

Samsonite Corporation vs Vijay Sales on 1 May, 1998

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Bench: K. Ramamoorthy

ORDER

K. Ramamoorthy, J.

1. The plaintiffs claiming to be engaged in the sale of suit cases all over the globe have instituted the suit against the defendants stating that the defendants have infringed the plaintiff's copyright in drawings; the defendants are passing off their goods and they are imitating the trade dress in making the suit cases to sell their products. The defendants resist the case of the plaintiffs on various grounds. In view of the fact that the parties relied heavily on their respective pleadings to project their respective contentions and the arguments covered a very wide canvass, it has become necessary for me to refer to the pleadings in the first instance and then to deal with the rival contentions put forth at the time of the arguments and the precedents referred to by the learned counsel for the parties.

2. The case of the plaintiffs could be recounted in the following terms.

The first plaintiff Samsonite Corporation is a Company operating under the State of Delaware Colorado in the United States of America. The second plaintiff Samsonite India Pvt., Ltd. is a joint venture Company formed by virtue of the agreement dated 7.11.1995 between the first plaintiff and the Indian Promoters represented by Mr. Ramesh Tainwala, the present Managing Director of the second plaintiff Co. The first and the second plaintiffs have also entered into technical know-how, trade mark patents and trade name agreement dated 7.11.1995 whereby the second plaintiff is given a licence to use the trade mark and other trade marks, patents and technical know-how. The second plaintiff pursuant to such an agreement has obtained clearance from the concerned authorities. According to the plaintiffs, the first defendant Vijay Sales is stockist in Connaught Place, New Delhi. The second defendant Blowplast India Ltd. is a Company registered under the Companies Act having registered office at Mumbai. The third defendant V.I.P. Industries Ltd. is a Company having registered office at Nasik, Maharashtra. The first plaintiff has established itself as market leaders and trend setters for manufacturing soft and hard luggage, pullmans, carry alls, shoulder bags, backpacks, brief cases, vanity cases of superior quality, contemporary style, innovative design and distinctive colour combinations, which are sold under various specie names but under the umbrella trademark of SAMSONITE. The first plaintiff is a registered proprietor of the trade mark SAMSONITE in 59 countries. In India, the first plaintiff has registered its trade mark SAMSONITE

under class 18 bearing registration Nos. 249728 (SAMSONITE word per se) and 286195 (Samsonite logo). The plaintiffs claim that the first plaintiff has subsidiaries and licencees in almost all the countries in the world. The sales turnover on global market in 1996 have been 675.20 million US Dollars. The first plaintiff had advertised on a very large scale and it is claimed :-

"The range of goods manufactured and/or marketed by the Ist plaintiffs and/or their licensees under the umbrella trademark SAMSONITE are also featured the world over in the catalogues of leading departmental stores like ROBINSON's in Singapore and HARROD'S, SELFRIDGS and JOHN LEWIS in U.K., PRINTEMPS in France and HERTIE in Germany as well as inflight magazines of many international airlines like HIGHLIFE of British Airways and Priority of Singapore Airlines and several mail order and duty free shopping catalogues.

The Ist plaintiffs have also widely advertised the range of goods manufactured and/or marketed by the Ist plaintiffs and/or their licensees under the umbrella trademark SAMSONITE in various printed media including newspapers, tabloids and magazines with international circulation like The Sunday Times, The Telegraph, Daily Mail, Mail on Sunday, She's, Capital, National Geographic, TIME, Cosmopolitan, Khaleej Times and through attention catching T.V. commercials in the U S and Europe. Many of these magazines have a wide circulation in India. The plaintiffs crave leave to refer and rely on such advertisements of Samsonite products."

The plaintiffs project their products stating :-

"The goods of the Ist plaintiffs distinguish themselves and are easily recognizable from those of other manufacturers by their distinctive features which contribute to the ease of travel, namely, the wheels; the extendable handle and the built in trolley, making it easy for the traveller to manoeuvre and move his luggage; the combination of material and choice of colour, design and style, which makes the travel cases of the Ist plaintiff easily recognizable amongst a milieu of other travel cases manufactured by other manufacturers; the lay out of their interior compartments, with all the special features to suit all needs and tastes."

The plaintiffs found their case on copyright in the following terms :-

"The Ist plaintiffs are the proprietors of the technical know-how in respect of the new products and product improvements, conceived and developed at their research facility or that of their subsidiaries and/or licensees, including the drawings and proto types prepared in respect of new products and/or improvements there upon by the draftsman or technicians in the employment of the Ist plaintiffs, their subsidiaries and/or licensees.

In and about 1986 the Ist plaintiffs introduced the system-4 range. The range was developed by two Belgians, Mr. Guido Wijckman and Mr. Victor Festjens, both

employees of Samsonite NV, a Belgian subsidiary of the Ist plaintiffs. The System-4 range was modified and improved and in 1993, the Ist plaintiffs introduced the System-4 Deluxe range. The System-4 Deluxe range was created by Mr. Nikolaus Muller, a German citizen in the employment of Samsonite Espana S.A., a Spanish subsidiary of the Ist plaintiffs. The System-4 Delux range comprises of a handy case, beauty case, pullman (51 cms), Express (59 cms), piggyback, express (67 cms), Express (75 cms), Express (77 cms) and vertical express and as seen on page 5 of Annexure A to the list of documents. This range has been introduced in three distinctive colours in a combination of Acrylonitril Butadiene Styrene (ABS) and leather, namely bronze/leather, green/leather and black/leather as seen in page 5 of Annexure A. The trimming consisting of a double band of tan leather goes around the hard case, which has a slightly textured surface. The interior has a double compartment with a polyester lining in green/blue paisley print. The other special features of this range is a suit hanger with 2 hangers, a zippered enclosure for files and papers, two toilet and accessory compartments, and a tie rack. All the aforementioned features are visible at the point of sale to the customers and have therefore registered in the minds of the purchasing public.

The property in the aforementioned distinctive features comprising of the unique colour combination, the textured outer surface cover together with the inner silk lining with a paisley print, of the System-4 Deluxe range, vests with the Ist plaintiffs.

In accordance with the Trademark, Technical Know-how, Patents, Tradename License Agreement between the Ist Plaintiffs and Samsonite NV, and the Ist Plaintiffs and Samsonite Espana, SA (both being subsidiaries of the Ist plaintiff), all rights in respect of new developments and improvements in respect of goods manufactured and sold under the umbrella trademark SAMSONITE, vest with the Ist plaintiffs. The drawings of which the aforesaid travel case is a three dimensional representation, is an original artistic work within the meaning of Section 2(c) of the Copyright Act, 1957. The said artistic work is subject matter of copyright protection in India by virtue of India's membership to the Berne Convention and the Universal Copyright Convention as also the International Copyright Order, 1991.

Thus, the copyright in the artistic work in the drawings of which the aforesaid travel case is a 3-dimensional representation, vests with the Ist plaintiffs. The copy of the blue print drawings of the plaintiffs goods referred to as System- Deluxe Express style in sizes 59 and 67 cms and a copy of the drawing showing the improvements and modifications thereupon is submitted along with the list of documents, and marked Annexure B, B1 an B2 respectively. The plaintiffs also crave leave to refer and rely on the employment agreements of the artists with their respective employers and the take back agreement between the Ist plaintiffs and Samsonite NV and Ist plaintiffs and Samsonite Espana SA."

3. Sales turnover of Samsonite System-4 range sold by the 1st Plaintiff is given in paragraph 26 and it is not necessary to extract them. The System-4 range has also been widely advertised in inflight magazines and other international newspapers and magazines having circulation in India like the Sunday Telegraph Business and the duty free shopping magazine of Khaleej Times. In the year 1994 the first plaintiff had created a website on internet for Samsonite products which is accessible to users of internet in India. On 7.11.1995 there was a product display held by the plaintiffs. The plaintiffs had given advertisement through T.V., press releases and the display was the subject of extensive coverage by the media. In or about February 1996 the second plaintiff imported into India from Belgium the System-4 Deluxe range and other range on travel goods. The second plaintiff had given a caution notice in newspapers against pirated suit cases with colour and features identical and deceptively similar to that of the suit cases of the first plaintiff. Through the Samsonite Industries news letter published by the second plaintiff intended for stockists and dealers put them on notice that the second plaintiff would be introducing in the Indian market a range of suit cases of international standard under the trade mark SAMSONITE. This was in 1995. The factory of the second plaintiff at Nasik is almost complete and the second plaintiff was proposing to commence commercial operations for travel cases and travel accessories under the trade mark SAMSONITE in India by May/June 1997. The second plaintiff is the licensed user of the copyright in the artistic work in the drawings based on which the SAMSONITE System -4 range of travel cases are to be manufactured in or around the 25th January 1997. The second plaintiff came to know about the press release dated 22.1.1997 announcing the launch of range of luggage called Odyssey GLX by the defendants. What the plaintiffs meant is that it was by defendant No. 3. The plaintiffs would state :-

"The representatives of plaintiff no. 2 thereafter purchased a suit case of ODYSSEY 700 GLX series from defendant no. 1 situated in New Delhi on 31.1.1997. These goods were identical if not deceptively similar in all respects to the goods manufactured and/or marketed by the 1st plaintiff or their licensees and soon to be manufactured and/or marketed by the 2nd plaintiff in India. Herewith submitted and marked Annexure K hereto is a photograph of the impugned travel case with a dimension of 67 cms. The aforementioned impugned travel case as seen in Annexure K has a dark green ABS with a trimming of tan leather double band around the case and a slightly textured outer surface. Annexed and marked Annexure K1 and K2 are copies of photographs showing the lateral and vertical view of the impugned goods. The inner Polyester lining has a paisley print of green colour. The inner case has two compartments as seen in Annexure K3 hereto, with a compartment for hanging suits, two compartments for accessories and toiletries, and a tie rack. The impugned travel cases as seen in Annexure K4 consists of a similar travel case manufactured by the 2nd defendants in silver colour and has an inner polyester lining of paisley print in gray colour as seen in Annexure K5. In all other respects it is identical to goods as seen in Annexure K. The defendants have indicated in their price list that the impugned travel cases are also available in dimensions of 51,59,64 and 71 cms. Annexed and marked as K6 hereto is a photograph showing a set of 3 travel cases manufacture, marketed and/or sold by the defendants which are identical to the plaintiffs' set."

According to the plaintiffs "the impugned goods are identical 3-dimensional reproduction of the Ist plaintiffs drawings." The plaintiffs would state that the product display held in November 1995 by the plaintiffs, the Managing Director of the second defendant Company Mr. Sanjeev Aga and the Executive Director of the third defendant Mr. Venkitachalam were present. It is also claimed by the plaintiffs :-

"By reason of the acts of infringements of copyright in the artistic work contained in the drawing of the Ist plaintiff of which drawing the impugned travel case is a three-dimensional representation, the plaintiffs have suffered damages and loss of business and continue to suffer damages and loss of business on account of the continuing acts of infringement of copyright in the artistic work."

4. About the passing off and trade dress the plaintiffs would put their case thus :-

"The plaintiffs submit that the travel cases come in several styles and no two styles of travel cases of various manufacturers are of the same colour, features and size. The mala fide and dishonest intentions of the defendants are evident from the fact they have slavishly adopted all the unique and distinctive features of plaintiffs' travel cases.

The defendants adoption of the unique and distinctive features of the plaintiffs' in respect of the impugned goods is a blatant act of plagiarism. The dishonest and malafide intention of the defendants to pass off their goods or enable others to pass off their goods as and for those of the plaintiffs is apparent from the manner of imitation of the plaintiff's goods in respect of:

- Use of identical pantone specification for colour.
- Identical dimensions of the travel cases.
- Outer surface texture.
- Tan leather trimmings used.
- Identical shade of tan leather used.
- Identical width of the band around the travel case.
- Identical placement of brass holds on the leather bands.
- Identical lock systems used.
- The deceptively similar print of the polyester lining used in the inner compartment.

- The design, layout and construction of the inner compartment.
- Identical handles used.
- Identical material used for the outer casing that is ABS.

It is obvious that the impugned goods are not identical or deceptively similar to the plaintiffs goods by a random or chance occurrence, but has been the outcome of devious scheming and meticulous planning with the ultimate objective of deceiving and misleading the public and customers.

It is therefore obvious that the defendants' are straining their every nerve to ride on the coat-tails of the plaintiffs' reputation. The fact that the plaintiffs are the world leaders whose System-4 range has acquired immense reputation not only the world over but in India as well; the further fact that the Managing Director of the 2nd defendant company, Mr. Sanjeev Aga and Executive Director of the 3rd defendant company Mr. Venkitachalam were present at the plaintiffs product display even in November, 1995 and were fully aware that the said product of the plaintiff, namely the System-4 range was going to be launched in the market by the joint venture company, plaintiff no. 2 and the fact that the defendants have copied the said System-4 range travel case in such uncanny details including colour scheme, size, shape and even external and internal textures and designs only with a view to pre-empting the plaintiffs product and to pass off their product as the well-known SAMSONITE System-4 goods shows their clearly dishonest state of mind.

Passing off of the defendants goods as those of the plaintiffs is inevitable in the present case for the following reasons:

The impugned travel case of the defendants is identical to the travel case of the plaintiffs in respect of colour combination, surface texture, outer accessory features, layout of the internal compartment, inner polyester lining and the special features contained within the travel case.

The impugned travel case appears as if it were a part of the set which is available internationally in the System-4 Deluxe range and is likely to pass off as one.

The trade channels and the trade outlets for both the goods are the same or are likely to be the same.

The defendants and the plaintiffs are trying to attract the same class of customers that is potential purchasers of up market goods, who travel extensively and are therefore likely to be aware of the plaintiffs products, and when they see the defendant's impugned travel case they will assume that the defendants goods are the goods of the plaintiffs, or that the defendants have some type of collaboration with

the plaintiffs or that defendants have manufactured the impugned travel case under license from the plaintiffs.

The features of the System-4 Deluxe range has been conceived, developed, adopted by the plaintiffs by themselves or through their subsidiaries or licensees and the plaintiffs who are the proprietors in the aesthetic appearance and other functional features of the travel case have been using the said features, openly and unchallenged by any quarter since 1993, and if any one saw an identical travel case, they would attribute its origin to the plaintiffs.

The goods of the plaintiffs are well known and have tremendous visibility because of its wide use by travellers, the prominent window and shop floor display in well known department stores in many parts of the world, the photographs and pictures in their catalogs and shop catalogs and the attention catching advertisement over television. The aesthetic appearance of the plaintiffs goods itself has become so distinctive with use and are associated exclusively with the plaintiffs, that the purchasing public are likely to associate the defendant's impugned travel cases with the plaintiffs.

The plaintiffs goods have had good visibility in India through print media and electronic media, i.e. through the Samsonite website on the internet and through actual usage of the plaintiffs products in India by the frequent Indian traveller, the foreign tourists and visitors, representatives in the embassies and consulates, airlines crew or the business executives. The plaintiff crave leave to refer and rely on the affidavits of Indian users of Samsonite products. Hence when any customer or user sees an identical travel case, they are likely to assume that the impugned travel cases originate from the plaintiffs or are manufactured in collaboration with the plaintiffs or are in some way connected to the plaintiffs.

The defendants have priced their suite cases in the range of Rs.3950/- to Rs.6950/-, which is substantially similar to the price at which the plaintiffs propose to introduce their products in India, and therefore it appears as if the defendants are attempting to pass off their inferior goods as and for the superior high quality goods of the plaintiffs, and simultaneously make illegal gain by trading on the reputation of the plaintiffs.

The inferior goods with an identical design will be associated by the members of the public with the plaintiffs and will not only damage the 2nd plaintiffs business at its natal stage, but also tarnish the global image of the 1st plaintiffs. The use of an identical or deceptively similar trade dress by the defendant would not only lead to passing off due to the likely confusion and deception of consumers but would erode distinctiveness of the plaintiffs trade dress diluting the same beyond repair.

Further the purchasing public and members of the trade are already anticipating the plaintiffs goods in the market because of the ground work and prior publicity that has been given by the plaintiffs in respect of the products, and therefore there is every likelihood of the impugned goods being mistaken for the original standard goods of the plaintiffs.

The defendants by manufacturing, marketing and/or selling the impugned travel cases have caused or attempted to cause confusion and deception in the minds of the purchasing public leading them to believe that the impugned goods are the goods of the 1st plaintiff or that the defendants have some type of collaborations, association or connection with the plaintiff for the manufacturer of the impugned goods."

5. The plaintiffs would plead, with reference to the case of copyright, in the following terms :-

"The 2nd defendants have wrongfully, illegally and dishonestly three dimensionally reproduced the drawing of the 1st plaintiffs. Further this reproduction by the defendants is unauthorized and without license or permission from the 1st plaintiffs, thus infringing the 1st plaintiffs copyright therein. Thus the 1st and 2nd defendants have infringed the copyright that the 1st plaintiffs have in the artistic work in the drawing of which the impugned travel cases are 3-dimensional representations. The 3rd defendants have aided and abetted the 1st and 2nd defendants in infringing the copyright of the 1st plaintiff."

The plaintiffs would assert that they have got markets all over the world and that is being sought to be exploited by the defendants. The plaintiffs would state:-

"The plaintiffs state that their goods are always marketed as a set, and sold as a set or as individual pieces. The impugned travel case is identical if not deceptively similar to the goods of the plaintiffs under the SYSTEM-4 range and to the customer it would appear as if the impugned travel case were a part of the SYSTEM-4 range of the 1st plaintiffs, currently being sold world wide including countries like the U.K. Germany, France, Italy, Switzerland, Singapore, Hongkong, U.A.E, Bahrain, Thailand, Australia etc. and soon to be manufactured and sold in India by the 2nd plaintiffs under license from the 1st plaintiffs."

It is stated by the plaintiffs that the price stipulated by the defendants for the travel cases would be in the range of Rs. 3,950/- to Rs. 6,950/- and the plaintiffs' price range also is substantially similar. The plaintiffs would state :-

"The defendants with the obvious aim, object and purpose of misleading and deceiving the public and trading on the tremendous reputation and popularity of the said goods of the 1st plaintiff and with the intention of making dishonest gains at the cost of the 1st plaintiff, have intentionally, fraudulently and dishonestly adopted the distinctive features conceived, developed and manufactured by the 1st plaintiff

and/or heir subsidiaries and/or their licensees, the proprietary right in respect of which by written agreement vests with the Ist plaintiffs."

6. The plaintiffs pray for the following reliefs:-

"a) the Defendants by themselves, their servants, agents, stockists and distributors or otherwise be restrained by a perpetual order of injunction by this Hon'ble Court from in any manner manufacturing, marketing and selling travel cases thereby infringing the plaintiffs' copyrights comprised in the original artistic work as represented in the drawings as seen in Annexure B, B1 and B2 to the documents list or any three-dimensional representation of the two dimensional drawing as seen in Annexure B, B1 and B2 to the list of documents or making any other 3-dimensional representation from a similar drawing which results in a reproduction or substantial reproduction or a colourable imitation of the plaintiffs goods as seen in Annexure A and J to J5 hereto.

b) The defendants by themselves, their servants, agents, stockists, and distributors, or otherwise however be restrained by a perpetual order and injunction of this Hon'ble Court from in any manner using in respect of travel cases of any type the impugned features, as seen in Annexure K to K7 hereto or any other features which may be deceptively similar to the plaintiffs features as seen in Annexure A and Annexure J to J5 to the list of documents so as to pass off and/or enable others to pass off the defendants goods as and for the plaintiffs goods.

c) That the defendants be ordered and decreed to render a true and faithful account of all the profits earned by the defendants by using the impugned design as shown in Annexure J to J5 and the defendants be further ordered and decreed to pay to the plaintiffs such amount as may be found due on such accounts being taken.

d) That the defendants be ordered and decreed to forthwith deliver up to the plaintiffs for destruction the entire stock of the impugned travel cases as seen in Exhibit K to K5 together with pamphlets brochures, labels, dyes, blocks and other printed material bearing any artistic, photographic or pictorial representation thereof.

e) The defendants be ordered to pay plaintiffs the costs of this suit."

7. The plaint was presented on the 19th of February 1997.

8. On 29.3.1997 defendants 2 and 3 filed the written statements. The case of these defendants could be stated in the following terms.

The plaintiffs are guilty of making misrepresentations and they have made allegations which are false to the knowledge of the plaintiffs and on that ground alone the plaintiffs' case should be

rejected. The plaintiffs have made an attempt to cause inroads into the export market by defendants 2 and 3. The second defendant Blow Plast Ltd. is an associated Company of the third defendant. The second defendant is engaged in distributing and selling wide range of products manufactured by reputed Companies like the third defendant, Mattel Toys (India) Ltd. (a joint venture with M/s Mattel Inc. of USA), and Kemp & Company Ltd. The second defendant Blow Plast Ltd. has emerged as one of India's the most respected marketing Companies. The reputation and goodwill enjoyed by the second defendant is based on the brands promoted by it, VIP, Skybags, Odyssey, Elanza, Leo-Mattel, Barbie, Modern-Klober, Element etc. The second defendant has got more than 30 branches and the net work of nearly 10,000 dealers. The second defendant has made sales to the tune of Rs.253.95 crores during the year 1995-96 and had spent Rs. 10.54 crores on advertisements. In paragraph 9, the defendants had referred to the VIP Industries Ltd. in the following terms :-

"(a) History and achievements of VIPIL VIPIL is the world's second largest manufacturer of quality luggage in terms of total number of luggage pieces manufactured.

Cumulative luggage sales till date - over 40 Million pieces.

VIPIL is a Government of India recognised export house because of its export performance over the last many years.

VIPIL is an ISO 9001 and 9002 certified company (with each of its 4 manufacturing units independently certified). Perhaps the only luggage company in the world to have gained this distinction.

VIPIL's Research and Development centre is officially recognised by the Government of India as an approved R & D Centre.

VIPIL holds a number of design registrations and product and feature patents in India and abroad (including first world nations of Europe and America).

True and correct copies of the relevant approvals and authorisations referred to above are being filed as Document-3 (collectively) to the list of documents and the defendants crave leave of this Hon'ble Court to refer to and rely upon the same.

(b) Because of its innovative products and strong marketing strategy, VIPIL has made a strong impression in the international markets so much so that the world's top luggage companies including Samsonite USA's subsidiary - Samsonite Espana, have been keen to market the products of VIPIL in their respective home markets under their own trade marks. The following are some examples of internationally well known companies who are currently marketing the products of VIPIL:

UK - Equator Group plc (now called Greenwich Group plc)(one of Britain's larest luggage companies).

France - GYL Baggages (The second largest luggage company in France after Delsey).

USA - Skyway Luggage Company (Amongst USA's largest luggage companies).

Spain - Rodamilans s.a. (amongst Spain's largest luggage companies).

Other international companies who have shown interest in marketing the products of VIPIL are :

France-Delsey (ranks among the world's top three luggage companies).

UK - Antler (Brittain's most well known soft luggage company).

And most tellingly Samsonite USA's subsidiary - Samsonite Espana had expressed a desire to market the VIPIL's products in Spain (It may be noted that the System 4 Deluxe (referred to herein for the sake of clarity also as Samsonite product) - being the subject matter of the suit, is alleged to have originated at this subsidiary).

True and correct copies of the correspondence received from the aforesaid companies are being filed by the defendants as document-4 (collectively) to the list of documents and the defendants crave leave of this Hon'ble Court to refer to and rely upon the same.

(c) VIP trademark.

Since 1971, VIPIL and its predecessors in business have used the trade mark "VIP" on and in relation to its products. The trade mark "VIP" has since become synonymous with quality luggage in India and abroad. Some of relevant facts and figures concerning the "VIP" brand are:

"VIP" brand has 68% market share of the Indian organized sector luggage market.

"VIP" has been ranked by an independent survey by a respected industry journal as the 8th strongest brand across categories, in India in the highest income slab of over Rs. 4000 per month.

"VIP" enjoys nearly 100% awareness in house-holds with income over Rs.4,000/- and over 70% awareness across income segments in the entire country.

Nearly Rs. 70 crores has been invested in advertising and promotion of the "VIP" brand.

Sales of the "VIP" brand have exceeded Rs. 500 crores over the last three years.

True and correct copies of the relevant supporting documents are being filed as Document-5 (collectively) to the list of documents and the Defendants crave leave of this Hon'ble Court to refer to and rely upon the same. As this Hon'ble Court will note, the said document, amongst other things, features one write-up in a respected business magazine datelined Oct.1991, described in the evolution of the VIPIL products including the launch of the "VIP" branded products in 1971."

In paragraph 10 the defendants have given their version of the plaintiffs' case :-

"The plaintiffs appear to have set up their case on two prongs:

(a) VIPIL's product is a three dimensional representation of drawings, annexed at Annexures "B" "B1" and "B2" to the Application. These drawings constitute an "original artistic work" within the meaning of the Copyright Act. The disputed suitcases are an identical 3 dimensional reproduction of these drawings. VIPIL have therefore infringed the copyright in the said drawings, and/or

(b) The plaintiffs' product - System 4 Deluxe (herein referred to also as "Samsonite's product") contains certain features and VIPIL have slavishly copied, adopted and imitated such features and VIPIL have done so with a view to pass off, and are in fact passing off the disputed products as and for the products of the plaintiffs.

It is respectfully stated that the case put up by the plaintiffs as above is without any factual and legal foundation. Neither in law nor in facts, the plaintiffs can claim any exclusively in the features they claim as proprietary to them. The features claimed are in the public domain and are available for adoption and use not only by VIPIL but also by other manufacturers. The plaintiffs have no right to claim monopoly over these features or any of them."

In paragraph 11, the case of the plaintiffs on infringement of copyright is adumbrated:-

(A) The plaintiffs have in support of their case of that :

a) The drawings appearing at Annexures B, B1 and B2 were prepared by certain employees of certain subsidiaries of Samsonite USA;

b) Copyright in the works originated by such employees vests in such subsidiaries by virtue of employment agreement with the concerned employees;

c) Under a certain "take back agreement" (whatever that expression been vested in Samsonite USA.

d) The said drawings are "original artistic works" within the meaning of Section 2(c) of the Copyright Act, 1957 and are subject to protection in India by virtue of India's Membership of the Berne Convention and the Universal Copyright Convention as

also the International Copyright Order, 1991;

e) Lastly, that the subject products manufactured and sold by the Defendants are an identical 3 dimensional reproduction of the said drawings and thereby the Defendants are infringing Samsonite USA's copyright in such drawings.

(B) The defendants states that the claim of copyright and its purported infringement set up by Samsonite USA is invalid in law for, inter-alia, the following reasons:-

a) The features which are claimed as proprietary by Samsonite USA and being sought to be protected under "copyright" are all features of shape and configuration which are aesthetic, ornamental and visual in nature and appeal to the eye only. Statutory protection in such features, if novelty exists herein, can be claimed only under the provisions of the Designs Act, 1911 by obtaining registration thereunder. No such design registration is claimed by the plaintiffs.

b) It is submitted that in terms of Section 15(1) of the Copyright Act there is no copyright under the Act in any design which is registered under the Design Act, 1991. Further, under Section 15(2) of the Act the copyright in any design which is capable of being so registered but has not been registered ceases as soon as any article to which the design has been applied has been reproduced more than 50 times by an industrial process by the copyright owner or with his licence. The features as claimed in the drawings at Annexures B, B1 and B2 are those of shape, configuration, embellishment and ornamental - all being aesthetic and visual features registrable under the Designs Act and the said drawings were prepared with the intention of industrial reproduction. The plaintiffs have themselves asserted that Samsonite USA and its subsidiaries have made many hundreds of thousands of System 4 and System 4 Deluxe products which are reproductions of the designs contained in the drawings/sketch at Annexures B, B1 and B2. The industrial application of that design to such a large number of products brings Section 15(2) of the Act into operation and causes the copyright, if any, in the designs to cease and the plaintiffs forfeit their rights, if any, as the subject matter falls into public domain and any other person is entitled to use or utilise such design/features without restriction.

c) VIPIL's product, as will be shown hereafter, is based on its Classic range of products which was first manufactured in 1971. True and correct copy of the document tracing the design origin of the 1971 Classic on which the current product in question is modelled is being filed as Document-6A to the list of documents and the defendants crave leave of this Hon'ble Court to refer to and rely upon the same. Also being filed as Document 6B to the list of documents are photocopies of a few advertisements and colour photocopies of the Classic product as illustrated in Blow Plast's Annual Reports going back to 1976 in respect of the 1971 Classic product.

d) In any event, VIPIL's product is not a three dimensional reproduction or substantial reproduction of the two dimensional drawings at Annexures B and/or B1. An overlay comparison of equivalent drawings of the VIPIL products with the drawings of Annexures B and/or B1, shows that the drawings of VIPIL's product are different from the drawings at Annexures B and B1 to the Application. Copies of such "overlay" drawings have been filed in these proceedings.

e) Without prejudice to the above, it is denied that the alleged authors of the said drawings have actually assigned the purported copyright in favour of Samsonite NV, Belgium and Samsonite Espana SA, Spain respectively or that under the purported "take back agreements" (whatever that expression might mean) the said two subsidiaries have assigned the said copyright to Samsonite USA. Samsonite USA is put to strict proof of showing that any copyright vests in respect of the drawings in Samsonite USA.

f) Further, the said drawings lack "originality" in that the so-called drawings at Annexures "B" and "B1" merely show the outline of a standard type of shell as used in ABS and other cases for many years prior to 1986 and the sketch at Annexure "B2" represents conventional features of luggage available prior to 1986.

g) Further, the drawings are incomplete and devoid of details. The drawings at Annexures B and B1 are incomplete. In the first instance, the said drawings only give a description of what appear to be body shells of a suitcase.

The said drawings are totally devoid of details of several vital design parameters. Some of these are:-

The said drawing do not define the dimensions even of the said shells.

The said drawings are completely silent on the zones of transition between the region of one radii value to another in different planes.

The said drawings do not give cross sectional views at different parts of the body shell.

The said drawings are also incomplete on various parameters. The drawings at B and B1 do not show:

The frame, The wheels/wheeling area, The hinges, The pulling arrangement, The body shell texture, The interior organisation and The handle and handle lugs.

In the absence of the aforesaid additional details and design parameters, neither of the two drawings at B and B1, is capable of being rendered into a specific or unique 3 dimensional object which can be said to be a reproduction or substantial reproduction of such drawings. An affidavit from an expert in the design field is being filed as Document-7 (collectively) to the list of documents and the Defendants crave

leave of this Hon'ble Court to refer to and rely upon the same. As this Hon'ble Court will note from the said affidavit, the drawings relied upon by the plaintiffs in their plaint and interim injunction application are concluded to be insufficient and devoid of material details for purposes of arriving at the three dimensional reproduction corresponding to the plaintiffs' System 4 Deluxe product.

h) Even otherwise, Samsonite USA does not have an enforceable claim because at the relevant time when the drawings in question were made in 1986, USA was a member only of the Universal Copyright Convention. USA formally ratified the Berne Convention only in 1989. As the drawings relied upon by Samsonite do not fulfill the copyright notice requirements of the U, no enforceable copyright subsists therein.

i) Specifically, the drawing at Annexure B2 is a rough and crude sketch which is neither dimensioned nor accurately drawn. It is more an indication of the location and general nature of the features which are to be used than an attempt to reproduce them with any accuracy. It is clear from the text on the sketch that it is the same as the basic System 4 range of Samsonite USA and that all it seeks to do is to simply identify the areas of the trims to be upgraded. In other words, it is artistically unoriginal in the light of the pre-existing basic System 4 suitcase design from which it is directly derived. Its originality, if any, must reside in the descriptive material surrounding the sketch. As such matters cannot confer originality upon an artistic work, no claim of copyright infringement can be founded thereupon. The sketch at Annexure B2 at best may convey an idea. Thus, the sketch at Annexure B2 cannot support the degree of detail which would be required to establish that, in that respect, VIPIIL had taken the artist's work from that drawing. Without prejudice, it is submitted that the drawing itself is indistinguishable from the many similar suitcases which were on the market long before it was made.

j) The whole case of the plaintiffs is based on the look, shape and configuration of the product and certain embellishments and ornamental features none of which can be the subject matter of copyright as claimed by the plaintiffs. Samsonite USA has obtained design registrations in the past in India and elsewhere abroad in respect of features and configurations (in respect of other products) of the kind and character as are involved in the instant suit. True and correct copies of the certified extracts for use in legal proceedings in respect of the relevant design registrations obtained by Samsonite USA in India and extracts of its U.K. Design/Patent registrations/applications are being filed as Document-8 (collectively) to the list of documents and the defendants crave leave of this Hon'ble Court to refer to and rely upon the same.

k) Having failed and/or neglected to obtain design protection, the plaintiffs are seeking to legitimise their claim by relying upon a non-existent copyright. Their claim of monopoly in a specific type of intellectual property is different in substance and form from what would otherwise be available to them in their private domain,

that is, a specific design registration, if novelty in their claimed features had existed.

The case relating to passing off by the plaintiffs is set out in paragraph 12 in the following terms :-

The claims of the plaintiffs that the defendants have attempted to pass off and/or are in fact passing off their products as the products of the plaintiffs will now be dealt with. It is submitted that to succeed in their claim of passing off, the plaintiffs must establish that:

- a) that the features of get up upon which they rely are proprietary to them - that is - these have become exclusively and solely identified with and distinctive of their products.
- b) that the persons wishing to buy the aforesaid products of the plaintiffs are likely to be misled and deceived into buying the products of the defendants; and
- c) that the plaintiffs' are likely to suffer damage thereby.

It is respectfully submitted that the plaintiffs have failed to substantiate any of the aforesaid.

In paragraph 13 the defendants have dealt with the plaintiffs' claim of distinctiveness of features\appearance\get up in the following terms:-

- a) VIPIL states that the plaintiffs do not have proprietary and exclusive rights to the appearance, features and get up of the System 4Deluxe range of products. Whilst it is asserted in the application that the appearance of the System 4Deluxe range of suitcases is distinctive of the plaintiffs, there is in fact not a shred of evidence from which it is possible to infer that that range of products is identified by members of the public as being a product of the plaintiffs by its appearance alone.
- b) Specially, no prima facie evidence has been filed which suggests that the so called distinctive features claimed by the plaintiffs are associated by the public or any member of the public in India (or even elsewhere overseas) solely and exclusively with the plaintiffs.
- c) Furthermore, there is no allegation at all that the plaintiffs have sold and promoted the System 4deluxe range of luggage in India to anything like the extent which would be required to have caused the appearance of that range to become distinctive of the plaintiffs. Even elsewhere in the world, System 4Deluxe is just one of a large number of ranges of luggage marketed by the plaintiffs, the appearance of which varies widely. It is not the case of the plaintiffs that they have been manufacturing only one type or design of luggage, namely, System 4Deluxe for a long length of time and that the same has, therefore, become distinctive of them.

d) On the other hand, there is admission by the plaintiffs that the Samsonite product is not available in India. Luggage products cannot be imported into India. Local manufacturing of any "Samsonite" branded products has not commenced. The various agreements relied upon by Samsonite USA such as the joint venture agreement with the 2nd plaintiff are all in relation to their proposed activities in India. In other words, the plaintiffs products do not enjoy any reputation in India (or even overseas) of the sort alleged.

e) Furthermore, the plaintiffs have themselves admitted that until now they have imported into India only 7 (seven) pieces of the System 4 Deluxe and sold the same to one individual (the credibility of this sale is questionable as detailed hereinafter). This level of sale is wholly inadequate to support the allegation that the impugned features are exclusively and solely associated by the Indian consuming public with Samsonite USA. The evidence of imports of Samsonite product into India at Annexures F, F1, F2 and G is tainted by misrepresentations and irregularity in import and customs procedures. VIPIIL says and submits that submissions in this behalf will be made at the time of hearing by reference to the documents filed by the plaintiffs themselves."

Deception and likelihood of deception, as contended by the plaintiffs, is dealt with in paragraph 14 in the following terms :-

"a) VIPIIL says and submits that there has neither been any deception nor is there likelihood of any deception of the consuming public as alleged by the plaintiffs or otherwise. VIPIIL has not been party to any deception as alleged as VIPIIL has designed its products by its own efforts and by utilising information available in the public domain, which cannot be claimed to be proprietary to Samsonite USA.

b) The plaintiffs' own pleadings and supporting affidavits clearly state that the primary and most important source of the plaintiff's recognition by the public is the brand name "Samsonite". It is clear from the said pleadings and affidavits that the "Samsonite" name is said to have been used on their wide range of travel goods and styles of luggage as illustrated in their own catalogue. It is clear from these pleadings and the catalogue that the only unifying feature which links them together and identifies them as having a common trade source is the brand name "Samsonite". Similarly, VIPIIL's products are also recognised by the brand name "VIP".

c) Any likelihood of deception and any suggestion that VIPIIL are attempting to pass off their products as those of Samsonite USA can be dispelled by the fact that VIPIIL's product prominently mentions the brand name "VIP" on at least seven and as many as eight locations as follows :

First of all, at the time of retail, the said product is enclosed and sold in a sealed plastic bag which carries the inscription "VIP" in large Red letters. This prominent "VIP" branding is unmistakable even from a distance of 10 meters.

The front channel under the handle, has prominent "VIP ODYSSEY" branding, The hand tag on the handle carries "VIP ODYSSEY GLX" branding, The Guarantee card inside the bag (which has to be signed and stamped by the dealer at the time of purchase and which contains lock operating instructions which every customer has to go through), has multiple "VIP" and "ODYSSEY" branding (on every page).

The address tag on the side of the sectional frame carries "VIP" branding.

The keys have "VIP" inscribed on them.

The key chain has "VIP" and "ODYSSEY" branding.

The wheel cap in the larger sizes also has "VIP" branding. VIPIL's products are therefore projecting the "VIP" brand to its fullest. Any person who handles the said product or even notices the said product cannot but fail to observe the emphasis on "VIP".

d) Given the prominence, which it is plain from their evidence, that the plaintiffs give to their brand name "Samsonite" in the course of trade, it is difficult to see how any member of the discerning public, who is likely to buy such products could regard a product which did not bear that name as being a "Samsonite" product. To do so, he or she would have to have been wholly unaware of or unaffected by the extensive advertising and promotion of the "Samsonite" brand or the "VIP" brand. Such is obviously not the case. A product is only a "Samsonite" product if it bears the "Samsonite" name and that fact has been repeatedly drummed into the public by the plaintiffs themselves.

e) VIPIL's brand name "VIP" enjoys an unparalleled brand equity in the Indian market. In the class of customers who are likely to purchase luggage products of the kind that are relevant for these proceedings, VIPIL's "VIP" brand name is almost universally known and recognised. In this connection, VIPIL craves leave of the Court to refer to and rely upon the popularity of "VIP" brand as set out in the preceding paragraphs. In contrast, the brand appeal of the plaintiffs' products is comparatively non-existent. Few persons are aware of the plaintiffs' brand name in India. Consequently there is no gain for VIPIL to pass off their products as that of the plaintiffs.

f) In as much as VIPIL's "VIP" brand name enjoys universal recognition and appeal, the products manufactured by VIPIL are immediately recognised as products emanating from VIPIL. There is therefore no likelihood of any confusion of the said products emanating from the plaintiffs. Any purchaser of the said products will therefore immediately identify the said products as being the said products of VIPIL and not associate the same with the relative unknown entity in India such as the plaintiffs.

g) Samsonite USA's and VIPIL's products are admittedly purchased by extremely discerning customers within a high income group. The plaintiffs have themselves contended that the said class of customers include people who travel abroad frequently and are necessarily members of the public who are highly literate, educated and aware. This section of buyers is therefore not prone to buy suitcase as expensive as the products of the plaintiffs and the defendants without making sufficient enquiry. The said section of customers is not gullible and/or unaware and knows fully well the brand which they are purchasing. This section of customers is therefore not likely to be misled into believing that the defendants' products emanate from the plaintiffs stable as sought to be alleged. This likelihood of deception is seen less, considering the enormous brand popularity that VIPIL's products enjoy.

h) Samsonite USA and VIPIL are both seeking to manufacture and sell suitcase in a high priced range. Persons who spend thousands of rupees on the said suitcase do not buy suitcase from shops on the basis of their physical similarity. In fact, the said suitcases are purchased primarily on the basis of the brand name and brand popularity, which criteria prevail over all other criteria in the minds of the buyer. A person purchasing either Samsonite USA or VIPIL's products therefore purchases the said product because it bears a certain brand name and not because he has seen a similar looking product. Consequently, the likelihood of deception between Samsonite USA and VIPIL's products is negligible. A few affidavits from retailers and customers of luggage are being filed as Document 9(collectively) to the list of documents and the Defendants crave leave of this Hon'ble Court to refer to and rely upon the same.

i) Samsonite USA have themselves contended that their brand has a huge popularity in India. It cannot be denied that VIPIL's products enjoy much greater popularity in India. A purchaser of the said product can therefore easily discern the products of Samsonite USA from those of VIPIL.

j) Samsonite USA and VIPIL have in the recent past been extensively and repeatedly featured as rivals in the Indian national press, and magazines and even in TV channels like BBC and ABNI. Consequently every bag purchaser in the range and class of the disputed product is aware of the rivalry between Samsonite USA and VIPIL. It would not be an exaggeration to state that the said rivalry is very akin to the Coke-Pepsi rivalry or the Surf-Ariel rivalry. Consequently the prospective suitcase purchasers of the GLX range are likely to have already heard of the said rivalry and are aware of the fact of the existence of these two competing brands and products. It would be ridiculous to suggest that such a purchaser is likely to be deceived into believing that VIPIL's products emanated from Samsonite USA's stable or that VIPIL's products are associated with Samsonite USA.

True and correct copies of the extracts from the relevant newspaper articles in support of the above are being filed as Document-10 to the list of documents and the defendants crave leave of this

Hon'ble Court to refer to and rely upon the same.

k) The defendants have also widely advertised the fact that the VIP Odyssey GLX is a new product offering from them. They have held retailer conferences in sixteen major cities of the country to exhibit and launch this product. This product has also been displayed prominently in two locations at the Bombay airport. The mass media comprising of various magazines and newspapers have also widely covered this new product launch from VIPIL. Wide spread mass media advertising was also planned but was abandoned consequent upon the ex-parte injunction issued by this Hon'ble Court. True and correct copies of the extracts from the relevant newspaper articles together with a few true and correct photographs in support of the above are being filed as Document-11 (collectively) to the list of documents and the defendants crave leave of this Hon'ble Court to refer to and rely upon the same.

l) The plaintiffs have not placed a shred of evidence that any deception has taken place in the Indian market with respect to their products. VIPIL states that there cannot be a case of any deception given the prominence of VIPIL's "VIP" brand in India. Confronted with the inherent unsustainability of their claim, it appears that the plaintiffs have been engaged, post filing of these proceedings, in the exercise of creating evidence by way of a contrived market survey.

m) Striking Visual Differences Quite apart from the clear and obvious packaging and branding differences between the products, there are many significant design differences between the products which are obvious to the naked eye. Samsonite USA has chosen to remain silent about these difference for reasons not far to seek. Any consumer with ordinary observation faculties would note on a cursory examination that the Samsonite product is different from the VIPIL product, inter alia, in respect of the following major features:

i. Wheeling mechanism:

(a) Samsonite's product has wheels on all the sizes above the 59 cm size. While the VIPIL product has Wheeling only on the largest two sizes starting from size 700.

(b) Samsonite's product has a wheeling system comprising 4 similar looking small wheels. While the VIPIL product employs a completely different wheeling mechanism with two large and two small wheels.

(c) Visually the wheels are almost invisible in the Samsonite product while they are clearly visible in the VIPIL products.

(d) The wheels used by the VIPIL products have prominent VIP branding on them while those used by the Samsonite products have no branding.

ii. Pulling Mechanism

(a) The VIPIL product has a dual pulling mechanism in the two largest sizes (700 and 950) while the Samsonite product has single retractable pulling mechanism.

(b) The VIPIL product employs pulling handles which are either covered by leather or which are constructed fully of leather while the Samsonite product uses a plastic moulded handle. These two types of handles are thus completely different aesthetically and functionally.

(c) The pulling handles used by the VIPIL product are visually overt while those used by the Samsonite product blend into the frame.

iii. Frames

(a) VIPIL uses the same wide frame (which accommodates a 22 mm band around the suitcase) on all the four sizes of its products while Samsonite USA uses at least two different sizes of frames. On its smaller sizes a frame that accommodate a 9mm band around the suitcase is used while on the larger sizes a frame that accommodates a 19 mm band around the suitcase is used.

iv. Handles

(a) The main carrying handle used by VIPIL is its old design introduced in 1986 (which also has been design registered in India in 1986 and hence belongs exclusively to VIPIL in India).

(b) The handle is quite chunky in appearance. On the other hand, the handle of the Samsonite product is quite slim and has a different contour. Visually, these two handles are distinct.

(c) As detailed hereinafter, the soft grip mechanism used in the handle for the Odyssey GLX is similar to a soft grip mechanism registered as a patent in India under the Indian Letters Patent No. 163876 dated November 10, 1986.

v. Shell design

(a) The shell design and graphics are quite distinct in the two products of VIPIL and Samsonite USA. The Samsonite product has a clear droop in the front and which is absent in the VIPIL product.

(b) The VIPIL product has a distinct line running across the bottom which is absent in the Samsonite product. This graphic line is one of the defining features of the VIPIL product's shell design.

True and correct photographs of the Samsonite System 4Deluxe product and the VIPIL product, with tabulated details of the glaring differences between the two, are being filed in support of the above as Document-12 (collectively) to the list of documents and the defendants crave leave of this Hon'ble Court to refer to and rely upon the same.

There are only a few of the many glaring differences between these products. Many of other differences are dealt with in the following sections."

The defendants would dispute the claim for damages made by the plaintiffs. The defendants in paragraph 18 of the written statement had completely traversed the case of the plaintiffs. The defendants had disputed that the System 4 Range was developed by two Belgians, as claimed by the plaintiffs. The defendants would also deny that System 4 Deluxe Range was created by Mr. Nikolaus Muller, and was introduced by the first plaintiff in 1993. All the allegations made by the plaintiffs are denied by the defendants. The defendants would deny that the drawings claimed to be a three dimensional reproduction are "original artistic work" within the meaning of Copyright Act, 1957 or subject matter of copyright protection in India. It is not necessary to deal with each and one of the averments in the written statement in detail. About the relationship between the first plaintiff and the defendants 2 and 3, these defendants would state:-

"With reference to paragraph 39 of the said plaint, it is respectfully submitted that the allegations in the said paragraph are in poor taste and have no bearing whatsoever on the controversy in issue. It is, however, submitted that the plaintiffs have suppressed the fact that the Managing Director of the 2nd Defendants and Executive Director of the 3rd Defendant were present at the said meeting pursuant to an express invitation extended to them by the plaintiffs. It is submitted that despite the fact that the 2nd plaintiffs were going to be rival manufacturers, the representatives of the 2nd and 3rd Defendants had the good grace and courtesy to accept the invitation extended to them by the 2nd plaintiffs. In fact, the 2nd plaintiff's Managing Director Mr. Ramesh Tainwala has himself visited the premises of the 3rd Defendant on several occasions and sought assistance and co-operation of the 3rd Defendant in connection with their manufacturing activities. The Defendants have always extended to the Plaintiffs their wholehearted support. The fact that the Plaintiffs have now turned around and misused this basic act of courtesy and good grace and sought to suggest that the said persons attended the said meeting for purposes to akin to espionage and have sought to take undue advantage of the products exhibited by the Plaintiffs, is in extremely bad taste. The same does not merit any response. In any event, the defendants submit that the allegations in the said paragraph are totally meaningless."

10. On 19.4.1997 the plaintiffs filed the replication to the written statement filed by defendants 2 and 3. The plaintiffs would state that they have been exploring the possibility of entering into the India market in 1978. Mr. Dilip Perimal, the Chairman of the second defendant and third defendant Company at the relevant time approached the first plaintiff for a joint venture. Mr. Dilip Perimal acknowledged that the first plaintiff was a leading manufacturer of the luggage in the world and the second and the third defendants were market leaders in the same business in India and their cooperation in the business yielded rich dividends. In or about July 1982 the officials of the second and the third defendant visited Denmark to finalise the proposals. The third defendant made an application to the Govt. of India for foreign collaboration in October 1982. The third defendant obtained the copies of the copyrights of the first plaintiff and identified the range of the luggage. In

January 1985 the third defendant Company informed the first plaintiff that it was no longer interested in the joint venture. After introducing this case, the plaintiffs have denied the averments in the written statement. About the trade dress, the plaintiffs would state that certain features are non-functional.

"The trade dress which is comprised of the following features are purely aesthetic and non-functional, namely:

- i. The colour scheme of a dark metallic green colour & the tan leather.
- ii. bands and golden accessories;
- iii. The geometric graining which is the textured outer surface;
- iv. The use of leather bands to cover the channels and rivets;
- v. The use and placement of brass rivets on the leather band;
- vi. Gold plated locks.

These features are external, aesthetic, non-functional and hence constitute a protectable trade dress of the product as they are distinctive and are recognized or likely to be recognized by the purchasing public and the trade."

According to the plaintiffs, certain features are protected by copyright. What is stated is:-

"Where there is a copyright in the drawing of any article, copying of the article made in accordance with that drawing is indirect copying of the drawing constituting an infringement of Copyright."

The plaintiffs have disputed the affidavit filed by an expert in the field of designs on behalf of the defendants.

11. It is asserted by the plaintiffs :-

"a. The plaintiffs state the combination of features of the getup relied upon by the Plaintiffs in respect of the said product are not generic, but are inherently distinctive of the Plaintiffs products, and are associated exclusively and solely with the Plaintiffs. In addition by way of extensive circulation of the products among the relevant class of customers, namely a frequent traveller in any one or more of the following ways namely:

- by way of direct personal use

- by way of seeing the use of the said product by friends and family
- by way of seeing the product used by other travellers at airports,
- by way of watching the luggage as it comes down the conveyer belt while waiting for luggage
- by way of seeing them on display at departmental stores, during the course of travel
- by way of seeing the pictures of the same in catalogs, brochures and inflight magazines the above trade dress of the said goods have come to be associated exclusively with the plaintiffs."

The plaintiffs would state that the said products of the plaintiffs have become distinctive of the plaintiffs in India as else where by virtue of :-

"i. transborder reputation, ii. extensive visibility of the product both by way of use in India and abroad, iii. stocking of the Plaintiffs products by some luggage dealers for second sale of the product on behalf of airlines crew, sailors and other travellers.

iv. by way of advertisements in international and inflight magazines and duty free shopping catalogs, v. by way of the widely publicized product launch event in 1995, vi. by way of Newsletter and trade notices.

Thus the said products of the plaintiffs enjoy reputation and product presence in India even though commercial operations may not have begun in India by the plaintiffs."

The travel cases are usually displayed on the shelves or on the floor of the shop, the first choice is made by the customer on the visual appeal and there is every likelihood of the customer being deceived into believing that the suit-cases of the defendants emanate from the plaintiffs. The dealers of the luggage had admitted that confusion is caused when the product of the plaintiffs and the defendants are put in the same place. According to the plaintiffs, the suit cases under question are not always bought on the basis of a known and familiar brand. Often times, purchases are made on the basis of size, special external and internal features, as well as the aesthetic looks and visual appeal. The plaintiffs would develop their case by stating :

"Being an upmarket product, the relevant class of customers are those:

- i. who are frequent travellers and particular about the quality and aesthetic looks of the luggage they carry and/or ii. WHO HAVE THE MONETARY POTENTIAL TO MAKE AN IMPULSIE BUY AND/OR iii. Who already possess a System-4 deluxe model, and would like to buy another similar case to extend their luggage set.

The potential customers are likely to buy the Defendant's impugned product especially if they have had an occasion to be impressed by the distinctive trade dress of the Plaintiffs product and the customer would like to urgently by a similar looking travel case, and the dealer does not stock the plaintiff's product, or buy the impugned product so that it forms a good looking luggage set in case he already has a SYSTEM 4 luggage thus causing a loss of a potential customer to the plaintiff.

The plaintiffs deny the universal recognition on popularity of the Defendants trademark. On the contrary the global survey of brand recognition of luggage brands, have ranked Samsonite as No. 1 in most European countries and in U.S.A. In India too, the trademark SAMSONITE is very well recognized, as in indent from the survey report. 93% of the sample were aware of the SAMSONITE brand in India."

The plaintiffs referred to a survey report and would state :-

"Further the survey report shows that 76% of the sample thought that plaintiffs product and the Defendants product were very similar, and in such cases deception is very imminent. In fact 92% of the sample in the survey felt that the customers are likely to The Defendants have gone to great lengths to establish technical differences between the product of the Plaintiffs and their own product. Some of these differences like the surface texture and the pantone colour shade variation are not even apparent to the naked eye, and require as stated by the Defendants sophisticated equipment to determine the difference. From the survey report it is apparent that the differences are so subtle, that even some dealers are not aware of the same. It is seen more unlikely that such differences will be known to an ordinary customer."

The plaintiffs would assert that "the ordinary customer and a small time dealer are more likely to be easily misled by the similarities of the prominent features like the colour combination, the tan leather trims, the surface texture, the gold plated locks and the combination of ABS and leather, than be conscious of the difference in the intricate details between the two travel cases. According to the plaintiffs, they have made out a just and equitable case to establish their exclusive right to the intangible property in the trade dress, both under the statute and common law. According to the plaintiffs, they claim a proprietary right only in respect of the combination of features that has been their creation, which constitutes their trade dress and not over any individual feature. The individual features of the travel case may be functional and/or non-functional; further they may be distinctive or generic. However combination of such features in products of well known brands are not generic, but inherently distinctive and exclusive, or they acquire a secondary meaning as a result of extensive use and are identified with a particular manufacturer. The Louis Vutton range of luggage is an example where the type of print on the surface of their product, is so distinctive that the appearance itself is an identification of the manufacturer. The plaintiffs would state :-

"The defendants have stretched every nerve to show that the trade dress of the plaintiffs is not unique or distinctive. Yet they have been unable to find even a single

product that would be remotely similar to the product of the plaintiffs, other than the defendants impugned product.

Plaintiffs have not questioned the use of the 'metallic gray' by the defendants in respect of their ODYSSEY luggage series, but vehemently object to the modifications and so called improvements made on the ODYSSEY range of products, such that their impugned product mimics the SYSTEM-4 Deluxe range. Further such modifications and so called improvements have all been made subsequent to the availability of the SYSTEM-4 Deluxe in the international market, and more important, subsequent to the product launch event organized by the plaintiffs.

Further the defendants have never used a shade of green similar to what has been used by them in respect of their impugned product or the plaintiffs product prior to this time, nor have they used a polyester lining with a paisley print in respect of any of their products at any time. The plaintiffs put the defendants the strict proof thereof.

It is therefore hard to believe even for a man of less than average intelligence that the resultant impugned product of the defendants, was as a result of the independent evolution of ideas of the 3rd defendants and not as a result of blatant plagiarism and copying of the plaintiffs product."

The plaintiffs would deny that the defendants had at any time used the green that is deceptively similar or identical to the plaintiff's product in respect of any of their goods leave alone the ODYSSEY series, prior to their use in respect of the impugned product, and put the defendants to strict proof thereof. The plaintiffs would state that they had not at any time opposed the use by the defendants of primary or secondary colours that are sometimes generic to the trade or in public domain. The plaintiffs would further state :-

"The plaintiffs are opposed to the use of the identical or deceptively similar colour combinations by the defendants in respect of their products, such that to the layman the product of the defendant would pass off for the product of the plaintiff. The details of the colours as given by the defendant in para 17 (a) of their written statement are irrelevant, since such level of technical sophistication to ascertain the difference in colour shades is not available to the customer at a dealer's shop, nor is it of any consequence to the customer, as long as the colours appear identical or deceptively similar to the visual eye.

Luggage size and dimensions may be influenced by custom, practice and acceptance. There are no specific dimension standards for the manufacture of luggage and therefore the averments made by the defendants in this regard are denied in toto.

The surface texture of the both the plaintiffs product and the impugned product, would fall under the broad term-geometric grain on ABS shells. It is obvious that the

defendants contacted the agent referred to in then written statement, and requisitioned the product of a visual effect similar to that of the plaintiffs product. It is relevant to note that all correspondence in this regard is subsequent to Nov. 7 1995, when the defendant just came to know of the intended launch of the plaintiffs products.

The use of leather trims with ABS, to cover the rivets, especially in the specific combination of colours is an idea developed by the plaintiffs, and is associated by the trade and users exclusively with the plaintiffs. The total effect so produced was never generic nor has it become generic, as adduced by the defendants. Not one of the luggage cases in the pictures seen as document 25, 26 and 28 to the list of documents filed by the defendants even remotely resemble the product of the plaintiff.

The argument of the defendants regarding the exactness of the width of the trims or the difference in the intricate or internal construction of the lock system is irrelevant and immaterial because such detailed differences are known only to the manufacturer and not to the ordinary customer and in some cases not even to dealers.

The positioning of the levels may be altered, depending on the manufacturer. The rivets can be placed before the radius, or any where further or closer, without any technical problems. Thus the justification of the defendant on the issue of rivets is false to his own knowledge."

The plaintiffs deny that the defendants have used the paisley polyester lining as used in the impugned product and which is deceptively similar to the lining used in the plaintiffs product at any time whatsoever in the past in respect of any of their products and put the defendants to strict proof thereof.

The similarity in the shape, layout and construction of the inner compartment of the plaintiffs product and the defendants product cannot be denied. Taking in to consideration the principle of incomplete recall, and that the same manufacture may himself give slight variation to the internal construction depending on the size of the luggage, such minor variations do not condone or justify the wrongful intention of the defendants.

Last of all, the plaintiffs are not ignorant novices in the trade, and are aware of the ubiquitous use of ABS in hard luggage. The plaintiffs have not at any time in isolation objected to the use of ABS by the defendants or any other party for that matter. The plaintiffs however maintain that the use of high-tech look, i.e. the geometric grain on the ABS shell with the traditional look of leather is unique to the plaintiffs."

12. According to the plaintiffs, the defendants have tried to confuse the Court by trying to make it appear as if the present issue was a case of infringement of Design or Patent, by sidelining the real issue namely infringement of copyright in the drawings as well as passing off of tradedress. The

defendants have desperately tried to justify their wrong doings by reverse rationalization and failed to make any substantial case for defense.

13. According to the plaintiffs, the so called improvement or modification of their existing product resulting in the impugned products have all been subsequent to the launch of the SYSTEM-4 luggage, not only internationally but also in India in November 95. The drawings in respect of the so called modification or improvements resulting in the impugned product are all as late as on the 18th of March, 1996. The defendants have conveniently remained silent as to when the first prototype of the impugned product was made. More important the defendants had knowledge of the plaintiffs product, and were aware of the plaintiffs intention to launch the product in India by May-June of 97. The thrust of the plaintiffs' case is that for manufacturing and marketing the said impugned product the defendants have infringed the copyrights of the plaintiffs in respect of the drawing as seen in annexure B, B-1 and B-2 to the list of documents. The plaintiffs would assert at the end of the replication:-

"the confusion between the plaintiffs product and the impugned product of the defendants is both apparent and imminent, as has been evidenced by the survey report."

14. The parties had filed affidavits in support of the application, reply and rejoinder and they are on the same lines as the plaint, written statement and the replication and it will be wholly unnecessary to refer to them over again. The case of the plaintiffs has to be considered in the light what has been stated in the plaint and the case of the defendants has to be considered in the light of what is stated in the written statement.

15. The plaintiffs have filed I.A. 1616/97 praying for the following relief:-

"It is, therefore, respectfully prayed that during the pendency of the present proceedings, this Hon'ble court may be pleased to grant a temporary injunction restraining the defendants, their proprietor or partners or directors as the case may be, their principal officers, servants, agents, stockists and distributors from in any manner manufacturing, marketing and selling travel cases thereby infringing the plaintiffs' copyrights comprised in the original artistic work as represented in the drawings as seen in Annexure B, B1 and B2 to the documents list or any three-dimensional representation of the two dimensional drawing as seen in Annexure B, B1 and B2 to the list of documents or making any other 3-dimensional representation from a similar drawing which results in a reproduction or substantial reproduction or a colourable imitation of the plaintiffs goods as seen in Annexure A to J to J5 hereto and from in any manner using in respect of travel cases of any type the impugned features, as seen in Annexure K to K7 hereto or any other features which may be and Annexure J to J5 to the list of documents as to pass off and/or enable others to pass off the defendants goods as and for the plaintiffs goods."

16. The defendants 2 and 3 have filed I.A. No.2920/97 to vacate the injunction.

17. While opening the case, the learned senior counsel Mr. Kapil Sibal made very brief submissions. Mr. V. Lakshmikumaran, the learned counsel for defendants 2 and 3 made elaborate submissions referring to the documents filed by the plaintiffs, documents filed by the defendants 2 and 3 and the survey reports relied upon by the plaintiffs. In his reply, the learned senior counsel Mr. Kapil Sibal took considerable length of time to expatiate the principles applicable to the facts of this case and also referred to the pleadings and the documents and formulated the points to be considered by the Court in his own inimitable style, I am happy to place on record my sincere appreciation of the exoteric arguments advanced by the learned counsel for the parties and but for their assistance I am free to confess that I would not have been able to understand and appreciate the principles involved in the case. The learned counsel referred to English cases and explained to me with ease and aplomb and I really admired at the way in which the learned counsel could put across their view points which could be registered, retained and recalled easily by me.

18. The pleadings extracted above would give an idea about the nature of the controversy between the parties. The plaintiffs claim copyright in the drawings B, B-1 and B-2 and according to the plaintiffs the second defendant had copied the drawings and had produced suitcases in three dimension and thus has infringed the copyrights of the plaintiffs in the drawings. The second point raised is that the second defendant is guilty of passing off the suit cases of the plaintiffs as that of their own and second defendant is causing loss to the plaintiffs. To buttress their case, the plaintiffs have stated that they have been able to establish considerable transborder reputation by making wide advertisements and their products are used by a very large section of businessmen who travel extensively all over the globe. And in parenthesis the plaintiffs would refer to the trade dress with reference to the suit cases and would state that it is distinctive of the plaintiffs. The plaintiffs have also relied upon the result of their market survey. The plaintiffs pray for injunction pending the suit. The second defendant would state that plaintiffs have not been having consistent stand. One case is set up in the plaint and another in rejoinder and yet another at the time of the oral submissions. In the plaint, the plaintiffs put forth their case on the basis of statute and then on common law. The plaintiffs invoked the provisions of Indian Copyright Act, 1957 for the purpose of showing that the plaintiffs had introduced a suit case in the year 1993 called the System 4 Delux and the suit case was manufactured on the basis of the drawings B, B-1 and B-2. According to the plaintiffs, the defendants' suit case is a three dimensional representation of the drawings B, B-1 and B-2. According to the plaintiff, they constitute original artistic work. The plaintiffs referred to the passing off on the basis of common law. According to the plaintiffs, the trade mark and trade name Samsonite is a very world famous name and it enjoins statutory protection in 59 countries. The main features in System 4 Deluxe are unique and distinctive. They say:-

"a) VIPIL states that the plaintiffs do not have proprietary and exclusive rights to the appearance, features and get up of the System 4 Deluxe range of products. Whilst it is asserted in the application that the appearance of the System 4 Deluxe range of suitcases is distinctive of the plaintiffs, there is in fact not a shred of evidence from which it is possible to infer that that range of products is identified by members of the public as being a product of the plaintiffs by its appearance alone.

b) Specifically, no prima facie evidence has been filed which suggests that the so called distinctive features claimed by the plaintiffs are associated by the public or any member of the public in India (or even elsewhere overseas) solely and exclusively with the plaintiffs.

c) Furthermore, there is no allegation at all that the plaintiffs have sold and promoted the System 4 deluxe range of luggage in India to anything like the extent which would be required to have caused the appearance of that range to become distinctive of the plaintiffs. Even elsewhere in the world, System 4 Deluxe is just one of a large number of ranges of luggage marketed by the plaintiffs, the appearance of which varies widely. It is not the case of the plaintiffs that they have been manufacturing only one type or design of luggage, namely, System 4 Deluxe for a long length of time and that the same has, therefore, become distinctive of them.

d) On the other hand, there is admission by the plaintiffs that the Samsonite product is not available in India. Luggage products cannot be imported into India. Local manufacturing of any "Samsonite" branded products has not commenced. The various agreements relied upon by Samsonite USA such as the joint venture agreement with the 2nd plaintiff are all in relation to their proposed activities in India. In other words, the plaintiffs' products do not enjoy any reputation in India (or even overseas) of the sort alleged.

e) Furthermore, the plaintiffs have themselves admitted that until now they have imported into India only 7(seven) pieces of the System 4 Deluxe and sold the same to one individual (the credibility of this sale is questionable as detailed hereinafter). This level of sale is wholly inadequate to support the allegation that the impugned features are exclusively and solely associated by the Indian consuming public with Samsonite USA. The evidence of imports of Samsonite product into India at Annexures F, F1, F2 and G is tainted by misrepresentations and irregularity in import and customs procedures. VIPIIL says and submits that submissions in this behalf will be made at the time of hearing by reference to the documents filed by the plaintiffs themselves."

19. According to the plaintiffs, the defendants have copied, adopted and imitated the features mentioned above with a view to passing off.

20. Before dealing with the point raised and the arguments advanced before me, a brief prologue as it were has become imperative to highlight the main issues. I feel that if the ground is clear in respect of the provisions of the English Act and decision thereon then the correct position of law in our country could be appreciated without any difficulty untrammelled by technical aspects outlined in the judgments in the English Courts. Before the advent of independence British Parliament enacted the Designs Act, 1911 for India. After the advent of independence in 1957 the Copyright Act was enacted. The ultimate decision by me would revolve on the proper construction of the provisions in these two enactments which deal with the subject matter of designs and the copyright.

As pointed out by the Judges in England, here also the statutory provisions are not very clear and unless the meanings of the provisions are clearly spelt out on proper construction it will be very difficult to decide the case one way or the other. The words employed by the Parliament are not of clear import and they require some sort of polishing so that their clear intention could be ascertained to be applied to a given case. It is of interest to recollect the of quoted observations of Holt C.J. in *City of London Vs. Wood*, 1701 (12 Mod Rap 669) = 88 E.R. 1592 "Parliament can do no wrong, though it may do several things that look pretty odd". If the words of the statute are clear and unambiguous and they don't change the colour depending upon the situation the function of the Courts would be minimal. But that cannot be, because the words of the statute have to be considered in the light of the progress in the particular field depending upon the development of Science and Technology. No doubt, in our constitutional polity the proposition of Holt C.J. may not be quite apposite but what the learned C.J. meant was that the parliamentarians do not bestow sufficient thoughts on the legislation concerned. Whatever may be in an action like this, the validity of an act Parliament cannot be gone into and that is not the issue here. As I had noticed above, I am concerned with the two statutes i.e. the Designs Act, 1911 and the Copyright Act, 1957. There was a Copyright Act, 1914 but that stood repealed by Copyright Act, 1957. The Designs Act, 1911 deals with the designs. And the Copyright Act, 1957 was enacted to consolidate the law relating to copyright. There has been four amendments to the Copyright Act;

1. The Copyright Amendment Act, 1983 (23 of 1983)
2. The Copyright Amendment Act, 1984 (65 of 1984)
3. The Copyright Amendment Act, 1992 (Act 13 of 1992).
4. The Copyright Amendment Act, 1994 (Act 38 of 1994)

21. These amendments do not throw any light on the question that has arisen for consideration in this case and there is no need to refer to these amendments. The principal contention on the basis of the provisions of these two Acts by the learned counsel for the defendants is that the drawings relied upon by the plaintiffs are designs within the meaning of Designs Act, 1911 and by virtue of Section 15 of the Copyright Act, 1957 the plaintiffs cannot claim any copyright. Section 2(5) of the Designs Act, 1911 gives the definition of design, which reads as under :

""design" means only the features of shape, configuration, pattern or ornament applied to any article 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.":

Section 2(2) of the Act defines "article" :-

" "article" means any article of manufacture and any substance, artificial or natural, or partly artificial and partly natural."

Section 2(4) of the Act defines "copyright" :-

" "copyright" means the exclusive right to apply a design to any article in any class in which the design is registered."

Sections 3 to 42 have been omitted by the Patents Act, 1970. Section 47 of the Act provides duration of protection for the registered designs. Section 47 reads as under :-

"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 five years from the date of registration.

(2) if before the expiration of the said five 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 five years.

(3) If before the expiration of such second period of five years application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years."

22. While this law has been in force the Parliament enacted the Copyright Act, 1957 and it came into force on 14.6.1957. Section 14 of this Act provides :-

"Meaning of copyright.- For the purposes of this Act, "copyright" means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely -

(a) in the case of a literary, dramatic or musical work, not being a computer programme,-

(i) to reproduce the work in any material form including the storing of it in any medium by electronic means;

(ii) to issue copies of the work to the public not being copies already in circulation;

(iii) to perform the work in public, or communicate it to the public;

(iv) to make any cinematograph film or sound recording in respect of the work;

(v) to make any translation of the work;

(vi) to make any adaptation of the work;

(vii) to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);

(b) in the case of a computer programme,-

(i) to do any of the acts specified in clause (a);

(ii) to sell or give on hire, or offer for sale or hire any copy of the computer programme, regardless of whether such copy has been sold or given on hire on earlier occasions;

(c) in the case of an artistic work,-

(i) to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;

(ii) to communicate the work to the public;

(iii) to issue copies of the work to the public not being copies already in circulation;

(iv) to include the work in any cinematograph film;

(v) to make any adaptation of the work;

(vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv);

(d) in the case of a cinematograph film,-

(i) to make a copy of the film including a photograph of any image forming part thereof;

(ii) to sell or give on hire or offer for sale or hire, any copy of the film, regardless of whether such copy has been sold or given on hire on earlier occasions;

(iii) to communicate the film to the public;

(e) in the case of a sound recording-

- (i) to make any other sound recording embodying it;
- (ii) to sell or give on hire, or offer for sale or hire, any copy of the sound recording regardless of whether such copy has been sold or given on hire on earlier occasions;
- (iii) to communicate the sound record Section 2-C gives the meaning of artistic work :-

" "artistic work" means,-

- (i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;
- (ii) an architectural work or art;

and

- (iii) any other work of artistic craftsmanship."

23. The Parliament in his wisdom thought it unnecessary to give the meaning of design separately for the purpose of this Act because that is defined in the Designs Act, 1911. Therefore, for the purpose of deciding the question these provisions have to be read together because Section 15 of the Copyright Act, 1957 takes away the protection that is given to a copyright to a drawing which is a design. Section 15 of the Copyright Act, 1957 reads as under :-

"Special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 1911.- (1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 1911 (2 of 1911).

(2) Copyright in any design, which is capable of being registered under the Designs Act, 1911 (2 of 1911) but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his licence, by any other person."

24. It is a basic principle of interpretation of statutes that when two enactments deal with the same subject and the provisions are in pari materia, they have to be interpreted harmoniously. Here the position is, the Copyright Act which is later in point of time would impliedly incorporate into that Act the provisions of the Designs Act. The plaintiffs confine themselves to the provisions of the Copyright Act, 1957 and would assert copyright in the drawings while the second defendant would rely upon the provisions of the Designs Act and Section 15 of the Copyright Act to show that what is relied upon by the plaintiffs is a design and the claim of the plaintiffs would come within the mischief of Section 15 of the Copyright Act, 1957. The term 'design' is not defined in the Copyright Act and, therefore, it has become necessary to fuse the two acts and consider the point involved in

this case.

25. Lord Mansfield held in *R Vs. Lords Dell*, (1758) 97 E.R. 394 "where there are two different statutes in *pari materia* though made different times, or even expired, and not referring to each other, they shall be taken and constitute together, as one system and as explanatory of each other.

This has been approved of by the Supreme Court of India in:-

J.K. Steel Ltd. vs Union of India, .

The meaning of the phrase *pari materia* is :-

"Statutes are in *pari materia* which relate to the same person or thing, or to the same class of persons or things."

It is a phrase applicable to different statutes or general laws made on different times and in reference to the same subject. This has been accepted by the Supreme Court in:

Shah & Co., Bombay vs State of Maharashtra, AIR 1967 S.C. 1877, and *Sir Silk Ltd. Vs. Textile Commissioner*, .

For the purpose of appreciating this position, provisions of the Prevention of Corruption Act, 1947, The Indian Evidence Act, Assam Agriculture Income Tax Act, 1939, Income Tax Act, 1922, Industrial Development and Regulation Act, 1951 and the Textiles Committee Act, 1963, The Indian Tariff Act, 1934 and the Imports & Exports Act, 1937 as they form part of the Import Control Scheme of the Government can be regarded to. This method of construction has been adopted to avoid any apparent contradiction between the statute dealing with the same subject.

26. Lord Isher M.R. held in :-

Re Wood Vs. Estate (1886) 31 Ch Division 607:-

"If a subsequent Act brings into itself by reference some of the clauses of a formal Act, the legal effect of that, as has often been held, is to write those Sections into the new Act as if they have been actually written in it with the pen, or printed in it."

27. Therefore, it has to be ascertained what is the meaning of the design and how the term design had been used in Copyright Act, 1957 and how far the defendants are right in saying that the plaintiffs cannot claim any copyright in the design projected by the plaintiffs as a drawing to claim protection under the Copyright Act, 1957. The solution may look elusive because the Statutes had given rooms for debate in view of number of decisions by English Courts on the provisions of series of enactments brought into the effect in England. The other parts of the globe could not think of any codified law and the human ingenuity in England could evolve some method to frame laws and at

about the turn of the 18th century the Parliament in England enacted in 1709 the Copyright Act which was the precursor of the later Acts, which formed a base as it were for improvement and which could give food for thought for further development on the subject. In 1787, 1814, 1839, 1842, 1862, 1883, 1907, 1911, 1919, 1928, 1932, 1942, 1946, 1947, 1949, 1956, 1968, 1985 and 1988 legislations were brought about. It is not necessary to burden this judgment with the provisions in all the statutes but I shall refer to the definitions in some of the Acts as and when necessary. The Courts in England had to face a similar problem as I am facing in this case, engaged in the task of finding out the real import of the term design and the correct position of the owner of the copyright in a drawing. Fortunately, for us, there has been no complications as we may call it. And the provisions of the Indian Acts, in my view, do not give us as much trouble as one would have anticipated or could have imagined. In the Patents, Designs & Trade Mark Act, 1883 (England) the term design was defined in the following terms :-

"In and for the purposes of this Act, "design" means any design applicable to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or Chemical, separate or combined, not being a design for sculpture, or other thing within the protection of the Sculpture Copyright Act of 1814."

A slight modification was made in the definition in the Patents and Designs Act 1907 :

"`Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or Chemical, separate or combined."

In 1919 further change was made in the Patents and Designs Act 1919 :-

" `Design' means only the features of shape, configuration, pattern, or ornament applied to an article 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."

In the present Act in England in the Registered Designs Act, 1949 the definition is in the following terms :-

"In this Act the expression "design" means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform."

28. In 1956, as I had mentioned above, the Copyright Act was enacted and in Section 10, which is relevant in the present purpose of discussion, reads as under :-

"10 Special exception in respect of industrial designs (1) ...

(2) Where copyright subsists in an artistic work, and-

(a) a corresponding design is applied industrially by or with the licence of the owner of the copyright in the work, and

(b) articles to which the design has been so applied are sold, let for hire, or offered for sale or hire [whether in the United Kingdom or elsewhere], and

(c). the following provisions of this section shall apply.

(3) Subject to the next following subsection, after the end of the relevant period of 15 years it shall not be an infringement of the copyright in the work to do anything which at the time when it was done would, if a corresponding design had been registered under the Registered Designs Act 1949 (in this section referred to as "the Act of 1949") immediately before that time, have been within the scope of the copyright in the design as extended to all associated designs and articles.

In this subsection "the relevant period of 15 years" means the period of 15 years beginning with the date on which articles, such as are mentioned in paragraph (b) of the last preceding subsection, were first sold, let for hire or offered for sale or hire, whether in the United Kingdom or elsewhere.

(4) For the purposes of subsections (2) and (3) of this section, no account shall be taken of any articles in respect of which, at the time when they were sold, let for hire, or offered for sale or hire, the design in question was excluded from registration under the Act of 1949 by rules made under subsection (4) of section one of that Act (which relates to the exclusion of designs for articles which are primarily literary or artistic in character); and for the purposes of any proceedings under this Act a design shall be conclusively presumed to have been so excluded if-

(a) before the commencement of those proceedings, an application for the registration of the design under the Act of 1949 in respect of those articles had been refused;

(b) the reason or one of the reasons stated for the refusal was that the design was excluded from such registration by rules made under the said subsection (4); and

(c) no appeal against that refusal had been allowed before the date of the commencement of the proceedings or was pending on that date.

(5) The Power of the Board of Trade to make rules under section thirty-six of the Act of 1949 shall include power to make rules for the purposes of this section for determining the circumstances in which a design is to be taken to be applied industrially.

(6) In this section, references to the scope of the copyright in a registered design are references to the aggregate of the things, which, by virtue of section seven of the Act of 1949, the registered proprietor of the design has the exclusive right to do, and references to the scope of the copyright in a registered design as extended to all associated designs and articles are references to the aggregate of the things which, by virtue of that section, the registered proprietor would have had the exclusive right to do if-

(a) when that design was registered, there had at the same time been registered every possible design consisting of that design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, and the said proprietor had been registered as the proprietor of every such design, and

(b) the design in question, and every other design such as is mentioned in the preceding paragraph, had been registered in respect of all the articles to which it was capable of being applied.

(7) In this section "corresponding design", in relation to an artistic work, means a design which, when applied to an article, results in a reproduction of that work."

29. In the 1956 Act there is no provision similar to Section 15 of the Copyright Act, 1957. In the Copyright Act, 1956 (England) there is a provision similar to Section 22 of English Copyright Act, 1911. Perhaps the English Parliament thought Section 10 of the Copyright Act, 1956 would be sufficient in providing protection to the owners of the copyrights and the designs.

30. The learned counsel for the parties brought to my notice a number of English cases for interpreting and appreciating the meaning of the word term 'design' and the copyright in a drawing. Before considering the cases cited, I feel that it is necessary to have the meaning of the words design and drawing.

31. In the new Encyclopedia Britanica Vol. 4 15th Edition, (Design) the meaning of design is given as, the process of developing plans or scheme of actions; more particularly, a design may be the development plan or scheme whether kept in mind or set forth as a drawing or model. The execution of a plan is not, properly, designing, except in so far as the plan may continue to develop in order to meet originally unanticipated requirements. The end result is not a design but it is reasonable to speak of a design, that is, of the antecedents plan or scheme discoverable in it. A plan or scheme as

the pattern for the making a product indicates primarily an inter- relation of parts intended to produce a coherent and the effective whole, originally plan with four limiting factors in mind;

(1) The capacities of the materials employed;

(2) The influence of methods adopting these materials to their work;

(3) The infringements of parts within the whole; and the affect of the whole on this who may see it, use it, or become involved in it.

32. Design in the sense of pattern for making a product has become a synonym for work in the applied arts and a designer is one who practises them. Design in the fine arts is often considered to be the creative process per se, while in engineering, on the contrary it may mean a concise record of the embodiment of appropriate concept and experience.

33. While describing the concept of drawing, Encyclopedia Britannica Vol. 5 page 1003 it is stated that the development relates to applied drawings. It is stated :

"Mechanical devices. Mechanical aids are far less important for art drawing than for any other art form. Many draftsmen reject them altogether as unartistic and inimical to the creative aspect of drawing."

In Encyclopedia Americana Vol. 9 1993 Edn. the meaning of drawing is given in the following terms:-

"DRAWING. In English, to draw means literally to trace or delineate, implying that a drawing is an image represented purely in line and therefore monochromatic. In this sense, drawing is closely related to writing, since both involve graphic notation and significant linear configurations; indeed, the tools of drawing and writing have generally been identical. In other languages, however, the word for drawing-disegno (Italian) dessin (Franch)-includes the concept of design in a broader sense, the full range of visual composition."

34. While referring to engineering drawing it is stated:

"DRAWING, Engineering, the representation of the ideas of the architect, designer, and engineer through a standard graphic language of lines, geometric shapes, and symbols. Because the draftsman uses a number of mechanical instruments in engineering drawing, it is often called mechanical drawing. Engineering drawings are used mostly to communicate the ideas of the architect, designer, and engineer to the manufacturer and assembler, but they are also used in illustrations for the layman. In engineering drawing there are two fundamental methods of shape representation; pictorial and orthographic."

Under the pictorial drawing it is stated that there are certain projection to be made for the purpose of getting the desired result and they are mentioned as Axonometric Projection, Isometric Projection, Dimetric and Trimetric Projections, and oblique Projection. It is only to show that the concept of projecting a drawing for the purpose of claiming copyright must be one satisfying the comprehensive meaning of the word 'drawing'. It is also stated that there is another aspect of drawing called perspective drawing. The drawing concerned has to give a sectional view, dimensions and the production details, including assembling. In Words and Phrases legally defined 3rd Edn. by John B Saunders 1989 Edn. Volume 2, it is stated that drawing includes any diagram, map, chart or plan and Copyright Act 1956 is referred to. Reference is made to dies which are referred to as drawings and according to the author that their value consisted not in the use of the original drawing or exhibition but for the multiplication of the article by a particular process.

35. In Words and Phrases, Permanent Edn, 12th Edition meaning of a design is given in the following terms:-

"A "design", in the view of the patent law, is that characteristic of a physical substance which by means of lines, images, configuration, and the like, taken as a whole, makes an impression, through the eye, upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement, but in the tout ensemble-in that indefinable whole that awakens some sensation in the observer's mind. Impressions thus imparted may be complex or simple; in one a mingled impression of gracefulness and strength alone. But whatever the impression, there is attached in the mind of the observer, to the object observed, a sense of uniqueness and character. Pelouze Scale & Mfg. Co. Vs. American Cutlery Co., 102 F. 916, 918, 43 C.C.A. 52."

36. The Oxford Dictionary gives the meaning of drawing as "the arrangement of the lines in a drawing which determine the form." Oxford Dictionary meaning of the design a preliminary sketch, a plan or pattern from which a picture, building, machine etc. may be made. An idea as executed, the combination of elements in the finish work; an artistic device, a pattern. The action or out of planning and creating in accordance with the appropriate functional or aesthetic creative; the selection and arrangement of artistic or functional elements making up a work of art, machine or other objects.

37. Users of Industrial Design Law have conflicting requirements. The manufacturers introducing new products are always desirous of maintaining a very high profile without any competition to make as much money as possible within as short time as possible. They want to say that their products had been designed by them for the first time when there may be others producing the same kind of products without much publicity. Having regard to the development in the field of science and technology, innovations and improvements in manufacturing methods, continuous research in all fields of human activities, the nature of designs are such that the considerations involved are too many and too complicated and they cannot be brought under any comprehensive rubric. The design must be applied to an article by any industrial process or means and must be apparent in the finished article. The industrial calculation does not mean that the article must be machine made

because hand made articles also may be registrable. The law does not require that any article should have been made out of a particular design or there should be any definite intention to make any article at the time of designing or registration. The calculation or general understanding in the field is generally taken to mean that the nature of the article concealed in a design should be suited to production in quantity. It may exclude articles which would normally be or only capable of being produced signally such as non reproduceable or artistic creation or architectural works.

38. In G.A. Hari & Co. (London) Vs. Secure Fittings Ltd., 1966 RPC 515 a combination of hot and cold water tank for a hot water system was found after much evidence to be registrable and it was observed that the design is an addition to or embellishment of the fundamental form of such a unit and is not dictated solely by function. It was further stated that one has to identify fundamental form of the article i.e. the essential structure to perform the required function and then one has to determine to what extent that form has been supplemented. In considering the contentions the Court acknowledged that "the dividing line if there be one is somewhat metaphysical." In his Treatise Design, The Modern Law and Practice 1987 Edn. Mr. Morris Quest had dealt with the nice difference between the artistic copyright and artistic craftsmanship, which is also maintained by the Indian Act. The learned Author had dealt with the subject on the basis of the law codified by the Parliament in England but I have my own reservations about the view expressed by the Author in view of the Copyright, Patents and Designs Act, 1988 enacted by the Parliament in England which had brought about a sea change in the statute law. But the arguments before me cover the field dealt with by the Author on the basis of the case law on the statutes prior to 1988 Act and, therefore, with a view to highlighting a few aspects I am referring to the opinion expressed by the Author in this book. While dealing with artistic copyright the learned Author has referred to:-

Dorling Vs. Honnor and Honnor Marine Ltd. (1964) Ch. D. 560 = 1963 RPC 205, British Northrop Ltd. Vs. Texteam Blackburn Ltd., 1974 RPC 57, and 1986 (1) AER 850 House of Lords. While dealing with artistic craftsmanship, the learned Author has referred to:-

George Hensher Ltd. Vs. Restawile Upholstrey (Lancs) Ltd., 1975 RPC 31 The House of Lords dealt with the question whether the manufacturer of jars and shelties could claim their products to be artistic. It was observed that protection should have been sought under the Registered Designs Act, 1949 and not under the Copyright Act, 1956. It is not necessary to expatiate any further. As observed by Lord Raid:-

in Amp. Inc. Vs. Utilex, 1922 RPC 103 "those who wish to purchase an article for use should often influence in their choice not only by practical efficiency but by appearance."

It can also be noticed that a design can be considered to be a visual characterisation of an article which influences a person to purchase that article in preference to other articles which are identical in function but differ in appearance. Therefore, the projection by the plaintiffs is that out of drawings B, B-1 and B-2 suit-cases are manufactured and inspite of manufacturing of suit-cases the plaintiffs would retain

the copyright in the drawings and the second defendant in manufacturing suit-cases had infringed the copyright. As I had mentioned above, the preliminary point taken by the second defendant is that the plaintiffs had not registered their drawings which are designs and, therefore, under section 15 of the Copyright Act, 1957 the plaintiffs cannot claim any copyright.

39. The learned counsel for the defendants, as I had referred to above, relied upon a number of authorities and a brief survey of the authorities is necessary to appreciate the submissions made by the learned counsel for the defendants Mr. V. Lakshmikumaran.

In - Con Planck Ltd. vs Kolynos Incorporated, 1925 KBD 804 the plaintiff Company claimed damages for the infringement of their copyright in two sketches or cut out advertisement show cards and an injunction to restrain the defendant from further infringement. The case of the plaintiffs was that under the Copyright Act, 1911 they were entitled to a copyright in these sketches as being artistic work within the meaning of section 1, 2 of the Act. One of the defenses was that the sketches were designs to which the Copyright Act would not apply and ought to have been registered under the Patents and Designs Act, 1907 and as they had not been registered the plaintiffs were not entitled to make the claim. The learned Judge while dealing with the arguments referring to the Patents & Designs Act, 1907 and the Patents and Designs Act, 1919 observed :-

"What then is the fundamental distinction between a design and artistic work. This is a point which the writers of the various text-books have found to be one of great difficulty and upon which they differ. There have been discussions as to whether Christmas cards and posters fall under one or other category. It would be impossible and I think undesirable to lay down any definition. As each case comes up for determination an endeavour must be made to say upon which side the particular case lies, and no doubt in course of time a multiplication of examples may lead to an attempted definition. It may be right to say, as is said in the last edition of Copinger's Law of Copyright, 5th ed., p. 97, that the fundamental distinction between a design and a simple artistic work lies in the applicability of the former to some other article. The plaintiffs contended that a design is something produced as a pattern to assist one in making some other article which shall appeal to the eye; a thing which has no market in itself but is meant to be applied to some other article. I am disposed to think that these definitions are approximately correct, but I am far from saying that they assist the plaintiffs in the present case.

I have had the great advantage of Mr. Ballantyne's evidence. He assured me that having examined the sketches in question it is his opinion that they are designs which are capable of registration under the 1907 Act, and that they do not come within the exception of the section. In my view that is right. I think that the designs were capable of being registered under the 1907 Act, and, so far as it is a question of fact, I find that they were designs which were used and intended to be used as models or patterns to be multiplied by an industrial process. In these circumstances they ought, in my opinion, to have been registered under that Act, and as no registration has been

effected the plaintiffs are not entitled to succeed."

40. In *Kenrick & Co. vs. Lawrence & Co.*, 1890 QB 99, Queen's Bench Division was invited to decide the question whether a card on which there was a picture of hand holding a pencil and in the act of completing a cross within a square showing the process of casting a vote in an election could become subject of copyright. The Court held that there is no question of any copyright in this subject. The Court observed that no one could speak of such a drawing as work of art. The Court held that it was the product of artistic faculty that was intended to be primarily the subject of copyright. Having regard to the language in the statute with which I am concerned, it is not necessary to deal with this case. The learned counsel for the defendants referred to :

Ware vs Anglo Italian Commercial Agency Ltd. (No. 1).

This case is mentioned in Macgillivray's Copyright Cases page 346 (1907 to 1923). There the plaintiff prayed for an injunction restraining the defendant from printing and publishing of certain post cards which the defendants were issuing as trade advertisement which the plaintiff alleged contained a reproduction of his original design for a Motor Lorry Body and was an infringement of his copyright therein. This is not a full report of the judgment and looks like extracts from the judgment and as there are no full facts available, the ratio of the judgment could not be spelt out clearly. Therefore, I do not want to go any further on this case. It may be noticed that this case is referred to by the House of Lords in *King Features Syndicate Incorporated and Frank Cecil Betts, The Personal Representative of Elzie Chrisler Segar, deceased v. O. & M. Keleeman Ltd.* 1941 (58) RPC 207 (Popeye the Sailor's case). Russell J. who was the Judge who decided the case was one of the members of the House of Lords which decided King features Syndicate case.

41. The learned counsel relied upon:

Pytram Ltd. Vs. Models (Leicester), Ltd., 1930 (1) Ch. 639.

The case was decided by Chancery Division after evidence was recorded in the case. The plaintiff company therein carried on business as modelers and sculpture at New Malden in the County Surrey. The plaintiff had a wolf cub's head which according to the plaintiff was copied by the defendants for being displayed on the tops of polls by the Boys Scouts Association. The mould by the plaintiff was stated to be a design within the meaning of the Patents and Designs Act, 1907 by the defendant. The Court held that it was a design that should have been registered and, therefore, the plaintiff cannot claim any right under the copyright. The Court relied on section 22 of the Copyright Act, 1911, which is similar to Section 15 of the Copyright Act, 1957 (India). The Court observed "now it appears to me that the model which which I am concerned in this case comes within the definition of design which I have read, and accordingly is capable of being registered under the Patents and Designs acts 1907 and 1919. That which is registered and most necessarily be the features of a shape

configuration pattern or ornament applied in this particular model to a substance by an industrial process; and I see no escape from the position that this model was a design capable of being registered under the Act."

42. From the above, the view of the Court is clear, and that is if the design comes within the definition of that word the person claiming copyright cannot project his case without that being registered under the relevant Act.

43. The learned counsel for the defendants referred to the case reported in:

King Features Syndicate Incorporated and Frank Cecil Betts, The Personal Representative of Elzie Chrisler Segar, deceased v. O. & M. Keleeman Ltd. 1941 (58) RPC 207.

The suit was instituted on the ground that the respondents before the House of Lords infringed the copyrights of the appellants in certain artistic work, namely sketches, portraying a fictitious character known as "Popeye the Sailor" by the merchant and sale of certain dolls and brooches. The defense was that in any event the brooch was not an infringement. Section 22 of the Copyright Act, 1911 was relied on, which reads as under :-

"This Act shall not apply to designs capable of being registered under the Patents and Designs Act, 1907 except designs which though capable of being so registered are not used or intended to be used as models or patterns to be multiplied by any industrial process."

The learned Judge dealing with the point observed :-

"(Section 60) The registration protects the design for a maximum period of fifteen years. (Section 53) It was evidently not the intention of the legislature when the Copyright Act, 1911, was being passed into law and the right was being given to every proprietor of copyright to reproduce his work in "any material form whatsoever" (Section I(2)) to give the author of a new or original and previously unpublished design, if he chose to register it, not only the right conferred on him by the Patents and Designs Act, 1907, but also the much more extensive rights which he might get in any drawing of the same design for the life of the author and fifty years thereafter. Yet, apart from special provision in the Copyright Act, such a drawing, if it on a design taken from it and applied to an article, was registered under the Act of 1907, in some cases would, and on many cases might, have received protection under both Acts. It is evident that the inventor of a design intended to be used as a model or pattern to be multiplied by an industrial process must almost inevitably make a drawing or print which is an artistic work within the meaning of the Copyright Act, 1911, and clearly such a drawing or print in some cases may be a design capable of registration under the Act of 1907. On the other hand, an industrial object, whether

in two or three dimensions, may well be an infringement of the artistic copyright in the preliminary drawings or prints made by the author or in the design registered under Section 49 of the Act of 1907. It is not, in my opinion, open to doubt that the main object of Section 22 was to prevent such a result and to leave the author of a design capable of registration, if he intended to use it industrially, with no more than the rights which the Act of 1907 gave him."

44. The learned Judge just for the purpose of extending the meaning of the provision of Section 22 observed :-

"Subsection (I) of Section 22 may be a little easier to understand if it is rewritten thus: This Act shall apply to designs capable of being registered under the Patents and Designs Act, 1907, which are not used or intended to be used as models or patterns to be multiplied by any industrial process. With that exception this Act shall not apply to designs capable of being registered under the Patents and Designs Act, 1907."

45. The learned Judge had noticed that it was admitted before the Court that the original drawings were not capable of being registered as designs. The learned Judge had proceeded on the basis that until manufacture was made by an industrial process the original owner would continue to have copyright in the drawings. Lord Wright observed :-

"The test to be applied is purely visual, the sketch and the brooch being compared oculis subjecta fidelibus. It is not material that the respondents were stealing the idea of "Popeye the Sailor", or availing themselves for commercial profit of the popularity acquired by that figure. The Appellants' copyright is in the actual sketch, not in the idea."

The learned Judge observed:-

"Section 22 is not a very perfect example of drafting. I think the governing element in the definition is the use or intention to use the design as a model or pattern for industrial multiplication.

There may be artistic works which ab initio fall within the category of designs, as my noble and learned friend Lord Russell then Russell J. held in - Ware v. Anglo-Italian Commercial Agency, Ltd., No. 1, reported in Mac Gillivray's Copyright Cases (1907 to 1923), page 346."

Therefore, the learned Judge was of the view that once the intention was there even at the time of making the drawing, Section 22 of the Copyright Act, 1911 would apply. The learned Judge further observed :-

"A design is something produced as pattern to assist one in making some other article which shall appeal to the eye; a thing which has no market in "itself but is meant to be applied to some other article." In cases of that nature, what might in other circumstances have been regarded as entitled to artistic copyright may be held to be a design entitled, if other conditions are fulfilled, to protection under the Patents and Designs Acts, but excluded from the protection under the Copyright Act by Section 22. Such a case is illustrated in *Pyram Ltd. Vs. Models (Leicester), Ltd.*, (1930) 1 Ch., page 639, where Mr. Justice Clauson (as he then was) held that a wolf-cub's head, produced as a model for multiplication by industrial process, was not entitled to copyright under the Act of 1911, because of Section 22. Nor had it any protection as a design because it had not been registered."

Lord Romer held :-

"In the present case the designs were presumably either a sketch prepared by or on behalf of the licensees or a completed brooch or doll. Whichever they were, being unregistered, they were not the subject of design copyright under the Act of 1907, but the original sketches, which were not used or intended to be used as models or patterns to be multiplied by any industrial process, retain their copyright, and their owner can prevent any infringement of that copyright, though the licensees could make no complaint of the reproduction of their designs which were both intended to be and were so used."

46. Therefore, the learned Judges have clearly laid down the proposition that if at the time of the drawing it was intended to be for manufacture an article by industrial process the bar under section 22 would operate.

In *Copinger And Skone James on Copyright Eleventh Edition*, the learned Author has put the principles in the following terms :-

"It is clear that it cannot have been intended that every artistic work, the design of which is reproduced or is intended to be reproduced in more than fifty articles, was to be excluded from protection under the Copyright Act, since this would affect many engravings and photographs of a purely artistic character. The only guide given is that the section only applies to designs capable of registration under the Designs Act, but, as has been pointed out, this affords little assistance. There seems no reason, upon a literal reading of the Designs Act, why the design for a poster or a Christmas card should not be registered as a design, since features of pattern or ornament are to be applied to paper in such cases just as much as in the case of a design for wallpaper, which has always been regarded as registrable. It is submitted, however, that the fundamental distinction between a "design" and a simple "artistic work" lies in the applicability of the former to another article. That is to say, an artistic work is bought purely and simply for its artistic properties, an article to which a design has been applied is bought, not simply because of the artistic qualities of the design, but

because of the utility of the article apart from the design, and that this distinction may be implied from the obvious purpose of the Designs Acts, and from the use of the words "pattern or ornament," which are not properly applicable to such designs as are not merely appurtenances but are the essence of the thing created. For example, the plate from which an engraving is to be printed is intended to be applied to a sheet of paper or other material, but an engraving is not usually purchased for the material on which it is printed. Therefore, engravings are *prima facie* entitled to protection under the Copyright Act. But if it were intended that this engraving should be applied to, say, a wallpaper, then it would be different; for nobody would be likely to purchase an engraving printed upon a wallpaper, unless it was for the purpose of papering a room. In such a case the engraving would fall under the law as to designs."

The same Author in the Thirteenth Edition (1991) taking into account the 1988 Act in England had given the following opinion :-

"This still left the question whether the designs were capable of registration, the main problem being whether "capable of registration" referred only to capacity as a possible subject-matter for registration, or also included the requirement of novelty. It was held, under the 1911 Act, that a work which existed before the commencement of that Act, if it had not been registered under the Patents and Designs Act 1907, was entitled to copyright under the 1911 Act because, at the commencement of that Act, it was not capable of registration as a design for lack of novelty. The strange result of this decision was pointed out, by the Privy Council, in *Interlego A.G. v. Tyco Industries Inc.*, and the contrary conclusion was reached in a Canadian case and by Whitford J. in *Interlego A.G. v. Alex Folley, etc. Ltd.* Indeed, the Privy Council, in *Interlego A.G.*, *supra*, affirming the decision on this point of the Hong Kong Court of Appeal, held that the words "constituted a design capable of being registered" refer to designs possessing, when they were made, those essential characteristics which qualify them as "designs" and rejected any requirement of novelty. Otherwise, as was pointed out by Lord Oliver, there did not appear to be any logic in according copyright to works possessing all the relevant features for registration but which were denied protection for want of novelty or originality and, at the same time, denying it to works possessing those same features but which the author does not choose to register."

47. The learned counsel for the defendants referred to the judgment of the House of Lords in:

AMP Incorporated Vs. Utilux Proprietary Limited, (1972) RPC 103.

The defendants in the suit were the appellants before the House of Lords. The plaintiff filed the suit stating that the designs registered under the Registered Designs Act, 1949 were not valid. The suit was dismissed. On appeal, the Court of Appeal decreed the suit. On appeal by the defendants, the House of Lords allowed the same. The action was on the ground of infringement of two registered designs relating to a

single electric terminal and to a number of terminals joined together in line. The House of Lords noticed the facts in the following terms :-

"The terminals each comprised a receptacle, a transition portion, and a connecting channel, the latter having two sets of ears adapted to be crimped round a connecting channel, the latter having two sets of ears adapted to be crimped round a connecting wire lived at right angles to the axis of the receptacle producing a flag or battle-axe connection. The terminals had originally been devised for a customer II for use in washing machines. It was admitted by the plaintiffs that function was the sole cause or reason which led the author of the design to choose the shape he did, but they contended that the terminals could have been of a different shape without affecting their function. The trial judge held that both designs were invalid as lacking novelty or originality and on the ground that alleged novel or original features were dictated solely by the function which the article in question had to perform. On appeal by the plaintiffs to the Court of Appeal the trial judge's findings were reversed and the appeal allowed, the Court holding, inter alia, that the statutory objection to validity that features of a design were dictated solely by the function which the article had to perform was only made out when article's function for successful performance required that the article be made in that shape and in no other, and that that was not so in the present case. On appeal by the defendants to the House of Lords the appeal turned mainly on the questions whether the features of the design were dictated solely by function and of whether the designs appealed to and were judged solely by the eye."

The House of Lords held that the features of the designs were dictated solely by function and that the designs were invalid. The learned Judges noticed the definition of design in 1949 Act in Section 13 in the following terms :-

"'Design' is defined by section 1(3):

"In this Act the expression 'design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform."

Lord Reid observed :-

"Then there come the words "being features which in the finished article appeal to and are judged solely by the eye". This must be intended to be a limitation of the foregoing generality. The eye must be the eye of the customer if I am right in holding that the policy of the Act was to preserve to the owner of the design the commercial value resulting from customers preferring the appearance of articles which have the

design to that of those which do not have it. So the design must be one which appeals to the eye of some customers. And the words "judged solely by the eye" must be intended to exclude cases where a customer might choose an article of that shape not because of its appearance but because he thought that the shape made it more useful to him."

Lord Morris observed:-

"The terminals, unseen in the machines for which they were required (save by those who make or service the machines), had only to pass the test of being able to perform their functions. They would be judged by performance and not by appearance."

The learned Judge further observed :-

"I would not, however, exclude from possible validity for registration a case where someone set out to produce an article that would perform a particular function but where in producing it he added or applied (by any industrial process or means) some feature of shape that was additional to or supplementary to what was functionally needed, with the result that in the finished article there was a feature that appealed to the eye." The learned Judge put it that :

"if there are alternative features of shape but each one is "dictated solely" by the function which is to be performed by the article then each one would be excluded from expression design."

The learned Judge proceeded to emphasise the point by "In the features of shape of the terminals in the present case there was neither the purpose nor the result of making an appeal to the eye; the features of shape were adopted only because of functional requirements ; they were dictated solely by the function which terminals to be made in that shape would have to perform."

Lord Pearson concluded his judgment by observing :-

"Thus all the features of the terminal's shape are "dictated by" in the sense of being attributable to or caused or prompted by the terminal's function of forming an electric connection between the two electric conductors, the tab and the wire. Therefore, the respondents' design fails to comply with the negative statutory requirement mentioned above."

48. The learned counsel referred to:-

Politechnika Ipari Szovetkezet & Others vs Dallas Print Transfers Ltd., 1982 Fleet Street Reports 529.

The Chancery Division had to deal with the question whether a cube shape puzzle which the plaintiffs had been marketing in England under the name of the Rubik's Cube and the cube shape puzzle almost identical appearance that defendants Dallas Print Transfers Ltd. who had been marketing and marketing in England under the name Wonderful Puzzlers were similar and whether the plaintiffs had made out a case of infringement of copyright and passing off. The plaintiffs sought injunction on the ground of passing off and the infringement of copyright. The plaintiffs alleged infringement of copyright in the base and the cover of the packaging, the black plastic base and the transparent plastic cover. The copyrights in the drawings were owned by the plaintiffs. The learned Judge noticed the arguments as under :-

"Another way of putting this point is that the drawings of the cover and base are very rudimentary, and where very rudimentary drawings are concerned there would be an infringement of copyright only if there were almost an exact reproduction of the drawings. (See Kenrick & Co. v. Lawrence & Co. (1890) 25 Q.B.D. 99). I do not find any of the Wonderful Puzzler covers or bases sufficiently exact."

The learned Judge concluded that the plaintiffs have not proved infringement of copyright in respect of the cover and base. The argument of the learned counsel for the defendants based on this judgment is that the drawings relied upon by the plaintiffs in this case are rudimentary in nature and, therefore, there could be no claim for copyright on those drawings.

49. The learned counsel for defendants referred to:-

Bayliner Marine Corporation vs Doral Boats Limited, 1987 Fleet Street Reports 497.

It is a decision by the Federal Court of Appeal in Canada. The lower court in that case found that the appellant Doral had infringed the copyright of the respondents Bayliner in the plans for the fibreglass hull and deck of one boat and had not infringed the copyright in the plans for another. The plans with reference to which the trial Judge found infringement the boat is a run about approximately 16.1/2 feet in length. The copyright in whose plans it was found there was no infringement is a cabin cruiser about 24.1/2 feet long. The trial Judge found :-

"Designers at Bayliner first prepare design drawings of the hull section and deck or superstructure sections separately. Because of the cured tapered configuration of boats, in the hull sections especially, a number of measurements appear on tables on the plans giving co-ordinates at perhaps one and one half foot intervals from bow to stern. These drawings are used to produce what is called a plug which is a three dimensional rendering of the boat to be constructed and prepared from the drawing. A mould is then made from the plug and in manufacturing the boat fibreglass mat of the colour desired is first laid down in the mould. Fibreglass is then inserted either mechanically or by hand to the desired thickness and this creates the hull of the boat. The same applied to the superstructure mould which of course has to fit on the hull

when the boat is assembled. Plaintiff produced four drawings, namely the hull and deck section of each boat, and a fifth drawing since the hull for the 2450 Ciera was a modification of an earlier design of plaintiff for which the drawing was also produced.

Defendant frankly admits that it produces its boats without the use of any engineering design, nor does it have an engineering design department as such. It purchased a 1650 Capri and stripped it down taking the superstructure and hull sections apart and using these to make the plug for its boats. The same thing was done to Plaintiff's 2450 Ciera. This practice .. short circuits the costly design process as no engineering drawings have to be made for a plug from them, as the plugs are made from plaintiff's own boats with the alterations made on them.

My conclusions of fact are based on a full consideration of all the evidence including details of comparisons which of necessity have been omitted from these Reasons. On this basis I conclude that Defendant made sufficient differences in the Citation that it does not infringe plaintiff's copyright in the 2450 Ciera. In the case of the TRX however I have reached the opposite conclusion. The differences from the 1650 Capri are relatively minor and insignificant. While they may be noticeable to an expert and even perhaps to an experienced dealer an average customer would see no significant differences except with respect to finishing and equipment which is not protected by copyright."

50. The argument on behalf of the defendants was that the Bayliner plans were not protected by copyright by virtue of section 46 of the Copyright Act R.S.C. 1970. Section 46 of that Act would read as under :-

"46.(1) This Act does not apply to designs capable of being registered under the Industrial Design Act, except designs that, though capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by an industrial process.

(2) General rules, under the Industrial Design Act, may be made for determining the conditions under which a design shall be deemed to be used for such purposes as aforesaid."

The protection given under the Industrial Designs Act, R.S.C. 1970 extends upto a maximum 10 years monopoly in a design while the protection given to a copyright is lifetime plus 50 years monopoly. With reference to section 46 of the Copyright Act, Rule 11 of the Industrial Designs Rules, R.R.C. 1978 has been framed. Sub rules 1 and 2 of that Rule found to be relevant and they are as under :-

"11.(1) A design shall be deemed to be used as a model or patterns to be multiplied by any industrial process within the meaning of section 46 of the Copyright Act,

(a) where the design is reproduced or is intended to be reproduced in more than 50 single articles, unless all the articles in which the design is reproduced or is intended to be reproduced together form only a single set as defined in subsection 2; and

(b) where the design is to be applied to

(i) printed paper hangings,

(ii) carpets, floor cloths, or oil cloths manufactured or sold in lengths of pieces,

(iii) textile piece goods, or textile goods manufactured or sold in lengths or pieces, and

(iv) lace, not made by hand.

(2) For the purposes of this 'set' means a number of articles of the same general character ordinarily on sale together, or intended to be used together, all bearing the same design with or without modification not sufficient to alter the character or not substantially affecting the identity thereof."

The Court referred to a judgment dealing with a sweater design and observed :-

"The only other pertinent Canadian decision is an even more recent judgment of the Trial Division, Jeffery Rogers Knewear et al. v. R.D. International Style Collections (1985) 6 C.P.R. (3d) 409, dealing with a sweater design, which reluctantly followed the decision under appeal and that which it had followed. The reluctance was expressed, at page 413, in the following terms :

"With the benefit of the arguments that I heard, I would be inclined to differ, with respect, from my two esteemed colleagues on the construction of Rule 11(1). It would appear to me that if a design must meet all the criteria in paragraph 11(1)(a) and in paragraph 11(1)(b) so as to be deemed to be a pattern to be multiplied by an industrial process, then no design can possibly qualify and therefore no design would have to be registered under the Industrial Design Act. In other words, I cannot see how a design can be reproduced in more than 50 articles and be applied as well to paper hangings, carpets, textile piece goods and lace not made by hand. Such an interpretation of the Rule would effectively bar any and all registrations under the Industrial Design Act. That cannot have been the intention of Parliament.

Of course, normally, 'and' is conjunctive, 'or' is disjunctive, but to carry out the intention of the legislation it is at all times necessary to read 'and' as being disjunctive: Maxwell on The Interpretation of Statutes, 12 ed. (1969), London, Sweet & Maxwell at pp. 232-3. Rule 11(1) is a deeming provision. As such, it lists all the conditions under which a design is deemed to be used as a pattern that is capable of

being registered under the Industrial Design Act; they are condition (1)(a) and (or) conditions 1(b)(i), (ii), and (or) (iv). In my view, a design under any of those conditions is capable of being registered."

The Court came to the conclusion that the trial Judge committed an error in construing that sub rule 11(1) of the Industrial Design Rules excluded the application under section 46 of the Copyright Act. The Court posed the question:

"Whether the subject matter of the claimed copyright is a design within the meaning of the Industrial Design Act."

The Court observed :-

"The locus classicus is the decision of Jackett P., considering a sofa, in *Cimon Ltd. Vs. Benchmade Furniture Corp. et al.* (1965) 1 Ex. C.R. 811 in which he held, at pages 831 and 832, "... The sort of design that can be registered is therefore a design to be 'applied' to 'the ornamenting' of an article. It must therefore be something that determines the appearance of an article, or some part of an article, because ornamenting relates to appearance. And it must have as its objective making the appearance of an article more attractive because that is the purpose of ornamenting. It cannot be something that determines the nature of an article as such (as opposed to mere appearance) and it cannot be something that determines how an article is to be created. In other words, it cannot create a monopoly in 'a product' or 'a process' such as can be acquired by a patent for an invention. There is, however, nothing in the legislation that limits the type of design that may be registered (as was suggested in argument) to those providing for something that is applied to an article after the article comes into existence.

... The fact that a design relates to shape or configuration of an article is not, in itself, an objection to its registration. As long as it is a design to be applied 'to the ornamenting' of an article, it is eligible for registration even though it requires that its purpose of 'ornamenting' be accomplished in whole or in part by constructing the article, or parts of it, in a certain shape or shapes."

In my view, the functional requirements of the hull and superstructure of a pleasure boat is that they provide a buoyant platform within and upon which the essentials and amenities required by its operator may be installed. The general shape may be largely dictated by functional considerations; however the details of that shape which serve to distinguish the appearance of, for example, one 16.1/2 foot run about from another are essentially ornamental. Those details are what make one run about more attractive, in the eyes of the beholder, than another."

The Court ultimately held :-

"The designs disclosed by the plans in issue are, in my opinion, designs capable of being registered under the Industrial Design Act within the meaning of section 46 of the Copyright Act and are not excluded from the operation of that provision by section 11 of the Industrial Design Rules. The plans themselves are not, therefore, subject of copyright."

51. The learned counsel referred to:

Interlego Ag Vs. Alex Folley (VIC) Proprietary Limited, 1987 Fleet Street Reports 283.

The learned Judge Mr. Justice Whitford referred to the judgment decided by the Hongkong Court which was under appeal to the Privy Council. The judgment of the Privy Council is referred in Interlego A.G. v. Tyco Industries INC., 1988 RPC 343. Therefore, it is not necessary to deal with this judgment. The learned Judge observed :-

"The legislature long ago formed the view that it was inappropriate to give to industrial designs-that is designs for articles which are going to be multiplied industrially-the full protection afforded to artistic works under the Copyright acts. Industrial designs were given protection under a series of Designs Acts-the first of which was passed in 1839-for a somewhat lesser period. There has, however, for a long time been, and notably since the passing of the Copyright Act 1911, some difficulty in what can be described as a field of overlap. Nonetheless, the overriding principle has been to give a relatively short period of protection to persons whose designs are going to be mass produced and whose return no doubt as a consequence is considered as being likely to be that much quicker."

This is with reference to the object of giving protection to the Industrial Designs and Copyright.

52. In Interlego A.G. Vs. Tyco Industries INC., 1988 RPC 343 the learned counsel for the defendants placed reliance. The appellant before the Privy Council was one of the Group of Companies who was engaged in the manufacture and sale of toys for children. Lego is a system of model building consisting in the main, of plastic brick shape block so designed that they are capable of being joined together to make a stable structure and the same was capable of being disassemble without any damage to the continent elements. The Privy Council referred to the appellant group as Lego. The Lego also manufactured toys under the name "Duplo" which is a larger version of Lego. The Tyco Industries (two Companies) main and subsidiary in United States and Hongkong the Court referred (together as 'Tyco'), which were the respondents, was a Company from United States. The Lego instituted proceedings in Hongkong for infringement of copyright. Lego claimed that in producing, by a process of what is called "reverse engineering", what are, in all essential features, replicas of Lego and Duplo construction units, Tyco have infringed Lego's copyright in the design drawings from which the Lego and Duplo units were manufactured. What is to be noticed is what the Court took note of :

"It is not suggested nor could it be suggested that Tyco ever had or even saw the design drawings themselves. Their elements were made simply by measuring and reproducing the configuration of the three dimensional Lego elements."

The Privy Council proceeded on these vital facts that the Tyco had entered the market by doing the re-engineering. The Court noticed the submission of Lego, that it had copyright in design drawings. The Privy Council dealt with the decision of the lower courts very briefly in the following terms :-

"In the action, which was tried before Jones J. in the High Court of Hong Kong. Lego were successful in their claim for infringement of copyright in all their design drawings, save that, on their counterclaim, Tyco obtained a declaration of their entitlement to manufacture one item, a new version of the 2 x 2 x 2 roof tile. On 20 March 1986 an order was made restraining Tyco from infringing copyright in all the drawings specified in Lego's amended pleading and granting consequential relief by way of delivery up and an inquiry as to damages. On an appeal by the respondents to the Court of Appeal of Hong Kong, that court, on 6 May 1987, reversed the decision of the trial judge so far as it related to Lego's pre-1973 drawings but affirmed it as to the remainder, leave being given to both appellant and respondents to appeal to Her Majesty in Council."

The Privy Council observed:-

"the definition of "design" in section 1(3) of the Act of 1949 is hardly a model of Parliamentary draftsmanship and this is by no means the first case in which its meaning and application have been called in question."

In approaching the question of construction it has to be borne in mind that the purpose of the Act, as appears both from its terms and its legislative history, is to protect novel designs devised to be "applied to" (or, in other words, to govern the shape and construction of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or inventions which, if protected at all, ought to be made the subject matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. The Court noticed that a shape has to be tested by two criteria, one positive and one negative, and both must be satisfied in full before it can qualify as a design within the definition of the Act. Both the parties relied upon the judgment of the House of Lords in *Amp Inc vs. Utilux Proprietary*, 1972 RPC 103 (H.L.).

In *Interlego A.G. Vs. Tyco Industries INC.*, 1988 RPC 343, the Privy Council has desired that the principle laid down by the House of Lords could be stated thus :-

"Accepting that there are differences of emphasis in the speeches of the various members of the Committee in the Amp case, their Lordships are nevertheless of the view that the principles to be deducted from it are tolerably clear. First, the primary

essential before a shape can be registered as a design is that it should have eye-appeal and in this context (a) the eye is that of the prospective customer and (b) the appeal is that created by a distinctiveness of shape, pattern or ornamentation calculated to influence the customer's choice. This, at least, emerges from the speeches of Lord Reid at page 108 (with whom Lord Donovan agreed), Lord Morris at page 112 and Viscount Dilhorne at page 118. Secondly, the negative part of the definition does not involve, in order to demonstrate that a particular shape is "dictated solely" by function, showing that that function could not have been performed by an article in some other shape. All that has to be shown is that the relevant features of the shape were brought about only by, or are attributable only to, the function which the article in that shape is to perform, even if the same function could equally well be performed by an article of a different shape. Thirdly, if every feature of the shape is one which is attributable solely to the function which the finished article is to perform, then the exclusion operates even though the shape may also have eye-appeal."

The Court further proceeded to say in an attempt to clear the position :-

"The doubt is created by the final two paragraphs of the speech of Lord Reid where the observed (at page 110):-

"There must be a blend of industrial efficiency with visual appeal. If the shape is not there to appeal to the eye but solely to make the article work then this provision excludes it from the statutory protection.

I would add to avoid misunderstanding that no doubt in the great majority of cases which the Act will protect the designer had visual appeal in mind when composing his design. But it could well be that a designer who only thought of practical efficiency in fact has produced a design which does appeal to the eye. He would not be denied the protection because that was not his object when he composed the design."

The Court posited :-

"Whether or not this is the right interpretation of Lord Reid's words, their Lordships are clearly of the opinion that the mere coincidence of eye-appeal with functional efficiency will not confer the right to protection if, in fact, every feature of the design is dictated by the function which the article is to perform. But what is the position where the shape has eye-appeal but where some only of its features are dictated solely by functional considerations? If the interpretation placed upon Lord Reid's remarks is correct, then he and Lord Donovan would clearly have contemplated that in these circumstances the exclusion would not operate to deprive the shape of protection as a design. Lord Morris clearly contemplated that it would not (page 113) and Viscount Dilhorne too (page 118) appears to have contemplated that any feature which went beyond those dictated solely by function and provided eye-appeal would entitle the shape as a whole to protection. This is, in their Lordships' view, clearly right in

principle."

The Court observed :-

"Thus in *Amp Vs. Utilux* the evidence given by Mr Collier, who actually designed the article there in question, as to his purpose in selecting the particular shape which the article there took, was treated as significant both in the courts below and in the House of Lords. In the instant case there was a not insubstantial body of evidence that, in arriving at their design, Lego's draughtsman had in mind not simply the functional efficiency of the brick, although that was clearly of primary importance, but its visual appearance. In the light of this and having regard to the very nature of the finished article under consideration, their Lordships conclude that the first and positive part of the definition is satisfied in the instant case."

The *Bayliner's* case (1987 Fleet Street Reports 497) was distinguished by the Court. The Court concluded:-

"In their Lordship's opinion, the Court of Appeal correctly concluded that the only sensible construction of the words "constituted a design capable of being registered", having regard to the evident purpose of the statute, is that it refers to designs possessing, when they were made, those essential characteristics which qualify them as "designs". If such designs are, at that time, used or intended to be used for the purpose of industrial reproduction, they are not to qualify for copyright under the Copyright Act 1956. It follows that no copyright now subsists in Lego's pre-1973 drawings."

The Court also observed that engineering drawings are no doubt artistic works within the broad meaning of that expression in the Copyright Act, 1956 but it has to be remembered that they are essentially no more than manufacturing instructions for a three-dimensional artefact. The Court held that Lego's claim for infringement of Copyright in their post 1972 drawing was not established.

53. The decision is important in considering the meaning of design from two angles. The first is, design gets the colour from the meaning ordinarily given to it and it should be considered along with statutory definition. Second is, whether something drawn for giving instructions for the manufacture of three dimensional artefact could claim protection under the Copyright Act. The exegesis made by the Privy Council is of immense use in deciding the question that has arisen in this case.

54. In *Punit Industries Vs. Classic Electronics*, 1997 (17) PTC 161 this question in the form in which it is projected was not at all put forth in that case. Therefore, the ratio laid down in that case would not apply to the facts and circumstances of this case.

55. The learned senior counsel for the plaintiffs submitted that under Indian Copyrights Act, 1957 there are two concurrent rights. There is a distinction between the Copyright in a drawing and the

Copyright in a design. The learned senior counsel relied upon the judgment in Punit Industries' case (supra), which I had already dealt with. The learned senior counsel sought to distinguish the decision of House of Lords in Amp Inc Vs. Utilux Proprietary, 1972 RPC 103 (H.L.). An emphasis was laid that in Dorling Vs. Honald (1964 RPC 160) the Court recognised the distinction between Copyright and Design and Copyright in the drawing. I am unable to agree. I had already dealt with the case and it is not necessary to repeat it. The learned senior counsel submitted that in Interlego's case the court found that the post 1972 drawings were not substantially different from pre 1972 drawings and hence they were refused protection because they lacked originality. According to the learned senior counsel the drawings relied on by the plaintiffs are not copies of any other drawings. The drawings B and B1 and the sketch as seen in B-2 are original drawings in respect of which a separate copyright exists. The learned senior counsel sought to distinguish the Bayliner's case (1987 FSR 497). I am not able to appreciate the submission. The Canadian Court, in my view, had to deal with a similar situation. It was submitted that even though intention test was part of section 22 of U.K. Copyright Act, 1911, in King Features Syndicate (supra) the Court granted injunction. The observation at page 219 was relied on. The same is as under :-

"There is nothing in Section 22 of the Copyright Act which can be construed as cutting down or destroying the full scope of the artistic copyright once it has attached under the Act."

56. The facts in King Features Syndicate are noticed above and I do not find any force in the submission made on behalf of the learned senior counsel for the plaintiffs. The learned senior counsel for the plaintiffs relied upon the judgment of the High Court of Punjab and Haryana in:

Shri Lakbor Singh vs Sardar Trading Corp., ILR 18 Punjab 658 which was referred to by the learned counsel for the defendants, which I thought was not necessary to be referred to. But the learned senior counsel for the plaintiffs relies on that case as an authority for the proposition that as drawings are not registrable as designs, cartons on which matters is printed are not registrable designs, the basic reason being that a design is applied to a finished article. Cartons are not finished articles. In view of this, the intention of the person making the drawing would be totally irrelevant. It was submitted that there are distinctions in the law in United Kingdom and in India in respect of artistic work in relation to a design. The English Act specifically excludes artistic work in relation to a design which is registered or capable of registration under the Registered Designs Act from the copyright protection, in the Indian Act artistic work is not included under section 15(2) of the Copyright Act. Strong reliance is placed on the case reported in:

British Leyland Motor Corporation vs Armstrong Patents Co. Ltd., 1986 FSR 221 where the Judge had held:-

"it is not for the Court to take away a right that are being specifically granted by a Parliament."

57. In the light of the above discussion, the point distils down to this whether the plaintiffs can claim copyright in the drawings when from the facts it is clear that the intention was to manufacture suit-cases. Section 15 of the Indian Copyright Act, 1957 reads as under :-

"15. Special provision regarding copyright in designs registered or capable of being registered under the Designs Act, 1911.- (1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 1911 (2 of 1911).

(2) Copyright in any design, which is capable of being registered under the Designs Act, 1911 (2 of 1911) but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his licence, by any other person."

58. The drawings simplicitor are not of any use to the plaintiffs. They are only instructions or ideas to give shape to an article to be manufactured. Therefore, they are designs capable of being registered. The learned senior counsel for the plaintiffs submitted that drawing does not become a design. Design must relate to an article shown by a drawing. The learned senior counsel gave an example of a manufacture of a car being conceived by a drawing. According to the learned senior counsel things to be established are :-

(1) the defendants had copied the work;

(2) the defendants had access to the product;

(3) The defendants should give a reasonable explanation that by his independent act unrelated to the act of the plaintiffs the defendants manufacture the articles in question.

59. The learned senior counsel posed the question how did the third defendant manufacture the same product with the same colour specifications and the third defendant is bound to explain. The learned senior counsel relied upon:-

British Northrop Ltd. & Another vs Texteam Blackburn Ltd. & Another, 1974 RPC 57.

It is a judgment by Justice Megarry, Chancery Division. The case concerned the manufacturing of looms and weaving machinery. The drawings had been drawn to scale with precise dimensions. The argument of the learned senior counsel is that in the drawings whatever be the form the plaintiffs have the artistic copyright and the learned senior counsel relied upon passage at page 68 :-

"I turn to the second main ground of defense on copyright in the drawings, namely, that some of them are too simple to be capable of being "original" artistic works within section 3. According to a very helpful tabular statement which the defendants

prepared in the course of the hearing, there were rather over a dozen of the plaintiffs' drawings which the defendants said lacked originality solely on account of simplicity. There does not seem to be much direct assistance to be found in the authorities on the score of simplicity; but indirectly and on principle the matter does not appear to me to be particularly opaque. Copyright is concerned not with any originality of idea but with their form of expression, and it is in that expression that originality is requisite. That expression need not be original or novel in form, but it must originate with the author and not be copied from another work: see *University of London Press Ltd. v. University Tutorial Press Ltd.* (1916) 2 Ch. 601 at 608. A drawing which is simply traced from another drawing is not an original artistic work; a drawing which is made without any copying from anything originates with the artist. The Act merely provides, by section 48(1) that "'drawing' includes any diagram, map, chart or plan", and so prima facie if there is anything which can fairly be called a diagram. It is a drawing and may be the subject of copyright. It may indeed be that some thing maybe drawn which cannot fairly be called a diagram or a drawing of any kind; a single straight line drawn with the aid of a ruler would not seem to me a very promising subject for copyright. But apart from cases of such barren and naked simplicity as that, I should be slow to exclude drawings from copyright on the mere score of simplicity. I do not think that the mere fact that a drawing is of an elementary and commonplace article makes it too simple to be the subject of copyright."

60. Dealing with Bayliners case (supra), the learned senior counsel for the plaintiffs submitted that if the plaintiffs had made engineering drawings and if the plaintiffs rely on those drawings then the ratio in that case would apply. I am not able to accept this contention because whatever be the nature of the drawing the purpose and intention would be the relevant criterion to consider whether the drawings are designs in the light of the provisions of the Designs Act and the Copyright Act, 1957. No argument was advanced on behalf of the plaintiffs that the ultimate purpose of the drawing was not for the purpose of manufacture but the drawings were made for keeping the artistic quality of the drawings. The distinction between the drawing for artistic purpose and manufacturing is ignored by the plaintiffs. The main thrust of the argument of the learned senior counsel of the plaintiffs was that the suit-cases manufactured by the plaintiffs would easily attract any person because it has got a powerful and attractive shape which would immediately attract the eye. The learned senior counsel submitted that people travelling by Air, Rail and other modes of transport would look at the shape of the box and then would make enquiries as to who had manufactured it and they would like to buy one. Therefore, the whole purpose of the manufacture was to attract the eyes of customers. Therefore, it would follow from the argument on behalf of the plaintiffs that it is clearly a design coming within the meaning of the definition of design, under the Designs Act, 1911 and coming within the meaning of section 15 of the Copyright Act, 1957. Consequently, the plaintiffs cannot claim any copyright as the same had not been registered. The fact that it is being manufactured industrially is not in dispute. Prima facie, I accept the submission I accept the submission on behalf of the learned counsel for the defendants that inasmuch as the plaintiffs had not registered the designs the plaintiffs cannot claim any protection under the Copyright Act, 1957 with reference to the drawings.

61. Now I turn to the claim for injunction on the ground of passing off on the strength of trade dress. The law is well settled. There is a catena of decisions laying down the principles. Luckily, we are in a State of chrysalis warranting an expatiation from Hindustan Radiators Co. Vs. Hindustan Radiators Ltd., laid down 8 probanda for guidance :-

(i) That the plaintiff has been using its trading style and trade mark for quite a long period and continuously, whereas the defendant has entered into the said field only recently;

(ii) that there has not been much delaying the filing of the suit for injunction by the plaintiff;

(iii) that the goods of the plaintiff have acquired distinctiveness and are associated in the minds of the general public as goods of the plaintiff;

(iv) that the nature of activity of the plaintiff and that of the defendant are the same or similar;

(v) that the goods of the parties, with which the trade mark of the plaintiff is associated, are the same or similar;

(vi) that the user of the same trade mark or trade name by the defendant is likely to deceive and cause confusion in the public mind and injury to the business reputation of the plaintiff;

(vii) that the sphere of activity and the market of consumption of goods of the parties are the same;

(viii) that the customers of the plaintiff inter alia include uneducated, illiterate and unwary customers who are capable of being deceived, confused or misled."

62. The plaintiff must establish that a trade dress or get up has become by use of distinctive of the plaintiff's goods. The term distinctive when used for the purpose of deciding the question of passing off must be taken as meaning factually distinctive and not mere assertion on the part of the plaintiff that the products of the plaintiff are inherently distinctive. When the plaintiffs are relying upon trade dress or get up the plaintiffs must, prima facie, establish that the trade dress or get up used by the plaintiffs had become associated exclusively with the products of the plaintiffs. The plaintiffs must also establish, prima facie, reputation and the plaintiffs must also, prima facie, show that the trade dress of the defendants is likely to deceive or cause confusion. The House of Lords in :

Reckitt & Colman Products Ltd.Vs. Borden INC. & Ors., 1990 RPC 341."

had laid down that the plaintiff in a passing off action should prove three things which are described as classical trinity. They are :-

1. that there was a goodwill or reputation attached to the goods or to the services which the plaintiff supplied, in the mind of the purchasing public by association with the plaintiffs' identifying get up;
2. that there was a misrepresentation to the public likely to lead the people to believe the goods offered by the defendants were the goods of the plaintiffs;
3. that the plaintiff was suffering or plaintiff is suffering or is likely to suffer by reason of the erroneous belief on account of the misrepresentation of the defendants.

In that case the plaintiffs sold lemon juice in England for domestic use under the name JIF in a peculiar get up of plastic squeeze which almost looked like in shape, size and colour a natural lemon fruit. This product had become well known as JIF lemons. This was copied by the defendants. The Court on the facts established on evidence granted injunction in favour of the plaintiff restraining the defendant from using the same type of get up.

63. Lord Halsbury L.C. gave guidance in such cases in *Schweppes Ltd. Vs. Gibbens* (1905) 22 R.P.C. 601, 606 to be followed in get up cases. The learned Judge observed that the question to be determined is :-

"whether in selling the bottle a person is likely to be deceived by the resemblance of the one thing to the other; and if a person is so careless that he does not look, and does not... 'treat the label fairly' but takes the bottle without sufficient consideration and without reading what is written very plainly indeed upon the face of the label on which the trader has placed his own name, then you certainly cannot say he is deceived... The whole question in these cases is whether the thing - taken in its entirety, looking at the whole thing - is such that in the ordinary course of things a person with reasonable apprehension and with proper eyesight would be deceived." That guidance has been followed and applied ever since in get up cases :

J.B. Williams Co. Vs. H. Bronnley & Co. Ltd. (1909) 26 R.P.C. 765, 771, per Cozens Hardy M.R.; *Jones Brothers Ltd. Vs. Anglo American Optical Co.* (1912) 29 R.P.C. 361, 366, per Cozens Hardy M.R.; *Smith's Potato Crisps Ltd. Vs. Paige Potato Crisps Ltd.* (1928) 45 R.P.C. 132, 146, per Lord Hanworth M.R., Sargant L.J., at p.149 and Lawrence L.J., at p.151; *John Haig & Co. Ltd. Vs. Forth Blending Co. Ltd.* (1953) 70 R.P.C. 259, 261, 262 and 267. [Reference was made to *Payton & Co. Ltd. Vs. Snelling, Lampard & Co. Ltd.* (1899) 17 R.P.C. 48; [1901] A.C. 308.]"

64. The question is whether the plaintiffs in this case have established that the particular trade dress had become associated in the minds of the public exclusively with their business. On the facts and circumstances, I have no hesitation in coming to the conclusion that the plaintiffs have not established its right. In fact, the plaintiffs have not established any distinctive trade dress at all. The colour, shape and other features referred to by the plaintiffs are quite common to the trade. The plaintiffs have not established any proprietary interest in the trade dress or the colour which is

capable of being acquired so as to make it a ground for claiming the relief of passing off. The plaintiffs on the materials placed before me, have not established, prima facie, a proprietary right by way of reputation and attendant goodwill in the trade dress. In *Ciba Geigy Vs. Parke Davis* 1994 FSR 8 where the Court held that the plaintiffs should establish a serious issue to be determined at the trial both in relation to allegation of passing off and injurious falsehood. In this case, the plaintiffs have not established any serious issue to be determined at all and this is my, prima facie, view. The allegations set out in the plaint would go to show that the plaintiffs have projected a case that they are suffering a swapping of their reputation by the defendants but, prima facie, no case has been made out.

65. The learned counsel for the defendants submitted that the plaintiffs must establish for getting injunction on the ground of passing off, on the strength of trade dress that the features of get up are owned by the plaintiffs, that those features and get up had become exclusively and solely identified with and distinctive of the plaintiffs' products and that intending buyers are likely to be misled and the products are so similar they are likely to cause deception. The learned counsel for the defendants relied upon the following authorities:-

- (a) *Payton Vs. Snelling* (1900) 17 RPC 48.
- (b) *Imperial Tobacco Co. Vs. Purnell and Company* (1904) 21 RPC 368.
- (c) *Schweppes ID Vs. Gibbens* (1905) 22 RPC 113.
- (d) *Jarman and Paell Ltd. Vs. I. Banget Ltd. and others* (1977) FSR 260.
- (e) *Adcock-Ingam Bakeries Ltd. Vs. Beecham S.A.*
- (f) *Cadbury-schweppes Pty Vs. The Pub Squash Case.*
- (g) *Hodgeson and Corby Vs. Wards* (1995) FSR 169.
- (h) *Kellogg Company Vs. Pravin Kumar* 1996 PTC (16) 187.
- (i) *Premier Hanger Co. Vs. V. Polyoak (PTY) Ltd.* 1997 (I) S.A. 416.
- (j) *Duraco Products Inc. Vs. Joy Plastics Enterprises Ltd.* [32 USPQ2d1724] (3d Cir. 1994)
- (k) *Reckitt Colman Products vs Borden Inc.*, 1990 RPC 341 = 1990 All E.R. 873.

66. The learned senior counsel for the plaintiffs submitted that the submission on behalf of the defendants that the plaintiffs do not have a protectable trade dress as the features of the products are common to trade and not inherently distinctive is not correct. The learned senior counsel for the plaintiffs referred to the judgment of 8th Circuit Court in United States reported in *Stewart Hall Vs.*

Ampad Corporation, 34 US P.Q. 1428 which was rendered under section 43-A of the Act called Lahham Act. I do not think that this decision renders any assistance to the plaintiffs.

67. I was shown the suit-cases manufactured by the plaintiffs and the suit-cases manufactured by the defendants. The learned counsel for the defendants brought to my notice the stages of using of various components used by the third defendant in the ViP Odyssey GLX. The development of the business of the third defendant according to the learned counsel is this :-

COMPONENTS YEAR OF DEVELOPMENT Body Shells 1970 Frame (Section) 1970 Suitcase Handle 1984 (including handle lug) Soft Grip Handle 1986 Gold Plated Lock Cover 1984 Wheel Bracket Wheels Using since long Castor Wheel Pulling Assembly (CWPA) Since 1985 Divider Flap and Interior 1980 Metallic Green 1992 Coloured Shell with Geometric Grain.

This is only to show that it is not as if that the third defendant being so attracted by the trade dress of the suit cases of the plaintiffs wanted to break into the market as a fresher.

68. By merely looking at the suit-cases one can easily distinguish between the products of the plaintiffs and the third defendant. It is the case of the plaintiffs that the third defendant is using the same colour for the suit cases to cash in on the trade dress of the plaintiffs. In my view, the plea is not tenable. Colour alone is not a decisive factor. No doubt, the products of the plaintiffs and the products of the third defendant are shifted. The other features in the suit cases would show the difference distinctly. The learned senior counsel for the plaintiffs very much laid stress on the trade dress. Except the terminology, I do not find any force in the submissions made on behalf of the plaintiffs that the so called trade dress of the suit cases of the plaintiffs are identical with the suit cases of the third defendant. The observation made by the Privy Council in:

Schwappes Pty Ltd. Vs. The Pub Squash Co. Ltd. (1981) RP 429 (PC) would be apposite to the facts and circumstances of this case and the observation is :-

"The whole question in these cases is whether the thing taken in its entirety looking at the whole thing is such that in the ordinary course of things a person with reasonable apprehension and with proper eyesight would be deceived."

69. I do not want to deal with elaborately about the availability of the raw materials for manufacturing the suit cases and other luggage materials because that was not very much put in issue. I was given the impression that the parties had proceeded on the premise that the raw materials are purchased from the third parties from various countries and that factual position was not disputed by the learned senior counsel for the plaintiffs. Perhaps the plaintiffs thought that that point could be relegated to be decided at the time of the trial of the case.

70. The statement of law by the learned author Lan Morris Barry Quest in, Design The Modern law and Practice, 1987 Edn. is interesting and instructive and it is in the following terms :-

"The traditional view of the extent of passing off was dealt with in *Benchairs Ltd v Chair Centre Ltd*. (1974) RPC 429, CA.

Facts: An action was commenced whereby the plaintiff alleged infringement of registered design and passing off by the Defendant's chair. The first instance decision of Graham J was overruled by the Court of Appeal on the ground they did not agree with the judge's finding. The Court of Appeal took the view that where they clearly disagreed with the first instance judge's view on infringement, they had an unfettered duty to disagree and overrule the grant of an injunction or order. The decision is significant however, as in the observations of Graham J on passing off, he said :

"The question then arises whether, as a matter of law, the mere fact of the similarity between two articles can ever give rise to a claim for passing off. The plaintiffs assert that it can on the basis that the shape of the article itself is an attribute equivalent to get-up in the sense normally used in trade mark cases, and thus in the Haig 'Dimple' whisky bottle case (*John Haig & Co. Vs. Forth Blending Co. Ltd and Paterson* (1953) 70 RPC 259) and in *Coca-Cola Co Vs. Barr & Co.* ([1961] RPC 387) which both concerned bottles of unusual shape, and in *Hoffmann-La Roche Vs. DDSA Pharmaceuticals Ltd.* ([1972] RPC1, CA), which was concerned with a distinctive green and white capsule, being authority for such a proposition. In these cases it is said the articles sold are the bottle of whisky, the bottle of Coca-Cola and the capsule containing the drug, those articles as such have a distinctive shape or appearance characteristic of the proprietor, and that anyone who sells articles of a similar shape or distinctive appearance is liable to an action for passing off.

...the defendants say there can never be an actionable wrong of passing off merely upon proof that one person is selling an article which is the same or similar in appearance to another article, it being a fundamental right, so far as passing off is concerned, of any member of the public to copy an article of any other person and to sell it provided that no representation, either directly or indirectly, such as by similar get-up is made that the defendants' article emanates from the plaintiffs.' It is interesting in the context of this chapter that the judge, in considering passing off, specifically excluded consideration of other grounds of action based on infringement of design of letters patent or of design copyright. Thus the interrelationship demonstrated in this chapter is of considerable significance in selecting the cause of action. In the *Plix* case referred to at 6.3.2, the defendants failed, partly on the ground that they had, in fact, adopted the get-up in terms of colour, size of container and so forth. Graham J went on to state :

"The essence of passing off is "the false representation by the defendant that his goods are those of the plaintiff as has been laid down by the authorities for well over a century in numerous cases." ([1974] RPC 429 at 435) .. If there is no such false representation there can be no passing off, and the mere copying of the shape of the plaintiffs' article is not in itself such a representation. Anyone is entitled, subject to

some monopoly or statutory right preventing him, to copy and sell any article on the market, and false representation and passing off only arise when a defendant does something further which suggests that the article which he is selling is that of the plaintiff. This he may do by a direct representation to that effect such as by the use of the plaintiff's name or mark, or by an indirect representation such as by imitation of get-up by enclosing the article in a distinctive package which is similar to that used by the plaintiff.

Graham J said:

'These cases are binding on this court and make it quite clear in my judgment that there must be something more than mere similarity between the goods themselves to amount to a representation constituting passing off... The only qualification I would wish to make to the propositions of law set out above is that I think there might be a case where an article itself is shaped in an unusual way not primarily for the purpose of giving some benefit in use or for any other practical purpose, but in order purely to give the article a distinctive appearance characteristic of the particular manufacturer's goods. In such an event it seems to me possible that such manufacturer must be able in course of time to establish such a reputation in such distinctive appearance of the article itself as would give him a cause of action in passing off if his goods were copied, because in the circumstances assumed the putting of the copy on the market would amount to a representation that it emanated from the plaintiff. Such a possibility is no doubt remote but it is not impossible, and the holding of passing off would not be inconsistent with any of the cases cited above.' In the instant case he rejected passing off and therefore the summary of law was not called upon to be considered on appeal, but it is suggested that the traditional scope of the tort of passing off is accurately and amply set out in that judgment."

71. The learned senior counsel for the plaintiffs for the purpose of buttressing the case for the plaintiffs relating to the passing off relied upon a market survey. It was submitted by the learned senior counsel for the plaintiffs that the market survey was conducted by an independent agency. The sample taken was wide enough to comprehend the impression of the public coming within the wide net of the survey. The total blind study was adopted by the plaintiffs which is a method to find out the position of the products in the markets. At the time of the arguments it was contended on behalf of the plaintiffs that the market survey adopted by the plaintiffs is known as 'Squirt Format' and that method came to be adopted in the United States after the judgment in:

Squirt Co. Vs. Seven Up Company, 207 USPQ897.

72. The learned counsel for the defendants submitted that the survey evidence was filed after the plaintiffs had instituted the action that while it was made to appear as if that the survey was conducted in February 1997. From the affidavits it transpires that the interviewers were approached in April 1997. The survey was totally biased. The survey stated to have been done on totally blind basis. The entire survey is cooked up and the survey report is contrary to the well settled principles.

Having regard to this submission, not with a view to dealing with the relevant contentions of the learned counsel for the parties it is only to record that such a submission was made, at this stage, without the concerned parties being put to cross examination on the basis of additional documents now filed the Court cannot decide the issue. The plaintiffs cannot project the survey report unless the persons concerned are put into the witness box and subjected to cross-examination by the other side. Therefore, it is unnecessary, in my view, to deal with the affect of market survey conducted by the plaintiffs and at this stage it is wholly irrelevant.

73. Having regard to the well settled principles and considering the facts of this case in the light of the principles, I am unable to persuade myself to accept the submissions made on behalf of the plaintiffs. The learned senior counsel for the plaintiffs submitted that there was some connection between the plaintiffs and the second defendant sometime ago and taking advantage of that situation, the second defendant had attempted to imitate the work of the plaintiffs. This particular point cannot be decided unless evidence is let in and the parties are subject to cross-examination. As it is, on the basis of the materials placed before me, one cannot come to any conclusion in favour of the plaintiffs.

74. In fine, I am very clear in my mind that the plaintiffs have not made out a, prima facie, strong case for the grant of injunction and accordingly I.A.1616/97 is dismissed and I.A. 2920/97 filed by the defendants is allowed and the ad-interim injunction granted stands vacated. There shall be no order as to costs.

Post the matter for further proceedings before the regular Court on the 15th of July 1998.