

(1999) 05 DEL CK 0011

In the Delhi High Court

Case No : I.A.Nos. 3053/97 and 10707/97 in Suit No.934 of 1997

Baldev Singh

APPELLANT

Vs

M/s Godran Rubber Plastic Industries

RESPONDENT

Date of Decision : 06-05-1999

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2
Designs Act, 1911 — Section 53

Citation : (1999) 05 DEL CK 0011

Hon'ble Judges : Dalveer Bhandari, J

Bench : Single Bench

Advocate : Mr. S.K. Bansal, for the Appellant; Mr. Ajay Sahni, for the Respondent

Judgement

Dalveer Bhandari, J.—This Order shall dispose of two applications, namely, I.A. No. 3053/97 under Order 39 Rules 1 & 2 CPC and I.A. No.10707/97 under Order 39 Rule 4 CPC.

2. The plaintiff filed a suit u/s 53 of the Designs Act,1911 for infringement of registered designs in which prayer has been made that a decree for perpetual injunction be passed in favor of the plaintiff and against the defendants, by himself and through their officers, servants, agents, distributors, dealers, representatives, successors advertising or offering for sale footwear under design identical to or deceptively similar and thereby pirating or infringing the plaintiff's registered design No.167995 in Class-10 in respect of footwear and also passing off their impugned footwear under the impugned design as that of the plaintiff. Along with this suit the plaintiff has also preferred an application under Order 39, Rules 1 & 2 read with Section 151 CPC.

3. On 9.5.1997 summons to the defendant was issued and an ex parte ad interim order was granted. The defendant filed a written statement and reply to the interim application.

4. The basic facts which are necessary to dispose of these interlocutory

applications are recapitulated as under.

5. The case of the plaintiff is that he is engaged in the business of manufacturing, marketing and selling of footwears. One such footwear of the plaintiff is popularly known as Article No .002. The said footwear has distinctive shape, design, configuration and surface pattern propounded and originated by the plaintiff.

6. It is further incorporated in the plaint that in order to afford statutory protection to their novel design the plaintiff got the design of the said footwear registered under the provisions of Design Act,1911. The plaintiff's design of Article No.002 is registered under No. 167995 as on 25.8.1994 in Class-10. It is also mentioned that the said registration of the plaintiff is still valid, regular and subsisting in law.

7. It is also alleged that the plaintiff's products on account of their aesthetic forms of the design, shape and surface pattern offers great fascination to the purchasers and on account of the popularity of the said design, the plaintiff has effected considerable sales of the said footwear throughout India and the people at large recognise these particular products of the plaintiff by their peculiar design, shape and surface pattern.

8. It is also mentioned in the plaint that it came to the knowledge of the plaintiff that the defendant was manufacturing footwear bearing the shape, design, configuration and surface pattern identical to that of the plaintiff for which the plaintiff enjoys statutory protection under Designs Act,1911 without leave and license of the plaintiff. Thus the defendant is committing piracy as envisaged in the provisions of Designs Act,1911.

9. In the written statement the defendant has taken the preliminary objection that the alleged registration of the design on which the suit is based is clearly prior published and prior registered. The impugned design is already prior published and/or prior registered in favor of Liberty Footwear Company under No. 161848 on 29.1.1990 which date is much prior to the date of registration of the impugned design in favor of the plaintiff. The plaintiff himself being a pirator has no right whatsoever to file the present suit against the defendant and the plaintiff's suit is liable to be dismissed on this ground alone.

10. It is also mentioned that this Court has no territorial jurisdiction to entertain and try the present suit as the defendant neither resides, carries on business nor works for gain within the territorial jurisdiction of this Court. It is also mentioned that the Liberty Footwear Company has been using the above mentioned registered sole bearing No. 161848 dated 29.1.1990 in respect of its series of shoes sold under its brand name "Windsor". However, the said series of shoes bearing the trademark "Windsor" are being sold in various styles under the names of Azhar, Classic, Attacker etc. It is stated that the design of Liberty Footwear Company which exactly corresponds with the registered design of the plaintiff is a shoe which is sold under the "Windsor" series with a sub-name of

"Attacker".

11. The defendant has placed on record photographs of the plaintiff's products and the defendant's products. The products were also shown in the Court during the course of submissions. The sample products of the plaintiff seem to be identical with that of the Liberty Footwear Company's product. The defendant has also placed on record a copy of the certificate of design dated 29.1.1990 in favor of Liberty Footwear Company. He has also produced the bill showing that these products were sold in the market on 30.3.1991 by the Liberty Distributors. On 10.9.1998 the defendant has also placed on record a photocopy of the magazine "First City" of August, 1991 depicting the shoe of the Liberty Footwear Company. He has also placed on record a photocopy of the September 1991 issue of the magazine "Signature" depicting the photograph of shoes manufactured by the Liberty Footwear Company. The defendant has also produced a photocopy of the September 1991 issue of the magazine "Discover India" depicting the photograph of the shoes of Liberty Footwear Company. These photographs clearly demonstrate that the shoe of the Liberty Footwear Company is identical and similar to the plaintiff's product.

12. I have heard Mr. S.K. Bansal, learned counsel for the plaintiff and Mr. Ajay Sahni, learned counsel for the defendant. I have perused the documents and photographs placed on record by the parties. I have also carefully seen the products of the plaintiff and the products of the defendant. Both the shoes appear to be similar and identical in their features. The broad view of configuration and designs are similar. On careful examination of both the shoes, I am of the prima facie view that it cannot be said that there is substantial variation in the designs of these shoes. The documents and photographs on record establish beyond doubt that Liberty Footwear Company had started manufacturing exactly similar product much prior to the manufacture of the plaintiff's product.

13. Learned counsel for the plaintiff submitted at length in what kind of cases, the Court should grant the interim injunctions. I do not deem it necessary to deal with those cases. The settled principles are well known and real controversy involved in the case is whether one pirator can injunct the other pirator ?

14. Learned counsel for the defendant Mr. Ajay Sahni placed reliance on Capital Plastic Industries Vs. Kapital Plastic Industries reported in 1989 Patents and Trademarks Cases 98. In this case a Division Bench of this Court held that the user of the trade mark RABBER/RAHBER by the plaintiff and the trade mark RAHBER by the defendant is being tainted with piracy from the very beginning and no law having been brought to notice providing protection to the pirators of a trade mark, the undertaking given by the respondent that he will not manufacture, sell or offer for sale jugs under the trade mark RAHBER or RABBER is hereby released with direction that the defendant will maintain true and proper account of such sales, meaning thereby a pirator cannot injunct another pirator. The originator of the trade mark or design is entitled to protection of law, but not

a pirator.

15. Mr. Sahni also placed reliance on a Division Bench Judgment of this Court reported as Niki Tasha India Pvt. Ltd. Vs. Faridabad Gas Gadgets Pvt. Ltd., , wherein the Court observed that interlocutory injunctions are granted in exceptional cases where damages will not provide an adequate remedy to the plaintiff. The Court also observed that an interlocutory injunction should not be granted unless there is a real probability of the plaintiff succeeding on the trial of the suit. It is also mentioned that when there is a serious question as to the validity of the design to be tried in the suit and an application for cancellation has been made, no injunction should be granted.

16. The Court in the said Judgment also observed that the design is a conception, suggestion or idea of a shape and not an article. If it has been already anticipated, it is not "new or original". If it has been pre-published, it cannot claim protection. Publication before registration defeats the proprietor's right to protection under the Act.

17. Both these judgments have been followed in a later Judgment of this Court in Baldev Singh Vs. Shriram Footwear (1997 (17) PTC 268). The court while following the ratio of these judgments dismissed the plaintiff's application under Order 39 Rules 1 & 2 CPC and allowed the defendant's application under Order 39 Rule 4 CPC.

18. On consideration of relevant law, documents and photographs on record, prima facie, I am of the considered opinion that one pirator cannot seek injunction against another pirator and consequently the plaintiff is not entitled to any interim protection and accordingly, the ad interim exparte injunction granted to the plaintiff is liable to be vacated. I order accordingly.

19. The plaintiff's application under Order 39 Rules 1& 2 is accordingly dismissed. Consequently, the defendant's application under Order 39, Rule 4 CPC is allowed and disposed of.