom, no water indicator and rectangular shape.
2.	Design No. 219309 Dated 17.10.2008 	**Design No. 200427 dated 26.07.2005 at Pg. 27** of the Defendant No. 1's Documents 
Comment:	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze	Design 200427 has a broad top and bottom, with waves design on the top part, a rectangular

	shape and narrow bottom	shape and no water indicator.
3.	Design No. 219309 Dated 17.10.2008 	Design No. 204308 dated 23.05.2006 at Pg. 33 of the Defendant No. 1's Documents 
Comment:	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom	Design 204308 has broad top, flat front, no water indicator and wide bottom.
4.	Design No. 219309 Dated 17.10.2008 	Design No.207629 dated 11.12.2006 at Pg. 46 of the Defendant No. 1's Documents Proprietor: Super Engineering Works (Ranjit Singh).  Registration cancelled vide order dated 28.02.2017 by Controller of Designs.
Comment:	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom	Design 207629 has broad top, flat front, no water indicator and wide bottom.
5.	Design No. 219309 Dated 17.10.2008	Design No. 260986 dated 14.03.2014 at Pg. 11 of the Defendant No.1's Reply to

		Application u/O39 R1&2 
Comment:	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom	Design 260986 has opaque top and bottom, **concave insert** at the top;

No Novelty in view of Prior Registrations (Argued not pleaded by Defendant No. 1)		
1.	Design No. 219309 Dated 17.10.2008 	**Design No. 198527 dated 16.02.2005 at** Pg. 11 of the Defendant No. 1's Documents  FRONT)  ((SIDE)
Comment :	Design 219309 has trapeze shape with a curvy drooping top, water indicator, front bulging	Design 198527 has a hexagonal shape, with a narrow top and bottom and broad middle. The nozzle is placed at the top of the design, no water indicator and an

	portion, and narrow bottom	elongated back.
2.	Design No. 219309 Dated 17.10.2008 	Design No. 194743 dated 31.03.2004 at Pg. 40 of the Defendant No. 1's Documents Proprietor: Eureka Forbes  
Comment :	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom	Design 194743 has a half cylindrical shape, with a flat top, no water indicator
3.	Design No. 219309 Dated 17.10.2008 	Design No. 199214 dated 21.04.2005 at Pg. 42 of the Defendant No. 1's Documents Proprietor: Eureka Forbes  
Comment :	Design 219309 has curvy drooping top, water indicator, front bulging portion, trapeze shape and narrow bottom	Design 194743 has a half cylindrical shape, with a flat top, no water indicator.

No Novelty in view of Prior Registrations

S. No.	Design in Present Suit Design No. 219309 Dated 17.10.2008	Prior-published design. (Advertisement Dated 13.12.2007) on Pg. 56 of the Defendant No. 1's Documents
1.		
Comment :	Design 219309 has trapeze shape with a curvy drooping top, water indicator, front bulging portion, and narrow bottom	This corresponds to model 'Kent Grand' (Design 204308 dated 23.05.2006). Design 204308 has broad top, flat front, no water indicator and wide bottom.

16.6 In this context, Ms. Rajeshwari also places reliance on paras 20 to 22 of the decision of a Coordinate Bench of this ***Dart Industries***[9].

> 20. It is not in dispute that the designs valuation whereof is alleged by the plaintiffs are registered in favor of the plaintiffs under the Designs Act, 2000. Therefore onus is upon the defendants to prove that they are pre published designs and not "original" as per definition contained in Section 2(g) of the Designs Act that they are in public domain. It is the common case that if the designs were pre published before registration was granted in favor of the plaintiffs, then such designs cannot be treated as "original". The mute question, Therefore, is as to whether there is pre publication of the designs forming subject matter of the present suit, either by prior use or sale or display or publication in any other form. "Publication" has not been defined in the Designs Act, 2000. However, by judicial pronouncement concept of publication has been developed. In the case of ***Rosedale Associated Manufacturers Ltd. v. Airfix Ltd***[41]., Lord Evershed M.R. enunciated the concept of prior publication in the following words:

[41] **1957 RPC 239**

> In this respect the test of prior publication of answering Defendants 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....

21. To put it simply, the test laid down is that a person with ordinary prudence while seeing the designs/documents in question is able to relate, in his mind's eye, the same antecedents' designs/statements without the necessity of making further experiments i.e. the moment he sees the design, he is able to at once say 'Oh! I have seen before'.

22. In ***Gopal Glass Works Limited v. Assistant Controller of Patents and Designs and Ors***.[42], Calcutta High Court opined that in order to destroy the novelty of a design registration, prior disclosure whether by publication or use or any other way, must be of the pattern, shape and/or configuration applied to the same article. By this definition, the test which is to be applied is that the prior publication the design disclosed is of the same pattern, shape and/or configuration. About publication, the Court made following pertinent observations:

> It is true that publication has not been defined in the 2000 Act. Yet, for reasons discussed above, mere publication of design specifications, drawings and/or demonstrations by the Patent Office of the United Kingdom, or for that matter, any other foreign country, in connection with an application for registration, would not, in itself, amount to publication that would render a design registered in India liable to cancellation.
>
> 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

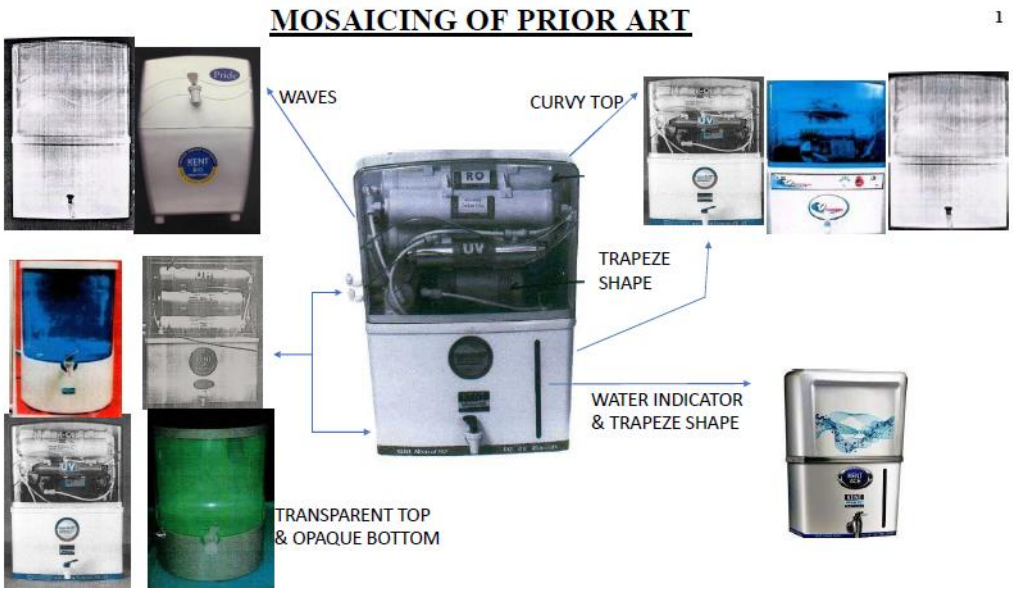
[42] **2006 (33) PTC 434**

depict the application of the design on the same article, with the same visual effect would be sufficient.

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.

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."

16.7 Apropos brochures of third parties, on which the defendant has placed reliance and which are to be found at pages 85 to 123 of the documents filed by the defendant, Ms. Rajeshwari submits that there is no date on any of the documents and that, therefore, they cannot be treated as prior publication. She further submits that, in order to contend that the suit design suffers from want of novelty vis-a-vis prior art, the defendant has mosaiced individual features of prior art water purifiers, to allege want of novelty in the suit design, thus:



16.8 Ms. Rajeshwari submits that lack of novelty *vis-a-vis* prior art cannot be alleged by mosaicing individual features of prior art. She draws attention, in this context, to the definition of "article" as contained in Section 2(d), which defines the expression to mean "any article of manufacture or any substance, artificial, or partly artificial and partly natural; and includes *any part of article capable of being made and sold separately*". Where part of an earlier article is being relied upon, to compare with the suit design, and allege want of novelty, the said part must be capable of being made and sold separately. She relies, in this context, on para 28 of the judgment of a learned Single Judge of the High Court of Bombay in ***Cello***[13] and on paras 14 to 16 of the decision of a Division Bench of High Court of Bombay in ***Videocon***[15].

16.9 Regarding the allegation of Mr. Vidhani that the differences between the suit design and prior are are merely trade variants, Ms. Rajeshwari relies on the following passages from Russell-Clarke and Howe on Industrial Designs, Ninth Edition:

> "It has always been held that nothing will be counted new or original unless it differs from what has gone before by something more than ordinary trade variants, or features in common use in the trade. This is embodied in the statutory test of novelty in the RDA(A), which specifically excludes from registration those designs which differ from prior designs only in features which are "variants commonly used in the trade". This is a distinct ground of invalidity from a variation in "immaterial details" and a design may lack novelty on this ground even if replacing one trade variant in the prior art with the common trade variant in the registered design does have a significant visual impact. Consideration of this aspect of novelty will normally involve the evidence of experts in the trade.
>
> What is a trade variant was explained by Lord Moulton in ***Phillips***[35].
>
> > "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."
>
> 3-156 A trade variant is, therefore, some embellishment (useful or otherwise) which is known, and sometimes, though not always, used in connection with a particular class of article or class of work."

16.10 With respect to the decision in ***Crocs***[16], on which Mr. Vidhani placed reliance, Ms. Rajeshwari submits that the only difference between the plaintiff's sandals, and sandals already in the market from a prior point of time, was the existence of a strap at the back. But for this strap, the sandals were identical. That, she submits, is not the situation which obtains in the present case, where, but for the exercise of mosaicing to which Mr. Vidhani has taken resort, the suit design is different, in several significance respects, from earlier designs cited by him.

16.11 With respect to the alleged admissions contained in para 19 of the plaint in CS(OS) 1469/2016, Ms. Rajeshwari submits that the suit design was not even subject matter of the said proceedings. The sales figures in para 19 of the said plaint related to other products, namely, KENT PEARL, KENT GRAND+, KENT PRIME and KENT SUPREME. There was, in the said plaint, no pleading which could be treated as admitting any of the contentions of the defendant in the present case.

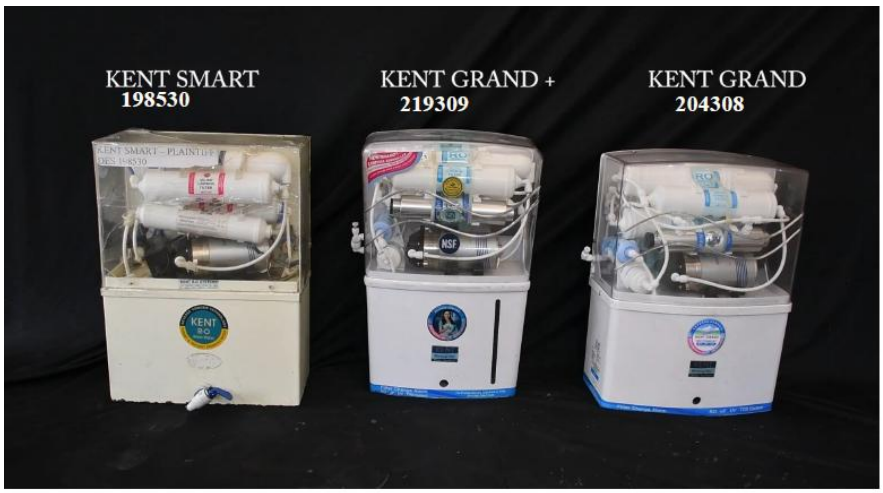
16.12 With respect to Mr. Vidhani's submission that there was no licence, from Plaintiff 2 to Plaintiff 1, entitling Plaintiff 1 to use the suit design, on record, Ms. Rajeshwari submits that, as Plaintiff 2 has joined in the present proceedings, the submission is merely inconsequential. That apart, she submits that the existence of the licence has been specifically pleaded in para 9 of the plaint and that, therefore, at a prima facie stage, the court would proceed on the basis that such a licence existed. She also submits that she has moved IA 11228/2021 to place the said licence on record under a sealed cover.

16.13 The power of Plaintiff 2 to licence use the suit design to Plaintiff 1, she submits, stands statutorily conferred by Section 30(4) of the Designs Act. She has relied, in this context, on paras 23 to 25, of the judgment of a Division Bench of this Court in ***Sergi Transformer Explosion Prevention Technologies Pvt. Ltd. v. CTR Manufacturing Industries Ltd***[43] and on the judgment of a learned Single Judge of this Court in ***Nirma Ltd. v. Nimma International***[44].

16.14 Ms. Rajeshwari submits that the licence granted by Plaintiff 2 to Plaintiff 1 stands renewed and is in force as on date.

16.15 Apropos the earlier KENT SMART and KENT GRAND products of the plaintiff, Ms. Rajeshwari the product correspondence to the suit design, i.e. KENT GRAND +, is significantly different. She has provided a comparison of the three water purifiers, thus:

[43] **(2015) 64 PTC 357 (Del)**
[44] **(2010) 42 PTC 307 (Del)**



16.16 As against this, Ms. Rajeshwari submits that the "configuration" of the suit design, under which the controller has certified the existence of novelty involves

(i) a convex curved top,

(ii) waives on the transparent upper half of the purifier,

(iii) a bulging/pot bellied mid-section and

(iv) a water indicator on the right side of the lower opaque half of the water purifiers.

All these features, she submits, stand copied in the design of the impugned water purifier of defendant, which makes out a case of piracy of suit design, within the meaning of Section 22(1) of the Designs Act. She also submits that the shape of the defendants' design is also trapezoid, like that of the suit design.

16.17 Ms. Rajeshwari relies on the principle, enunciated by a learned Single Judge of High Court of Madras in ***Preethi Kitchen***[5], which read thus:

> "(xxx) I therefore lay down the principle that in design infringement actions, if some views in design registration certificate and alleged offending product are same/similar and

> when some other views are not same/similar, the overall perspective will be the clincher."

16.18 On the aspect of passing off and trade mark infringement, Ms. Rajeshwari submits that once the defendants had, *vide* judgment and decree dated 19th December 2017 passed in CS(Comm) 1469/2016 been injuncted from using the mark AQUA GRAND + or any other similar mark, the defendant could not use any mark which had the suffix "GRAND" or "GRAND +". Given the fact that this Court has already held the defendants' "AQUA GRAND +" mark to be deceptively similar to the plaintiff's KENT GRAND +" mark, she submits that the impugned AQUA GRAND/  , is also obviously deceptively similar to the plaintiff's "KENT GRAND +" mark. Given that, "AQUA GRAND" is the dominant part of the "AQUA GRAND/  , Ms. Rajewshwari submits that the defendants can not legitimately seek to capitalise on the  part of the impugned mark. She has placed reliance, in this context, on para 21 of the judgment of a learned Single Judge of this Court in ***Eicher Goodearth Pvt. Ltd. v. Krishna Mehta***[45]**.**

Analysis

17. I proceed, now, to examine the issues that arise for consideration from the rival submissions of learned Counsel, one by one, at a *prima facie* level.

18. <u>Licence Agreement and right of licensee to sue</u>

[45] **(2015) 63 PTC 444**

18.1 Mr Vidhani sought to contended that no licence agreement, licensing the ownership and use of the KENT GRAND + trade mark, or the suit design, issued by Plaintiff 2 to Plaintiff 1, is on record. He also submitted that a licensee cannot sue for infringement of a trade mark.

18.2 It is not necessary to return any findings on either of these submissions, as Plaintiff 2 has joined Plaintiff 1 in filing and prosecuting the present suit. Plaintiff 2 is, moreover, the Chairman and Managing Director of Plaintiff 1. It cannot possibly be contended that neither Plaintiff 1 nor Plantiff 2 has the right to sue the defendants for infringement of the suit design. Though Mr. Vidhani did seek to contend, faintly, that the suit design was exploited only by Plaintiff 1 and not by Plaintiff 2, that is a matter of evidence which would necessarily require a trial. In any event, at a *prima facie* stage, Plaintiffs 1 and 2 having jointly filed the present plaint, I am inclined to hold that the suit is maintainable.

18.3 The submission that a licensee cannot sue for infringement, too, therefore, need not be examined at this *prima facie* stage.

19. <u>What can the plaintiff assert?</u>

19.1 Mr. Vidhani sought to contend that the plaintiff cannot claim novelty over the entire suit design, as novelty is restricted, in the certificate of design, to the features at Points 'A' and 'B'. In this context, he also sought to contend that, in its reply to the FER issued by the Controller of Designs following the submission of the application by the plaintiff for registration of the suit design, the

plaintiff had emphasized the features 'A' and 'B' as imparting novelty to it. The plaintiff cannot, therefore, in his submission, urge novelty in any feature of the suit design, other than the features at 'A' and 'B'.

19.2 Ms. Rajeshwari does not agree with this submission, and neither do I.

19.3 The certificate of registration of the suit design does *not* certify novelty to reside in the features at points 'A' and 'B'; rather, it certifies novelty as residing "*in the shape and configuration of the Water Purifier and particularly at points 'A' and 'B', as illustrated*". I have already observed that, from the views of the suit design as provided in the certificate, it is not possible to precisely pinpoint the features at points 'A' and 'B'. Ms Rajeshwari says that they refer to the upper curved edge and the bulging midsection of the water purifier; perhaps they do, but I, at least, am unable, judicially, to return even a *prima facie* finding to that effect. That, however, does not, in my view, impact the effect of the registration on the dispute at hand. The certification of novelty, *prima facie*, is of the *entire shape and configuration* of the Water Purifier. The definition of 'design', in Section 2(d)[46] of the Designs Act, also bears this out, as it speicifically identifies "shape" and "configuration" as two of the features of a design. Thereafter, the Designs Act, as a running theme, envisages certification "of *the design*". Once a design stands registered, Section 11 grants copyright, to the registrant, of the *whole design*. The

[46] (*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 an 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 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (*c*) of Section 2 of the Copyright Act, 1957;

submission of Mr Vidhani, that the plaintiff could claim novelty only in respect of the features at points 'A' and 'B' is, therefore, contrary, not only to the certificate of registration itself, but to Section 11 of the Designs Act as well. I, therefore, agree with Ms Rajeshwari that the particularization of Points 'A' and 'B' cannot detract from the certification of the overall shape and configuration of the Water Purifier. Neither can the defendants, nor can the Court, rewrite the certificate of registration granted by the Controller in respect of the suit design to read "novelty resides in the portions marked 'A' and 'B', as illustrated.

20. Prior publication

20.1 Mr. Vidhani has invoked Section 22(3)[47], read with Section 19(1)(b)[48] of the Designs Act to contend that the registration of the suit design is liable to be cancelled as it has been published in India prior to the date of registration. To support this submission, he has relied on

(i) Designs 198530, 200427, 204308 and 207629, 198527, 194743, 199214

(ii) certain brochures, placed on record with the written statement,

(iii) newpaper articles at pages 52 to 56 of the documents filed with the written statement,

(iv) the fact that sales figures of the suit design have been provided since 2002-2003 in the pleadings in CS (OS) 1469/2016, i.e. the earlier suit between the plaintiff and defendant,

[47] See Footnote 28
[48] See Footnote 11

(v) admission of prior publication of the water indicator feature of the suit design in CS (Comm) 762/2018 and

(vi) the record of cross-examination in CS (OS) 1574/2007.

He has also sought to contend that the plaintiff would not be entitled to the protection of Section 6(3)[49] of the Designs Act, in view of the proviso thereto. Ms Rajeshwari contends, *per contra*, that prior publication, as envisaged in Section 19(1)(b) as a ground to seek cancellation of the suit design, has to be of *the suit design itself*. Moreover, she submits, *the entire suit design* must have been published prior to the registration of the suit design.

20.2 I agree with Ms. Rajeshwari.

20.3 The fact that the grounds of cancellation, as envisaged in Section 19, pertain to the suit design itself, and not to any other design, even a deceptively similar one, is plain etymological common sense. "The", as an article of speech, refers to that to which allusion has been proximately earlier. The opening words of Section 19(1) refer to the right of any interested person to present a perition "for the cancellation of a design". The words "of a design", read with the definitive article "the" used to denote the design in each of the clauses that follow, make it clear that the disqualifications, to which the clauses allude, must attach *to the design of which cancellation is sought*. Section 19(1)(b) would, therefore, apply, as Ms. Rajeshwari correctly contends, only where *the design, of which cancellation is sought,* has been published earlier.

20.4 The designs on which Mr. Vidhani places reliance are not the

[49] See Footnote 29

suit design. Mr. Vidhani does not seek to contend that the suit design has been registered more than once, so that it is not necessary to examine, any further, the said designs for the purposes of applying Section 19. Suffice it to state, therefore, that, as the designs cited by Mr. Vidhani are not the suit design, their grant, or existence prior in point of time to the registration of the suit design, cannot attract Section 19(1)(b).

20.5 Similarly, not one of the Brochures at pages 85 to 123 pertain to the suit design. Quite apart from the fact that they are all undated, so that their publication prior to the registration of the suit design can also not be ascertained, as they do not pertain to the suit design, they, too, cannot attract Section 19(1)(b).

20.6 The newspaper advertisements at pages 52 to 56 filed by the defendant under cover of index dated 9th August 2021, are so indistinct that it is hardly possible for the Court to discern, therefrom, the features of the water purifiers shown therein, with any degree of clarity. To the extent they are visible, it is clear that they do not advertise the water purifier which stands registered under the suit design. For one, they do not have the water indicator in the opaque lower portion of the purifier. The arrangements of features inside the transparent upper portion of the water purifiers is also clearly different from those in the suit design. The said advertisements, too, therefore, do not attract Section 19(1)(b).

20.7 Mr. Vidhani has also relied on the sales figures provided in para 19 of the plaint in CS (OS) 1469/2016. The reliance is, on a plain reading of the said paragraph, obviously misplaced. Para 19 of the

plaint in CS (OS) 1469/2016 provides sales figures for the years 2001-2002 *till 2014-2015*, on a yearly basis, and precedes the tabular data with the following averment:

> "The annual sales and the expenses on advertisement and publicity for corresponding period of Plaintiff No. 1 *in respect of its products bearing the trademarks KENT PEARL, KENT GRAND +, KENT PRIME and KENT SUPREME and other variants of the Plaintiff's KENT RO purifiers* are mentioned hereinbelow *...*"

The sales figures, therefore, pertain not only to the KENT GRAND + water purifier, but to all water purifiers of the plaintiff. The figures span as many as seven years after the suit design was registered. It cannot, therefore, be said that para 19 of the plaint in CS (OS) 1469/2016 contains any admission of publication of the suit design prior to its registration.

20.8 The reliance, by Mr Vidhani, on paras 13 and 16 of the plaint in CS (Comm) 762/2018, is similarly misplaced. What is stated, in para 13 of the said plaint, is that, "since 1988, the Plaintiff's products *including products KENT SUPREME, KENT WONDER, KENT ACE and KENT SUPERB* has become a trendsetting product due to its unique design, unmatched and remarkable quality coupled with high efficiency and cost effectiveness". There is no reference, whatsoever, to the KENT GRAND + water purifier. Incidentally, the KENT ACE purifier also had a water indicator on the right side of the lower half. There is no similarity, whatsoever, between the KENT ACE and the present KENT GRAND + purifiers. In fact, the KENT ACE purifier is opaque throughout. No allegation of prior publication of the suit design can, therefore, be levelled, on the basis of the pleadings in CS (Comm) 762/2018.

20.9 Equally misplaced is the reliance, by Mr. Vidhani, on the record

of cross-examination in CS (OS) 1574/2007. Para 15.9 *supra* sets out the relevant portion thereof. The deposition relates, not to the KENT GRAND + purifier forming subject matter of the dispute at hand, but to the KENT GRAND water purifier. The photograph of the water purifier, as provided in the said plaint, also makes this apparent. The period from which the brochure for the KENT GRAND water purifier was circulated can have no relevance to the present case.

20.10 As none of the material, on which Mr. Vidhani seeks to place reliance to support his allegation of prior publication of the suit design, aids towards that end, it is not necessary to deal with Section 6(3) of the Designs Act.

20.11 The allegation that the suit design is vulnerable to cancellation under Section 19(1)(b) as it has been published prior to its registration, therefore, is *prima facie* unacceptable.

21. Novelty of the suit design

21.1 Mr. Vidhani contends that the suit design is bad for want of novelty and originality, *vis-à-vis* Designs 200427, 207629, 204308, 260986, 198527, 198530, 194743 and 199214. Para 16.5 *supra* sets out the manner in which, in a tabular fashion, Ms. Rajeshwari as distinguished the suit design from the aforesaid prior art designs.

21.2 Section 19(1)(c) of the Designs Act envisages cancellation of registration of a design where it is "not a new or original design". "New" is not defined in the Designs Act. However, Section 2 (g) defines "original", "in relation to a design", as "(meaning) originating

from the author of such design *and includes the cases which though old in themselves yet our new in their application*". The italicised words in Section 2 (g) are, in my view, of prime significance. Old designs, if newly applied are, therefore, "original". A Full Bench of 5 Hon'ble Judges of this Court has, in ***Reckitt Benckiser India Ltd v. Wyeth Ltd***[50], held thus, on the aspect of "novelty" and "originality", inter alia explaining the afore-italicised words in Section 2(g):

> "(ii) When we read the definition of a 'design' under Section 2(d) we find that there are inter alia four important aspects in the same. The first aspect is that the design is a design which is meant to produce an article as per the design by an industrial process or means. The second aspect is that design is not the article itself but the conceptual design containing the features of a shape, configuration, pattern, composition of lines etc. Third aspect is the judging of the design which is to be put in the form of finished article solely by the eye. Fourthly, the design which is the subject matter of the Act is not an artistic work which falls under the Copyright Act or a trademark which falls under the Trademarks Act.
>
> (iii) More clarity is given to the meaning of the word design when we look at the definition of 'original' as found under Section 2(g). The definition of the expression 'original' shows that the design though is not new because such design exists in public domain and is otherwise well-known, however, the design is original because it is new in its application i.e. new in its application to a specific article. Therefore, for seeking registration under the Act it is not necessary that the design must be totally new, and it is enough that the existing design is applied in a new manner i.e. to an article to which that design has not been applied before.
>
> (iv) So far as the expression 'new ' is concerned, it is well known i.e. it is something which comes into existence for the first time and therefore a new design which comes into existence for the first time obviously will be entitled to copyright protection."
>
> (Emphasis supplied)

21.3 The authoritative pronouncement of the Supreme Court in ***Bharat Glass Tube***[34] also sheds considerable light on the aspects of

[50] **(2010) 44 PTC 589**

novelty and originality, in the context of designs.

21.4 In that case, Gopal Glass Works Ltd. ("Gopal") claimed to be the originator of new and original industrial designs, for application by a mechanical process to glass sheets, some of which were registered and some awaiting registration. The design with which the court was concerned was registered on 5th November 2002. Gopal claimed exclusive copyright on the said design, as applied to glass sheets. The glass sheets, bearing the design, were marketed under the name "Diamond Square". Bharat Glass Tube Ltd. ("Bharat") and its associate IAG Company Ltd. ("TAG") started imitating Gopal's registered design. Gopal sued Bharat for piracy, vide Civil Suit 1 of 2004 instituted in the district court of Mehsana. The learned District Judge restrained IAG from infringing Gopal's registered Design No. 190336. Bharat filed an application under Section 19 of the Designs Act before the Controller of Patents and Designs for cancellation of Design No. 190336, on the ground that it had been previously published in India and abroad and was not, therefore, new and original. Reliance was placed, by Bharat, on a catalogue of M/s. Dornbusch Gravuren GmbH ("Dornbusch"), which, Bharat claimed, had developed an identical design in 1992, as well as a document downloaded from the official website of the Patent Office of the United Kingdom on 22nd September 2004 indicating that the same design had been registered in the United Kingdom by M/s. Vegla Vereinigte Glaswerke GmbH in 1992. Gopal contested the application. It was submitted that Dornbusch was merely engaged in manufacturing engraving rollers. The rollers were used to manufacture glass sheets to which Design No. 190336 was engraved. Gopal submitted that Dornbusch never manufactured engraved glass sheets

using the engraving rollers. Dornbusch, it was submitted, had sold the engraving rollers to Gopal, granting it exclusive user rights in India for at least five years. Gopal also disputed the entitlement of Bharat to rely on material downloaded from the UK Patent Office. Holding that Design No. 190336 was not new or original, as it had been published outside India, as well as in India prior to the date of application by Gopal, the Assistant Controller of Patents and Designs set aside the registration of Design No. 190336. Gopal appealed against the said decision under Section 36 of the Designs Act. A learned Single Judge of the High Court allowed the appeal and reversed the decision of the Assistant Controller. Bharat appealed, against the said decision of the learned Single Judge, to the Supreme Court.

21.5 Dealing with the issue, the Supreme Court outlined the sole purpose of the Designs Act, in para 26 of the report, thus:

> "The sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act."

21.6 The prohibitions under the Designs Act, held the Supreme Court, "have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time". Reliance was placed, by the Supreme Court, on para 27.01 of P. Narayanan's Law of Copyrights and Industrial Designs, the relevant parts of which may be reproduced as under:

> "*The protection given by the law relating to designs to those who produce new and original designs, is primarily to advance industries, and keep them at a high level of competitive progress.*
>
> Those who wish to purchase an article for use are often influenced

> in their choice not only by practical efficiency but the appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will increase sales.' *The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods*.
>
> *The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of particular articles to be manufactured and marketed commercially*."
>
> (Emphasis Supplied)

21.7 The Supreme Court noted that the Assistant Controller, in order to hold that the design of Gopal was not new or original, had relied on (i) the registration of the design in 1992 by the German Company, for use on glass, rexine and leather and (ii) the United Kingdom Patent website which indicated that the same design had been granted in the UK. As such, the Supreme Court identified the issue arising before it for consideration as "whether the design is new and original".

21.8 The expression "new or original" was explained, by the Supreme Court in para 29 of the report thus:

> "The expression, "new or original" appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, "new or original" means that it had been invented for the first time or it has not been reproduced by anyone."

21.9 The Supreme Court held that Design no. 190336 of Gopal was required to be reproduced on a glass sheet. As such, the expression "new or original", in that context, was required to be construed by examining "whether this design has ever been reproduced by any

company on the glass sheet or not". The letter of the German company, it was observed, in para 31 of the report, merely indicated that the German Company produced the rollers for manufacture of the glass sheet and did not indicate that the design was reproduced on the glass sheet either by the German Company or by any other agency.

21.10 Paras 32 and 33 of the report go on to observe thus:

> "32. There is no evidence whatsoever produced by the complainant either before the Assistant Controller or before any other forum to show that this very design which has been reproduced on the glass sheet was manufactured anywhere in the market in India or in the United Kingdom. There is no evidence to show that these rollers which were manufactured or originally designed by the Company were marketed by this Company to be reproduced on glass sheets in India or even in the United Kingdom. This proprietorship of this design was acquired by this respondent from the German Company and there is no evidence on record to show that these rollers were used for designing them on the glass sheets in Germany or in India or in the United Kingdom.
>
> 33. What is required to be registered is a design which is sought to be reproduced on an article. This was the roller which was designed and if it is reproduced on an article it will give such visual feature to the design. No evidence was produced by the complainant before the Assistant Controller that anywhere in any part of the world or in India this design was reproduced on glass or it was registered anywhere in India or in any part of the world. The German Company only manufactured the roller and this roller could have been used for bringing a particular design on the glass, rexine or leather but we are concerned here with the reproduction of the design from the roller on glass which has been registered before the registering authority. Therefore, this design which is to be reproduced on the article i.e. glass has been registered for the first time in India and the proprietary right was acquired from the German Company. We have gone through the letter of the German Company and it nowhere says that this was reproduced on a glass sheet. No evidence was produced by the complainant that this design was reproduced on a glass sheet in Germany or in India. The contents of the letter are very clear. It shows that it was designed in 1992 and was marketed in 1993. But there is no evidence to show that this design was reproduced on glass sheet anywhere in Germany."

(Emphasis supplied)

21.11 Following the above, in para 34, the Supreme Court proceeds to hold as under:

> "....what is sought to be protected is that the design which will be reproduced on the roller by way of mechanical process and that design cannot be reproduced on glass by anybody else. Now, the question is whether it is new or original design. For that it is clear that there is no evidence to show that this design which is reproduced on the glass sheet was either registered in India or in Germany or for that matter in the United Kingdom."

21.12 Thereafter, the Supreme Court expounded, in some detail, on the jurisprudential contours of the concept of "design". It was noted that the definition of "design" in the Registered Designs Act, 1949 in force in UK, was almost pari materia to the definition of "design" in the Designs Act. Placing reliance on para 27.07 of P. Narayanan's Law of Copyrights and Industrial Designs, the Supreme Court went on, in para 36 of the report, to hold thus:

> "36. Similarly our attention was also invited to Para 27.07 of Law of Copyright and Industrial Designs by P. Narayanan (4th Edn.) 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 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."

(Emphasis supplied)

21.13 On the question of eye appeal, the Supreme Court quoted, with approval, the decision of the Privy Council in ***Interlego AG v. Tyco Industries Inc.***[51], and went on to hold, in paras 40 and 41 of the report, thus:

"40. The question of eye appeal came up for consideration in Interlego AG v. Tyco Industries Inc. In that case Their Lordships have laid down important test in the matter of visual appeal of the eye. It was observed as follows : (All ER pp. 959g-960a)

> "In relation, however, to an assessment of whether a particular shape or configuration satisfies the former and positive part of the definition, the fact that an important part of the very purpose of the finished article is to appeal to the eye cannot be ignored. That factor was one which was conspicuously absent from the articles upon which the courts were required to adjudicate in ***Tecalemit Ltd. v. Ewarts Ltd.***[52] (No. 2), ***Stenor Ltd. v. Whitesides (Clitheroe) Ltd.***[53], and ***Amp Inc. v. Utilux Pty. Ltd.***[54], and in the more recent Irish case of ***Allibert S.A. v. O—Connor***[55] in all of which the claim to registration failed. It was one which was

[51] **(1988) 3 All ER 949**
[52] **(1927) 44 RPC 503**
[53] **1948 AC 107 : (1947) 2 All ER 241 : (1948) 65 RPC 1 (HL)**
[54] **1972 RPC 103 (HL)**
[55] **(1981) FSR 613**

present in Kestos case, where the claim to the validity of the design succeeded. It is present in the instant case. One starts with the expectation of eye appeal, for part of the very purpose of the article is to have eye appeal. That was aptly expressed by Whitford, J. in relation to the same subject-matter as in this appeal in ***Interlego AG v. Alex Folley (Vic) Pty. Ltd.***[56] (FSR at p. 298):

> 'I would have expected a designer designing toys to have the question of the appeal of the toy to the eye, even in the case of a functional toy, in mind. Mr. Rylands who gave evidence for the defendants said that when designing a functional toy it is necessary to have regard not only to suitability for purpose but to overall appearance. You have to design so that the article in question will make an immediate visual appeal to a child or to the parent or other person buying for a child'."

41. One has to be very cautious, unless two articles are simultaneously produced before the court then alone the court will be able to appreciate. But in the present case no design reproduced on 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 the United Kingdom or Germany. That could have been decisive.'

(Emphasis supplied)

21.14 From the decision in ***Bharat Glass Tube***[34], this Court has, in its judgment in ***Diageo Brands B.V v. Alcobrew Distilleries India Pvt. Ltd.***[57]**,** culled out the following principles:

> "The principles which emerge from the decision of the Supreme Court in ***Bharat Glass Tube***[34] may be enumerated thus:
>
> (i) The purpose of the Designs Act is protection of intellectual property in the original design for a period of ten years, extendable by five more years. The protection is intended to benefit a person for the research and labour put in to evolve a new and original design.
>
> (ii) The prohibitions in the design were engrafted so as to protect the original person who has designed a new design

[56] **(1987) FSR 283**
[57] **2022 SCC OnLine Del 4499**

by virtue of his own efforts by researching for a long time.

(iii) The object of design registration was to see that the originator of a profitable design was not deprived of the reward due to him by others applying the designs to their goods.

(iv) The Designs Act was intended to protect novel designs.

(v) The expression "new or original" was defined as a design hitherto not published or made known to the public, invented for the first time and not reproduced by anyone else.

(vi) The expression "design" means a conception or idea which could be applied to an article. It was not the article, but the idea which was capable of registration. The registrant was, however, required to produce a pictorial illustration of the idea or suggestion, such as to enable the court or authority to visualize the design.

(vii) The important part of the purpose of registration of a design was the finished article and its appeal to the eye."

21.15 These decisions, therefore, clearly hold that, in assessing the aspect of novelty of the suit design *vis-à-vis* prior art, the Court is required to compare design to design. It is only where the Court could come to a definitive conclusion, based on such comparison, that the suit design does not contain any novel features *vis-à-vis* prior art, that want of novelty can be found to exist. It must also be borne in mind, in this context, that the very concept of a design is predicated on its visual appeal to the eye. The novelty of a design, therefore, does not rest on its functional, but on its visual attributes. In fact, a design which is purely functional and the nature is incapable of registration, as held in ***Castrol***[1] . When, therefore, assessing novelty *vis-à-vis* prior art, the Court is to examine the matter from the point of view of the visual appeal of the design. The suit design may, functionally, serve the very same purpose which the prior art design serves. Water

purifiers are water purifiers. That would not necessarily mean that the suit design is bad for want of novelty or originality.

21.16 It is also well-settled that, whether one is dealing with the aspect of validity *vis-à-vis* prior art, or infringement *vis-à-vis* the defendants design, the entire suit design has to be taken into account. One cannot pick features of the suit design which may exist in prior art to contend that the suit design is bad for want of novelty. Often, the same features, when arranged in two different ways, may result in two different designs.

21.17 Novelty and originality may also exist in the manner in which has picked out individual features from different prior art designs are picked out and put together. It is for this reason that, while assessing novelty and originality of a design *vis-à-vis* prior art, mosaicing of features of prior art is completely impermissible.

21.18 The reliance, by Ms Rajeshwari, on Section 2(d) of the Designs Act is also, in this context, apt. Section 2(d) defines "design" as "only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article". "Article" is, in turn, defined, in Section 2(a) as including "any part of an article capable of being made and sold separately". Infringement has to be *by a design, of a design*. A design is article-specific. Part of an article can also be registered as a design, provided that part is capable of being made and sold separately. Juxtaposed, the position that emerges is that similarities between those parts of a design which are capable of being made and sold separately, alone can form a basis for alleging lack of novelty *vis-à-vis* prior art. The defendants, in the present case, do not

seek to contend that those features of the suit design, in which it is allgedly similar to prior art, are capable of being made and sold separately. Similarity between such features, therefore, even if it were to be presumed to exist, could not give rise to a finding of infringement.

21.19 At the same time, the Court is required to be conscious of the fact that the Designs Act is not intended to protect the design of an article *per se*, but the novel features of the design of an article. *Sans* novelty and originality, there can be no registerable design within the meaning of the Designs Act. Novelty and originality are everything. If the novel features of a design are, therefore, contained in prior art (without resorting to mosaicing), the design is vulnerable to cancellation on the ground of want of novelty and originality. In that event, the mere fact that the creator of the suit design as may be certain minor, inconsequential or infinitesimal alterations, which makes no real difference to the visual appeal of the design, *vis-à-vis* prior art, would not confer, on his design, either novelty or originality. Such minor, inconsequential or infinitesimal alterations are, in design jurisprudence, referred to as "trade variants".

21.20 In the present case, novelty has been certified, in the certificate of registration issued in respect of the suit design, to recite in the shape and configuration of the design. I am in agreement with the view, expressed by the UK High Court in ***Kevi A/S***[45] that, where the certificate of registration certifies novelty to reside in the shape and configuration of the design, and not only in certain features thereof, the entire suit design has to be taken into account while assessing novelty of the suit design *vis-à-vis* prior art.

21.21 The exercise is simple, and admits of no complication. The Court has merely to keep, side-by-side, the suit design and the design cited as prior art. Keeping them, thus, side-by-side, the Court is required to glean, for itself, the features which distinguish the suit design from prior art. If these features are minor, inconsequential or infinitesimal in nature, or do not pertain to the features of the suit design which had been certified to be novel, the Court would regard them as "trade variants", and hold the suit design to be vulnerable to invalidity on the ground of want of novelty and originality. If, however, the features are not "trade variants", thus assessed, the Court should, in my opinion, be hesitant in returning any finding of want of novelty or originality.

21.22 The Court should not embark on a subjective exercise of appreciating, for itself, the aesthetic values of a design. What the Court may not deem to be aesthetic, may be aesthetic to another viewer. Dali is a master, but his artistry is not for everyone. Appreciation of aesthetics must be left to the aesthete, and the Court cannot arrogate to itself expertise in this field.

21.23 When examining the matter from a *prima facie* point of view, which is what the Court does under Order XXXIX of the CPC, the Court, if it finds notable differences between prior art at the suit design should, ordinarily, in my view, protect the suit design. This consideration would apply all the more where the defendant admits to copying the suit design, and merely sets up a plea of invalidity of the suit design by taking advantage of Section 22(3) of the Designs Act. While the Court has to be conscious of the fact that the statute does

provide, in Section 22(3), the grounds on which cancellation of the suit design could be sought under Section 19 as grounds to defend a plea of infringement, where the design of the defendant's product is found to be an "obvious imitation" or a "fraudulent imitation" of the suit design, even on considerations of equity, the Court should lean against piracy, rather than permit it. At the same time, if the plaintiff is found to be as culpable as the defendant, in registering a design which is neither new nor original *vis-à-vis* prior art, no equities can weigh in the plaintiff's favour.

21.24 That, in my considered opinion, is the manner in which the Court is to proceed, when faced with a challenge to the validity of the suit design, predicated on Section 19(1)(c) of the Designs Act.

21.25 Viewed thus, I am in agreement with Ms. Rajeshwari that the factors on the basis of which she has distinguished the designs cited as prior art, as tabulated in para 16.5 *supra*, *prima facie* indicate that the shape and configuration of the suit design, when viewed as a whole, cannot be said to be wanting in novelty *vis-à-vis* the designs cited as prior art. Though the features of practically none of the designs cited as prior art are clearly discernible, to the extent they are, the features that distinguish the suit design from the cited prior art be regarded as mere trade variants. Viewed aesthetically as designs, it is clear that none of the cited prior arts are similar to the suit design, so as to justify even a *prima facie* finding of want of novelty of the suit design on that score. Mosaicing of prior art elements being impermissible, none of the cited prior art designs can be said to approach the suit design so closely as to deprive it of novelty or originality.

21.26 Mr. Vidhani's plea that the suit design is vulnerable to cancellation under Section 19(1)(c) on the ground of want of novelty and originality cannot, therefore, *prima facie* merit acceptance.

22. Expiry of suit design

22.1 Mr. Vidhani also sought to contend that the suit design has expired by efflux of time and that there is no material on record to vouchsafe its renewal. I had, for this purpose, queried of Ms Rajeshwari, after renotifying the matter, as to whether the registration had been renewed. She has also placed, on record, under cover of an index dated 13th March 2023, a certificate dated 26th May 2022, issued by the Assistant Controller of Patents & Designs, renewing the registration till 17th October 2023. Though this document was produced after judgement had been reserved in the matter, I am not inclined to ignore it, as it is an official document issued by the Assistant Controller, and merely vouchsafes the renewal of the registration of the suit design.

22.2 Mr. Vidhani contends that the said renewal, even if assumed to have taken place, cannot help the plaintiff, as, on the date when the suit was filed, the registration stood expired. The suit was, therefore, he submits, not maintainable, in view of Section 14(2)[58] of the Designs Act.

22.3 The original registration of the suit design was to lapse on 17th October 2018, prior to which the plaintiff applied for extension of the registration of the suit design on 11th October 2018. The requisite fees

[58] Refer Footnote 27

for the same purpose were also deposited with the Controller of Designs on 11th October 2018 itself. The case is not, therefore, one of *restoration of a lapsed design*, but one of renewal of an existing registration. Section 11(2) of the Designs Act provides that "if, before the expiration of the said ten years, applicatin for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years *from the expiration of the original period of ten years*. The registration of the suit design *stands extended* by the Controller, thereby meaning that the renewal would take effect from the date of making of the application for registration, i.e. 11th October 2018. There is, therefore, no hiatus between the lapsing of the registration of the suit design and its renewal, so that the institution of the present suit cannot be regarded as barred by Section 14(2).

22.4 Even otherwise, Section 14(2) applies where a *design, which has lapsed, is restored*. In the present case, as the plaintiff had applied for 5-year extension of the original period of registration, under Section 11(2), and the extension, by operation of the same provision, took effect from the date of expiration of the original validity period of the registration, Section 14 has no application at all.

22.5 Mr. Vidhani's submission that, as the suit design had lapsed, the suit was not maintainable when filed, therefore, in the first place ignores Section 11(2) and, in the second, erroneously applies Section 14 and cannot, therefore, sustain.

23. Judgment dated 19th December 2017 in CS (Comm) 1469/2016

23.1 Mr. Vidhani sought to contend, further, that the present suit was not maintainable as the reliefs sought herein already stand granted to the plaintiff *vide* judgment and decree dated 19th December 2017.

23.2 The submission lacks substance both on the design as well as on the trade mark aspect. The defendant's product, which formed subject matter of challenge in CS (Comm) 1469/2016, is different from the impugned product in the present case. The impugned trade mark in CS (Comm) 1469/2016 is also different from the impugned trade mark in the present case. The design and trade mark of the impugned product of the defendant, in the present case continue, nonetheless, to infringe the plaintiff's registered design and trade mark, in clear violation of the jugement dated 19th Decembe 2017. As such, the maintainability of the present petition is not affected, in any way, by the judgement and decree dated 19th December 2017 in CS (Comm) 1469/2016.

23.3 In fact, in view of the judgment and decree dated 19th December 2017, the defendants in the present care are estopped, at least at a *prime facie* stage, from questioning the validity of the suit design, as the suit design in CS (Comm) 1469/2016 is the same as the suit design in the present case. The judgment dated 19th December 2017, therefore, actually enures in favour of the plaintiff, rather than against it.

24. <u>The piracy aspect</u>

24.1 On the main issue in controversy, which is the aspect of piracy

of the suit design by the design of the defendant's product, Mr Vidhani submits that, *vis-à-vis* the suit design, the design of the defenants' product

(i) did not have sharp edges, but had, instead, a tapered left edge and top edge,

(ii) had a ripple effect on the right edge, from the top to the bottom of the purifier,

(iii) had an inverted 'U' shape around the tap at the base of the purifier,

(iv) had no wave shape on the transparent upper portion of the purifier and

(v) had a unique zig zag strip towards the middle of the design,

(vi) had a wider upper surface than lower, and

(viii) had a differently shaped base.

24.2 There are differences between the suit design and the design of the defendant's water purifier. Para 9.6 of this judgment has reproduced, *in extenso*, the tabular statement provided by the defendant as manifesting the differences between the suit design and the design of the defendant's water purifier. The question is the extent to which these differences can insulate the defendant from the allegation of design piracy, as defined in Section 22 of the Designs Act.

24.3 The decision of Ruma Pal, J. (as she then was), sitting singly in the High Court of Calcutta in ***Castrol***[1] is often quoted as laying down the definitive tests for design piracy. Section 22 of the Designs Act defines design piracy as having taken place where the design of the

defendant's product is an obvious imitation, or a fraudulent imitation, of the suit design. On the scope and ambit of these expressions, ***Castrol***[1] holds thus:

> "21. The next question is whether there is sufficient resemblance between the allegedly infringing copy and the petitioner's registered design to found an action for infringement under section 53 of the Act. It is not every resemblance in respect of the same article which would be actionable at the instance of the registered proprietor of the design. The copy must be a fraudulent or obvious imitation. The word 'imitation' dose not mean 'duplication' in the sense that the copy complained of need not be an exact replica. The word has been judicially considered but not defined with any degree of certainty. In ***Best Products Ltd. vs. F.W. Woolworth & Company Ltd.***[59] (supra) it was said in deciding the issue of infringement, it was necessary to break the article down into integers for descriptive purposes but in the ultimate result it is the article as a totality that must be compared and contrasted with the features of a shape and configuration shown in the totality observable from the representation of the design as registered. It was said that the Court must address its mind as to whether the design adopted by the defendants was substantially different from the design which was registered.
>
> 22. Apart from such overall resemblance in the design, the authorities have held that the Court is required to see in particular as to whether the essential part or the bases of the petitioner's claim for novelty forms part of the allegedly infringing copy. In ***Best Products Ltd.***[60] (supra) the essential part of the registered design of a whistling kettle was found by the Court to be the shape of the spout and the cap applied to it. The Court said that the very form of the registration emphasised that it was in respect of the audible alarm characteristic that the application of the plaintiff's registered design found its intended exploitation. The audible alarm, according to the learned Judge necessarily assumed a primary significance. The difference between the audible alarm of the plaintiff's kettle and that of the defendant's kettle as being marked, the action for infringement was dismissed (see: also in the context ***Phillips***[35] and ***Dunlop Rubber Co. Ltd. vs. Golf Ball Developments Ltd***.[60].
>
> 23. The next task of the Court is to judge the similarity or difference through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser. Thus in the case of ***Benchairs Ltd. vs.***

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[59] **(1964) IX RPC 215**
[60] **(1931) 48 RPC 268, 281**

Chair Center Ltd.[61] where the article to which registered design was applied was a chair. Russel L.J. said:

> "As we see it, our task is to look at these two chairs, to observe their similarities and differences, to see them together and separately, and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole: and apparently, though we do not think it affects our present decision, viewed as though through the eyes of a consumer or customer."

24. In judging the articles solely by the eye the Court must see whether the defendant's version is an obvious or a fraudulent imitation.

25. In ***Dunlop Rubber***[61] (1931) XLVIII RPC 268 at 279, the meaning of the word 'obvious' and 'fraudulent' have been stated

> "... 'obvious' means something which, as soon as you look at it, strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two."

26. In a later portion of the judgment it was said:

> "...fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement."

In ***Castrol***[1], the Court was concerned with the designs of containers in which the plaintiff and defendant were selling automotive lubricants. The plaintiff alleged that the design of the defendant's container

[61] **1974 RPC 429**

infringed the registered design of the plaintiff's container. The Court noted, with respect to the respective shapes of the two containers, as under:

> "15. The respondent No. 1 sells petroleum products under the trade name 'Veedol'. The respondent No. 1 sells some of its products in non-metallic containers the body of which is rectangular with a ridged side. The top is not quite as triangular as the petitioner's design. The top of the 'triangle' is flattened to a larger extent. But like the petitioner's design the sloping side of the top supports the handle. The entire container is larger than the petitioner's and is capable of holding 5 litres as opposed to the 4 litres container of the petitioner. At the hearing the respondent No. 1 produced containers being utilised by Indian Oil Corporation Ltd. and Bharat Petroleum Corporation Ltd. The design of the container used by these two companies are similar in the sense that they have rectangular bodies with a ridged side, a triangle like top with a handle on the slope of the triangle and the top triangle ending in the mouth of the containers.
>
> 16. The difference in the petitioner's containers and the containers of the other concerns including the petitioner is primarily in the proportions of the rectangle and secondarily in the colours used. But broadly speaking there can be no doubt that the design of the respondent's container bears a 'family resemblance' to the petitioner's design (see: ***Best Products***[60]). There can also be no doubt that the design used by the respondent in respect of the very class of goods in respect of which the petitioner's design is registered.

It is clear, from the afore extracted passages, that the containers of the plaintiff and the defendant, in ***Castrol***[1], bore similarities as well as differences. Having set out the legal position as already extracted supra, the Court held the design of the defendant's container to be immediately of that of the plaintiff's. In so doing, the Court returned the following pertinent observation:

> "37. The test of deceptive similarity would be appropriate where the petitioner pleads passing off. But *in cases of infringement of design the question is not whether the similarity has or is likely to cause confusion or deception of a purchaser but whether the similarity is an imitation of the registered design sufficient to destroy the exclusive right of user of the proprietor despite the fact*

> *that no confusion is or may be caused as to the source of the goods.* Otherwise every registered design could be imitated with impunity merely by changing the colour of the two products thus obviating any confusion. In my view the respondents have so imitated the petitioner's design as to deprive the petitioner of the protection under the Statute."
>
> (Emphasised)

The observation, of Ruma Pal, J., that, unlike the test which applies in the case of passing off, while examining a plea of design piracy, the Court is not concerned with the possibility of confusion of deception in the mind of the purchaser, as a consequence of the use, by the defendant, of the impugned design. The pertinent appropriate question, to be addressed, is "whether the similarity is an indication of the registered design sufficient to destroy the exclusive right of user of the proprietor".

24.4 ***Bharat Glass Tube***[34], which is really the only authoritative pronouncement of the Supreme Court on the Designs Act, approves, significantly, the following extract from Law of Copyright and Industrial Designs by P. Narayanan:

> "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 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."

24.5 What is registered, and protected, under the Designs Act is, therefore, the idea, as is required to be applied to an article. While, therefore, examining the aspect of design piracy, i.e., as to whether the defendant's design is an obvious or fraudulent imitation of the plaintiff's design, the Court has to proceed, principal, along the lines of "idea infringement". If those features of the plaintiff's design, which could be regarded as attributing novelty to it, treating it as an idea of the plaintiff, are replicated, substantially, in the design of the defendant's product, the Court would have to hold that piracy has taken place. The fact that the defendant's product might also have minor variations, in design, *vis-à-vis* the plaintiffs, would not alter the legal position.

24.6 Viewed thus, and being in balance the similarities, *vis-à-vis* the differences, between the suit design and the design of the defendant's product, I am convinced, prima facie, that the latter infringes the former. The impugned design in judgment and decree dated 19th December 2017, passed by this Court in CS (Comm) 1469/2016, which was between the plaintiff and the defendant, was found to infringe the suit design of the plaintiff. When one compares the impugned design in CS (Comm) 1469/2016 with the impugned design in the present case, and given the fact that the suit design in both the suits is the same, I am unable, prima facie, to hold that the distinction between the two designs of the defendant's products are such as to efface the infringing nature of the said design, *vis-à-vis* the suit design

of the plaintiff. The design of the defendant's product is, like the suit design, comprising a transparent upper and an opaque white lower half. There are waves on the transparent upper surface. The roof of both the designs is the, death of a chair is similar. There is a water indicator, which is situated, in both designs, at the left side of the lower white opaque part of the water purifiers. In both cases, there is a bulging mid-section. If one is to regard the shape and configuration of the suit design as novel and original, the similarities in shape and configuration, between the suit design and the impugned design, art too many for the Court to ignore. The primary features which appeal in the suit design are also present in the impugned design of the defendant. At the cost of reiteration, once the impugned design in CS (Comm) 1469/2016 had been found, by this Court, to infringe the suit design, the defendants, if they wanted to launch a new product with a new design, were required to maintain, between the impugned design in CS (Comm) 1469/2016 and the new design, sufficient distance, as would eliminate the considerations which weighed with the Court in CS (Comm) 1469/2016 in holding the impugned designs of the defendant, in that case, to be infringing of the suit design. That distance, in my considered opinion, has not been maintained.

24.7 Of no little importance, in this context, is the fact that the defendants are themselves marketing the impugned product as "KENT type" cabinets. There is, therefore, an employee acknowledgement, by the defendant, of similarity in design between their water purifiers, and the water purifiers of the plaintiffs**.**

24.8 Prima facie, therefore, the impugned design of the defendant's water purifier infringes the suit design of the plaintiffs, so as to amount to piracy within the meaning of Section 22 of the Designs Act**.**

25. Trade mark infringement

25.1 A *prima facie* case of trademark infringement is also seen to exist. The defendants already stand injuncted, *vide* judgment and decree dated 19 December 2017 from dealing with products bearing the mark AQUA GRAND+ and/or any other mark, identical or deceptively similar to, inter alia, the plaintiff's trademark KENT GRAND +. The impugned mark, in the present case, is the device mark 

. Clearly, the dominant part of the impugned mark is 'AQUAGRAND'. Inasmuch as the mark AQUA GRAND+ has already been found to be infringing of the plaintiff's KENT GRAND + mark, prima facie, the mark AQUAGRAND would also infringe the plaintiffs registered plaintiff's KENT GRAND + trade mark. The added material in the impugned device mark cannot detract from the factum of infringement, as held by the Supreme Court in ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories***[62]**.**

25.2 The injunction granted by this Court against the use, by the defendants, of the AQUA GRAND+ would also, therefore, *mutatis mutandis*, extend to the impugned 

device mark.

25.3 As I have found, prima facie, in favour of the plaintiff and against the defendants on the aspect of design piracy and trademark

[62] **(1965) 1 SCR 737**

infringement, I do not deem it necessary to enter into the aspect of passing off.

Conclusion

26. Resultantly, Defendants as well as all others acting on their behalf shall stand restrained, during the pendency of the suit, from dealing, directly or indirectly, in any products, being water purifiers or parts thereof that infringe plaintiff's registered Design no. 219309 or using the mark AQUA GRAND/AQUA GRAND+/   or any other other mark thereof as would infringe KENT GRAND+ mark of the plaintiffs.

27. Furthermore, Flipkart is directed to block/take down/ remove/delist all URLs that lead to infringement of the Plaintiffs' design no. 219309 and/or Plaintiff's trademark KENT GRAND+ or other variants including AQUA GRAND. It shall however be for the plaintiffs to convey, to Flipkart the URLs in question.

28. Needless to say, all observations and findings in this judgment are prima facie, and are not tantamount to any final expression of opinion on any of the issues in controversy.

29. I.A. 6940/2021 stands allowed accordingly.

C. HARI SHANKAR, J.

MARCH 24, 2023
dsn