

(1999) 07 DEL CK 0118

In the Delhi High Court

Case No : I.A. No. 4614 of 1997 in Suit No. 1065 of 1997

Hello Mineral Water Pvt. Ltd.

APPELLANT

Vs

Thermoking California Pure

RESPONDENT

Date of Decision : 20-07-1999

Acts Referred:

Designs Act, 1911 — Section 2(5)

Citation : (2000) 56 DRJ 700

Hon'ble Judges : S.N. Kapoor, J

Bench : Single Bench

Advocate : S.C. Chadha, for the Appellant; Kanchan Singh, for the Respondent

Judgement

S.N. Kapoor, J.—In this case, plaintiff claims that he has a registered design under Certificate of Registration of Design No. 171327 dated 13th May, 1996 and the photocopies thereof are already on record at pages 4 to 8. The grievance of the plaintiff is that the defendants are infringing his copyright by using the same design in respect of Water coolers. The plaintiff claims that he has sold goods up to May, 1997 worth Rs. 2,20,71,976 and has built up the goodwill in respect of water coolers. The defendant introduced his product through publicity by sending pamphlets of water coolers in the month of May, 1997 which is an obvious imitation. Earlier also, the same defendant used the bottles of the plaintiff company and on filing of the suit, this Court restrained the defendant by order dated 9th January, 1997. The learned counsel for the plaintiff in respect of his submissions relies upon the report of the Local Commissioner wherein it is stated that defendant has not manufactured the water cooler of its design but 100 pamphlets were found with the defendant. Consequently, the plaintiff seeks an interim injunction for restraining the defendants from using the design in any manner.

2. The case of the defendant is that there is no novelty in the design for it was already known and was being used in the market in India as well as abroad. Consequently, the plaintiff cannot claim any monopoly by virtue of the

registration. It is also claimed that the plaintiffs is neither the originator nor inventor of the design. It is further contended that the plaintiff cannot seek injunction for the design is of recent date where damages would be sufficient remedy in case of plaintiff succeeding in the suit.

3. Having heard the parties counsel, it would be appropriate here to reproduce the definition of "design" as used in Sub-section (5) of Section 2 of Designs Act, 1911. It reads as under:

"(5) "design" means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or Chemical, separate or combined, which in the finished article appeal to end are judged solely by the eye ; but does not include any mode or principle of construction or anything which is in substance a more 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."

4. It would also be relevant to refer to the definition of the term "copyright" as given in Sub-section (4) of Section 2 of the Act. It reads as under:

"(4) "Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered."

5. There cannot be any dispute about the legal proprietor that under Sub-section (3) of Section 46, the register of designs shall be prima facie evidence of any matters by this Act directed or authorised to be entered therein. According to Section 47, the registered proprietor of the design shall, subject to the provisions of the Act, have copyright in the design during five years from the date of registration and he shall also have an exclusive right to apply a design to any article in any class in which the design , is registered. Section 53 of the Act undisputedly makes it unlawful for any person to apply the design or its fraudulent or obvious imitation or cause it to be applied to any article in any class of goods in which the design is registered.

6. On the basis of the above said legal proposition, the learned counsel for the petitioner has submitted that once a design is registered, it is only the registered proprietor who could lake benefit of the registered design during the period of validity of the registration and none else. It is also contended that registered design is not even open to inspection in order to maintain the secrecy and to destroy or belittle sanctity of the design by any body except the proprietor or a person authorised by him in this behalf. Consequently, once the design is registered, the registered proprietor can insist that any one committing piracy should be restrained from doing so, for the purpose of the Designs Act is to protect a novelty in the design to be applied to a particular article to be marketed commercially. This protection is primarily intended to advance industries and to keep high level of competitive progress. The learned counsel for the plaintiff relies on Mohammad Abdul Karim Vs. Mahammad Yasin, , Sat Paul Singh v. S.P.

Engineering Works Meerut 1982 PTC 193 Castrol India Ltd. v. Tide Water Oil Co. (I) Ltd 1996 (16) PTC 202, Alert India v. Naveen Plastics (1997 (17) PTC 15.

7. On the other hand, the submission of the learned counsel for the defendant is that in fact the design of the water dispenser has been taken by the plaintiff from the designs prevalent in the other advanced countries of the world and applied with minor superficial variations in India much prior to the registration of plaintiff's design. It is generic in nature like the designs of airconditioners, refrigerators, washing machines etc. Consequently, the plaintiff cannot claim to be the originator of the said design. There is neither any newness nor anything inventive about the design of the plaintiff and where the design in question is one with superficial variations of a pre-existing design then its registration is liable to be cancelled. The contention of the plaintiff that the only remedy open to the defendant is to apply for the cancellation of the design of the plaintiff under the Designs Act is also ill-founded for, no injunction is to be granted. According to the learned counsel for the defendant where the design is of a recent date and where damages would provide an adequate remedy in case of plaintiff succeeding in the suit, the plaintiff is not entitled to injunction prayed for. Learned counsel for the defendant relies on the following cases in support of his contention that the plaintiff himself is not an originator and he is not entitled to the injunction prayed for; Ravinder Kumar Gupta Vs. Ravi Raj Gupta and Others, , Prem Singh Vs. Ceeam Auto Industries, and Niki Tasha India Pvt. Ltd. Vs. Faridabad Gas Gadgets Pvt. Ltd., .

8. As regards the originality and novelty of design, from the side of the defendant, numerous pamphlets have been filed indicating cylindrical features of the mineral water coolers not only of the plaintiff but "FREEDOM" of Drink well India Private Ltd., "DIAMOND" COLD/HOT Water Dispensers. However, except the submission of learned counsel for the defendant, there is nothing to indicate on the file that it was so. But at the same time, the plaintiff in his replication about such designs stated that the plaintiff is the first one to design the particular type of water dispensing machine/cooler. It is not a trade variant for original and new design. While admitting the existence of the pamphlets filed by the defendant, the plaintiff claimed that the defendant has not placed on record water dispensing machines prior to the registered design of the plaintiff. The plaintiff has surveyed the market and these companies, pamphlets of which are on record, manufacturing of mineral water dispensing machines/coolers. Consequently, at this stage in the absence of any specific evidence, it is not possible to say prima facie that the water coolers of similar design are being sold in the market or not.

9. It also appears that insofar as the cylindrical shape is concerned, there is no novelty for the novelty does not lie in just shape of this kind or the other, it is something much more. Novelty as defined in Blacks Law Dictionary reads as under:

"In order that there may be "novelty" so as to sustain a patent, the thing must

not have been known to any one before ; mere novelty of form being insufficient."

10. Accordingly, mere novelty of form or shape is insufficient. Novelty involves the presence of some element or new position of an old element in combination, different from anything found in any prior structure. Secondly, in even cylindrical shape, there may be different shapes. The test is to consider and look at the design in question with an instructed eye and say whether there was or not such a difference between the which has been published previously, and the registered design as to entitle the proprietor. However, the colour combination, the location of the cup holder and brand labels may give an impression that it may or may not be a copy of the design of the plaintiff. But there may be some reasonable apprehension about passing off the goods. Submission of the learned counsel for the defendant that these water coolers are purchased not always by illiterate persons and as such, similar type of cylindrical water coolers were available in the market is also not an irrelevant consideration.

11. The learned counsel for the defendant at this stage states that the defendant undertakes to remove the cup holder and place it differently and of different design ; use the different kind of water tap ; colour though may remain white but of different shade; and bolder brand names in order to avoid giving any impression that it is either a copy of the design of the plaintiff or it is an attempt to pass off his goods. As regards the red and blue, colour of part of water taps, learned counsel for the defendant submits that it is universally used colour and there is nothing specific and the taps are of totally different designs.

12. In *Niky Tasha v. F.G. Gadgets Pvt. Ltd.* (supra), a Division Bench of this Court took the view that "an interlocutory injunction will not normally be granted where damages will provide an adequate remedy should the claim succeed, "where the design is of recent date" and "more so when there is serious question as to the validity of the design."

13. In view of the submissions made and undertaking given by learned counsel for the defendant during arguments, I feel that while the defendants may use the cylindrical shape of his water coolers, he would use different colour combination, at least of different shade, place the cup holder of different design at different place so that the consumers are not misled. The defendant shall also use bolder brand name indicating . its name at different place than at the place at which it is being shown by the plaintiff. In view of the statement of the learned counsel for the defendant, I feel that it would be appropriate to dispose of the application further subject to two following conditions :

(i) The defendant shall continuously submit quarterly statements of manufacture and sale of the water cooler using the same design; and

(ii) The defendant shall be given an undertaking that in case the suit is decreed in favor of the plaintiff, he shall pay 15% of the gross sale proceeds to the plaintiff within six months.

14. The application is disposed of accordingly.

15. List the matter on 2nd November, 1999 before Joint Registrar for admission/denial of documents.