

(1996) 08 DEL CK 0058

In the Delhi High Court

Case No : Company Appeal No. 17 of 1985

Jg Vacuum Flask Limited

APPELLANT

Vs

Eagle Flask (P) Limited

RESPONDENT

Date of Decision : 30-08-1996

Acts Referred:

Designs Act, 1911 — Section 51A

Citation : (1996) 4 AD 258 : (1996) 26 ARBLR 518 : (1997) 70 DLT 255 :
(1996) 39 DRJ 43

Hon'ble Judges : Devinder Gupta, J

Bench : Single Bench

Advocate : Parveen Anand, for the Appellant;

Judgement

Devinder Gupta, J.

(1) This is a petition for cancellation of registration design No-154305 in class 3 dated 16th April, 1984 in the name of respondent No. 1 filed u/s 51A of the Designs Act, 1911.

(2) It is alleged that respondent No. 1 filed a suit No.10/95 in the court of the Additional District Judge, Delhi seeking a decree for permanent prohibitory injunction against the petitioners on the basis of its registered design No. 154305 dated 16th April, 1984.

(3) The petitioner in that suit alleged that the design registered under No.154305 is not valid and is opposed to basic principles of design law, being a copy of a German model, well known in India. It is alleged that petitioner No. 1 is a company incorporated under the Companies Act, 1956 having its registered office at Chinchawad, Pune and petitioner No.2 is a seller of petitioner No. 1's product in Delhi. Petitioner No. 1 is engaged in the manufacture and sale of vacuum flasks and refills for the past several years. Both the petitioners have been arrayed by respondent No. 1 in the said civil suit No.10/85 filed by respondent No. 1 and since the petitioners are aggrieved by the existence of

design No.154305, they are the persons interested in seeking cancellation thereof within the meaning of the Designs Act, 1911 (hereinafter referred to as "the Act").

(4) The grounds on which cancellation has been sought are that there has been concealment of material facts by respondent No. 1 from respondent No.2, while obtaining registration of its design as design No. 154305. Respondent No.1 did not disclose the fact that vacuum flasks bearing the same design as design No. 154395 had already been published in India prior to its registration and the said design is not a new or an original design. Subject matter, of design No. 154305 is a copy of a German model, which had been imported by petitioner No. 1 as well as by respondent No. 1 into India, prior to 16th April, 1984. Respondent No. 1 imported the vacuum flask body (outer shell) from Germany and marketed the same even prior to March, 1984 in India and the design, subject matter of the registration, being re-published in India, it deserves to be cancelled.. It is further alleged that respondent No.1 received the Gezi catalogue issued by Westdeutache Isolierflasche Company in the year 1983 and placed an order with the said German company for supply of outer shells, bearing the same design, as are the subject matter of the impugned design. The said order was confirmed on 15th January, 1984 and invoice is dated 19th January, 1984. The bill of lading related to the order is dated 29th January, 1984 and as such respondent No. 1 cannot contend that it holds a valid registration. The subject matter of the design was also known to petitioner No. 1 and to various other parties in India from the year 1983 onwards. In addition, the Chief Executive of petitioner No. 1 had visited Germany in 1983 and obtained a sample of vacuum flask of the type known as Article 490 of M/s.Westdeutache Isolierflaschen Company. Respondent No. 1 had imported outer plastic body of the same type from Germany in the later part of 1983 and introduced its model vacuum flask through circular No.120 dated 26th March, 1984 in the market. Respondent No. 1 in suit No.10/85 has admitted the circular dated 26th March, 1984 and even in pleadings, respondent No. 1 having admitted imported vacuum flask the subject matter of design No. 154305 although has falsely stated that the import was carried out after the date of registration. Subject matter of design, which relates to the main body of vacuum flask was imported under valid license and respondent No. 1 cannot, Therefore, claim any goodwill in respect of an article which originated from Germany and was in fact in existence for the last several years not only in India but abroad also. In this back ground cancellation is sought.

(5) After notice, respondent No. 1 put in appearance through counsel, and filed its reply. Respondent No. 1 denied that vacuum flasks bearing same or similar design were published in India at any time prior to March, 1994 or that petitioner No.1 imported the shells prior to 16th April, 1994. Respondent No.1 also denied that the design was in existence in India prior to respondents' activities or that the design was known to a large number of persons since 1983 or at any time prior to 16th April, 1984.

(6) Petitioners filed rejoinder to the reply filed by respondent No. 1 controverting all the allegations made by respondent No. 1. The case was thereafter posted for admission/denial of documents, which was done. On 3rd November, 1989, the following issue was framed:-

"1. Whether the design is liable to be set aside on the grounds mentioned in the plaint? 2. Relief."

(7) The case was posted on a number of dates but nobody put in appearance on behalf of the respondents. Accordingly, respondent No. 1 was proceeded against ex parte on 6th April, 1995. The petitioner was asked and has led ex parte evidence by placing on record affidavit of Shri R.Somasundaram son of Shri Ramasubramaniam, Manager of the petitioner company, supporting in material particulars, all the allegations made in the petition. It is stated that the subject matter design No.154305 is a copy of a German model, which had been imported both by petitioner No. 1 and respondent No. 1 into India prior to 16th April, 1984. Respondent No. 1 imported the outer plastic body of the same type from Germany and marketed the same in India on 26th March, 1984 and the design was also published prior to its registration. The original catalogue Ex.P.1 is stated to have been received by the petitioner company from Westdeutsche Isolierflaschen Company in 1983, when it placed an order with the said German company for supply of outer shells. Ex.P.2 and Ex.P.3 are the copies of the telex dated 15th January, 1984 and invoice dated 19th January, 1984 respectively from the German manufacturer. Bill of Lading relating to the said order is Ex.P.4 dated 29th January, 1984. It is also stated in the affidavit that the Chief Executive of petitioner No. 1 company had paid a visit to Germany in the year 1983 and obtained a sample of vacuum flask of the type known as Article 49Q of M/s.Westdeutsche Isolierflaschen Company. Respondent No. 1 had also imported outer plastic body of the same type in the later part of 1983 and introduced its model vacuum flask vide circular No. 120 dated 26th March, 1984. The circular referred to in the affidavit is Ex.P.5.

(8) On comparison of the design, as is shown on certificate of registration as design No.154305 dated 16th April, 1984, there is no dissimilarity with the design of the vacuum flask, as are shown in catalogue Ex.P.5. In the light of the order, which had been placed by petitioner No. 1 and in view of the circular, there is no manner of doubt that the petitioners have been successful in establishing that the design, being the subject matter of the aforementioned registration had already been published prior to its registration in India. It was much prior to its registration that petitioner No. 1 had placed an Order and imported into India the outer shells of the vacuum flask. As such, in view of the ex parte evidence on record and on the admitted position, the design having been published in India prior to its date of registration, the registration of the design is liable to be cancelled under the provisions of Section 51A of the Designs Act, 1911.

(9) Consequently, the petition is allowed and registration of design No. 154305 dated 16th April, 1984, as registered with respondent No.2 is ordered to be

cancelled. Due intimation of the order be sent to respondent No.2.