
(2019) 05 CAL CK 0024
In the Calcutta High Court
Case No : AID No. 1 Of 2012

Lucky Exports

APPELLANT

Vs

Controller Of Patents And Designs & Ors

RESPONDENT

Date of Decision : 10-05-2019

Acts Referred:

Design Act, 2000 — Section 2(a), 2(d), 4, 5, 36, 44
Registered Designs Act, 1949 — Section 1, 1B, 1(1)(b)(i), 1(b)(ii), 1B (8), 44(1)

Citation : (2019) 05 CAL CK 0024

Hon'ble Judges : Soumen Sen, J

Bench : Single Bench

Advocate : Ranjan Bachawat, Sayantan Bose, Debnath Ghosh, Prithwiraj Sinha, Arindam Chandra, Atish Ghosh, Ravi Prasad Mukherjee, Soumya Roy Chowdhury, Sarosy Dasgupta, Sk. Ainul

Final Decision : Allowed

Judgement

Soumen Sen, J

The appeal is directed against an order dated 31st January, 2012 under Section 36 of the Design Act, 2000 by which the application for cancellation of the design no. 202108 registered on 11th November, 2005 for article "Coaster Brake Sub Assembly" under Class 12-11 in the name of the private respondent, namely, International Cycle Gears, was rejected.

In AID No. 3 of 2012 an appeal by International Cycle Gears in relation to "Coaster Brake Hub" I have held that the controller was justified in cancelling the registered Design No.201728 dated 11th May, 2007, in respect of 'Coaster Brake Hub' in Class 12-11.

The present appeal which was heard along with AID 3 of 2012 as same and the similar points arose with the only difference being that the definition of "Article" in relation to "Design" in this appeal requires a deeper consideration in view of the submissions made by the parties.

The primary ground for challenge is that the impugned Design No. 202108 is purely functional and mechanical in nature and hence is not registrable. The contention of the petitioner is that the product is a combination of small components, and is not visible to the eye when applied to the cycles and could not have constituted a design under the provisions of the Designs Act 2000. The appellant relied on a certificate of a chartered engineer to demonstrate that the "Coaster Brake Sub Assembly" is the mechanical part/functional part of "Coaster Brake Hub". The private respondent had been selling the products since 2003 onwards as would be evident from the sale invoices. The impugned design was previously published in Indian bicycles channels Velo Bike Special Issue, February 2005. Each and every part of the "Coaster Brake Sub Assembly" of the impugned design were itemised and published in the advertisement in Velo Bike Special Issue, February 2005. If all the parts were to be put together the result would be the very same sub assembly as registered under the Registered Design No. 202108. There is no feature of shape or configuration or pattern or ornament or composition and colours on the face of the product and it is just a mechanical device. The design is a mere mechanical contrivance which is the working part of the coaster brake hub and it goes completely into the brake hub not being visible to eye.

In brief these were the submission made before the controller for cancellation.

The defence of the registered proprietor with reference to the advertisement in the Velo Bike Special Issue February 2005 was that it pertains to Coaster Brake Hub (Russian model) of Eagle brand. It also forms a part of the plaint filed by the registered proprietor before the District Court, Ludhiana. The distinguishing features of the registered design to the article in question in its finished state had not been shown in any manner whatsoever in the said advertisement of February, 2005. The parts shown in the advertisement dated February 2005 would not result in the article being the impugned design in its finished state as the instant registered design is to be considered and judged solely by eye in the finished state of the article. The design is not a mechanical device and the representations of the said design contain disclaimer against mechanical and/or function of the article. None of the sale invoices on which the private respondent has placed reliance contains any specific indication of the said design part. The registered proprietor appears to have produced before the Controller for visual inspection, one sample of Coaster Brake Sub Assembly bearing design registered Design No. 202108 to which the response of the appellant was that there was no evidence to show that it was in any way different from the sub assembly which has all along been fitted into the Russian model advertised in the Velo Bike Special Issue February 2005 and if all of the parts advertised therein were to be put together, the result would be the very same sub assembly of registered Design No. 202108.

On consideration of the submissions made on behalf of the parties as well as on the basis of the evidence on record the Deputy Controller observed that the

impugned design does not consist any mode or principle of construction of the article which is disclaimed in the representations. The expert's certificate relied upon by the appellant only stated the coaster brake sub assembly is the mechanical or the functional part of coaster brake hub but does not specify that it is a mere mechanical device. The statement that the product is a combination of small component and is not visible to the eye when fitted to some other article, does not disqualify a design from being registered. The design has to be judged by eye in the finished article itself. Accordingly, the Deputy Controller held that the impugned design is not a mere mechanical device and thus it is not disqualified as a design.

With regard to the prior publication the controller had taken into consideration the sale invoices and observed that none of the sale invoices would indicate or specify that they are in relation to the particular "Coaster Brake Sub Assembly" bearing the impugned design. The said invoices do not specifically show sale of "Coaster Brake Sub Assembly" and in view thereof the objection with regard to the prior publication on the basis of sale invoices that the article bearing the impugned design was manufactured, sold or used prior to its date of registration was held to be not established and not proved. The correspondence being annexure P-1 to P-13 of the statement of case was also considered and it was held that they do not suggest publication of the particular subject design before its date of registration.

The submission of the appellant that every part of the "Coaster Brake Sub Assembly" of the impugned design were itemised and published in the advertisement in Velo Bike Special Issue February 2005 and that if all the parts were to be put together it would result in the impugned design was also not accepted on the ground that the said publications do not suggest or establish the said objection of the appellant as it was not supported by any expert evidence or certificate to corroborate the aforesaid contention. The assistant controller accordingly arrived at a conclusion that the impugned design is not anticipated by prior publication. The petitioner has not been able to establish that the registered design was used and published prior to its date of registration inasmuch as it cannot be contend that the registered design is not new or original.

This judgment of the Assistant Controller is under appeal.

In AID 3 of 2012 I have dealt with the aspect of design as well as what would constitute prior publication, in relation to Coaster Brake Hub. On consideration of the material on record I have arrived at a conclusion that the registered design for article Coaster Brake Hub is devoid of newness and originality in as much as the said design was taught and anticipated by a prior publication, in Velo Bike Special Issue, February 2005 In the instant appeal the registration of Coaster Brake Sub Assembly is at issue. The endeavour of the appellant in the appeal is to demonstrate that in rejecting the application for cancellation of the design the Assistant Controller has failed to take into consideration the prior publication of

such designs which would demonstrate that if all the parts advertised in the prior publication were to be put together the result would be the very same sub assembly and hence devoid of novelty or originality. Apart from that, submissions have been made with regard to the scope and ambit of definition of "article" in Section 2(a) and "design" in Section 2(d) of the Designs Act, 2000.

During the hearing of this application I directed the controller to produce copy of the documents considered prior to registration. In terms of the said direction, the controller has produced all documents relating to pre-registration under Sections 5 and 44 of the Designs Act, 2000 for registration of the Registered Design No. 202108 dated 11th November, 2005 under class 12-11 titled as Coaster Brake Sub Assemblies. From the document produced it appears that at the time of examination of the said design few objections were raised by the examiner of Patents and Designs which, inter alia, include the following:-

"19. The designs prima facie appears to be lacking in novelty, as the article illustrate appears to be well known if there is any novel feature, the same should be pinpointed in the representation sheet and statement of novelty should be amended accordingly.

30. Views as shown in the representation sheets are not consistent with each other as indicated. View(s) is/are not correctly named and should be amended as indicated." (emphasis added)

In response to the said objection, the patent and trademark attorneys of the registered proprietor by a communication dated 12th April, 2006, inter alia stated:-

"3. Objection No. 19- Your good office has failed to cite any prior registration in support of the objection and therefore the objection is not maintainable and may please be waived.

4. Objection No. 20 (should read as 30)-Complied with".

The interesting point that falls for consideration is that should sub assembly be treated as an article under Section 2(a) of the Designs Act and the design of that article can be independently considered without referring the design of the principle component. In other words, if the design of the sub assembly can be independently considered as a subject-matter of design irrespective of the design of its principle component. It also raises an issue as to whether if the design of the principle component within which the sub assembly would subsume or fitted in would be a ground for non-consideration or disqualification of the sub assembly for registration of the design even if as an article of commerce it is found to be novel and original.

Mr. Ranjan Bachawat, learned Senior Counsel appearing on behalf of the appellant has submitted that the order of the Controller dismissing the application for cancellation of the Design No. 202108 is erroneous and cannot be sustained. It is submitted that the coaster brake hub is a braking device used in

countries such as Russia where conventional disk brakes cannot function due to extreme cold climate. The complete device of the coaster brake hub comprises of a coaster brake hub shell and the coaster brake sub assembly which is fitted to the shell and is the mechanical /functional part.

Mr. Bachawat stated that the Examiner had objected to the registration of the design, inter alia on the ground, that the design is a mere mechanical contrivance and the shape of each part is solely dictated by function apart from lacking in novelty. It is submitted that this seems to have been overlooked by the Controller in granting registration. In any event the records available do not disclose any reasons for granting registration despite such objection. The Chartered Mechanical Engineer's Certificate clearly opines that the Coaster brake sub-assembly which goes into the shell and is a mechanical /functional part. Further, the certificate does not mention that the sub assembly or any part thereof has any eye appeal.

It is argued that registration of Design No. 201728 of the Coaster brake hub has been granted for the entire article i.e. a coaster brake hub which comprises of the shell together with the "Coaster brake sub assembly". The registration of the entire article, i.e. the coaster brake hub includes the sub-assembly. Thus having obtained registration of the sub-assembly as a part of Design no 201728, the registered proprietor could not have later applied for separate registration of the sub-assembly. The subsequent registration of the sub assembly bearing Registration No.202108 is invalid both on the ground of prior registration and prior publication. In this context, Mr. Bachawat has relied upon the documents referred to in the Ludhiana suit to show that admittedly the coaster brake hub and the sub assembly which formed a part thereof were sold together since 2003-2004 long prior to the registration. The sub assembly was also sold separately since 2003-2004 as a replacement/ spare part prior to its registration. The learned senior counsel has referred to the following documents disclosed by the registered proprietor and other documents which were before the Controller :-

- i. Advertisements published by the registered proprietor in the Velo Bike Special February 2005 and Punjab Kesri prior to the registration
- ii. The plaint and the injunction filed by the registered proprietor referring to sales of "the said cycle parts "in 2003-2004.
- iii. Bills and invoices relied on by the registered proprietor in the infringement suit.

Relying on the said documents it is submitted that it is clear that by adducing the evidence mentioned above the registered proprietor was seeking to establish in the suit that it was the prior user of the design and had huge sale without realizing that the same could invalidate its registered design.

In relation to prior publication, Mr. Bachawat submits that the evidence on which the applicant for cancellation rely includes the plaint filed by the registered

proprietor in the Court of the District Judge at Ludhiana and the annexure thereto including the Velo Bike special issue February 2005. The said publication was much prior to registration and dissolves the whole article comprising both coaster brake shell and sub assembly. The Registered Proprietor has itself stated in its plaint, in paragraph 5, that it had made wide publicity of cycle parts in various magazines and also showed its products in exhibitions, long prior to its applications for registration. The invoices annexed to the plaint would show that the subject design has been pre-published prior to the date of registration. The said invoices relate to the sale of Coaster brake hub complete and also of the assembly for the period 9th March 1996 to 1st October 2005. My attention has been drawn to the commercial invoices of registered proprietor dated 24th May 2005 evidencing sale of "Complete internal assembly for coaster brake hub Russian type axle, sprocket black colour with flange nut" with Export Invoice No. 402 dated 24th May 2005. Much emphasis has been laid to the statements made in the suit proceeding that both the alleged invented products had been sold from the year 2003 onwards indigenously as well as abroad by the registered proprietor. It has been argued that admittedly the registered proprietor had in hand huge orders for its products from Ukraine in Russia, Singapore etc. which also showed that the so called designs were in the public domain before registration and the averments made in the plaint particularly in paragraph 11 are clear and admits of the fact that the Registered Proprietor was manufacturing both the Coaster brake hub as well as the Coaster brake sub assembly from 2003 onwards and was marketing such products in lakhs of units both in India as well as in Ukraine, Russia and other places abroad. The sales figures appearing in paragraph 11 of the plaint show sales of both coaster brake hub as well as the coaster brake sub assembly from the year 2003 and 2004 onwards which was long before the registration obtained by the registered proprietor in India and which establishes the prior publication of the said impugned designs. The registered proprietor had also annexed advertisements to the plaint filed in Ludhiana suit evidencing sale of Russian model coaster brake hubs. These included publications in the magazine Punjab Kesari of February, March, April and August 2005 all carrying photographs of the registered designs. The registered proprietor also annexed a series of advertisements which it had published in a magazine called "Bike Europe" claiming in such advertisement to be the manufacturer of the "Russian model coaster brake hub" with reproductions by way of publications of its products. Copies of such advertisements published abroad were inter alia dated February, 2005 and April, 2005, long before the registration obtained by the registered proprietor in India. In sum and substance, the plaint and the annexures thereto establish that the registered proprietor had from long before October/November 2005 put its so-called inventions in the markets, hence, the case in the plaint attracts the application of each limb of section 4 of the Designs Act and demolishes the claims to registration altogether. From the admissions contained in the plaint, it is evident that the registrations had been obtained by the registered proprietor fraudulently and the design was neither new nor original. Having held that Design No. 210728 had been pre-

published and cancelled the same, the Controller was obliged to hold Design No. 202108 as also having been pre-published as it admittedly formed a part of Design No. 201728. It is argued that in an attempt to explain the admissions contained in its plaint, the registered proprietor now alleged that it had invented a traditional coaster brake hub and also a newly designed coaster brake hub and sub assembly with some differences. This attempt is evidently an afterthought and without any basis and is contradicted by the averments in the plaint. In any event a perusal of the same would show that the so-called differences are admittedly insignificant and have nothing to do with designs. Hence, the explanation is unacceptable and has to be rejected.

The first Registration being Design no 201728 has been granted on 10th October 2005 for the entire article i.e. a coaster brake hub which comprises of the shell together with the "coaster brake sub assembly". The registration of the entire article, i.e. the coaster brake hub includes the sub-assembly. Thus having obtained registration of the sub-assembly on 11th November 2005 as a part of Design no 201728, the registered proprietor could not have later applied for separate registration of the sub-assembly. The subsequent registration of the sub assembly bearing Registration No.202108 is invalid both on the ground of prior registration and prior publication.

Mr. Bachawat, has submitted that there is a marked difference between the Designs Act, 2000 and the English Designs Copyright and Designs Patent Act, 1988 and accordingly the definition of articles and/or design in the English statute may not apply in interpreting the definition of "article" and "design" under the Designs Act, 2000.

The learned Senior Counsel has referred to the definition of "article" in section 2(a) of the Designs Act, 2000 and submitted that 'article' includes any part of an article capable of being made and sold separately. The Registered proprietor has included the sub-assembly in the design titled Coaster Brake Hub and the sub-assembly being visible in the registration of the article Coaster Hub, the same is also registered to the extent of shape, configuration and surface pattern having eye appeal.

Having obtained registration of the whole Coaster Brake Hub including the sub-assembly the registered proprietor could not have applied for separate registration of the sub-assembly for the following reasons:

- i) Prior registration (as part of the whole);
- ii) Prior publication of the sub-assembly, being part of the whole article;
- iii) Subsequent application for part of Article would, therefore, lack originality and novelty, having been part of the earlier registration, even if not visible to the eye;
- iv) Prior sale of Coaster brake Sub-assembly;

A design which is registered may be a part of another article. Thus handles of

wardrobe and fancy steering wheels of cars can also be registered separately as long as they are made and sold separately, that is, not simply as a spare part of a greater article or as an adjunct of some larger article of which it forms a part as observed in Ford Motor Company Limited's Design Applications (1995) RPC 167). The House of Lords in the Ford's case (*supra*) has construed "made and sold separately" to not include an Article made and sold simply as a spare part of the greater article. To be registrable, it must have an independent life and not merely an adjunct of the larger article of which it forms a part. The Court drew a distinction between spare parts and items with fancy designs, which may be bought for its own sake and not simply as a replacement part i.e. the proprietary article, which by its own nature, is made and sold separately as a fancy item. It is stated in such a case while the former is not registrable the latter is however registrable. Mr. Bachawat relying on the said judgement has argued that the Coaster Brake Sub Assembly is a spare parts and not a stand-alone item with any artistic feature and not sold separately as a fancy item and hence not registrable.

The learned senior counsel has argued that invisible parts of an article cannot be registered as Design to which Mr. Roychowdhury the learned counsel on behalf of the Registered proprietor has argued that there are instances where Courts have held that even the invisible parts are registered. Reliance was placed by the Registered proprietor on P. Ferrero And C.S. P A's Application reported at 1978 RPC 473 and K. K. Suwa Seikosha's Design Application reported at 1982 RPC 166 in support of such argument. The Registered proprietor has also referred to AMP Incorporated v. Utilux Proprietary Limited reported at 1972 RPC 103 in support of this proposition. The first two authorities according to Mr. Bachawat are, however, orders of the Controller passed in some extreme cases and cannot be cited. In any event, the same do not support the proposition for which the same was cited. Reliance on AMP (*supra*) is also misplaced as this case was concerned only with external parts and the Court had no reason to decide on the question of registrability of invisible parts. Hence, observations made therein are obiter dictum. In any case, there is no positive finding on this aspect in the judgment. Court has merely observed that the Designs Act "may not preclude" the possibility of invisible parts being registered, but did not decide the issue. Moreover, the examiner had also objected to registration being granted on the ground that the design is a mere mechanical contrivance and the shape of each part is solely dictated by function. These findings find support in the Expert Certificate relied on by Lucky Exports. This seems to have been overlooked by the Controller in granting registration. At least the records available do not disclose any reasons for granting registration despite such objection. There is also no order available on the records to show that the Controller has taken into consideration the response of the Registered proprietor to the objections taken. From the available documents it appears that In response to the objections raised by the Examiner of designs International cycle gear itself admitted that the coaster brake hub is a mechanical device by reasons whereof the design

could not have been registered. The sub-assembly being functional part of the whole mechanical device could not have been registered as the same is also mechanical and functional in nature.

Mr. Bachawat has submitted that there is a distinction in the requirements of the law in England and law in India on this aspect of the matter. The definition of 'Design' in U.K. in Section 1(1)(b)(i) of the Registered Designs Act, 1949 specifically states that "a design does not include features of shape of configuration of an article which are dictated solely by the function which the article has to perform. This requirement is missing in the definition of 'Design' in the Design Act, 2000. Hence, there is a difference between the definition of design in U.K. and in India. It is by reason of the aforesaid requirement in U.K. that the English judgments have held that unless a design is dictated solely by function, it would be registrable. Thus, designs which are functional but also have eye appeal have been held to be registrable in U.K. In the absence of such a requirement in Indian law, it is submitted that if an article is a mere mechanical device, it would not be registrable. There is no scope to apply the test of whether it is dictated solely by the function of the article.

The Controller has failed to appreciate this vital difference and distinction in considering the Expert Certificate. While the Controller has recorded in the impugned order that the Expert Certificate relied upon states that the article is a mechanical/functional device, he held that this, in itself, could not be a ground to hold that the same was not registrable on the basis that for the device to be held to be a mere mechanical device all the features of the device has to be dictated solely by the function which the article is to perform by placing reliance on the English authority, reported in AMP's case (supra). The Assistant Controller according to Mr. Bachawat has overlooked the differences in the two statutes and mechanically applied the ratio in AMP (supra) ignoring that there is a specific requirement in English law on the basis of which for a device to be a mere mechanical device, all features are required to be dictated solely by the function which is not a requirement under the Indian Designs Act, 2000.

Hence, the registration of the sub-assembly is invalid and should be cancelled.

The learned Senior Counsel has relied on *Castrol India Ltd. v. Tide Water Oil Co. (I) Ltd.* reported at (1996) 16 PTC 202 and stated that it reiterates the principles enunciated herein above that the object of the Design's Act is to protect shape and not functional shape. The controller herein did not consider and has not given any finding in respect of the expert's report wherein the impugned article has been stated as 'functional'. Therefore, if the article is functional in shape, it will not be granted registration as held in *Tide Water Oil case* (supra).

Per contra, Mr. Soumya Roy Chowdhury, appearing on behalf of the respondent has submitted that the correct test would be, whether the design is a solely functional one or is a mere mechanical device and not whether it is more attributable by its mechanical function rather than its design. In other words, a

design registration is prohibited only in a case where it is found that the subject design is solely functional. A design, being "more attributable to function" does not mean that it does not have any eye appeal. A part of a design may be functional and there may be a part of the same design, which may have an eye appeal. In such cases, a design can be registered.

Mr. Roy Chowdhury referred to section 2(d) of the Design Act, 2000 for the definition of 'design'. It is submitted that the said definition makes it clear, that only when the design is a mere mechanical device or in other words is solely functional, only in such cases, the same does not qualify as a design under Section 2(d) of the Designs Act, 2000. It is submitted that Lucky Exports have tried to make a specious distinction saying that the term 'dictated solely by function' is not there under the Indian Law and made an attempt to dilute the correctness of the judgement in ITC Limited vs. Controller of Patents & Designs reported at 2017(2) CHN 367 (Cal). However, the said understanding is incorrect as under the Indian law, the term 'judged solely by the function' is very much present in the definition of design under Section 2(d) of the Designs Act, 2000 in the form of "mere mechanical device". Mr. Roy Chowdhury submits that there is no difference between the terms 'dictated solely by function' and 'mere mechanical device'. The same would also be clear since a mere mechanical device has been excluded from the purview of design registration under the Indian law. A mere mechanical device would mean a device which is solely dictated by function. The law, as has been laid down by the ITC Limited (supra) as well as the other judgments which have been followed in the said decision lays down the correct proposition of law. It is submitted that it is possible for a design, which has both mechanical function as well as eye appeal to be registered as design under the Designs Act as observed in ITC (supra).

Mr. Roy Chowdhury submits that the law is well settled that even a part of an article if capable of being made and sold separately can be registered as a design. The finished article which is capable of being made and sold separately is the Coaster Brake Sub Assembly which is a separate product altogether from the Coaster Brake Hub which is visible to the eye at the time of purchase. The learned Counsel emphasized that Lucky Exports themselves have admitted in their written statement filed before the Ludhiana Court that they have been manufacturing and selling both the products.

Mr. Roy Chowdhury refers to Section 2(a) of the Designs Act, 2000 and submits that the definition of 'article' explicitly includes 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.

It is therefore submitted that the Coaster Brake sub Assembly as a part of Coaster Hum can be treated as an article capable of Registration. The respondent accordingly has prayed for dismissal of the appeal.

Section 2(a) of the Designs Act, 2000 defines the term 'article' to mean 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.

The phrase "capable of being made and sold separately" was not in the Designs Act 1911. This phrase was added in the Designs Act 2000 to enlarge the definition of article and design. In *Marico Ltd v. Raj Oil Mills* reported in AIR 2008 Bom 111 the Court observed:

"17.The definition of 'article' under the Act as reproduced above read with the definition of 'design' are different from the provision of the English statute as reproduced above and importantly, the following words 'includes any part of an article capable of being made and sold separately', whereas, in the English statute the words are 'if that part is to be made and sold separately'. Therefore, the words 'capable of being made and sold separately' has to be read and considered in the context of the Act. The English Law is silent with regard to the above words of the Act. The repealed Act 1911 defines 'article' means any article of manufacture and any substance artificial or natural or partly artificial or partly natural. The above words 'capable of being made and sold separately' were not there earlier. Therefore, as noted in the objects and reasons and as intended to enlarge the definition of 'article' and 'design' above words have been inserted. These words are clear and unambiguous.

29. The phrase as inserted in the Act, now even covers 'any part of an article capable of being made and sold separately'. Apart from any article of manufacture, therefore, we have no doubt that the words inserted in the Act have a wide meaning and are not to be restricted to exclude an article and or event he part of an article which is 'capable of being made and sold separately', as contended and as held by the learned Judge. There is no question of giving the restricted meaning to exclude finished design article like cap in question which admittedly and factually were and are made separately. These caps are capable of being sold separately." (emphasis added)

The definition of an 'article' thus effectively imposes two requirements in order for an object to count as an article for the purposes of design registration. First, it must be an "article of manufacture" and secondly, it must be "made and sold separately". It must be pointed out that these requirements are similar to the requirements for an object to qualify as an 'article' under the English Registered Designs Act 1949 ("RDA").

The jurisprudence relating to section 44(1) of the RDA, which contains the definition of "article" is clear that an article in respect of which a design is registered can be part of another article. Thus, even though the coaster break sub-assembly fits into the shell of the coaster break hub, for which a separate registration application had been filed, that by itself will not lead to a rejection of the application for registration of the coaster break sub-assembly. Such items such as handles for wardrobes, or fancy steering wheels for cars, can be the

subject of design registrations in their own right (as distinct from merely forming part of the design of the greater article into which they are incorporated - in this case, the coaster break hub). The only qualification to this is that the article must be made and sold separately. The House of Lords, in this context, has however added another qualification to the "made and sold separately" requirement and stated that it is not sufficient that the part concerned is made and sold simply as a spare part for the greater article, it must in addition "have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms a part". (See Ford Motor Co.'s Design Applications (1994) RPC 545, per McCowan LJ, QB Div Ct.; approved in Ford Motor Co.'s Design Applications (1995) RPC 167 by Lord Mustill)

The law is well settled that even a part of an article if capable of being made and sold separately can be registered as a design. The finished article which is capable of being made and sold separately is the Coaster Brake Sub-Assembly which is a separate product altogether from the Coaster Brake Hub which is visible to the eye at the time of purchase. Lucky Exports themselves have admitted in their written statement filed before the learned Ludhiana Court that they have been manufacturing and selling both the products.

For an article to qualify as a design, in my view, it should have an eye appeal and not be a mere mechanical device. The definition of article in Section 2(a) makes it clear that the article, inter alia, includes any part of an article capable of being made and sold separately. It is immaterial whether the said article is visible or invisible. A sub-assembly of an article would constitute a part of an article and it can be capable of being sold separately as it happens in the instant case. The proceeding in the Ludhiana Suit would show that both the plaintiff and the defendant are rivals in the trade and both are selling the coaster brake hub and coaster brake sub assembly separately. However, what is of importance in the context of prior publication is if the same coaster brake sub assembly is sold by the respondent prior to its application for registration of design of coaster brake sub assembly and on enquiry it is found that the coaster brake sub assembly sold earlier by the respondent is same and/or similar to the registered impugned design, then the said design is not registrable in view of prior publication unless differences between the two designs are noticeably distinguishable, remarkably different and distinct. Moreover, the later design should not be in substance a mere mechanical device and must be new or original. It should appeal to the eye. There cannot be any doubt that when spare parts are considered from the point of view of design, it should have some unique features which might induce and/or influence the mind of a customer to buy the said part separately without the main article although the said article may not even put to any use. The Law Lords in Ford has decided that in order to satisfy this requirement it is not sufficient that the part concerned is made and sold simply as a spare part for the greater article; it must in addition "have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part." In applying this test the House dismissed an appeal against the rejection

of applications to register designs in respect of components for cars such as main body panels, doors, bonnet lids, boot lids and windscreens and in doing so, the House of Lords appeared to have approved the distinction drawn by the lower courts between these category of items which could be sold simply as spare parts and items such as wing mirrors, seats and steering wheels, where customers might buy fancy designs for their own sake and not simply as replacement spare parts. These latter articles were referred to as "proprietary articles", which by their nature were susceptible to being made and sold separately.

The House of Lords in *Ford* (supra) cited with apparent approval the observations of Graham J. in *Sifam Electrical Instruments Co. Ltd. v. Sangamo Weston Ltd* reported at 1973 RPC 899 (at 913), who was considering whether the fronts of electrical meters were registrable under the Registered Design Act.

"The meter front here is not now and never has been sold separately nor was it ever intended that it should be If an article or part of an article is in fact being sold at the time of the application to register that in itself would invalidate the registration because the design would have been published and would not be new or original within sub section (2). What then do the words mean? The defendants say they mean "susceptible of being sold separately," which they say this meter front is. But here again any part of any article is susceptible of being sold separately even if, for example the part has to be forcibly removed from the whole of the article of which it forms part... why should designs not be registrable for such parts which to give the words such a meaning would have the result that any part of any article could then be registered and thus would defeat the apparent intention of the Act. One might also then ask: when is part of an article not an article in its own right?

... The intention must be to grant registration only for such articles as are intended by the proprietor of the design to be put on the market and sold separately, such as for example a hammer handle, or a bit for a bradawl....The words used are "if that part is made and sold separately", and the phrase as a whole, to my mind, confirms that both the manufacture and sale of the part in question must be operations which are distinct from the manufacture and sale of the whole article of which the "part" forms a component. It is necessary to imply the words "to be" in order to construe the phrase as not including sale of the part prior or at the date of the application for registration since this would produce an absurd result contrary to Section 1(2) and cannot possibly have been the intention of the legislature."

Design protection can also be claimed for a set of articles. Indian law defines a "set" as "a number of articles of same general character ordinarily sold together or intended to be used together, all bearing the same design, with or without modification insufficient to alter the character or substantially to affect the identity thereof". Examples include furniture sets, tea sets and dinner sets. If a particular design is to be registered for articles in different classes, separate

applications must be filed. Further, a design may be registered for different embodiments, provided that a separate application is filed for each embodiment. The filing of multiple embodiments of the same article in a single application is not permissible under Indian law. In order to protect part of an article, each part must meet the requisite condition of "capable of being made and sold separately". If part of the article is capable of being made and sold separately and can be judged solely by the eye, design protection can be obtained for such part. (See: Russell-Clarke and Howe on Industrial Designs (Ninth Edition, Chapter 11) The definition of "design" under the Registered Design Act, 1949 (in its pre-2001 version) registration is Section 1 reads:-

"In this Act "design" means features of shape, configuration, pattern or ornaments applied to an article by any industrial process being features which in the finished article appeal to and are judged by the eye, but does not include-

- (a) a method or principle of construction, or
- (b) features of shape or configuration of an article which-
 - (i) are dictated solely by the function which the article has to perform, or
 - (ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part."

Thus, Section 1(b)(ii) excluded features of shape and configuration from the statutory definition of "design" which "are dependent upon the appearance of another article of which the article is intended by the author to form an integral part."

The definition of "design" under the present English Law is:-

"1. A design may, subject to the following provisions of this Act, be registered under this Act on the making of an application for registration.

2. In this Act "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

3. In this Act- "complex product" means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product; and "product" means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product. (substituted by the Registered Designs Regulations (SI 2001/3949) reg 2)"

Under the unamended Registered Designs Act 1949 (pre-2001), a design shall not be registered in respect of an article if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description,

and would not be so taken into account if the design were to be applied to the article.

A design shall not be regarded as new for the purposes of this Act if it is the same as a design-

(a) registered in respect of the same or any other article in pursuance of a prior application, or

(b) published in the United Kingdom in respect of the same or any other article before the date of the application.

There are various other grounds on which a design may be refused to be registered but those grounds are not material for the present. The current version of Registered Design Act 1949 in Section 1B lays down the conditions required to be taken into consideration in deciding whether the design is registrable. Under the present law a design is protected to the extent that the design is new and has individual character. A design is new if no identical design or no design whose features differs only in immaterial details have been made available to the public before the relevant date. However, the significant changes made in the current version of the Registered Design Act, 1949 is the introduction of the words "complex" product and Section 1B (8) which reads:-

"For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character-

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character."

The test of visibility was absent in the earlier statute which the our Designs Act 2000 has no similar definition of complex product or similar provision. The statute proceeds on the premise that the finished article should appeal to the eye and is to be judged solely by the eye but does not include, inter alia, anything which is in substance a mere mechanical device, which phrase, is akin to the phrase 'are dictated solely by the function which the article has to perform' under pre-2001 Registered Design Act, 1949 and 'which are solely dictated by the product's technical function', under the current Registered Design Act, 1949. However, the essence is the same. In absence of a provision similar to Section 1B(8), the argument of Mr. Bachawat that the Sub-assembly cannot be independently treated as an article for the purpose of consideration as a design cannot be accepted. One has to proceed on the basis of the definition of 'article' and 'design' as it appears in Designs Act 2000 and in interpreting the said provisions one may apply the principle laid down by the English Courts in interpreting the expression 'design' under the pre-2001 Registered Designs Act. The decision in Ford (supra) was rendered under the Registered Designs Act

1949 (pre-2001).

Mr. Roy Chowdhury, has drawn my attention to the observation made in *Castrol India Ltd. (supra)*, for the proposition that when a design is sought to be registered, the Controller of Patent and Design must be satisfied that the design was new and original. The observation in *Castrol India Ltd. (supra)* with regard to the tests to be applied in considering whether the design is, in fact, novel is important. Paragraph 19, 20 and 21 which are as follows:-

"19. The court is then to consider whether the design is in fact novel and if so to what extent. This follows from section 43 of the Act under which the registration under the Act can be made of a new or original designs not previously published in India.

20. But all novel designs are not protected. Novel designs which are purely functional cannot found an action for infringement (see : *In re: Lamson Industries Ltd.'s Application* (1978) RPC 1). The object of the Designs Act is to protect shape but not a functional shape and if shape and configuration are dictated solely by function it is not registrable as a design. The decision in the case of *Amp. Inc. vs. Utilux Pty. Ltd*: 1972 RPC 103, of the house of Lords related to the manufacture of electric terminals.

21. Lord Reid J. Said: "... and the words 'judged solely by the eye' must be intended to exclude cases where a customer might choose an article of that shape not because he thought that the shape made it more useful to him."

The words "judged solely by the eye" shows that the customer must be influenced only by the eye and not by the suitability of the article for any particular purpose (*Amp vs. Ulitex (supra)* at page 108 (HL)). The design in order to qualify for registration essentially has to have an 'eye appeal'.

A design for shape in which all the features are dictated solely by the function which is to be performed by the article to which the shape is applied, and that shape possesses no features beyond those necessary to enable the article fulfil its function is a mere mechanical device. [*Stenor v. Whitesides* reported at (1946) 63 RPC 81 at p.91 (CA)]

A device is nonetheless mechanical whether the mechanism with which it is to be used is devised before or after the device. Primarily the object of the Act is to protect shape not function, and not to protect functional shape. [*Stenor v. Whitesides* (1948) 65 RPC 1 at p.10 (HL)]"

In the present case, it appears that in the impugned order the report of the examiner expressing the view that the design lacks novelty and/or originality was not considered at all. There must not only be a finding to the effect that the article is not a mere mechanical device but also a positive finding that the article appeals to the eye. The assistant controller has proceeded on the basis that the design is not a mere mechanical device. But crucially, there is no clear finding that the designs in the finished article appeal to the eye.

The Chartered Engineer's report opines that "Coaster brake sub-assembly" which goes into the shell of the coaster break hub is a mechanical/functional part. The appellant contends that since the expert's report has stated that the coaster break sub-assembly is a mechanical/functional part, the Assistant Controller erred in ignoring this report and granting registration for the coaster break sub-assembly.

he Assistant Controller's after taking note of the expert's report has held that - "the expert's certificate only states that the sub assembly is a mechanical/functional part but does not specify that it is a mere mechanical device. The statement, that the product is a combination of small components and is not visible to the eye when fitted to some other article, does not disqualify a design from being registered. The design has to be judged by the eye in the concerned finished article itself. I, therefore, opine that the impugned design no. 202108 is not a mere mechanical device and thus qualifies as a design." (emphasis added)

The protection under the Designs Act is granted only to those designs which have an aesthetic value or otherwise appeal to the eye. There may be, however, cases where the design while fulfilling the test of being appealing to the eye, is also functional. (*Mohan Lal v. Sona Paint & Hardwares*, AIR 2013 Del 143: 2013 (55) PTC 61 (Del) and *Micolube India Limited v. Rakesh Kumar*, 2013 (55) PTC 61 (Del) (FB) at p.75).

In *Kestos Ltd. v. Kempat Ltd.*, (1936) 53 RPC 139, the court observed that "a mere mechanical device is a shape in which all the features are dictated solely by the function or functions which the article has to perform". In *AMP Incorporated v. Utilux Proprietary P. Ltd.*, (1972 RPC 103), the House of Lords approved the above statement of law in *Kestos Ltd.* (supra). The House of Lords held that "dictated solely by function" meant "attributable to or caused or prompted by function". The House of Lords further held that where a design would perform a particular function, but the designer had also added some features of shape that appealed to the eye and was additional to or supplementary to the function the design could be registered. In other words, where a designer sets out to produce an article that would perform a particular function, but where in producing it he has added or applied some features of shape that are additional to or supplementary to what is functionally needed, with the result that in the finished article there are features that appeal to the eye, there may be a design which is registrable within the statutory definition.

Further, in *Cow (P.B.) and Coy Ltd. v. Cannon Rubber Manufacturers Ltd.* reported at 1959 RPC 347, referred to in *Whirlpool of India Ltd. v. Videocon Industries Ltd.* reported at (2015) 1 BomCR 137, the Court held that there may be cases where the design while fulfilling the test of being appealing to the eye is also functional.

In *ITC Limited* (supra), this Court has held -

"76. It is also well-settled that where a design could particularly perform a

particular function but the designer has also added some features of shape that appealed to the eye and are additional to or supplementary to the function, the design could be registered."

In *Anuradha Doval vs. The Controller of Patents and Designs & Ors.* reported at 2017 (71) PTC 288 (Cal) it is observed:

"20. The design must be such that in the finished article the features of it 'appeal to and are judged solely by the eye'. It does not relate features which are dictated by function. The rationale behind this exclusion is that the point of design protection is to reward and encourage good product design by protecting the skill, creativity and labour of product designers. Design is concerned with both form and function. Design law is not seeking to reward advances in function. A good subject of design must be visually appealing, though it need not be an artistic work or possess artistic merit. The purpose of the Designs Act was to protect novel designs devised to be applied to particular articles to be manufactured and marketed commercially. In *Parle Food Products Pvt. Ltd. vs. Surya Food and Agro Ltd.*, reported in 2009 (40) PTC 638 (Mad) (DB) at p.648, the Court stated that the purpose of the Designs Act was to protect novel designs device to be applied to particular articles to be manufactured and marketed commercially. The main concern was what the finished article was to look like and not with what it did".

"29. Design is a conception, suggestion or idea of a shape and not an article. If it has been already anticipated or pre-published it is not "new or original". A design which is prior published cannot be considered as new. Publication before registration defeats the proprietor's right to protection under the Act. *Niki Tasha Pvt. Ltd. v. Faridabad Gas Gadgets P. Ltd.*

"37. The principle that emerges from the judicial decisions as well as from the authorities on the subject is that, in the event, it is found that the impugned design has substantial identity with the prior published design, it is liable to be cancelled. In order to claim novelty, there has to be a significant change or difference in the design, although, it may have a common source. A mere trade variant without significant and substantial noticeable features would destroy novelty. A drawing or publication of a design in any form must suggest explicitly or implicitly by context that the pattern or picture should be applied to an article."

From the above decisions and also a reading of section 2(d) of the Designs Act, what emerges is that it may be possible for an article to be functional and at the same time has an eye appeal. As long as the article is not merely a functional device and has an eye appeal, it is capable of design registration, if other requirements are met.

There is a distinction between a mechanical part and a mere mechanical device. In the present case, the expert's report did not state that the coaster break sub-assembly was a mere mechanical device. However, for the article to be granted a design registration, in addition to this requirement being met, the Controller

would also have had to certify that the article had eye appeal. In the present case, the Assistant Controller has not independently arrived at a conclusion that the design of the coaster break sub-assembly has eye appeal.

The appellant contended that the coaster break sub-assembly ought not to be given registration as the subject design formed part of the design of coaster break hub which has been pre-published prior to the date of registration, including in the 'Velo Bike' Special Issue of February 2005; February, March, April and August 2005 issues of 'Punjab Kesari'; and 'Bike Europe'. The appellant also contended that the coaster break sub-assembly was also hit by prior registration since the earlier registration obtained by the appellant for the coaster break hub had included the design of the sub-assembly and the said sub-assembly was visible in the registration of the coaster break hub.

On prior publication, the Assistant Controller held that each of the exhibits related only to the coaster break hub. It was further stated - "Learned Counsel for petitioner pleaded that every parts of the coaster brake sub-assembly of the impugned design No. 202108 were itemized and published in the advertisement published in Velo Bike Special Issue February 2005 and it was stated that if all of the parts were to be put together, the result would be the very same sub assembly as registered under registered design No. 202108. It is observed that aforesaid publications do not suggest or provide any hint to the validity of this statement. Such statement is not supported by any expert's evidence or certificate to corroborate said criteria. Therefore, I opine that petitioner is not able to establish that the impugned design was published prior to its date of registration."

By an order dated 17th May, 2011, this matter had earlier been remanded back to the Controller for a fresh consideration on merits. The Controller had been directed to consider two important issues, namely, prior publication and the originality and novelty of the design. The controller was directed to take into consideration all the evidence that had been annexed not only to the affidavit of evidence but also the evidence annexed to the Ludhiana suit. The evidence annexed in the Ludhiana suit contains invoices that disclose the sale of the article in question. This has not been considered by the Assistant Controller. In any event, the onus lay on the registered proprietor to show that the design of the impugned article is significantly different from the design of the coaster break sub-assembly sold under those invoices. The registered proprietor claims to have improved on the existing designs. However, it is unclear from the order of the Assistant Controller as to what the existing design was on the date on which the application of the impugned design registration was sought; or what improvements have been made to that existing design. The onus was on the registered proprietor to establish that it was new by leading evidence as the respondent was in possession of the best evidence to explain this but such evidence was not forthcoming.

On such circumstances the appeal is allowed and the impugned order dated 31st

January, 2012 is set aside.

However, there shall be no order as to costs. The original papers produced before this Court during hearing shall be returned to the Learned Counsel representing the statutory authorities.

Urgent xerox certified copy of this judgment, if applied for, be given to the parties on usual undertaking.