

Dart Industries Inc & Anr vs Polyset Plastics Pvt Ltd & Ors on 1 August, 2018

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Author: Yogesh Khanna

Bench: Yogesh Khanna

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+ CS(COMM) 630/2018

DART INDUSTRIES INC & ANR Plaintiffs
Through: Mr.Hemant Singh, Ms.Mamta
R.Jha, Mr.Pranav Narain and
Ms.Shrutttima Ehersa, Advs.
versus

POLYSET PLASTICS PVT LTD & ORS Defendants
Through: Mr.Sudhir Chandra, Sr. Adv. with
Mr.Jatin Zaveri and Mr.Neelkamal
Mishra, Advs.

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CORAM:
HON'BLE MR. JUSTICE YOGESH KHANNA

YOGESH KHANNA, J.

IA No. 14512/2014 and 10831/2015 in CS(COMM) 630/2018; IA No. 14515/2014 and 10849/2015 in CS(COMM) 631/2018

1. The plaintiff has filed this suit against the defendants for infringement of its designs of bottles and

caps in any size including 500ml, 750ml or 1 litre bearing the impugned designs or any other designs as may approved or obvious imitation of the plaintiff's design registration no. 221424 and 221425 amounting the infringement thereof.

2. The plaintiff alleges:

a. the plaintiff no.1 is a company incorporated under the laws in Delaware USA and the plaintiff no.2 is a company incorporated under the Companies Act 1956. The plaintiff's belong to Tupperware Brands Corporation. The plaintiff no.1 being its subsidiary located in Florida USA;

b. tupperware Brands Corporation is a globally known as a multi-brand, multi-category, direct sales company. Prior to 2005 Tupperware brands corporation was known as Tupperware Corporation. It sells products under 8 brands consisting of Tupperware, which represents food preparation, storage and serving solutions for the home;

c. plaintiff no.2 was incorporated in the year 1996 as the subsidiary of plaintiff no.1 to carry on the business of distribution and marketing, interalia of food grade plastic storage containers and other products. Plaintiff no.1 is the owner of intellectual property rights including the proprietary know-how, innovative possession, trade secrets related to the Tupperware products, which are the culmination of the extensive research effort and investment by the plaintiff no.1's predecessor companies or subsidiaries or sister concerns or as a collective effort of each of these affiliates of the plaintiff no.1 the labour, skill and judgment in addition to financial investments used for the manufacture by Tupperware products has resulted in the creation of novel and original design, moulds and drawings relating to Tupperware product;

d. the plaintiff alleges they have acquired widespread reputation in the market in respect of its product viz. aqua safe bottle which design includes the cap, created by Famia E. Ablo, a professional designer working with plaintiff no.1 as industrial designer. Since plaintiff no.1 is the proprietor of the design in question so it applied for registration of the said design with United States Patent and Trademark Office vide application No.29/310,710 (Bottle) and Application No.29/310,711 (Cap) dated 5th September, 2008 in class 09- 01 and 09-07 respectively. The said design applications were granted US design registration nos. 609, 104 S dated 02.02.2010 (bottle) and 613, 160-S dated 06.04.2010 (Cap) the design, copy of design and registration certificates are placed on record. On grant of the US design no. 609,104-S, plaintiff no.1 took steps to file and obtain the aqua safe bottles design (including cap) in several countries including India by claiming same priority as US design application referred herein above namely 05.09.2008. The said bottle design is registered in 20 countries and the cap design in 19 countries. Accordingly design applications were filed before the Controller General of Patents, Designs and Trade

Marks, India on 23.03.2009 claiming priority from the US Design 609,104 S (for Bottle) and US Design No. 613,160 S (for the Cap) whose priority dates were date of filing of their applications before USPTO on 05.09.2008. The said applications were granted design no. 221424 for bottle and design no. 221425 for cap design respectively;

e. the Aqua safe bottle is new, original and extremely popular in Indian market and acquired tremendous goodwill and reputation. Aqua safe bottle is one of the largest selling products of the plaintiff. The sale of the 500ml and 1litre bottle have raised from 5.6 crores and 15.2 crore in the year 2010 to 15.8 crores and 35.2 crores in the year 2013. The bottles are stated to be unique, distinctive, original, long- lasting, non-toxic and non-carcinogenic material. It is alleged the shape is neither functional nor utilitarian from the nature of goods with any second value to the functioning of the bottle and cap;

f. the plaintiff in December 2012 have launched another water storage product with a unique and novel design cap herein referred to (flip top) along with registered bottle design hereinafter referred to a (Eco flip top bottle) the feature of novelty in the eco flip top bottle resides in its flop top cap design which is unique, novel and aesthetically attractive original design created by the expert designers engaged by the plaintiff no.1 for consideration paid. The photograph of the bottle is given in the para 21 of the plaint and the sale of 750 ml (flip top bottle) has been raised from 2.8 crores in the year 2012 to 22.9 crores in 2013;

g. it is alleged in the second week of May 2014 the plaintiff came to know that the defendant have been selling bottles identical to the design of the plaintiff as shown in para 24 of the plaint. The plaintiff engaged an independent investigator on 25.06.2014 which disclosed the sale of Glaze wow bottle by the defendant imitating the Eco flip top bottle;

h. the plaintiff has taken me to various documents viz. the photographs of the bottle manufactured by the plaintiff and that of the defendant showing similarity even in its cap. The registration certificate of design 221424 was granted on 05.09.2008 for 10 years from the date of its registration. The certificate No.8742 dated 23rd December, 2009 is filed on record and it gives a view of the bottle and its cap. The certificate also contains the claim of the plaintiff viz the novelty resides in the shape and configuration of the bottle and not to its mechanical, other action, mechanism or in respect of any mode or principle of construction of article. Similarly the registration certificate No.8896 dated 13.01.2010 pertaining to design No.221425 is for the cap of the bottle w.e.f. 05.09.2008 and also depicts different views of the cap and the certificate says the novelty resides in the shape and configuration of the cap;

i. the registration certificates from the USPTO in respect of the design of the bottle and of cap has also been filed along with list of documents. The plaintiff also filed various invoices from 2009 onwards and various promotional material issued in India to show the investments made in advertising the product. The investigator's report revealed defendant no.2 is the mould supplier to defendant No.1 and since now the defendant No.3 has merged with defendant No.1 so the primary case is against the defendant No1. It is pertinent to mention defendant no.1 though before the Local

Commissioner had name the defendant no.2 as its mould supplier but in its written statement had feigned ignorance of such supplier. It is alleged by the learned counsel for the plaintiff since the plaintiff is a registered owner of the design of the bottle and cap since 05.09.2008 and since the defendant claims its user after the said date hence considering the documents filed along with the plaint, a prima facie case is made against the defendant and hence the interim injunction must continue.

3. On the other hand the defendant in its application under Order 39 Rule 4 CPC says the defendant no.1 have been manufacturing and selling its product Glaze wow bottle since March 2013 and the Glaze wow bottle is registered as design no. 245630 09-02 under the Designs Act and Designs Rule 2001 vide certificate dated 04.10.2012 prior to the suit of the plaintiff and the plaintiff is guilty of suppression of this fact.

4. The defendant alleges prior to the injunction being granted on 05.08.2014 the defendant no.1's sales was Rs.5 crore of glasswow bottles all over India and it is false to say the plaintiff came to know the selling of their bottles only in May 2014.

5. It is alleged by the defendant the plaintiff has also have suppressed there are some more players, large and small, in the market who are manufacturing/selling/marketing the bottle designs, similar to the Aquasafe Bottles of the plaintiff. The defendant has filed a tabulated comparison in para 10 of its application to allege there is nothing distinctive in the design and it is functional in nature; the flip top concept being well known not only for bottles but also for shampoos, moistures etc; and the defendant had earned goodwill and reputation in the market and they have copied the shape from the product manufactured by one Sheelpe Enterprises under the trade mark "Aava". It is alleged the word Glaze wow and polyset are permanently engraved on the bottle which gives its a distinctive look from the bottle of the plaintiff and hence if the injunction is not removed it shall cause irreparable loss and injury to the defendant.

6. Thus the defendant has raised the following issues: (a) the defendant no.1 itself is a registered proprietor of the design of the bottle,

(b) the design is neither new nor original as alleged; (c) the defendant is selling the product since March 2013 till date and the suit is filed in 2014 and (d) the market is already flooded with large and small manufacturers and sellers of the bottle, (e) the design being common, the defendant has copied the shape of the bottle and flip top design which is functional in nature; the flip top being not only used for water bottle but also for other products.

7. The learned senior counsel for the defendant argued the defendant has got a registered design for its Aqua Safe bottle and the plaintiff's having a registered design does not automatically lead to any alleged infringement. It is argued the registration proceedings in the case of designs are not similar to that of registration in the trademarks, as objections are never invited here and hence the certificate of registration does not confer any conclusive right to the owner but has to be tested in the laboratory of the Court and the plaintiff needs to prove its registration is valid and its design new and original, which it has failed.

8. The learned senior counsel for the defendant referred to the following provisions of the Designs Act, 2000 as under:

"Section 2(d)

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

4. Prohibition of registration of certain designs:-

A design which--

(a) is not new or original; or

(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or

(c) is not significantly distinguishable from known designs or combination of known designs; or

(d) comprises or contains scandalous or obscene matter, shall not be registered.

19. Cancellation of registration.--

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

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

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

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

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

(e) that it is not a design as defined under clause (d) of section 2. (2) xxxxxxxx

22. Piracy of registered design.--

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

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

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

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

(2) xxx xxx (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under section 19 shall be available as a ground of defence."

9. The learned senior counsel for the defendant referred to various documents to show the design of the plaintiff is neither new nor original. He referred to Exhibit I viz the design of Aava bottle which had a depression in the middle to show this design was in publication in the year 2005 and the Aava bottle had won an award of World Bottled Water Design Award in the year 2007 as shown at pages No.76-77 of defendant's documents viz; Exhibit J and Exhibit K. The learned senior counsel also referred to para No.3.3.(a) (i) of written statement of defendant No.1. It notes:-

"3.3 Without prejudice to the foregoing, this Defendant respectfully submits that the present Suit is misconceived, untenable and/or the Plaintiffs have no case on merits and are not entitled to any reliefs for the following reasons :

(a) Originality/novelty:

(i) This Defendant states that the alleged novel and original shape/configuration of the Aqua Bottle and Eco Flip Top Bottle (both having the same shape) (hereinafter referred to as "the Bottle Design") in which the Plaintiffs claim copyright was in fact launched in 2005 by one Sheelpe Enterprises under the trademark Aava. In 2007, the said Aava Bottle was nominated for best bottle in PET 2007 World Bottledwater Design Awards. The said Aava Bottle has the identical shape and configuration as the

Plaintiffs' alleged novel and original design. This Defendant states that it is apparent that the Plaintiff is attempting to monopolize the Bottle Design, which has been invented/ created by Sheelpe Enterprises with mala fide motives of curtailing competition. This Defendant states that the Plaintiff has deliberately suppressed that the Bottle Design is in fact invented/created by another and also sought to misappropriate the same. Hereto annexed and marked Exhibit 'I' is a copy of the newspaper article of Aqua Bottle published in Times of India on 5th October 2005. Hereto annexed and marked Exhibit 'J' is a copy of the print out from the website Sheelpe Enterprises. Hereto annexed and marked Exhibit 'K' is a copy of the report dated September 17, 2007 in respect of the 2007 award set out above."

10. The plaintiff in its replication replied:-

"3.1(a) The contents of the para under reply are wrong and incorrect, hence denied. It is denied that the Plaintiffs are disentitled to any reliefs as the Plaintiffs have suppressed relevant/ material facts in the course of its submissions with the motive to mislead this Hon ble Court. It is further denied that the present suit ought to be dismissed. It is respectfully submitted that the allegations made in para under reply are vague and bald. It is respectfully submitted that the Defendant No.1 has not specified as to what fact has been concealed from this Hon ble Court by the Plaintiffs. Such vague allegations are liable to be rejected outrightly being misleading and incorrect."

11. It is argued by the defendant the details of the Aava bottles is denied by the plaintiff only for want of knowledge which is an evasive reply and hence an adverse inference ought to be taken against the plaintiff. It is argued what is registered is the shape and configuration of the bottles of the plaintiff and not its service pattern as the plaintiff allege the bottle is convenient to hold from its middle thus it is neither new nor original since its shape is same to Aava bottle which is in public domain since the year 2005 its publication is prior to that of plaintiff's, hence the plaintiff cannot allege service pattern of the defendant's bottle is same; there being no registration for the service pattern.

12. The learned senior counsel for the defendant relied upon Niki Tasha Private Limited vs Faridabad Gas Gadgets Private Limited 26 (1984) DLT 355 viz:

"22. The principles are clear. The difficulty lies in their application. On the recent designs in this case the plaintiffs cannot be granted an injunction when there is a serious question to be tried in the suit. If there is any real dispute on the questions as to infringement or validity of the registered design the court will, as a general rule, refuse an interim application. Damages will afford a sufficient remedy. The defendants are prepared to give an undertaking as to damages.

23. I cannot accept the argument that the plaintiffs on the strength of the registration certificate have an absolute right, a right which is good even against independent designers. "The Court is not in the habit of granting injunctions until the title has

been established." "The Court leans against monopolies". The certificate does not establish a conclusive right. It has to be tried and tested in the laboratory of Courts. We must not forget that the registered design of the plaintiffs is of a very recent date. In case of a recent monopoly which is seriously disputed on various grounds such as prior publication, lack of originality, trade variation etc it will not be proper to grant an injunction. There is a serious question to be argued as to whether the design is valid or not, and on the facts I am not satisfied that the balance of convenience requires an interim injunction, particularly in view of the undertaking which the defendants are prepared to give."

13. The learned senior counsel for the defendant urges the defendant is inclined to give an undertaking to pay damages in case its defence is proved to be wrong and hence injunction be vacated as there exist serious questions to be tried. Reference is also made to Kemp and Company And Others vs Prima Plastics Limited 2000 PTC 96 which notes:

"8. However by similarity of such design, the plaintiffs by itself cannot claim the relief sought for in the motion. The prayer for temporary injunction and appointment of Receiver is based on two grounds; (i) the 1st plaintiff is the proprietor of the registered design; and (ii) the plaintiffs have acquired distinctiveness, reputation and goodwill in the said design, and therefore, the defendants cannot pass off the said goods as that of the plaintiffs. It is true that the 1st plaintiff has got its design registered bearing No. 169723 under the Design Act, but it is well settled principle of law that the certificate of registration by itself is not conclusive of the validity of the registration or that such design is new and original."

14. Further in M/s B.Chawla & Sons vs M/s Bright Auto Industries AIR 1981 Delhi 95 the Apex Court held:-

"9. Similar view was expressed by Buckley L.J. on the question of quantum of novelty in Simmons v. Mathieson & Cold (1911) 28 R.P.C. 486 at 494 in these words :

"In order to render valid the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree."

(10) ... On final analysis, it was emphasized that the use of the words "new or original" in the statute is intended to prevent this and that the introduction or substitution of ordinary trade variants in a design is not only insufficient to make the design "new or original" but that it did not even contribute to give it a new or original character. If it is not new or original without them the presence of them cannot render it so."

15. Qua the infringement of the cap it is argued the cap is not registered under class 9-07 of Schedule III of the Designs Act, hence the plaintiff cannot claim any right in the cap. Further, the design in cap is functional, can only be used for moving it and hence the plaintiff could not have got the cap registered as a device.

16. It is argued that eco flip bottle or its cap is also not registered though its infringement has also been claimed and there is a misrepresentation to this extent, there being no averment both the bottles are same and have been registered, though para No.28 of the plaint claims both of these bottles are registered. Hence it is argued there are serious questions to be tried viz a) the design being not new or original as Aava bottle was already in existence since the year 2005; b) the balance of convenience is in favour of the defendant since defendant is doing its business since June 2012 and has been selling its glaze wow bottles; and

c) there cannot be any confusion to consumers since the plaintiff sells its product door to door through licensed dealers whereas the defendant sell its bottles in shops and there being a big price difference between the bottles of the two; the plaintiff's bottles being used by elite.

17. It is argued the defendant has spent huge amount of expenses in the year 2013-14 in promotion and has sold about 1,45,94,063 bottles in that year and hence if stay is continued, the defendant would suffer huge loss of investments made in its product and further there being serious questions involved and since the defendant has agreed to pay damages in case of its failure; the injunction be vacated.

18. The learned senior counsel for the defendant also says the judgment of Apollo Tyres Limited, 2017(72)PTC 253 (Delhi), since was in a case of passing off and not of infringement shall not be applicable as, even otherwise, its peculiar in tyre manufacturing industry to identify their tyres by treads like JK Tyres, and Bridgestone etc and these tread pattern are the source identifiers of its origin hence become trademark of a particular tyre manufacturing unit. The learned counsel referred to Para No.78 of the decision and it notes:-

"78. In the present case, it is the case of the plaintiff that the tread pattern adopted by it in respect of its tyre "Endurance LD 10.00 R20"

serves the purpose of a trademark, i.e. it is source identifier. According to the plaintiff, it is an industry practice that different manufacturers adopt different tread patterns in respect of their tyres. The plaintiff has placed on record the different tread patterns adopted by different manufacturers. Tyres of vehicles, by and large, are black in colour; they are made of the same material, namely rubber compounds; they are all round in shape like a wheel; and they all have grooves which are functional inasmuch, as, they provide the gripping and friction. In this background, prima facie, it appears to this Court that the tread patterns adopted by different manufacturers in respect of their tyres become one of the primary source identifiers apart from their brand names. The manner in which the tyres are displayed in the course of advertising also shows that the tread patterns adopted by the different manufacturers are prominently displayed along with the brand name of the manufacturer. The "face" of the tyre i.e. its tread pattern is what is displayed

by all the manufacturers, while advertising their tyres in publications, hoardings, pamphlets etc."

The learned senior counsel for the defendant further argued the principle of estoppel cannot be urged against the defendant since the plaintiff never acted on any alleged assurance of the defendant and neither the defendant got its trademark registered at the behest of the plaintiff, hence despite its registration of design on a plea its new and original, the plaintiff will yet have to stand on its own legs. It was argued the stray arguments of one of the counsels in cases R.N.Gosain AIR 1993 SC 352, and Ishi Khosla 2007 (34) PTC 370, cannot be relied upon by the plaintiff and if the defendants registration is held to be invalid, the plaintiff would still have to prove the validity of its design.

19. The learned counsel for the defendant as a caution referred to The State of Orissa vs. Sudhansu Sekhar Misra and Ors (1968) 2 SCR 162, which notes:-

"xxxxx A decision is only an authority for what it actually decides. What is of the essence in a decision is its ratio and not every observation found therein nor what logically follows from the various observations made in it."

20. In M/s Amar Nath Om Prakash and Others vs. State of Punjab and Others (1985) 1 SCC 345, which notes:-

"10. There is one other significant sentence in Sreenivasa General Traders v. State of A. P. (supra) with which we must express our agreement. It was said:

„With utmost respect, these observations of the learned judge are not to be read as Euclid's theorems, nor as provisions of the statute. These observations must be read in the context in which they appear .

xxxxx

11. There are a few other observations in Kewal Krishan Puri' s case to which apply which the same force all that we have said above. It is needless to repeat the oft quoted truism of Lord Halsbury that a case is only an authority for what it actually decides and not for what may seem to follow logically from it. We have said so much amount Kewal Krishan Puri's case because the learned Counsel placed implicit reliance upon it though as we shall presently show, we do not see how a mere declaration that the levy and collection of fee in excess of Rs.

2/- per hundred would automatically vest in the dealer the right to get at the excess amount when in fact he did not bear the burden of it and when the moral and equitable owner of it was the consumer-public to whom the burden had been passed on."

21. Further it was argued the plaintiff gave evasive denial of the publication of Aava bottles in the market since the year 2005 and it amounts to an admission of the plaintiff. In Badat and Co. vs East India Trading Co. (1964) 4 SCR 19, the Court held :-

"These three rules form an integrated code dealing with the manner in which allegations of fact in the plaint should be traversed and the legal consequences flowing from its non-compliance. The written-statement must deal specifically with each allegation of fact in the plaint and when a defendant denies any such fact, he must not do so evasively, but answer the point of substance. If his denial of a fact is not specific but evasive, the said fact shall be taken to be admitted. In such an event, the admission itself being proof, no other proof is necessary."

22. Thus it was argued the plaintiff cannot rely upon the defence of the defendant and the plaintiff would still have to prove its design is new and original as the Act requires the plaintiff to prove its design to be new, original and a valid one. Tinkering, here and there, in an existing design can best be a trade variant and do not make a design, much less a new and original; as held in *Wander Ltd. and Another vs Antox India* 1990 (Supp) SCC 727.

23. Heard.

24. Before proceeding to meet the arguments of the plaintiff I need to state the object of registration of designs as observed in *Bharat Glass Tube Ltd. vs. Gopal Glass Work Ltd.* 2008 (37) PTC 1 (SC):

"27.01. Object of registration of designs. The protection given by the law relating to designs to those who produce new and original designs, is primarily to advance industries, and keep them at a high level of competitive progress.

The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods. xxxx

10. xxxx One has to be very cautious unless two articles are simultaneously produced the Court then alone the Court will be able to appreciate. xxxx "

25. In *Dabur India Limited vs. Amit Jain & Anr.* 2009(39) PTC 104 (Del.) (DB) the Court held:

"This Scheme of the Act makes its purpose clear that the underlying principle behind the law providing for registration of a design is that the commercial exigency requires that a specific design should be protected and its infringement prohibited and prevented."

26. A brief look at the provisions viz. Section 2(d), Section 4, 19 of the Designs Act (supra) would reveal of prohibition under Section 4 for registration of such designs which are neither new nor original goes with the argument of the plaintiff, viz. it being first user of design, advertising and selling its bottles, hence a similar design ought not to have been registered in favour of the defendant; the design of the plaintiff having prior registration and publication in India and USA.

27. Admittedly, the defendant has not filed any evidence to show such a design existed prior to 2008. The defendant though relied upon Aava bottles but failed to produce the same. It was so

produced by the plaintiff but a bare look of it reveal the plaintiff's bottle is substantially different in design/shape.

28. Further the defendant itself got the same design registered in the year 2012 saying its new and original, can he now question the registered design of the plaintiff being invalid. In R.N.Gosain v. Yashpal Dhir AIR 1993 Supreme Court 352 and in Automatic Electric Company s it was held:

" 10. Law does not permit a person to both approbate and reprobate. This principle is based on the doctrine of election which postulates that no party can accept and reject the same instrument and that "a person cannot say at one time that a transaction is valid any thereby obtain some advantage, to which he could only be entitled on the footing that it is valid, and then turn round and say it is void for the purpose of securing some other advantage"...."

and further "... The fact that the defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT", it does not lie in their mouth to say that the word "DIMMER" is a generic expression...."

29. The defendant admittedly has got the same design registered as that of the plaintiff claiming it to be new and original, hence it can't allege the plaintiff's design is neither original nor new, but despite that I have compared the bottle and its cap of defendants with that of the plaintiff and I am in no hesitation to say the plaintiff being the originator of such design cannot be deprived of its reward by others applying it to their goods.

30. Section 2(c) of the Copyright Act and Section 11 of the Designs Act are also relevant in this context:

"(c) "Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered;

Section 11 of the Designs Act says:

11. Copyright on registration.--

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

Further section 22 of the Designs Act relate to the piracy of the registered design and it says during the existence of a copyright in any design it shall not be lawful for any person for the purposes of sale to apply or cause to be applied to any article, in any class of articles in which design is registered, the design or any fraudulent imitation thereof, except with the licence or written consent of the registered proprietor, ought to do anything with a view to enable the design to be so applied.

31. Hence once the design of the bottle and cap was registered in favour of the plaintiff it was not lawful for the defendant to apply for the same design and offer it for sale. Admittedly the defendant started using the same shape, configuration etc. after about four years of the registration of design of the plaintiff, hence Section 22 (supra) makes it a case of infringement against the defendant.

32. The argument if a plaintiff can maintain a suit against a registered holder of a design has already been settled in Mohan Lal, Proprietor of Mourya Industries v. Sona Paint & Hardwares 2013 (55) PTC 61 (Del)(FB) wherein it was held:

"4. Mr Justice Manmohan Singh (who is also a member of the Full Bench) vide order dated 30.03.2012 has sought a decision on the following issues:

I. Whether the suit for infringement of registered Design is maintainable against another registered proprietor of the design under the Designs Act, 2000?

17. A composite reading of the aforesaid provisions would show that a plaintiff is entitled to approach the court and plead that his registered design is unique and that the defendant registrant (in a case where he has a registration in his favour as against one who applies an unregistered design to articles in the class of articles qua which registration has been obtained) has obtained registration which is neither new nor significantly distinguishable when compared to the plaintiff's registered design. The assertion in the suit is a right of monopoly. It is quite possible that the defendant on the other hand apart from pleading as part of his defence, those very grounds which are available under Section 19 to seek cancellation of the plaintiff's registration may be able to establish that his registered design is new or original or even significantly distinguishable from that of the plaintiff.

35. Accordingly, our answers to the three issues are as follows:

ISSUE No.I: A holder of a registered design could institute a suit against a defendant who is also in possession of a registered design., ISSUE No.II: A holder of a registered design can institute an action for passing off.

ISSUE No.III: The two actions cannot be combined in one suit."

33. The use of design not substantially different from the registered design would of course, amount to infringement. It is settled law the designs must be protected against imitations since the statutory right of exclusive use is granted only for a limited period of time. Damages can never be an adequate compensation to the plaintiffs if are deprived of their statutory right of commercial exploitation.

34. To find the extent of similarities in design, I may refer to Alert India vs Naveen Plastics 1997 PTC (17) (Delhi), which note:

" 36. Thus for determining whether two designs are identical or not, it is not necessary that the two designs should be exactly the same. The main consideration to be applied is whether the broad features of shape, configuration, pattern etc. are same or nearly the same and if they are substantially the same then it will be a case of imitation of the design of one by the other."

and in Castrol India Ltd. V. Tide Water Oil Co. (I) Ltd. 1996 PTC (16) the Court held as follows :

"26. In a later portion of the judgment it was said:

"...fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement."

28. The petitioner's complaint is relatable solely to the shape of the containers and not to the mode of manufacture. The shape of a drinks bottle or a carton is clearly project able as a registered design even though the purpose behind the shape is to persuade a customer to purchase the contents of the bottle or carton rather than the packaging itself. See Morris & Quest: Design, the Modern Law & Practice para 11.4.2.)"

35. The contention qua existence of other players, big and small producing the same product was dealt with in Apollo Tyres Ltd. v. Pioneer Trading Corporation and Ors. 2017 (72) PTC 253 (Delhi) which notes:

"116. Merely because there are multiple manufacturers of tyres in China who may have planned to capture the Indian market by flooding their tyres with identical tread patterns, as that of the plaintiff or other leading Indian tyre manufacturers, is no excuse to permit the defendant to do the same. If the plaintiff is so minded, and if the plaintiff's interest is jeopardized on account of introduction of the same tread pattern by other manufacturers, it is for the plaintiff to assess the impact of such conduct and to take appropriate action against other manufacturers and distributors such as GOLDSTAR and KUNNYUAN."

36. The learned senior counsel for the plaintiff has, even otherwise, taken me to various documents viz. at pages no. 2 to 30 of index dated 01.08.2014; and at pages no.1 to 31 of its index dated 10.10.2015; pages no.1 to 22 of its index dated 18.04.2016 and to an order dated 12.05.2017 passed in OA 1103-1104/2015 in CS(OS) 8/2016 to show the plaintiff has being vigilant, taking steps against such other players.

37. The defendant's another contention was the shape of the bottle and the cap being functional, hence are not protected under the Designs Act, can be answered in a way every product has its own functionality but one thing which need to be proved by the defendant is if the design is essentially functional. It means there is no other shape or configuration available in which the product can discharge the desired function. Apollo Tyres (supra) rather explains the concept of functionality :

"87. From the aforesaid averments, it is clear that while on the one hand, the plaintiff talked about the "tread pattern" as being one of the most important factors to identify the tyre manufactured by a particular manufacturer, on the other hand, the plaintiff seeks to explain the purpose that "a tread" on a tyre serves, functionally. The submissions of Mr. Lall do not account for the distinction between a "tread" and a "tread pattern". Mr. Chandra has clarified-and I agree with his submission, that no party can claim proprietary over the shape of a tyre, since all tyres are round in the shape of a wheel, which is a functional requirement. No party can claim proprietary over the technique/ practice of providing treads in a tyre, since treads are functional, i.e. they afford the necessary grip between the tyre and the ground during movement of the vehicle to keep it substantially stable. No party can claim proprietary over the technique/practice of having a plurality of ribs, separated by grooves, which create the tread on the tyre. However, that does not mean that the unique pattern of the tread adopted by a particular manufacturer, which constitutes its unique design and shape, would not be entitled to protection as a design - if it is registered, and also as a trademark- if the tread pattern has been exploited as a trademark i.e. a source identifier. What is functional in a tyre are the "treads" and not the "tread pattern".

88. It is clear from the documents placed on record that each of the manufacturers have adopted their unique tread patterns. It is not the defendants case that the tread pattern adopted by the plaintiff is the only tread pattern which can serve the function of providing the necessary grip between the tyre and the ground during movement of the vehicle, so as to keep it substantially stable. This is not, and cannot be, the defence of the defendant since numerous unique trade patterns have been adopted by different manufacturers of tyres the world over. xxx

90. In Cow (P.B.) & Coy Ltd. (supra), the Chancery Division protected the plaintiff's design of rubber hot water bottle. In this case, the plaintiff sued the defendant for infringement of a design of rubber hot water bottle. The registered design showed - on both sides of the water bottle, a series of ribs disposed diagonally on the surface, and extending right upto a narrow side strip at the union of back and front. The plaintiff had claimed novelty in its design in the following terms-

"The novelty resides in the shape or configuration of the article as shown in the representation". The Court held:

92. ... For a defense of functionality to succeed, it is not enough to say that the form has some relevance to the function. If a particular function can be achieved through a number of different forms, then a defense of functionality must fail. For the defence of functionality to succeed, it is essential for the Defendant to establish that the

design applied for is the only mode/option which was possible considering the functional requirements of the products. Even otherwise, as submitted by the Plaintiff assuming that the shape also performs a certain function, that by itself is not determinative of the fact that the design is functional if that is not the only shape in which the function could be performed.

93. No doubt, the tread pattern adopted by the plaintiff in respect of its tyre also serves the purpose which the treads on any tyre serve.

However, if the same function can be achieved through numerous different forms of tread patterns, then the defence of functionality must fail. It was essential for the defendant to, at least, *prima facie*, establish that the tread pattern of the plaintiff was the only mode/ option, or one of the only few options, which was possible to achieve the functional requirements of the tyre. The position which emerges on a perusal of the documents placed on record by the plaintiff is that there are innumerable different and unique tread patterns in existence, adopted by different manufacturers of tyres, which achieve the same objective.

111. Thus the submission of Mr. Lall that the tread pattern adopted by the plaintiff is functional and, therefore, not capable of protection, cannot be accepted. This submission is rejected."

38. Further I may add Niki Tasha (*supra*) relied by defendant is held not to be a good law. *Metro Plastic Industries (Regd.) vs M/s.Galaxy Footwear New Delhi 2000 (52) DRJ (FB)* notes:

"33. Therefore, in our view, neither the extreme view taken in Niki Tasha's case or in Rotomac Pen's case are correct.

34. In our view, these are matters where no hard and fast rule can be laid down. Section 53 creates a right in a registered owner. In the absence of an application for cancellation of the design such a right can be enforced and no defense can be taken based on a ground of cancellation."

39. and also in *Bharat Glass Tubes Ltd. vs. Gopal Glass Works Ltd. 2008 (37) PTC 1(SC)* wherein the Court held:

"8. Therefore, the question is whether the design is new and original. Section 4 which is couched in the negative terms, says that the design which is not a new or original then such design cannot be registered. Therefore, the question is the design which has been prepared by the German Company and which has been sold to the respondent which became the proprietor of it, is a new or original or not. In this connection, the burden was on the complainant to show that the design was not original or new.

10. One has to be very cautious unless two articles are simultaneously produced the Court then alone the Court will be able to appreciate. But in the present case no

design reproduced on the glass-sheets was either produced before the Assistant Controller or before the High Court or before us by the appellant to appreciate the eye appeal."

40. The emphasis is thus on visual images and the test is to keep two bottles side by side to see if those appear to be similar or different. Much less to say the burden of proof is upon the complainant to show the plaintiff's design is not new or original. Suffice is to say the grant of the design, trademark, patent, copyright is though subject to a right of rebuttal but the onus is always upon the defendant/complainant. The plaintiff only need to produce the two products before the Court and by visual imaging the Court may even find if impugned products are substantially similar or different. The defendant herein having failed to discharge its onus hence there is no prima facie challenge to the validity of the design of the plaintiff.

41. Now if prima facie the plaintiff proves its case can damages be appropriate is answered by Castrol India Ltd. (supra) as under :

39. In addition to the prima facie satisfaction that the petitioner's rights under the Act as registered proprietor of the design in respect of the containers has been infringed by the respondents, I am also of the opinion that the balance of convenience requires that the respondents should be restrained from using the design. Besides where there is infringement of a Copyright, an injunction should normally be granted as the matter of course as damages would not be an adequate remedy (See: Penguin Books Ltd. England v. India Book Distributors MANU/DE/0402/1984 : AIR 1985 Del. 29 para 47). In addition in this case it is on record that the respondent No. 1 has been and is still using other designs for sale of its products in the market. No such damages would be suffered by the respondents as cannot be compensated in the event the suit is ultimately dismissed if they are restrained from for selling other products in non-metallic containers with the same or a similar design."

42. Yet another argument of the defendant viz the design is a pattern and not a configuration, one may refer to Webster, Oxford dictionaries to say configuration means arrangement of elements in a particular form of figure or combination. The configuration includes the features that form part of the fabrication of the article itself unlike a pattern which is embossed upon an article. The configuration and pattern could be interchangeably used depending upon manner of use. In Cow (P.B.) Coy Ltd. vs Cannon Rubber Manufacturers Ltd. (1959) Report of Patent Design and Trade Mark Cases (Volume no.14) page 347 it was held:

"It is quite true that in some earlier cases (and I mention, without taking time to recite, Lindley, L.J.'s language in re Clarke's Design, (1896) 13 R.P.C. at pp. 358-361, "shape" and "configuration" has been regarded as something like synonymous terms, used in contradistinction to "pattern" on the one hand or "ornament" on the other. But I do not think it right to say that the division between "shape and configuration" on the one side and "pattern or ornament" on the other is at all rigid; and applying

what I hope is a common sense test to this hot water bottle, I would have thought it right to say that the ribbing is so marked a feature of the bottle as a whole as to be entitled to be described as a feature of its configuration."

43. Further in M/s Selvel Industries vs. M/s. Omplast (India) Suit (L) No.1434/2016 decided on 30.06.2016 and 01.07.2016 it was held:

"I am unable to accept this argument in the manner in which it is placed. Having regard to the nature of the object itself, it seems to me that the wave portion is not an ornamentation or a pattern of the kind that Mr.Khandekar says it is. There are three reasons for holding against Mr.Khandekar:

The first is that the wave-form portion is fused in the process of fabrication into the container or article itself, and has become one with it. There is a unity in this. The wave-form is now inseparable from the rest. While this may not speak to "shape", it certainly speaks to configuration"

44. Page 91 of defendant's documents is a certificate of novelty of Design of defendant and it says the novelty resides in the shape and configuration of the cap, hence the defendant prima facie believes the design was a configuration and not a pattern. In any case, it is the design of the bottle as a whole which is protected under Section 11. It is the design of the bottle as a whole which must be novel and original irrespective of whether a feature is described as a configuration or a pattern.

45. Lastly it was argued by the learned senior counsel for the defendant the registration of cap is in class 09-01 and not under class 09- 07 hence the design cap is not registered. Section 6 and Section 21 (a) of the Designs Act need to be examined in this regard:

"6 Registration to be in respect of particular article. --

(1) A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.

(2) Any question arising as to the class within which any article falls shall be determined by the Controller whose decision in the matter shall be final.

(3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated--

xxxx 21 (a) the exhibitor exhibiting the design or article, or publishing a description of the design, gives to the Controller previous notice in the prescribed form; and Rule 10

10. Classification of Goods.- (1) For the purposes of the registration of designs and of these rules, article shall be classified as specified in the Third Schedule hereto.

(2) If any doubt arises as to the class to which any particular description of article belongs, it shall be determined by the Controller in consultation with the applicant wherever required.

Schedule III Class 9 09-07 Closing Means and attachments Notes:-- (a) Including only closing means for packages. (b) „Attachments means, for example, dispensing and dosing devices incorporated in containers and detachable atomizers."

46. Section 6 and Section 21 and Rule 10 above only talk of class and not sub-classes. The III rd Schedule attached to the Rules show class 9 has its various sub classes and Section 6 and Section 21 only speaks about class and not its sub-classes, hence registration in any of its sub- class would still relate to the main class in which the article is registered. Determination of classification in any case is a matter of adjudication by the Controller and cannot be questioned. Admittedly the plaintiff's registration is for cap and defendant has used it for cap. The products are identical and importantly, the plaintiff's US design registration is in class 09-07.

47. Qua irreparable loss to the defendant I may note admittedly, the defendant even today is carrying on its business and is selling bottles in different designs, as shown in list of documents filed by the plaintiff on 16.07.2018 containing photographs of five such different bottles. Such bottles were also produced in the court, hence it cannot be said the defendant is suffering irreparable loss and injury due to interim injunction granted.

48. Hence the facts stated above do show the plaintiff has the prima facie case in its favour and if injunction is not granted the plaintiff shall suffer irreparable loss/injury and the balance of convenience is also in its favour. Hence the IA No.14512/2014 in CS(COMM) 630/2018 and 14515/2014 in CS (COMM) 631/2018 is allowed. IA No.10831/2015 in CS(COMM) 630/2018 and IA No.10849/2015 in CS (COMM) 631/2018 is dismissed.

49. Before parting with this order, it is noted that the observations made herein are tentative and shall not affect the case of either party at the stage of final determination, post trial.

CS(COMM) 630/2018;and CS(COMM) 631/2018

50. List for admission/denial of the documents before the learned Joint Registrar on 26.10.2018.

YOGESH KHANNA, J AUGUST 01, 2018 DU