
(1997) 03 DEL CK 0028

In the Delhi High Court

Case No : I.A.S. 2461 of 1996 and 313 of 1997 in Suit No. 617 of 1997

Baldev Singh

APPELLANT

Vs

Shriram Footwear

RESPONDENT

Date of Decision : 18-03-1997

Acts Referred:

Citation : (1997) 03 DEL CK 0028

Hon'ble Judges : Dr. M.K. Sharma, J

Bench : Single Bench

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

Judgement

Dr. M.K. Sharma, J.—This order shall dispose of the application filed by the plaintiff under Order 39, Rules 1 and 2 of the CPC registered as is 2461/96 praying for a temporary injunction against the defendants, their servants and agents from manufacturing, marketing, selling or advertising or offering for sale of shoes bearing the design identical or having fraudulent and obvious imitation to the design of shoe of the plaintiff popularly known as Article No. 887, as also the application filed by the defendant No. 1 under Order 39, Rule 4 and registered as is 313/97 praying for vacation of the interim injunction granted by this Court on 20-9-1996 against the defendant No. 1.

2. The plaintiff is engaged in the business of manufacturing, marketing and selling of shoes and shoe soles known as Article No. 887, which, according to the plaintiff, has distinctive shape, design, configuration and surface pattern propounded and originated by the plaintiff. The said design of the plaintiff is also stated to be registered with novelty of the front view, bottom view and side view. It is stated that the plaintiff is using the aforesaid design being Article No. 887 continuously since 7-6-1995 and that the plaintiff has acquired a wide sale of the said design in respect of the shoe. According to the plaintiff, the design is new, original and novel and that the defendants have started manufacturing and selling shoe bearing similar shape, features, configuration and surface pattern

having a fraudulent or obvious imitation to the plaintiff's aforementioned design of shoe w.e.f. 12-1-1996. It is stated that the plaintiff came to know about the piracy of design being committed by the defendants on 12-2-1996 and filed the present suit praying for relief of permanent injunction in favor of the plaintiff and against the defendants restraining the defendants from pirating and passing off under the plaintiff's design of shoe known as Article No. 887 or having fraudulent imitation thereof.

3. Along with the suit, the plaintiff filed an application under Order 39, Rules 1 and 2 of the CPC on which this Court passed order on 20-9-1996 restraining the defendants from manufacturing, marketing, selling, advertising or offering for sale of shoes bearing the design identical or having fraudulent and obvious imitation to the design of the shoe of the plaintiff popularly known as Article No. 887 until further orders.

4. After issuance of the aforesaid ad interim temporary injunction, the defendant No. 1 appeared in the suit and filed a written statement and reply to the application filed by the plaintiff under Order 39 Rule 1 and 2 CPC and also filed an application under Order 39, Rule 4 CPC praying for vacating the interim injunction granted by this Court.

5. I have heard the learned Counsel appearing for the parties in respect of the aforesaid interim applications. The Designs Act, 1991 lays down the procedure for registration of designs and the effect thereof as also the procedure for cancellation of a registration. u/s 43 of the Designs Act, it has been provided that the Controller may, on an application of any person claiming to be the proprietor of any new or original design not published in India, register the design. Section 47 of the Act lays down that when a design is registered, the registered proprietor of the design shall, subject to the provisions of the Act, have copyright of the design during five years from the date of registration. Once a design is registered, a certificate of registration is granted to the proprietor of the design by the Controller and that it would be valid for a period of five years from the date of registration which may be extended for a further consecutive period of five years. Cancellation of a registration is permissible u/s 51(A) wherein it is laid down that any person interested may present a petition for the cancellation of the registration of a design to the High Court on any of the grounds, namely, (1) that the design has been previously registered in India or (2) that it has been published in India prior to the date of registration or (3) that the design is not a new or original design. The other relevant section of the Act for the purpose of the present case is Section 53 which deals with the question of piracy of registered designs.

6. In the case of M/s. Nikky Tasha India Pvt. Ltd. v. M/s. Faridabad Gas Gadgets Pvt. Ltd. (AIR 1985 Delhi 136), the Division Bench of this Court has held thus :-

"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."

7. The defendant No. 1 in its reply to the application under Order 39, Rules 1 and 2 CPC and also in its application under Order 39, Rule 4 CPC has stated that the plaintiff himself is a pirator of the registered design No. 160283 registered in favor of M/s. Bata India Limited which design is identical/similar to the alleged design of the plaintiff. It is further stated that design of M/s. Bata India Limited is in use much prior to the alleged registration and use being claimed by the plaintiff. It is stated that under such circumstances, the claim of the plaintiff being proprietor and originator of the impugned design is false and baseless and the plaintiff himself being a pirator cannot seek for any equitable relief from this Court under Order 39 Rule 1 and 2. The defendant No. 1 has also placed on record a copy of the certificate of registration of design in respect of registered design No. 160283 dated 14-10-1988 in the name of M/s. Bata India Limited. From the said certificate it is disclosed that design of the sole in the footwear in the name of Bata India Limited was registered on 14-10-1988 with novelty of the bottom view of the sole.

8. The Counsel for the parties have produced both the two products of the plaintiff as also of Bata India Limited in the Court and I had occasion to see the nature and type of both the two products carefully.

9. In the context of the aforesaid, the question that arises for my consideration is whether the plaintiff has made out a prima facie case for the grant of temporary injunction. The Counsel appearing for the parties agree that mere proof of one of the three conditions, namely, prima facie case, balance of convenience and irreparable injury, does not entitle the plaintiff to an order of temporary injunction. It is obligatory for the plaintiff not only to prove the prima facie case but also the two other conditions, namely, balance of convenience and irreparable injury as well. The Counsel appearing for the plaintiff submitted that the plaintiff has a registration in respect of the shoes with novelty on bottom view, side view and front view of the sole where as Bata India Limited, as stated by the defendant No. 1, has registration in respect of bottom view of shoe alone. According to him, in any case, the defendant have neither any registration nor admittedly is a prior user than the plaintiff and Therefore the plaintiff is entitled for grant of a temporary injunction of the nature sought for in the present application against the defendants. He further submitted that even if it is assumed that Bata India Limited is registered prior to the plaintiff in respect of shoes with novelty on the bottom side, the plaintiff having registration with novelty of rear view, front view and side view is entitled to be granted with an injunction against the defendants in respect of novelty of side view and front view of the shoe sole, for which at least M/s. Bata India Limited had no registration at all.

10. I have carefully considered the respective submissions of the learned Counsel appearing for the parties. On perusal of the two types of shoes belonging to the

plaintiff and the Bata India Limited, it appears to me that both the shoes appear to be similar in its features which is visible to the naked eyes. There does not appear to be much difference between the design of the plaintiff and that of the Bata India Limited. The broad pattern of the two soles seems to be the same. The entire soles of both the varieties have the same pattern in cuts, rigids, roofs and lines pattern. The broad features of configuration and design being similar, it cannot be said that there are substantial variations in the two designs. That, of course, relates to the bottom view of the shoes in respect of which both the plaintiff and the defendants have registration, but the registration of the Bata India Limited being that of 1988, necessarily the design of the plaintiff in respect of the bottom view of the sole was previously published in India and that the said design to that extent could not be said to be a new or original design when it was registered in the year 1995. Besides from the brochure filed by the defendant, it is disclosed that M/s. Bata India Limited widely published in or about the year 1989 the front and side view of the same shoe and Therefore, it could be deducted that in respect of side view and front view of the shoe also, there was no novelty of the plaintiff as the same was previously widely published by M/s. Bata India Limited prior to the registration and user by the plaintiff. That being the position, I am of the prima facie opinion that the design in respect of which the plaintiff obtained registration and is using from 1995 could not be said to be new or original or was not previously published.

11. The registration of the plaintiff is also of very recent origin being of 1-12-1995. In M/s. Nikky Tasha India Pvt. Ltd. (supra), the Division Bench of this Court has held that where the design is a pre-published and recently registered and where the question of the validity of the design is pending, normally no injunction should be granted in favor of the plaintiff. It is stated by the defendant No. 1 that a suit has been instituted by the defendant No. 1 in this Court for cancellation of the registration granted in favor of the plaintiff. It is however, true that the plaintiff does not lose his rights arising out of registration of the design merely because an application for cancellation of the registration of the design is filed. So long the registration is not cancelled, the plaintiff is the registered proprietor of the design and he is entitled to the rights available to him under the Act. But at the same time, as held by the Division Bench of this Court in M/s. Nikky Tasha's case (supra) the certificate does not establish a conclusive right and that it has to be tried and decided in the laboratory of Courts. The Court held thus :-

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

12. In a subsequent case, another, Division Bench of this Court in Capital Plastic

Industries v. Kapital Plastic Industries (1989 PTC 88), has held that the user of trade mark rabber/rabber by the plaintiff and the trade mark rabber by the defendant 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, no injunction was required to be issued except for directing for maintaining a true and proper account of the manufacture and sale of the alleged offending goods.

13. Law, Therefore, is well settled that when a seriously disputed question on various grounds such as prior publication, lack of originality, trade variation, etc. is raised in a particular case, no injunction should be granted. In the context of the aforesaid legal proposition and considering the fact that a similar design is registered in favor of M/s. Bata India Limited being registered design No. 160283 and the same being shown to have been in use from 1989 onwards, i.e., prior to the registration and user of the plaintiff of his design, I do not think the present case to be a fit case where temporary injunction as sought for in the present application should be granted in favor of the plaintiff except for directing the defendant No. 1 to keep an account of all the sale that it would make of the impugned product. The defendant No. 1 shall submit the same after every six months in the Court and shall also give an undertaking within four weeks that it will pay damages to the plaintiff. should the plaintiff subsequently succeeds. The suit, however, may be tried expeditiously for the reasons stated above. The application filed by the plaintiff under Order 39, Rules 1 and 2 stands dismissed and the application filed by the defendant under Order 39, Rule 4 of the CPC stands allowed and the interim injunction granted by this Court on 20-9-1996 stands vacated.

List the suit before the Joint Registrar on 21-4-1997 for admission/denial of documents and before the Court on 26-5-1997 for framing of issues.

14. Injunction vacated.