

(1972) 09 AP CK 0008
In the Andhra Pradesh High Court
Case No : A.A.O. No. 359 of 1972

Ampro Food Products

APPELLANT

Vs

Ashoka Biscuit Works and Others

RESPONDENT

Date of Decision : 26-09-1972

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, 9

Designs Act, 1908 — Section 2(5), 51A

Trade and Merchandise Marks Act, 1958 — Section 2(1)

Citation : AIR 1973 AP 17 : (1973) 1 AnWR 71

Hon'ble Judges : Chinnappa Reddy, J

Bench : Single Bench

Advocate : T. Anantha Babu and B.V. Rama Mohana Rao, for the Appellant; P. Babul Reddy and G.V. Sitarama Rao, for the Respondent

Judgement

Chinnappa Reddy, J.—The appellant makes biscuits. So does the respondent. The appellant's biscuits have embossed on them a certain design in the centre of which appear the letters " AF". The design is registered under the Design act, 1911. The respondent's biscuits also have embossed on them an identical design except that the letters " AB" appear instead of the letters "AF". The appellant complains that the respondent has committed piracy of his design. He has filed a suit in the city Civil Court, for a permanent injunction to restrain the respondent from using the design on his biscuit. Pending disposal of the suit he sought a temporary injunction. An ad interim injunction was granted on 20.6.1972 but after notice the interim injunction was vacated on 10.7.1972. The present appeal was filed and an interim injunction was granted on 31.7.1972 by my brother Mukthadar, J. The appeal has now come up for final hearing. The learned additional Judge of the City Civil court refused the temporary injunction on two grounds: (1) the appellant's design, though registered was not a new and original design since the affidavit filed on behalf of the respondent showed that they had been using the same design even before it was registered by the appellant. (2) the design gave no right to the appellant to us, it as a trade mark.

The respondent's application for the registration of a trade mark was pending before the Registrar of Trade marks and was likely to be granted. I will consider the correctness of both the grounds.

2. Under the Designs Act, a design is required to be a new or original design not previously published in India in order that it may be registered. An application for registration of design must be made to the Controller who may refuse to register any design presented to him for registration in which case an appeal against such refusal shall lie to the Central Government. Where a design is registered, the Controller shall grant a certificate of registration to the proprietor of the design and suitable entries shall be made in the Register of Designs. On registration the registered Proprietor of the design shall have a copy right in the design for a period of five years from the date of registration. Any person interested may present a petition for the cancellation of the registration of design on any of the following grounds (i) the design has been previously registered in India. (ii) It has been published in India prior to the date of Registration (iii) The Design is not a new or original design. The petition may be presented in the High Court without any limitation of time or where the cancellation is sought on the first two grounds it may be presented to the controller within a year from the date of registration. Where the petition is presented to the controller an appeal to the High court is provided against the decision of the Controller. The provision for the cancellation of the registration of design is found in Section 51-A of the Designs Act. Section 53 prohibits all acts of piracy of a registered design. Section 53(2) provides that a person acting in contravention of the Section shall be liable " (a) to pay a sum not exceeding Rs. 500/- recoverable as a contract debt, or (b) if the proprietor elects to bring a suit for the recovery of the damages for any such contravention; and for an injunction against the repetition thereof to pay such damages as may be awarded and to be restrained by an injunction accordingly." In the present case, it is admitted that the respondent has not taken any steps for the cancellation of the registration of the design. The question for consideration is whether it is open to the respondent to claim that the design is not a new or original design in defence to a suit for an injunction based on a registered design, he having taken no action to have the registration cancelled on that ground. To my mind, such a defence is not open to the respondent. If such a defence is open to the respondent, then the elaborate provisions made for the registration of a design and the cancellation of registration become practically meaningless. The learned counsel urged that the Civil Court's jurisdiction to decide the question cannot be taken away except by an express provision in that regard. I do not see why not. An express provision is made for the presentation of a petition to the High court for the cancellation of the registration of design on the ground that the design is not a new or an original design. When there is an express remedy provided under the act and that by way of a petition to the High court, I do not see why another civil Court should have concurrent jurisdiction over the same question and that in defence to an action based on a registered design. I am of the view that the provision for the cancellation of the registration

of a design by the High court excludes by necessary implication the jurisdiction of the ordinary Civil Court from going into the questions which may be decided by the High court when a application is presented to it u/s 51-A of the Act. The learned counsel for the respondent relied on the decision of a Single Judge of the Bombay High court in *Dwarakadas v. Chootalal*, AIR 1941 Bom 188. To meet the argument that there was no advantage to be gained by having a certificate of registration it if was not be final and conclusive the learned Bombay Judge said :

"The advantage is that if no evidence is led by the defendants to the contrary, the certificate is sufficient evidence that the plaintiffs are the proprietors, i.e., proprietors of a new or original design. If evidence is led, it is for the court to come to its finding on the question. A further advance is that as the register is prima facie evidence of the matters contained in it, the onus ordinarily will be on the defendants to show that the plaintiffs are not the proprietors of the registered design in question."

3. With great respect to the learned Judge I am not prepared to agree. I do not think that the Legislature made the elaborate provision for the registration of a design and the cancellation of the registration merely with a view to raise a flimsy presumption in favour of the proprietor of the registered design. The learned judge referred to Section 46(3) of the act in support of his conclusion. Section 46(3) of the act merely provides that the Register of Designs shall be a prima facie evidence of any matters by the act directed or authorised to be entered therein. The matters which are directed or authorised to be entered in the register are mentioned in Section 46(1). They are the names and address of proprietors of registered designs, notifications of assignments and all transmissions of register designs, and such other matters as may be prescribed. The register of Designs will, therefore, be prima facie evidence of the ownership or assignment of a registered designs. That is all. The register of Designs cannot be prima facie evidence of the fact that a design is a new or original design. In my view, the learned judge was not correct in thinking that an entry in the Register of Designs would be prima facie evidence that the registered design was a new or original design. When the learned judge's attention was drawn to the fact that the case of patents it was expressly provided by Section 29(2) of the Patents and Designs act, 1911 that every ground on which a patent might be revoked shall be available by way of defence to a suit for infringement of a patent and that there was no similar provision in the case of a design the learned judge observed that the absence of a similar provision in the case of a design did not exclude such a defence. The absence of an express provision, such as the one contained in Section 29(2) in regard to a patent, in the case of a design, it, in my view, a ground for coming to the conclusion that such a defence is precluded in a suit based on the infringement of a design. I, therefore, hold that the defence that the design is not a new or original design is not open to the respondent in this action.

4. The respondent, it seems has applied for the registration of a trade mark and

Mr. Babulu Reddy, learned counsel for the respondent submitted that the application will be granted as a matter of course. Assuming so, I do not see how that will entitle the respondent to commit an act of piracy in regard to the appellant's registered design. It should be remembered that a trade mark is different from design. A design is necessarily part and parcel of the article manufactured while a trade mark is not necessarily so. In fact, the definition of "design" in Section 2(5) of the Designs Act expressly states that it does not include any trade mark as defined in Section 2(1)(v) of the Trade and Merchandise Marks act, 1958. That is why the certificate of registration of the design contains a note which recites " the novelty in the design resides in the ornamental source pattern which appears only on the side of the biscuit as illustrated. No claim is made by virtue of this registration to any right to the use as a trade mark of what is shown in the representations or to the exclusive use of the letters appearing in the design". This note does not give any right to the respondent or other biscuit manufacturer to commit an act of piracy of the design as defined in the designs act under the guise of using it as a trade mark. The respondent, or other biscuit manufacturers may perhaps use the design as a trade mark on a wrapper or a label or otherwise but not so as to make it part and parcel of the biscuit in which case he could be committing an act of piracy of the design as defined in the Designs Act.

5. I am, therefore, of the view that the learned Additional Chief judge , City Civil Court was in error in refusing to grant a temporary injunction. The appeal is allowed and a temporary injunction will issue restraining the respondent from using the registered design of the appellant and from selling biscuits bearing that design. I understand that the suit is posted for trial in the first week of October. The learned Additional Chief Judge is directed to dispose of the suit expeditiously. There will be no order regarding costs.

6. Appeal allowed.