

(2018) 06 DEL CK 0041
In the Delhi High Court
Case No : CS(COMM) 837 OF 2017

VEGA AUTO ACCESSORIES (P) LTD	Vs	APPELLANT
S.K. JAIN BROS. HELMET (I) PVT. LTD		RESPONDENT

Date of Decision : 01-06-2018

Acts Referred:

Code of Civil Procedure, 1908 — Order 9 Rule 1, Order 39 Rule 4
Trade Marks Act, 1999 — Section 31
Designs Act, 2000 — Section 4, 10(4), 22, 22(1)

Citation : (2018) 06 DEL CK 0041

Hon'ble Judges : RAJIV SAHAI ENDLAW

Bench : Single Bench

Final Decision : Disposed Of

Judgement

1. The plaintiff has sued the defendant for permanent injunction restraining infringement of registered design in relation to helmets, and for ancillary reliefs.
2. The suit was entertained and summons/notice of the application for interim relief ordered to be issued, though no ex-parte injunction granted.
3. The counsel for the defendant appeared on 12th December, 2017 and stated that he did not know anything about the case and sought adjournment. It having been made clear while issuing summons/notice, that the application for interim relief shall be heard on the date for which the summons/notice were issued, on 12th December, 2017, while granting time to the defendant to file written statement/reply, the defendant and its dealers and agents were restrained from making, selling, offering for sale, advertising and directly or indirectly dealing in helmets amounting to infringement of plaintiff's registered design No.264763 dated 13th August,

2014 (incorrectly stated in the plaint as 13th August, 2013) and particularly the helmets under the mark "POWER" and as depicted in paragraph 22 of the plaint.

4. The defendant filed application under Order XXXIX Rule 4 of the Code of Civil Procedure, 1908 (CPC) contending that the design of the defendant was also registered and interim injunction should thus be vacated.

5. The said application came up before this Court on 4th January, 2018. The counsel for the plaintiff appearing on advance notice on that date referred

to Mohan Lal, Proprietor of Mourya Industries Vs. Sona Paint & Hardwares AIR 2013 Del 143 (FB) holding that a suit for infringement of a

registered design lies against a registrant of a design as well. The counsel for the plaintiff also sought time to reply to the application under Order

XXXIX Rule 4 of the CPC and the hearing was adjourned to 15th February, 2018. At the instance of defendant, it was however clarified that the ad-

interim order did not injunct the defendant from using the mark "POWER" for marketing helmets of other designs.

6. The defendant preferred FAO(OS)(COMM) No.13/2018 against the orders dated 12th December, 2017 and 4th January, 2018 and which was

disposed of on 24th January, 2018 observing that since the hearing was scheduled before this Court for 15th February, 2018, no interference was required.

7. The counsel for the parties were heard on 15th February, 2018.

8. The counsel for the defendant, during the course of hearing drew attention to the IA No. 1903/2018 under Order XI Rule 1 of CPC for taking on

record documents filed subsequent to the filing of replication by the plaintiff to the written statement of the defendant. The counsel for the defendant,

with respect to the additional documents, stated that the same are with respect to three helmets "Vega off Road", "O2" and

"Cruizer" and show the features in the helmet of the plaintiff to have been prior published.

9. The counsel for the plaintiff contended that the said documents cannot be taken on record. In fact, the counsel for the plaintiff, at the

commencement of hearing only, contended that if the said documents were to be relied upon by the defendant in the course of hearing, first the said

application has to be considered.

10. However, during the hearing, both counsels referred to the said additional documents; the counsel for the plaintiff of course, without prejudice to

her rights and contentions and in this light of the matter, it is deemed appropriate to allow the said documents to be taken on record.

11. IA No.1903/2018 is allowed and disposed of.

12. The counsel for the plaintiff argued, (i) that the registration in favour of the plaintiff is dated 13th August, 2014 and the registration relied upon by

the defendant in its favour with respect to the impugned product is dated 1st March, 2017; (ii) that while the product of the plaintiff is sold under the

mark 'VEGA', the product of the defendant is sold under the mark 'POWER'; (iii) that the defendant, in its written statement has raised

three defences; firstly, that they also have a registered design; secondly, that the registered design of the plaintiff had been pre-published; and, thirdly,

that the design of the plaintiff and the design of the defendant are different; (iv) attention was invited to the registration in favour of the respective

parties to contend that the design of the defendant is identical to the design of the plaintiff and minor variations cannot allow the defendant to defeat

the claim of the plaintiff for infringement, as the test of substantial similarity is to be applied.

13. The counsel for the plaintiff, on enquiry, whether a holder of the registered design can maintain a suit for infringement, as this suit is, against holder

of a registration and whether not as per the law under the Trade Marks Act, 1999, in such eventuality, the remedy would be only of passing off, has

again invited attention to Mohan Lal, Proprietor of Mourya Industries supra and the counsel for the defendant did not controvert the said legal

position. A reading of the judgment indeed shows the Full Bench of this Court, by majority, to have held so.

14. I enquired from the counsel for the defendant, that the defendant being itself a registrant of the design, if found to be similar to that of the plaintiff,

whether can take a plea of the design of the plaintiff being prior published and being thus not valid and the plaintiff being not entitled to injunction on

this ground.

15. The counsel for the defendant though controverted but on further enquiry stated that there is no judgment till date on the said position. He

however contended that merely because the defendant also has obtained

registration, even if the design of the defendant is identical to that of the plaintiff, the same would not prevent the defendant from taking the plea of, the design of which the plaintiff has obtained registration, being not original or new or having been prior published.Â It was contended that the said defence, under the scheme of the Designs Act, 2000, is vested in a defendant in a suit for infringement and merely because the defendant is also a registrant, will not deprive the defendant from taking such a defence. Though the counsel for the defendant also took me through the provision of the Act but need to record the same is not felt.Â Suffice it is to record the contention that the defences under Section 22(3) are available against a claim for infringement.

16. The counsel for the defendant next contended that the registration is never for the entire product and is only for what is new and novel.Â It was argued, that otherwise, helmets have been in vogue since much prior to the registration in favour of the plaintiff and owing to the very nature of the product and the requirement to comply with ISI specifications, all the helmets will have certain common features.Â

17. The counsel for the defendant, on being asked to point out the dissimilarities in the subject helmet of the defendant with the subject helmet of the plaintiff, invited attention to four features i.e. (a) placing of front air vent; (b) button at the bottom for lifting the visor is on the inside and not visible from outside and is different from that on the helmet of the plaintiff; (c) symbol of gear lock on the right side of the helmet of the defendant is unique and not to be found on the helmet of the plaintiff; and, (d) the shape of the air vent at the place of the chin are different in the two helmets.

18. However when the counsel for the defendant, during the course of hearing, was showing other helmets in the Court under the mark

â??CRUIZERâ?, â??O2â? and â??VEGA OFF ROADâ?, it was found that the button on the inside, to lift the visor, in the helmet of the defendant

is identical to that in the helmet under the mark â??O2â? and the counsel for the defendant agreed that the same cannot be said to be unique to the

helmet under the mark â??POWERâ? of the defendant.

19. It was also the contention of the counsel for the defendant, that air vents are also common to all helmets and the newness or originality with

respect thereto can only be with respect to the shape thereof.Â It is argued that

the shape of the air vents in the subject helmet of the plaintiff and in the impugned helmet of the defendant is different.Â It is further contended that the functional features in a helmet, by virtue of the definition of design in Section 2(d), are excluded from consideration and the lines on the helmet are functional for the reason of aerodynamic and no uniqueness with respect thereto can be claimed.

20. The counsel for the defendant also argued that mere registration does not grant protection and the entire case of the plaintiff is based on the entirety of similarity but it is the uniqueness of the features which is to be seen and not the product in entirety.

21. During the course of hearing, the counsel for the plaintiff, with respect to the vents at the place of chin on the helmet of the defendant, also agreed that the said vents are of the same shape as the vents in the helmets under the mark â??O2â? and â??VEGA OFF ROADâ? of the plaintiff. The defendant thus cannot claim uniqueness with respect thereto as well.Â

22. The counsel for the defendant referred to paras 30 to 32 of Amit Jain Vs. Ayurveda Herbal 2015 63 PTC 121 (Del) and to Steelbird Hitech India Ltd. VS. S.P.S. Gambhir (2014) 58 PTC 428, also with respect to helmets.Â Attention was also invited to Russell-Clarke on Industrial Designs, Sixth Edition para 3.183 titled â??Isolating the features which constitute the designâ?.

23. The counsel for the plaintiff, in rejoinder, contended that it is overall design which has to be seen and not only the unique features. It was argued, that the registration granted is also not with respect to the unique features but with respect to overall design.Â Reliance was placed on para 29 and 30 of Troikaa Pharmaceuticals Ltd. Vs. Pro Laboratories (P) Ltd. (2008) 3 GLR 2635, para 12 of Vikas Jain Vs. Aftab Ahmad (2008) 37 PTC 288 (Del) and paras 17 & 18 of Dabur India Ltd. Vs. Amit Jain 155 (2008) DLT 407 (DB).

24. The counsel for the defendant, by sur rejoinder, contended that patent has also been obtained in United States, as far back as in the year 2001, with respect to the features on the helmet of the plaintiff.Â The counsel for the defendant, from the additional documents aforesaid, also showed that the pre-publication was on 22nd December, 2013 and 28th April, 2014.

25. I have considered the rival contentions.

26. I will first deal with the aspect, whether it is open to the defendant to oppose the interim injunction on the ground of invalidity of the design of the plaintiff and / or on the ground that the design of the plaintiff has been prior published.

27. As far as the law relating to trade marks is concerned, it has been consistently held by this Court in (i) Automatic Electric Limited Vs. R.K.

Dhawan (1999) 77 DLT 292; (ii) The Indian Hotels Company Ltd. Vs. Jiva Institute of Vedic Science and Culture 2008 (37) PTC 468 (Del) (DB);

and, (iii) Anchor Health & Beauty Care Pvt. Ltd. Vs. Procter & Gamble (Tianjin) Co. Ltd. 2014 SCC OnLine Del 2968, appeal whereagainst was

dismissed vide judgment reported as Procter & Gamble (Tianjin) Co. Ltd. Vs. Anchor Health & Beauty Care Pvt. Ltd. (2014) 211 DLT 466 (DB)

and SLP (C) No.15928 & 15929/2014 preferred whereagainst were dismissed on 3rd July, 2014, that the defendant itself having got his mark

registered, when faced with action by another for infringement, cannot say that the mark of the prior registrant was not distinctive or could not have

been registered. The reasoning which prevailed to hold so was that it is not open to a litigant to approbate and reprobate or to blow hot and cold. It

was yet further held that even if the defendant had only applied for registration, it is still not open to him to thereafter in a suit by another, take the

defence of the mark being descriptive and incapable of protection as a trade mark by the Civil Court.

28. I am unable to find any reason why the said principle of general law should not be made applicable to a defendant in a suit for infringement of

design. Though there is an essential difference in registration of a trade mark and registration of a design i.e. while registration of a trade mark vide

Section 31 of the Trade Marks Act gives rise to a presumption of validity of registration, it is not so qua registration of a design which as per Section

10(4) of the Designs Act is prima facie evidence only of the matters directed or authorised to be entered in the Register, however the reason which

prevailed in the judgments aforesaid was not of prima facie validity of the registration of trade mark. The reason which prevailed in the judgments

aforesaid was, that if a party has taken up a specific stand at a particular stage of the Court proceedings, it should not be open for him to take a

contrary position at a subsequent stage of litigation or in a different proceeding. The Full Bench of this Court in Rajneesh Kumar Singhal Vs. The

State (National Capital Territory of Delhi) 89 (2001) DLT 511 held that the said principle serves well as it does not allow a litigant to blow hot and cold

at successive stages of the same litigation or another litigation. It was held to be an elementary rule, that a party litigant cannot be permitted to assume

inconsistent positions in Court, to play fast and loose, to blow hot and cold, to approbate and reprobate, to the detriment of his opponent. This

wholesome doctrine was held to apply not only to the successive stages of the same suit, but also to another suit than the one in which the position

was taken up, provided that the second suit grows out of the judgment in the first.Â

29. Though the counsel for the defendants stated that there is no judgment on the said aspect but I find the Division Bench of the High Court of

Bombay in Asian Rubber Industries, New Delhi Vs. Jasco Rubbers Calicut 2013 (53) PTC 495 (Bom) to have held that the defendants in that case

having themselves sought registration of their design, it was not open to them to say that the plaintiff cannot claim exclusivity and it does not lie in the

mouth of defendants to contend that the plaintiff's design is not new or original or there is no novelty. The said view was reiterated recently by

another Division Bench of that Court in Kalpesh R. Jain Vs. Mandev Tubes Private Limited 2018 (73) PTC 591 (Bom). The High Court of Madras

also, in Dart Industries Inc. Vs. Cello Plastotech MANU/TN/1629/2017, relying on the dicta of this Court in Automatic Electric Limited supra, held

that the contention of the defendants of lack of novelty had no merit.

30. Another contention of the counsel for the defendant in this respect however remained to be recorded above. It was the contention of the counsel

for the defendant that unlike under the Trade Marks law, under the scheme of Designs Act there is no requirement on the applicant for registration of

a design to make an averment of the design being novelÂ or new and having not been pre-published and no such declaration is required to be made in

the forms prescribed for an application for registration of design.Â

31. I am however of the view that, notwithstanding the same, once an application for registration is made, in the light of the prohibition contained in

Section 4 of the Designs Act that a design which is not new or original or which has been disclosed to the public anywhere in India or in any other

country by publication or which is not significantly distinguishable from known

designs or combination of known designs, shall not be registered, it is implicit that the applicant for registration is making a declaration of the design of which registration is sought not falling in any of the clauses of Section 4 of the Act.Â In fact, the counsel for the defendant also subsequently stated that the prescribed form requires a declaration of newness and originality to be made.Â

32. Once, an applicant has claimed his design to be new or original and having not been prior published and being distinguishable from known designs, he cannot oppose the claim for infringement by a prior registrant, if his design is identical to that of the prior registrant, by contending that there is no newness or novelty in the design of the plaintiff and/or that the design of the plaintiff was prior published.

33. I therefore hold that the plea, of invalidity of registration of design of the plaintiff is not open to the defendant.Â The defendant having itself obtained registration of the impugned design; if the impugned design is found to infringe the design of the plaintiff registered prior to registration in favour of defendant, is estopped from taking the plea of invalidity of registration in favour of plaintiff.Â

34. The only question which thus remains for determination is, whether the defendant has pirated the registered design of the plaintiff within the meaning of Section 22(1) of the Designs Act.

35. Per Section 22, during the existence of copyright in any design, it is not lawful for any person, for the purpose of sale, to apply or cause to be applied to any article or any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, or to do anything with a view to enable the design to be so applied and to expose for sale that article. It is thus to be determined, whether the design of the helmet under the mark â??POWERâ? of the defendant whereof the defendant obtained registration vide registration certificate dated 1st March, 2017, is fraudulent or obvious imitation of the registered design no.264763 dated 13th August, 2014 under the mark â??VEGAâ?? ofÂ the plaintiff.

36. The defendant, in its documents has filed photographs of the helmet of the plaintiff and its own helmet as under:-

37. The Certificate of Registration of design of the helmet aforesaid of the plaintiff comprises of six sheets showing front, back, top, bottom, left side

and right side views thereof and with each of the sheets bearing the following endorsement:-

“Novelty resides in the shape & configuration of the Helmet as illustrated.

No claim is made by virtue of this registration in respect of any mechanical or other action of any mechanism whatever or in respect of any mode or principle of construction of the Article.

No claim is made by virtue of this registration to any right to the exclusive use of the words, letters, numbers, or trademarks appearing in the representation.

No claim of extraneous matter at the background of the photo is made which are not forming integrated part of the design, the same is disclaimed.”

38. The Certificate of Registration of the design aforesaid of the helmet of the defendant comprises of seven sheets showing the perspective, front, back, left side, right side, top and bottom views thereof and with each of the sheets bearing the following endorsement:-

“The novelty resides in the shape and configuration of the HELMET as illustrated.

No claim is made by virtue of this registration in respect of any mechanical or other action of any mechanism whether or in respect of any mode or principle of construction of the article. No claim is made by virtue of this registration in respect of colors appearing in the representations.

No claim is made by virtue of this registration to the words, letters, numerals, trademark etc. appearing in the representations.”

39. Having been shown the subject helmets as well as a host of other helmets during the course of hearing, in my view the subject helmet of the defendant is an obvious imitation of the shape and configuration of the subject helmet of the plaintiff.

40. As far as the differences between the two pointed out by the counsel for the defendant during the hearing and as recorded above are concerned, the Division Bench of this Court in Dabur India Limited supra cited by the counsel for the plaintiff has reiterated that sameness of the features does

not necessarily mean that the two designs must be identical in all points and should differ on none of them they have to be substantially the same. It was

further held that the Court must address its mind as to whether the design

adopted by the defendants was substantially different from the design which was registered.

41. Applying the aforesaid test, it may be said that the following elements in the shape and configuration of the subject helmet of the plaintiff have

been obviously imitated in the subject helmet of the defendant:

- (i) shape and configuration of the outer shell;
- (ii) the placement of the flip-up chin bar with the pro-shield on the side plates;
- (iii) the placement of the pro-shield on the flip-up chin bar;
- (iv) the placement and shape of the super vent on the outer shell;
- (v) the placement of the mouth vent on the flip-up chin bar;
- (vi) the shape of the arm of the flip-up chin bar with pro-shield;
- (vii) the placement and the shape of the rear vent;
- (viii) the placement of the press button on the flip-up chin bar at the centre of the flip-up chin bar;
- (ix) the pattern of grooves and ridges on the outer shell and on the flip-up chin bar.

42. I have taken the names of the various components of the helmet as hereinabove mentioned, from the diagram shown as under available at

<https://motorcycleroom.com/the-motorcycle-helmet-parts/> Save that, I have called the part which covers the chin as chin bar.

43. Once it is so, the plaintiff has a prima facie case. Needless to add that continued infringement of the registered design of the plaintiff by the defendant would cause injury to the plaintiff which cannot be compensated monetarily or otherwise. The balance of convenience is also in favour of the plaintiff and against the defendant.

44. The plaintiff is thus found entitled to confirmation of the ad interim order dated 12th December, 2017.

45. Needless to state that findings including of law and observations hereinabove are for the purposes of decision of the application for interim relief only and would have no bearing at the time of final outcome of the suit.

46. IAs No.14568/2017 and 123/2018 are disposed of.