

Dart Industries Inc & Anr. vs Techno Plast & Ors. on 21 July, 2016

Author: S.Ravindra Bhat

Bench: S. Ravindra Bhat, Deepa Sharma

\$~

*

IN THE HIGH COURT OF DELHI AT NEW DELHI

RESERVED ON: 23.09.2015

PRONOUNCED ON: 21.07.2016

%

+

FAO (OS) 326/2007

DART INDUSTRIES INC & ANR.

..... Appellants

Through: Mr. S.C. Agarwal, Sr. Advocate with
Ms. Jaspreet Sareen and Mr. Chirag Kher,
Advocates.

Versus

TECHNO PLAST & ORS.

..... Respondents

Through: Mr. Sushant Singh with Mr. Prakash C.
Arya and Ms. Nupur Lamba, Advocates.

CORAM:

HON'BLE MR. JUSTICE S. RAVINDRA BHAT

HON'BLE MS. JUSTICE DEEPA SHARMA

S.RAVINDRA BHAT, J.

1. The plaintiffs, unsuccessful in their application for ad-interim injunction during pendency of their suit for copyright and design infringement as well as for permanent injunction complaining passing off, appeal the decision of a learned single judge.

2. The two plaintiffs filed a suit for permanent injunction against the defendants under Section 22 of the Designs Act, 2000 read with Section 55 of the Copyright Act, 1957. The first plaintiff (hereafter "Dart") is a Delaware, USA incorporated company; the second plaintiff, i.e., M/s. Tupperware India Pvt. Ltd. (hereafter "TIPL") is an Indian company. Dart claims ownership and possession to the proprietary know-how, innovative FAO (OS) 326/2007 Page 1 technology, intellectual property rights and trade secrets in creating the designs used for the manufacture of its products commonly known as Tupperware products. These products- so the suit says- are the result of artistic work in the form of product drawings, mould drawings and moulds over which copyright is claimed. Dart contractually granted to TIPL the right to use its moulds to manufacture Tupperware products and the right to use and apply the proprietary and registered designs in respect of those products for manufacture and offer for sale in India. Dart alleges that it has registered the proprietary designs in

relation to the Tupperware products globally and in India as well. As the designs of these products are new and original, they have become extremely popular in the Indian market and have acquired tremendous goodwill and reputation. The extensive and longstanding use, reliability, high quality and wide publicity of the Tupperware products, has resulted in TIPL's substantial goodwill and reputation in India for the Tupperware products so much so that these products are identified by the customers by their respective design(s) and for being innovative and high quality products. The plaintiffs also claim that these products have won several design awards the world over. The Guinness Book has listed Tupperware products amongst ten greatest inventions of the 20th century. It is one of the seven US companies to recently receive the '2004 Good Buy Award' for its 'Stuffable Storage Containers' which is an award given by the Good Housekeeping Institute in USA. Details of awards won by the plaintiff over the years are furnished along with the plaint. The plaintiffs have also filed various newspaper and magazine clippings to show the goodwill and reputation which Tupperware products enjoy.

3. The plaintiffs claim that the diverse range of Tupperware products is FAO (OS) 326/2007 Page 2 known worldwide for its unique designs, world class quality, technical and functional superiority over similar kind of products produced by many other plastic manufacturers and these products are sold in more than 100 countries around the world. In India, the sales figures, which were `18.83 crores in the year 1998-99, have gone up to `56.47 crores by the end of financial year 2004. The products were marketed in the year 1996 and substantial amounts were also spent on advertising, publicity and promotion to the extent of `6.91 crores in the year 2003-2004.

4. The suit urges that the plaintiffs obtained registrations from the Controller General of Patents, Designs and Trade Marks under the Designs Act and Rules, particulars of which were noticed in a detailed chart in the impugned judgment of the learned single judge. This is an undisputed fact. The suit alleged that the defendants copied the plaintiff's design for their products i.e. food grade plastic storage containers and infringed the plaintiff's designs in these products. The defendants' infringing products' designs are identical to the designs of the plaintiffs' products. Such infringement entitles the plaintiffs to seek restraint of the defendants from manufacturing and marketing these products. These actions of the defendants amount to: (a) design infringement under Section 20 of the Designs Act; (b) copyright infringement under Section 55 of the Copyright Act; (c) defendants are passing off their goods as that of the plaintiffs by copying trade address and trade name etc. which is confusing and similar to that of the plaintiffs goods. Therefore passing off action in injunction is also maintainable; (d) The defendants have copied the designs by adopting reverse engineering methodology; (e) the impugned act of the defendants also amounts to unfair competition and unfair trade practices which also entitles the plaintiffs to claim injunction against the defendants. The FAO (OS) 326/2007 Page 3 plaintiffs described 12 infringing articles of the defendants; description of these articles is set out in Para 6 of the impugned judgment.

5. The Court had granted ex-parte injunction and appointed three local commissioners. They visited the premises and submitted their reports after preparing inventories. The first four defendants filed a common written statement. The eighth and ninth defendants filed separate written statements. The written statements filed on behalf of the first four defendants urged several preliminary objections. One, that the suit filed by the plaintiff under Section 22 of the Design Act is not

maintainable and 12 designs in question were previously published; thus neither new nor original. It was also urged that the first defendant is the sole proprietorship firm of fourth defendant; the second, third and fifth defendants had nothing to do with the suit. The sixth defendant too had nothing to do with the business of the first defendant and was only purchasing the material from the first and fourth defendants. The locus standi of TIPL to file the suit is also challenged on the ground that registration of the designs is in favor of Dart. TIPL was not a licensee to use these designs in India. The territorial jurisdiction of this Court to entertain and try the suit was challenged. The maintainability of the suit under Section 55 of the Copyright Act was challenged stating that the plaintiff has made the disclaimer vis-à-vis the copyright while obtaining the design registrations. It was also alleged by the defendants that there was no trademark or copyright infringement and there is no question of any confusion. It is also contended that passing off action under the Design Act is not even maintainable.

6. The defendants alleged that 'Signora' is the family trade mark of their business. They sell their products under the mark. The products and mark are distinct and have been marketed in cardboard packing material. TIPL, FAO (OS) 326/2007 Page 4 however sells its products in loose form. The written statement urged that there was a lot of difference between the two trade-marks namely 'Tupperware' of the plaintiff and 'Signoraware' of the defendants and, therefore, question of confusion and deception does not arise. The first four defendants manufacture the products in colours, which were never used by TIPL in India. The designs in question are in public domain and the first and fourth defendants prepared them with their own skill and labour and are entitled to do so. They gave their explanation how each design is in the public domain. The eighth defendant stated that he is neither a distributor/stockist nor in any way connected with Techno Plast (first defendant) or its trade; rather it is a company formed with the main objective of dealing in Medical and Pharmaceutical products and has nothing to do with the sale of the goods in question. The ninth defendant took an identical plea.

Impugned judgment

7. The learned single judge was of opinion that the contest in the proceedings was primarily between the plaintiffs and the first and fourth defendants and if injunction is to be confirmed vis-à-vis first and fourth defendants, the question of appointment of any distributors or marketing would not arise. On the other hand, it was said that if the plaintiff was disentitled to any injunction against the first and fourth defendants, then the question whether the eighth and ninth defendants were distributors/stockists or not would be immaterial. The single judge identified four issues on which the application for temporary injunction had to be addressed, viz design infringement; copyright infringement; passing off of trade dress, trade name etc and unfair competition and unfair trade practices.

8. As to design infringement, the single judge noticed previous decisions FAO (OS) 326/2007 Page 5 of this court and various other courts, on the meaning of "publication" 1 and concluded that it meant, contextually, the availability of knowledge or awareness about a particular design in relation to specific articles or products. If such information was available in the public domain that designs were registered in favour of an applicant (here, Dart) it did not strengthen its case, because

registration was only prima facie evidence of novelty and originality, the essential requirements of design protection in law. In sum, the learned single judge ruled that the materials to destroy novelty and to say that the designs were previously published were contained in the book revised new edition (C) 1989 "The Tupperware Cook". The single judge then stated that at the stage of granting or refusing temporary injunction, the court has to assess the prima facie strengths of the parties. The Court took note of an earlier decision, *Ravinder Kumar Gupta v. Sh. Ravi Raj Gupta and Ors.*² that ".....The Court has to consider and look at the designs in question with an instructed eye and say whether there is or is not such a substantial difference between that which had been published previously and the registered design as to enable the proprietor of the registered design to say that at the date of registration that was a new or original design and, therefore, properly registered."

*1Rosedale Associated Manufacturers Ltd. v. Airfix Ltd.*¹, *Hills v Evans*^{1862 LJ (Ch) 457}; *Gopal Glass Works Limited v. Assistant Controller of Patents and Designs & Ors* and *12006 (33) PTC 434* were relied on and cited by the Single judge to determine what kind of publication was necessary to undermine novelty. The Single judge relied on *Gopal Glass* where it was stated that:

"When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration....If the visual effect of the pattern, the shape or the combination of the pattern, shape, dimension, colourscheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design."

1986 PTC 50, *FAO (OS) 326/2007 Page 6* The single judge also relied on *B. Chawla & Sons v. Bright Auto Industries*³, where it was held that there were only little variations in the products already existing and that adding a curve here or there in shape which is well recognized shape of an article of common use in the market cannot make it an article new or original in design. Such a claim was devoid of newness and equally devoid of originality. In the light of all these prima facie findings and observations, it was held by the single judge that the designs lacked originality and the plaintiffs were not entitled to temporary injunction on the ground of infringement of design copyright.

9. The copyright infringement claim of the plaintiff was based on the plea that there existed copyright in the drawings, because they were a product of considerable skill and expense, spent by Darts experts. The claim here was that the drawings were "artistic works" under Section 2(c)(i) of the Copyright Act, 1957. Each mould - created with such drawings cost approximately US \$ 200,000 to US\$ 1,000,000 (approximately equivalent to Rs. 88 lakhs to Rs. 4.4 crores) and has a life of 30 years. Since these works were created during the course of the employment of such experts with Dart, by reason of Section 17 of the said Act, it became copyright owner of the artistic works. The plaintiffs relied on Sections 13 and 14 of the Copyright to say that the bundle of rights flowing from these entitled them to exclusive rights and that the drawings of moulds also gave them right over 3D and 2D objects and articles; the defendants used such objects and with computer aided programs, were able to misuse the drawings.

10. The impugned judgment rejected copyright claims, stating colour and colour combination by virtue of Copyright Act, cannot result in exclusivity under the law and the case of alleged infringement of copyright under AIR1981Delhi95 FAO (OS) 326/2007 Page 7 Section 45 of the Act is not maintainable. It was also observed that the copyright claimed by the plaintiffs ceased to exist under Section 15 of the Copyright Act. *Samsonite Corporation v. Vijay Sales* 4 was relied on for purpose. It was stated that the drawings in question were prepared by the plaintiffs for the purpose of creating designs for the products to be launched, as alleged in the suit. Description of various processes - from conceptualization of idea, creation of drawings, and moulds, leading to the manufacture of the product was for the purpose of product creation. *Microfibres Inc. v. Girdhar & Co. & Ors* 5, *Polymer Papers Ltd. v. Gurmit Singh and Ors* 6 and *Samsonite Corporation v. Vijay Sales* (supra) were followed and applied. The single judge held that since industrial drawings and designs were for the purposes of manufacturing of filter related machines or components and as such clearly fell within the meaning of design - defined in the Designs Act. The court held that the claim of copyright in the industrial drawings and designs, which were being used for manufacturing purposes, is not maintainable. The plaintiff's argument that Tupperware Products were "reverse engineered" by using its drawings with computer techniques possibly by 2D or 3D scanning was held to be something that required evidence. However, prima facie, the court held that that once drawings were made for creating the ultimate product design, the copyright in the said drawings cannot be claimed under the Copyright Act. It was observed that Section 15 of the Copyright Act provides that once a design is registered under the Designs Act, copyright therein shall not subsist. Such a copyright in any design ceases even when any article to which the design has been applied has been reproduced more than 50 times 1998 (18) PTC 372 128 (2006) DLT 238 2002 (25) PTC 327 (Del.) FAO (OS) 326/2007 Page 8 by an industrial process by the owner of the copyright. The underlying message is that the Designs Act governs copyright in an industrial design. If a design is registered under that Act it is not entitled for protection under the Copyright Act. *Warner Brothers v. Roadrunner* 7 was cited and relied on. However, the court felt that since there were serious disputes which needed evidence before the plaintiff could establish copyright infringement by showing that its copyright survived despite design copyright registration and also show that such copyright had tremendous reputation, it would not be safe to injunct the defendants.

11. The single judge considered the allegation of passing off, which was based on claim of visual similarity and likelihood of confusion. The impugned judgment states that the plaintiff's representative noticed that women who were visiting the defendants' stall in an exhibition were getting confused as to whether the products on display were the products of Tupperware and whether the said products were an imitation. Noting that in a report, the plaintiff admitted that the salesman was asserting that their products, namely Signoraware Products though were a look alike of Tupperware Products, they were being sold at half the price of Tupperware Products. Thus, the representation held out by the defendant was not that the goods were Tupperware Products. On the contrary, representation was that they were the products of a different manufacturer namely Signoraware Products and were being sold at half the price of Tupperware Products though they were look alike of Tupperware Products. Thus, in terms of this statement by the plaintiff, the defendants were not passing off their goods as that of Tupperware Products. The representation was that though they were similar to Tupperware, they were also cheap. This representation about half 71988 FSR 292 FAO (OS) 326/2007 Page 9 the price of the Tupperware Products meant that the

defendants were making it clear that though the products were not Tupperware Products but they were equally good and were sold at half the price of Tupperware Products. The single judge also observed prima facie that the defendants were, at the most, puffing up their product by alleging that they were of the same quality as Tupperware Products and selling at half the rates but had not created or tried to create any confusion. Rather, they were selling their own product, represented to be as good as that of plaintiffs' products. The question of passing off, therefore, did not arise. In *Microfibres Inc. v. Girdhar & Co. and Ors.* (supra), the Court denied injunction, inter alia, on the ground that the two products were sold under a totally different trade name. For these reasons, it was held that prima facie, there was no confusion and the claim for passing off, was not strong.

Submissions by parties

12. Mr. Sudhir Chandra, learned senior counsel, submitted that the learned single judge fell into error in not seeing the painstakingly built reputation of the plaintiff, in respect of its uniquely designed articles. It was highlighted that shapes and colours acquire distinctiveness and are protectable in law. He highlighted that a passing off action is not confined to a claim of a trademark; it covers trade dress, product shape, packaging, colour, visual and overall representation of the article to the consumer. Counsel placed reliance on *Vicco Laboratories Bombay v Hindustan Rimmer*⁸ and he relied on other decisions in this regard.⁹

13. According to learned senior counsel, the visual appeal and presentation *AIR 1979 Del 114 Castrol Ltd v O. MuraliDhar Reddy & Ors*²⁰⁰¹ (21) PTC 134 (Mad); *M/s Anglo Dutch Paint, Colour and Varnish Works v M/s India Trading House* *AIR 1977 Del 41*; *Richardson Vicks Inc v Medico Laboratories* 1985 (5) PTC 167 (Del);

FAO (OS) 326/2007 Page 10 of a product or article is of paramount importance to a customer. In the case of Tupperware products, the goods sold are known for their uniqueness and novelty, the world over. The shapes and functional features of the products, were unique; even the overall get up- including the colour combinations used for each article, have independent design and trade dress appeal. Emphasizing that the court should be careful in analyzing the passing off claim, it was submitted that a plain comparison of the plaintiffs' Tupperware goods and products with that of the Defendants' goods and articles would bring home the proof that the defendants were copying the plaintiff's designs; they showed visual similarity and likeness to the plaintiff's Tupperware goods. Learned counsel relied on *Lakshmikant Patel v Chetanbhai Shah*¹⁰ where it was held that:

"8. It is common in the trade and business for a trader or a businessman to adopt a name and/or mark under which he would carry on his trade or business. According to Kerly (Law of Trade Marks and Trade Names, 12th Edition, para 16.49), the name under which a business trades will almost always be a trade mark (or if the business provides services, a service mark, or both). Independently of questions of trade or service mark, however, the name of a business (a trading business or any other) will normally have attached to it a goodwill that the Courts will protect. An action for passing off will then lie wherever the defendant-company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to

occasion a confusion between the two businesses. If this is not made out there is no case. The ground is not to be limited to the date of the proceedings; the Court will have regard to the way in which the business may be carried on in the future, and to its not being carried on precisely as carried on at the date of the proceedings. Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.

10. A person may sell his goods or deliver his services such as in case 2002 (3) SCC 65 FAO (OS) 326/2007 Page 11 of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by Courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of some one else to himself and thereby resulting in injury."

14. It is argued that the impugned judgment is in error in its interpretation and applicability of M/s SmithKline Beecham Pic and Ors. V. M/s Hindustan Lever Limited & Ors¹¹. The Single Judge it is urged, incorrectly relied upon the defendants' representation in one incident without considering that similarity/confusion in the products is not to be judged by the claim of the parties but rather by what the products are saying and representing about themselves. It is urged that what is to be seen is whether the products are similar or are creating confusion and not what the sales representative informs the customer.

15. It was submitted that the single judge did not go into the question of passing off, based on trade dress similarity in the products- though there was sufficient material on this aspect but on the other hand, brushed it aside, saying that once the design copyright claim was held to be unsound, the question of shape based trademark confusion did not arise. It was submitted 2000 PTC 83 FAO (OS) 326/2007 Page 12 in this context that the Trademarks Act recognizes that shapes are capable of protection and are included in the expression "trade-mark".¹² He relied on the decision of the Bombay High Court in GorbatschowWodka KG ¹³. Counsel highlighted the test indicated by the Court in that case, which is extracted below:

"The test is whether the shape that has been adopted by the Plaintiff is one that is adopted capriciously, purely to give the article a distinctive appearance or characteristic of the goods of the manufacturer. If that be so, the manufacturer may be able to establish that he has a reputation and goodwill in the distinctive

appearance of the article itself which would furnish a cause of action in passing off."

The appellant/plaintiffs also submit that conscious deception and striking resemblance in shape, configuration and pattern of the Infringing Products to the Tupperware Products is evident from a first glance at the infringing products without going into the minute details of size, capacity, design, material used, colour combinations, product finish and the logos and trade names. Several cases are cited in support of the contention that colour combinations, shape and colour etc are important source identifiers which cannot be appropriated by a rival trader, without legal consequences.¹⁴

16. On the copyright claim, learned senior counsel argued that the impugned judgment is in error in holding that since the design claim is unsubstantiated, there can be no question of an independent copyright in respect of the drawings and moulds. The decision is in error, in concluding that only if 'product drawings' were intended for manufacture, as against the Under the Trade Marks Act 1999, the shape of goods is now statutorily recognized as being a constituent element of a trademark. Section 2(zb) of the Trade Marks Act, 1999, define the expression "trademark" to mean "a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others" and to include "shape of goods, their packaging and combination of colours".

2011 (4) BCR 1 14M/s Vicco Laboratories Bombay v. M/s Hindustan Rimmer, Delhi - AIR 1979 Del 114;

FAO (OS) 326/2007 Page 13 purpose of keeping the artistic quality of the said drawings, then such 'product drawings' would not qualify as 'artistic work' under Section 2(c)(i) of the Copyright Act, 1957. It is contended that the decision in Samosonite Corporation was wrongly relied on. It is emphasized that the Division Bench judgment in Micro Fibre Inc vs Girdhar & Co¹⁵ holds that original paintings/works which may be used to industrially produce the designed article would continue to fall within the meaning of 'artistic work' defined under Section 2(c) of the Copyright Act and would be entitled to the full period of copyright protection as evident from the definition of 'design' under Section 2(d) of the Designs Act. It is further submitted that moulds are 'engravings' covered within the definition of 'artistic works' under Section 2(c) of the Copyright Act and that under Section 14 (c) of the Copyright Act, the Appellants have exclusive rights to reproduce the artistic work in any material form. The impugned judgment erred in not considering that the Appellants copyright in the 'moulds' and in the 'drawings' has been infringed by the defendants as they have, by a reverse process of preparing drawings from the plaintiffs products and moulds therefrom, infringed copyright twice, once in the 'drawings' and again in the 'moulds'. The Calcutta High Court in Smithkline Beecham Consumer Health Care V. Eden Cosmetics Ltd held that copyright can be claimed in a 'mould' under Section 14 (c) of the Copyright Act 1957.

17. Learned senior counsel faulted the impugned judgment on the ground that Dart was author and proprietor of the registered designs comprising combination of shape, pattern and configuration. These vested Dart with copyright in the said designs by virtue of Section 11 of the Designs Act, 2000 and acquired an exclusive right to apply and cause to be applied to the 152009 (40) PTC 519 (Del) FAO (OS) 326/2007 Page 14 Tupperware products the registered design comprising the features of

shape, pattern and configuration etc. which appeal to the eye. These designs were original and novel and were created with the extensive knowledge, search, skill, labour and monies invested over several years by Dart's engineers and experts. Dart allowed and consented to TIPL's use of the said registered designs on the Tupperware Products as part of a worldwide arrangement as well as for the Tupperware Products to be offered for sale in India by TIPL. Unlawful use constituted a piracy of the registered design under Section 22 of the Designs Act, 2000. The defendants' use of the same designs, are a fraudulent or obvious imitation of Dart's registered designs to enable sale of the infringing products. The striking similarity between Tupperware Products and the infringing products results in consumer's confusion evidenced from the market survey report dated 10.12.2004 submitted by AC Nielsen ORG MARG, an independent reputed survey organization. The affidavit of the Notary Public who witnessed the reaction of consumers during a visit by him on 18.11.2004 to the IITF also records similar observations. It was contended that the single judge's prima facie opinion that Dart's registered designs were invalid due to lack of novelty or originality due to their prior publication is erroneous. It was argued that the claim of prior disclosure of the designs was wrongly accepted by the impugned judgment. They argued that the defendants' allegation that some of the registered designs are common to trade were unproved and are mere bald allegations. They disputed the defendants' plea with reference to the Tupperware catalogues on the ground that photographs shown in the catalogues do not show designs as a whole and that there was a lack of depiction of the registered design shape, features, pattern configuration etc. The visual effect of the picture illustration in the said catalogues does not FAO (OS) 326/2007 Page 15 give the explicit picture and clear depiction of the application of Dart's registered design on the article as a whole with the same visual effect as the sample of the product. Reliance on the publication in the price lists produced by the defendants on the record of the present case is misplaced and misconceived as the price lists do not relate to the product but only to a part of the product. For instance, in the case of the registered design of 'container crystal wave divided bowl', the price list referred has mentioned of the lid/the seal or a completely different product i.e. 'crystal wave medium', which is a different product altogether.

Defendants' contentions

18. Mr. Sushant Singh, learned counsel for the defendants, urged that the impugned judgment does not call for interference. It was argued that as an appellate court, in an interlocutory matter, the Division Bench should be extremely circumspect in interfering with the prima facie decision of the single judge: reliance was placed on *Wander limited v. Antox India (Pvt.) Limited*¹⁶ and *Mohd. Mehtab Khan & Ors. Vs Khushuma Ibrahim & Ors*¹⁷. It was argued that the impugned decision was based on a detailed analysis and appreciation of the facts; this court should not subject the materials appraised by the single judge as though the present proceeding were a regular appellate review of a final judgment. In the absence of a glaring prejudice to the appellant, on the basis of an important omission to take into account a material circumstance, the court should exercise restraint.

19. On the merits, learned counsel submitted that 13 designs asserted in the plaint are relating to the articles like Bowls, Casseroles, Lunch Boxes, etc., which on the face of them are commonly placed and lack novelty and 16(1990) Suppl. SCC 727 17(2013) 9 SCC 221 FAO (OS) 326/2007 Page 16 originality within the meaning of Designs Act. The learned Single Judge analyzed features of each of

these respective articles and came to the conclusion that all 13 designs were "pre-published" in nature and were trade variants of known designs. Counsel invited attention of the Court to the article-wise comparison of prepublication made by learned Single Judge in para 27 of the impugned judgment. It was submitted that having regard to the limited parameter for appellate intervention the single judge's decision should not be upset. Counsel submitted that mere registration or the fact that the appellant asserted that its products were unique or novel did not necessarily mean that they indeed were. The designs claimed to be unique or novel, were fairly commonplace; the incorporation of some features such as lines etc. did not per se mean that they became unique or design protectable.

20. It was submitted that no fault can be found with the single judge's opinion that design protection refusal meant facially that some other vague and unarticulated trademark right could be successfully asserted. In this context it was submitted that though the decision in *Microlubesis* an authority for the proposition that the lapse of design protection (at the end of the period prescribed for the duration of design registration) did not preclude existence of right to protect trade dress, through an action for passing off, there had to be strong grounds to claim that relief. Likewise, counsel submitted that *Laxmikant Patel* was in the context of trade dress in respect of label, packaging and get up. In the present case, the shape of the product having been held to be not unique or novel cannot claim to be distinctive, which is the basis for a passing off action. Learned counsel particularly relied on the following observations of the single judge:

"Thus, as per this statement of the plaintiff, the defendants were not passing off their goods as that of Tupperware Products. The FAO (OS) 326/2007 Page 17 representation was that though they were of the same type as Tupperware but sold cheap. The very fact that they were representing that they were at half the price of the Tupperware Products means that the defendants were making it clear that though the products were not Tupperware Products but they were equally good and were sold at half the price of Tupperware Products. It is also interesting to note that the plaintiffs themselves say that the comparison of the two products through their experts have revealed that the goods of the defendants are not as good in quality as that of the plaintiffs. Therefore, the defendants were, at the most, puffing up their product by alleging that they are of the same quality as Tupperware Products and selling at half the rates. Thus, they have not created or tried to create any confusion but have clearly told that they are selling their own product which is represented to be as good as that of plaintiffs products. The question of passing off, Therefore, would not arise. The latin maxim "Caveat Emptor" meaning let the buyer beware would, Therefore apply. It was not the case of the plaintiff nor could it be that the trade name of the two products have no commonality as the plaintiffs' products are sold under the trade name of 'Tupperware', whereas the defendants' trade name is 'Signoraware'."

Lastly, learned counsel relied on the judgment of the UK Chancery Division in *Société des Produits Nestlé S.A. v. Cadbury* UK18 for the submission that to protect any claim for distinctive shape of a mark, the applicant must prove that a significant proportion of the relevant class of persons regards the trade mark (as opposed to any other trade mark which may also be present) as indicating the

origin of the goods.

21. As to the submission that the impugned designs violated the copyright in the drawings, learned counsel stressed on Section 15 (2) of the Copyright Act to say that no copyright can subsist in any registered design. Since the plaintiffs were design proprietors in respect of the product, the question of separate copyrights in either the product or the drawings could not prima [2014] FSR 28 (Ch) FAO (OS) 326/2007 Page 18 facie arise. It was urged that though the Division bench ruling in Microfibres (supra) segregates the independent copyright in works of art, it cannot be asserted that copyright can subsist in drawings of purely functional day to day articles, unless they have inherent or minimum creativity. Counsel stressed that the drawings relating to glasses, bowls, etc with some lines added, per se are incapable of copyright protection and the plaintiff's argument that such drawings are artistic works (under Section 2 (c) of the Copyright Act) are insubstantial.

Analysis and Conclusions

22. This Court would first focus on the design claim of the plaintiff, before moving on to the other two aspects. The onus to show that the designs were unoriginal in terms of Section 2(g) of the Designs Act as they were in public domain was on the defendants. To decide this, it is essential to see if there was a prior publication of the designs over which the plaintiffs claimed exclusivity. In this context, the single judge noted that the expression "publication" was not defined in the Act. The Court noted *Rosedale Associated Manufacturers Ltd. v. Airfix Ltd.*¹⁹, where the Court of Appeals had relied on its previous ruling in *Hills v Evans*²⁰ that "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments." The Court of appeals then stated that:

"if a document is to constitute prior publication, then a reader of it, possessed ordinary knowledge of the subject, must from his reading of the document be able, at least, to see the design in his mind's eye and 1957 RPC 239 1862 LJ (Ch) 457 FAO (OS) 326/2007 Page 19 should not have to depend on his own originality to construct the design from the ideas which the document may put into his head...."

23. The single judge clarified that "a person with ordinary prudence while seeing the designs/documents in question is able to relate, in his mind's eye, the same antecedents designs/statements without the necessity of making further experiments i.e. the moment he sees the design, he is able to at once say 'Oh! I have seen before'. Reliance was also placed on *Gopal Glass Works Limited v. Assistant Controller of Patents and Designs and Ors.*²¹, where Calcutta High Court stated that in undermining the novelty of a design registration, prior disclosure must be of the pattern, shape and/or configuration applied to the same article. That High Court's observations about publication are as follows:

"When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration....If the visual effect of the pattern, the shape or the combination of the

pattern, shape, dimension, colour scheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design."

The impugned judgment relied on Paras 3.89, 3.92, 3.93, 3.96, 3.121, 3.147 and 3.181 Russell-Clarke on Industrial Designs (Sixth Edition). It was then noticed that novelty and originality was the bedrock of design protection law and that if the alleged infringer was able to show lack of novelty due to existence of the same design prior to its claim by the plaintiff, the action had to fail. *Niky Tasha India Pvt. Ltd. v. Faridabad Gas Cadgets Pvt. Ltd.* 22, 2006 (33) PTC 434 22AIR 1985 Del 136 FAO (OS) 326/2007 Page 20 which ruled that registration was "only a prima facie evidence" of proprietorship, was relied on.

24. The prima facie lack of novelty in respect of design registration for which the design infringement was alleged and materials published prior to the novelty claim, have been set out and described in great factual detail in Paras 26-27 of the impugned judgment.

25. The painstaking factual analysis thus undertaken by the single judge- both with respect to what in law constitutes prior publication and the application of the law to the given facts of the case, by a comparison of the several designs that are the subject matter of the disputes, in this court's opinion leaves no doubt as to the soundness of the conclusion that prima facie, the designs in respect of which temporary injunction was claimed, were part of the public domain over which protection could not be claimed. *Wander* (supra) and *Mohd. Mehtab Khan* (supra) are categorical that unless the interlocutory appellate court discerns serious infirmity in the reasoning of the court of first instance or trial court, interference in interim orders is uncalled for. As a result, this court holds that there is no scope for holding that the conclusions recorded- prima facie as to the lack of novelty of the designs is erroneous.

26. On copyright infringement the impugned judgment noted that the plaintiffs claimed copyright in the product in question on the ground that the designs which are created involve, inter alia, the making of 'product drawings' based on which the 'mould drawings' are made and ultimately the engravings in the form of 'moulds' is built by Dart, all of which are the 'artistic works' created by the experts during the course of their employment with Dart. The manufacture of each final product commences from the conceptualization of the idea for a design followed by a tedious and lengthy FAO (OS) 326/2007 Page 21 process involving extensive research and application of labour, skill and judgment of the experts employed by Dart, which had relied on an expert's affidavit describing the process of conceptualization and creation of the designs. This, according to Dart, showed that the drawings were its 'artistic works' under the proviso of Section 2(c)(i) of the Copyright Act, 1957. Since these works were created during the course of the employment with Dart, by reason of Section 17 of the said Act, Dart became copyright owner of the artistic works. The plaintiffs relied on Sections 13 and 14 of the Copyright Act; they are entitled to bundle of exclusive right including the right to reproduce the artistic work i.e. the product drawing in any material form including depiction in three dimensions of a two dimensional work or in two dimension of a three dimensional work as well as to make any adaptation of the artistic work. It is also the case of the plaintiffs that

the product drawings and mould drawings created by Dart determine the size and shape of the parts of the mould such that each part of the mould performs its function smoothly so as to arrive at the end product as designed. The plaintiffs argued that the defendants' products are an obvious imitation of the Tupperware Products and there is a material and sufficient degree of objective similarity amounting to deceptive similarity between the two products. Therefore, the defendants have, by manufacturing infringing products, produced 'infringing copies' as defined under Section 2(m) of the Copyright Act, 1957. The infringement is possible by use of computer techniques possibly by 2D or 3D scanning, along with other inspection and measurement tools followed by use of such assimilated designs to ultimately reproduce the assimilated designs in a tangible and finished form i.e. the infringing products.

27. The defendants firstly urged that the plaintiffs have themselves given up their claim pertaining to use of colour or colour combination as appearing FAO (OS) 326/2007 Page 22 in the design while obtaining the registration of the designs under the Design Act. They also stated that question of claiming the said colour and colour combination by virtue of Copyright Act is, impermissible under the law and the case of alleged infringement of copyright under Section 45 of the Act is not maintainable. The defendants argued that the copyright claimed by the plaintiffs ceased to exist under Section 15 of the Copyright Act. *Samsonite Corporation v. Vijay Sales*²³ was relied on for purpose. It was urged that the drawings in question were prepared by the plaintiffs for the purpose of creating designs for the products to be launched, as alleged in the suit. Description of various processes - from conceptualization of idea, creation of drawings, and moulds, leading to the manufacture of the product was for the purpose of product creation.

28. The single judge had relied on *Samsonite Corporation v. Vijay Sales* (supra) that unless the plaintiff pleads that the drawings were not for the purpose of manufacture but the drawings were made for keeping the artistic quality of the drawings there cannot be a copyright infringement claim for a design protected article and its underlying drawings. The court held that the claim of copyright in the industrial drawings and designs, which were being used for manufacturing purposes, is not maintainable. Prima facie, the single judge held that that once drawings were made for creating the ultimate product design, the copyright in the said drawings cannot be claimed under the Copyright Act. It was observed that Section 15 of the Copyright Act provides that once a design is registered under the Designs Act, copyright therein shall not subsist. Such a copyright in any design ceases even when any article to which the design has been applied has been reproduced more than 50 times by an industrial process by the owner of the copyright. The 1998 (18) PTC 372 FAO (OS) 326/2007 Page 23 underlying message is that the Designs Act governs copyright in an industrial design. If a design is registered under that Act it is not entitled for protection under the Copyright Act. *Warner Brothers v. Roadrunner*²⁴ was cited and relied on.

29. The term "artistic work" has been defined expansively in the Copyright Act. Section 15 (2) of the said Act does not apply to artistic works because of the definition of "design" (Section 2(d) of the Designs Act) which states that "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.... 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)." However, this ipso facto does not lead the court to agree with the plaintiff's contention. The language of Section 15 of the Copyright Act makes it clear that copyright does not subsist in a registered design. The rationale for this is that someone's choice of design registration is a conscious decision to use the underlying work, for mass production. The design then reaches, through the medium of the product or the article, a wider audience; it has a commercial element. This is of course possible in the cases of designs of products and articles that are sold widely or have a market. Such is not the case with an artistic work- typically a painting a drawing or even a sculpture for instance (which are closest species of copyrights that overlap with designs). Yet the transformation of a work of art into a design results in the 241988 FSR 292 FAO (OS) 326/2007 Page 24 possibility of its protection as a design. Section 15 (1) dictates that if this kind of work is registered as a design, there is no copyright protection. Section 15 (2) on the other hand, says that if a work is capable of design registration, and is not registered, but replicated as a product or article through a design more than 50 times through mechanical process, copyright in that work ceases. This dimension renders the issue complex, because works of art, primarily so, which are also capable of design registration or have been registered as design, would lose even copyright protection, thus undermining creativity and the efficacy of copyright protection itself. This paradox - and the strain in enunciating a satisfactory concord between these two disparate threads of thinking was noticed long ago, in *King Features Syndicate Incorporated and Frank Cecil Betts, the Personal representative of Elzie Chrisler Segar, Deceased v. O & M Kleeman Ltd.*²⁵ In that case, the anthropomorphic cartoon strip character "Popeye the Sailor" used in comics and later in films, was reproduced in the form of toys and brooches. The author, did not industrialize the cartoon character, but later, due to its popularity, he licensed some manufacturers to produce articles in the toys, brooches, etc. The House of Lords drew a distinction between copyright under the Copyright Act on the one hand, and "design copyright" under the relevant Designs law. The Court concluded that such design rights are separate and their extinction did not result in cessation of copyright in the work (i.e., the cartoon character in question). It was held that:

".....The statutory definition of design now in force is found in Section 19 of the Patents and Designs Act, 1919, which replaces that given in Section 93 of the Patents and Designs Act, 1907. The operative definition so far as here material is: " „Design means only the „ features of shape, configuration, pattern, or ornament 251941 (48) RPC 207 FAO (OS) 326/2007 Page 25 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". Thus design involves certain elements: there must be features of shape, configuration, pattern, or ornament and these must be applied (or intended to be applied in the words of Section 22 of the Copyright Act) to any article by way of industrial means or process. Section 22 emphasises the same aspects. Designs to which the section is to apply are those used or intended to be used as models or patterns to be multiplied by any industrial process. Thus a design may be the shape of a coal scuttle, a basin, a motor car, a locomotive engine or any material object, it may be the shape embodied in a sculptured or plastic figure, which is to serve as a model for commercial production,

or it may be a drawing in the flat of a complex pattern, intended to be used for the manufacture of things such as linoleum or wall paper. Design copyright is thus to be distinguished from artistic copyright.."

The Supreme Court succinctly set out the object of the Designs Act and Parliamentary intention in affording protection to designs, in *Bharat Glass Tube v Gopal Glass Works Ltd*²⁶. The Court held as follows:

"The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable 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. Thus the primary concern, is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of article of a design not AIR 2008 SC 2520 FAO (OS) 326/2007 Page 26 substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article. "

The Division Bench ruling in *Microfibres* 27 (supra) where the Division Bench observed as follows:

"23. There is, therefore, a clear distinction between an original artistic work, and the design derived from it for industrial application on an article. This position is clarified by the use of the expression "only" before the words "the features of shape, configuration, pattern, ornament or composition of lines or colours" in the definition of "design" in the Designs Act. Therefore, the original artistic work, which may have inspired the creation of a design, is not merely the feature of shape, configuration, pattern, ornament or composition of lines or colours which are created to apply to an article by an industrial process. The original artistic work is something different from the design. Secondly, the definition of "design" expressly excludes, inter alia, any artistic work defined in section 2(c) of the Copyright act, 1957.

27. Under the Designs Act, a copyright has a different connotation from a copyright under the Copyright Act. Under the Designs Act, copyright means the exclusive right to apply the design to any article in any class in which the design is registered.

28. The issue with regard to the extent of, and the conditions for the copyright protection to such an artistic work, as an artistic work under the Copyright Act, which is a design registered or capable of registration under the Designs Act, is what is dealt with, by section 15 of the Copyright Act. Once the distinction between the original artistic work and the design derived from it, and the distinction between Copyright in an original artistic work under the Copyright Act, and a copyright in a design under the Designs Act is appreciated, the meaning and purport of section 15 of the Copyright Act becomes clear.

Microfibres v Girdhar 2009 (4) PTC 519 FAO (OS) 326/2007 Page 27

29. Section 15 of the Copyright Act is in two parts. The first part i.e. sub-section (1) states that copyright shall not subsist under the Copyright Act in any design which is registered under the Designs Act. Consequently once the design is created and got registered under the Designs Act, whether or not the design is eventually applied to an article by an industrial process, the design loses its protection as an artistic work under the Copyright Act. Therefore, subject to whatever rights that are available under the Designs Act, the registered design holder cannot claim protection or complain of copyright infringement in respect of the registered Design under the Copyright Act.

30. Subsection (2) of section 15 deals with the situation where the design, which is capable of being registered under the Designs Act, is not so registered. It provides that copyright in such a design shall cease 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 owner of the copyright or with his licence, by any other person. It is clear to us that the Parliament in Section 15 of the Copyright Act was dealing with the aspect of copyright in a registered/registrable design, as understood in the Copyright Act and not the Designs Act. Else, there was no need to deal with this aspect in the Copyright Act. The same would have been dealt with under the Designs Act. Therefore, the law tolerates only a limited industrial, or shall we say commercial, exploitation of the original artistic work by the application/reproduction of the said work in any other form or reproduction of copies thereof in exercise of the rights under Section 14(c)(1) and 14(c)(iii) of the Copyright Act. Beyond the specified limit, if the design derived from the original artistic work is exploited (i.e. if the design is applied more than 50 times by an industrial process on an article) the copyright in the design ceases unless it is registered under the Designs Act...

***** We do hold that in the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work. Thus, for instance a famous painting will continue to enjoy the protection available to an artistic work under the Copyright Act. A design created from such a painting for the purpose of industrial FAO (OS) 326/2007 Page 28 application on an article so as

to produce an article which has features of shape, or configuration or pattern or ornament or composition of lines or colours and which appeals to the eye would also be entitled design protection in terms of the provisions of the Designs Act. Therefore, if the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act but not the original painting. If it is a design registrable under the Designs Act but has not so been registered, the Design would continue to enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process for more than 50 times is reached. But once that limit is crossed, it would lose its copyright protection under the Copyright Act. This interpretation, in our view, would harmonize the Copyright and the Designs Act in accordance with the legislative intent.

46. We thus summarize our findings as follows: -

- a. The definition of 'Artistic work' has a very wide connotation as it is not circumscribed by any limitation of the work possessing any artistic quality. Even an abstract work, such as a few lines or curves arbitrarily drawn would qualify as an artistic work. It may be two dimensional or three dimensional. The artistic work may or may not have visual appeal.
- b. The rights to which a holder of an original artistic work is entitled are enumerated in Section 14(c) of the Copyright act.
- c. It is the exclusive right of the holder of a Copyright in an original artistic work to reproduce the work in any material form. For example, a drawing of an imaginary futuristic automobile, which is an original artistic work, may be reproduced in the three-dimensional material form using an element, such as a metal sheet.
- d. The design protection in case of registered works under the Designs Act cannot be extended to include the copyright protection to the works which were industrially produced.
- e. A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher FAO (OS) 326/2007 Page 29 protection to pure original artistic works such as paintings, sculptures etc and lesser protection to design activity which is commercial in nature. The legislative intent is, thus, clear that the protection accorded to a work which is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure art.
- f. The original paintings/artistic works which may be used to industrially produce the designed article would continue to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and would be entitled to the full period of copyright protection as evident from the definition of the design under Section

2(d) of the Designs Act. However, the intention of producing the artistic work is not relevant. g. This is precisely why the legislature not only limited the protection by mandating that the copyright shall cease under the Copyright Act in a registered design but in addition, also deprived copyright protection to designs capable of being registered under the Designs Act, but not so registered, as soon as the concerned design had been applied more than 50 times by industrial process by the owner of the copyright or his licensee. h. In the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work per se.

i. If the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act. If it is a design registrable under the Designs Act but has not so been registered, the Design would continue to enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process for more than 50 times is reached. But once that limit is crossed, it would lose its copyright protection under the Copyright Act. This interpretation would harmonize the Copyright and the Designs Act in accordance with the legislative intent."

30. Therefore, unless a work of art is capable of design protection and has been registered as a design, or should have been registered as a design, the copyright in the underlying artistic work subsists independently of design rights. In this case, the work is protected as a design; the averments in the suit are that design registration subsists in respect of the products which the FAO (OS) 326/2007 Page 30 defendants are alleged to have infringed. In the circumstances, the question of asserting a copyright infringement claim, independently, when the design protection subsists, but infringement has not been prima facie established, cannot arise at all. Nevertheless, this court would proceed that arguendo, such claims would need to be examined at this stage.

31. For copyright protection (since the plaintiff asserts that the drawings of the products, i.e., bowls, etc) are "artistic works" the essential pre- requisite for protection, should be "original" under the Act. The content of what is "original" has undergone considerable change from the previously applicable "sweat of the brow" doctrine spelt out in *University of London Press (supra)* to the "modicum of creativity" standard put forth in *Fiest Publication Inc. v. Rural Telephone Service*²⁸. The Supreme Court has also signified a shift in *Eastern Book Company & Ors. v. D.B. Modak & Anr*²⁹ following the Canadian Supreme Court's judgment in *CCH Canadian Ltd. v. Law Society of Upper Canada*³⁰, it rejected the sweat of the brow doctrine, (which conferred copyright on works merely because time, energy, skill and labour was expended, that is, originality of skill and labour), and held that the work must be original "in the sense that by virtue of selection, co- ordination or arrangement of pre-existing data contained in the work, a work somewhat different in character is produced by the author". The Supreme Court noticed that the two positions i.e. the sweat of the brow on the one hand, and "modicum of creativity" were extreme; it preferred a higher threshold than the doctrine of "sweat of the brow" yet, not as high as "modicum of creativity". Therefore in India too, the law has recognized the ²⁸(1991) 199 US 340 ²⁹2008 (1) SCC 1 ³⁰(2004) SCC 13 FAO (OS) 326/2007 Page 31 shift, and mandates that not every effort or industry, or expending of skill,

results in copyrightable work, but only those which create works that are somewhat different in character, involve some intellectual effort, and involve a certain degree of creativity. This standard of originality is now applicable in respect of the plaintiffs' claim to copyright of its drawings. There are further limitations in the law of copyright such as the idea expression merger. By this, Courts have refused to protect (through copyright) the expression of an idea, which can be expressed only in a very limited manner, because doing so would confer monopoly on the idea itself. The decision in *Herbert Rosenthal Jewelry Corporation v. Kalpakian* 31 is illustrative in this regard. The plaintiffs there sued the defendants asking them to refrain from manufacturing bee shaped jewel pins. The Court held that the bee shaped jewel pin was an idea that anyone was free to copy, the expression of which could be possible only in a few ways; therefore, no copyright could subsist in it.

32. In the present case, the copyright protection (and infringement) claim is premised on a bare assertion that the drawings (from which the moulds are made) are artistic works, because considerable amount of money was spent on the making of such molds. Though the court cannot comment on the veracity of such claim, at least the decision in *Modak* (supra) now binds it to examine every copyright claim closely, to see whether there is some minimum creativity. Now, the plaintiff nowhere discloses that the drawings (i.e. the artistic works here) have any inherent capability of art: it is evident that these drawings are of commonplace every day articles used in households. The idea expression doctrine, itself would prima facie prevent copyright protection because the depiction of daily articles cannot per se be 31(1971) 446 F2d 738 FAO (OS) 326/2007 Page 32 "enclosed" to create a monopoly where the legitimate monopoly (design right) which the plaintiffs could have claimed, has not been prima facie established by them. For these reasons, it is held that the single judge's reasoning as to the lack of prima facie strength in the copyright infringement claim, cannot warrant interference.

33. On the issue of passing off action the plaintiffs had argued that the new and original designs of their Tupperware Products, had become extremely popular in the Indian market as well as in other countries worldwide and acquired tremendous goodwill and reputation. Sales of those products, the amount spent on research and development etc. and various awards those products had taken was the basis that the plaintiffs' products are well known and have acquired household popularity because of their quality, technical and functional superiority. The defendants' household plastic containers i.e., the infringing products were advertised as 'Microwavable Crockery' made from food grade plastic material meant to be sold to the same class of consumers as Tupperware Products. The plaintiffs argued that the defendants infringed the design and copyright of the plaintiffs by manufacturing and selling infringing products which have a striking resemblance in shape, configuration and pattern of the Tupperware Products. The infringing products, i.e., household goods are being targeted to be sold to the same set of consumers as of the Tupperware Products. The plaintiffs relied on the applicability of the test of impression of an unwary customer, who would be misled into purchasing the infringing product, believing it to be that of the plaintiffs. The application of designs identical or similar to the Tupperware Product designs by the defendants to the infringing products is clearly creating and is likely to further create confusion and misconception in the minds of the customers leading them to FAO (OS) 326/2007 Page 33 believe that the infringing products of the defendants are the products emanating from TIPL while in fact it is not so. It was alleged that the defendants have adopted the registered designs of the plaintiffs and

applied them to its products to encash the reputation and goodwill enjoyed by the plaintiffs and its products that is Tupperware Products manufactured with the registered designs.

34. The identity in trade dress and get up was highlighted in this regard, vis-à-vis the following features:

i) similar designs of the infringing products namely the "4-in-1 Multipurpose Container, the "Atta and Chapati Bowl", "Multipurpose Containers", "Tumbler" and "Slim Lunch Box" and the "Donga" have similar colour combination and identical colour shape, configuration and design.

ii) The infringing product "Snack and Spare Box" being identical in design to the Tupperware product namely "Freezer mate" (700 ml) was also illustrative of the passing off by the defendants inasmuch as the fountain shaped symbol shown on the sidewall and bottom of the Tupperware Product to indicate its use in refrigerator and its utility in the Freezer has been copied and placed at the same place in the infringing product which probably cannot be used in the refrigerator.

iii) Another infringing product namely "4-in -1 Multipurpose Container" and the "Atta and Chapati Bowl" are not only an obvious imitation of the design of the Tupperware Product namely "Crystalwave Divided Bowl" but also have the identical colour combination and even the written instructions on the lid as also the placement of the written instructions and the languages in which this written instructions which are given are identical.

iv) In the case of two of the infringing products namely "Executive Lunch" and "Classic Lunch Box", the defendants have not only made an obvious imitation of the registered designs of the corresponding Tupperware Products but have even used names matching those given to the identical Tupperware Products. Moreover the defendants are actively trying to cash on the goodwill and reputation of the plaintiffs by imitating and/or advertising the design of "Executive Lunch" carry bag recently introduced in the market by the plaintiff which product of the defendants is identical in colour combination to the plaintiffs' FAO (OS) 326/2007 Page 34 product and was found being sold by the defendants at the Trade Fair held in November, 2004. The brochure picked up from the India International Trade Fair shows a new design of the bag of the "Executive Lunch" which is identical in design, colour combination of green and black coloured check, shape and placement of the trade name, material and other configuration used in the bag recently launched by plaintiffs. The time lag between the launch of the infringing product and the Tupperware Product, being short, is helping the defendants in being successful in passing off the infringing products as Tupperware Product to take advantage of the reputation and goodwill acquired by the Tupperware Products. Such a practice is indicative of the intention of the defendants to not only make material and substantial imitation of the design of Tupperware Products but also an attempt to pass off the infringing products as

Tupperware Products.

v) Apart from the overall shape of the infringing products being identical to the shape of the Tupperware Products, one of the infringing products namely "Crazy Bowl" is identical in shape to the state of the art Tupperware Product namely "Serving Bowl" along with "Seal for Bowl" brought to India only for the purposes of being used as an incentive/promotional product and initially not yet sale but intended to be launched for sale in India in the near future. It is submitted that the design of the said product duly registered by plaintiff No. 1 in India is the state of art design using special moulding techniques and machinery to manufacture the said product.

Though the plaintiff No. 2 has only distributed the said product as a promotional item to its sales force and has not yet launched the said product for sale in India, the defendants appeared to have obtained the said product either from a member of the sales force of plaintiff No. 2 or the defendants may have purchased the said product abroad. In the case of the said product the defendants appeared to have not only imitated the said product but have also infringed the copyright in the design. Moreover, the launch by the defendants of the said product in the Indian market after the date of its design registration in favor of the plaintiff No. 1 but prior to the launch of the Tupperware Product in India is also indicative of the defendants actively trying to cash on the goodwill and reputation of the plaintiffs by imitating the design of the "Serving Bowl" sold subsequently in the Indian market. Similar is the case where the defendants have advertised the design of "Executive Lunch."

FAO (OS) 326/2007 Page 35

35. The plaintiffs had argued that the single judge's rejection of this claim is not correct and cited the decision in Microlube India Limited v Rakesh Kumar³². The defendants argued that there is no question of any confusion or deceptive similarity inasmuch as products of the plaintiffs and defendants are sold under totally different trade mark/name namely 'Tupperware' and 'Signoraware' respectively. It is also submitted that neither the plaintiff has alleged in the plaint about the trademark of the defendants nor any relief is claimed against the trademark 'Signoraware'. There is no common law right of passing off provided under the Designs Act.

36. The plaintiffs' assertion of the right to sue for passing off as an independent claim under the common Law not dependent upon the Designs Act was held to be correct: "This submission of the plaintiff appears to be correct. The common law right of passing off is distinct and is available dehors the Designs Act. This was so held by a Single Bench of this Court in the case of Smithkline Beecham Plc. and Ors. v. Hindustan Lever Limited and Ors. 2000 PTC 83". The single judge, however, rejected the passing off claim, in the following terms:

"50. No doubt, it is also alleged that the representative of the plaintiff noticed that women who were visiting the said stall were getting confused as to whether the products on display were the products of Tupperware products or not or whether the said products were an imitation of Tupperware Products. However, in the aforesaid

quoted portion, the plaintiff admits that the salesman was asserting that their products, namely Signoraware Products though were look alike Tupperware Products, were being sold at half the price of Tupperware Products. Thus, the representation held out by the defendant was not that the goods were Tupperware Products. On the contrary, representation was that they were the products of different 322013(55) PTC 61 FAO (OS) 326/2007 Page 36 manufacturer namely the Signoraware Products and were being sold at half the price of Tupperware Products though they were look alike of Tupperware Products. Thus, as per this statement of the plaintiff, the defendants were not passing off their goods as that of Tupperware Products. The representation was that though they were of the same type as Tupperware but sold cheap. The very fact that they were representing that they were at half the price of the Tupperware Products means that the defendants were making it clear that though the products were not Tupperware Products but they were equally good and were sold at half the price of Tupperware Products. It is also interesting to note that the plaintiffs themselves say that the comparison of the two products through their experts have revealed that the goods of the defendants are not as good in quality as that of the plaintiffs. Therefore, the defendants were, at the most, puffing up their product by alleging that they are of the same quality as Tupperware Products and selling at half the rates....

51. There would be another interesting question for determination if the design is no more protected under the Designs Act and is now in public domain, whether passing off action would be maintainable. In view of such question and coupled with the fact that there are certain aspects which will have to be settled through evidence, it may not be a case of injunction.

52. It is not only this reason which persuades me to take this view. The defendants are not a fly by night company. In the plaint, the plaintiff has itself stated that they are manufacturing the products at large scale and selling the same through various retail outlets in Punjab and Haryana and other parts of the country. The defendant No. 1 has three storied factory building measuring approximately 800 sq. yards at Hissar Road, Ambala City, with large number of workers who are working in multiple shifts. Likewise, the defendant No. 6 is also having another factory. It is also stated that the factory of the defendant No. 6 was established in the year 1981. This is not a fit case for grant of ad-interim injunction at interlocutory stage."

37. This court finds considerable merit in the approach of the single judge. Undoubtedly, the Full Bench, in its majority ruling in Microlubes declared that regardless of subsistence of design right - or its exhaustion, a FAO (OS) 326/2007 Page 37 passing off action can lie, in given cases. In so concluding, the court did take into account changes to the Trademark Act, which now extend trademark registration protection even to shapes. However, what is essential in such cases is not merely the existence of the remedy of infringement (of a trademark through a permanent or

temporary injunction) or the remedy against passing off, but the proof of essential elements that are necessary. The plaintiff must plead and prove the distinctiveness of the mark. In the present case, the distinctiveness averred in the suit relates to the mark "Tupperware". There is no assertion- except a general and vague assertion with respect to passing off of trade dress- as to how the shape mark which the plaintiffs seek protection of are distinctive for trademark purposes.

38. In the context of passing off, undoubtedly trade dress and the get up of the packaging, presentation of the product through label, etc constitute essential components of the goodwill and reputation of a commercial enterprise (Ref. Laxmikant Patel). William Grant & Sons Ltd v McDowell & Co Ltd³³ also supports such a proposition. Yet, for seeking even prima facie protection in the nature of interim injunction there should be material disclosing that the general public associates the shape in question (which is asserted by the plaintiff as their distinctive mark or get up) only with the plaintiff. Whilst in the case of trade dress in the form of label or mark, distinctiveness is easily discernable, in the case of shape based trade dress, the plaintiff has to necessarily show that the get up of the product or article (over which certain exclusivity or distinctiveness is claimed) has an integral association only with it. Unless this requirement is pleaded and established, (and for interim injunction purposes, at least prima facie) every product with 1994 FSR 690 (Del) FAO (OS) 326/2007 Page 38 a commonplace shape would "ride" on the reputation of an exclusive trademark, based on a distinctive name, label or color combination of the packaging or label, etc. In this case, the distinctiveness of the shape of the product- asserted to be unique or solely associated with the plaintiff has not been so pleaded and established.

39. As a result of the above discussion, it is held that there is no infirmity with the conclusions of the learned single judge on all aspects relating to the absence of prima facie strength of its case in relation to design protection, copyright infringement and passing off. The appeal fails and is therefore dismissed without any order on costs.

S. RAVINDRA BHAT (JUDGE) DEEPA SHARMA (JUDGE) JULY 21, 2016 FAO (OS) 326/2007
Page 39