

(2018) 01 DEL CK 0240

In the Delhi High Court

Case No : Civil Suits (COMM) No. 361 Of 2017

Pentel Kabushiki Kaisha & Anr

APPELLANT

Vs

M/S Arora Stationers & Ors

RESPONDENT

Date of Decision : 08-01-2018

Acts Referred:

Code Of Civil Procedure, 1908 — Section 96, Order 39 Rule 1, Order 39 Rule 2
Designs Act, 2000 — Section 2(d), 4, 4(a), 4(c), 19, 22, 22(3)

Citation : (2018) 01 DEL CK 0240

Hon'ble Judges : Valmiki J.Mehta, J

Bench : Single Bench

Advocate : Sandeep Sethi, Afzal Khan, Debjyoti Sarkar, Parul Singh, Shailen Bhatia, H.P. Singh, Amit Jain, Ektanayar Saini, Navroop Singh

Final Decision : Dismissed

Judgement

'''

Valmiki J. Mehta, J",,,

I.A. No.6056/2017 (under Order XXXIX Rules 1 & 2 CPC),,,

1. This application for injunction under Order XXXIX Rules 1 & 2 of Code of Civil Procedure, 1908 (CPC) is filed by the plaintiffs in a suit pleading",,,

piracy by the defendants of the plaintiffsâ?? registered design no.263172 for ball point pens.,,,

2. The cause of action as pleaded in the plaint is one under Section 22 of the Designs Act, 2000 (hereinafter referred to as â??the Actâ?) and which",,,

Section provides that during the existence of the copyright in any design, no other person shall use the registered design for commercial purposes, sale",,,

of the article etc being a design which is identical or an imitation of the registered design of the plaintiff. In the suit the following reliefs are claimed:-,,,

â??(a) A decree of permanent injunction restraining the Defendants, their partners, agents, proprietors, servants and all those actively in concert with",,,

them from manufacturing, selling, offering to sell, advertising, trading, dealing, either directly or indirectly in pens that is identical duplication or being",,,

obvious and/or fraudulent imitation to the Plaintiffsâ?? copyright in the registered design no 263172;,,,

(b) An order for delivery up to the Plaintiffs by the Defendants of all the infringing products including blocks, dyes, molds, any other material bearing",,,

the Plaintiffsâ?? registered design No.263172 or used for applying the Plaintiffsâ?? registered design No.263172 for purpose of erasure/destruction;,,,

(c) An order of rendition of accounts of profits directly or indirectly earned by the Defendants from their infringing activities and wrongful conduct and,,,

a decree for the amounts so found due to be passed in favour of the Plaintiffs;,,,

(d) A sum of Rs.1,00,00,000/- as decree of damages as valued for the purposes of this suit towards invasion of rights, loss of sales, revenue, and",,,

overall business identified with the Plaintiffsâ?? registered design No.263172 caused by the activities of the Defendants;,,,

(e) An order as to the costs of the present proceedings; and,,,

(f) Any further order (s) as this Honâ??ble Court may deem fit and proper in the facts and the circumstances of the present case.â??,,,

3. In the interim injunction application which is being disposed of in terms of the present order, the following reliefs are prayed:-",,,

â??a. An order of exparte interim injunction restraining the Defendants, their partners, agents, proprietors, servants and all those actively in concert",,,

with them from manufacturing, selling, offering to sell, advertising, trading, dealing, either directly or indirectly in pens that are identical or obvious and",,,

fraudulent imitation to the Plaintiffsâ?? copyright in the registered design no.263172 during the pendency of the suit.,,,

b. Any further order(s) as this Honâ??ble Court may deem fit and proper in the facts and circumstances of the present case.â??,,,

4. In sum and substance this Court has to examine as to whether the plaintiffs, who are the holders of registered design no.263172 with respect to ball",,,

point pens, are entitled to interim reliefs on the ground that the defendants are infringing the registered design of the plaintiffs. For the purpose of",,,

disposal of the present application, three Sections of the Act would be relevant,

and these are Sections 4, 19 and 22 of the Act. These Sections read",,,
as under:-",,,

â??Section 4. Prohibition of registration of certain designs.- A design which â?"",,,

(a) is not new or original; or",,,

(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the",,,

filing date, or where applicable, the priority date of the application for registration; or",,,

(c) is not significantly distinguishable from known designs or combination of known designs; or",,,

(d) comprises or contains scandalous or obscene matter shall not be registered.,,,
shall not be registered.,,,

Section 19. Cancellation of registration.- (1) Any person interested may present a petition for the cancellation of the registration of a design at any time",,,

after the registration of the design, to the Controller on any of the following grounds, namely:-",,,

(a) that the design has been previously registered in India; or",,,

(b) that it has been published in India or in any other country prior to the date of registration; or",,,

(c) that the design is not a new or original design; or",,,

(d) that the design is not registerable under this Act; or",,,

(e) it is not a design as defined under clause (d) of section 2.,,,

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition",,,

to the High Court, and the High Court shall decide any petition so referred."",,,

Section 22. Piracy of registered design.- (1) During the existence of copyright in any design it shall not be lawful for any person-",,,

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any",,,

fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable",,,

the design to be so applied; or",,,

(b) to import for the purposes of sale, without the consent of the registered

proprietor, any article belonging to the class in which the design has been",,,
registered, and having applied to it the design or any fraudulent or obvious
imitation thereof, or",,,

(c) knowing that the design or any fraudulent or obvious imitation thereof has
been applied to any article in any class of articles in which the design is",,,

registered without the consent of the registered proprietor, to publish or expose
or cause to be published or exposed for sale that article.",,,

(2) If any person acts in contravention of this section, he shall be liable for every
contravention-",,,

(a) to pay to the registered proprietor of the design a sum not exceeding twenty-
five thousand rupees recoverable as a contract debt, or",,,

(b) if the proprietor elects to bring a suit for the recovery of damages for any
such contravention, and for an injunction against the repetition thereof, to",,,

pay such damages as may be awarded and to be restrained by injunction
accordingly:",,,

Provided that the total sum recoverable in respect of any one design under
clause (a) shall not exceed fifty thousand rupees:",,,

Provided further that no suit or any other proceeding for relief under this
subsection shall be instituted in any court below the court of District Judge.,,,

(3) In any suit or any other proceeding for relief under subsection (2), ever
ground on which the registration of a design may be cancelled under",,,

section 19 shall be available as a ground of defence.,,,

(4) Notwithstanding anything contained in the second proviso to sub-Section (2),
where any ground or which the registration of a design may be",,,

cancelled under section 19 has been availed of as a ground of defence and sub-
section (3) in any suit or other proceeding for relief under sub-section,,,

(2), the suit or such other proceedings shall be transferred by the Court in which
the suit or such other proceeding is pending, to the High Court for",,,

decision.,,,

(5) When the court makes a decree in a suit under sub-section (2), it shall send
a copy of the decree to the Controller, who shall cause an entry",,,

thereof to be made in the register of designs.â???,,,

5. Sub-Section (3) of Section 22 of the Act provides that in spite of the fact that
a design is a registered design, whenever any suit is filed for the relief",,,

alleging piracy of the registered design by the defendant in the suit, then in such

a suit every ground on which registration of a design may be cancelled" ,,,
under Section 19 of the Act shall be available to the defendant as a ground of defence.,,,
6.(i) A reading of Sections 19 and 4 of the Act, shows that before a design is entitled to protection under the Act, the design has to be a new or" ,,,
original design. If the design is not a new or original design, then the registered design though registered is liable to be cancelled in the proceedings" ,,,
under Section 19 of the Act. The pendency or otherwise of the proceedings under Section 19 of the Act for cancellation of the registered design will ,,,
however not prevent a Court from deciding the issue of entitlement of the plaintiff to grant of an interim injunction in a suit which is filed under Section ,,,
22 of the Act by examining the defences that the registered design is such which is liable to be cancelled, i.e no interim or final relief can be granted to" ,,,
the plaintiff, and this is so specifically provided in Sub-Section (3) of Section 22 of the Act. Therefore, this Court has to examine that whether the" ,,,
design of the ball point pen of which the plaintiffs have obtained registration is or is not a new or original design and which are defences for ,,,
cancellation of a registered design in proceedings under Section 19 of the Act. Defendants contend that design of the ball point pen of the plaintiffs is ,,,
not a new and original design, and hence not only the design registered by the plaintiffs is liable to be cancelled in the proceedings already initiated" ,,,
under Section 19 of the Act, even the subject application for injunction is liable to be dismissed in view of Sub-Section (3) of Section 22 of the Act as" ,,,
defences under Section 19 of the Act are defences which are available to the defendants in the suit to contest the allegations and cause of action in ,,,
the plaint of piracy of registered design. ,,,
(ii) While on the subject, as to what is new or original, this Court cannot lose sight of the what is stated in Sub-Section (c) of Section 4 of the Act." ,,,
Whereas Sub-Section (a) of Section 4 of the Act provides that a design which is not new or original cannot be registered, Sub-Section (c) of Section 4" ,,,
of the Act provides and clarifies that a design cannot be registered if it is not significantly distinguishable from known designs or combination of known ,,,
designs. Sub-Section (c) of Section 4 of the Act is therefore in a way explanatory or clarificatory of Sub-Section (a) of Section 4 of the Act by stating ,,,
that merely because there is some sort of newness or originality in an article, but

in case that newness or originality is however not such so as to",,,

significantly distinguish the new article prepared from existing designs or combination of designs, then in such a case a design cannot be registered. It",,,

is implicit in the requirement of a design being new and original that there is creation by putting an effort. Since a totally new product applying the",,,

design comes into existence as a result of lot of labour and effort, consequently, this right is known as intellectual property right and the effect of",,,

registering of the intellectual property right called as design under the Act gives monopoly to the owner of the registered design for a total period of",,,

ten plus five years. Therefore it is sine qua non that there is required sufficient novelty and originality for a completely new creation to come into",,,

existence of a design, and only thereafter would the design be said to be one which is capable of being protected as a design under the Act. This",,,

aspect of novelty and creation as regards a design which can only be protected has been dealt with by the Division Bench of this Court in the case of",,,

M/s. B. Chawla & Sons Vs. M/s. Bright Auto Industries AIR 1981 Delhi 95. The relevant paras of this judgment which deal with the aspect of",,,

newness or originality are paras 8 to 12 and these paras read as under:-",,,

â??8. In *Le May v. Welch* (1884) 28 Ch. D, 24-, Bowen L. J. expressed the opinion:",,,

It is not every mere difference of cut""-he was speaking of collars-""Every change of outline, every change of length, or breadth, or configuration in a",,,

single and most familiar article of dress like this, which constitutes novelty of design. To hold that would be no paralyse industry ""and to make the",,,

Patents, Designs and Trade Marks Act a trap to catch honest traders. There must be, not a mere novelty of outline, but a substantial novelty in the",,,

design having regard to the nature of the article.""",,,

And Fry L.J. observed :",,,

It has been suggested by Mr. Swinfen Eady that unless a design precisely similar, and in fact identical, has been used or been in existence prior to the",,,

Act, the design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne in mind that the Act may be",,,

applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families",,,

for their own use. It appears to me that such a mode of interpreting the Act

would be highly unreasonable, and that the meaning of the words "novel" or original' is this, that the designs must either be substantially novel or substantially original, having regard to the nature and character of the subject matter to which it is to be applied."

9. Similar view was expressed by Buckley L.J. on the question of quantum of novelty in *Simmons v. Mathieson and Cold* (1911) 28 R.P.C. 486 at 494, in these words:

In order to render valid, the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree."

10. In *Phillips v. Harbro Rubber Company* (1920) 37 R.P.C. 233, Lord Moulton observed that while question of the meaning of design and of the fact

of its infringement are matters to be judged by the eye (sic), it is necessary with regard to the question of infringement, and still more with regard to

the question of novelty or originality, that the eye should be that of an instructed person, i.e. that he should know that was common trade knowledge

and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or

original, He went on to give the example saying, if it is common practice to have, or not to have, spikes in the soles of running shoes a man does not

make a new and original design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is

entitled at its will to take, in all cases, its choice of ordinary trade variants for use in particular instance, and no patent and no registration of a design

can prevent an ordinary workman from using or not using trade knowledge of this kind. It was emphasized that it is the duty of the court to take

special care that no design is to be counted a "new and original design" unless it distinguished from that previously existed by something essentially

new or original which is different from ordinary trade variants which have long been common matters of taste workman who made a coat (of ordinary

cut) for a customer should be left in terror whether putting braid on the edges of the coat in the ordinary way so common a few years ago, or

increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design. On final",,,, analysis, it was emphasized that the use of the words "new or original" in the statute is intended to prevent this and that the introduction or substitution",,,, of ordinary trade variants in a design is not only insufficient to make the design "new or original" but that it did not even contribute to give it a new or",,,, original character. If it is not new or original without them the presence of them cannot render it so.,,,

11. The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on,, the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the ultimate arbiter. However, the", eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as", to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of,, those engaged therein to share common knowledge be also protected.,,,

12. Coming to the facts of the instant case the design in question as a whole consists in almost rectangular shape with rounded edges with sides,, curved or sloping with a further curve on either side in the sloping upper length side. The respondent produced in evidence Japan's Bicycle Guide," 1972, Vol. 22. At page Nos. 218 to 221, there are standard models of back mirrors besides branded models numbering 36. Models bearing Nos. 59-6," 62-1, 61-3, 66-1 and 70-1 would show back view mirrors rectangular in shape with sloping widths or lengths. In some of these models there is curve in", the upper length side. We have mentioned this fact simply to emphasise that back view mirrors resembling the one in question have been in the market,, for a long time. The appellants' case is that further a curve in the sloping upper length side makes their design new or original. We have already noted,, that the extent and nature of novelty was not endorsed by the appellants in the application for seeking registration and, Therefore, it has to be taken", only as regards the shape and configuration. In final analysis the matter would boil down to whether addition of further curve on either side makes the,, variation a striking one or a substantial so as to constitute a novelty meriting for registration. The learned Single Judge after enunciating the legal,,

position correctly used his eye for discerning if there was in fact a novelty and answered the question in the negative. We have once again gone,,,

through the same exercise and come to the same opinion. We fail to see the hard labour which the appellants claimed to have bestowed in creating the,,,

design they got registered. It is devoid of newness and equally devoid of originality. An addition of curve here or there in a shape which is well-,,,

recognised shape of an article of common use in the market cannot make it an article new or original in design. If it is made eligible for registration, it",,,

would certainly hinder the progress of trade without there being any justification, whatsoever.â??",,,,

(emphasis added),,,,

7. The emphasized portions of the aforesaid paras of the Division Bench judgment of this Court leave no manner of doubt that there is required,,,

substantial novelty of design and that any and every change resulting in a new configuration will not necessarily constitute a novelty of design. Mere,,,

novelty of outline or few changes here and there which are trade variants would not result in creation of a new article on the design which would,,,

entitle to protection as a design under the Act. The Division Bench has time and again with reference to the different judgments of the courts of U.K.,,,,

emphasized the requirement of novelty or originality which is substantial novelty and substantial originality with regard to the nature and character of,,,

the article. In para 10 of the judgment in the case of M/s B. Chawla and Sons (supra) while making reference to the observations of Lord Moulton it,,,

is observed that special care has to be taken that no design is counted as a new or original design unless it is distinguished from what previously,,,

existed by something essentially new or original which is different from ordinary trade variants. In para 11, the Division Bench has concluded that",,,,

quintessence is that distinction has to be drawn between usual trade variants on the one hand and substantial novelty and originality on the other hand,,,

otherwise there will be blockage of trade. Only newness/originality entitles monopoly on account of registration of the design.,,,,

8. The Supreme Court in the case of Bharat Glass Tube Limited Vs. Gopal Glass Works Limited (2008) 10 SCC 657 has made similar observations in,,,

para 26 and this para 26 reads as under:-,,,

â??26. In fact, the sole purpose of this Act is protection of the intellectual

property right of the original design for a period of ten years or whatever",,,
further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and,,,
original design. This is the sole aim of enacting this Act. It has also laid down that if design is not new or original or published previously then such,,,
design should not be registered. It further lays down that if it has been disclosed to the public anywhere in India or in any other country by publication,,,
in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration then such",,,
design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known designs, then such",,,
designs shall not be registered. It also provides that registration can be cancelled under Section 19 of the Act if proper application is filed before the,,,
competent authority i.e. the Controller that the design has been previously registered in India or published in India or in any other country prior to the,,,
date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as",,,
defined in Clause (d) of Section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has already,,,
been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. These",,,
prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a,,,
long time. The new and original design when registered is for a period of ten years. Such original design which is new and which has not been,,,
available in the country or has not been previously registered or has not been published in India or in any other country prior to the date of registration,,,
shall be protected for a period of ten years. therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is",,,
evident from the Statement Of Objects And Reasons and from various provisions of the Act. In this background, we have to examine whether the",,,
design which was registered on the application filed by the respondent herein can be cancelled or not on the basis of the application filed by the,,,
appellant. In this connection, the Law of Copyright and Industrial Designs by P. Narayanan (Fourth Edition), Para 27.01 needs to be quoted.",,,

27.01. Object of registration of designs.- The protection given by the law relating to designs to those who produce new and original designs, is",,,

primarily to advance industries, and keep them at a high level of competitive progress.",,,

"Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but the appearance. Common,,,

experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or,,,

bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than,,,

one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will",,,

increase sales"". The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to",,,

their goods.,,,

The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of)",,,

particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable (sic",,,

protectable) at all, ought to be made the subject- matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in",,,

producing a drawing. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in,,,

a commercially produced artefact. Thus the primary concern, is what the finished article is to look like and not with what it does and the monopoly",,,

provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image",,,

registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of articles of a design not substantially",,,

different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.â?? (emphasis added),,,

9. A reference to the aforesaid para 26 of Bharat Glass Tube Limited's case (supra) shows that what is stated by the Division Bench of this Court in,,,

the case of M/s B. Chawla and Sons (supra) has been accepted and in sum and substance it has been held by the Supreme Court that the object,,,

behind enactment of the Act is to give benefit to a person for the research and labour put by him to evolve the new and original design which is an,,,

intellectual property right. Supreme Court has also observed that unless the design is not significantly distinguishable from the known designs or,,,

combination of designs, then such a design is not entitled to registration and hence monopoly of user for 15 years under the Act.",,,

10. With the aforesaid being the position of law with respect to the requirement of newness and originality, with the fact that it also stands further",,,,

clarified by virtue of Sub-Section (c) of Section 4 of the Act that design with respect to which registration is claimed has to be substantially different,,,

from existing designs, and hence monopoly for 15 years can only be given to such a design which is significantly distinguishable from the known",,,,

designs or combination of known designs.,,,,

11 . Let us therefore now turn to the facts of the present case on the basis of which plaintiffs claim entitlement to injunction on account of alleged piracy,,,

by the defendants and thereby the plaintiffs would be entitled to reliefs under Section 22 of the Act. The relevant paras with respect to plaintiffs's claim,,,

of its validity of registered design are paras 11 and 12 and these paras are scanned below:-,,,

12. Paras are being scanned instead of being typed so that by a visual impression it could be known as to what are the design features of which,,,

plaintiffs' claim exclusivity.,,,,

13. At this stage, it is required to be noted that whereas the plaintiffs are selling their ball point pens under the trademark PENTEL ENERGEL,",,,

defendants are selling their ball point pens under the trademark MONTEX and with sub-brands of MONTEX including the MONTEX MASTANI. It,,,

is MONTEX MASTANI which is pleaded by the plaintiffs to be an infringement of the registered design of the plaintiffs. The defendants as per their,,,

written statement in order to dispute the claim of the plaintiffs have denied that there is any newness or originality and in fact the defendants plead that,,,

they are in the business of manufacture of ball point pens since around the year 1976 and defendants have various registered trademarks with the,,,

main brand name/trademark MONTEX as also registration of the trademark/trade name MONTEX with other special brands. This is stated in para 7,,,

of the initial submissions of the written statement and this para 7 reads as

under:-,,,

â??7. That aforesaid goods of the defendants are sold under the various distinct names along with the well-known trade mark/House Mark,,,

SR. NO.,TRADE MARK,NO.,STATUS

1,MONTEX,204732,REGISTERED

2,MONTEX,383189,REGISTERED

3,MONTEX,502782,REGISTERED

4,MONTEX TURBO,673571,REGISTERED

5,MONTEX HYTONE,678540,REGISTERED

6,MONTEX GEL,835796,REGISTERED

7,MONTEX PENS,847279,REGISTERED

8,MONTEX PENS & REFILLS,1005718,REGISTERED

9,MONTEX LAYA AUR KUCH NAYA,1113344,REGISTERED

10,MONTEX MIRACLE,1185110,REGISTERED

11,MONTEX MERCURY,1185111,REGISTERED

12,MONTEX MEGA TOP,1262904,REGISTERED

13,MONTEX NEW HONEY,1273423,REGISTERED

14,MONTEX NEW HYBRID,1273424,REGISTERED

15,MONTEX HANDSOME,1273425,REGISTERED

16,MONTEX HYSQUARE,1273426,REGISTERED

17,MONTEX MASTER GRIP,1328890,REGISTERED

18,MONTEX FAST,1440830,REGISTERED

19,MONTEX ACTION,1440836,REGISTERED

20,MONTEX FARARI,1476482,REGISTERED

21,MONTEX MABACK,1476483,REGISTERED

22,MONTEX 9,1668638,REGISTERED

23,MONTEX PLUS,1668639,REGISTERED

24,MONTEX GLIDER,1668642,REGISTERED

25,MONTEX RADIUM,1668643,REGISTERED

26,MONTEX REGAL,1714628,REGISTERED

27,MONTEX CAPTIVA,1714629,REGISTERED
28,MONTEX ICON,1834331,REGISTERED
29,MONTEX MURFY,1834332,REGISTERED
30,MONTEX PAGODA,1834333,REGISTERED
31,MONTEX POLITE,1834334,REGISTERED
32,MONTEX SOLAR,1834335,REGISTERED
33,MONTEX PRESIDENT,1855597,REGISTERED
34,"MO N TEXT RICK RETRACTABL
BALL PEN",E2927355,REGISTERED
35,MONTEX CLASSIC,2927356,REGISTERED
SR. NO.,T.M. NO.,CLASS,STATUS

1,846602,9,REGISTERED
2,846603,21,REGISTERED
3,846604,28,REGISTERED
4,2930407,1,REGISTERED
5,2930408,22,REGISTERED
6,2930409,21,REGISTERED
7,2930410,20,REGISTERED
8,2930411,19,REGISTERED
9,2930412,18,REGISTERED
10,2930413,17,REGISTERED
11,2030414,16,REGISTERED
12,2930415,15,REGISTERED
13,2930416,14,REGISTERED
14,2930417,13,REGISTERED
15,2930418,12,REGISTERED
16,2930419,11,REGISTERED
17,2930420,10,REGISTERED
18,2930421,44,REGISTERED
19,2930422,43,REGISTERED

20,2930423,42,REGISTERED
21,2930424,41,REGISTERED
22,2930425,40,REGISTERED
23,2930426,39,REGISTERED
24,2930427,38,REGISTERED
25,2930428,37,REGISTERED
26,2930429,36,REGISTERED
27,2930430,35,REGISTERED
28,2930431,34,REGISTERED
29,2930432,33,REGISTERED
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32,2930435,30,REGISTERED
33,2930436,29,REGISTERED
34,2930437,28,REGISTERED
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39,2930442,23,REGISTERED
40,2930443,9,REGISTERED
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42,2930445,7,REGISTERED
43,2930446,6,REGISTERED
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45,2930448,5,REGISTERED
46,2930449,3,REGISTERED
47,2930450,2,REGISTERED
48,2930451,45,REGISTERED
7,MEGA TOP,16.03.2005,198983

8,HYSCALE,16.03.2005,198984
9,HABBIT,25.03.2005,199139
10,HY TANK 999,25.03.2005,199143
11,HANDY,25.03.2005,199144
12,HANDY # 18,25.03.2005,199145
13,HYBOSS,25.03.2005,199148
14,MASTER PIECE,13.09.2005,201286
15,MERCURY WITH OUT RUBBER,13.09.2005,201287
16,HYROLLER,21.04.1999,179345
17,HOT POINT,21.04.1999,179347
18,HYGEL,21.04.1999,179349
19,HY Q,01.09.1999,180289
20,HYPOWER,07.10.1999,180596
21,HYSPEED,28.12.2000,184343
22,HYPOWER,13.01.2001,184501
23,HEADLINE,28.12.2001,185791
24,HYSLIM,28.12.2001,187907
25,BARREL,26.02.2003,188689
26,HYSCALE,20.10.2002,190361
27,MERCURY,25.01.2003,191179
28,MIRACEL,25.01.2003,191180
29,INNOVA,22.03.2006,203812
30,ACCUPOINT,18.03.2006,203919
31,FARARI,19.07.2006,205692
32,PLATIMA,19.07.2006,206618
33,DYNA,01.10.2007,213008
34,REGAL,01.10.2007,213009
35,MAGNUM,19.07.2006,205693
4,2869733,EPO,REGISTERED
5,209812,EGYPT,REGISTERED

6,4234933572,GREAT BRITAIN,REGISTERED

7,11856,GAZA STRIP,REGISTERED

8,96417,JORDAN,REGISTERED

9,74688,KUWAIT,REGISTERED

10,28606,KAZAKHSTAN,REGISTERED

11,3200800858,O.A.P.I,REGISTERED

12,47961,OMAN,REGISTERED

13,192825,PAKISTAN,REGISTERED

14,97278,SRILANKA,REGISTERED

15,2004/14928,SOUTH AFRICA,REGISTERED

16,EE072261,TUNISIA,REGISTERED

17,40504,U.A.E,REGISTERED

18,51529,IRAQ,REGISTERED

18. In sum and substance the defences of the defendants are therefore that neither there is any newness or originality in the registered design of the,,,

plaintiffs with respect to ball point pens claimed by the plaintiffs and also, that the defendants have copied the features not from the registered design",,,

of the plaintiffs but from the features which are already adopted by the defendant no.2 in its ball point pens since the year 2005.,,,

19. In the opinion of this Court the issue which arises squarely is whether paras 11 and 12 of the plaint which contain the cause of action of the,,,

plaintiffs of creation of features of designs and thus the ball point pen of the plaintiffs as a whole being entitled to exclusivity of the registered design,,,

yet the plaintiffs will have to satisfy this Court that the plaintiffs's registered design of the ball point pens satisfies the requirements of newness and,,,

originality with the fact that the so called newness or originality is not such so as not to be significantly distinguishable from the known designs,,,

features.,,,

20. I must begin this reasoning portion by stating that a ball point pen is a ball point pen i.e every ball point pen normally has a refill with a nib, the refill",,,

is put in a lower casing called a barrel, over the barrel containing the refill and the nib there is a cap which is put, and such a cap obviously has a clip in",,,

order to fix/attach the ball point pen in the clothing of persons. In sum and

substance therefore every ball point pen has common features of a lower,,, casing/barrel in which lower casing/barrel there is a refill, the refill exists with a ball point pen nib, the cap covers the ball point pen nib portion with",,,, additional portion of the lower casing/barrel, and finally that the cap ordinarily contains a clip. In order for a design to be totally a new and original",,,, design with respect to a ball point pen, there will have to be significantly distinguishable features so as to make the ball point pen of which exclusivity",,,, and continuation of the registration is claimed by the plaintiffs, that such is a completely new and original ball point pen and that there is",,,, enough/substantial novelty and originality by application of labour whereby the ball point pen of the plaintiffs is distinguished from the aforesaid known,,, features/designs in a ball point pen. When the facts of this case on the features and design of the ball point pen of the plaintiffs is examined along with,,, ratios of the judgments of the Division Bench of this Court in the case of M/s B. Chawla and Sons (supra) and that of the Supreme Court in the case,,, of Bharat Glass Tube Limited (supra), in my opinion the fact that the cap of the plaintiffs's ball point pen is alleged to be unique because of wedges at",,,, the point of holding of the ball point pen or the barrel is polygonal or there exists slightly curved tip or that barrel/lower casing goes into a knob etc are,,, only trade variants and such features really cannot be said to be in my opinion such newness or originality so as to distinguish these features from the,,, known shape or the different features which already exist in a ball point pen. The features given in para 11 of the plaint which are claimed to be,,, unique and new are not such that it can be held that the features in themselves or taken with other features will make the ball point pen of the,,, plaintiffs as a completely unique new design having that much originality so as to be significantly distinguishable from the known features/design of a,,, ball point pen. In fact the wedges in the grip portion in my opinion is in fact a functional feature because this wedges design created is for a better grip,,, and in order to ensure that there is proper grip of the pen resultantly this being a mode or principal of construction applied with respect to a ball point,,, pen and for ensuring a better grip of the ball point pen and which because of Section 2(d) of the Act defining design cannot be protected as a design.,,,,

21. Learned counsel for the plaintiffs sought to place reliance upon a portion of Full Bench judgment of this Court in the case of Reckitt Benkiser India,,,

Ltd. Vs. Wyeth Ltd. AIR 2013 Delhi 101 (FB) but the para relied upon of this judgment reproduces the observations in the book 'Industrial Designs by,,,

Russell Clarke and Howe' which only deals with the requirement of a design becoming a design not because of the design being otherwise existing in,,,

public domain but because of the design necessarily having been applied to an article. Putting it in other words, non-existence of a design in public",,,,

domain is not enough to succeed on the aspect of registration of the design under the Act because even a known concept or known design or known,,,

idea becomes a design only when it is applied with respect to an article, whereby the new article would become a design as such, and one then which",,,,

would have protection as a design under the Act. This is said in so many words in Section 2(d) of the Act which defines a design as under:-,,,

â??Section 2(d) â??designâ? means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any",,,,

article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical,",,,

separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of",,,,

construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section",,,,

(1) of section 2 of the Trade and Merchandise Mark Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45",,,,

of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957)â?? (emphasis added)",,,,

22. In the opinion of this Court, this Court does not even have to go to the facts as stated by the defendants in their written statement of their having",,,,

used the features claimed by the plaintiffs as unique/new features in the ball point pens of the defendants which are already in existence in earlier,,,

manufactured ball point pens by the defendants in different years from the year 2005 inasmuch as firstly the plaintiffs have to satisfy this Court that,,,

the design of which exclusivity and ownership is claimed by the plaintiffs is a completely new and original design and is not as to be containing mere,,,

variations or trade variants or some or the other differences from the known designs already existing in a ball point pen. In this regard, in the opinion of",,,,

this Court, the plaintiffs have miserably failed of showing substantial newness/ originality as required by the definition and meaning of newness and",,,,

originality as stated in the Division Bench judgment in the case of M/s B. Chawla and Sons (supra) and the judgment of the Supreme Court in the case,,,

of Bharat Glass Tube Limited (supra), relevant paras of which are reproduced above.",,,

23. In view of the aforesaid discussion, I do not find any merit in this application and the same is therefore dismissed. Interim order passed by this",,,

Court on 26.5.2017 is vacated.,,,