
(2005) 08 CAL CK 0041
In the Calcutta High Court
Case No : AID No. 1 of 2005

Gopal Glass Works Ltd.

APPELLANT

Vs

Assistant Controller of Patents and Designs and Others

RESPONDENT

Date of Decision : 17-08-2005

Acts Referred:

Copyright Act, 1957 — Section 2
Designs Act, 1911 — Section 51A
Designs Act, 2000 — Section 19, 19(2), 2, 36, 4
Penal Code, 1860 (IPC) — Section 479
Trade and Merchandise Marks Act, 1958 — Section 2(1)

Citation : (2007) 1 CALLT 290 : (2006) 3 CHN 188 : (2006) 33 PTC 434

Hon'ble Judges : Indira Banerjee, J

Bench : Single Bench

Final Decision : Allowed

Judgement

Indira Banerjee, J.—The Court: This appeal u/s 19(2) read with Section 36 of the Designs Act, 2000, hereinafter referred to as the said Act, is from an order dated 20th September, 2004 of the Assistant Controller of Patent and Designs, being the respondent No. 1, directing cancellation of Design No. 190336 registered in the name of the appellant.

2. The appellant claims to carry on business inter alia of manufacture and marketing of figured and wired glass sheets since 1981. The appellant claims to be the originator of new and original industrial designs, applied by mechanical process, to glass sheets.

3. According to the appellant the glass sheets have eye-catching shape, configuration, ornamental patterns, get up and colour shades and the same are registered and/or are awaiting registration as industrial designs under the Designs Act, 2000 and/or the rules framed thereunder.

4. For production of glass sheets of the design registered as Design No. 190336, two rollers are required. The rollers are manufactured by M/s. DORN BAUSCH

GRAVUREN GMBH of Germany, hereinafter referred to as the German Company. According to the petitioner the rollers are not only used for manufacture of glass sheets, but for various other articles including plastic, rexin and leather.

5. The appellant claims to have placed orders on the German Company, for supply of the rollers for launching a design of figured glass with new and novel features, not produced before by any one else.

6. On or about 29th October, 2002 the appellant applied to the Controller of Patent and Designs u/s 51 of the Designs Act, 2000, hereinafter referred to as the said Act, for registration of the said design in Class 25-01. The said design was duly registered on 5th November, 2002 and was to remain valid for a period of 10 years from date of its registration.

7. The appellant claims exclusive copyright in India, in the said design applied to glass sheets. According to the appellant, no other person has any right to apply the said design to glass sheets, in violation of the exclusive copyright of the appellant, on the said design on glass sheets.

8. The appellant has been marketing glass sheets of the said design under the name of Diamond Square which according to the appellant, has become popular amongst customers soon after its launch in the market. The appellant has relied on a statement of sales figures for the period from December, 2002, to February, 2004 in support of its contention of popularity of and demand for glass sheets of the said design.

9. After registration of the said design the appellant issued a notice dated 21st May, 2003 cautioning other manufacturers from infringing copyright of the appellant in respect of the said registered design.

10. It is alleged that the respondent No. 2 and/or its associate IAG Co. Ltd. started imitating the said registered design, as a result whereof the appellant was constrained to file a suit being Civil Suit No. 1 of 2004 against the respondent No. 3 and its associate IAG Co. Ltd. in the District Court at Mehsana. The appellant obtained an interim order of injunction restraining IAG Co. Ltd. from infringing the copyright of the appellant in the said registered design.

11. In the meanwhile, the respondent No. 3 as counterblast to the aforesaid notice, filed an application u/s 19 of the said Act, before the respondent No. 1 for cancellation of registration of Design No. 190336 in the name of the appellant, mainly on the ground of prior publication of the design in India and abroad and on the ground of the design not being new or original.

12. The respondent No. 3 relied on inter alia a catalogue of the German Company, a letter dated 10th September, 2003 of the German Company addressed to M/s. IAG Co. Ltd. stating that the said German Company had developed Design No. 2960-9010 in the year 1992, and a document downloaded from the internet from the official website of the Patent Office of the United Kingdom on 22nd September, 2004 which shows that the same design had been

registered in the United Kingdom in the name of M/s. Vegla Vereinigte Glaswerke Gmbh some time in 1992.

13. The appellant filed evidence by way of an affidavit stating that the German Company is engaged in the manufacture of engraving rollers and no other goods. There is, in fact, no dispute on that issue. It is nobody's case that the German Company is engaged in manufacture of goods other than engraving rollers. In any case the German Company does not apply the design engraved in its rollers to glass sheets.

14. The appellant also relied on a letter dated 4th March, 2004 of the German Company confirming that the embossing roller covered by Design No. 2960-910 had been sold to the appellant on the condition that all user rights available in India under Indian Laws would vest exclusively in the appellant and that the appellant would be entitled to exclusive user rights for at least five years. The letter reveals that the German Company was aware of registration of Design No. 190331 and had no objection to the same.

15. A Liaison Executive of the appellant also filed an affidavit stating that he visited Germany, and upon enquiry ascertained that M/s. Vegla Vereinigte Glaswerke Gmbh had never manufactured glass sheets of the design registered as Design No. 2022468 in the United Kingdom.

16. In the proceedings before the respondent No. 1, the appellant questioned the admissibility of the materials alleged to have been downloaded from the United Kingdom Patent Office website, in evidence, in the absence of any corroborative evidence regarding the authenticity of the same.

17. It was emphatically argued that the German Company did not apply the design in question on glass sheets. The catalogue of the German Company did not depict the application of the design on glass sheets. As such the catalogue as also the letter of the German Company dated 10th September, 2003 to M/s. IAG Company Ltd. were of no relevance.

18. The respondent No. 1 framed three issues. The first issue was whether the design was not new or original in view of the fact that the design had been published before the date of registration and the registered proprietor was not the owner of the design. The second issue was whether the design had been published outside India as well as in India, prior to the date of application and the third issue was whether the registered design was in public domain due to sale/use of the design prior to the date of application of the registered proprietor.

19. By the impugned order dated 20th September, 2004 which is under appeal, the respondent No. 1 ordered the cancellation of registration of Design No. 190336. The first two issues were decided against the appellant. The third issue was not adjudicated since the evidence by way of affidavit filed by the applicant for cancellation was not taken on record for technical reasons.

20. The relevant findings of the respondent No. 1 are extracted hereinbelow:

...the impugned design was applied to a glass sheet from the roller bearing the Design No. 2960-910 and the said roller bearing design was sold and delivered by M/s. Dornbusch Gravuren GmbH on 04.09.2002 to the registered proprietor with the condition that the exclusive user right in favour of the purchaser shall be in force for a period of five years from the date of supply. It is also evident that the roller bearing design 2960-910 was created by said M/s. Dornbusch Gravuren GmbH in 1992 and delivered for the first time in 1993 and the said roller which, churns out the impugned design, was not specifically developed by the registered proprietor.... The registered proprietor has purchased the embossing roller, which is available as commodity and used the same roller and embossed the impugned design over the glass sheet and got it registered. This in turn, infers that registered proprietor has not applied any inventive ingenuity over the same. "A design to be registrable must be new and original. Novelty alone is not sufficient. There must be substantial originality as well substantial novelty, and even if there is bare novelty, but there is insufficient originality, then the application for registration ought not to be allowed to proceed." Caron International's Design Application (1981) RPC 179 at page 184 from P. Narayanan on Copyright and Industrial Designs, Second Edition at page 373, at Para 27.46. Therefore, I am of the opinion that the impugned design is not new or original and published prior to the date of registration....

...I am of the opinion that since there is no specific definition of publication given in the Designs Act, 2000, any document, which is freely made available to the public or it is shown or disclosed to the member of public, it is treated as publication. However, regarding the authenticity of the document which is downloaded from the Internet, I am of the view that since document is downloaded from the official website of UK Patent Office, it should be taken as authentic. Any person can take copies of the said document from the said office. Moreover, on visual comparison of the UK registered design number 2022468 with the impugned design 190336, I am of the view that both the designs make same appeal to the eye and there is sufficient resemblance between the two designs, therefore, the impugned design is taken as prior published and thereby not new or original as per Section 4 of the Designs Act, 2000. On this issue of comparison, the registered proprietor has failed to indicate any difference in UK design Number 2022468 with respect to the impugned design. Regarding the issue of the existence of the proprietor of the UK design as raised by the Counsel of registered proprietor I am of the opinion that the question of existence of proprietor as on date is immaterial and is not a matter to be judged by the Tribunal. The design was registered by the UK Patent Office way back in 1992 and the period for protection expired on 22.04.2002.

21. The question in this appeal is whether the conditions for cancellation of a registered design existed in the facts and circumstances of this case. In other words, was the respondent No. 1 justified in arriving at his above extracted findings, on the basis of the materials on record and having regard to the present law with regard to designs.

22. In the context of the issues involved in this appeal, it is necessary to advert to the relevant provisions of the Designs Act, 2000 set out hereinbelow:

2. Definitions.- In this Act, unless there is anything repugnant in the subject or context,-

(a)"article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural, and includes any part of an article capable of being made and sold separately;

(b) ...

(c)"copyright" means the exclusive right to apply a design to any article in any class in which the design is registered;

(d)"design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in Clause (v) of Sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in Section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in Clause (c) of Section 2 of the Copyright Act, 1957 (14 of 1957);

(e) ...

(f) ...

(g) "original", in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;

(h) ...

(i) ...

(j) "proprietor of a new or original design",-

(i) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed;

(ii) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(iii) in any other case, means the author of the design; and where the property in or the right to apply, the design has developed from the original proprietor

upon any other person, includes that other person.

3. ...

4. Prohibition of registration of certain designs.-A design which-

(a) is not new or original; or

(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration, or

(c) is not significantly distinguishable from known designs or combination of known designs; or

(d) comprises or contains scandalous or obscene matter, shall not be registered.

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 considered the report of the examiner on such reference.

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 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 of 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.

11. Copyright on registration.- (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period often years.

19. Cancellation of registration.- (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:

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

(b) that it has been published in India or in any other country prior to the date of registration, or

(c) that the design is not a new or original design, or

(d) that the design is not registrable under this Act, or

(e) that it is not a design as defined under Clause (d) of Section 2.

(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.

23. In enacting the Designs Act, 2000, hereinafter referred to as the 2000 Act, which has repealed the Designs Act, 1911, earlier in force, Parliament has consciously made changes in the law, pertaining to the registration of designs, some of which are relevant to the questions involved in this appeal.

24. Some of the notable changes made by Parliament are addition of "or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms" in the definition of design, the insertion of

the definition of original, the inclusion of part of an article capable of being made and sold separately" in the definition of article and inclusion in the definition of proprietor of new or original design, of persons to whom the property in or the right to apply the design might have devolved from the original proprietor.

25. Section 4 of the Designs Act expressly prohibits registration of design which is not new or original, a design, which has been disclosed to the public anywhere in India or any other country, by publication in tangible form, or by use or in any other way, prior to the filing date or where applicable the priority date of the application for registration; a design which is not significantly distinguishable from known designs; and a design which combination of known designs or comprises or contains scandalous or obscene matter. There was no provision in the Designs Act, 1911 corresponding to Section 4 of the 2000 Act which expressly prohibited the registration of any design. Section 4 restricts publication whether in India or in any other country to publication in "tangible form".

26. Section 51A of the Designs Act, 1911 which more or less corresponds to Section 19 of the 2000 Act provided as follows:

51A. Cancellation of registration,-(1) Any person interested may present a petition for the cancellation of the registration of a 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 the 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.

27. u/s 19 of the 2000 Act, a person interested might present a petition for the cancellation of the registration of a design, at any time after registration of the design on the ground that (a) the design has been previously registered in India or (b) it has been published in India or in any other country prior to the date of registration, or (c) the design is not a new or original design, or (d) the design is not registrable under the Act, or (e) that it is not a design as defined under Clause (d) of Section 2.

28. It is significant that prior to the enactment and enforcement of the 2000 Act prior registration or publication of the design in India was a ground for cancellation of a registered design, but not prior registration or publication abroad. Parliament in its wisdom deemed it expedient to add prior publication in

a country other than India as a ground for cancellation of a registered design, but not registration in a country other than India.

29. Parliament has thereby consciously differentiated between prior registration in India and prior registration abroad. No such difference has, however, been made in the case of prior publication. Prior publication either in India or abroad is a ground for cancellation of a registered design.

30. Under the law presently in force in India, specifications, drawings and/ or demonstrations in connection with registration of a design do not per se constitute publications which prohibit future registration of that design. Had publication of design specifications by a registering authority, particularly a registering authority in a foreign country, in connection with registration of a design, in itself, amounted to prior publication, that would hit all future applications in India for registration of designs, prior registration in India would not separately have been made a ground for cancellation of a registered design. Moreover, it is significant that Parliament consciously, made publication in a country other than India a ground of cancellation, in addition to publication in India, but expressly restricted the embargo of prior registration to registration in India. Registration in a country other than India has not been made a ground for the cancellation of a registered design.

31. The respondent No. 1 held that Design No. 190336 was not new or original and had been published prior to the date of its registration. The respondent No. 1 arrived at the aforesaid finding in view of the fact that the roller which churned out the impugned design had not specifically been developed by its registered proprietor.

32. The respondent No. 1 found that the registered proprietor, that is, the appellant, had purchased the embossing roller which was available as a commodity and used the same roller to emboss the impugned design on glass sheets. The respondent No. 1 therefore deduced that the appellant had not applied any inventive ingenuity in conceiving the impugned design.

33. The respondent No. 1 failed to appreciate that a design is solely judged by the eye. The visual appeal of a pattern, ornament or configuration on leather or rexin would not be the same as the visual appeal of that pattern, ornament or configuration on glass.

34. In order to destroy the novelty of a design registration, prior disclosure whether by publication or use or any other way, must be of the pattern, shape and/or configuration applied to the same article. The use of the embossing roller, to emboss a pattern ornament or configuration on a glass sheet, a material totally different in composition, nature, fragility, durability and look from leather, rexin or even plastic, in itself, involves inventive ingenuity.

35. In the case of *Gammeter v. Patents. Design Controller*, reported in AIR 1919 Cal 887, relied upon by Mr. Sudipto Sarkar appearing on behalf of the appellant,

Division Bench held as follows:

...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.

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 bracelet that the design in question may be said to be original.

36. Design is defined in the 2000 Act to mean the features of shape, configuration, pattern, ornament or composition of line or colours applied to any article whether in two dimensional or three dimensional or both forms, by any industrial process of means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle of construction, or anything, which in substance is a mere mechanical device.

37. The embossing rollers manufactured by the German Company are only the device for producing the impugned design. It is immaterial that the embossing rollers were not developed by the appellant. Furthermore, in relation to designs, the expression "original" include designs which though old in themselves are new in their application. The brochures of the German Company do not contain any photograph or illustrations of the impugned design on glass.

38. The respondent No. 1 has apparently not considered the definition of "original" in Section 2(g) of the 2000 Act. The reasoning on the basis of which the respondent No. 1 arrived at his impugned finding that the design was not new or original is misconceived.

39. The next question, in issue before this Court, is whether the finding of the respondent No. 1 that the document downloaded from the internet from the website of the Patent Office of the United Kingdom, might be taken as prior publication of the impugned design, is legally sustainable.

40. It is true that publication has not been defined in the 2000 Act. Yet, for reasons discussed above, mere publication of design specifications, drawings and/or demonstrations by the Patent Office of the United Kingdom, or for that matter, any other foreign country, in connection with an application for registration, would not, in itself, amount to publication that would render a design registered in India liable to cancellation.

41. To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication would have to be, in tangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article, with the same visual effect would be sufficient.

42. When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration.

43. If the visual effect of the pattern, the shape or the combination of the pattern, shape, dimension, colour scheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design.

44. In the case of *Rosedale Associated Manufacturers Ltd. v. Airfix Ltd.*, reported in 1957 RPC 239, Lord Evershed M.R. held as follows:

In this respect the test of prior publication of an alleged invention, should, in my judgment, be no less applicable in the case of a registered design, and as regards the former, I venture to cite once more the oft-quoted language of Lord Westbury in *Hills v. Evans* : "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments." By a like reasoning, to my mind, if a document is to constitute prior publication, then a reader of it, possessed ordinary knowledge of the subject, must from his reading of the document be able, at least, to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head.

45. The illustrations in the form of drawings downloaded from the website of the United Kingdom Patent Office depict the patterns that may be applied to glass sheets. The patterns may be same but the illustrations do not give the same visual effect as the samples of the glass sheets produced by the appellant in Court. There are also no clear unmistakable instructions or directions for production of glass sheets of the pattern illustrated.

46. The visual effect and/or appeal of a pattern embossed into glass sheets by use of embossing rollers could be different from the visual effect of the same pattern etched into glass sheets manually. The respondent No. 1 has not considered these factors.

47. The order impugned considered with the materials on record, including in particular the computer print-outs clearly reveals that the respondent No. 1 has only compared the pattern and/or configuration and considered the visual appeal

thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, the respondent No. 1 has not considered the visual appeal of the finished product.

48. There are no material on record to show that the design had previously been applied to glass sheets. On the other hand, an affidavit was sworn on behalf of the appellant by a Liason Executive affirming that he had ascertained that the proprietor of the design registered in the United Kingdom had never manufactured glass sheets of the design registered.

49. For the reasons discussed above, the impugned order cannot be sustained. The appeal, therefore, allowed and the impugned order is set aside and quashed.

50. All parties are to act on the signed copy of the minutes of the operative part of this judgment and order on the usual undertakings.