

(2012) 04 MAD CK 0127
In the Madras High Court
Case No : A.S. No. 433 of 1999

Indecon Structural Pvt. Ltd.

APPELLANT

Vs

Ultra Tiles Pvt. Ltd., Chennai-600083

RESPONDENT

Date of Decision : 12-04-2012

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 2 Rule 2, Order 2 Rule 3, Order 23 Rule 1(3), Order 23 Rule 1(4)
Copyright Act, 1957 — Section 13, 15, 15(2), 2(c), 2(c)
Designs Act, 1911 — Section 2(5), 2(d), 51A

Citation : (2012) 5 MLJ 61 : (2013) 54 PTC 466

Hon'ble Judges : V. Periya Karupiah, J

Bench : Single Bench

Advocate : Sundar, for the Appellant; Prabhakar Reddy, for the Respondent

Judgement

V. Periya Karupiah, J.—A.S. No. 433 of 1999: This appeal is directed against the judgment and decree passed by the trial Court made in O.S. No. 1 of 1996 dated 19.6.1998 in dismissing the suit filed by the plaintiff without costs. O.P. No, 328 of 1998: This petition has been filed by the petitioner, seeking for cancellation of registration of design u/s 51-A of the Design Act with regard to the registration of design in Design No. 171127 dated 19.4.1996 under certificate dated 26.12.1996 under Class-4 of Designs Act, 1911, granted in favour of the respondent and for other reliefs.

2. The appellant was the plaintiff and the respondent was the defendant before the trial Court. The said appellant is also the petitioner and the respondent is also the respondent in the aforesaid original petition.

3. A.S. No. 433 of 1999: The case of the plaintiff before the trial Court would be as follows:

3(1). The plaintiff manufactures and markets is different types of tiles under the trade mark "EUROCON TILES" along with various marks Aquarius, Taurus, Regalia, Pisces etc., in combination with trade mark "Eurocon Tiles". The trade

mark "Eurocon Tiles" has been registered under the Trade and Merchandise Marks Act under No. 437663 and this is in force. The plaintiff has executed many prestigious projects for a wide cross Section of clientele and the projects successfully executed and acclaimed include public concourses, hotels, clubs, industrial houses, hospitals etc. The plaintiff is the first pre-polished concrete tile manufacturing company in India to have bagged many prestigious orders from foreign countries such as Singapore, Maldives, Srilanka. The plaintiff has introduced a variety of designer tiles which range from the curved and chamfered, textured and hexagonal to the wavy and ribbed and as such revolutionised and inter-nationalised the tile industry of India.

3(2) The plaintiff has designed a particular variety of tile under the name Aquarius which it is manufacturing since 1992, which has specific application for drive ways, walk ways, gardens, parks, porticos, sit-outs, swimming pool decks etc. The said tile is a uniquely shaped interlocking cement concrete tile. The uniqueness of the shape of Aquarius tiles primarily stems from the curvature which has been designed both on the top and bottom side of the tile. This curvature creates a unique flowing wavy pattern and also performs the function of inter-locking between tiles when they are laid. The plaintiff has designed the said tile by employing enormous skill energy, labour and capital and in fact in view of the uniqueness of shape, design and configuration, the said tiles manufactured by the plaintiff has won widespread public as claim. The plaintiff having designed the said tile, it has become the owner of the copyright in the drawing in respect of the said product with the sole right to produce or reproduce the said drawings or any substantial part thereof in any material form whatsoever to the exclusion of all other persons. The plaintiff being the owner of the copyright in the said drawing, has made an application for registration of the said work under the Indian Copyright Act 1957 claiming user from 1992. The plaintiff is the owner of the copyright in respect of the said drawing and no person is entitled to use the same to manufacture any produce by reproducing the said drawing in three dimensional form or use the said drawing in any other manner whatsoever.

3(3). In view of the uniqueness and novelty of the design of the said tile, the corporation or the city of Madras has awarded a contract to the plaintiff for the aesthetic pavement formation of the famous Marina Beach as part of its Madras Vision 2000 project.

3(4). The plaintiff was shocked and surprised to come across during the third week of December, 1995, tiles of identical shape and design manufactured by the defendants. The said tiles are a substantial reproduction in three dimensional form of the drawing of the plaintiff, in respect of the aforementioned Aquarius tiles of which the plaintiff is the owner as stated above. The defendant has thus ventured to copy the drawing of the plaintiff and has come forward with the final product which is a substantial reproduction in three dimensional form of the plaintiff's drawings. Mr. Krishnamurthy left the services of the plaintiff in

December, 1993 and Mr. Vigneshwar Sunder in February, 1994. Mr. Vigneshwar was incharge of the design and development and Mr. Krishnamurthy was incharge of production at the relevant time, while in the service of the plaintiff. Thus, after resigning from the plaintiff's service, the said persons have ventured to copy the plaintiff's unique drawing and pass off their produce as and for the plaintiff's unique tiles by cashing on the reputation of the plaintiff's product. The defendant taking advantage of the wide acclaim and reputation enjoyed by the plaintiff's, produce is creating confusion in the minds of the public and is causing loss, hardship and injury to the plaintiff which is irreparable and immeasurable. The action of the defendant in reproducing in three dimensional form the plaintiff's drawings in respect of the tiles is as such an infringement of the plaintiff's copy right over the same, entitling the plaintiff to an injunction restraining the defendant from indulging in such illegal acts. The design is designed to deceive and calculated to confuse the public and in fact, the defendant is mis-representing that the products manufactures by it, are those of the plaintiff. Hence, the plaintiff is constrained to file the suit, for permanent injunction and other reliefs.

4. The contentions of the defendant stated in the written statement would be as follows:

4(1). The plaintiff had filed C.S. No. 2084 of 1995 before this Court for identical reliefs in which O.A. No. 1337 of 1995 and 1338 of 1995 also filed for interim injunctions. The plaintiff failing to get any interim injunctions, withdrew the suit on 3.1.1996 without obtaining leave to file a separate suit on the same cause of action. As the cause of action and the subject matter for the present suit are identical, the present suit is barred under Order 23 Rule (1)(4) of CPC, which follows the suit is liable to be dismissed.

4(2). The plaint do not disclose any cause of action, either for the infringement of the copy right as provided in the copyright Act 1957 or for passing off, based on the provisions of the Trade and Merchandise Marks Act 1958. Even as per the allegations in the plaint, the defendant's are not using any Trade Mark which is similar or disceptively similar to that of the plaintiffs' trade mark. No suit for infringement of copyright over the design is maintainable, unless the said design is registered under the Design Act, 1911. The plaintiffs have not registered the design under the Designs Act and therefore the prayer for permanent injunction is not maintainable (para 10 (a)). According to plaintiffs, they have designed the tiles first and there is no specific drawings of the tiles before the tiles are designed. The relief sought for is with regard to infringement of the design and not copyright as provided under the copyright Act. 1957. The plaintiffs have not become owner of the copyright in the drawing in respect of the tiles with the sale right to produce or re-produce the same or substantial part thereof in any material form whatsoever. The said drawing is not original, capable of protection under the Copyright Act. The plaintiffs have also suppressed the date of their filing of the Copyright application.

4(3). The plaintiffs are not the owner of the copyright in respect of drawing as no one can claim any copyright, over a drawing based on a drawing as the same is not original. Even otherwise the copyright in a design which is capable of being registered under the Designs Act, 1911, shall cease as soon as more than fifty articles, with the said design is produced as provided u/s 15(2) of the Copyright Act 1957. The plaintiffs have produced the tiles, with the said design commercially and completed many projects measuring production of more than fifty tiles and hence the plaintiffs copyright if at all, if there is any, shall cease to exist.

4(4). The tiles manufactured in the name of "AKASH" which gives an unique pattern is independently designed by the defendants taking the square as basic geometrical shape. This unique pre-polished concrete tile design of the defendants has its own individual shape, character texture and capable of giving entirely new appeal to the eye totally different from that of the plaintiff's tiles under the name "Aquarius". The plaintiffs tiles are designed taking triangle as the basic geometrical shape. The plaintiffs tiles can only give one particular pattern of laying. On the other hand, the defendants' tiles can give two independent patterns which can be combined and laid together. The defendants tiles in no way resembles the tiles of the plaintiffs whether in the individual tile shape or in the final laid out pattern. The defendants never represented to any of their clients or public that the products manufactured by them are that of the plaintiffs. The defendants have not committed any infringement of the plaintiffs' copyright muchless the infringement of the plaintiffs drawing in respect of the tiles. The plaintiffs are not the owners of the alleged drawings of the "Aquarius" tiles. The defendants are not cashing in on the popularity and also not cutting into the plaintiffs business and making illegal gains. The defendants tile has nothing to do with plaintiffs tile or the drawings of the plaintiffs tile. The defendants have not infringed the plaintiffs copyright over any drawings. The plaintiffs have no copyright in the alleged drawings as it is and therefore the allegation that the defendants are infringing the plaintiff's drawings and reproducing the same in three dimensional form are imaginary and made for the purpose of the case in order to obtain interim injunction so that the business of the defendants could be crippled. The other allegations are untrue, incorrect. Hence, it is prayed the suit may be dismissed with costs.

5. The trial Court had framed the following issues on the aforesaid pleadings for decision/consideration.

1. Whether the defendants have infringed the copyright of the plaintiff?
2. Whether the plaintiff is entitled to injunction as prayed for?
3. Whether the plaintiff is entitled to injunction restraining the defendant from passing off plaintiff's title by copying the plaintiff's drawing?
4. Whether the defendants are liable to surrender their stock of tiles as alleged by the plaintiff?

5. Whether the defendants are liable to render accounts to the plaintiff?
6. Whether the suit is barred under Order 23 Rule (1)(4) CPC?
7. Whether the suit is not maintainable for the reasons stated in para 5 of written statement?
8. To what relief?

Additional issues framed on 24.4.1998 as follows:

1. Whether the plaintiff has the copyright in the drawing of M.O.1 ?
2. Whether such right existed, or it ceased u/s 15(2) of Copyright Act?
6. The trial Court examined the plaintiff's director as P.W.1 and admitted Exhibits A-1 to A-26 and examined the defendant's Director as D.W.1 and admitted Exhibits B-1 to B-10 on his side and also marked M.Os. 1 to 3. After appraising the evidence adduced before it, the trial Court had come to the conclusion of dismissing the suit without costs.
7. Aggrieved against the judgment and decree passed by the trial Court, the plaintiff preferred this appeal on various grounds.
8. On perusal of the pleadings the evidence adduced on either side, the judgment and decree passed by the lower Court and the arguments advanced on either side, I could see that the following points emerged for consideration in the appeal.
 1. Whether the suit is barred as per the provisions of Order 23 Rule 1(4) CPC?
 2. Whether the plaintiff is entitled for permanent injunction against the defendants restraining him from in any manner infringing the plaintiff's copy right over the drawing in respect of the subject tiles by reproducing in three dimensional forms. The said drawings are in any other manner infringing the said drawings?
 3. Whether the plaintiff is entitled for permanent injunction against the defendant restraining him from in any manner passing off the tiles manufactured by the defendant by copying the plaintiff's drawings in respect of the subject tiles either by manufacturing or by selling or any manner advertising the same?
 4. Whether the defendant is liable to surrender the stock of tiles as alleged by the plaintiff?
 5. Whether the defendant is liable to render accounts as sought for?
 6. Whether the suit is maintainable in respect of the infringement of copy right?
 7. Whether the plaintiff has got copy right in the drawing of M.O.1 ?
 8. Whether the right existed was ceased u/s 15 of the Copy Rights Act?

9. To what relief the appellant is entitled?

9. O.P.No. 328 of 1998:

The petitioners case in brief would be as follows:

9(1) The petitioner is the first and the largest manufacturer of pre-polished cement concrete tiles in India and has been carrying on business since 1984. In the course of its business, the petitioner has honestly conceived and adopted a distinctive trade mark "EUROCON" for its tiles and the petitioner manufactures and markets its different types of tiles under the said trade mark "EUROCON", which is used exclusively and also along with certain other marks for the different types of tiles of the petitioner. The petitioner has obtained registration of the said trade mark "EUROCON TILES" under the Trade and Merchandise Marks Act under No. 437663 with effect from 13.5.1985 and the same has been renewed from time to time and is in force. The petitioner submits that it is a pioneer in semi indoor and out door applications and external wall claddings.

9(2) The petitioner has spent substantial sums of money towards sales promotion, publicity efforts and advertisement expenses for popularising its various products under the trade mark "EUROCON" through various media and the expenses incurred by the petitioner in this regard. The petitioner has introduced a variety of designer tiles which range from the curved and chamfered, textured and hexagonal to the wavy and ribbed and as such the petitioner has revolutionised and internationalised the above said tile industry of India.

9(3) The petitioner in the course of his business he has developed a particular variety of tile under the name "AQUARIUS" which it is manufacturing since 1992. This tile has specific application for drive ways, walk ways, gardens, parks, porticos, sit-outs, swimming pool decks etc. The said tile is a uniquely shaped interlocking cement concrete tile. The uniqueness of the shape of "AQUARIUS" tiles primarily stems from the curvature which has been provided both on the top and bottom side of the tile. This curvature performs the function of inter-locking between tiles when they are laid and also creates a unique flowing wavy pattern "AQUARIUS", is a tile with interlocking as its function. When laid one tile interlocks with the others. Being an inter-locking tile, each tile has a specific pre-fixed place and position when laid. Further when one tile gets dislodged from the embedded surface, it does not vastly affect the other tiles. The tile "AQUARIUS" is very unique in its conception and first of its kind introduced in the entire world. The petitioner has developed the said tile by employing enormous skill energy, labour and capital and in fact in view of its uniqueness, the said tiles manufactured by the petitioner have won widespread public acclaim. The petitioner having developed the said tile, it has become the owner of the copyright in the drawing in respect of the said product with the sole right to produce or reproduce the said drawing or any substantial part thereof in any material form whatsoever to the exclusion of all other persons. The petitioner

being the owner of the copyright in the said drawing, has obtained registration of the said work under the Indian Copyright Act, 1957 claiming user from 1992. The petitioner has obtained a Copyright Registration Certificate from the appropriate authority on 28.1.1997. Even after the Registration, there is correspondence, between the Registrar of Copyrights, New Delhi and the petitioner. The petitioner is the owner of the copyright in respect of the said drawing and no person is entitled to use the same to manufacture any product by reproducing the said drawing in three dimensional form or use the said drawing in any other manner whatsoever.

9(4) The petitioner had completed the first phase of the Marina Pavement Beautification project and was negotiating with the Chennai Corporation for beginning the second phase. At that juncture, the petitioner was shocked and surprised to come across during the third week of December 1995 tiles manufactured by the respondent. Which are a substantial reproduction in three dimensional form of the drawings of the petitioner in respect of the aforementioned "AQUARIUS" tiles and of which the petitioner is the owner as stated herein above. The respondent has thus ventured to copy the drawing of the petitioner and has come forward with the final product which is a substantial reproduction in three dimensional form of the petitioner's drawing. The petitioner on enquiry understood that the respondent company has been promoted by two ex. Employees of the petitioner viz. Mr. V. Krishnamurthy and Vigneshwar Sundar. In fact the respondent company was incorporated in August 1993 during which period, very significantly, the said persons were in the employment of the petitioner Company, which establishes the mala fides of their intention. Mr. Krishnamurthy left the services of the petitioner Company in December 1993 and Mr. Vigneshwar Sundar in February 1994. The said Vigneshwar Sundar was incharge of the design and development and Krishnamurthy was incharge of production at the relevant time while in the service of the petitioner Company. Thus, the said persons have ventured to copy the petitioner's unique drawings and passing off their product as and for the petitioner's unique tiles by cashing on the reputation of the petitioner's product. The said persons had access to the drawings of the petitioner and taking advantage of the same have come forward with a product which is substantially a reproduction of the petitioner's drawings with the sole intention of unjustly enriching themselves. Significantly, one of the said persons viz. Vigneshwar Sundar was closely involved in the execution of the Marina pavement project. It is submitted that the respondent taking advantage of the wide acclaim and reputation enjoyed by the petitioner's products is creating confusion in the minds of the public and is causing loss, hardship and injury to the petitioner which is irreparable and immeasurable.

9(5) On 7.1.1998, when one of the Directors of the respondent's company viz. Krishnamurthy was examined as D.W.1, for the first time the respondent herein has marked a document which is a certificate of Registration of Design, dated 26.12.1996. The certificate dated 26.12.1996 bears No. 4666. The design No.

171127 dated 19.4.1996 and the infringing tile "AKASH" has been registered under Class-4. The said Registration and Design is liable to be cancelled u/s 51-A of the Designs Act 1911 9 hereunder referred to as the said Act in this petition for the sake of brevity).

9(6) The alleged design which has now been registered is not shape, configuration, pattern or ornament which in the finished article appeals to and is judged solely by the eye. The individual tile, in isolation, in fact has no appeal to the eye at all. Appeal to the eye if any can be gained only when the tiles are laid. The shape, is functional, as stated supra and the curvature and shape performs the function of inter-locking one tile with the other, when laid. This is of phenomenal functional advantage in out door applications, as it provides anti skid feature when laid. Under such circumstances, the features of the tiles are dictated solely by the function, which is to be performed by the tile and it is as such a mere mechanical device not entitled to protection under the said Act. It would also be significant to note that the individual tile of the shape in question has no appeal to the eye and it is only when the tiles are laid together that a pattern is created which may have an appeal to the eye. Furthermore, these tiles have specific out door application, where tiling is sought to be done with antiskid features in drive ways, swimming pool decks, gardens, parks, etc. and it would not be possible to use the said tiles for any other purpose. It would, therefore, be seen there is no registrable design in the shape in question, the same not satisfying the requirement of a design under the said Act. The registration obtained by the respondent is therefore liable to be cancelled, The certificate of registration of the design does not give any specific statement on the purported novelty and the novelty that is claimed in the alleged design is a bald statement that the novelty resides in the design as illustrated. It would also be seen that the certificate of registration is not for use in legal proceedings.

9(7) The design registration obtained is liable to be cancelled for the reason that the design in question has already been published in India prior to the date of registration. The petitioner had manufactured and marketed the subject tiles admittedly even during (sic) 1992 much prior to the date of registration which is 26.12.1996. It would be clear therefore that the design has been published in India prior to date of registration and hence is liable to be cancelled.

10. The objections of the respondent stated in the counter statement would be as follows:

The allegation that the curvature in the Aquarius tile performs the function of interlocking between tiles when they are laid is totally incorrect and contrary to the facts. Absolutely, there is no interlocking between the tiles when they are laid. The pre-polished concrete tiles will have a male part and female part which are designed to fit in to exact position so that no gaps or space is left when they are laid. It is a mis-description to describe such fittings as interlocking functions. The pre-polished concrete tiles in whatever shape such as square, rectangle, hexagon or curves have this feature which enables the tiles to be laid

consecutively without leaving any space or gap between the tiles when laid. The pre polished concrete tiles, if made in different shapes than the conventional square or rectangle shape, are so designed that there will not be left any gaps or space after they are laid. The allegations that the curvature on the "Aquarius" tiles alone perform the function of interlocking between tiles are all made knowing it to be incorrect for creating a case.

10(2) The shape with the curvature on both the top and bottom of the tiles are commonly used in India for creating wavy pattern while the tiles are laid. There is no originality in the tiles as the curvature and wavy pattern are universal and is being used by many for creating such wavy patterns. The petitioner has obtained Copyright registration for the literary work in the word "Aquarius" and not for the artistic work in the alleged drawings of the Aquarius tiles. The tiles having been designed with geometrical shapes as basis and geometrical shapes being common and no exclusive copyright can be claimed by any one for such drawings. The tiles manufactured in the name of "Akash" which gives an unique pattern is independently designed by the respondent taking the square as basic geometrical shape. This unique pre-polished concrete tile designed by the respondent has its own individual shape, character texture and capable of giving entirely new appeal to the eye, totally different from that of the plaintiffs tiles under the name of Aquarius. The petitioners tiles are designed taking triangle as a basic geometrical shape. The respondents tiles are designed taking square as a basic geometrical shape. The petitioner tiles can only give one particular pattern of laying. On the other hand, the respondent tiles can give two independent patterns which can be combined and laid together. The respondents tiles in no way resembles the tiles of the petitioner either in the individual tile shape or in the final lay out pattern.

10(3) The shape and configuration of the tiles with name Akash is in no way a reproduction of the petitioners tiles under the name Aquarius or is based on the drawings of the petitioners. In any event, as the design in the tile Aquarius is capable of being registered under the Designs Act 1911 and as the tiles under the said design has been produced more than 50 times as admitted by the petitioners by industrial process and the registration of design under No. 171127 in respect of "Aakash" tiles is valid and not liable to be cancelled. There is no interlocking function in any of the concrete tiles including the Aquarius or Aakash.

10(4) The respondent has developed the Aakash tiles with unique shape and configuration which has a distinctive eye appeal when looked at single tile or when it is laid. The shape and configuration of the respondents tiles Aakash is unique, novel and never published prior to the manufacturer of the tiles by the respondents, since the respondents have developed the original tiles with novel shape and configuration they have a right to get registration of the said tiles under the Designs Act and the registration under No. 171127 date 26.12.1996 is valid and continue to remain in the register. Therefore, the respondent prays this Court to dismiss the original petition with costs.

11. Based on the aforesaid pleadings, this Court on 20.7.2000 framed the following issues for trial.

A Whether the registration of the design under Design Registration No. 171127 dated 19.4.1996 under Clause 4 of the Designs Act is liable to be cancelled?

2. Whether the design in question has already been published in India prior to the date of application?

3. Whether the impugned registration of design of the defendant is actually a "copyright" within the meaning of the Copyright Act, 1957?

4. Whether adverse inference shall be drawn owing to the absence of the Controller of Designs before this Court?

5. To what relief?

12. The aforesaid O.P. No. 328 of 1998 was taken up along with O.P. No. 24 of 2001 and this Court had recorded evidence in common in which Exhibits P1 to P25 were admitted on the petitioner's side and PW1 was examined on the side of the petitioner. The respondent did not adduce any evidence and in the meanwhile the said O.P. No. 328 of 98 was ordered to be disposed of along with this appeal by the order of this Court. The clubbed O.P. No. 24 of 2001 which was in respect of another tile regarding the drawing of "CATHERINE" was separated and O.P. No. 328 of 1998 alone is clubbed with this appeal for judgment.

13. For convenience, the status of the parties before the trial Court in O.S.No. 1 of 1996 are maintained in this judgment.

14. Heard Mr. Sundar, learned counsel for the appellant/plaintiff and Mr. Prabhakar Reddy, learned counsel for the respondent/defendant.

15. The learned counsel for the appellant/plaintiff would submit in his argument that the judgment and decree passed by the trial Court was erred due to mis-reading the evidence and understanding the terms of patent, design, copy-right and trade marks and was arrived to contradictory findings in its judgment. He would further submit that the Copy Right Registration Certificate produced by the plaintiff in Exhibit A12 was with an inadvertent clerical error which would read as literary work instead of the drawing or an artistic work and it could be evidenced on perusal of the application for the said copy right. He would further submit that the inadvertent clerical error was given weight and the trial Court also arrived to an erroneous decision. He would further submit that even otherwise, the registration of copy right is not essential for claiming a right over any drawing or any literary work. He would further submit that the decision reached by the trial Court that "M.O.1" sample tile would have been registered under Designs Act, when M.O.2 tile was capable of being registered under the said Act, would go to show that the trial Court has completely landed on another assumption to reach an erroneous decision. He would also submit in his argument that the plaintiff had developed his product in a particular variety, in a curved style and named it

as "aquarius " and the same curvature was copied by the defendant in order to steal the reputation and do the "passing off his product as that of the plaintiff's product by using the same curvature. He would further submit that the Managing Directors of the defendant's Company namely Mr. Krishnamurthy and Mr. Vignesh Sundar were working in the plaintiff's company during 1992 and they have copied the said drawing and developed the tile M.O.2 and thereby infringed the right of the plaintiff. He would also submit in his argument that the similarity of both M.O.1 tile "aquarius" and the M.O.2 tile produced by the defendant would go to show that the curve used by the plaintiff was imitated by the defendant for bringing the structure of the tile, M.O.2. He would also submit that the drawing of M.O.1 tile was already registered under the Copy Right Act and any diversions developed from any drawing would be infringed from the copy right and the consequent passing off the products of the plaintiff. He would further submit in his argument that the defendant's men namely D.W.1 and Mr. Vignesh Sundar had access with the plaintiff's company in the year 1992 as employees and thereafter, they were relieved and they started the defendant's company in August 1993 and they have copied the drawing registered by the plaintiff and started manufacturing the said tiles and thereby encashed the reputation of the plaintiff's company. He would further submit in his arguments that the said fact was not denied by D.W.1, which would be amounting to an admission. He would also submit that the mere production of Exhibit B-2, the drawing of M.O.1 would go to show that it was lifted from the plaintiff's company. He would further submit that the evidence of D.W.1 would go to show that the tile produced by the defendant in M.O.II was not developed through the geometric basis i.e., square, cannot be true. It would be amounting to copying the plaintiff's drawing and it would certainly an infringement of the copy right. He would also submit that a square is nothing but a combination of two right angled triangles and therefore, the reason suggested by the defendant that the tile belonging to the plaintiff was on the basis of triangle and the tile manufactured by the defendant on the basis of square cannot be a different one. He would also submit that the trial Court had failed to note this point but had come to the conclusion that the geometrical shape of triangle or square are generic in nature and anybody can use the curve in those structures, which would not be sustainable. He would also submit that the designs put by D.W.1 would go to show that he has infringed the copy right of the plaintiff obtained in Exhibit A-12. He would also submit that the drawing in Exhibit A-17 was in three dimensional form and the same was registered with the appropriate authority under Copy Rights Act and therefore, the drawing produced as Exhibit A-22 which was certified by Exhibit A-12 was infringed by the defendant by producing M.O.2 tile by the defendant. He would also submit that the trial Court did not catch the point that the drawing was copied by the defendant by developing it in three dimensional design and manufactured tiles with the help of the said design. The trial Court had also not understood the difference between a copy right and the design. He would further submit that the design as defined in Section 2(5) of the Designs Act would explain that a design can be judged solely by the eye whereas the Section 13 of the Copy Rights Act

would entitle the registration of an artistic work also. He would draw the attention of the Court to the division of artistic work in Section 2(c) of the Copy Right's Act. He would also submit that the tiles manufactured by the plaintiff is "Aquarius " admittedly, performing inter-locking and anti-skid functions which was admitted by D.W.1 in his cross-examination and the said tile was different from "square" or rectangular shaped tiles, which would not inter-lock itself. He would further submit that the curvature of the top and bottom of the tiles of the plaintiffs when laid in the floor, wave anti skid grooves would form and this would give good grip to the feet which would not be available in square or rectangular tiles. He would further submit that the similar wave like pattern and anti-skid grooves was also developed in the tiles of the defendant in such a way, he had followed the method of the plaintiff. Therefore, he would submit that the purpose of manufacture of the tiles would also material for arriving to a conclusion that the copy right of the plaintiff was breached by way of adopting a design from the said drawing. He would further submit in his argument that the suit was filed by the plaintiff for permanent injunction against the defendant restraining him from in any way infringing the copy right and also for passing off the products on the basis of subsequent cause of actions. No doubt, the plaintiff had filed an earlier suit in C.S. No. 2034 of 1995 which was withdrawn and based upon the subsequent causes of action only, the present suit has been filed before the trial Court. The said fact was accepted by the Court while discussing the point but it had decided in the earlier paragraphs that the infringement of copy right was barred on this view but however, it had found that the suit was not barred by res judicata. He would further submit that the trial Court should have definitely come to the conclusion that there was no bar in bringing the suit as passing off is a subsequent cause of action and on that basis, the entire suit was laid and it was not barred.

16. He would further submit in his argument that the finding of the trial Court that M.O.2 was registered as per Designs Act and therefore, M.O.1 tile could also have been registered under the Designs Act and the copy right of the drawing would not emerge in to a design and therefore, it ought to have been registered under Designs Act. The said view of the trial Court is not in accordance with law.

17. He would further submit that the plaintiff has filed the original petition for cancellation of the said design in I.P. No. 328 of 1998 on the grounds that there was no novelty in the design and it was not incapable of registration as design and the purported design, for which, the application was being made was only on 19.4.1996 when the plaintiff's tiles in M.O.1 were already in public domain, from 1992 onwards. He would also submit that the said grounds raised would apply to M.O.2 tiles" design and on that aspect, the registration of design can be cancelled u/s 51(A) of the Act. He would also submit that the plaintiff had let in evidence as PW1 and had also produced the documents to show that the registration of design was already in vogue, at the time of filing application even from the year 1992 and there was no novelty in the said design and such a design could not be capable of registration. The said evidence was not

controverted by the defendant in the said proceedings. He would further submit that the design which was registered in the year 1996 was already over and on that aspect also, the design cannot be sustained. He would therefore request the Court to cancel the registration of the said design granted in favour of the defendant as prayed for in O.P. No. 328 of 1998.

18. He would further submit in his argument that the defendant had ultimately infringed the copy right of the plaintiff in the drawing attached with Exhibit A-12 and even otherwise, the said drawing was not registered and the drawing attached to Exhibit A-12 was utilised for the purpose of developing the design of M.O.1 tile and the said tile M.O.1 was in public domain from the year 1992 onwards and thereafter, the defendant had clandestinely designed M.O.2 tile with slight modification so as to resemble M.O.1 tile and had obtained the design registration by suppressing the facts and the said act of the defendant would be amounting to infringement of the copy right of the plaintiff and the production of M.O.2 tiles on the basis of the drawing registered for the design Exhibit B-2, would be amounting to passing off the products as that of the plaintiff and thereby the defendant had enriched. The learned counsel for the plaintiff would also draw the attention of the Court to an unreported judgment of this Court made in A. No. 3097 to 3099 of 2007 and O.A. No. 293 of 2001 in C.S. No. 216 of 2007, for the proposition that the registration of copy right would be in respect of the work annexed as shown in column No. 14 of the certificate Exhibit A2 which would therefore, relate to the drawing attached to the said certificate and not the literary work as stated therein. He would also rely upon a judgment of Hon'ble Apex Court M/s. Bengal Waterproof Limited Vs. M/s. Bombay Waterproof Manufacturing Company and Another, for the principle that there would not be any res judicata under Order 2 Rule 3 CPC when a subsequent suit would be in respect of a subsequent cause of action, even though for the same relief in the earlier suit. He would further submit that the similar and common feature in the tiles manufactured by the defendant would deceive and cause confusion in the public market and in such circumstances, the right of the plaintiff ought to have been considered as infringed. For that, he relied upon a judgment of Hon'ble Apex Court in Corn Products Refining Co. Vs. Shangrila Food Products Ltd., in support of his arguments. He would therefore, request the Court to interfere and set aside the judgment and decree passed by the trial Court and thereby to allow the appeal. He would also request the Court to order the petition filed by the petitioner/plaintiff seeking for cancellation of the registration of the design by the defendant/respondent.

19. The learned counsel for the respondent/defendant would submit in his argument that the suit filed by the plaintiff was mis-conceived on the alleged infringement of the copy right of the drawings of M.O.1 tile by reproducing three dimensional form in M.O.2 tile and for passing off the tiles by using the plaintiff's drawings in respect of M.O.1 tiles, cannot be sustained. He would submit in his argument that the copy right registration produced as Exhibit A-12 was with reference to the alleged drawing of M.O.1 tile. He would further submit that the

said certificate does not register any drawing but only literary work of "Aquarius" name of the said tile. He would also submit that the defendant is manufacturing M.O.2 tile in the name of "Akash" and not in the name of "Aquarius". He would also submit that the argument of the plaintiff that there was a clerical mistake in Exhibit A-12 cannot be countenanced since the plaintiff could have approached the concerned forum for correcting the alleged clerical mistake but there was no evidence on that aspect. He would further submit that there was no registration of copy right of the drawing said to have attached with all the application forms in Exhibit A-11 nor was there reference in the certificate with regard to the attached drawing of M.O.1. He would also submit that the M.O.2 tile manufactured by the defendant is of a different design and its drawing would be different from the drawing of M.O.1 tile. He would further submit in his argument that M.O.1 tile is based upon the geographical shape, the square. He would also submit that the different geometric shapes would not be similar and the curve or square or rectangle or triangle are shapes which are in public domain and nobody can claim any exclusive right over the geometric shapes. He would further submit that the design of M.O.2 is different from M.O.1 and the mere creation of wavy grooves on the floor where laying would not in any way similar but this would result in a different pattern and it could be evidenced very easily. He would further submit that the appearance of M.O.1 tile is bigger than M.O.2 tile and therefore, there cannot be any copy of the drawing of M.O.1 tile. He would further submit that M.O.2 tile was invented by the defendant's Directors and they lawfully submitted for registration of design in order to get the protection of Designs Act and it was promptly registered and or certificate was issued in Exhibit B-2. He would further submit in his argument that the plaintiff who has come forward for seeking relief of injunction should have come to the Court with clean hands for getting the discretionary relief from the Court. But, the plaintiff has suppressed the earlier litigation filed by him in C.S. No. 2034 of 1995 before this Court and after getting no interim orders, it was designed for withdrawal and the relief sought for by the plaintiff was identically with the present relief sought for in the plaint and the present reliefs are therefore, barred by res judicate. He would also submit that the plaintiff did not get the permission of the Court before withdrawal with liberty to file a fresh suit and therefore, it would be barred under Order 23 Rule 1(4) CPC. He would also submit that the reasoning given by the trial Court that the subsequent cause of action as mentioned in the 3rd week of December 1995 would not bar the filing of the suit could not be correct since the infringement of the copy right, the main relief sought for by the plaintiff was barred and therefore, the subsequent passing off relief should have also been consequently barred under Order 2 Rule 2 CPC. He would further submit in his argument that the design registered by the competent authority cannot be cancelled, merely because the plaintiff had asked for. There is no similarity in between both the tiles produced in M.O. No. 1 and 2 and therefore, the grounds raised by the plaintiff for cancellation of the design already ordered in favour of the defendant, cannot be ordered. He would further submit in his argument that the registration of design granted in favour of the

defendant cannot be cancelled at this stage, since the design is valid only for the period of 10 years and those orders have also been lapsed. He would further submit in his argument that even otherwise the plaintiff is entitled for a copy right in respect of the drawing based upon M.O.2 tile, such right would enure to the design of M.O.1 and the right of the plaintiff would be over, when 50 of its type had been manufactured by the plaintiff and on that aspect also the plaintiff would not be entitled for any injunction against the defendant. He would further submit in his argument that the trial Court had detailedly discussed the points on the basis of evidence and on admission of P.W.1 it had come to the conclusion that all the reliefs sought for by the plaintiff cannot be ordered and therefore, suit was rightly dismissed and there is no infirmity in the said orders passed by the trial Court.

20. He would quote a judgment of Delhi High Court 1998 PTC 18 and submitted that a similarity on design if not found, the protection of copy right is not available to the plaintiff. He would also quote the said judgment for the principle that the consequent passing off would not also enure to the plaintiff and therefore, there would not be any injunction in respect of passing off also. He would also submit in his argument that the use of a design on the basis of a registered copy right would not be attracted under the Copy Rights Act. He would also quote a judgment of Delhi High Court Microforms Inc Vs. Girdhar and Co. and Others, for that purpose. He would also bring it to the notice of the Court that the plaintiff has come forward with concealment of material facts. He would further submit that the defendant has come to the Court with unclean hands and he cannot get the discretionary relief of injunction. For that principle, he would rely upon a judgment of Delhi High Court in Polymer Papers Ltd v. Gurmit Singh and Others 2002 (25) PTC 327 (Del). He would therefore request the Court that the judgment and decree passed by the trial Court was very much in consonance with the evidence produced by both the parties and also on the principles of law and therefore, they are not liable to be interfered and the appeal may be dismissed.

21. He would also request the Court that the evidence produced before the trial Court would also apply to the original petition filed by the plaintiff for cancellation of the design and on the basis of the evidence produced in the suit as well as in the original petition, the plaintiff/petitioner has not established anything to cancel the design and the right over the design had also expired as lapsed and nothing survives in the said petition and thus liable to be dismissed.

22. I have given anxious thoughts to the arguments advanced on either side.

23. It would be more appropriate if the arguments advanced by both the counsel are considered on point-wise.

24. Point Nos. 2, 3, 6, 7 and 8 in A.S. No. 433 and Issue Nos. 1 to 3 in O.P. No. 328 of 1998:

The plaintiff has filed the suit for permanent injunction restraining the defendant

from infringing the copy right over the drawing in respect of M.O.1 tile, registered by the plaintiff and also from passing off the tiles manufactured by the defendant copying the plaintiffs drawings in respect of the said tile M.O.1, uniquely shaped for inter-locking under the name "Aquarius" and for other consequential reliefs. The said reliefs sought for by the plaintiff were not granted by the trial Court against which the present appeal has been preferred.

25. The admitted facts are that the plaintiff's company was indulged in manufacturing M.O.1 tile which is in the following shape:

26. The shape drawn above was named as "Aquarius". The defendant is manufacturing the M.O.2 tile, which is in the following shape:

27. The contention of the plaintiff was that the drawing of the plaintiff was registered through Exhibit A-12 under the Copy Rights Act and the same was misused for developing a three dimensional shape so as to imitate the tiles of the plaintiff produced in M.O.1. M.O.1 is claimed to be the resultant development of the drawing of the plaintiff said to have been registered under Exhibit A-12. The contention of the defendant was that Exhibit A-12 certificate was not having the registration of the said drawing attached to that but it had the registration of the literary of the title of the work "Aquarius". On a careful perusal of the said documents in Exhibit A-12, I could see that the class and description of the work as mentioned in Sl. No. 4 was mentioning only as literary. However, it is further argued by the learned counsel for the petitioner that the drawing produced in Exhibit A-17 was produced along with the said certificate Exhibit A-12 and therefore, the attached drawing should have been considered as the registered copy right. For that, he would rely upon an unreported judgment of this Court made in A. No. 3097 to 3099 of 2007 and O.A. No. 293 of 2001 in C.S. No. 216 of 2007 dated 7.11.2007 which was confirmed by the Bench of this Court with the finding that the view taken by the learned single Judge was a prima facie case and it has to be considered only in a detailed trial. As far as this case is concerned, the decision to be taken is upon a fullfledged trial, but the opinion given by the learned single Judge in the unreported judgment was admittedly to make a prima facie case. Moreover, in the document, Exhibit A-12 in class-4, there was an indication that the required substance was attached. As far as this case is concerned, there is no such indication in class-4, but only referred to as "literary work". Therefore, the said judgment cannot be helpful to the plaintiff for showing that the certificate produced in Exhibit A-12 was in relation to the drawing produced in Exhibit A-17. Moreover, the submission of the learned counsel for the plaintiff that the omission was only a clerical mistake and the mistake committed by the authorities cannot be taken advantage by the defendant is not sustainable in view of the fact that the application given by the plaintiff produced in Exhibit A-11 shows a drawing but it was not granted by the competent authorities. Moreover, no such drawing produced in Exhibit A-17 was proved to have considered by the authorities for the grant of the copy right. The certificate alone could be a conclusive proof to show the grant of certificate and if

there is no mentioning in certificate regarding attachment of drawing then it could be construed that the said drawing was registered under the provisions of Copy Rights Act. The plaintiff did not take steps to summon the records of the competent authority who granted Exhibit A-12 in order to show that the said copy right was given only for the drawing and not for the title or literary of the document. If so examined by the plaintiff, he could have also proved to the effect that the omission of mentioning in the certificate as drawn in class-4 was a clerical mistake. Therefore, it cannot be said that the drawing produced in Exhibit A-17 has been registered as per the provisions of Copy Rights Act.

28. Even though, the drawing has not been registered under the Copy Rights Act, can the defendant violate the design of the plaintiff's tile in M.O.1 by producing or manufacturing the tiles in the design of M.O.2. On a careful perusal of the M.O.1 tile, it is seen that it is bigger in size than M.O.2 tile. The evidence of PW1 would go to show that it was generated on the geometrical shape of triangle and tile produced by the defendant in M.O.2 was developed on the geometric shape of "square". The shapes in geometry namely circle, rectangle, square, triangle and oval are all public domain and anybody can use such geometric shape and it cannot be considered as exclusively belonging to one person. No doubt, when we apply the geometric shape as admitted by the plaintiff in his evidence, the shape of M.O.1 would exactly fit in with the triangle whereas the M.O.2 tile did not suit with the triangle. However, the M.O.2 tile is matching with the square drawn over it but M.O.1 tile did not fit in with a square. But, both the tiles can be laid to form a wavy appearance in its own way. Whether the wavy grooves created by laying of both the tiles would bring any similarity, the answer would be "no". In a case, when a square tile or a rectangular tiles are produced by different persons and are laid, it would give a design similar to each of the laying of tiles but that would not infringe or violate any design of any person in producing the particular type of tiles. Similarly, the formation of wavy grooves on laying the tiles would not in any way give a right to sue for infringing of design or if any copy right accrued to the plaintiff. Therefore, I could see that the designs, even if not registered under the Designs Act, the designs of M.O.1 has not been infringed by the defendant by manufacturing M.O.2 tiles. On appearance also M.O.2 tile is not similar to M.O.1 tile.

29. The learned counsel for the defendant brought to the notice of this Court that the M.O.2 tile was registered under Designs Act by the defendant even though after the suit, the defendant is entitled to override the right of the plaintiff even the designs are one and the same. In the discussion held above, I could see that the design of M.O.2 is different from the design of M.O.1 and therefore, even without registration of M.O.2, under Designs Act, the defendant has not committed the infringement of the design of M.O.1 tile.

30. Therefore, the judgment of Hon"ble Apex Court as cited by the learned counsel for the plaintiff in Corn Products Refining Company v. Shangrila Food Products Ltd. (supra) is not applicable to the present facts of the case since there

was no infringement of copy right or the reputation attached to the goods.

31. When there is no violation of any copy right or design of M.O.1 tile by the defendant, the plaintiff cannot claim an exclusive right over the designs and no protection can be granted under the provisions of Copy Rights Act. It is also pertinent to note that unless the design has been registered under the Designs Act, such design cannot be protected through any prohibitory order that the design of the concerned person has been infringed. Admittedly, the design of M.O.1 tile, belonging to the plaintiff was not infringed under Designs Act on the date of suit. Therefore, the plaintiff is not entitled to seek any remedy invoking the provisions of Designs Act for the grant of injunction. However, the plaintiff was very much conscious to ask for permanent injunction against the defendant on the foot of the registration of copy right over the drawing produced in Exhibit A-17 which was not shown to have a connection with Exhibit A-12 and therefore, the injunction sought for by the plaintiff against the defendant in respect of the M.O.1 tile, cannot be granted.

32. As already discussed, the design followed by the plaintiff to manufacture M.O.1 tile was not similar to that of M.O.2 tile manufactured by the defendant. In that aspect, the plaintiff is not entitled for the grant of any injunction towards the manufacture and marketing of the tile produced in M.O.2. When the said design or the copy right as claimed by the plaintiff was not established, the production or manufacture of M.O.2 tile by the defendant would be entirely different from that of M.O.1 tile. Therefore, there would not be any passing off, as we could see the proof of differences in between two tiles including size and other aspects discussed above. Therefore, there could be no possibility of passing off, and encash the reputation of the plaintiff's tile M.O.1. Therefore, both the reliefs of injunction sought for by the plaintiff are not available to the plaintiff as sought for.

33. As regards the cancellation of the design granted to the defendant after the suit, the plaintiff even though examined as P.W.1 in O.P. No. 328 of 1998, the evidence produced in those original suit coupled with the evidence produced by the plaintiff in the original petition would not go to show that the designs of the tiles M.O.1 and M.O.2 are not similar. The competent authority have followed the procedures for granting the certificate of design to M.O.2 tile and has granted the certificate of design. Nothing was shown to be wrong in granting such design in favour of the defendant. It is also brought to the notice of this Court that the design registered in favour of the defendant would be valid for only 10 years and the said 10 years also lapsed and therefore, there is no need for cancellation of the said registration certificate even though it is liable to be revoked since the petition became infructuous. Having come to a decision that the plaintiff is not entitled for permanent injunction, on the basis of infringement of copy right or through violation of any design, this Court had incidentally found that the designs of both M.O. Nos. 1 and 2 are different and therefore, the petitioner (the plaintiff) seeking for the cancellation of the design granted to the respondent/ defendant, cannot be ordered. When the registration of the designs granted in

favour of the defendant was not liable to be cancelled, the issues 1 and 2 framed in O.P. No. 328 of 1998 are decided against the petitioner/plaintiff. In view of the decision that the registration of design of the defendant was validly granted to the defendant, it cannot be considered as registration of copy right only. Exhibit B-8 produced as certificate of registration of Design Board No. 171127 cannot be considered only as the registration of copy right. The design of M.O.2 has been considered and the photographs in three dimensional character has been registered as a design in Exhibit B-8.

34. The learned counsel for the defendant placed reliance on the judgment in Polymer Papers Ltd v. Gurmit Singh and Others (supra) for the principle that the copy right resulting a design cannot be claimed since the said design has to be registered under the Designs Act. The relevant paragraph would run as follows:

29. Learned counsel for the defendants submit that industrial drawings and designs in which the plaintiffs claim copyright are for the purposes of manufacturing of filter related machines or components and as such clearly fall within the meaning of "design" as defined in the Designs Act and since the alleged designs have not been registered under the designs Act the plaintiffs cannot claim copyright therein. In support of above proposition of law Ms. Pratibha M. Singh has aptly placed reliance on Samsonite Corporation v. Vijay Sales, 1998 PTC (18) 372 (Del), Hello Mineral Water Pvt. Ltd. v. Thermoking California Pure 2000 PTC 177, Jg Vacuum Flask Ltd v. Eagle Flask Pvt. Ltd. 1996 PTC (16) 558 (Del) and Deepak Printery, Ahmedabad v. The Forward Stationery Mart and Others, (1981) PTC 186.

30. Learned counsel for the plaintiffs contends that in order to have copyright in the artistic works the drawings were not required to be registered under the Designs Act. Reference is made to Nav Sahitya Prakash and Others Vs. Anand Kumar and Others, The said case related to the copyright of a author in his literally works "SAPANA KHAND KAVYA" which was inherited by his sons. In that connection, it was held that in legal parlance right of property in literal or intellectual production existed independently of a statute. There cannot be any quarrel with this proposition of law. This judgment has no relevance to the facts of the instant case. In the instant case the plaintiffs are claiming copyright alleging to be the exclusive owners of the industrial drawings and design which they are using for manufacturing purposes. The plaintiffs also claim to be the originators of the said drawings and designs. As discussed above, in view of the provisions of the Designs Act, 2000 and the Copyright Act, 1957 the plaintiffs could have claimed copyright therein only if the designs were registered under the Designs Act.

35. Reliance was also placed by the learned counsel for the defendant Microforms Inc Vs. Girdhar and Co. and Others, for the principle that the Copy Right Act is not applicable for the artistic work connecting the design. The relevant passage would run thus:

65. The exclusion of an "artistic work" as defined in Section 2(c) of the Copyright Act from the definition of "design" u/s 2(d) of the Designs Act, 2000 is only meant to exclude the nature of artistic work like painting of M.F. Hussain. It is, thus, the paintings, sculptors and such works of art which are sought to be specifically excluded from the new Act.

66.....It is thus, apparently clear that in the context of the Indian Law, it is the Design Act of 1911 or 2000, which would give protection to the plaintiff and not the Copyright Act. The application of mind and skill is not being denied nor the fact that the defendants have copied the same, but that would still not amount to the works in question being labeled as "artistic work" within the definition of Section 2(c) of the Copyright Act and, thus, the protection is not available under the Copyright Act. Issue No. 1 is answered accordingly.

36. For the same principle, yet another judgment of Delhi High Court in *Samsonite Corporation v. Vijay Sales* (supra) has also been cited.

37. On a careful perusal of the aforesaid judgments, I could see that when the industrial use or process has to be done, the work or configuration in an industrial process or on artistic work as defined u/s 2(c) of the Copy Right Act, the provisions of the Designs Act would alone be applicable and the provisions of Copy Right Act are not applied.

38. Therefore, the issue No. 1 to 3 in O.P. No. 328 of 1998 and the points 2, 3 and 6 to 8 are answered against the petitioner/plaintiff and in favour of the respondent/defendant.

39. Point No. 1 in A.S. No. 433 of 1999:

It was vehemently argued on the side of the defendant that the plaintiff had suppressed the fact that as to the file of a suit in C.S. No. 2084 of 1995 on the same cause of action for the same relief and the said suit was withdrawn without the permission of the Court as required under Order 23 Rule 1(4) CPC which would bar the plaintiff to ask for the reliefs once again. Exhibit B-1 is the plaint filed in C.S. No. 2084 of 1995.

40. On a careful perusal of the said plaint, I could see that every pleading is one and the same except the cause of action. The cause of action in the suit on appeal was said to have taken place at the 3rd week of December 1995. But, the cause of action in the earlier suit in C.S. No. 2084 of 1995 was said to have taken place during the 1st week of December 1995. Can this be considered as a different causes of action and in the subsequent suit filed by the defendant maintainable?

41. The learned counsel for the plaintiff relied upon a judgment of Hon"ble Apex Court in *Bengal Waterproof Limited v. Bombay Waterproof Manufacturing Company and Another* (supra) and the principle laid down would be helpful for deciding these points. The relevant passage would run thus:

10. As seen earlier, Order 2, Rule 2, sub-rule (3) requires that the cause of action in the earlier suit must be the same on which the subsequent suit is based and unless there is identity of causes of action in both the suits the bar of Order, Rule 2, sub-rule (3) will not get attracted. The illustration below the said Rule amply brings out this position. A mere look at the said illustration shows that if a landlord sues the tenant in 1908 for the rent due till that year and omits to sue for rent for any of the previous years which had then accrued due he cannot subsequently sue the tenant for the previous rent due, claim for which was given up in the suit. It is obvious that a subsequent suit would not be barred in case of rent falling due after the first suit, say, for the year 1909 or 1910 etc. as that default would give him a fresh cause of action. In the facts of the present case, it becomes obvious that when earlier suit was filed in 1980 the plaintiff had a cause of action regarding the alleged illegal use of his trade mark "DUCK BACK" by the defendants and had also a grievance regarding the then existing deceitful action of the defendants in trying to pass off its goods "DACK BACK" as if they were similar to the plaintiff's goods "DUCK BACK". Therefore, the cause of action for the first suit of 1980 was based on the infringement of plaintiff's trade mark "DUCK BACK" by the defendants till the date of the suit filed in 1980. The grievance regarding passing off of the defendants' goods as if they were plaintiff's goods was also confined to the situation prevailing on the date of the earlier Suit No. 238 of 1980. That suit failed as the plaintiff had not claimed proper relief. Consequently for the alleged acts of infringement of plaintiff's trade mark or the alleged passing off actions on the part of the defendants till the date of the earlier suit no subsequent grievance could be ventilated by the plaintiff by filing a fresh suit. It is also pertinent to note that in the earlier suit, that is, the first suit the plaintiff had claimed Rs. 25,000 by way of damages for the alleged illegal acts of the defendants which were brought on the anvil of scrutiny in the 1980 suit. So far as that cause of action is concerned no subsequent suit lies as it would be barred under Order 2, Rule 2, sub-rule (3). But, we are concerned in the second suit with entirely a different grievance of the plaintiff. In the second suit namely, the present suit the grievance is not based on any acts of infringement or passing off alleged to have been committed by the defendants in 1980 but plaintiff's grievance is regarding the continuous acts of infringement of its trade mark "DUCK BACK" and the continuous passing off action on the part of the defendants subsequent to the filing of the earlier suit and which had continued on the date of the second suit of 1982.

42. As per the judgment of Hon"ble Apex Court, it has been held that if the subsequent suit was in respect of the same cause of action like that of the previous suit, the suit is clearly barred and no cause of action to continue. There would be corresponding continuous causes of action in passing off which continued the deceit, which would give fresh causes of action. As regards this case, the infringement of copy right as well as passing off were clearly described in both the plaints similar. But the dates of cause of action alone has been mentioned as 1st week of December and 3rd week of December 1995

respectively. Once, the plaintiff has found the infringement of copy right, even if true, the cause of action to file a suit would not enure again to go for filing another suit on a subsequent infringement of the copy right he had. As far as the passing off relief is concerned, it is purely a subsequent cause of action in which the action of the defendant would be on the passing of his products as that of the plaintiff in the later point of time to which a subsequent cause of action would enure. The principle laid down in the aforesaid judgment of Hon'ble Apex Court would apply to the relief sought for by the plaintiff for passing off and not to the relief of infringement of the copy right. Therefore, the part of the relief namely the reliefs sought for permanent injunction for infringement of alleged copy right of the plaintiff is clearly barred under Order 2 Rule 2 CPC, since permission was not obtained by the plaintiff under Order 23 Rule 1(3) CPC and therefore, Order 23 Rule 1(4) CPC prohibits the repeated filing of suit on the same cause of action. When the said relief sought for by the plaintiff are party barred or partly allowable, this point of res judicata is also decided accordingly.

43. Issue No. 4 in O.P. No. 328 of 1998:

The contentions raised by the respondent/defendant was that the competent authority to issue registration certificate of the design issued to the respondent should have been impleaded as necessary party in the petition and the petitioner/plaintiff did not implead the Controller of Designs, who issued the certificate of registration of design and therefore, the Court cannot decide about the proprietary of the petitioner seeking for cancellation of the design. However, the respondent also contended that if the issuing authority was impleaded as a party, then only, the order passed by this Court would bind him and any order passed in his absence may not bind the issuing authority namely Controller of Design. From the said submission of the learned counsel for the respondent/defendant, I could see that the Controller of Design was not impleaded as a party while certificate of design was issued in Exhibit B-8 by him in favour of respondent/defendant.

44. If really, the Controller of Design is impleaded as party, he would produce all the records relating to the issue of the certificate of registration of design in favour of respondent/defendant but it was not done by the petitioner. Furthermore, the petitioner has not summoned the documents pending before the Controller of Designs for the purpose of deciding the issue regarding the grant of design and the procedure to be followed.

45. In the said circumstances, there is no other option except to take adverse inference which is against the petitioner for not impleading the Controller of Designs in this original petition. The said point is also decided against the petitioner.

46. Point Nos. 4 and 5 in AS. No. 433 of 1999:

In the forgoing discussion, it is found that the plaintiff is not entitled for permanent injunction in respect of the alleged infringement of copy right of the

plaintiff for evolving the three dimension tile namely M.O.1 against the defendant and also permanent injunction against the defendant for passing of the tiles belonging to him as M.O.2 as that of the plaintiff tile M.O.1. were not grantable to the plaintiff. In the said discussion, it was held that the plaintiff was not found to have entitled to such a copy right and also there was no infringement of copy right nor was there any passing off committed by the defendant. In the said circumstances, the plaintiff is also not entitled to seek a direction against the defendant to surrender all the tiles in the shape of M.O.2. to the plaintiff or to the Court nor to render any account in respect of the sale of M.O.2. tiles. Therefore, the plaintiff cannot also get such reliefs of surrendering the M.O.2. tiles and rendering of accounts regarding sale of those tiles by the defendant. Therefore, these two points are also decided against the plaintiff.

47. Point No. 9 in AS. No. 433 of 1999:

In view of the discussion held above, the plaintiff is not entitled to get any relief as asked for in the plaint and the trial Court had also come to the same conclusion. I find no reason to interfere with the judgment and decree passed by the trial Court and therefore, the appeal filed by the plaintiff deserves dismissal and accordingly, appeal is dismissed without costs.

48. Issue No. 5 in O.P. No. 328 of 1998: In view of the findings reached in the issues 1 to 4 in the O.P. that the petition filed by the petitioner (plaintiff) seeking for cancellation of certificate of design issued to the defendant (Exhibit B-8) is not liable to be granted, the objection filed for that purposes also is liable to be dismissed. Accordingly, the petition in O.P. No. 328 of 1998 is dismissed without costs.

In fine, the petition in O.P. No. 328 of 1998 is dismissed with costs. The first appeal in A.S. No. 433 of 1999 is dismissed without costs.