

Smithkline Beecham Consumer ... vs G.D. Rathore And Ors. on 16 January, 2002

Equivalent citations: 2002(25)PTC243(DEL)

Author: S.K. Mahajan

Bench: S.K. Mahajan

JUDGMENT

S.K. Mahajan, J.

1. Plaintiff claiming themselves to be the owners of the copyright in the precision moulds used for manufacturing toothbrushes under the name and style of DR. BEST, AQUAFRESH FLEX, AQUAFRESH FLEX 'N' DIRECT, have filed this suit against the defendants for an injunction restraining them from manufacturing, selling and/or offering for sale toothbrushes having dimensions like the toothbrushes CELLO FLEXY or any other toothbrush having dimensions substantially similar thereto or any other manner whatsoever infringing the copyrights of the plaintiffs in respect of the drawing and moulds for the DR. BEST and/or mould for the Flex 'N' DIRECT toothbrushes. Plaintiffs have also claimed an injunction restraining the defendants from manufacturing, selling and/or offering for sale toothbrushes which were identical in appearance to the AQUAFRESH FLEX toothbrush or any other toothbrush confusingly similar in appearance to the plaintiffs DR. BEST, AQUAFRESH FLEX and/or AQUAFRESH FLEX 'N' DIRECT toothbrushes or manufacturing toothbrushes under or by reference to the mark FLEXY or any other mark confusingly similar to the plaintiffs mark FLEX. The plaintiffs case in short is :-

2. That plaintiff No. 3 Along with its associate companies and its subsidiaries was one of the world's largest and fastest growing prescription medicines, over the counter medicines, consumer healthcare and oral care companies, that plaintiff No. 3 was carrying on its business activities in India through plaintiff No. 2, that plaintiff No. 3 and its subsidiaries and associated companies had researched and developed a design of toothbrush which comprised of a distinctive aesthetic handle and head shape ; a connecting portion with S-shaped (zig-zag) folds between the head (carrying the bristles) and the handle ; the S-shaped folds modifying flexibility between the head and the handle and that the S-shaped portion of the brush was alleged to be primarily aesthetic and serve the function of modifying flexibility of the connected portion. It was alleged that the toothbrush under the mark AQUAFRESH FLEX was test marketed in India in 1996 and put on general sale in July, 1997. The sale of AQUAFRESH FLEX in India for the year 1997 has been alleged to be more than Rs. 4.63 crores and for the year 1998 more than Rs. 12 crores. Plaintiff No. 3 has alleged to have spent more than Rs. 8.5 crores in advertising and promotion of AQUAFRESH FLEX toothbrushes in India in the year 1997 and more than Rs. 10 crores in the year 1998. The trade mark AQUAFRESH FLEX

as well as its packaging material and design of the toothbrushes have alleged to have acquired a tremendous reputation in India and other countries of the world and is alleged to be exclusively associated with the plaintiffs and no one else. Plaintiff No. 2 is allegedly selling its product AQUAFRESH FLEX in the carton/dispenser pack containing 12 toothbrushes apart from having a unique locking flap having a single toothbrush. It is submitted that a certain moulded toothbrush manufactured for plaintiff No. 1 is sold by it in German-speaking countries under the name DR. BEST SCHWINGKOPF ('DR BEST'). Another moulded toothbrush claimed to be a modification of DR. BEST SCHWINGKOPF design is allegedly sold by plaintiff No. 3 under the name AQUAFRESH FLEX 'N' DIRECT. It is stated that DR. BEST was test marketed in Germany in 1993 and FLEX 'N' DIRECT was test marketed in India in 1998 and the plaintiffs would start manufacturing the same shortly in India. It is submitted that the suit was not directly concerned with the toothbrushes but the defendants had infringed the copyright of the plaintiffs 1 and 3 in precision moulds used for manufacturing the toothbrushes.

3. Further case of the plaintiffs is that in or about August, 1990, plaintiff No. 1 had commissioned one Hans Halm to design a new toothbrush incorporating an 'S' bend region in the toothbrush neck between the handle and the head and the final result of such effort was the DR. BEST toothbrush. It is submitted that throughout the design process, plaintiff No. 1 and Hans Halm were in regular communication regarding the execution of the brief and the toothbrush design filed Along with the plaint was specifically approved by plaintiff No. 1. This design was stated to have been introduced by plaintiff No. 1 and Halm to its manufacturer M + C Schiffer GmbH, a German company specialising in the manufacture of toothbrush. It is submitted that the next stage for development of DR. BEST toothbrush involved a working collaboration between the four parties so as to produce a pilot mould and thereafter a production mould for quantity manufacture of DR. BEST toothbrush handle. It is stated in the plaint that the four parties involved in the project were : the Studio Halm, M + C Schiffer GmbH, plaintiff No. 1 and a Belgian company Machines Boucherie N.V. of Stuivenbergstraat, Belgium. It is submitted that from the drawings prepared by the plaintiff and Studio Halm, Schiffer with the approval of plaintiff No. 1 requested Boucherie to prepare drawings of precision pilot moulds for producing the said toothbrush handle by injecting moulds. The drawings of the said pilot mould were stated to have been made by one Geert Calu, a Belgian citizen working under a contract of service with Plast O Form. The drawings so prepared were stated to have been approved by plaintiff No. 1 and used by Boucherie to create a pair of precision moulds. It was in the year 1992, Pilot moulds were stated to have been made by two Belgian citizens working under a contract of service with Plast O Form. Sample toothbrush handles were stated to have been produced by Boucherie using this pilot moulds by injection moulding of plastic and rubber during late 1992 for approval by plaintiff No. 1. The sample toothbrushes stated to have been approved by plaintiff No. 1 and Boucherie was then produced by Schiffer on the direction of plaintiff No. 1 for preparing drawings for making production moulds for the said toothbrush handle. It is submitted that by late 1992 drawings for the production mould were made. It is submitted that the production mould was in reality, the pilot mould multiplied by six. The toothbrushes made by the use of the said production mould was stated to have been launched in Germany in 1993 by plaintiff No. 1 under the name and style of DR. BEST SCHWINGKOPF.

4. The AQUAFRESH FLEX 'N' DIRECT toothbrush is alleged to be a modification of DR. BEST toothbrush. It is submitted that in late 1992 plaintiff No. 3 decided to develop a modified version of the DR. BEST toothbrush. According to the proposal, the modified version was to be a two-component plastic and rubber toothbrush based in apart upon the DR. BEST toothbrush. However, the handle was proposed to be of a modified shape. The toothbrush is stated to have become known as the FLEX 'N' DIRECT toothbrush'. On the instructions of plaintiff No. 3, Studio Halm is stated to have designed the modification of DR. BEST toothbrush for market outside Germany and an initial sketch was allegedly made in 1993. It is submitted that throughout the design process, plaintiffs 1 and 3 and Studio Halm were in regular communication regarding the execution of the brief. On approval of the design by plaintiff No. 3 and Halm, it was introduced to Schiffer who prepared a mould in the same manner as was prepared in the case of DR. BEST toothbrush. Sample toothbrush handles were stated to have been produced by Boucherie by injection moulding during June, 1993 for approval by plaintiff No. 3. On approval of the sample toothbrush handles, instructions were given to prepare drawings for the production moulds. It is submitted that there was no material change between the pilot and the production mould. The toothbrush made by the use of the aforesaid production mould was stated to have been launched in Great Britain in 1993 as the FLEX 'N' DIRECT toothbrush.

5. The case of the plaintiffs is that the drawings for the pilot moulds are the original works of respective authors and were produced in the course of and as part of their authors' employment under a contract of service with the plaintiffs. It is also submitted that the moulds for the DR. BEST toothbrushes and the FLEX 'N' DIRECT toothbrushes are also the original works of respective authors and were produced in the course of and as part of their authors' employment under the aforesaid contract of service and copyright subsists in them. It is submitted that the said moulds have never been published and at all material time were in custody, power and control of the plaintiffs being their confidential property. It is submitted that by virtue of Section 40 of the Copyright Act, 1957 the said 'works attract copyright protection, in India, Belgium being a country specified in both the Schedule (Parts I and II) to the International Copyright Order, 1958 and in the Schedule (Parts I and II) to the International Copyright Order, 1991. It is submitted that the drawings of the aforesaid moulds are the original artistic works within Section 2 of the Copyright Act, 1957. It is submitted that each of the said works having been commissioned by and fully paid for by plaintiffs 1 and 3, they are the owners of all intellectual property rights including copyright therein and the plaintiff being the equitable owners of any or all such copyrights, are entitled to initiate and maintain the present suit. It is submitted in the alternative and for avoidance of debate in the matter, Boucherie have expressed their willingness to assign all title to the several copyrights works in India to plaintiff No. 3. It is submitted that the copyright subsists in India in the pilot mould drawings and in the pilot moulds for the DR. BEST toothbrushes and AQUAFRESH FLEX toothbrushes and plaintiffs 1 and 3 are the proprietors thereof. It is submitted that moulds for production of DR. BEST and FLEX 'N' DIRECT toothbrushes have neither been registered as designs nor they were being capable of being registered as designs under the Designs Act, 1911 and by virtue of Section 15(1) and (2) of the Copyright Act, 1957, copyright subsists therein and in the drawings, therefore, for the full term as original artistic work.

6. It is submitted by the plaintiffs in the plaint that defendants 1 to 3 are trading and claiming themselves to be the Directors/Proprietors/owners of the trading style Cello Oral Hygiene Products. These defendants, according to the plaintiffs, were carrying on business as manufacturers of and/on dealers in and/or sellers of toothbrushes. Defendant No. 4 is the stockist of defendants 1 to 3 and is stated to be selling the toothbrushes manufactured and sold by defendants 1 to 3 on commercial scale in Delhi as well as other parts of Northern India. It is submitted that prior to the commencement of the suit, defendants 1 to 3 had manufactured, offered for sale and/or sold and were threatening and intending to sell toothbrushes under or by reference to the mark CELLO FLEXY. It is submitted that the defendants had not only copied the moulds of their DR. BEST, FLEX 'N' DIRECT toothbrushes but also the descriptive matter appearing on the reverse panel of the AQUAFRESH FLEX toothbrush being manufactured and marketed by plaintiff No. 2 continuously and extensively since 1996. Some of the descriptive matter which is alleged to have been copied from the plaintiffs packing may be reproduced as under:-

**PLAINTIFF NO. 2 INDIVIDUAL TOOTHBRUSH PACK DEFENDANT'S
TOOTHBRUSH PACK**

1. Aquafresh Flex has a unique pressure absorbent neck that bends and flexes when you brush and helps protect you from over brushing. Aquafresh Flex is gentle on your gums.

1. Flexy has a unique pressure absorbent neck that bends and flexes when you brush and helps protect you from over brushing. Flexy is gentle on your gums.

2. Aquafresh Flex's international bristles are designed to make brushing safer for you. The firm, coloured bristles on the inside clean your teeth and molars, while the soft white ones on the outside gently massage your gums. Thus, they help prevent damaging your gums while still giving your teeth a through cleaning.

Firm inner coloured bristles remove plaque & clean teeth thoroughly, while soft white ones on the outside gently massage your gums.

3. And of course, the rubberised long, flat and easy grip handle allows you complete brushing control.

3. The rubberised long, flat and easy grip handle allows you complete brushing control.

7. It is submitted that the CELLO FLEXY toothbrush is manufactured in plastic material by a process of injection moulding in precision moulds whose cavities have been made by engraving by the process of spark erosion upon steel blank cavities corresponding to the shape of the CELLO FLEXY toothbrush. It is submitted that the said moulds were manufactured by the defendants or by a third party under the control and authority of the defendants and may be lying in the premises of defendant No. 1 within the jurisdiction of this Court. It is submitted that having regard to the near identity in shape, size and dimensions of two toothbrushes, it can be inferred that the defendants'

toothbrush was intentionally copied directly or indirectly from the DR. BEST or FLEX 'N' DIRECT toothbrushes or from a toothbrush which was itself a copy of the aforesaid two toothbrushes. It is submitted that the cavities within the mould used to manufacture the defendants toothbrush handles owe their shape and appearance of the pilot mould drawings and pilot moulds in issue in these proceedings as works attracting artistic copyright. It is submitted that such cavities were made by or on behalf of defendants 1 to 3 by the process of spark erosion by the process of reverse engineering via a specimen of plaintiff No. 1's DR. BEST and/or plaintiff No. 3's FLEX 'N' DIRECT toothbrushes without the license or consent of the plaintiffs or anyone of them. It is submitted that the moulds used by defendants 1 to 3 to manufacture CELLO FLEXY toothbrush were reproductions, alternatively substantial reproductions of the copyright works of plaintiffs 1 and/or 3 and these reproductions have been made by the defendants in pursuance to a common design without the license or consent of the plaintiffs and are infringements of the copyright of the plaintiff. It is submitted that the defendants are also using the mark FLEXY as the trade mark which was deceptively similar to the plaintiffs mark FLEX to which the plaintiff was the prior user. It is submitted that by the unlawful conduct of the defendants in allegedly imitating the plaintiffs copyright, the defendants were passing off their goods as those of the plaintiffs thus causing irreparable loss, damage and injury to the plaintiffs design, goodwill and reputation. Plaintiffs, therefore, have sought a decree for injunction as aforesaid.

8. The defendants in the written statement have denied all the allegations levelled by the plaintiffs against them. It is stated in the written statement that the suit was barred by the provisions of Order 7 Rule XI, CPC inasmuch as the plaint did not disclose any cause of action. It was also stated that the design of tooth brush including the "S" bend flexible neck feature was within the law of public domain and thereby entitled to be used, reproduced and exploited by each and every member of the public and no monopoly to exclusive use thereof could be claimed by the plaintiff. It is submitted that the copyright in the design of the tooth brush of the plaintiff was the subject-matter of Design Registration Nos. 166434 and 167936 granted in favor of the plaintiff Nos. 2 and 3 under the Designs Act, 1911 and these designs have since been cancelled and surrendered by the plaintiffs. It is submitted that no copyright subsists in favor of the plaintiffs in respect of designs of these tooth brushes either under the Designs Act or under the Copyright Act. It is submitted that insofar as the mould and drawings of the mould of plaintiffs tooth brushes are concerned, admittedly they were not published by the plaintiffs, hence there was no question of the defendants copying them arose. It is submitted that defendant's tooth brushes were manufactured by engineering drawings and moulds of their own and the plaintiffs could not claim a monopoly in the engineering drawings and the moulds under the Copyright Act. It is stated in the written statement that defendants 1 to 3 were the registered proprietors of the design of their toothbrush under Design Registration No. 177074 dated 30.7.1998 and they, therefore, had a statutory right to apply the design in question under Section 47(1) of the Designs Act. It is submitted that the "S" bend flexible neck feature of the plaintiffs' tooth brush AQUAFRESH FLEX and AQUAFRESH FLEX-N-DIRECT were utilitarian and functional and were also represented by the plaintiffs in their advertisements, trade literature as well as packaging of the tooth brushes. It is submitted that the design represent the flexible neck feature of the toothbrush and not trade origin of the plaintiffs. The "S" bend neck feature was incapable of distinguishing the goods and business of the plaintiffs nor had been used to distinguish their goods/business and the same could not be the subject-matter of any proprietary right as a

trade mark and no suit for passing off was maintainable in respect thereof. It is stated that the plaintiffs could not claim life time monopoly in such functional and utilitarian features. It is submitted that the packaging and trade dress of the competing goods were also totally different and there was no possibility of any confusion or deception considering that the plaintiffs did not have any proprietary right or goodwill in the "S" bend flexible neck feature and the feature being in the public domain, no suit for passing off lie against the defendants.

9. It is further submitted in the written statement that "S" bend neck feature was common to the trade of toothbrush and was being used by various toothbrush manufacturers. The case of the defendants is that the Hindustan Lever Limited, which was the market leader, was selling toothbrushes with "S" bend neck feature under the trade mark PEPSODENT FLEXY ever since July, 1998 and Kewal Raj & Company was selling the similar toothbrushes under the trade mark OZETTE since 1991, plaintiff had filed suits against both these parties in 1996 being Suit No. 2515/96 but were not granted any interim injunction against such use of S-shape feature by the said parties. It is submitted that the plaintiffs had filed the present suit by making material concealment of facts and documents and by misleading this Court and hence they were dis-entitled to any relief claimed by them. It is submitted that the plaintiffs had obtained the discretionary order of injunction ex parte by withholding facts and documents from this Court which had a direct bearing to the issues involved in adjudication of the case. Some of the facts and documents which were stated to have been withheld by the plaintiffs from the Courts may be reproduced as under :-

(i)(a) The plaintiff Nos. 2 and 3 had filed a suit being Suit No. 2515/96 in respect of the same design of tooth brush which is subject-matter of the present suit against sale of PEPSODENT POPULAR toothbrush and OZETTEE toothbrush by Hindustan Lever Limited, Mumbai and Kewal Raj & Co. Private Limited, Mumbai respectively in October 1996 for infringement of their registered design Nos. 166434 dated 27.10.1993 and 167936 dated 22.8.1994. In the said suit, the plaintiffs prayed for ad interim injunction order restraining the defendants therein from manufacturing and marketing their tooth brushes bearing the aforementioned registered designs and from passing off their goods and business as those of the plaintiff. The interim application under Order 39 Rules 1 and 2 CPC being LA. No. 9450/96 was argued by plaintiffs before Hon'ble Mr. Justice M.K. Sharma during months of October and November, 1998. No interim injunction, so far, has been granted to plaintiff and the case is now listed for defendants' arguments on 3.2.99. Copies of Design Registration Nos. 166434 and 167936 relied upon by plaintiff Nos. 2 & 3 under the Designs Act, 1911 in respect of their AQUAFRESH Flex tooth brush and AQUAFRESH Flex-N-Direct tooth brush have been placed on record. Copy of the plaint in Suit No. 2515/96 filed by the plaintiffs has also been placed on record.

(i)(b) Kewal Raj & Co. (P) Ltd., Mumbai had obtained design registration of "S" bend flexible neck of toothbrush in question in its favor vide Design Registration Nos. as under:-

Design Registration Nos. Date of Registration

-163019 13.3.91

-167696 23.6.94

-167697 24.6.94

-167698 24.6.94

-167699 24.6.94

-167712 29.6.94 All the aforementioned design registrations have been assigned by Kewal Raj & Co. (P) Ltd. to Hindustan Lever Limited, the current registered proprietor. Copies of Design Registrations set out above and the assignment deed dated 4.7.96 have been placed on record. (i)(c) Plaintiffs herein applied for cancellation of Registration Designs set out in preceding paragraphs before Calcutta High Court vide case Nos. AID 10/96, 11/96, 12/96, 13/96 14/96 and 17/96. However, during pending proceedings, plaintiffs withdraw their plea for cancellation of these designs. Copy of the order dated 3.9.1997 passed by Calcutta High Court in this regard has been placed on record.

(i)(d) Hindustan Lever Limited filed cancellation of the Design Registration Nos. 167936 and 166434 of the plaintiffs before Calcutta High Court being Cancellation Petition No. AID Nos. 15/96 and 16/96 respectively. In AID No. 16/96 pertaining to plaintiffs' design registration No. 166434, the plaintiffs counsel surrendered the said design registration and by order dated 10th July 1998, the High Court of Calcutta ordered removal of the said registration from the registrar of Designs. A copy of the said order dated 10.7.1998 has been placed on record. The cancellation petition being AID No. 15/98 pertaining to registration No. 167936 is pending. (i)(e) While addressing arguments before Hon'ble Mr. Justice M.K. Sharma in Suit No. 2515/96, in November, 1998, the counsel for the plaintiff withdraw their claim for infringement of their registered design pertaining to tooth brushes in question against the defendants therein. (ii)(a) As the plaintiffs surrendered their claim for infringement of design registration pertaining to AQUAFRESH Flex and AQUAFRESH Flex-N-Direct tooth brush in Suit No. 2515/96, they have no right or monopoly to the exclusive use of the design pertaining to these tooth brushes. However, the plaintiffs withheld the afore-mentioned facts and documents and filed the present suit for infringement of copyright in the same design concealing from this Hon'ble Court that they have surrendered their proprietary right in design of the tooth brush and no copyright subsists in the said design or any feature of the said design by virtue of prohibition legislated under Section 15(1) as well as 15(2) of the Copyright Act, 1957 which are reproduced as under. As a result thereof, the designs are in public domain and every person is entitled to use it.

(ii)(b) As the designs in question were already registered under the Designs Act, 1911, no copyright can subsist in them or their industrial drawing or in their mould by virtue of categorical prohibition under Section 15(1) and 15(2) read with Section 16 of the Copyright Act, 1957. Design applied to toothbrush and its mould is one and the same. Mould is part of industrial process of application of the design. Once copyright in design is lost, it cannot continue to subsist in the mould. Instead of disclosing these crucial and fundamental facts, the plaintiffs made fraudulent, misleading and false averments in paragraph 20 of the plaint that there are no design registrations in relation to tooth brushes in question. The defendants are not manufacturing and selling moulds. There cannot be a copyright subsisting in mould if it has ceased to exist in respect of a design sought to be applied by the said mould. The conduct of the plaintiffs is deplorable and highly abusive of process of law. The suit for infringement of copyright as, filed by the plaintiffs is a sheer abuse of process of law, misconceived and without any cause of action. (ii)(c) The plaintiffs, even otherwise, are not the authors of designs or their drawings in question and cannot claim copyright therein in absence of deed of assignment of copyright from author in their favor. No deed of assignment has either been pleaded or produced by the plaintiffs. (ii)(d) Copyright is not a monopolistic right, unlike a patent, trade mark or registered design. In paragraphs 13 and 15, the plaintiffs have admitted that designs of their moulds are confidential property and have never been published. The question, therefore, of defendants' copying a drawing which has never been published and which is in lock and key of the plaintiffs cannot arise. The defendants have not copied plaintiffs' moulds but have got their own mould made by a company "Ming Chung Brush Industrial Co. Ltd., Tiawan. The institution of the present suit is a clever attempt on part of the plaintiffs to circumvent and over reach the statutory bar and prohibition envisaged under sections 15 and 16 of the Copyright Act, 1957.

10. It is also submitted in the written statement that the defendants were engaged in the business of manufacturing and marketing toothbrushes, thermoware, vaccum ware, plastic mould furniture, etc. under their trade mark CELLO since 1961 having a turn over of approximately Rs. 180 crores per annum. It is submitted that the design in question pertaining to CELLO FLEXY was conceived by the defendants in 1997 from the catalogue of toothbrushes shown to them by Taiwance mould manufacturing company. "Ming Chung Brush Industrial Co., Taiwan" which manufactured the mould of toothbrushes in question. It is submitted that the defendants had placed an order of making a mould for manufacturing toothbrushes in question with the aforesaid company in Taiwan vide letter dated 14th April, 1997 and the mould was received on 26th March, 1998. The machinery for manufacturing the toothbrushes was imported from Zahoransky, Germany and the defendants had been manufacturing the toothbrushes in question since July, 1998 having capacity of manufacturing 29000 toothbrushes per day. It is submitted that the defendants toothbrushes are sold under the trade mark CELLO and the word FLEXY was used only to highlight the flexible neck feature of the toothbrush. It is submitted that even otherwise there was no assignment in favor of the plaintiffs nor the persons who had filed the suit were authorised to file the same.

11. Along with the suit, the plaintiffs had filed an application for the grant of an ad-interim injunction. The suit and the application came for hearing before this Court on 16th December, 1998 and the Court on that day passed an ex parte order of injunction restraining the defendants from manufacturing or marketing the toothbrushes which were similar in appearance of the plaintiffs DR. BEST, AQUAFRESH FLEX and/or AQUAFRESH FLEX 'N' DIRECT toothbrushes. They were also restrained from using the trade mark FLEXY which was allegedly confusingly similar to the trade mark FLEX of the plaintiffs. After the summons and the injunction orders were served upon the defendants, besides filing the written statement, they also filed an application under Order 39 Rule 4, CPC for vacating the injunction. It was stated in the application that the injunction was obtained by the plaintiffs by misleading this Court and by making mis-representation, mis-statement and concealment of material facts in an unfair manner which was sufficient ground for dis-continuing/vacating ad-interim injunction without even going into the merits of the case. The facts and documents which were allegedly not disclosed while obtaining injunction have already been reproduced hereinabove. This order will dispose of both the application of the plaintiff for the grant of injunction as well as the application of the defendants for vacating the injunction granted by this Court.

12. Mr. V.P. Singh, learned Senior counsel, appearing on behalf of the defendants has sought the vacation of the stay granted by this Court on 16th December, 1998 on the ground that the plaintiffs have not come to the Court with clean hands and had suppressed material facts from this Court. It is contended by him that the ex parte order of injunction has been obtained by the plaintiffs by misleading the Court and by making mis-representation and mis-statement and these are sufficient grounds for vacating the ad-interim injunction granted by this Court. It is contended by Mr. Singh that the plaintiffs had earlier filed a suit being Suit No. 2515/96 in respect of the same design of toothbrushes which are the subject-matter of the present suit against Hindustan Lever Limited and Kewal Raj & Company for their having started manufacturing and marketing toothbrushes under the name and style of PEPSODENT POPULAR and OZETTE. It is submitted that in the said suit, the plaintiffs had claimed injunction against the said parties from marketing their products bearing the designs allegedly registered in the name of the plaintiffs and from passing off their goods and business as those of the plaintiffs. The application of the plaintiffs for the grant of injunction being IA No. 9450/96 was argued during the months of October and November, 1998 and the said application was dismissed by this Court by detailed order passed on 26th November, 1999. It is submitted that by an order passed by the Calcutta High Court on 10th July, 1998 the design registered in the name of the plaintiffs was removed and cancelled and the plaintiffs, therefore, lost their copyright and monopoly right granted by the Designs Act, 1911 as well as under the Copyright Act, 1957 on account of the provisions of Sections 15 and 16 of the Copyright Act.

13. It is also submitted that the plaintiffs had also filed an application for cancellation of the designs registered in the name of Kewal Raj & Company and assigned to Hindustan Lever Limited ; the toothbrushes bearing design in the earlier suit were marketed by Kewal Raj & Company since 1991 and the cancellation applications of the plaintiffs against Kewal Raj & Company were dismissed as withdrawn by the Calcutta High Court on 3rd September, 1997. It is submitted that in the suit filed by the plaintiff against Hindustan Lever Limited and Kewal Raj & Company in respect of PEPSODENT FLEXY and OZETTE toothbrushes manufactured by the said parties respectively, the

objection of the plaintiffs pertain to the same design as is the subject-matter of the present suit. The plaintiffs were not granted any interim injunction in the said suit and the application for injunction having been dismissed, it was the duty of the plaintiffs to disclose all such facts and documents for perusal and adjudication by this Court and there was thus deliberate concealment of facts by the plaintiffs and the injunction obtained by such suppression of material facts are sufficient ground for vacation of the order of injunction.

14. In reply to the aforesaid submission, the contentions of learned counsel for the plaintiffs are that the suit filed against Hindustan Lever Limited and Kewal Raj & Company has no bearing in the present case inasmuch as the said suit concerned passing off of toothbrushes and infringement of registered design whereas the present suit was in respect of copyright in injection moulds and for drawings in those moulds. It is also the contention of the plaintiffs that cancellation of the design of the plaintiffs or dismissal of the application of the plaintiffs for cancellation of the design of Kewal Raj & Company has also no bearing on the present case as the present case is not for infringement of designs but is for infringement of copyright in the moulds. It is submitted by the plaintiffs that even if the copyright in design has been lost, they can still maintain the suit for infringement of copyright in the mould. It is stated that despite the copyright in design having been lost, the copyright in mould will subsist.

15. It is no doubt true that in the present suit the plaintiffs have claimed relief on the ground that they have a copyright in the moulds from which the toothbrushes are manufactured, however, the fact remains that in the plaint the plaintiff has claimed relief of injunction restraining the defendants from manufacturing, selling and/or offering for sale toothbrushes which are identical in appearance to the CELLO FLEXY toothbrushes of the defendants or any other toothbrush allegedly similar in appearance to the plaintiffs DR. BEST, AQUAFRESH FLEX and AQUAFRESH FLEX 'N' DIRECT and from manufacturing toothbrushes under or by reference to the mark FLEXY or any other mark confusingly similar to the plaintiffs mark FLEX. Though the plaintiff has also claimed an injunction for restraining the defendants from infringing the plaintiffs alleged copyright in the moulds and mould drawings, however, once the plaintiff is seeking relief of an injunction for restraining the defendants from manufacturing and/or offering for sale toothbrushes which are allegedly similar in appearance to the plaintiffs toothbrushes, in my opinion, plaintiffs were required to disclose not only the pendency of the earlier suit in which similar relief was claimed against the Hindustan Lever Limited and Kewal Raj & Company but they should have also disclosed the proceedings which were pending in the Calcutta High Court in which their applications for cancellation of design of Hindustan Lever Limited and Kewal Raj & Company were dismissed. Plaintiffs ought to have disclosed to this Court that certain other parties were manufacturing similar toothbrushes since 1991 when design were registered in their name and non-disclosure of these facts has, in my opinion, clearly misled the Court in granting ex parte injunction in favor of the plaintiffs. It is now well settled that a party who approaches the Court to seek the discretionary relief must come with clean hands. If an information which has a bearing on the question of exercise of discretion is withheld from the Court, the Court would be justified in refusing to exercise the discretion in favor of such a party.

16. In *Udai Chand v. Shankar Lal and Ors.*, it was held that the Court would be justified in revoking the leave to appeal if the same was obtained by making mis-statement of a material fact which was of decisive importance in the case. It was held that a party who approaches the Court invoking the exercise of its overriding discretions, it must come with clean hands. If there appears on his part any attempt to over reach or mislead the Court by false or untrue statements or by withholding true information which would have a bearing on the question of exercise of discretion, the Court would be justified in refusing to exercise the discretion or, if the discretion has been exercised, in revoking the leave to appeal granted even at the time of hearing of the appeal.

17. In a judgment of the Division Bench of this Court reported as *Satish Khosla v. Eli Lilly Ranbaxy Limited*, it was held that a party must come to the Court with clean hands and must disclose all the relevant facts which may result in appreciating the rival contentions of the parties. It was held that a litigant who approaches the Court must produce all the documents which are relevant to the litigation and he also must disclose to the Court about the pendency of any earlier litigation between the parties and the result thereof.

18. In another judgment of this Court reported as *Anand Swarup v. Municipal Corporation of Delhi*, 36 (2998) Delhi Law Times 304, it was held that it was a cardinal principle of law that a person must come to the Court with clean hands if he seeks an injunction under Order 39 Rules 1 and 2, CPC. It was held in that case that the conduct of the plaintiff must not leave much to be desired as time and again facts were mis-represented to the Court. It was held that the attempt of the party to mislead the Court may or may not amount to a contempt but it will certainly dis-entitle the party to any interim relief from the Court.

19. It is thus clear that in case the plaintiff has approached this Court with unclean hands and had suppressed material facts from the Court, it will not be entitled to an order of injunction and the injunction granted in favor of the plaintiffs will be liable to be revoked. When the plaintiffs filed this suit, the suit filed by them against the Hindustan Lever Limited and Kewal Raj & Company was still pending. It was a fact that reliefs claimed in the earlier suit against Hindustan Lever Limited were almost similar to the relief claimed in the present suit except that in the present suit copyright in the moulds has also been claimed. It is also a fact that in the earlier suit, the Court had not granted injunction in favor of the plaintiffs and the arguments on the injunction application were being heard at the time when the present suit was filed. It is also a fact that design in respect of toothbrushes in favor of the plaintiffs were cancelled and the application of the plaintiff for cancellation of designs of the Hindustan Lever Limited and Kewal Raj & Company were dismissed by the High Court of Calcutta. In my considered opinion, it was the abundant duty of the plaintiffs to disclose to this Court about the pendency of the aforesaid earlier proceedings. If such facts had been disclosed to the Court in this suit, may be the Court would not have granted ex parte injunction in favor of the plaintiffs. Suppression of the aforesaid facts has clearly misled the Court in granting ex parte injunction on 16th December, 1998. I am, therefore, of the view that the plaintiffs have not come to this Court with clean hands and have also suppressed material facts from the Court with a view to gain advantage in this suit. Ex parte injunction in favor of the plaintiffs is liable to be vacated on this ground alone.

20. Even on merits of the case, in my opinion, the plaintiffs are not entitled to any relief. As already observed above, in the suit filed against the Hindustan Lever Limited and Kewal Raj & Company, learned Single Judge of this Court has dismissed the application of the plaintiff for an injunction against those parties from manufacturing and marketing the toothbrushes which were alleged to be Similar to the toothbrushes of the plaintiffs. While dismissing the application in that suit, it was observed by the Court as under :-

12. It is settled law that unless plea is corroborated by pleadings no such plea could be allowed to be taken up for the purpose of deciding an action unless enough material to prove and establish the charge have been placed on record. The action of passing off is an action for mis-representation and/or deceit and in order to prove such charges strong and cogent material shall have to be available on record and in absence of the same the Court would decline to investigate on the charges. Besides, it is an admitted position that when the aforesaid proceedings were instituted in this Court AQUAFRESH FLEX 'N' DIRECT was not sold in the Indian Market at all. Admittedly, the product was prior published in India in Dental Journals. Since the produce was not available in the Indian Market having not been marketed and sold in the Indian Market by the plaintiffs there was no scope for contending that the said product had already achieved a goodwill in India. Pleadings to prove creation of a goodwill and reputation in India for the tooth-brush 'AQUAFRESH FLEX N' DIRECT' are absent. In my considered opinion, therefore, the plaintiffs have failed to make out a prima facie case to prove and establish either a case of action for infringement or a passing off action in respect of its product with the name 'AQUAFRESH FLEX N' DIRECT'.

13. Having arrived at the aforesaid finding it would thus be necessary during these proceedings to scrutinies and ascertain as to whether the plaintiffs have been able to prima facie show that there has been passing off by get up in relation to the OZETTE tooth brush having regard to the FLEX medal of the plaintiffs. At this stage it would also be necessary to deal with the contention of the counsel appearing for the defendants that no action for passing off could lie or be entertained in respect of a matter relating to design. According to the defendants the design law frowns upon monopolies as it is in public interest that inventions and improvements enter the public domain and are freely available for public use and, therefore, in such a situation public interest supersedes the individual interest of a person claiming ownership over intellectual property. In support of the contention, the counsel for the respondent relied upon the decision of this Court in Tobu Enterprises Pvt. Ltd. v. Megha Enterprises, 1983 PTC 359. Relying on the said decision of this Court learned counsel submitted that the definition of design as given under Section 2(5) of the Designs Act having excluded the trade mark from its purview, the remedy against passing off is specially excluded under the Act as there is no section similar to that of Section 27 of the Trade and Merchandise Marks Act, 1958. The aforesaid submission was considered by me after taking notice of the provisions of the Designs Act as also the decisions relied upon in respect of the said contention by the counsel appearing

for the parties.

Rights under the registered design are set out in the Designs Act itself whereas the law of passing off is carved out under the Common Law Rights and, therefore, both the rights are distinct and different. The contention of the counsel appearing for the respondents that there can be no monopoly in respect of a design is also without any merit for the provisions of the Design Act itself provide for having monopoly over such a design for a statutory period. Only after expiry of the aforesaid statutory period inventions and improvements go into the public domain and could be made freely available for public use but till then the inventor or the registered owner of the design have a monopoly over the said design in terms of the provisions of the Design Act. The Plea that concept of passing off cannot be made applicable to a case of design is also equally without merit. As delineated above, the registered design and Common Law rights are distinct and different rights arising from two different situations. Infringement right accrues on the basis of the provisions of the Design Act whereas the passing off rights accrue on the basis of Common Law rights. It is true that there is no similar section to that of Section 27 of the Trade and Merchandise Marks Act in the Design Act. Section 27(2) of the Trade and Merchandise Marks Act the right of passing off would not be available to a case of design. If such a right is available to someone under the Common Law rights that could well be enforced even though the same is not statutory recognised under a Statute. In this connection reference may be made to a subsequent decision of this Court in *Tobu Enterprises Pvt. Ltd. v. Joginder Metal Works*, . I am, therefore, inclined to hold that passing off action is also available to case of design and such right could be enforced provided the same is available in accordance with the law even in case of design, for otherwise a latitude would be given to manufacturer to misrepresent and to deceive unwary customers by manufacturing and selling its products as that of products of some other manufacturer or seller. Such course would also allow unscrupulous manufacturer or dealer to take recourse to confusing the unwary customer/public to purchase some goods which it was unwilling to purchase but being deceived and/or confused proceeded to purchase the same believing it to be products and goods manufacturing and sold by the actual manufacturer or dealer.

14. It is next to be scrutinised and ascertained as to whether the defendants have in any manner passed off his OZETTE tooth brush as that of the toothbrush of the plaintiffs namely - AQUAFRESH FLEX. In order to succeed for proving the prima facie of passing off action against the defendants the plaintiffs shall have to prima facie show that goodwill was created by the plaintiffs in respect of AQUAFRESH FLEX tooth brush and that the defendants have mis-represented by using the features which were calculated or likely to deceive the general customers and that such action had resulted in injury actual or probable to the goodwill of the plaintiffs. Therefore, one of the questions which needs consideration is whether 'S' shape in the tooth brush could be taken as an indication of the source or origin and that the plaintiffs have acquired a reputation in the aforesaid features by the use of which the defendants calculated or sought to deceive resulting into injury to the goodwill of the plaintiffs. It would also be necessary to examine whether the use of the goods with the design or a substantially similar design by the defendants has caused or is likely to cause confusion by leading the public to mistake the defendant's goods for those of the plaintiff or to associate them with it. It would also be necessary to take notice of the fact that the whole get-up of the article i.e. the shape of the packet, the colour, the printing and the whole product would have to be taken into

consideration, apart from looking at the distinctive features in order to ascertain whether the goods of the defendants were calculated to deceive the general public.

15. Before discussing the aforesaid factors it would be relevant at the first instance to ascertain whether 'S' shaped feature is functional or aesthetic, for if the said feature is held to be functional in nature the same would be incapable of any protection, for no passing off action would lie for a design if the feature is held to be merely functional features. The contention of the defendants during the course of arguments was that the purpose and advantage of the design is that a certain flexibility is attained through the extensive pliability of the handle connected thereby enabling better access of the bristle to the inner surface of the tooth. It is held to be so then the aforesaid feature would be deemed to be functional only inasmuch as only non-functional and non-utilitarian features are capable of being exclusively monopolised by anyone.

16. I have given my anxious and thoughtful consideration to the plea taken up by the defendants and refuted by the plaintiffs who submitted that the dominant feature of the 'S' shape was aesthetic feature. Although to some extent the said feature could be said to be aesthetic but the court is to look into the dominant purpose for deciding as to whether the features are functional or utilitarian or not. The parties have placed on record certain documentary evidence including the advertisements given by the plaintiffs in various magazines and newspaper. In the said magazines and newspapers this feature has been described by the plaintiffs themselves as lending flexibility to the neck portion of the tooth brush. Even in paragraph 9 of the plaint the aforesaid feature has been described by the plaintiffs as 'S' shaped folds being resilient lending flexibility between the head the handle. The S-shaped region serves the function of modifying flexibility to the connected portion. Swiss patent granted in 1932, which document is placed on record, indicates that plaintiffs claim that the purpose and advantage of the design is that a certain flexibility of the whole tooth brush and/or of the brush head is attained through the extensive pliability of the handle connecting part in the handling and moreover also a better access of the bristle rim to the inner surface of the tooth is made possible than normally. U.S. Patent dated 1.10.1991 also describes "resiliency flexible portion and a head carrying portion, the resiliently flexible portion conspiring atleast one transverse V shaped fold formed integrally with the remainder of the handle". Some of the documents placed on record including advertisements in the TV particularly the advertisement of TV test high-light the functional feature of the tooth brush and not the aesthetic aspect. It would thus be deduced that the purpose and advantage of the aforesaid designs is basically to lend a certain flexibility to the neck portion of the tooth brush, so as to provide extensive pliability of the handle thereby enabling better access of the bristle to the inner surface of the tooth. Thus the said feature has dominant and primarily functional feature, although there could be an aesthetic feature with the zig-zag bend which seeks to give an aesthetic view to the user. But still the dominant purpose of the feature is functional and utilitarian and that is how advertisements were also brought out in the advertisements published and, therefore, no passing off action could be available in respect of a design under the common law."

21. Though in that case the Court was dealing with a matter under the Designs Act, however, the observations made by the Court are not only relevant but will also fully apply to the facts of the present case as well. It was clearly held by the Court in the earlier suit that the S-shaped feature was

only functional and the same was, therefore, not capable of any protection and no passing off action would lie if the features are merely functional features. It was also held by the Court that the action of passing off is an action for mis-representation and/or deceit and in order to prove such charges, strong and cogent material has to be available on record and in the absence of the same, the Court would decline to investigate on the charges. It was also held by the Court that it was admitted position that when the proceedings were instituted against Hindustan Lever Limited in 1996, the AQUAFRESH FLEX 'N' DIRECT was not even sold in the Indian market at all and since the product was not available in the Indian market by the plaintiffs, there was no scope for contending that the said product had already achieved goodwill in India. It was also held that the pleadings to prove creation of a goodwill and reputation in India for the toothbrushes AQUAFRESH FLEX 'N' DIRECT were absent.

22. In the present case as well, according to the plaintiffs own admission, AQUAFRESH FLEX was put on general sale in July, 1997. The defendants had placed an order for making of their moulds for manufacturing toothbrushes in question with a company in Taiwan vide its letter dated 14th April, 1997 and the moulds were received on 26th March, 1998. It is thus clear that even before the plaintiffs had marketed their products in India for sale to general public, an order for making of the mould for manufacturing of toothbrushes of similar type had already been placed by the defendants with a company in Taiwan. Prima facie, therefore, it does not appear to be correct that the moulds from which the defendants are manufacturing toothbrushes were made with reverse engineering from the brushes of the plaintiffs, as alleged in the plaint. After importing machinery from Germany, the defendants are manufacturing toothbrushes since July, 1998. Therefore, on the basis of the material on record, I am prima facie of the opinion that the plaintiffs have not placed sufficient material on record to prove that the defendants have copied their moulds from the moulds of the plaintiffs. At this stage, I am not considering the argument as to whether or not the plaintiffs have a copyright in the moulds from which the toothbrushes are manufactured. Similar toothbrushes being manufactured by the Hindustan Lever Limited and Kewal Raj & Company are already available in plenty in the market and I, therefore, do not see any reason as to why the defendants should be enjoined from manufacturing the toothbrushes under their name CELLO FLEXY. During the hearing, large number of judgments have been cited by the parties on the question as to whether or not there can be a copyright in the moulds from which the toothbrushes are manufactured, however, for the view I have taken, I have not considered it necessary to refer to the judgments cited by learned counsel for the parties.

23. For all the foregoing reasons, in my opinion, the plaintiffs have not been able to make out any case for the grant of an injunction in their favor. Ex parte injunction, in my opinion, was obtained by the plaintiffs by concealment of material facts from this Court and the plaintiffs are, therefore, not entitled to any discretionary relief from this Court. Consequently the application of the defendants is allowed and the application of the plaintiffs is, accordingly, dismissed with costs assessed at Rs. 10,000/-. Injunction granted in favor of the plaintiffs stands vacated.

By a separate order passed today in Suit No. 2771/98, the application for injunction and application for vacation of stay have been decided. Counsel for the petitioner has made an oral prayer for stay of the order passed today so as to enable him to file an appeal before the Division Bench of this Court.

In view of the fact that the application of the petitioner has been dismissed on the ground that the petitioner has not come to the Court with clean hands and had concealed material facts from the Court so as to take advantage against the respondent, I am not inclined to stay the order passed today. Matter be now listed before the regular bench on 28.1.2002.