

(2001) 01 DEL CK 0127

In the Delhi High Court

Case No : IA No's. 4266 and 5295/99 in Suit No. 893 of 1999

Texla Metals and Plastics Pvt. Ltd.

APPELLANT

Vs

Anil K. Bhasin and Others

RESPONDENT

Date of Decision : 31-01-2001

Acts Referred:

Designs Act, 1911 — Section 43

Citation : (2001) 01 DEL CK 0127

Hon'ble Judges : Madan B. Lokur, J

Bench : Single Bench

Advocate : Neel Mason, for the Appellant; Harish Malhotra and Aswhani Sood, for the Respondent

Judgement

Madan B. Lokur, J.—is No. 4266/99 is an application filed by the plaintiff under Order 39 Rule 1 and 2 of the Code of Civil Procedure, while is No. 5295/99 is an application filed by the Defendant under Order 39 Rule 1 of the Code of Civil Procedure.

2. The case of the plaintiff is that it has obtained a registration of a design of a bollard with effect from 21st September, 1988 under Registration No. 177437. A bollard is actually a road safety marker. The design of the plaintiff consists of a rhombus with nine reflectors inside it. Below the rhombus are the words "DARK EYE". Below these words is a circular disk with an arrow pointing towards the road and below the circular disk is a pole. The entire unit is called a bollard.

3. The plaintiff also claims to have obtained registration of the design of a delineator with effect from 21st September, 1988 under Registration No. 177438. A delineator is also a road safety marker and consists of a circular reflector on a pole. The circular reflector is covered by a cage to protect it from damage or theft.

4. The plaintiff has attached the registration certificates as well as photographs of a bollard and a delineator designed by the plaintiff along with the plaint.

5. The Defendant is also manufacturing bollards and the admitted position is that the bollard of the Defendant also consists of nine reflectors in a rhombus. This rhombus is placed upon a pole. In other words, the difference between a bollard of the plaintiff and the Defendant is that in the case of the Defendant the words "DARK EYE" and the circular disk with an arrow is missing. The Defendant is also manufacturing delineators and as per the photographs annexed to the plaint the design of the delineator is the same, namely a circular reflector on top of a pole.

6. According to the plaintiff, it had conceived both designs and had applied for their registration which was granted to the plaintiff without any objection. The plaintiff says that the Defendant is infringing the designs of the plaintiff and, Therefore, an injunction should be granted restraining the Defendant from manufacturing bollards and delineators which infringe the design of bollards and delineators designed by plaintiff.

7. According to the Defendant, these items are of common use as road safety markers in Korea and Japan. The Defendant is aware of these items and had even obtained catalogues and samples of these items prior to the application filed by the plaintiff for registration of the designs.

8. Before considering the various submissions of learned counsel for the parties, it would be worth noticing that Section 43 of the Designs Act, 1911 provides for the making of an application by any person claiming to be the proprietor of any new or original design not previously published in India. A design when so registered will be effective from the date of the application for registration. Section 51-A of the Designs Act, 1911 provides for the cancellation of a registration already granted. The registration of a design may be cancelled if the design has been previously registered in India or it has been published in India prior to its registration or if the design is not a new or an original design.

9. The Defendant has taken no steps to have the design of the plaintiff cancelled on any of the grounds mentioned in Section 51-A of the Designs Act, 1911.

10. However, before me the contention of learned counsel for the Defendant is that both the designs have been published in India prior to the date of the application of the plaintiff and the design is not a new or an original design.

11. Learned counsel for the Defendant has sought to place reliance on certain brochures and catalogues said to have been received by him from Korea and Japan to show that bollards and delineators were in use in those countries several years ago. While this may be so, these brochures relied upon by the Defendant do not indicate the date of publication. In any case, there is nothing to suggest that these brochures were available in India or were in a sense published material which is available to the general public. In view of this, no reliance can be placed on these brochures and catalogues.

12. Learned counsel then relied upon a letter dated 31st December, 1997 said to have been written by the Defendant to the Assistant Engineer of the Municipal

Corporation of Delhi regarding the display of road safety signs and devices. It is mentioned in the letter that the Defendant has displayed delineators on G.T. Road near Shyam Lal College red light and fly over. Again, the nature of these delineators that have been displayed has not been indicated and there is nothing to suggest that these delineators which the Defendant claims to have displayed are of a similar design to the delineators of the plaintiff. This letter also does not suggest any prior publication of the design of delineators manufactured by the plaintiff.

13. Reliance is also placed upon two letters to suggest that the Defendant had received brochures from Malaysia referring to road safety equipment being manufactured in Korea. These letters also do not advance the case of the Defendant because there is nothing to indicate that the goods described were in any manner similar to the designs registered by the plaintiff.

14. Learned counsel for the Defendant placed reliance upon a few decisions in support of this case. He relied upon Joginder Singh Vs. Tobu Enterprises (P.) Ltd., more, particularly the example given towards the end of paragraph 10 of the Report where it has been stated as follows :-

"If, for example, an importer imports a car which works on solar energy and even though the car so imported may be the only one of its kind in India but when it is driven on the roads here it would mean that the design of the car has been made public in India."

15. There can be no dispute about the proposition that has been laid down. I do not see how it applies to the facts of the present case since there is nothing to suggest that bollards and delineators similar to the ones designed by the plaintiff were made public in India or were displayed in India. On the other hand, it has been held in the very same judgment as follows :-

"If goods are imported from abroad and are used by the importer without its disclosure to anyone else and goods of such design are not freely available in India then, possibly, it can be said that there is no publication of the design of the goods so imported."

16. In the present case, even if the contention of learned counsel for the Defendant is accepted that his client has received brochures from Malaysia, Korea and Japan with regard to these goods, the mere receipt of such brochures would not amount to publication of such designs within India.

17. Reliance was also placed upon National Trading Co. Vs. Monica Chawla, , particularly paragraph 5 of the Report to contend that publication of a design, if disclosed to any individual member of the public who is not under an obligation to keep it secret, would constitute publication of the design. I am afraid this decision does not help the case of the Defendant because there is nothing in the present case to suggest that the designs registered by the plaintiff were either disclosed to any person prior to their publication or any individual was made

aware of these designs.

18. Learned counsel for the Defendant then referred to *Brighto Auto Industries v. Raj Chawla* 1977 RLR 755, to explain the principles laid down for the cancellation of a design. I am not dealing with a case of cancellation and, Therefore, this decision is of no consequence.

19. Learned counsel for the Defendant finally relied upon. *The Pilot Pen Co. (India) Private Ltd., Madras Vs. The Gujarat Industries Private Ltd., Bombay*, to contend that unless the design is new, original and not of a pre-existing type its registration cannot be deemed to be effective. This decision has to be read in the context of Section 43 of the Designs Act, 1911 which requires previous publication of the design in India. 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 relatable 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.

20. Under the circumstances, I am of the view that the plaintiff has made out a case for the grant of an injunction.

21. An ex parte injunction had already been granted in favor of the plaintiff on 28th April, 1999. This injunction is confirmed in view of my findings above. *is No. 4266/99 is*, Therefore, allowed. Consequently, *is No. 5295/99* filed by the Defendant under Order 39 Rule 4 of the CPC is dismissed.

22. Needless to say, any expression of views is only for the purpose of deciding the applications before me and is not intended to be binding in the final disposal of the suit.

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The Defendant should file its written statement. Replication may be filed thereafter.

To be listed before the Joint Registrar on 12th April, 2001 for admission/denial of documents.