

# Servewell Products Pvt Ltd & Anr vs Dolphin on 9 April, 2010

**Author: S.Ravindra Bhat**

**Bench: S. Ravindra Bhat**

\* IN THE HIGH COURT OF DELHI AT NEW DELHI

Pronounced on : 09.04.2010

+ IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010

SERVEWELL PRODUCTS PVT LTD & ANR ..... Plaintiff

Through: Mr. Mohan Vidhani with Mr. Rahul Vidhani and  
Mr. Mahir Malhotra, Advocates.

versus

DOLPHIN ..... Defendant

Through: Ms. Pratibha M. Singh with Mr. Deepak Gogia, Advocates.

CORAM:

MR. JUSTICE S. RAVINDRA BHAT

1.

Whether the Reporters of local papers may be allowed to see the judgment?	YES
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2. To be referred to Reporter or not?	YES
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3. Whether the judgment should be reported in the Digest?	YES
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MR. JUSTICE S.RAVINDRA BHAT

1. This is an order deciding two applications, i.e. I.A. No. 383/2010 (of plaintiffs under Order XXXIX Rules 1 & 2) and I.A. No. 1119/2010 (of Defendant under Order XXXIX Rule 4) in Suit No. 49/2010, seeking permanent injunction under section 51 and 55 of the Copyright Act, 1957 read with section 22 of the Designs Act, 2000 restraining infringement of registered design, copyright and passing off by the defendant.

2. The suit states that the first and the second plaintiffs (hereafter jointly, "Servewell") are sister concerns, as they are controlled by members of the same family. It is further stated that the first plaintiff came into existence more than a decade ago, whereas the second plaintiff was established on 01.04.2005. Servewell are engaged in the business of designing, developing, manufacturing

marketing and exporting domestic kitchen appliances, melamine decorative IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 1 serving trays and tableware. It is claimed that they have manufactured and marketed the above said goods in scores of different shapes, sizes, designs and artistic works, which, according to them, have been well received by the consumers. The first plaintiff claims to be the owner of almost all intellectual property rights of the group and the second plaintiff is aggressively manufacturing and marketing the aforementioned goods in domestic, as well as international market. Servewell claims that their business is well-known for superior quality, durability and unique attractive artwork depicted on their products sold under their distinctive trademark "SERVEWELL".

3. It is stated that, as a part of promotional activities, in 2005 Servewell commissioned the services of one Mr. Bhupendra Chotalia, a commercial artist to design art works for calendar and greeting cards for the year 2006, to be distributed among stockists and distributors. The copyright in the said art works vests in the first plaintiff, by assignment. It is stated that the second plaintiff, using the said artistic works launched its first line of products. The suit avers that this product line was a resounding success in domestic and international market, this prompted the first plaintiff to approach the Registrar of Copyrights, New Delhi for registration of said artistic works, which are now duly registered in the first plaintiff's name under nos. A- 84938/09, A-84939/09, A-84940/09, A-84941/09, A-84942/09, 84943/09, A-84944/09, A- 84945/09 and A-84946/09. Again in the year 2008 the first plaintiff got some artistic works executed by the same author, which too were registered in its name under nos. A-84918/09 and A-84919/09. Copies of all the above said certificates have been filed. In 1st week of August, 2008 the first plaintiff claims to have invented a new/novel design of serving tray having a unique shape and configuration, which was duly registered on 11.08.2008 with the Controller of Designs under no. 217625; a copy of the certificate is filed. The first plaintiff permitted the second plaintiff to manufacture and market serving trays under the said new/unique design and incorporating all/any of the above mentioned artistic works.

4. In support of its contention about enjoying a widespread reputation in the market for its product, Servewell has, in Para 11 of the suit, reproduced its total turnover figures; in 2006-07, its turnover was Rs. 5,05,94,000/-; it increased to Rs. 12,19,13,000/- for the year 2008-09. Servewell contends that its serving trays are distributed through 16 branches, and sales depots, throughout the world; it also states possessing distribution networks in 53 cities, across the IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 2 country. The suit alleges that Servewell participates in international fairs and that its goods are retailed in well known stores, and malls.

5. The suit claims permanent injunction, and consequential relief, against the defendant (hereafter "Dolphin") for alleged infringement in respect of registered artistic works displayed in trays marketed by the latter (i.e. Dolphin), which are identical replicas of the artistic works found in the trays marketed by Servewell. The copyright in these artistic works is the subject matter of copyright registrations in A-84918/09, A-84919/09 A-84938/09, A-84939/09, A-84940/09, A- 84941/09, A-84942/09, 84943/09, A-84944/09, A-84945/09 and A-84946/09. Servewell also claims that Dolphin has infringed their design in respect of the shape of the tray, which is the subject matter of design registration No. 217625.

6. This Court, at the stage of first hearing of the suit, while issuing summons, made the following interim order, on the application for ex-parte ad-interim injunction, as well as the application for appointment of a local commissioner:

"I.A. No. 383/2010 (Under Order 39 Rule 1 and 2) Issue notice to the defendant, returnable on 27.10.2010. The plaintiffs claim to be the copyright and registered owners of unique and distinctive designs of trays. They rely upon the Design Registration No.217625 in respect of the trays. It is submitted that the plaintiffs are the copyright owners in respect of the original works which are embedded on the trays, being A-84938/09, A-84939/09, A-84940/09, A-84941/09, A-84942/09, A-84943/09, A-84944/09, A-84945/09, A-84946/09, A-84918/09, A-84919/09 and 217625. It is claimed that the plaintiffs have acquired a reputation in the market for the quality of their products. The suit relies upon the progressive increase of plaintiff's turn-over in para 11 of the application.

The plaintiffs complain that the defendant has blatantly copied both their design as well as some of the artistic works which are embedded on the tray. In support, the plaintiffs have produced photographs of the two products. After considering the materials on record, the Court is of the opinion that the plaintiffs have prima facie established their case for infringement of their designs and copyright. Unless an appropriate injunction is granted, the plaintiffs are likely to suffer injury. In the circumstances, the defendants, their proprietors/partners, principal officers, servants, retailers, stockists, distributors, representatives and agents are hereby restrained from manufacturing, selling, offering for sale, stocking, advertising, directly or indirectly dealing in serving trays or other allied and cognate goods which are subject matter containing depictions and artistic works A-84938/09, A-84939/09, A-84940/09, A-84941/09, A-84942/09, A-84943/09, A-84944/09, A-84945/09, A-

IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 3 84946/09, A-84918/09, A-84919/09 as well as depicting the design which is subject matter of Design No. 217625, of which the plaintiffs are the proprietors, till the next date of hearing.

Provisions of Order 39 Rule 3 shall be complied within a week.

I.A. No. 384/2010 (Under Order 26 Rule 9) This is an application for appointment of Local Commissioner. It is submitted by learned counsel for plaintiffs that the defendant has stocked a large quantity of the goods bearing deceptively similar trademarks as that of the plaintiffs (hereafter referred to as the "impugned goods" at their premises 13/19, Shop No.1, Saraswati Marg, Karol Bagh, New Delhi-110 005. The plaintiffs apprehend that on being served with the summons, the defendant might remove the stock of the impugned goods bearing the impugned trademark as well as they may tamper with the books of accounts.

After hearing learned counsel for the plaintiffs, Mr. Vikas Bhadauria, Advocate (Mob. No. 9312124521) is hereby appointed as Local Commissioner to visit the premises of the defendant - 13/19, Shop No.1, Saraswati Marg, Karol Bagh, New Delhi-110 005. The Local Commissioner will take into custody the impugned goods and other incriminating materials such as all finished and unfinished materials, goods, cartons, boxes, bags, wrappers, labels, dies, packagings etc. and other material bearing any of the plaintiffs' trademark or bearing any other mark or any marks similar to the trademark of the plaintiffs; inventorize them and ensure that they are kept in sealed condition, in the defendant's premises after releasing them on superdari. The defendants are restrained from removing them, and shall produce them in Court whenever called upon to do so. The Local Commissioner may have the goods and packaging photographed. The Local Commissioner will also visit other go-downs of the defendant and also sign the books of accounts, ledgers, cash registers, stock registers, invoices, books etc. of the defendant, as revealed by them. The Local Commissioner will be entitled to seek police aid from the local police station, if required. The Local Commissioner will be paid a sum of Rs.50,000/- (Rs. Fifty Thousand) apart from transport, travel and other incidental out-of-pocket expenses. The Local Commissioner shall submit his reports to the Court within two weeks."

7. The report of the local commissioner, dated 29th January, 2010 states, inter alia, that 805 goods bearing the Servewell's registered design, with or without the copyright were found, and that 1019 goods, bearing the copyright were also found. 147 cartons, bearing Servewell's copyright, were found. The commissioner took photographs, which are annexed to the report.

8. Servewell argues that the copyright in the artworks, which are embodied in the trays, have been slavishly reproduced by Dolphin, in the trays sold by the latter. It is submitted that the IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 4 so called changes urged by Dolphin, do not obscure the slavish reproduction of the essential artistic works, in all the products or goods, and that the written statement does not disclose any legitimate defense. It is urged that Dolphin - which relies on some catalogues, to say that four designs of the plaintiffs, are not original works, but are themselves copied from other existing material- possesses copyright not only in respect of those features (assuming them to be unoriginal, as they are flowers) but in the entire artwork. Servewell submits that the author or creator of the artistic works, Chotalia, had originally made them for use in calenders and such like works, but had assigned the copyrights by the deed, dated 27.05.2006. As a consequence, the copyright registrations were accepted in favour of Servewell, in 2009. It is submitted that there is a minor mistake in description, in respect of one of the works. Servewell urges that the overall artistic work is to be seen, rather than the minute differences such as changes in the colour, of the impugned work, to discern whether the copyright is infringed.

9. Learned counsel for Servewell submits that whereas there can be no quarrel with the argument that those elements in nature can be reproduced- such as flowers- yet the creativity of an artist, by the use of such elements, bearing his originality, in the use of other devices, such as colour bars, their positioning in the artistic work, are protected by copyright, which cannot be reproduced, except with the consent and authorization of the copyright proprietor. Therefore, the defendant's

submission, based on existence of such flowers, in some catalogues, is untenable. The reproduction of such flowers or floral designs, in combination with the unique manner of presentation of the colours in the background, constitutes infringement of the original artistic works, which has to be restrained, through a temporary injunction. Servewell relies on the decision reported as *The Daily Calender, Supplying Bureau v. The United Concern*, AIR 1967 Mad 381, to say that exact reproduction of an artistic work is not to establish copyright infringement, but the showing of the impugned mark, copying essential elements of the copyrighted work.

10. In *Daily Calender*, the Madras High Court stated that:

"For the purpose of infringement of copyright, an exact reproduction of substantial part or copy is not necessary. What is essential is to see whether there is a reproduction of substantial part of the picture. There can be no test to decide what a substantial part of a picture is. One useful test, which has been followed in several decisions of courts, is the one laid down by Lord Herschel, LC, in *Banfstaengl v-Baines & Co* 1895 AC 20:

IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 5 "...it depends really on the effect produced upon the mind by a study of the picture, and of that which is alleged to be a copy of it, or at least of its design."

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There might be and there will be obvious differences deliberately introduced to avoid a possible charge of infringement. A bad copy does not cease to be a copy. If the court, on a consideration of all the relevant circumstances and a comparison of the plaintiff's picture and the infringing picture comes to the conclusion that the defendant's picture was consciously copied from the work of the plaintiff, that would be sufficient to hold that copyright is infringed."

11. Servewell urges, as far as the case concerning design infringement is concerned, that there is no room for doubt about Dolphin's intention. Reliance is placed on the local commissioner's report, and it is contended that once the design owner establishes that the novelty in the design (in this case, the shape of the tray) is protected by registration, there is no question of having to satisfy any other test. The test of deceptive similarity, or overall comparison to discern substantiality, etc., are apt in trademark passing off actions; for a design infringement action, the plaintiff merely has to show that he is owner of the registered design, and that it is copied by the defendant, which has been done, in this case. Servewell relies on the decision reported as *Castrol Ltd v. Tide Water Oil Co.*, 1996 PTC 16 (Cal) in support of this submission. It is submitted that the defendant's argument about existence of prior art, taken in the written statement, cannot stand scrutiny, since only photographs have been produced, and not any object in material or three dimensional form.

12. Dolphin contests the suit; it has filed a written statement, and also filed an application for vacation of the ad-interim order, made by the Court. Its contention is that the artistic works, in

which copyright proprietorship is claimed, are not protectable under the Copyright Act, since the main or dominant feature, i.e. the floral representations, had been published previously. In support of this argument, the defendant relies on photographs from books and catalogues. They are described in detail as follows:

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Sl. No.	Copyright No.	Description	Servewell's document	Dolphin's Document	
1	A-84938	Yellow colored petals	Pages 5-6	Pages 79-81	Copies of Plates
2.	A-84919	Pink Rose	Page 3	Pages 85-86	Copies of Japanese Design Diagrams
3.	A-84944	White flowers set in blue design	Page 17-18	Pages 82-84	Copies of Plates
					Copies of Catalogues

It is argued that the three floral designs used by Servewell for its trays are neither original nor works of art, as they merely copy prior publications. Dolphin also says that the floral designs are, in any case not entitled to copyright protection, since they do not satisfy the test of original artistic works, as there is no creative element. Dolphin relies on the recent ruling of the Supreme Court, in *Eastern Book Co. v. D.B. Modak*, 2008 (1) SCC 1. It is submitted that copyright registration does not in any manner affect the right of Dolphin to submit that the works in question are not copyrightable, or entitled to copyright protection, unlike in the case of trademark registration.

13. Dolphin challenges the design registration of Servewell in respect of the trays in question, and states that by virtue of Section 22(3) of the Designs Act, 2000 (hereafter "the 2000 Act") the Court can independently conclude that the controller of designs could not have registered the design(s) in question, for any of the reasons enumerated under Section 19, enabling cancellation (of such design registration). In this case, says Dolphin, there is no novelty or uniqueness in the tray design, as what is urged to be so novel is fairly commonplace. Besides, says Dolphin, Annexure-E (Collectively) - at page 103 ( in support of I.A. 1119/2010) reveals that the so- called uniqueness of the shape, which is the angled sides of the tray, styled distinctly, and convenient for holding by the hand, existed in catalogues printed by an Italian company. It is also submitted that the said design is known as "trendy" and was existing, and marketed as such, IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 7 openly, even before the design was registered. Copies of certain invoices issued by Premier Marketing, Servewell, one M/s Sunware's trays, and photographs from other traders and retailers have been produced.

14. It is submitted that Section 15(2) of the Copyright Act, 1957, provides that where a design, capable of being registered under the Designs Act, is not so registered, copyright (in such design) shall cease as soon as any article, to which the design has been applied is reproduced more than 50 times by an industrial process by the owner of the copyright or with his licence, by any other person. Relying on the Division Bench ruling in *Microfibres Inc. v. Girdhar & Co. & Anr.*, 2009 (40) PTC 519 (Del), Dolphin submits that in this case, the Court ruled that there is lesser copyright protection, in the case of industrial designs. The relevant portion of the said Division Bench judgment reads as follows:

"32. A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher protection to pure original artistic works such as paintings, sculptures etc and lesser period of protection to design activity commercial in nature. The period of copyright would be the author's life span plus 60 years. However, the legislature has allocated a lesser time span for the protection available to a registered design as only being 15 years. Thus, commerce and art have been treated differently by the Legislature and any activity which is commercial in nature has been granted lesser period of protection. On the other hand, pure artistic works per se have been granted a longer protection.

A perusal of the above Section 6 clearly indicates that once the design has been registered for a particular article comprised in a class of articles, the subsequent registration of other articles comprised in that class of articles shall not be refused but the subsequent registration shall not extend the period of copyright in the design beyond that arising from the previous registration. It is significant that the subsequent registration has statutorily been mandated not to extend the period of copyright registration beyond the period beginning from the original registration. This clearly shows the legislative intent of limiting the copyright protection in the design to the initial period of 10 years, extendable by further period of 5 years.

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35. However, there can be no quarrel with the plea of Shri Ramachandran that the operation of Section 15(2) of the Copyright Act does not exclude from the ambit of Copyright protection either the original "artistic work" upon which the design is based or the design which by itself is an artistic work. It cannot be disputed that the original paintings/artistic works which may be used to industrially produce the designed article would continue to fall within the meaning of the artistic work defined under Section 2(c) IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 8 of the Copyright Act, 1957 and would be entitled to the full period of copyright protection. This is also evident from the definition of the design under Section 2(d) of the Designs Act. This, in our view, in fact is a factor which would go against the appellants in construing the nature of protection to be given to the original artistic work such as a painting, as contrasted with the applied artistic work that is the

design, which in the present case does not mean the intermediary medium such as a mould, engraving devised/produced only to enable industrial application of the painting to produce the furnishing products of the appellant. Thus, while the original painting would indeed be entitled to the copyright protection, the commercial/industrial manifestation of such paintings such as the design derived from and founded upon the original painting for the purpose of industrial production of furnishings would only be covered by the limitations placed in Section 15 of the Copyright Act and would get protection if registered as a design under the Designs Act but would enjoy lesser period of protection in case of a registered design.

36. This clearly shows that the legislature intended that even if the artistic work such as a painting has been used as the basis for designing an industrially produced object for commerce, such as the furnishing in the present case, nevertheless the original painting would indeed enjoy full copyright protection, while the result of the industrial application of such painting, namely, the design used in the industrial production of the ultimate product shall enjoy lesser period of protection as stipulated under the Designs Act provided it is registered as a design under the Designs Act. Thus, we are of the view that an original artistic work initially acquires protection under the Copyright Act as an 'artistic work' or else the protection under the Designs Act qua the product created from the artistic work when industrially applied."

15. From the above discussion, it is apparent that what is in issue is the alleged copyright infringement, by Dolphin, in respect of the artistic works which are depicted in the trays offered for sale, by it. Copyright is claimed, in respect of these works, by Servewell, as assignee/owner. The original owner it is claimed, created them, for the purpose of publication of calendar and other similar matter, sometime in 2005-2006; Servewell submits that copyright assignment took place, by such author, on 27th May, 2006; a copy of the deed has been produced, (in a list filed after the suit was filed, and Dolphin's written statement was filed) on 11th March, 2010. Servewell urges that even though the depiction of flowers can be reproduced, Dolphin, in copying all other features, such as the exact colour combinations, even the position of the unique colour bars and designs, has indulged in copyright violation. Dolphin's answer is that the floral depiction is itself copied from previously published photographs and works and that the other elements (such as colour combinations) do not constitute any creative element.

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16. It is now well known that copyright law does not grant the author of a literary work protection on ideas and facts. (Baker v. Seldon, 101 US 99 [1879], Nichols v. Universal Pictures Corp., 45 F.2d (2d Cir. 1930), RG Anand v. M/s Delux Films, (1978) 4 SCC 118) It is only the creative expression of ideas which is conferred exclusive privilege (to exploit, the various rights emanating from it) for a limited time. Copyright does not extend to every expression, but those which are fixed in a medium and are "original". Section 13 of the Copyright Act provides that only "original, literary, artistic, dramatic and musical works" are entitled to copyright protection. Any literary work, in order to



qualify as work in which copyright can subsist, must therefore be original. Originally, in *University London Press v. University Tutorial Press*, [1916] 2 Ch. 601 the Court formulated the "sweat of the brow" doctrine, to scrutinize whether a work was original or not. The Court emphasized that the aesthetic content of the work, or its artistic appeal was irrelevant, so long as the author or creator was able to show that some effort had been put in to create it. This test was discarded and a more exacting creativity standard ("the modicum of creativity") was insisted upon by the US Supreme Court, in *Fiest Publication Inc. v. Rural Telephone Service*, 199 US 340 (1991). The Supreme Court recognized this shift and in *Eastern Book Company v. DB Modak* (supra), following the approach laid down by the Canadian Supreme Court in *CCH Canadian Ltd., v. Law Society of Upper Canada*, (2004) SCC 13, rejected the "sweat of the brow doctrine", (which conferred copyright on works merely because time, energy, skill and labour was expended), and held that the work must be original "in the sense that by virtue of selection, co-ordination or arrangement of pre-existing data contained in the work, a work somewhat different in character is produced by the author". Thus, in India, the test for creativity establishes a higher threshold than the "sweat of the brow" doctrine, but not as high as "modicum of creativity". It acknowledges that that not every effort or industry, or expending of skill, results in copyrightable work, but only those, which create works that are somewhat different in character, involve some intellectual effort, and involve a certain degree of creativity.

17. If this Court were to test the plaintiff's contentions from this standpoint, it would be apparent that each artistic work has to be seen, to determine, on a visual comparison with the infringing work, whether indeed it is "copyrightable" and whether Dolphin has copied them. Out of the allegations of copyright infringement, three artistic works relate to flowers. The designs in the trays are dominated by these flowers, and floral designs. A comparison of each of the flowers IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 10 with the extracts from the two books/publications relied on immediately reveals that Servewell's flower/ flower designs replicate the flowers and floral designs found in the two published books "The Planimetric Design Cyclopedia 2004" and "Japanese & Korean Graphic Materials Design Dictionary". Indeed, Servewell, during the hearings, conceded that Dolphin could reproduce the flowers, but underlined that yet, the copyright in the overall artistic works relied on by it, had been infringed. The emphasis here was to the manner in which colours were portrayed, inlaying the floral designs or flowers.

18. There are two aspects which require consideration, even at the prima facie stage. One, whether there is the minimum creativity element, in the depiction of colours and their positioning, and if so, whether their combination with elements, for which no copyright protection can be claimed, (i.e. the flowers) would render them original artistic works. The kind of colours depicted, and the shapes in which they are shown horizontal yellow bars or strokes, (in A-84938/09); blue stripe/ strokes forming the background for a pale yellow and white flower, (in A-84944/09) Golden flora set in yellow (A-84940/09); violet flower petals set against horizontal violet and white stripes (A-84942/09) and tulips in vase, set in yellow (A-84943/09) are commonplace. The colour depictions are in the form of broad lines or stripes, and appear to have been created by using some computer software, or else are plain brush strokes, matching the colours of the flowers and floral designs they underlay. They do not fulfil the new originality or creativity standard spelt out in *Eastern Book Co.* Such being the case, the mere combination of two non-copyrightable elements by

itself - at least in this case, does not result in a new copyrightable artistic work. So far as A-84919 is concerned, no claim to any colour combination is made; in fact the copyright registration certificate attaches only a pink flower depiction. This Court is also mindful of the circumstance that copyright, based on originality or uniqueness is inadmissible to mere colours or colour combinations. For these reasons, the Court does not prima facie discern any copyright infringement.

19. So far as the depiction of various spices (such as cinnamon sticks, red and yellow peppers, turmeric, red chilli, chilli powder, cardamom, olive oil, etc. in different sized bowls or containers/jugs) are concerned, there may be no originality or creativity in each element. The positioning of these elements, and the depiction of containers, appears to have been reproduced by the artist, who perhaps kept them on the table, and depicted them on canvas, or some other IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 11 medium. That these are commonplace objects cannot be denied. There can also be no denial that depiction of such condiments and spices for cooking or culinary efforts, is limited, if the effort is only to show them. Here, the idea of showing the spices in containers is necessarily limited, and conferment of monopoly to the artist would prevent the reproduction of such objects. In a somewhat similar context, where the creator of a jewel pin design inspired by a bee complained of copyright infringement. The US Federal Court of Ninth Circuit in *Herbert Rosenthal Jewellery Corporation Vs. Kalpakian* 446 F.2d 738 (1971) rejected the claim for protection, starting as follows :

"The critical distinction between "idea" and "expression" is difficult to draw. As Judge Hand candidly wrote, "Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.'" *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir.1960). At least in close cases, one may suspect, the classification the court [\*\*11] selects may simply state the result reached rather than the reason for it. In our view, the difference is really one of degree as Judge Hand suggested in his striking "abstraction" formulation in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930). The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws.

What is basically at stake is the extent of the copyright owner's monopoly -- from how large an area of activity did Congress intend to allow the copyright owner to exclude others? We think the production of jeweled bee pins is a larger private preserve than Congress intended to be set aside in the public market without a patent. A jeweled bee pin is therefore an "idea" that defendants were free to copy. Plaintiff seems to agree, for it disavows any claim that defendants cannot manufacture and sell jeweled bee pins and concedes that only plaintiff's particular design or "expression" of the jeweled bee pin "idea" is protected under its copyright. The difficulty, as we have noted, is that on this record the "idea" and its "expression" appear to be [\*\*12] indistinguishable. There is no greater similarity between the pins of plaintiff and defendants than is inevitable from the use of jewel-encrusted bee forms in both.

When the "idea" and its "expression" are thus inseparable, copying the "expression" will not be barred, since protecting the "expression" in such circumstances would confer a monopoly of the "idea" upon the copyright owner free of the conditions and limitations imposed by the patent law. *Baker v. Selden*, 101 U.S. 99, 103, 25 L. Ed. 841 (1879); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-679 (1st Cir. 1967); *Crume v. Pacific Mut. Life Ins. Co.*, 140 F.2d 182, 184 (7th Cir. 1944). See also *Continental Cas. Co. v. Beardsley*, 253 F.2d 702, 705-706 (2d Cir. 1958)."

For the above reasons, the claim for copyright protection in respect of the work embodied in A-84941/09 also cannot stand.

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20. The next question is the allegation of infringement of design, by Dolphin. The relevant provisions of the Designs Act are reproduced below, for the sake of convenience. Section 2 (d) defines "design" as follows:

"(d) "design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957);

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Registration is provided in Section 11:

"11. Copyright on registration.-

(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.

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A person claiming that some design does not reveal any novelty can apply for its cancellation, under Section 19:

"19. Cancellation of registration.-

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:-

(a) that the design has been previously registered in India; or

(b) that it has been published in India or in any other country prior to the date of registration; or

(c) that the design is not a new or original design; or

(d) that the design is not registrable under this Act; or

(e) that it is not a design as defined under clause (d) of section 2. (2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

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The remedy available to the design proprietor and the possible defence available to the alleged infringer, are subject matter of Section 22:

"22. Piracy of registered design.-

(1) During the existence of copyright in any design it shall not be lawful for any person-

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or

(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention-

(a) to pay to the registered proprietor of the design a sum not exceeding twenty- five thousand rupees recoverable as a contract debt, or

(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly: Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees: Provided further that no suit or any other proceeding for relief under this sub- section shall be instituted in any court below the court of District Judge. (3) In any suit or any other proceeding for relief under sub- section (2), every ground on which the registration of a design may be cancelled under section 19 shall be available as a ground of defence.

(4) Notwithstanding anything contained in the second proviso to sub- section (2), where any ground on which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence and sub- section (3) in any suit or other proceeding for relief under sub- section (2), the suit or such other proceeding shall be transferred by the court, in which the suit or such other proceeding is pending, to the High Court for decision.

(5) When the court makes a decree in a suit under sub- section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs."

21. Dolphin states that the Servewell's design registration is liable to be cancelled, by virtue of Section 4, which enacts that a design which is not new or original or has been disclosed to the public anywhere in India, or in any country by publication in tangible form, or by use, etc. is IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010 Page 14 prohibited from being registered. In support, invoices of certain dealers and traders, and a webshot of the SIND ELECTRIC AND TRADING COMPANY, Servewell's distributor, from the website [www.setcpune.com](http://www.setcpune.com) are relied on. It is stated that the claimed uniqueness or novelty is to the curved and stylized handle of the tray, which is clearly discernable from copies of the web shots, which show that the tray was sold as part of the SERVEWELL TRENDY range, in 2008; the invoices pertain to such range. Significantly, in the plaintiff's reply to the allegations in Dolphin's application for vacation of stay, there is a bland denial; there is no specific denial about the product having been in existence in 2008, or that M/s Sind Electric and Trading Co. being Servewell's distributor. Furthermore, a visual comparison of the

photographs forming part of Annexure E to the said application, with the photographs relied on by Servewell, in support of its claim for infringement of design, prima facie, reveal that the designs are the same. In these circumstances, the Court is of opinion that Dolphin has a reasonably arguable case in support of its contention that the design registration is liable to be challenged. Of course, these observations are tentative, and based on the existing materials; the parties are yet to test their respective strengths in the trial, in this case. Consequently, the Court is of the view that the injunction vis-à-vis the registered design cannot be granted.

22. As a result of the above discussion, it is held that the subsisting interim order has to be vacated. The injunction in respect of the artistic works, which have been registered by the first plaintiff, is hereby vacated. Likewise, the injunction in respect of Design No. 217625 is hereby vacated. Resultantly, the defendant is permitted to open the seals in respect of all the products I.A. No. 383/2010 (the plaintiffs' application under Order XXXIX Rules 1 & 2) is dismissed and I.A. No. 1119/2010 (Dolphin's application for vacation for stay) is therefore allowed. No costs.

CS(OS) 49/2010 List for further proceedings on 27th August, 2010.

April 09, 2010

(S.RAVINDRA BHAT)

JUDGE

IA Nos. 383/2010 & 1119/2010 in CS(OS) 49/2010