

(1917) 05 CAL CK 0009
In the Calcutta High Court

Gammeter

APPELLANT

Vs

The Controller of Patents and Designs and Others

RESPONDENT

Date of Decision : 22-05-1917

Acts Referred:

Specific Relief Act, 1877 — Section 45

Citation : 48 Ind. Cas. 437

Hon'ble Judges : Lancelot Sanderson, C.J.; John Woodroffe, J

Bench : Division Bench

Judgement

Lancelot Sanderson, C.J.—This is an appeal by Ernest Otto Gammeter against the judgment of my learned brother Mr. Justice Fletcher.

2. The matter arises in connection with an application which was made by Mr. Gam-meter to the Controller of Patents and Designs on the 16th of January 1915, whereby the Controller was requested to register the accompanying design in class. The description of the design was as follows: "The design consists of a metal band, for attaching a watch to the wrist and novelty is claimed for such a band, preferably of silver, passed" below the watch through loops affixed to each side of the watch case, which method by preventing the bending of the band between the said loops, tends to draw the free ends of the band apart, and thus assisted by the resilience of the metal, prevent the accidental opening of the fastening" means which consist of one or more studs on one end and projecting from either the inner or outer side of the band, taking into one or more or several key-hole slots provided in the other end of band."

3. The Controller registered that design on the 5th of February 1915. On the 23rd of July 1915, Messrs. J, Boseck & Co. applied to the Controller for cancellation of the registration; and, after hearing both parties, that is to say, Mr. Gammeter and Messrs. Boseck & Co., on the 7th of August 1915, the Controller cancelled the registration. On the 23rd of February 1916, notice of an application to the learned Judge was given; and the notice was that an application would be made for an order that the Controller of Patents and Designs should place the

Design No. 2611 upon the register of designs in such manner as the same was on and prior to 4th August 1916. The notice was headed "In the matter of Section 45 of the Specific Relief Act, 1877, and, in the matter of the Indian Patents and Designs Act, 1911." Section 45 of the Specific Relief Act provides as follows: Any of the High Courts of Judicature at Fort William, Madras and Bombay may make an order requiring any specific act to be done or forborne, within the local limits of its ordinary original civil jurisdiction, by any person holding a public office, whether of a permanent or a temporary nature, or by any Corporation or inferior Court of Judicature, provided ... (c) that in the opinion of the High Court such doing or forbearing is consonant to right and justice, (d) that the applicant has no other specific and adequate legal remedy."

4. The first point that "was taken before the learned Judge was that the Controller had exceeded his jurisdiction: and the second point was that, even if he had jurisdiction, he ought not to have cancelled the registration, because the design was in fact a new and original design.

5. Now, the Controller is alleged to have acted u/s 62 of the Indian Patents and Designs Act: and it is argued on behalf of the appellant that the Controller had no jurisdiction upon the application of Messrs. Boseck & Co., which was hostile to the interest of Mr. Gam-meter, to cancel the registration of the design, on the ground that Section 62 is limited to oases of applications by the registered owner or somebody in whom is vested the interest of the registered owner, such as the trustees in bankruptcy or the Liquidator, if the registered owner happens to be a Company. That is the first question I propose to consider.

6. The first part of this Act deals with patents, and the second part, which begins at Section 43, deals with designs and Section 43 provides, in Sub-section (1) that "The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in British India, register the design under this part." Sub-section (4) provides that " 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 Governor-General in Council": so that, the Controller upon an application for the registration of a design has discretion either to register or to refuse to register, but his decision is subject, to an appeal not to the Courts, but to the Governor-General in Council. Then after several sections to which I need not refer in detail, comes Section 62 in Part III, which part applies generally both to Patents and Designs. That section provides, "The Controller may, on request in writing accompanied by the prescribed fee,-(a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification; (b) cancel the registration of a design either wholly or in respect of any particular goods in connection with which- the design is registered; (c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs." That is the section upon which

this matter primarily depends. I am of opinion that the contention of the appellant in this case with regard to the construction of that section is correct. I think, on reading the section itself, the proper construction to put upon it is that it is limited to applications by the registered proprietor or by some person in whom his interest is vested. First of all the words "on request in writing" induce me to think that they must mean on request, by a person who is interested in the patent or design. Then when I come to look at the matters which are dealt with in that section, I find that Clause (a) deals with the correction of any clerical error in or in connection with an application for a patent or in any patent or any specification; and Clause (c) deals with the correction of any clerical error in the representation of a design, etc. These are obviously matters which can concern only the proprietor or the person in whom his interest is vested. Then between these two Clauses (a) and (c), comes the clause in question, "(b) cancel the, registration of a design either wholly or in respect of any particular goods in connection with which the design is registered." It is quite passable that the registered owner may desire to have the registration cancelled, for instance, he may desire to avoid a litigation which may be threatened against him in connection with the design which he has been successful in getting registered. I think it is an extraordinary way of providing, if it was intended to provide, that the Controller might cancel the registration upon an application by a third person hostile to the registered owner, by placing the provision between two clauses which obviously deal with the correction of clerical errors which obviously can only be corrected on the application of a registered owner. The matter does not rest there, because when I come to Section 64, Sub-section (1), I find it provides, "A High Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging or varying such entry as it may think fit." I think the learned Judge in the Court below held that the words "non-insertion in or omission from the register" would cover a case of the registration of the design and subsequent cancellation of it. I doubt, having regard to the provision of Section 62, whether that is the correct interpretation to put upon it. When the word "cancel" has been used in Section 62, if the Legislature intended that Section 64 should apply to cancellation by the Controller, I think it is a curious thing that that has not been specifically mentioned in Section 64. The word "cancel" has been used in Clause (6) of Section 62; and if that was intended to be "cancellation" upon the application of a person hostile to the registered owner, and if it was intended by Section 64 to give a right of appeal against such cancellation, I think it is extraordinary that the word "cancellation" was not used in Section 64. But again the matter does not rest there because when I turn to Section 67, I find that section provides as follows: "Where" any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of an application or of a specification,

or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard." I think it is pretty plain that the sections which are referred to in that section are Sections 5, 17 and 43, and that Section 62 is not referred to. It provides that if the Controller is going to exercise his power adversely to the applicant in any of the cases mentioned, he should give the applicant an opportunity of being heard. The section does not deal with the application which it is suggested may be made by a third person u/s 62 for cancellation of the registration. The learned Advocate General argued that inasmuch as the Controller would be occupying a quasi judicial position, he would naturally give the applicant an opportunity of being heard. The point, however, is that when the Act specifies certain cases in which an opportunity of being heard should be given to the applicant, it seems to me that if paragraph (6) of Section 62 had been intended to apply to the cancellation of registration upon the application of a person other than the registered owner, then Section 67 would have contained a provision that in such a case an opportunity of being heard should be given to the owner of the registered design. These considerations lead me to think that the contention put forward by the appellant in this case is a correct one. Then again, this section is similar to Section 70 of the English Act, (7 Edw. 7), and our attention was drawn to the form which had been drawn up by the Board of Trade in pursuance of the English Act: that section has been interpreted by the Board of Trade as applying only to applications by a registered owner or by somebody in whom the interest of the registered owner is vested, such as the trustee in bankruptcy or, in the case of a Company, the Liquidator. I quite agree with the learned Advocate General that that interpretation is not binding upon this Court; but it is interesting, at all events, to find that the Board of Trade interpreted the Act in the same way that I have. It is argued by the learned Advocate-General that, as regards this country, Form No. 20 is not limited to applications by registered owners. That is quite true. But the section which gives power to the Governor-General in Council to make rules under the Act, is Section 77, and it is in these words: "(1) The Governor-General in Council may make such rules as he thinks expedient, subject to the provisions of this Act... (g) generally for the purpose of carrying into effect the provisions of this Act." It must be obvious that that section does not give the Governor-General in Council power to extend the powers of the Controller further than is given to him by the express provisions of the Act, and I do not think that the fact that Form No. 20 has been framed in a general way and is not limited in its words to applications by a registered owner, affects what I think is the meaning of Section 62.

7. Therefore, the conclusion at which I arrive on this point is that the Controller, upon the application of Messrs. Boseck & Co., had no jurisdiction to cancel the registration, and it seems to me that under the Act the proper and ordinary way of expunging the registration of a design was to apply to this Court u/s 61. This, however, does not conclude the question, because the learned Judge in deciding the first point in favour of the Controller adjourned the matter in order that he

might see whether or not the design was a new or original design. The learned Judge thought that the Court had power to revise the Controller's decision u/s 64. If my interpretation of Section 62 is correct, then that would not be so, and the applicant would be entitled to the order which he asks for, u/s 45 of the Specific Relief Act, but for the existence of paragraph (e) to which I have already referred, namely, "that in the opinion of the High Court such doing or forbearing is consonant to right and justice."

8. Therefore, before we can direct the Controller to restore the registration of "the design, we have to consider in effect the same question which was considered by the learned Judge, Mr. Justice Fletcher, namely, whether the Court should require the Controller to restore the design to the register On the ground that the design was " new and original.

9. Now, the findings of the learned. Judge on this part of the case are as follows: First of all, he points out that "the judgment of the Controller turned on the question as to whether there was any novelty in the key-holes and buttons which are used for fastening the band to the wrist." The applicant seems to have been rather doubtful as to the ground on which he ought to have based his case, and the point that was urged before the Controller has not been urged before us. Obviously it could not be because there was no novelty or originality in the fattening of this particular band. That is clear upon the evidence. But it is not "unimportant to notice. Apparently,- this was the main point which the Controller had, before him when Messrs. Boseck & Co. were objecting to the registration; and, if that was the main ground relied upon for novelty and originality, I can quite understand that the Controller came to the conclusion that there was no novelty, or originality. When this matter was before the learned Judge, one of the grounds on which the appellant relied was that there was flattening of the band. The learned Judge based his decision, to some extent at all events, upon the fact that he was convinced that there was nothing in that point and that the flattening did not really exist and that it only came into existence when the band was fitted on to the watch, and that by reason of the manner in which it was fitted to the watch a certain amount of flattening must take place. He did not base his judgment upon that ground alone, but he came to the conclusion that having regard to the shape and configuration of the bracelet which was produced before him in Court there was nothing new or original in the design which was relied upon. Before considering that point, which is the real point at all events as regards the merits of this case, I think I ought to point out that the learned Judge came to certain definite findings; first, he held with regard to this band which I may, for the sake of convenience, call the "Novelty" band, that prior to its introduction the evidence establishes that a plain metal band of uniform width in one piece passing through the loops of the watch had not been used in connection with wrist watches; secondly, that shortly after the "Novelty" band had been introduced, Messrs. Boseck & Co. copied it; thirdly, that on a threat of legal proceedings they applied to the Controller to remove the design from the register, which the Controller, after hearing the parties, did; fourthly, that the

evidence also shows that when the "Novelty" band was introduced, it had a large and immediate sale; and, fifthly, that there was produced before him, as there had been before the Controller, a bracelet which, it was said, was an anticipation of the petitioner's design. Then he describes the bracelet as follows; "The bracelet consists of a plain metal band of gold of uniform width fastened in exactly the same method as the Novelty" band. In this metal band are two (it ought to be three) small holes pierced so as to allow a pearl ornament to be affixed thereto by screws. The object, of course, is for this to be used as an ornament. This bracelet is one of a pair manufactured by Messrs. Cooke and Kelvey of this city, and which they have had in stock for about 5 years prior to August 1915. There is other evidence of the manufacture and sale of other similar bands, but I am not satisfied that the evidence on that point is reliable." Then he goes on to say: "The case must, therefore, stand or fall on the bracelet produced by Messrs. Cooke and Kelvey" (that is, this bracelet which I have now in my hand), "It has been decided in a series of cases that the test of novelty is the eye of the Judge. He must place the two designs side by side and see whether the one for which novelty is claimed is new." I entirely agree with the principle which is laid down by the learned Judge. The matter, of course, to a very large extent, is a matter of first impression, inasmuch as it depends upon the view a Judge looking at the article in question takes, when comparing it with the other article which is said to be an anticipation.

10. In my judgment, the shape and configuration of the metal band taken by itself cannot be said to be new or original. I have the "Novelty" band before me and the bracelet which was produced by Messrs. Cooke and Kelvey. It is true that it is not of the same size, that is to say, it is narrower than the bracelet, and not of the same dimensions; but as regards the shape and the configuration, I confess I cannot see anything new or original. It is conceded that the fastenings are similar and that the method of the fastening has been known in the trade for a considerable time. But that does not conclude the matter. The real point in this case, in my judgment, arisen in connection with the user of this metal band: and I have to ask myself the question whether the application of the "Novelty" band was in respect of an object analogous or kindred to the bracelet: or to put it in another way, was the metal band intended for such a different purpose and for a use so dissimilar that the design may be held to be new or original, I think the case of *Clarke's Design, In re* (1896) 2 Ch. 38 : 65 L.J.Ch. 629 : 74 L.T. 631 lays down quite clearly what the test in matters of this kind is. In the judgment of Lord Justice Lindley, at page 45, he dealt with the case which had been decided by Mr. Justice Chitty [*Read & Gresmell's Design, In re*. (1889) 42 Ch.D. 260 : 58 L.J. Ch. 624 : 61 L.T. 450 : 38 W.R. 88] and then with reference to that he said as follows: "In this last case, Chitty, J., said that; to be capable of being registered a design must be new or original in fact and not, as is suggested, new or original as to some particular class of goods. It cannot be said to be new and original if it is already being applied to articles of an analogous character" (that is a quotation from Mr. Justice Chitty's judgment). The learned Judge was

obviously referring to the classes of goods mentioned in the schedule to the designs rules, and the words referring to articles of an analogous nature show that the learned Judge did not intend by the words "new or original in fact" to decide that a design must be new or original in the sense of never having been seen before as applied to any article whatever. In *Walker, Hunter and Co. v. Falkirk Iron Co.* (1887) 4 R. PC. 390 : 14 R. 1072 : 24 Sc. L.R. 750 and *Hecla Foundry Co. v. Walker, Hunter and Co.* (1889) 14 A C. 550, a design for the shape of an iron "furnace-door was protected, although wooden doors of the same shape for side boards and other articles of furniture were old. The things shaped were for such different purposes and their uses were so dissimilar that the design for one of such things was held to be new or original, although it was old for the other. What "then is the test to be applied to a case such as that before us? The design must be new or original with reference to the kind of article for which it is registered, meaning by, kind of article, not the class of article mentioned in the schedule to the rules, but the kind of article having regard to its general character and use." Then he proceeds to give well known instances: "A design may be new for a coal-scuttle, but not for a bonnet." Now, that being the test, I formulate the question which I have, to put to myself, having regard to its general character and use, was the ""Novelty" band, for a purpose so different from, and for a use so similar to, the purpose and use of the bracelet that the design may be said to be new and original. To my mind the purpose and use of the band are entirely different from the purpose and use of the bracelet. The "Novelty" band is intended to attach a watch to the " wrist. The object of wearing a watch on the wrist is generally different from that of wearing a bracelet,-one is for a useful purpose and the other is ornamental. It was pointed out in argument, and I think based upon evidence, that the leather straps which had been generally used for the purpose of attaching a watch to the wrist, were unsuitable to such a country as this, or in fact to any other country of hot climate, and consequently this band-the "Novelty" band- which was introduced had become a very useful article, and, as appears from the evidence, had, to use the words of the learned Judge, "a large and immediate sale." There may be a few cases where the articles (the watches) are so ornamental that they are worn more as ornaments than as articles of use but I think they are the exceptions and not the rule: and in my judgment this "Novelty" band which was made an exhibit in the, case is not the kind of band which would be- ordinarily used for an ornamental watch.

11. It is said by the learned Counsel for Messrs. Boseck & Co. that utility is wholly immaterial. So it is in one sense, that is to say, the Statute applies to all designs, whether they add to the utility of the articles to which they are applied or not. "But in considering the purposes and uses of the article in question for the sake of considering whether they are analogous or kindred to the purposes and uses of the article which is said to be the anticipation, I think it is legitimate to take into consideration that one purpose is ornamental and the other is useful. In addition to that which I have already mentioned there are other facts which to

my mind are significant. The fact that as soon as this article was produced there was a large and immediate sale, is strong evidence that it was novel and original: then there is the fact that Messrs. Boseck & Co shortly after its production, adopted and copied it and put it in their catalogue on the top of one of the first pages (the catalogue was produced before us). Farther, there was evidence of well-known people in the jewellery trade who described the "Novelty" band as a novelty. The result is that all these facts lead me to the conclusion that although in view of the bracelet produced by Messrs. Cooke and Kelvey, the shape of the "Novelty" band by itself, cannot be said to be new and original, the application of it to a watch to be worn on the wrist was for a purpose so different from " and for a use so dissimilar to the purpose and use of the barcelet that the design in question may be said to be original.

12. For these reasons, I think, that the appeal should be allowed and the application of the 22nd of February 1916 granted.

13. In my judgment, the Controller ought to pay his own costs of the proceedings" before Mr. Justice Fletcher and this Court, and Messrs. Boseck & Co. ought to pay the costs of the appellant in respect of the hearing, so far as the merits are concerned, before Mr. Justice Fletcher, and the appellant ought to have the costs of this appeal with the exception of one day which was taken up in the argument with respect to the preliminary point, as to which there ought to be no costs before us. The costs will be on the basis as "of hearing."

14. I should myself like to say before parting with this case, that I am indebted to the learned Counsel engaged in the case for their able arguments and for the assistance they have given me in this matter.

John Woodroffe, J.

15. This application was made u/s 45 of the Specific Relief Act. It is not, in my opinion, barred by Section 64 of the Designs Act. The action of the Controller was not justified by Section 62 of that Act. We have then to see whether the application is justified on the merits. Mr. Justice Fletcher seems to have dealt with the question as one u/s 64 of the Designs Act. But the appellant does not admit that that section applies, for," if it did, he could not get relief u/s 45 of the Specific Relief Act. His case is that the merits are to be entered into under the provisions of Section 45, under which provision the application is made.

16. As to the merits, in my opinion, the appellant has established his case. There is no question, I think, that it is a good design. It is found as a fact that it had never been previously applied to wrist watches and the fact that it had an immediate and lucrative sale strongly indicates that the article sold was a useful novelty. It was also copied by Messrs. Boseck and Co. and inserted in their catalogue, and there given the first place. The case before Mr. Justice Fletcher was decided practically on one ground and one ground only, and that was that the design in question was not new, in that it had been anticipated by a bracelet of Messrs. Cooke and Kelvey which they had held in stock for about 5 years prior

to August 1915; the learned Judge after finding several points in favour of the applicant then says that "the case must stand or fall on the bracelet produced by Messrs. Cooke and Kelvey."

17. It has been argued by Mr. James that the band of the bracelet produced, by Messrs. Cooke and Kelvey is not the same as the band of the design in question, Assuming for the sake of the argument, without deciding the point, that it is the same there is, I think, novelty in applying what on this assumption is an old thing to a new use. If that is so, the design should be protected, provided it is not merely, to use the words of the cases, analogous. The present case does not seem to be within the proviso, though it may be that class divisions do not necessarily determine whether one case is analogous to another; it seems to me that the fact that articles are in different divisions is a matter of some account." However this may be, in the present case we have here different purposes and different uses. A wrist band used to carry an ornament such as that produced by Messrs. Cooke and Kelvey and a wrist band to carry a watch do not appear to me to be so analogous as to deprive the applicant of his claim to novelty. Further, the band is in my opinion, original and differs from the other band produced by its circular shape according, to which it passes at the back of the watch, and as a consequence of that, produces a flattening which is referred to in the evidence.

18. In my opinion, therefore, the appeal succeeds and the applicant is entitled to the order which he sought.