
(2014) 05 CAL CK 0011

In the Calcutta High Court

Case No : G.A. No. 822 of 2012 and AID No. 2 of 2011

Britannia Industries Ltd.

APPELLANT

Vs

Controller of Patents and Designs and Others

RESPONDENT

Date of Decision : 08-05-2014

Acts Referred:

Designs Act, 2000 — Section 19(1), 2(d), 3, 31, 5

Citation : (2014) 05 CAL CK 0011

Hon'ble Judges : Indira Banerjee, J

Bench : Single Bench

Judgement

Indira Banerjee, J.—This appeal is directed against an order dated the 24th of May 2011 passed by the Asst. Controller of Patents and Designs inter alia dismissing the petition filed by the appellant, for cancellation of the Design No. 188157 dated 18th of February 2002 in respect of Biscuit Packets in Class 09-07 registered in the name of the respondent No. 3.

2. The respondent No. 3, Parle Products Ltd is engaged in the business of manufacture, marketing and sale inter alia of confectionery and bakery products throughout the country. The respondent No. 3 applied for and obtained registration of various packets, in which biscuits and confectionery products, manufactured by it, are sold in different parts of the country.

3. The respondent No. 3 is the registered proprietor of the designs being design Nos. 188156 and 188157. The said designs are in respect of Biscuit Packets and are registered in class 09-07 as per classification of goods, under Rule 10 of the Designs Rules 2001, which stipulates that for the purpose of registration of designs, articles shall be classified as per the Third Schedule of the said Rules. The said designs were registered under the Designs Act on 18 February 2002.

4. Section 5 and 6 of the Designs Act 2000 are set out hereinbelow for convenience:-

"5 Application for registration of designs.--

(1) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act: Provided that the Controller shall before such registration refer the application for examination, by an examiner appointed under sub-section (2) of section 3, as to whether such design is capable of being registered under this Act and the rules made thereunder and consider the report of the examiner on such reference.

(2) Every application under sub-section (1) shall be in the prescribed form and shall be filed in the patent office in the prescribed manner and shall be accompanied by the prescribed fee.

(3) A design may be registered in not more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Controller may decide the question.

(4) The Controller may, if he thinks fit, refuse to register any design presented to him for registration; but any person aggrieved by any such refusal may appeal to the High Court.

(5) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(6) A design when registered shall be registered as of the date of the application for registration."

"6. Registration to be in respect of particular article.--

(1) A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.

(2) Any question arising as to the class within which any article falls shall be determined by the Controller whose decision in the matter shall be final.

(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.

(4) Where any person makes an application for the registration of a design in respect of any article and either--

(a) that design has been previously registered by another person in respect of some other article; or

(b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application, the applicant had been the registered proprietor of that design."

5. Rule 11 of the Design Rules 2001, relevant in this regard, are set out hereinbelow for convenience:-

"11. Application.-(1) An application under section 5 of the Act for the registration of a design shall be accompanied by four copies of the representation of the design and the application and each of copy of the representation of the design shall be dated and signed by the applicant or his agent.

(2) The application shall state the class in which the design is to be registered, and the article or articles to which the design is to be applied.

(3) If it is desired to register the same design in more than one class of article, a separate application shall be made in each class of article and the application shall contain the number or numbers of the registration or registrations already effected.

(4) If so required by the Controller, the applicant shall state purpose for which the article is used."

6. The respondent No. 3 contends that the said design was created by Mr. Vijay Chauhan, the Chairman and Managing Director of the respondent No. 3 when no other manufacturer had manufactured or put in use any similar design of packaging.

7. The respondent No. 3 claims that, the novelty of the design of the said biscuit packets resides in its shape, configuration and surface pattern. The said design is a substantially rectangular package with rounded corners, having 2 fin seals with a seam line running parallel to the length on either side of the biscuit packet, 1 cross seal with seam line present at the midway and perpendicular to the no end seals. The fin Seals are provided with serration.

8. At the time of registration of the said designs, no claim was made in respect of any mechanical or other action of mechanism or in respect of any mode or principle of construction of the article. The novelty of the design resided purely in the shape, configuration and surface pattern of the biscuit packets, as illustrated

and forming part of the certificate of registration.

9. In or about 2005, the respondent No. 3 issued a notice to the appellant, Britannia Industries Ltd alleging that the appellant Britannia Industries Ltd had infringed the said design of the respondent No. 3 by using the same design in the packet of its product Britannia Marigold Double. The respondent No. 3 called upon the appellant, Britannia Industries Ltd. to cease and desist from using the registered design of the respondent No. 3.

10. After receipt of the said notice, the appellant, Britannia Industries Ltd., as a counterblast, filed an application under section 19(1) of the Designs Act 2000 for cancellation of the aforesaid registered design of the respondent No. 3, before the Controller of Patents and Designs.

11. The appellant and the respondent No. 3 filed their respective statements in the proceedings before the Controller of Patents and Designs and also filed affidavits by way of evidence. The short question is whether the impugned designs of the respondent No. 3 are substantially different from the "pillow pack" design commonly used in the trade.

12. By the judgment and order impugned, the Controller of Patents and Designs dismissed the application for cancellation of the aforesaid registered design of the respondent No. 3.

13. The learned Assistant Controller of the Patent and Design inter alia held:-

"....The design appears to be a rectangular box type appearance with i) two fin seals with seam lines running parallel to the length of either side of the biscuit and both the fin seals are in downward direction ii) The cross seal with seam line is present is in the mid of the rectangular box iii) Both the fin and cross seals are provided with serration. iv) The left and right side view appear to be rectangular with two fin seals in downward directions. The overall novelty in the shape, configuration and the surface pattern of the biscuit packet is thus determined by the above eye appealing feature which is readily visible.

Regarding the above issues I would like to mention two documents as pointed out in the hearing one is one book (Book-Biscuits, cookies and crackers volume 2, P-263 by Noel Almond 1988) which is annexed as annexure 5 in evidence by the applicant for cancellation). In my pinion the design as depicted therein is fundamentally different with regard to "appeal to and are judged solely by the eye" as mentioned in the section 2(d) of Design Act, 2000.

... ..

The mode or principle of manufacture is beyond the purview of the sec. 2(d) of Design Act, 2000 which is also disclaimed in the disclaimer part of the accompanying representations. In the book of Noel Almond shows a conventional rectangular pack with fin seals across the length of the pack and cross seals are along the width on two sides. The same is different for the impugned design with

regard to visual appeal is concerned.

Regarding the prior publication in the magazine (packing India Volume 32 No. 1 [April-May] 1999 at page 62 annexed as A in statement of application for Cancellation), the advocate relied upon a particular "Snax Pack" & submitted colored photocopy of the same and could not able to provide the specimen of the same during hearing. Scrutinizing the document I am of the opinion that the packet has no relevance with regard to shape, configuration and surface pattern of the impugned Design 188156. It appears to be a pillow pack and seal type is substantially different from the registered design.

Hence the design features of the impugned regd. Design 188156 vis a vis all cited packs of the magazine are completely different with regard to visual appeal. So I conclude the novelty or originality of the impugned design vis a vis any of the cited Packs relied upon by the petitioner for cancellation specially the "Snax pack" is established as impugned design is distinct in its visual appeal in comparison to the cited designs.

I have also noted that the apart from above argument the applicant for cancellation also argued on the surfaced pattern of the impugned design is of mere mechanical contrivance and is dictated solely by function and help the user to tear the packets. It is also argued by the applicant that the seam lines seems on the surface as illustrated "Biscuit Packet" are usual for joining the edges of materials at elevated temperature. So this conventional seam lines cannot be considered any sort of surface pattern to produce visible embellishment on the fundamental forms of the packets. But in my opinion though such seam lines do appear to be common and does serve some functional purpose, the arrangement of the seam lines, does have any visual impact on the consumer and also the said visual appeal is not established by any other cited finseal and cross seal arrangement of any pack and such arrangement of the pack of impugned design has added definite eye appealing feature of the surface pattern of the impugned design to the shape and configuration of the same. Moreover, the mechanical function is disclaimed in the disclaimer statement in the accompanying representation of the subject design.

I shall now deal with the issues whether registered Design No. 188156 is a new or original design within meaning of Act and whether the impugned design meets the criteria of Sec. 2(d) of the Act with regard to above issues I have already observed that I have not found any material evidence including prior publication which could affect the novelty or originality of the subject design No. 188156 and this impugned design 188156 is new or original with regard to distinct eye appealing feature of the same. Therefore, the impugned Biscuit packet is new or original and satisfies the Sec. 2(d) of the Design Act, 2000.

The applicant also introduced one new point regarding incorrect class number, but that proceeding is under the purview of section 31 of Act, so the matter is not dealt herein.

Upon consideration of statement of case, counter statement, evidence filed by both the parties and submission met during hearing on 18.01.2011 and after thorough observation and analysis I am of the opinion that the petitioners was not able to established any of the grounds of cancellation (state the grounds). I, therefore, dismiss the petition for cancellation of registered Design No. 188156 dated 18.02.2002 in respect of Biscuit Packet in class 09-07 without cost to any party."

14. Ms. Moushumi Bhattacharya appearing on behalf of the appellant submitted that the said designs were pre-published and lacked novelty or originality, the same being common to the trade. It was argued on behalf of the appellant that the impugned design is pillow pack design, which is commonly used in the confectionery trade and publicly known long prior to the registration of the impugned design. The design lacks novelty and/or originality.

15. Ms. Bhattacharya argued that the impugned designs were wrongfully granted registration and the registration granted of the impugned designs was liable to be cancelled. In support of her submission, Ms. Bhattacharya referred to 2 issues of a magazine by the name of "Packaging India" (volumes 31 and 22) published in December 1998-January 1998 and April-May 1999 and Volume 2 of the book of Noel Almond entitled "Biscuits Cookies and Crackers" that describes the biscuit making process. According to the appellant the said designs were published and disclosed in the books. The impugned designs were therefore not original at the time of making of the application for registration. The impugned designs were therefore liable to be cancelled.

16. The appellant has filed an application being GA No. 823 of 2012 annexing copies of design Nos. 185711, 185712 and 185713 which were registered on 31st of May 2001 in class 09-01 of the Designs Act by the Registered Proprietor. Ms. Bhattacharya argued that designs similar to the impugned designs had been prior published by the registered proprietor itself.

17. Mr. Siddharta Mitra, Bar at Law and Senior Advocate, appearing on behalf of the respondent No. 3 has vehemently objected to introduction of new evidence at the appellate stage by filing the said application being GA No. 823 of 2012. In view of such objection, this Court deems it appropriate to first deal with the question of whether this Court should allow new evidence at the appellate stage.

18. In support of her argument that the appellant should be allowed to rely upon the documents annexed to the application being GA No. 823 of 2012, by way of additional evidence, Ms. Bhattacharya cited the following judgments:-

(i) K. Venkataramiah Vs. A. Seetharama Reddy and Others, ;

(ii) Surinder Kumar and Others Vs. Gian Chand and Others, ;

(iii) M.M. Quasim Vs. Manohar Lal Sharma and others, ;

19. Mr. Mitra cited the following judgments:-

- (i) Arun Chandra Sinha Vs. The Hon"ble Lt. Satyendra Chandra Ghose Moulick, ;
- (ii) State of U.P. Vs. Manbodhan Lal Srivastava, ;
- (iii) Charan Misra and Another Vs. Labanya Debi, ;
- (iv) Rajkishore Panda and Another Vs. Banitia Madhya Engrajee Bidyapitha and Others, ;
- (v) Mahavir Singh and Others Vs. Naresh Chandra and Another, ;

20. The proposition of law which emerges from the judgments referred to above is that where there is lack of diligence on the part of the party who seeks to rely on additional evidence, the additional evidence may be rejected. However, additional evidence can always be permitted when substantial justice cannot be done in the absence of such evidence. The Court has inherent power to make such orders as may be necessary for the ends of justice, including the power to allow additional evidence.

21. When a person seeks to rely upon his own document at the appellate stage, the Appellate Courts take a stricter view. In this case the appellants are relying on the designs of the respondent No. 1 registered earlier. Ms. Bhattacharya submitted that the hearing of the appeal by the High Court was a rehearing and the proper course would be to allow additional evidence to avoid multiplicity of proceedings.

22. An appeal in the High Court being a rehearing, this Court is of the view that the additional evidence sought to be adduced by the appellant ought to be allowed. The appellant is relying on a prior registered design of the registered proprietor itself. Ends of justice demand that the registered design sought to be relied upon be looked into and examined.

23. Mr. Siddharta Mitra referred to Section 6 of the Designs Act 2000 in support of his contention that an application for registration of the design cannot be refused on the ground that the design had earlier been registered in some other class.

24. Mr. Mitra submitted that Section 6(3) makes it clear that where a design has been registered in respect of any article which belongs to a class of articles, the application of the proprietor of the said design to register it in respect of some other article in the same class or another class would not invalidate the registration on the ground that the design was not new or original or that the same was previously published. Mr. Mitra submitted that the additional documents which the appellant filed by way of Annexure to the application being GA No. 823 of 2012 were never placed before the Controller of Patents and Designs, either on the first occasion or later when the matter was heard on remand.

25. Relying on the judgment of the Chancery Division in Re Game Ball Company Limited reported in 55 RPC 26, Mr. Mitra submitted that the controller must

prima facie be the judge of novelty, having regard to his knowledge and experience in the matter and unless he has proceeded upon some wrong principle, his findings in the matter should not be interfered with.

26. Mr. Mitra argued that in this case, the order of the Controller has extensively dealt with the issue of novelty of the designs and also the allegations of prior publication raised by the appellant. Mr. Mitra argued that the Controller has not proceeded on the basis of any wrong principle. As such the impugned order does not call for interference.

27. There can be no doubt, that the Controller has knowledge and experience in relation to designs. However, the originality or novelty of a design has to be judged having regard to the eye of the consumer. When this Court compared the impugned designs with designs that were prepublished, as referred to above, and also with the prior registered designs of the respondent No. 3 itself, having regard to the nature and character of the article, it appeared to this Court that the article covered by the impugned registration neither had sufficient novelty nor originality to be registered.

28. On careful perusal of the evidence and materials on record including the prior publications this Court finds that the impugned designs are only minor variations of designs that were already in existence. An addition here or there in the shape of an article in common use in the market cannot make it an article new or original in design, as held by the Delhi High Court in *B. Chawla and Sons Vs. Bright Auto Industries*, . The claim of the respondent No. 3 of originality and novelty is not sustainable.

29. The conditions precedent for registration of a design are novelty and originality. The Registrar would satisfy himself of the novelty and the originality. The design should be new and original and not previously published in the country. A new combination of 2 or more old designs may form the subject matter for registration as a new or original design, but the combination must not be obvious and must result in something new or original.

30. In this case this Court finds nothing new or original. There is no originality or novelty in changing the placement of the fin cross seals, or in size and shape and/or other minor and obvious changes in the surface pattern, as has been done in this case.

31. Significantly, the learned Assistant Controller herself found the surface seam lines did appear to be common and did serve some functional purpose. She, however, held that the arrangement of the seam lines did have visual impact on the consumer and that "visual appeal is not established by any other cited fin seal and cross seal arrangement of any pack and such arrangement of the pack of the impugned design has added definite eye appealing feature of the surface pattern of the impugned design to the shape and configuration." This Court is however unable to appreciate how the arrangement of seam lines is either original or novel to make the article eligible for registration as a design.

32. The judgment and order under appeal is long and elaborate. The features of the impugned design have been discussed in detail. However, there is hardly any discussion with regard to the differences in features that are so striking, original and novel, to render the impugned designs eligible for registration.

33. The appeal is, therefore, allowed.

34. The impugned order dated 24th May 2011 passed by the respondent No. 2 is set aside. The Design No. 188157 dated 18th of February 2002 in respect of Biscuit Packets in Class 09-07 registered standing in the name of the respondent No. 3 is directed to be forthwith cancelled.

LATER

35. Mr. Gautam Ray, learned Advocate for the respondents prays for stay of operation of this Order.

36. Prayer for stay is considered and refused.

37. Urgent certified photocopy of this order, if applied for, be supplied to the learned Advocates appearing for the parties subject to compliance of the requisite formalities.