

# Klassic Wheels Private Ltd vs The Assistant Controller Of Patents And ... on 4 June, 2018

**Equivalent citations: AIR 2018 CALCUTTA 276, (2018) 4 CAL HN 410, AIRONLINE 2018 CAL 180**

**Author: Soumen Sen**

**Bench: Soumen Sen**

IN THE HIGH COURT AT CALCUTTA  
SPECIAL JURISDICTION  
ORIGINAL SIDE

BEFORE:  
THE HON'BLE JUSTICE SOUMEN SEN

G.A. No.2407 of 2017  
AID No.6 of 2013

KLASSIC WHEELS PRIVATE LTD.  
VS.

THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS AND ANR.

For the Appellant : Mr. Siddhartha Mitra, Sr. Adv.,  
Mr. Gautam Kumar Roy, Adv.,  
Mr. Soumya Ghosh, Adv.

For the Respondent : Mr. Shamit Sanyal, Adv.,

Mr. Anirban Das, Adv.

For the Respondent No.1 : Mr. Rabi Prosad Mookerjee, Adv.

Hearing Concluded On : 10.05.2018

Judgment On : 4th June, 2018

Soumen Sen, J.:- The appeal and the application for additional evidence being G.A No.2407 of 2017 are taken up together and disposed of by this order.

This appeal is arising out of an order passed by the Assistant Controller of Patents and Designs on 8th July, 2013 in connection with an application filed under Section 19 of the Designs Act, 2000 for cancellation of registration of Design No.229267 under Class 12-16 filed by the applicant/petitioner.

The petitioner on 25th July, 2011 filed the application for cancellation of the design registered in favour of the respondent No.2 on 13th May, 2010 for article "Wheel Rim" under Class 12-16 in the name of Steel Strips Wheels Ltd. The grounds for cancellation were that it was published in India prior to the date of registration, it was not a new or original design and lastly the design was not registrable under the Act. The primary grounds as would appear from the record are prior publication and lack of novelty.

Sworn of details, the petitioner claims to be, in the business of manufacturing and supply of Wheel Rim Assemblies to Piaggio Vehicles Ltd. (hereinafter referred to as "Piaggio") for their three wheelers and mini trucks. The petitioner acquired essential data required for designing Wheel Rim Assemblies from Piaggio. Based on the design data, the petitioner designed the "Wheel Rim Assembly" and proposed Design - drawings for the "Wheel Rim Assembly" bearing drawing No.60001.00P. The petitioner started manufacturing and supplying such Wheel Rim Assemblies since 31st May, 2009. On 29th April, 2009, Piaggio provisionally approved the drawing No.60001.00P for the "Wheel Rim Assembly" and placed a purchase order on 29th April, 2009 for the "Wheel Rim Assembly" bearing drawing no.60001.00P as provisionally approved by the Piaggio on 29th April, 2009 followed by a letter from Piaggio dated 5th May, 2009 confirming such provisional approval. The petitioner also applied for type approval certificate as per AIS-037 standard from the Automotive Research Association of India (ARAI). The invoice of ARAI dated 6th April, 2009 would confirm that the petitioner had approached ARAI for testing of the Wheel Rim Assemblies and the testing fee was deposited on 12th May, 2009. The testing report of ARAI pertaining to Wheel code 3.50B x 10, part no.6001.00.PA drawing no.60001.00PA was submitted to ARAI on 29th May, 2009 for conducting such tests. Piaggio thereafter inspected the samples and forwarded one inspection report on 31st May, 2009. The petitioner received the type approval certificate being No.A94845 from ARAI on 23rd September, 2009 for their Wheel Rim Assemblies corresponding to their design approved from Piaggio. After receiving the said certificate the petitioner supplied " Wheel Rim Assemblies" on a mass scale to Piaggio. The petitioner disclosed copies of invoices bearing invoice number 1910, 1993, 2071 and 2290 dated 30th September 2009 and 12th November 2009 respectively. The comparison of the impugned design vis- a- vis the design corresponding to the petitioner's design drawings of the wheel rim assembly it would be clear that the impugned design is an exact copy of design corresponding to the petitioner's design drawing approved by Piaggio.

The respondent No.2 filed its counter-statement objecting to the locus of the petitioner to maintain the action. The respondent, inter alia, contended that under a non-disclosure agreement between the respondent No.2 and Piaggio entered into by and between the parties on 31st July, 2007, the respondent is not authorized to disclose such drawings. Several drawings were developed by the respondent and shared with Piaggio. The respondent no.2 contended that even if the designs disclosed in the application for cancellation were obtained unauthorisedly from a third party the design no. 229267 would still remain novel. The Wheel Rim Assemblies duly registered in favour of the applicant is novel in nature. The wheel rim assemblies were duly registered as a convex bolt hole and this novelty is irrespective of a communication between the respondent no.2 and any 3rd Party. The innovative features of the designs of the respondents are discernable to the person skilled in the art and its novelty resides in the shape and configuration of the wheel rim as illustrated in the

application filed by the respondent no.2 for registration. It was contended that whatever communication happened between the petitioner and any other party was not within the knowledge of the respondent No.2 inasmuch as any unauthorized disclosure by such third party would not invalidate a registered design of the respondent.

The petitioner in their reply stated that the design patent referred to by the respondent could not be the present impugned design because the minutes of the meeting referable to the said document was dated 31st June, 2007 whereas the impugned design was applied for registration on 13th May, 2010. The design of the Wheel Rim Assemblies was at the time of impugned registration disclosed to the public in India as would be corroborated by email correspondence submitted by the petitioner. The petitioner refers to the annexures submitted to the statement of case, namely, the testing of Wheel Rim Assemblies by ARAI, report of Piaggio, sale invoices of the petitioner with Piaggio as well as the comparing of the impugned design with the petitioner's drawings to substantiate its claim.

Before the authority, it was contended that the Annexure R/2 being the minutes of the meeting between Piaggio and the respondent on 31st July, 2007 it does not show and furnish any information such as design number, design class etc. to identify the design patent for the Three-Wheeler Rims to be supplied by the respondent. It merely shows an understanding regarding the number of pieces of three-wheeler rims to be supplied by the respondent No.2. As many as 65,000 pieces three-Wheeler rims were to be supplied by the respondent no.2 to Piaggio per month from October, 2007 onwards. This amounts to an admission on the part of the respondent No.2 that the said design was in public domain since the year 2007. The petitioner copied the design drawing, provisionally approved by the Piaggio on 5th May, 2009 and the same was tested by ARAI. ARAI test report was obtained on 29th May, 2009 in respect of Wheel Rim Assemblies bearing drawing No.60001.00P. The sample lot of Wheel Rim Assemblies manufactured by the petitioner based on the above design drawing was inspected by Piaggio as would appear from the inspection report dated 31st May, 2009. These facts would show that the Wheel Rim Assemblies of the design was known prior to the impugned registration of 229267. After getting type approval certificate from ARAI, the petitioner supplied the Wheel Rim Assemblies on a mass scale to Piaggio as would appear from the invoices dated 2nd April, 2010. The impugned design is identical with the Wheel Rim Assemblies developed by the petitioner in 2009 and cannot be said to be new or original or that the said design was in public domain prior to its registration.

The Assistant Controller on consideration of the pleadings and the evidence-on-record arrived at a finding that the grounds for cancellation are unsustainable.

The Assistant Controller has referred to the email correspondence of March, 2009 furnished as a ground for prior publication and on scrutiny arrived at a conclusion that the set of emails with subject modified Wheel Rim specification does not depict any design of the article except mentioning its size. The purchase order for Wheel Rim Assemblies dated 2nd April, 2009 vide order no.PV91000096 shows that at foot Note 3 on the first page of the said purchase order the dyes for manufacturing of the article to be purchased from the petitioner were supplied by Piaggio. The letter dated 5th May, 2009 from Piaggio to the petitioner shows that the petitioner was requested to send five numbers of samples for part no.60001.00P. for Quality Control (Q.C) approval, whereas the

purchase order dated 2nd April, 2009 shows that the order was meant for part no.644973R and Revision No.-00-. Much later on 25th January, 2010, the petitioner was requested to send necessary documents and samples for Wheel Rim Assemblies part No.644973R Rev. No.-01- and Wheel rim assemblies part No.Boo3860, Rev. No.-00-. These evidence would show that there are different wheel rim assemblies bearing different part no. and the purchase order dated 2nd April, 2009 for Part no.644973R is not for the part no.60001.00PA as depicted in the design drawing of the petitioner dated 21st March, 2007. The copies of invoices, bank receipt, test report and type approval certificates from "ARAI" forming Annexure D of the evidence show that the petitioner had applied for testing of Wheel Rim Assemblies as per standard AIS-073 Part II, on 6th April, 2009. The test certificate also consists the drawing No.6001.00PA as well as details of test procedure standards. There are other documents also regarding subsequent similar testing wherein same drawing is referred.

On the disclosures forming Annexure E of the evidence, the Assistant Controller found that the emails exchanged between the parties concerning certain modifications of the Wheel Rim Assembly were covered under secrecy direction with disclaimer at the bottom that the contents are privileged and confidential and should not be disclosed to other than the addressee. The test certificates with accompanying documents and drawing no.60001.01 PA relates to requirement of chemical composition and physical specifications of the material used for the casts which were held by the Controller to be irrelevant.

The petitioner before the Controller in relation to prior publication has relied upon drawing No.60001.00PA. The said drawing only depicts a design of a wheel rim. The email correspondence between the petitioner and the Piaggio in reference to certain matters were covered under secrecy agreement with disclaimer at the bottom to the effect that the contents are privileged and confidential and should not be disclosed to other than the addressee. The emails were mean for addressee only and any correspondence with such instruction could not be considered as prior publication. In order to arrive at such finding, the Assistant Controller has relied upon Gopal Glass Works Ltd. Vs. Asst. Controller of Patents & Designs reported at 2006 (33) PTC 434 (Cal), National Trading Co. Vs. Monica Chawla reported at AIR 1994 Del 309, The Wimco Ltd. Bombay Vs. Meena Match Industries, Sivakashi & other reported at 1983 (3) PTC 373 (Del), Faber Castell Aktiengesellschaft Vs. Pikpen (P.) Ltd. reported at 2003 (27) PTC 538(Bom) and Reckitt Benckiser (India) Ltd. Vs. Wyeth Limited reported at 2009 (41) PTC 24 (Del.) and had attempted to draw an analogy from Section 16 of the Designs Act, 2000. The observations of the said Controller in this regard are:-

"It is already been discussed above that the email correspondence between the petitioner and Piaggio, in some references, are covered under secrecy direction with disclaimer in bottom that the contents are privileged and confidential and should not be disclosed to other than the addressee. Emails are mean for addressee only and any correspondence with such instruction cannot be considered as prior publication. Similar analogy is there in the Section 16 of the Designs Act 2000 in a parallel context relating to registered proprietor, which reads thus:-

"The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person, other than the proprietor of the design, and the acceptance of a first and confidential order for articles bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance."

The drawing no.60001.00PA, in full scale, was submitted by the petitioner as Annexure G, with submission in Para 9 of the evidence by way of affidavit accompanying the statement of evidence, stating that the impugned design is exact copy of design corresponding to the applicant design drawing approved by Piaggio annexed and marked herewith as Annexure G. Annexure G is the same drawings as the drawing no.60001.00PA so far referred in all earlier evidences where only the drawing portion was reproduced. In this full scale drawing, it is clearly written in right hand bottom side that 'This drawing is the property of PVPL and must be returned on request. It must not be used, copied or lent for any purpose without authorization'. There is no reference to any authorization of Piaggio in the whole proceeding and in turn shows the obligation for the secrecy of the drawing. There is no reference of publication by Piaggio either.

At the same time, the same drawing was submitted to ARAI for testing of the same as evidenced from Annexure D. There are no evidences that ARAI publishes such certificates along with drawings. I would refer to the website of ARAI: <https://www.araiindia.com/>. In one of the pages concerning web based service for homologation and regulation [<https://araiindia.com/hmr/index.aspx>], it is clearly stated that vehicle manufacturers can upload application for type approval and track the case on line, but subscription to the services is restricted to only ARAI customers for type approval. Similarly, archived data of previous TA certificates is available but through controlled access and subscription to the service is restricted to only ARAI customers. These references clearly show that the applications and its certificates for type approval can be accessed by the concerned customer only, which in this case the petitioner itself. But at the same time, there is no evidence that the petitioner published such reports through any other way. Thus this cannot be considered as publication of the drawing.

Remaining evidence Annexure F of the petitioner consists of invoices to show the sale of wheel rim assemblies by the petitioner to Piaggio. These invoices are prior to the date of registration of the impugned design but are in relation to wheel rim assembly no.644973R which has already been discussed in relation to Annexure C. These invoices do not depict any design of the article so as to correlate the so referred drawing or part no.60001.00PA. Petitioner, in para 8 of the evidence by way of affidavit, stated that after getting the type approval from ARAI, applicant supplied wheel rim assemblies on a mass scale to Piaggio, in which reference these invoices of Annexure F were submitted. But in the subsequent sentence, it is stated as "the wheel rim assemblies supplied by the applicant to 'Piaggio' were used by 'Piaggio' for their three wheelers and mini trucks that were sold in the marked by 'Piaggio' before the impugned registration (please confirm)". Such a statement to establish prior use needs to be examined. It is seen from documents of Annexure C that, on

5/5/2009, the petitioner was intimated to send 5 numbers of samples for Part no.60001.00P for Q.C. approval. The pre-despatch report of petitioner dated 11/02/2009 in relation to the said inspection report shows delivery of 25 nos. of quantity. Annexure E consists of a sample/lot inspection report dated 31/05/2009 by Piaggio for part no.60001.02P showing the status of the report as rejected. There is no further reference of mass scale supply of the said article to Piaggio. It is unlikely that the article, which was rejected in sample testing, was used for vehicles and thereby put in public use. There are no further evidences that the article of impugned design was in public domain prior to its date of registration.

Respondent relied upon a minutes of meeting (Annexure R/2) dated 31/07/2007 held between PVPL (Piaggio) and the respondent. The minutes at least reveal that respondent was in business dealing with Piaggio since 2007 and Piaggio honours in writing for design patent of respondent and will not accept supply of wheel rim of same design from any other vendors as well as not to offer propriety drawing to any party for development. Counsel of petitioner, on this subject, pled that it is clearly stated in the said minutes that as many as 65,000 pieces of the 3W wheel rims were to be supplied by the respondent to Piaggio per month since October, 2007 and this amounts to submission on the part of respondent that the said 3W wheel rim design was in public domain from as early as 2007. However, it is seen that there is no specific reference about the impugned design or any illustration depicting such design. In view of aforesaid findings, I construe that neither Annexure B to G nor the minutes of Annexure R/2 discloses that the impugned design was prior published and used prior to its date of registration."

The stand of the respondent no.2 appears to be that the said respondent had developed several innovative designs after several meetings and share all such several drawings with Piaggio. All these were under the agreement of not to disclose proprietary drawings and this does not amount to disclosure to the public. These proprietary designs of registered proprietor appear to have been shared by Piaggio with the petitioner which does not amount to disclosure to public. The communication between the petitioner and the third party is not within the knowledge of the respondent and the design is based on a Convex Bolt Hole Cavity and different from the petitioner's design.

Before the controller the petitioner relied upon the following documents in support of its contention that:-

- A) Impugned Design for "Wheel Rim" bearing Design No.229267. B) E-mail correspondence between the Applicant and "Piaggio" that confirms that the applicant had acquired essential data pertaining to wheel rim assembly design from "Piaggio".
- C) Copies of purchase orders and the letter of provisional approval of applicant's design of the "Wheel Rim Assemblies" that the applicant received from "Piaggio".
- D) Copies of Invoices, bank receipt, test-report and type approval certificates from "The Automotive Research Association of India" (ARIA). E) Copy of the signed sample/lot inspection report sent by "Piaggio" to the applicant.

F) Invoices confirming that the applicant has been producing "Wheel Rim Assemblies" on a mass scale and supplying them to "Piaggio". G) Drawings used by the applicant for manufacturing the "Wheel Rim Assembly"

However, during the pendency of this proceeding the petitioner filed an application for additional evidence at the appellate stage being GA No. 2407 of 2017.

In the application, for the first time, it is contended that the appellant/petitioner as early as February, 2000, was manufacturing wheel rim assembly for Piaggio on the basis of a wheel rim drawing that was given by Piaggio to the appellant. The wheel rim assembly drawing given by Piaggio to the appellant was the intellectual property of Piaggio and Piaggio had every right to disclose the same to the appellant. At the relevant time, Piaggio already had prepared a drawing bearing no.109579 for the wheel rim assembly containing a convex dome shaped center with saddle nut to hold the rim firmly on axel. The appellant had been manufacturing wheel rims in accordance with the shape and configuration in the aforesaid drawing as provided by Piaggio. The appellant wanted to rely upon such drawings and purchase orders for the years 2001 to 2008 received from Piaggio for the wheel rims confirming to the shape and specification ordered and required by Piaggio.

In the year 2007, the appellant was informed that Piaggio wanted to substitute the saddle nut with a conical nut in order to increase the stability of the wheel rim as well as to add to the aesthetic value and visual appeal of the wheel rim. Accordingly, in as early as March 2007, the appellant prepared a drawing based on Piaggio's design with suitable changes to accommodate the conical nut instead of the saddle nut in design and shape of the wheel rim. The said design received provisional approval of Piaggio on April 29, 2009 which was communicated to the appellant by Piaggio vide their letter dated May 5, 2009.

On 25th January, 2010 Piaggio granted final approval to the appellant's design bearing no 60001.00 P A which was super imposed on the template of Piaggio. The appellant disclosed a letter from Piaggio dated 25th January, 2010 along with the cover note and summary of Piaggio along with the drawing of the appellant super imposed on the template of Piaggio in annexure B to the said petition.

The drawings of the appellant for the wheel rim assembly, wheel rim and reinforcement were accorded part nos.B003860, B003867, B003866 and all three drawings taken together were to constitute drawings for the part 644973R which also appears on all the purchase orders for the wheel rims that were supplied to Piaggio by the appellant since 2009. The appellant disclosed in annexure C claims to be the purchase order of the part 644973R dated April 2, 2009.

In the application it is contended that the summary of the drawings for the part no. 644973R lists 3 drawings namely 109579 (wheel rim assembly drawing of Piaggio),

Boo3860 (wheel rim assembly drawing of appellant) and 644973 which as per Piaggio are "alternate to each other".

The term alternate to each other would mean that wheel rims manufactured on the basis of either of the aforesaid drawings can be used as an alternative for each other and/or can also be referred to as alternative to each other. On the said drawing summary Piaggio has also mentioned that part number Boo3860 has been added for the wheel rim of the appellant herein. It is thus claimed that the drawing of the Respondent no.2 was approved and was prepared on the basis of Piaggio's drawing bearing number 109579 in as early as at least May 24, 2009. Further on December 23, 2009 the appellant's drawing for wheel rim assembly that was approved was given part number Boo3860 and which was communicated to the appellant on January 25, 2010. It is, therefore, clear that the respondent no.1 has also prepared its drawing bearing number 644973 on the basis of and with the reference of Piaggio's drawing bearing number 109579. Since there are only two suppliers of wheel rim assemblies for three wheelers of Piaggio, namely, the appellant and the respondent no.2, the wheel rim assembly drawing bearing number 644973 cannot be said to be that of the respondent no.2 herein and none other. The respondent no.2 did not produce on record its design of the product wheel rim assembly which was approved by Piaggio, which the appellant has strong reasons to believe to be none other than the drawing bearing number 644973. Piaggio has name the part as 644973R but the drawing bearing the said number which was approved by Piaggio which included the central and the conical nut aspects was already manufactured by both the appellant as well as the respondent no.2 and were supplied to Piaggio in as early as the year 2009 which admittedly is prior to the date of filing of application of the impugned design bearing number 229267; thereby rendering the impugned design "not register-able"

under the provisions of the Designs Act, 2000.

The three drawings (referred to as part numbers by Piaggio) 644973, 109579 and Boo3860 are in fact drawings for the part number 644973R which has been stated as the drawing number on the summary page. In the year 2009, respondent no.2's design bearing drawing number 644973 was already approved by Piaggio. The wheel rims manufactured by respondent no.2 were mounted and used on Piaggio's vehicle 'Ape-501' which was already then existing in the Indian market in 2009. It is clear that the said design of respondent no.2 was already made known to public as the said vehicle was available for purchase in the Indian market rendering the same "non register-able" under Section 4 the Designs Act, 2000. Further, respondent no.2's design is a mere work shop modification of Piaggio's design made at the instance of Piaggio for the vehicle Ape-501 on the basis of drawing number 109579 for part number 644973R. Hence the impugned registered design was not new, original and certainly not distinguishable from the wheel rim design of the appellant herein at the opportune time when respondent no.2 applied for its registration under the Designs Act, 2000.

The drawing number 644973 was already disclosed, approved and manufactured by the respondent no.2 for Piaggio since at least 2009. It is thus evident from the said



documents that the wheel rim assembly having the impugned design was available in the market prior to the filing and application for registration of the impugned Design by the respondent no.1 herein.

The appellant stated that although the documents relied upon in the cancellation petition squarely indicate and establish that the respondent no.2's design was wrongly registered the respondent no.1 failed and erred to appreciate the same and instead arrived at an incorrect interpretation of the drawing number 60001.00P as a part number and further went on to compare the same with part number 644973R. Further the respondent no.1 also failed to appreciate and understand that the drawing bearing number 60001.00 P was allotted by the appellant whereas the part number 644973R was allotted by Piaggio to the very same drawing referred to as drawing number 60001.00 P. Thus, it is necessary for the appellant to produce on record the documents which clarify this confusion and incorrect fact finding given by the respondent no.1 in the interest of justice and equity. Thus it is necessary that the appellant be allowed, permitted and granted leave to produce on record to clarify and establish that the appellant's drawing bearing no. 60001.00 P is none other than design for the part 644973R of Piaggio.

Such documents are very material and relevant for proper adjudication of the issues involved in the present proceeding more particularly on account of respondent no.1 confusing drawing number with part number and concluding that both are part numbers that are different and independent form each other.

At the time when the matter was heard before the respondent no.1, the appellant's concerned officer was out of station and therefore these additional documents were in the custody of the said concerned officer. At the time of hearing before the respondent no.1 these document could not be produced as they were in the custody of the officer and he was not available at that point of time. These additional documents being very vital and important are kept under lock and key with the concerned officer. It is stated that due to these reasons the same cold not be produced before the respondent no.1. The appellant further submitted that when the instant appeal came up for hearing and a conference was fixed with the senior counsel, the concerned officer attended the said conference and placed those documents at the time of discussion. The Senior Counsel appearing for the appellant after going through the said documents was of the opinion that the same are very relevant to prove prior publication and also the facts that the said Design under challenge is the Design which has been supplied to the appellant and the respondent no.2 are that of Piaggio and therefore the respondent no.2 cannot claim to have any proprietary right of the same.

Under such circumstances this application in additional evidence at this appellate stage has been filed.

In the affidavit in opposition the respondent no.2 has specifically denied that the respondent prepared its drawing bearing no.644943 on the basis of and with the reference of Piaggio drawing bearing no.109579. The impugned design no.229267 dated 13th May, 2010 was registered under Class 12-16 of the Designs Act. The representation consists of two pages comprising front view in the first sheet and perspective view of the second sheet. The novelty is claimed to be residing in the shape and configuration of the wheel rim as illustrated. Disclaimers were provided in the respective sheets regarding mechanical or other action of the mechanism whatever or in respect of any mode or principle of construction of the article. The Deputy Controller as discussed earlier as relied upon by the Gopal Glass Works Ltd. (supra) and National Trading Company (supra) and few other judgments to come to a finding that the e mail correspondence between the petitioner and the Piaggio, in some references are covered under secrecy direction with disclaimer in bottom that the contents are privileged and confidential and should not be disclosed to other than the addressee.

The list of documents relied upon by the petitioner before the Controller does not show that the design of the petitioner was taught by any other prior publication design and it is needless to mention that improvement which has an aesthetic value on any existing article is registerable under the Designs Act. The appellant realized that the evidence adduced before the Controller is inadequate and does not establish that the impugned design lack novelty has now come out with an application for additional evidence. This Court has independently gone through the affidavit evidence filed by the appellant/petitioner on 5th December, 2011 and is of the considered view that none of the said annexure disclosed the claim of novelty or support the case of the appellant based on prior publication. There is no whisper in the said evidence that the petitioner was supplying to the Piaggio since 2000 wheel rim with same and similar design. On the contrary, in the said proceeding the appellant had relied upon an affidavit of Bhavana Ashish Kankariya affirmed on 30th October, 2013 in which the said deponent stated that she is the proprietress of Shri. Ambaji Tempo House and the wheel rims fitted to Piaggio Ape, Model No.501 without saddle have been in the market since 2009. However, the deponent was unable to prove such claim. In any event, the said affidavit totally belies the claim of the appellant that the said design was in vogue since 2000 and the said design was conceived by Piaggio. The Deputy Controller had analyzed each of the annexures with his expertise and found that the case of prior publication or that the impugned design lacks novelty was not established. The said expert body with its required expertise has found novelty in the design. The Appellate Court ordinarily will not interfere with the finding of the controller unless it is found that the controller has proceeded on some wrong principle. The controller must, prima facie, be the judge of novelty having regard to its knowledge and experience in the matter and certainly in this case, I see nothing wrong in principle what the said controller has done. The petitioner in the additional evidence as sought to justify that Piaggio and none others have a proprietary right over the designs registered by the respondent no.2 under the

Designs Act. One would have expected that in such circumstances the objector would have produced some evidence from Piaggio in the pending proceeding to show that the impugned design is the intellectual property of Piaggio. Even in the application for additional evidence no such document has been disclosed. Apart from the fact that the explanation offered for not being able to bring such document on record earlier is unsatisfactory it is very difficult to comprehend that since 5th December, 2011 till 6th July, 2012 when the cancellation proceeding was pending the petitioner was prevented from producing such documents. The onus is on the appellant/petitioner to establish at the trial that Piaggio is the proprietor of the design and none of the parties have any contribution to the said design. Even if at this stage, the additional evidence is taken on record in absence of any assertion from Piaggio that the impugned design has been conceived by Piaggio and shared with the respondent No.2 and the very same drawings are being used by the respondent No.2 it is well-nigh impossible on the part of the appellant to succeed in its objection.

In ITC Limited v. Controller of Patents & Designs, reported at 2017 (2) CHN (Cal) 367; (AIR 2017 Cal 156) it is stated in paragraphs 8, 9 and 10:-

"8. this court had the occasion to consider the question of novelty and originality of a design as well as what would constitute a prior publication. It was held that a design is an idea or conception as to features of shape, configuration, pattern or ornament applied to an article. Although an idea may be potentially capable of registration, in fact, it must be reduced to visible form to be identified with. The design must be such that in the finished article, the features of it appeal to the eye and are judged solely by the eye. The Court followed the dictum of Buckley, L.J. as to the distinction between new or original.

9. The surface features, particularly if they are pronounced, may be treated as features of shape or configuration, as in *Cow & Coy Ltd. V. Cannon Rubber Manufacturers Ltd.* Reported at (1959) RPC 240 at 347 where it was held that a series of ribs on the surface of a hot water bottle were features within the scope of the statement of novelty which claimed such features. The novelty in the instant case is also claimed on surface pattern and the Deputy Controller has applied its mind to such features before concurring with the earlier finding that novelty resides in the surface pattern of scarf as illustrated.

10. In *Anuradha Doval v. The Controller of Patents and Designs & Os.* Being AIR no. 1 of 2015 on 13th April 2017, this court had the occasion to consider what would constitute in the prior publication and after considering the laws on the subject held: "if a document is to constitute prior publication then a reader of it, possessed ordinary knowledge of the subject, must from his reading of the document be able, at least, to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head."

The documents disclosed by the appellant before the Deputy Controller does not per se show that Piaggio has any proprietary interest in the impugned designs. The respondent no.2 under a non-disclosure agreement could not be asked to produce documents in the cancellation proceeding inasmuch as the court cannot direct a party to act in breach of such agreement. Any document shared under non-disclosure agreement cannot constitute a prior publication with the meaning of Designs Act. Moreover, additional evidence should not be allowed at this stage to fill up any lacuna. The Hon'ble Supreme Court in Satish Kumar Gupta Vs. State of Haryana reported at 2017 (4) SCC 760 relying upon its earlier decision in N. Kamalam Vs. Ayyasamy reported at 2001 (7) SCC 309 has stated that at the appellate stage unless the appellant is able to establish that the evidence sought to be adduced was not available despite the exercise of due diligence, additional evidence could not be permitted to filling the lacuna or to patch up the weak points in the case.

Mr. Siddhartha Mitra, the learned Senior Counsel has relied upon the decision of the Hon'ble Supreme Court in Union of India Vs. Ibrahim Uddin reported at 2012 (8) SCC 148 for the proposition that the appellate court may for the ends of justice allowed the additional evidence at the appellate stage. The learned Senior Counsel has submitted that at the appellate stage if it is found that the additional evidence would have important bearing on main issue or necessary to remove any lacuna in evidence and for clearing any doubt, the Court may permit such additional evidence to do substantial justice. There cannot be any doubt as a general principle, the appellate Court should not travel beyond the record of the lower court and cannot take any evidence in appeal, however, as an exception as held in Union of India (supra) under Order 41 Rule 27 CPC the appellate court can take evidence in exceptional circumstances. The appellate court observed "may permit additional evidence only and only if the conditions laid down in the said rule are found to exist".

The application for additional evidence must also fail as the petitioner has failed to give full explanation for the delay as also for non-disclosure of the evidence at the appropriate stage although allowing such additional evidence would not have made any difference. It is trite to observe that under Order 41, Rule 27, additional evidence could be adduced in one of the three situations, namely, (a) whether the trial Court has illegally refused the evidence although it ought to have been permitted; (b) whether the evidence sought to be adduced by the party was not available to it despite the exercise of due diligence; (c) whether additional evidence was necessary in order to enable the Appellate Court to pronounce the judgment or any other substantial cause of similar nature. It is equally well-settled that additional evidence cannot be permitted to be adduced to as to fill in the lacunae or to patch up the weak points in the case. (Malayalam Plantations Ltd. v. State of Kerala, AIR 2011 SC 559) The application for additional evidence being G.A. No.2407 of 2017 is dismissed.

The appeal being AID No.6 of 2013 is also dismissed.

However, there shall be no order as to costs.

Urgent Photostat certified copy of this judgment, if applied for, be given to the parties on usual undertaking.

(Soumen Sen, J.)