

(1971) 12 CAL CK 0011
In the Calcutta High Court
Case No : Matter No. 157 of 1970

B.K. Plastic Industries

APPELLANT

Vs

Jayantilal Kalidas Sayani

RESPONDENT

Date of Decision : 08-12-1971

Acts Referred:

Patents and Designs Act, 1911 — Section 51A, 51A(1)

Citation : AIR 1972 Cal 339

Hon'ble Judges : S.C. Ghose, J

Bench : Single Bench

Advocate : P.K. Mullick, for the Appellant;

Final Decision : Allowed

Judgement

S.C. Ghose, J.—This is an application for cancellation or revocation of the registration of the design bearing No. 134095 dated the 26th June. 1968. This application has been made u/s 51-A of the Patent and Designs Act 1911. The said section reads as follows :--

"51-A. Cancellation of registration---

1. Any person interested may present a petition for cancellation of the registration of design-

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

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

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

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

(b) Within one year from the date of registration to the Controller on either of the grounds specified in Sub-clauses (i) and (ii) of Clause (a).

2. An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred".

2. The facts leading to the making of this application are set out hereunder:

On or about January 29, 1968 the petitioner applied to the Controller of Patents and Designs at Calcutta for the registration of a patent in respect of a "picnic set" being an assembly of tumblers made of plastics. After making the said application the petitioner started manufacturing and marketing for commercial purposes the said assembly of tumblers.

3. The petitioner subsequently came to know that on or about June 26, 1968 an application was made by one J. K. Savani of Bombay for the registration of a design in respect of assembly of tumblers. On the said date, i. e., 26th June, 1968 a certificate of registration of design bearing No. 134095 was issued by the Controller of Patents and Designs in favour of the said J. K. Savani of Bombay. Prior to the said application made by the said J. K. Sayani for the registration of the said design on 26th June, 1968 but subsequent to the date of application for the issue of the Patent made by the petitioner the said J. K. Sayani also known as Jayantilal Kalidas Sayani produced and sold in the market the said assembly of tumblers according to the said design. The petitioner on coming to know of the said marketing of the said tumblers according to the said design complained of the infringement made thereby of its aforesaid patent in respect of the said "picnic set".

4. On 5th October, 1968 on behalf of the petitioner advertisement was published in the Gazette of India in respect of the said petitioner's patent by the Patent Office, Calcutta. Notwithstanding the complaint made by the petitioner it appears that the respondent J. K. Sayani went on marketing the said design in infringement of the aforesaid patent granted to the petitioner.

5. On April 2, 1969, the petitioner filed a suit in this Court being Suit No. 969 of 1969 (Cal). (B. K. Plastic Industries v. Plasto Metal) inter alia against the Respondent for a permanent injunction restraining inter alia respondent from infringing the petitioner's Patent in respect of the said "picnic set". The petitioner also made an application before the Controller of Patents for the cancellation of the said registration of the said Design.

6. Thereafter the petitioner made the present application.

7. The respondent has not appeared in the instant application. But it appears that the said J. K. Sayani also known as Jayantilal K. Sayani has assigned and transferred the said design bearing No. 134095 together with the rights, power, authority, privileges and advantages appertaining thereto to one Jethalal K. Savani a partner of one Plasto Metal. The said assignment and/or transfer it appears however has not been registered in accordance with the provisions of the Patent and Designs Act and as such this Court is unable to take any notice of

the said alleged assignment.

Be that as it may, the assignee was granted leave to appear in the instant proceeding and make his submission.

8. The main contentions on behalf of the assignee as made by the Counsel Mr. P. K. Mullick, are as follows: to wit, the said design was in any event an original design on the date of registration and therefore cannot be cancelled or revoked. Secondly the fact that the said application before the Controller of Patent is pending is a bar to this Court's entertaining the instant application for cancellation or revocation of the said registration of the said design. According to Mr. Mullick the right of an applicant for cancellation or revocation of a design in a forum u/s 51-A of the Act has been given in the alternative. Under Clause (a) to Sub-section (1) the applicant may choose his forum to be the High Court or under Clause (b) of the said sub-section the applicant may choose his forum to be the Controller; but if the applicant chooses his forum to be the Controller of Patent and Designs the application for such cancellation has to be made within one year from the date of the registration and only on the grounds specified in Sub-clauses (i) and (ii) of Clause (a) of Section 51-A(1) of the Act. The grounds enumerated in Sub-clause (iii) of Clause (a) would not be available to an applicant before the Controller. In short the submission by Mr. Mullick was that the two forums prescribed by the said section for the relief of cancellation or revocation of a registration of design as prescribed in the said Sub-section (1) of Section 51-A of the said Act are mutually exclusive.

9. An application for registration of a design is made u/s 43 of the Act. Sub-section (1) to the said section provides as follows :--

"The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in (India), register the design under this part".

10. Previously the words used in the corresponding section of the Invention and Designs Act of 1888 were "new and original design" which were substituted by the words "new or original design" in the said Section 43 of the Patents and Designs Act, 1911. Mr. Mullick laid stress on the substitution of the word "and" by the word "or" and submitted that even if a design be not new but only original the same may be registered. Publication, according to Mr. Mullick, does not do away with the originalities of a design. We are not really concerned with this aspect of the matter in the instant application because under Sub-clause (iii) to Clause (a) of Sub-section (1) to Section 51-A of the Act the ground for cancellation is where the design is not new or where the design is not an original design. Therefore, as contended rightly, to my mind, by Mr. Rav if a design loses its novelty or newness on the date of registration the registration of such design shall be cancelled or revoked. In my opinion the case relied on by Mr. Mullick and reported in *Dwarkadas Dhanji Sha Vs. Chhotalal Ravicarandas and Co.*, does not assist Mr. Mullick. Even if a design which is original but is published earlier than

the date of registration the registration may be revoked. It has been admitted in paragraphs 6, 7 and 10 of the affidavit affirmed by Amritlal K. Sayani affirmed on the 1st July, 1970 that the respondent since December. 1967 with the consent of J. K. Sayani has been manufacturing the plastic tumblers in the aforesaid form of the design for the purpose of selling the same in the market and has been selling the same in various parts of India through various agencies. In the case of *Gunston v. Winox. Ltd.*, (1921) 1 Ch D 664 it was held that if a particular design was disclosed in good faith prior to the registration thereof that amounted to publication of the design. Similar was the decision also in the case of *Blank v. Footman. Pretty & Co.* (1888) 39 Ch D 678 where the inventor of a design showed it to his own agent who in his turn showed it to two persons and asked for their orders. The said soliciting of custom with regard to the said goods was held to be amounting to the publication of the design of the said goods within the meaning of the said Patent and Designs Act. In the instant case the invention or the method or dovetailing the tumblers under a cover is not of any intricate mechanism. It is true that any process is not registered but only the product i. e. the shape and configuration of the tumblers assembly with the cover but even then in any event the same has to be held to have been published on the basis of the admission itself made in the said affidavit of Amritlal K. Sayani.

11. Reliance of Mr. Mullick on Section 43 in my opinion is not of assistance to him. It is true that either a new or an original design may be registered u/s 43 of the Act but certificate of registration issued by the Controller u/s 45(1) of the Act is only a prima facie evidence to the said effect. In an action for damages for infringement defence may raise the plea that the design is neither new nor original. Similarly, in an application for cancellation or revocation of a registration of a design the petitioner may raise the plea that the design is neither new nor original and on that ground should be cancelled or revoked. Upon proof of either of the said grounds, the registration may be cancelled. Mr. Mullick's first contention, therefore, fails for the reasons stated hereinabove.

12. It is true that the word "or" prima facie or in the absence of ambiguity should be taken to be disjunctive. But the word "or" should be construed in the context in which the same is used. Sub-clauses (ii) and (iii) in Clause (a) of Sub-section (1) of Section 51-A of the Act are preceded by the word "or". But it appears to me that a person is entitled to take any or all of the grounds set out in Sub-clauses (i), (ii) and (iii) of Clause (a) of Sub-section (1) to the said section as the ground for cancellation or revocation of registration of a design. It cannot be said that since the word "or" stands in between the sub-clauses, a person is entitled to take only one of the grounds mentioned in the said sub-clauses in the application for cancellation of registration. That would lead to an incongruous result. Mr. Ray was right when he submitted that the word "or" here should be read as "and/or" namely, in the sense that a person is entitled to take one or all of the grounds mentioned in the said sub-clauses for cancellation or revocation of the registration of a design. Mr. Ray in support of his submission relied on the decision of this Court in *Haridas Mundra Vs. National and Grindlays*

Bank Ltd., wherein a Division Bench of this Court presided over by Mr. Justice Bachawat construed the word "or" appearing in Section 176 of the Indian Contract Act as "and". To understand the said construction made by the said Division Bench, it is necessary to consider Section 176 of the Indian Contract Act which reads as follows :--

"176. If the pawnor makes default in payment of the debt or performance, at the stipulated time of the promise, in respect of which the goods were pledged the pawnee may bring a suit against the pawnor upon the debt or promise, and retain the goods pledged as a collateral security; or he may sell the thing pledged on giving the pawnor reasonable notice of the sale. If the proceeds of such sale are less than the amount due in respect of the debt or promise, the pawnor is still liable to pay the balance. If the proceeds of the sale are greater than the amount so due, the pawnee shall pay over the surplus to the pawnor".

It was argued in the said case that the pawnor in case of default to redeem by the pawnor has three rights, viz. (a) he may bring a suit against the pawnor upon debt or promise, (b) he may retain the goods pledged as a collateral security, or (c) he may sell it on giving the pawnor reasonable notice of the sale.

13. It was urged that the pawnee if he institutes a suit to recover the debt has the right only to retain the goods pledged. He cannot in that event sell the goods. In other words the right to institute a suit on the debt or promise is alternative to and not concurrent with the right to sell the goods pledged and are mutually exclusive rights under the said section. Bachawat. J. observed to the following effect, to wit :--

"I think that when the word "or" is used in relation to two or more alternatives, it is not necessarily the case that the alternatives are mutually exclusive. The question as to whether they are mutually exclusive or not must be determined by applying the general rule that words should be construed to ascertain the intention of the provision in question to be collected from the whole of its terms".

It was held by the said Division Bench that the word "or" preceding the last sentence of the first paragraph of Section 176 did not make the rights conferred by the two sentences of the said first paragraph of the said Section 176 mutually exclusive and it was held that the institution of the suit on the debt or promise by a pawnee in court does not destroy his right to sell the goods pledged out of Court.

14. In *C. D. Fund Etc. v. Simpson* (1944) 2 All ER 60 it was observed at p. 73 by their Lordships that "In certain contexts meaning of the word "or" might not be exclusive". In my opinion the entirety of the Section 51-A of the Patents and Designs Act would lead to anomalous and absurd result if the word "or" in between Sub-clauses (i), (ii) and (iii) in Sub-section (1) in Clause (a) of the said section be not read as "and". The word "or" appearing before Clause (b) of the said Sub-section (1) should also be given the same meaning, for the simple reason that the same word appearing in the same statute and in particular in the

same section should be given the same meaning.

15. For the reasons stated above I am of the opinion that the forums prescribed by Section 51-A for cancellation or revocation of registration of Design in Sub-clauses (a) and (b) are not mutually exclusive. In the premises, the application made by the applicant which is pending now before the Controller cannot operate as a bar to the initiation of the present proceeding by way of petition. The word "or" may mean "and/or" in the context of certain circumstances is also corroborated by Saunders' Words and Phrases Vol. IV. The last contention of Mr. Mullick must also fail for the reasons stated above.

16. In this premises this application must succeed. There shall be an order in terms of prayers (a) and (b) of the petition.