

(1994) 05 DEL CK 0012

In the Delhi High Court

Case No : Company Appeal No. 3 of 1992

National Trading Co.

APPELLANT

Vs

Monica Chawla

RESPONDENT

Date of Decision : 24-05-1994

Acts Referred:

Designs Act, 1911 — Section 51A

Citation : AIR 1994 Delhi 309 : (1995) 1 ARBLR 40 : (1994) 29 DRJ 489

Hon'ble Judges : J.K. Mehra, J

Bench : Single Bench

Advocate : Mohan Vidhani, G.D. Chugh and S.K. Bansal, for the Appellant;

Judgement

J.K. Mehra, J.

(1) This is a petition u/s 51A of the Designs Act, 1911 for the cancellation of the design No-163216 in Class I dated 6th May, 1991 registered in the name of respondent M/s Monica Chawla. The petitioner claims that the design of the product "Baby Bouncer" which is impugned in the present petition, cannot be and could not be registered under the Designs Act as the said design had been published before the registration by the respondent herself. Written statement has been filed wherein the respondent has taken various pleas, but has admitted that the design of Baby Bouncer, i.e., the impugned design, has been in use by her since 1987. The petitioner on the basis of this admission, in the written statement has moved an application under Order 12 Rule 6 for judgment on admissions.

(2) I have heard both the parties. Mr. Bansal conceded at the Bar that this design has been in use by the petitioner since 1987, which was long before the registration in 1991. To consider the merit of both the application and the main petition, it will be necessary to have a look at the relevant provision of law. Section 51A of the Designs Act reads as under :-

"51-A.Cancellation of registration- (1) Any person interested may present a

petition for the cancellation of the registration of a design - (a) at any time after the registration of the design, to the High Court on any of the following grounds, namely:- (i) that the design has been previously registered in India; or (ii) that it has been published in India prior to the date of registration; (iii) that the design is not a new or original design."

(3) It is stated that the respondent had in fact initiated proceedings against the petitioner for the alleged breach of its registered design vide Suit no.1594/91 and that the present petition is malafide. Respondent has further alleged that the petitioner has no locus standi to institute the present suit. This Court cannot pass any order. During the course of arguments, the respondent could not satisfy me as to why the present petition could not be instituted by the petitioner, particularly, when a suit is pending against it in respect of the same design. That fact alone makes the petitioner a person interested as contemplated u/s 51A. The respondent could not also advance any arguments on her objection that this Court had no jurisdiction to grant the relief in the present petition. The said objections are, Therefore, dismissed.

(4) The question as to what would amount to pre-publication of the design has been very well stated in commentary by Russel and Clerk in Chapter-IV. This question has been dealt with as under :-

"meaning of publication Broadly speaking, there is publication if the design has been disclosed to the public as opposed to being kept secret. The question which has to be decided is, Therefore, has the public been put in possession of the design? Has it knowledge of the design? It is not, of course, necessary that every member of the public should possess the knowledge. It is sufficient, and there will be publication if the knowledge was either- (1) Available to members of the public; or (2) Actually in fact shown and disclosed to some individual member of the public who was under no obligation to keep it secret. It is not necessary that the design should have been actually used."

While considering the cases of knowledge available to public in Harris Vs. Rothwell, Lindley L.J., reported as (1887) 4 R.P.C. 225, it has been held in that case as under :-

"It is sufficient to show that the invention was so described in some book or document, published in this country, that some English people may fairly be supposed to have known of it."

Again in Otto Vs. Steel, reported as (1886) 3 R.P.C. 109, Pearson, J. has said as under :-

"the question is whether or not this book has been published in such a way as to become part of the public stock of knowledge in this country. It is not, to my mind, necessary for that purpose to show that it has been read by a great many people, or that any person in particular has got from it the exact information which it is said would have enabled Dr. Otto in this case to have made his engine."

But, to my mind, it must have been published in such a way that there may be a reasonable probability that any person, and amongst such persons, Dr. Otto, might have obtained that "knowledge from it."

In the case of *Humpherson Vs. Syer*, reported as (1887) 4 R.P.C. 407, Bowen L.J. held as under :-

"I put aside questions of public use, and treat this as a question of whether there has been a prior publication; that is, in other words, has information been communicated to any member of the public, who was free in law or equity to use it as he pleased. Was Widmer a person to whom this communication had been made in a manner which left him free both in law and equity to do what he liked with the information.... You must take all the circumstances of the case, and ask yourself whether there was any confidential relation established between the two parties-whether it was an implied term of the employment that the information should be kept by the shop man to himself, or whether he might afterwards, without any breach of good faith, use the matter, and use it as he chose."

(5) Thus it becomes clear that there is also pre-publication if the design is disclosed to any individual member of the public, who is not under an obligation to keep it secret. Disclosure to such person is sufficient to constitute publication of design.

(6) The only question before this Court in the facts of the present case is as to whether the impugned design had been published in India prior to the date of its registration. In para 3 of the reply on merits of the respondent it is clearly brought out that "respondent during the course of her business activities propounded the said new and original design of "BABY BOUNCERS" in the year 1987 and has since then been continuously using/selling the same. This admission on the part of the respondent clearly brings the case within the mischief of Section 51A(1)(a)(2) that the design has been published in India prior to the date of registration. I am supported in this by the reported rulings in the cases of *Domestic Appliances and others Vs. Globe Super parts* reported as 1981 Ptc 239 and *Radha Engineers Vs. Young Electricals* reported as 1982 Ptc 313.

(7) Another argument raised by the respondent is that the petitioner in the present case had subsequent to the impugned registration, got a registration in his favor for the same design and pointed out that the respondent in present case has also moved a rectification application. But since their application was within one year of the registration, they had filed it before the Controller of Patents and Designs at Calcutta. I find that there is merit in what Mr. Bansal has said and that the petitioner also could not have obtained registration of the design in respect of Baby Bouncer unless there are any facts that take the case of the petitioner out of the mischief of Section 51A of the Designs Act, 1911. Since that case is pending before the Controller of Design, it will be for that authority to consider this.

(8) In the light of the above discussion, this petition succeeds and the Design No.163216 in class 1 is ordered to be cancelled and the Controller of Designs, Calcutta be informed accordingly. The petitioner is also entitled to the costs as per the Rules. Petition stands disposed of.