

(2014) 02 DEL CK 0161

In the Delhi High Court

Case No : I.A. No's. 19671 of 2013 and 596 of 2014 in CS (OS) No. 2407 of 2013

Steelbird Hi-Tech India Ltd.

APPELLANT

Vs

S.P.S. Gambhir and Others

RESPONDENT

Date of Decision : 24-02-2014

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, Order 39 Rule 4
Copyright Act, 1957 — Section 2
Designs Act, 2000 — Section 10 11 19 19(b) 2
Penal Code, 1860 (IPC) — Section 479
Trade and Merchandise Marks Act, 1958 — Section 2

Citation : (2014) 58 PTC 428

Hon'ble Judges : Manmohan Singh, J

Bench : Single Bench

Advocate : Sudhir Chandra, Ms. Diva Arora and Mr. Rajat Katiyar, for the Appellant; Prathiba M. Singh Ms. Bitika Singh and Mr. Kapil Midha, for the Respondent

Final Decision : Disposed Off

Judgement

Manmohan Singh, J.—The plaintiff has filed a suit for permanent injunction restraining infringement of design under Registration No. 241153, passing off, rendition of accounts, damages etc. The said suit was listed along with IA No. 19671/2013 under Order 39 Rules 1 and 2 CPC wherein this Court passed the interim order. Upon service, the defendants have filed reply to the interim application and also filed an application being I.A. No. 596/2014 under Order 39 Rule 4 CPC for vacation of the ex parte ad-interim order passed on 6th December, 2013.

Case of the Plaintiff

The Plaintiff produces wide variety of open face and full face motorcycle helmets like Safety Helmets, Ski Helmets, Grand Prix Racing Helmets, Jet Helmets, Off Road Helmets, Moto Cross Helmets etc. in different sizes catering to all customer

segments.

i) The helmets, pannier boxes and other motor accessories of the Plaintiff and its sister concerns are manufactured under strict quality control to ensure that they meet the national and the international safety standards.

ii) The Plaintiff's product is a helmet bearing novel and distinctive features in shape, configuration and surface pattern. The Plaintiff is the registered proprietor of the design under No. 241153 dated 1st December 2011 as per the Designs Act, 2000 (hereinafter referred to as "the Act") in respect of "the shape, configuration and surface pattern of the Helmet".

iii) The shape, configuration and surface pattern is distinctive and unique to the Plaintiff's helmet sold under the trademark "STEELBIRD".

iv) The Plaintiff has been using the helmets bearing the design No. 241153, since January 2012.

v) The plaintiff has marketed and promoted the said products in India and abroad on a substantial scale. The plaintiff's product under the aforesaid design respectively has met with unprecedented success within a short period of time. Thus the design for the aforesaid helmet has come about to be exclusively identified with the plaintiff by the members of trade and the public in general within this period of time. The plaintiff has sold a huge number of helmets bearing the said design. (The sales figures and the number of the Plaintiff's helmets bearing the said design sold in the last two years are given.)

vi) The plaintiff has earned substantial goodwill and reputation inter alia in the design of the said helmet as a result of its efforts towards the creation of the said design. Due to such efforts of the plaintiff, the said design has acquired a secondary meaning in the eyes of the public as denoting the goods of the plaintiff and no one else.

vii) In November, 2013, the plaintiff learnt about the fraudulent imitation of its registered design under No. 241153 by the defendants who were manufacturing and selling helmets under the mark "Format" in the same design as that of the plaintiffs wherein the defendants had copied the essential features of the plaintiff's registered design applied to helmets.

viii) The plaintiff's representative visited a shop and purchased the defendants infringing product without a cash memo. On enquiry, the plaintiffs came to know that the defendants have recently launched impugned helmets bearing the said design in the month of November, 2013.

x) From comparison of the plaintiff's and the defendants' helmets there is no difference between any essential features of the plaintiff's registered design and that of the defendants impugned product design. Therefore it is evident that the impugned product of the defendant under the mark "Format" constitutes an infringement of the prior statutory rights that vest in the plaintiff by virtue of

registered design No. 241153.

2. The defendants have filed the reply to the injunction application and also filed a separate application for vacation of the ex-parte orders. In the application under Order 39 Rule 4 CPC, the prayer is made that the ex-parte interim order dated 6th December, 2013 is liable to be vacated inter alia on the following grounds:

(i) The design of the plaintiff falls within the provisions of Section 4 of the Act and it lacks novelty. The novelty is primarily claimed by the plaintiff during arguments in the "Beak shaped design" which is in fact common to trade. The term "Beak shaped design" which has been argued by the plaintiff has neither been mentioned in the plaint nor in the design registration certificate of the alleged design.

(ii) No novelty resides in the said beak shape helmet in as much as even prior to the design registration of the plaintiff i.e. 1st December, 2011 such beak shape design helmet or the helmets were available in the market as the other competitors like STUDDS and AIROH have their similar design helmets existing in the market much prior to the alleged design registration of the plaintiff, i.e. on 1st December, 2011. The rate cards/catalogues of these helmets were available at the time or even prior to December, 2011 which shows that the similar shaped and designed helmets were, in fact, available in market for purchase when the plaintiff alleged novelty in the design and applied for registration. The pictures of both the designs of these two manufacturers are given below for ready reference:

(iii) Therefore, the alleged design of the plaintiff is not "original" within the meaning of the Act as there are various manufacturers already making such designs with the claimed "Beak Shape" and have been marketing across the world. An internet search reveals various such similarly designed Helmets which are being given below for ready reference:

(iv) It is also alleged that there is no similarity between the plaintiff's helmet registered under the registration No. 241153 and helmets manufactured by the defendants sold under the mark FORMAT. The pictures of both the designs are given below for ready reference:

FRONT VIEW

SIDE VIEW

Comparison of the product of the Defendants and the Plaintiff.

BACK VIEW

A table of dissimilarities between the product of the Plaintiff and the Defendants has been given as under:

(v) It is also contended that the Visor provided in the centre of the helmet is a "functional feature" which is common to trade and also as per the definition in

Section 2(d) of the Act, cannot be a subject matter of the design registration. The Visor gives good visibility and good water run-off. Apart from protecting the eyes from flying rocks, dirt, mud and water, Visor keeps sweat from dripping into your eyes (like a sweat band). No novelty or originality or any right in any manner whatsoever can be claimed over the Visor and the lower chin portion of the Helmet supporting the Visor.

(vi) It is submitted that the impugned registration under design No. 241153 does not fall within the purview of Section 2(d) of the Act. What is registrable under the Act is the features of shape, configuration, pattern etc. i.e. the features appealing to the eye. The functional features are prohibited from being registered. Further requirements envisaged under the Act for registrability of any design is that the design has to be new or original [Section 4 of the Act read with Section 19(b), (c) and (e)]. Such designs should not be disclosed to the public anywhere in India or in any other country by publication in tangible form. Moreover, the subject matter of design registration is distinguishable from known designs or combination of known designs. None of these features are qualified by the alleged design registration No. 241153 of the plaintiff. Since the design registration No. 241153 of the Act in the name of the plaintiff does not qualify in all of the above said conditions of being registrable under the Act, therefore, is liable to be cancelled u/s 19 of the Act. The defendants reserve their right to take appropriate action before the Controller of Designs as and when required.

3. In response to the argument of the defendants, it is alleged by the plaintiff that the helmets being referred to by the defendants are either different to that of the plaintiff's helmet design which is the subject of a registered design. The documents sought to be relied upon by the defendants are undated and are not clear and reliable, hence, the same cannot be relied upon. In fact, the defendants have failed to produce any documentary evidence which shows that the design of the plaintiff's helmets was pre-published. It is alleged that the plaintiff's product has similarities with the designs of the defendants and is not different from the designs of other companies referred by the defendants and hence falls within Section 4(c) of the Act. The documents filed by the defendants prove that the alleged design registration was published in tangible form and disclosed in India as well as abroad within the meaning of Section 4(b) of the Act.

4. It is argued that from a mere comparison of the plaintiff's helmets bearing the said design and the defendant's helmets sold under the mark FORMAT, it is obvious that the two are identical and that there is no difference between any of the essential features of the plaintiff's registered design and that of the defendants impugned product design. Therefore it is evident that the impugned product of the defendants under the mark "Format" constitutes an infringement of the prior statutory rights that vest in the Plaintiff by virtue of registered design No. 241153 which is to be judged solely by the eye.

5. It is argued that the defendants were well aware of the design of the plaintiff's helmets being in the same industry and the plaintiff being one of the

biggest manufacturers of helmets. The defendants have imitated the plaintiff's products and have intended to misrepresent and pass off their products as those of the plaintiff. The defendants themselves have stated that their helmets bearing the impugned design were launched by them only in November, 2013 and the plaintiff approached the Court in November, 2013 itself. Hence, no prejudice is being caused to the defendants in any manner whatsoever. Further, the defendants have been restrained only from manufacturing and selling the model of helmets bearing a design which is identical to the plaintiff's registered design.

6. The plaintiff has referred the following decisions in support of its submission:

i) In the case of Rotomac Pens Ltd. vs. Milap Chand & Co., 1999 PTC 757 (DB) at pages 769-770 and 791 it was held that:

.....From a visual comparison of the respondent's and the appellant's product, it appears to us that the design adopted by the respondent is virtually identical with the appellant's design. The differences, which the respondents sought to point out in its affidavit-in-opposition before the Trial Court do not appear to be relevant to the question of similarity in design. It is true that the respondent produces its pen in five colors and of these five colors only three colors are similar to the colors used by the appellant, but all have the same glossy finish. It is not necessary for the purpose of considering an allegation of infringement of a design to decide whether the purchasers are likely to be deceived.

ii) In the case of Vikas Jain Vs. Aftab Ahmad and Others, it has been held that:

As indicated above, I am, prima facie, of the view that the Defendants' design is an obvious imitation of the Plaintiffs design. On the other hand, there are sufficient differences between the purported Hong Kong design and the Plaintiffs design. The Plaintiffs design is a three-wheeler scooter, whereas the Hong Kong design is a two-wheeler scooter.....

Apart from that, there are many distinguishing features, such as the difference in the foot-rest, the handle, shock absorbers, hub caps, etc. In my view, the submission of the Learned Counsel for the Plaintiff that the Hong Kong design and the Plaintiffs design are not identical is correct. The Plaintiffs design also, prima facie, does not appear to be an obvious imitation of the Hong Kong design.

11. So, on a comparison of the three designs, i.e., the Hong Kong design, the Plaintiffs design and the Defendants' design, I find that while there is identity between the Plaintiffs design and the Defendants' design, there is no such identity between the Plaintiffs design and the Hong Kong design. For the defence of prior publication taken by the Defendants to succeed, it must be shown that the very design that is utilised by the Plaintiff has been published in India or in any other country prior to the date of registration of the Plaintiffs design.

iii) In the case of Alert India vs. Naveen Plastics, 1997 PTC (17) it was held that:

Thus for determining whether two designs are identical or not, it is not necessary that the two designs should be exactly the same. The main consideration to be applied is whether the broad features of shape, configuration, pattern etc. are same or nearly the same and if they are substantially the same then it will be a case of imitation of the design of one by the other.

iv) In the case of Troikaa Pharmaceuticals Ltd. Vs. Pro Laboratories (P) Ltd. and Another, Gujarat High Court held that:

The test of ascertaining whether the two designs are identical is that the designs have to be judged by the eye and each design has to be compared to a whole with all its component features, important and unimportant. It is open for the plaintiff to demonstrate that even if the plaintiff's design is regarded as having been inspired by some previous designs, the plaintiff has introduced sufficient novelty so as to constitute a new and/or original design. Previously published designs of other Companies have not been produced before the Court except in pictures and photos. The plaintiff's D Shape tablets as well as defendant's D Shape tablets are produced which are more or less similar. The defendant's D Shape tablets are similar in shape as well as in colour with that of the plaintiff. It would certainly create deception in the mind of ultimate user.

v) In the case of Castrol India Limited vs. Tide Water Oil Company (I) Ltd., 1996 (16) PTC 202 it was held that:

.....The statement of novelty filed by the petitioner was in respect of the shape, configuration and surface pattern particularly the ridged side of the container. The novelty was not claimed either in relationship to the proportion of the shape or in the colour used. Therefore, the difference in the proportion of the container and the difference in colour between the petitioner's containers and the defendant's containers are immaterial, as neither of the colour nor the proportions were part of the registered design. The Court further held that the test of deceptive similarity would be appropriate whether the petitioner pleads passing off. But in cases of infringement of design the question is not whether the similarity has or is likely to cause confusion or deception of a purchaser but whether the similarity is an imitation of the registered design sufficient to destroy the exclusive right of user of the proprietor despite the fact that no confusion is or may be caused as to the source of the goods. Otherwise every registered design could be imitated with impunity merely by changing the colour of the two products. The Court, therefore, held that the respondents have so imitated the petitioner's design as to deprive the petitioner of the protection under the Statute.

vi) In the case of Texla Metals and Plastics Pvt. Ltd. Vs. Anil K. Bhasin and Others) it was held that:

The basic nature and design of a bollard and a delineator would essentially be the same all over the world like traffic lights for example. But what has to be remembered is that bollards and delineators which are designed by the plaintiff

and which are being manufactured by it were not available in India prior to the date of registration of the plaintiff's design. Therefore, while it can be said that the designs were not completely new or original elsewhere, it cannot be said that it is not a new or an original design so far as India is concerned. The concept of a new or an original type of design is reliable to the publication of such a design or its availability to the public in India. This decision also, therefore, does not advance the case of the defendant any further. Under the circumstances, the plaintiff has made out a case for the grant of an injunction.

7. In view of plaintiff's pleadings and the decisions referred by Mr. Sudhir Chandra, learned Senior counsel, it is settled law that if the plaintiff is able to show prima facie, the design used by the defendants is an identical/similar being is an obvious imitation and the design registered in favour of plaintiff is a new or original and it has not been published in India prior to date of registration/application and is registrable under the Act which covers as defined u/s 2(d) of the Act, then a strong case of grant of injunction is made out. The interim order under these circumstances is to be continued till the disposal of the suit. But at the same time, in case the plaintiff failed to prove his case prima facie with regard to challenge made u/s 19 of the Act and material available on record to show that the design is not new or original on the date of registration or any other grounds stipulated in said Section, then the plaintiff may not be able to get the injunction in view of settled law. Despite it is observed that the defendants' design is similar to the design of the plaintiff.

8. Thus, as far as decisions referred by both parties are concerned, the law is very clear on this aspect. In the cases referred by the plaintiff, each case is determined as per its own merit wherein it was held that the defendants have failed to prove the case of prior publication and the design adopted by the defendant is either an identical or similar amounting to an imitation. Thus, the interim order was passed.

9. Let me now discuss the present matter in the light of facts and circumstances in the present case and as per relevant mandatory provisions of the Act.

10. Nature And Scope of Design Act 2000:

The Design Act is purposefully made as a statutory protection for the industrial designs which pass the tests of novelty and originality provided by the Act. The said protection is akin to Patent Act which is also a purely statutory remedy and tests for evaluation of novelty are also somewhat similar to that of the Patent. The said protection of Industrial Designs is for limited period which is 10 years for once and 5 years renewal thereafter and not beyond the same. The said law has been made specifically to protect the industrial designs like shape and configuration of the "article" and the said protection under the Designs Law is totally statutory in nature, and available in the form of The Designs Act, 2000 which is a complete code in itself as it provides the nature and extent of protection available under the designs law and the relevant provisions relating to

the same are reproduced herein after:-Section 2(d) "design" means only the features of shape, configuration, pattern, ornament or composition of lines or colors 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 Marks Act, 1958 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957.

Section 9. Certificate of Registration - (1) The Controller shall grant a certificate of registration to the proprietor of the design when registered (2) The Controller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

Section 10. Register of designs - (1) There shall be kept at the Patent Office a book called the register of designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matter as may be prescribed and such register may be maintained wholly or partly on computer, floppies or diskettes, subject to such safeguards as may be prescribed.

(2) Where the register is maintained wholly or partly on computer floppies and diskettes under sub-section (1), any reference in this Act to any entry in the register shall be construed as the reference to entry so maintained on computer, floppies or diskettes. (3) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act. (4) The register of designs shall be prima facie evidence of any matter by this Act directed or authorized to be entered therein.

Section 11. Copyright on registration - (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration. (2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.

Section 22. Piracy of registered design - (I) 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. (1) 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), every ground on which the registration of a design may be cancelled u/s 19 shall be available as a ground of defence.

(4) Notwithstanding anything contained in the second proviso to sub-Section (2), where any ground on which the registration of a design may be cancelled u/s 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.

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 registrable under this Act; or

(e) that 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.

11. The conjoint reading of the aforementioned provisions would reveal that the Act is a complete code itself which provides that there is a condition for certificate of registration of the said design u/s 9 and the said design upon registration confers the copyright in the said design for a period of 10 years as envisaged u/s 11 and for further renewable of five years under the said provision. The said term of the also indicates that the design right is a statutorily conferred right for limited period and there is no room for any other right to exist except the one conferred by the Act. Likewise, Section 22 provides remedy for piracy of a registered design wherein the said piracy will only happen during the existence of copyright in the said design. Sub-section (3) of Section 22 mandates that in any suit or any other proceedings for relief under sub-section (2) every ground on which the registration of a design may be cancelled u/s 19 shall be available as ground of defence.

12. All these provisions provided under the Act are indicators to the effect that infringement/piracy can only be of a registered design and the said remedy is available during the existence of the said copyright as mentioned u/s 11 of the Act. What follows from the above discussions is that there is no remedy, which is being saved.

13. The defendants relied upon the following decisions in support of their case:

I. Dabur India Limited Vs. Mr. Rajesh Kumar and Others,

In cases of design, the Court while granting interim injunction must keep in mind that the design must be validly registered and there must be some novelty and originality in the designs sought to be protected and it must not have been re published. No specific novelty has been mentioned by the plaintiff in the design of the bottle, neither any specific novelty has been mentioned in the registration certificate. The registration certificate only gives bottom view, top view and side view of the bottle. There is no specific dimensional ratio of the bottle given in the design as bottles are manufactured by most of the manufacturers for containing specific quantity of liquid by measurement. Normally these bottles are made 50 ml, 100 ml, 200 ml, etc. Since all the manufacturers manufacture bottles for such quantities, the bottles of same quantity are bound to have almost same height if they have same bottom circumference. Unless, plaintiff had any claim over specific ratios of the dimensions which were not pre-existing, there can be

no novelty in the bottle. Similar designs are being used by many leading companies from the time much before the registration of this design by the plaintiff. I, Therefore, consider that the plaintiff is not entitled for interim injunction. The application of the plaintiff is hereby dismissed.

II. Rotela Auto Components (P) Ltd. and Another Vs. Jaspal Singh and Others,

28. As far as present Act is concerned, the legislature in its wisdom by incorporating Sub-section (3) of Section 2 of the Act has made every ground, on which registration of a design may be cancelled, available as a ground of defense. The ground on which cancellation can be sought of registration are enumerated in Section 19 of the Act. It may be noticed that the design is a conception, suggestion or idea of a shape and not an article. If it has already been anticipated, it is not new or original. If it has been pre-published, it cannot claim protection as publication before registration defeats the proprietor's rights to protection under the Act.

29. Looking it from any angle from the documents placed on record the design has been pre-published and, Therefore, it cannot claim protection. In view of the fact that registration of design is of recent date, the design having been published earlier, the ground of defense as mentioned in Section 19 can be taken by the defendants pursuant to Sub-section (3) of Section 22 of the Designs Act, 2000, Therefore, no injunction can be granted as there is a serious dispute as to the validity of the design to be tried in the suit. Before closing the arguments affidavit has been filed by the defendants that application for cancellation has already been made by the defendants before the appropriate authority. The applicants are not entitled to the injunction. I, Therefore, vacate the injunction order granted earlier. The order dated 10th July, 2001 stands vacated. The application of the plaintiff is dismissed. Nothing said earlier would be an expression of opinion on the merit of the case. However, the defendants are directed to keep an account of the sale of the impugned product. The defendant shall submit the statement after every six months in Court. The defendants shall also give an undertaking within six weeks that they will pay the damages to the plaintiffs if ultimately plaintiffs succeed in the suit.

III. Prayag Chand Agarwal Vs. M/s Mayur Plastics Industries,

But in view of the facts that the broad pattern of the two soles seems to be the same and the entire sole of both the shoes have same patterns, cuts, rigid roofs and lines pattern and in view of the fact that law is well settled that when serious disputed question on various grounds such as prior publication, lack of originality, trade variation is raised in a particular case, no injunction should be granted. Taking into consideration that the impugned design is registered in favor of the plaintiff in the year 1995 and the same having been shown to be in use from 1988 onwards i.e. prior to the registration of plaintiff's design and plaintiff has prima facie failed to establish that he was the originator of the design, it is difficult to injunct the defendant.

IV. Prem Singh Vs. Ceeam Auto Industries,

The consensus of judicial opinion is thus unmistakably clear to the effect that in order to succeed in an infringement of copyright, or passing off action, a party has to show that he is originator in the sense that the concept emanated from him, and further that the given design or get-up or style has become distinctive of his goods to the extent that the trading public associates his goods exclusively with the given design or get-up. The moment this is established even prima facie, the Courts have never hesitated, in stopping the-opposite party, shown to have adopted by imitation or other deceptive means, the design or get-up of the first party, from continuing with the mischief, because that is treated to be a rank instance of dishonesty by the second party.

V. The Wimco Limited Vs. Meena Match Industroies,

17. The design may be applied to any kind of article but some novelty or originality must exist in a substantial degree otherwise it would paralyse the industry to make the design a trap for honest traders. There is no novelty or originality as the identical design has already been applied to the match boxes. I have already discussed at length the evidence of pre-publication of the design which shows prior application to the same class of goods, namely, match boxes. The same reasoning would apply.

18. For the above reasons, I hold that Design No. 146498 dated January 5, 1978 is liable to be cancelled on both the grounds, namely, that it has been published in India prior to the date of registration and that the design is not new or original design. Issue No. I is held in favor of the petitioner and against Wimco.

The defendants have produced few helmets of the parties as well as of third parties and also original catalogues in order to show the prior publication/user of plaintiff's design. It is admitted position that the brand names of the parties are totally different.

14. In the present case, it is undisputed fact that pattern of the helmet is available in this country and other parts of the world for more than three decades. Even the plaintiff is manufacturing and marketing helmet for the last more than twenty years. The issue involved in the present litigation is as to whether novelty, shape and configuration claimed by the plaintiff during the course of hearing is new or original or has not been prior known or published by anyone or not on the date of registration i.e. 1st December, 2011. If the answer is yes, then interim order must continue. If answer is in negative, then interim order may not be issued as per settled law.

15. It was expressed by Buckley L.J. on the question of quantum of novelty in *Simmons v. Mathieson & Cold*, (1911) 28 R.P.C. 486 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.

16. In *Phillips v. Barbro 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, 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 what 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, any man does not make a new and original designs out of an old type of running shoes by putting spikes into the sales. 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 as "new and original design" unless it is 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 tender 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.

17. The question before me for consideration is whether the plaintiffs' design when registered on 1st December, 2011 was new or original or different from what has been done before. As per certificate of registration produced alongwith plaint, the same does not show any light except the novelty is claimed in all views for the whole shape, configuration and surface pattern of the Helmet. "Original" means that the design originating from the author.

18. Drawing a distinction between "new" and "original" Buckley L.J. said in *Dover Ltd. vs. Nurnberger Celluloidwaren Fabric Gebruder Wolff*, (27 R.P.C. 498) that "new" is referred to a case where the shape or pattern was wholly new in itself and on the other hand "original" to the case where it was old but new in its application to the particular subject matter. The word "original", according to the learned Judge "contemplates that the person has originated something, that by

the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it shall be applied".

19. It is rightly held in the cases decided that in the matter of novelty the eye is to be the ultimate test and the determination has to be on the normal ocular impression. In order to know its newness or originality it is necessary that a design identical with or even materially similar to the relevant design should not have been published or registered previously. A slight trivial or infinitesimal variation, from a pre-existing design will not qualify it for registration. Taking into account the nature of the article involved, the change introduced should be substantial. It is not necessary to justify registration that the whole of the design should be new, the newness may be confined to only a part of it but that part must be a significant one and it should be potent enough to impart to the whole design a distinct identity, unless registration is sought for the said part alone.

20. It was laid down by Lord Moulton in *Phillips v. Harbro Rubber Company* (37 R.P.C. 233) that it is the duty of the Court to take special cast that no design shall be counted new or original unless it is distinct from what previously existed by something essentially new or original which is different from ordinary trade variants which may have long been common matters of taste or choice in the trade. It is well established that a registration cannot be deemed effective unless the design or configuration sought to be protected is new or original and not of a pre-existing common type. (*Ram Sahai v. Angnoo*, Air 1922 All, 496, AIR 1934 709 (Lahore) and *The Pilot Pen Co. (India) Private Ltd., Madras Vs. The Gujarat Industries Private Ltd., Bombay*, Vide In the matter of Wingate's Registered Design No. 768.611 (52 R.P.C. 126) it was observed that what a substantial difference is, is a question upon which no general principle can be laid down at all; it must depend on the particular facts in each case. In one case a quite small variation in the details of a design may be enough to make the design something quite different from an existing design. On the other hand, there are cases even where quite large alterations in detail leave two designs for all practical purposes the same. The Court has to consider and look at the design in question with an instructed eye and say whether there is or is not such a substantial difference between that which had been published previously and the registered design as to entitle the proprietor of the registered design to say that at the date of registration that was a new or original design and therefore properly registered.

21. Thus, the design must be held to be valid if the statement of novelty is correctly construed in the narrow sense. However, in other type of cases like the case reported in *Neggretti and Zambra v. W.F. Stanley & Co., Ltd.* (42 R.P.C. 358), the case was concerned with the design of a thermometer. The Court deciding the action noticed the plaintiffs had produced a useful article of commerce for a particular purpose, which, from its smallness and neatness, was readily distinguishable from the larger thermometers which had gone before; but

that was found to be wholly immaterial. "The fact that the plaintiffs have hit upon a useful shaped and useful sized thermometer for the particular purpose in hand", it was found that there is no reason in law why the defendants should not even copy such features of that Design which were common in the trade, nor is it any reason why they should not add to such Design any ordinary trade improvement or trade variant which is obvious as soon as the particular use to which the article is intended to be put is appreciated."

22. The defendants in order to show prima facie evidence with regard to prior knowledge and prior publication of the similar design than the plaintiff's design's registration date i.e. 1st December, 2011, has produced the following documents and tried to connect the documents along with invoices and name of the model and their advertisement.

(a) The product catalogue of AIROH of the year 2010 shows picture of their helmet with Code TR 211 which is visually and structurally similar to the subject matter of design No. 241153.

(b) The product catalogue of AIROH of the year 2010 on page 12 shows picture of their helmet with Code TR 211 shows has a "Beak Shaped" design. The original catalogue has also been handed across during arguments.

(c) The STUDDS Downtown Full face helmet which is identical to the plaintiff's design has been available in the market much prior to the registration of the alleged design of the plaintiff i.e. 1st December, 2011. The original catalogue showing the STUDDS Full face Downtown helmet is on page 19 of the defendant documents. Also, the price list/rate card (dated 20th December, 2011) mentioning the price of the STUDDS Downtown Full face helmet is on page 27 of the defendant documents. Original invoices along with the delivery challan and the VAT Form dated 10th October, 2011, 12th October, 2011 and 17th August, 2011 is filed with the additional list of documents filed on 23rd January, 2014 and 24th January, 2014 shows that the STUDDS helmet were being sold even prior to the registration of the alleged design of the plaintiff. Further, the original STUDDS Full face Downtown helmet was placed before this Court to show the identity with the design of the plaintiff.

23. Therefore, it appears to this Court prima facie that similar design was in fact already available in the market manufactured by STUDDS Accessories Ltd. and the design thereof would certainly have been conceived by this manufacturer much prior to 1st December, 2011. The product brochure of STUDDS along with the above said price list is filed with the present application which shows beyond doubt that the plaintiff's design is neither new nor original.

24. It is also a matter of fact that the plaintiff has not taken any action against the company who is marketing STUDDS and AIROH. Thus, the documents prima facie show that the alleged registered design of the plaintiff was published in tangible form and disclosed to the public in India as well as abroad within the meaning of Section 4(b) of the Act.

25. The mere glance at the product of the plaintiff reveals many similarities with the above said designs of the helmets of STUDDS and AIROH. Therefore, the plaintiff's product is not dissimilar from the designs of these two companies or combination thereof and hence falls within the purview of Section 4(c) of the Act.

26. There are various manufacturers already making such designs with the claimed "Beak Shape" and have been marketing across the world. An internet search reveals various such similarly designed helmets. The details and pictures of the same are mentioned earlier in this order.

27. Even otherwise the addition of small feature here or there from the features of STUDDS and AIROH helmets" design would not make any difference which could only be called as routine type of trade variation as per demand of customers for their conveniences and advantages. Thus, prima facie I do not find the plaintiff's design being new or original and is not meant for protection. The interim injunction is thus accordingly liable to be vacated. Ordered accordingly. Both the applications are disposed of.

CS(OS) No. 2407/2013

List before the roster Bench on 6th May, 2014.