

Dart Industries Inc. And Anr. vs Techno Plast And Ors. on 4 June, 2007

Equivalent citations: 2007(35)PTC285(DEL)

Author: A.K. Sikri

Bench: A.K. Sikri

JUDGMENT

A.K. Sikri, J.

1. There are two plaintiffs in this case who have filed this 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 plaintiff No. 1 is a company incorporated under the laws of Delaware, USA. The plaintiff No. 2 namely M/s. Tupperware India Pvt. Ltd. is an Indian company. The plaintiff No. 1 claims ownership and possession to the proprietary know-how, innovative technology, intellectual property rights and trade secrets in creating the designs used for the manufacture of its products commonly known as Tupperware products. It is also stated that these products are the result of artistic work in the form of product drawings, mould drawings and moulds and therefore, copyright is also claimed therein. The plaintiff No. 1 has consented and contractually granted to the plaintiff No. 2 the right to use its moulds to manufacture Tupperware products and also granted the right to use and apply the proprietary and registered designs in respect of those products for manufacture and offer for sale in India.

2. The plaintiff No. 1 has registered the proprietary designs in relation to the Tupperware products globally and in India as well. It is stated that since the designs of the Tupperware products are new and original, the same have become extremely popular in the Indian market keeping with the trend in the other countries worldwide and have acquired tremendous goodwill and reputation. By virtue of the extensive and longstanding use, reliability, high quality and wide publicity of the Tupperware products, the plaintiff No. 2 has generated a 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.

3. The plaintiffs boast that their products have won numerous design awards all over the world. The Guinness Book has listed Tupperware products amongst ten greatest inventions of the 20th century. Home Furnishings News, a weekly newspaper circulated in the United States, has ranked Tupperware products at second place out of 150 US companies that sell home products in terms of brand recognition. 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 given in Annexure P-3 (Colly.). Copy of the publication in which aforesaid awards are given is filed as Annexure P-4 (Colly.). The plaintiffs have also filed various newspapers and magazines clippings in support of goodwill and reputation which Tupperware products enjoy. It is, thus, stated that the diverse range of Tupperware products is known worldwide for its unique designs, world class quality, technical and functioning 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 alone, sales figures which were Rs. 18.83 crores in the year 1998-99 have gone up to Rs. 56.47 crores by the end of financial year 2004. The products were marketed in the year 1996 and the substantial amount is also spent on advertising, publicity and promotion which was Rs. 6.91 crores in the year 2003-2004.

4. The plaintiffs have obtained registrations from the Controller General of Patents, Designs and Trade Marks under the Designs Act and Rules, particulars whereof are as under:

S. No.	Tupperware Products	Registration Certificate number & date
1.	"Serving Bowl"	189685 : 07.02.2002
2.	"Seal for Bowl"	189687 : 07.02.2002
3.	"Soup Server with Ladle"	186134 : 24.07.2001
4.	"Container-Crystalwave Divided Bowl"	188562 : 26.03.2002
5.	"Container-Modular Mate Round"	185951 : 05.07.2001
6.	"Container - Modular Mate Oval"	172740 : 29.11.1996
7.	"Crystal Sheer Tumbler with lid"	172739 : 29.11.1996
8.	"Classic Slim Lunch"	176605 : 05.06.1998
9.	"Lunch Box with Bag"	185956 : 05.07.2001
	Executive Lunch Bag"	185956 : 05.07.2001
10.	"Travel Twin Bag" &	185952 : 05.07.2001
	"Travel Twins with Bag"	185957 : 05.07.2001
11.	"Freezer Mate"	185972 : 06.07.2001
12.	"Freezer Mate" (Small)	185975 : 06.07.2001

5. It is alleged that the defendants have copied the plaintiff's design for their products i.e. food grade plastic storage containers and in this manner infringed the plaintiff's designs in these products. It is the allegation of the plaintiffs that the designs of all the aforesaid products of the defendants are identical to the designs of the products of the plaintiffs. According to the plaintiffs, this act on the part of the defendants is illegal and defendants are liable to be restrained from manufacturing and marketing these products as it amounts 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 the 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.

6. According to the plaintiffs, the infringing goods of the defendants are the following:

S. No.	Infringing Products
1	"Crazy Bowl"
2	"Casserole with lid"
3	"4-in-1 Multipurpose container"
4	"Atta and Chapati Bowl"
5	"Multipurpose Containers"
6	"Multipurpose Containers" (in three different sizes)"
7	"Tumbler"
8	"Slim Lunch Box"
9	"Executive Lunch"
10	"Classic Lunch Box"
11	"Snack & Spare Box" (700 ml)
12	"Snack & Spare Box" (140 ml)
13	"Donga"

7. Defendant Nos. 1, 6 & 7 are stated to be sister concerns manufacturing and marketing these products. Defendant Nos. 2 to 5 are the persons who are allegedly running the affairs of defendant Nos. 1 & 6. Defendant No. 8 is the distributor in Delhi of defendant No. 1. It is further alleged that defendant No. 8 has in turn formed another company i.e. defendant No. 9 for marketing infringing products. For this reason, all these parties are arrayed as defendants No. 1 to 9.

8. Along with the plaint, the plaintiffs have filed IA No. 3592/05, which is an application under Order 39 Rules 1 & 2 CPC for ad-interim injunction in which ex-parte injunction was granted in favor of the plaintiffs on 5.5.2005.

9. While granting the ex-parte injunction, three local commissioners were appointed. They visited the premises and submitted their reports after preparing the inventories. The defendant Nos. 1 and 4 have filed one common written statement. Separate written statements are also filed by the defendant Nos. 8 and 9. In the written statements filed on behalf of the defendant Nos. 1 and 4, they have raised many preliminary objections. In the first instance, it is stated that the suit filed by the plaintiff under Section 22 of the Design Act is not maintainable and 12 designs in question are prior published and not new and original and, therefore, were unregistrable under the Design Act in favor of the plaintiff No. 1. It is also explained that the defendant No. 1 is the sole proprietorship firm of defendant No. 4 and defendant Nos. 2, 3 & 5 have nothing to do with the present suit. Likewise, the defendant No. 6 has nothing to do with the business of defendant No. 1 as it is only purchasing the material from the defendant Nos. 1 and 4. Defendant No. 7 is also irrelevant party for the purpose of the present suit. Locus of plaintiff No. 2 to file the suit is also challenged on the ground that registration of the designs are in favor of the plaintiff No. 1 and the plaintiff No. 2 has not been made as a licensee to use these designs in India. As far as suit filed by the plaintiff No. 1 is concerned, it is contended that this Court does not have territorial jurisdiction to entertain and try the suit. The maintainability of the suit under Section 55 of the Copyright Act is challenged stating that the plaintiff has made the disclaimer qua the copyright while obtaining the design registrations. They have also stated that there is no infringement of any trademark or copyright as there is no question of any confusion. It is also contended that passing off action under the Design Act is not even maintainable.

10. On merits, it is stated that 'Signora' is the family trade mark of the business of the defendants under which they are selling the products which are distinct as the same have been marketed in the cardboard packing material whereas the plaintiff No. 2 is selling its products in loose form. There is 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. Defendant Nos. 1 and 4 are manufacturing the products in the colours which have never been used by the plaintiff No. 2 in India. The designs in question are in public domain and the defendant Nos. 1 and 4 have prepared the same from their own skill and labour and are entitled to do so. They have tried to give their explanation in respect of each design to contend that how they are in public domain.

11. In the written statement filed on behalf of the defendant No. 8, it is stated that he is neither a distributor/stockist nor in any way connected with the trade of Techno Plast i.e. defendant No. 1 and, therefore, unnecessarily imp ledged as a party. It is stated that the defendant No. 8 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. Same plea is taken by the defendant No. 9.

12. Though in the replications filed by the plaintiff to the written statements filed on behalf of the defendant Nos. 8 & 9, it is denied that these defendants are not distributors/stockists or connected with the business of the defendant No. 1 and it is reiterated that they are selling goods produced by the defendant No. 1, it is clear from the aforesaid narration that contest is primarily between the plaintiff, on the one hand, and the defendant Nos. 1 and 4, on the other hand, inasmuch as the alleged infringing goods are manufactured by the defendant Nos. 1 and 4. If the injunction is to be confirmed qua defendant Nos. 1 and 4, the question of appointment of any distributors or marketing would not arise. On the other hand, if the plaintiff is held not entitled to any injunction against the defendant Nos. 1 and 4, then whether the defendant Nos. 8 and 9 are distributors/stockists or not would be immaterial. Therefore, for the purpose of these applications, the pleadings of plaintiff and defendant Nos. 1 and 4 are primarily taken into consideration.

13. The brief description of respective cases of the opposite parties would show that plaintiffs are claiming injunction alleging the infringements on the part of the defendants under the following heads:

1. Design infringement.
2. Re-copyright infringement
3. Re-Passing off of trade dress, trade name etc.
4. Unfair competition and unfair trade practices.

14. I, therefore, proceed to deal with the submissions and counter submissions under these heads.

15. Design infringement: It is the contention of the plaintiffs that the plaintiff No. 1, by virtue of the registration of designs particulars whereof are given in the plaint, has become the author and proprietor of the said registered designs comprising the features of shape, pattern and configuration. The case set up is that because of these registrations, the plaintiff No. 1 has become vested with copyright in the said designs by virtue of Section 11 of the Designs Act, 2000 and has thereby acquired an exclusive right to apply and cause to be applied to the Tupperware products the registered design comprising the features of shape, pattern and configuration etc. which appeal to the eye. It is claimed that the registration designs of the Tupperware products owned by the plaintiff No. 1 are original and novel having being created with the extensive knowledge, search, skill, labour and monies invested over several years by the engineers and experts of the plaintiff No. 1.

16. The plaintiff No. 1 has consented to the plaintiff No. 2 using the said registered designs on the Tupperware Products as part of a world wide arrangement as well as for the Tupperware Products to be offered for sale in India by plaintiff No. 2. The application by a third party of any such registered design to any article for the purpose of sale, in any Class of articles in which the design is registered under the Designs Act or an obvious or fraudulent imitation thereof, is not lawful and constitutes a piracy of the registered design under Section 22 of the Designs Act, 2000. The defendants have applied designs, which are a fraudulent or obvious imitation of the said registered designs of plaintiff No. 1, for the purposes of promoting the sale of the infringing products as listed. It was submitted that the defendants' infringing products have been found to be deceptively similar to the plaintiff's Tupperware products on a visual comparison of the two products where the infringing products appear to the eye to be closely resembling the Tupperware products.

17. Even the independent expert body namely the examiner of Patents and Designs at the office of Controller of Patents and Designs, Kolkata has, in respect of the infringing products' designs representations upon a 'search request' under Section 18 of the Designs Act, 2000, made by plaintiff No. 1, cited the registration details of only the plaintiff's designs vide its reports dated 14.10.2004, 10.11.2004 and 12.01.2005. This shows that the designs representations of infringing products were mistaken even by the examiner of Patent and Designs as the designs of the plaintiff No. 1. Furthermore, the striking similarity between the Tupperware Products and the Infringing Products has caused confusion in the minds of the consumers as would be evident from the market survey report dated 10.12.2004 submitted by AC Neilsen ORG MARG, an independent reputed survey organisation. In 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. This infringement by the defendants of the registered designs of plaintiff No. 1 makes them liable for contravention under the provisions of Section 22 of the Designs Act, 2000.

18. The defendants, on the other hand, contend that the designs claimed to be registered in the favor of the plaintiff No. 1 are invalid on the basis of lack of newness or originality by virtue of prior publication. Section 2(g) of the Design Act, 2000, defines the word "original" as under:

Original, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application.

According to Section 4 of the Design Act, 2000, a design which has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use in any other way prior to the filing date, or where applicable priority date of application for registration is not capable of design prohibited from registration. The designs, on the basis of which the suit is filed, are invalid as the same were pre-published as on the date of registration. Under Section 19 of the Design Act, 2000 the design registration is liable to be cancelled on the ground that the designs have been published in India or in any other country prior to the date of registration, hence, the same are not new or original and were not registrable under this Act. Under Section 22(2)(3) of the Design Act, 2000, the above said ground is available with the defendants even in these proceedings. The defendants have already filed rectification petitions against the said designs before the Controller of Patents and Designs. The defendants have produced the cogent evidence that the present design was pre published within the knowledge of the plaintiff as on the date of application. It is also stated that the plaintiff has made incorrect statements regarding novelty of the said designs before the Controller of the Designs and got the invalid and publish domain designs registered in their favor in order to harass the bonafide users/traders of the said public domain designs including defendants. The defendants have also referred to various other documents filed in this behalf on the basis of which they are trying to prove the pre publications of the designs in question.

19. The plaintiffs, on the other hand, have disputed this claim of the publication as set up by the defendants either by prior use or sale or display or publication in any other form. The plaintiffs also submitted that defendants' allegation that some of the registered designs are common to trade has also not been proved on record and are mere bald allegations. They have also disputed the plea of the defendants regarding pre publication in the Tupperware catalogues on the ground that photographs shown in the catalogues do not show designs as a whole. In other words, there is 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 give the explicit picture and clear depiction of the application of the registered design of plaintiff No. 1 on the article as a whole with the same visual effect as the sample of the product. Furthermore, the 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. Similar is the case for the price list references given to show pre-publication for the registered design of 'container-modular made round'. In some cases, the price list referred by the defendants does not relate to the product to which the registered design has been applied but to a completely different product. For instance, the price list to show pre-publication of design of 'classic slim lunch' relates only to 'slim lunch' and cannot be relied upon. Even in the case of 'executive lunch bag' and 'lunch box with bag', there is no reference in the price list, contrary to the allegation of the defendants. Without prejudice, it is submitted that the price lists cannot be relied upon as they are neither original documents nor have been proved otherwise. Hence the said price lists also cannot be relied upon to prove prior publication and

disclosure of the registered designs of the plaintiff.

20. It is not in dispute that the designs valuation whereof is alleged by the plaintiffs are registered in favor of the plaintiffs under the Designs Act, 2000. Therefore onus is upon the defendants to prove that they are pre published designs and not "original" as per definition contained in Section 2(g) of the Designs Act that they are in public domain. It is the common case that if the designs were pre published before registration was granted in favor of the plaintiffs, then such designs cannot be treated as "original". The mute question, therefore, is as to whether there is pre publication of the designs forming subject matter of the present suit, either by prior use or sale or display or publication in any other form. "Publication" has not been defined in the Designs Act, 2000. However, by judicial pronouncement concept of publication has been developed. In the case of Rosedale Associated Manufacturers Ltd. v. Airfix Ltd. 1957 RPC 239, Lord Evershed M.R. enunciated the concept of prior publication in the following words:

In this respect the test of prior publication of answering Defendants alleged invention, should, in my judgment, be no less applicable in the case of a registered design, and as regards the former, I venture to cite once more the oft-quoted language of Lord Westbury in *Hills v. Evans* : '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.' By a like reasoning, to my mind, if a document is to constitute prior publication, then a reader of it, possessed ordinary knowledge of the subject, must from his reading of the document be able, at least, to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head....

21. To put it simply, the test laid down is 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'.

22. In *Gopal Glass Works Limited v. Assistant Controller of Patents and Designs* and Ors. 2006 (33) PTC 434, Calcutta High Court opined that in order to destroy the novelty of a design registration, prior disclosure whether by publication or use or any other way, must be of the pattern, shape and/or configuration applied to the same article. By this definition, the test which is to be applied is that the prior publication the design disclosed is of the same pattern, shape and/or configuration. About publication, the Court made following pertinent observations:

It is true that publication has not been defined in the 2000 Act. Yet, for reasons discussed above, mere publication of design specifications, drawings and/or demonstrations by the Patent Office of the United Kingdom, or for that matter, any other foreign country, in connection with an application for registration, would not, in itself, amount to publication that would render a design registered in India liable

to cancellation.

To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication would have to be, in tangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article, with the same visual effect would be sufficient.

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.

23. The Court in that case did not rely upon the illustrations in the drawings downloaded from the website of the United Kingdom Patent Office on the ground that the said illustrations did not give the same visual effect as the samples of the glass sheets produced before the Court.

24. Russell-Clarke on Industrial Designs (Sixth Edition) also throws some light on the manner in which prior publication is to be found. Relevant portion from the said book containing discussion on this aspect can be reproduced below:

3.89. ...In practical terms, there are two main ways in which a design can be published by prior use of the design, by selling or displaying to the public articles to which the design has been applied, and by paper publications of one sort or another.

3.92. Prior publication of a design by prior use can be said to take place when the design has been applied to articles and those articles have been used in such a way that the design becomes disclosed to the public before the date of application for registration of the design in suit. It should be noted that it is sufficient if the design is used on any kind of article, and it need not be the same article, or even in the same category, as the article in respect of which the design is registered or sought to be registered.

3.93. In general there will be publication if articles to which the design is applied are manufactured, displayed or used in such a way that members of the public will or might see them. It is not necessary that the articles should have been sold.

3.95. Thus, if the use was in such a position and in such circumstances that some members of the public would be likely to have seen the design, there will be publication, even though it is not proved that anyone did examine it.

3.96. The disclosure of the prior use need not be to a large number of the public. If there has been a disclosure of the design to any individual member of the public....

3.121. ...However, there is no restriction on the manner in which the design comes to be published and the disclosure could even be purely oral. In general, there will be publication if the design is disclosed to any individual member of the public who is not under any obligation to secrecy. Disclosure to merely one such person will be sufficient to constitute publication....

3.147. What is a trade variant was explained by Lord Moulton in *Philips v. Harbro Rubber Co.*.... It is necessary with regard to the question of infringement and still more with regard to the question of novelty and originality that the eye should be that of an instructed person i.e. that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original. For example, if it is common practice to have or not to have spikes in the soles of running shoes, a man does not make a new or original design out of an old type of running shoe by putting spikes into the soles.

3.181. In order to ascertain what the registered design is, so that it may be compared with the alleged infringement, it is necessary to examine the representation of the design on the register. A copy of this is in practice attached to the certificate of registration...although if this course is adopted care should be taken to avoid introducing further features which are not present on the representation on the register....

3.182. A registration, if valid gives to the registered proprietor an exclusive right in relation to article to which the registered design, or a design not substantially different from it....

25. It is not in dispute that even if the plaintiff possesses registration of designs in question, defendant can, in an action by the plaintiff brought in the suit, plead that the designs in question were no new or original. This Court in *Niky Tasha India Pvt. Ltd. v. Faridabad Gas Cadgets Pvt. Ltd.* AIR 1985 Delhi 136 clarified this legal position when it observed as under:

...Where a person is entered as a proprietor of a registered design, that is under the Act he conclusive proof that the plaintiff is the proprietor of the design but only a prima facie evidence that he is the proprietor. The plaintiff has the advantage that if no evidence at all is given then the certificate is sufficient evidence that he is the proprietor. *Modh. Abdul Karim v. Mohd. Yasin.*

Para 14. Design is a conception, suggestion or idea of a shape and not an article. It has been already anticipated it is not new or original. "If it has been pre-published it cannot claim protection. Publication before registration defeats the proprietor's right to protection under the Act."

23. Counsel for the plaintiffs says that the effect of Section 53 of the Act is to grant statutory right to the person who happens to have got registered and that the person has an absolute statutory right until the registration is set aside. I do not agree. The reason is that it really does not matter much in this case whether the defendants' defenses are considered in the infringement suit or in the cancellation application.

26. Keeping in view the aforesaid test, let me examine the material produced by the defendants in order to answer the question as to whether it would amount to pre publication and the related question as to whether the designs in question are original designs of the plaintiff or not. The defendants state that following are the specimen examples of prior publication:

i) Soup server with Laddle with Registration certificate No. 186134 Dt. 24-7-2001 The said product is in "The Tupperware Cook" in revised New Edition c 1989 created By Jane Anderson printed and bound by William Clowes Ltd., England on page No. 34, 35 & 37. This also shows that this product is prior published. These are expired Products and are in public domain by law because these are 17 years old products by this catalogue. Even these products can be very old.

ii) Container "Modular Mate Round" with registration certificate No. 185951 Dt. 5-7-2001 Container modular mate round is shown in "The Tupperware Cook" in revised new edition c 1989 created by Jane Anderson printed and bound by William Clowes Ltd., England on page No. 21 & 65. This clearly shows that the products similar to this product are prior published. These are now very old products and are in public domain by law because these are 17 years old.

iii) Container "Modular mate Oval" with registration No. 172740 Dt. 29.11.1996 The product Modular mate round is shown in "The Tupperware Cook" in revised edition c 1989 created by Jane Anderson printed and bound by William Clowes Ltd., England on Page No. 4. This clearly shows that these products are Prior published. These are now expired products and are in public domain because these are now 17 years or more old.

Crystal Sheer Tumbler with lid with registration certification No. 172739 dated 29-11-1996.

(i) These collar type crystal sheer tumbler are shown in "The Tupperware Cook" in revised new edition c 1989 created by Jaine Anderson printed and bound by William Clowes Ltd., England on Page No. 68 & 71.

(ii) This product Tumbler with Lid is also shown in Yesterdaypaper.com magazine ad FAQ published 1961(approx. Size-10 1/2" * 13 1/2") with item code -AD 3008 of yesterday paper clearly shows that tumbler with lid with air tight seal is so much old (more than 43 years old).

(iii) This product Tumbler is shown in Yesterdaypaper.com magazine ad FAQ published 1962(approx. Size-10 1/2"* 13") with yesterday paper item code no-AD 4015.

(iv) The product Tumbler is shown in TIAS.com with further link Copperfield's Antiques, published 1958 Tupperware ad (approx. size 1/2" *11") with item no code -34-024010100. This clearly shows that this product tumbler is prior published and public domain by law.

7) Classic Slim Lunch with registration certificate No. 176605dated 5-6-1998.

The product classic slim lunch shown in "The Tupperware Cook" in revise new edition c 1989 created by Jane Anderson printed and bound by William Clowes Ltd., England on page No. 69 (Upper Photo with the written "Beef turnovers"). This clearly shows that these products are prior published. These are very old products and are in public domain by law because the are 17 years old products by this book.

8) "Lunch Box with Bag" with registration certificate No. 185956 dated 5-7-2001.

Big Container of Lunch Box is shown in "The Tupperware Cook" is revised new edition c 1989 created by Jane Anderson printed and bound by William Clowes Ltd., England on page No. 58 photo No. 1 and page No. 64 and last title page of the book. This clearly shows that this product is prior published. These are very old products and are in public domain by law because these are 17 years old which is proved by this Cook Book.

9) Freezer Mate : - Registration Certificate No. 185972 dated 06-07-2001.

These Freezer Mate in the name of Snack & Spare container of the defendant Branding "Signoraware" are shown in "The Tupperware Cook" is revised new edition c 1989 created by 'Jane Anderson printed and bound by William Clowes Ltd on page No. 6. This clearly shows that these products are prior published. This is very old which is proved by this book.

27. They have also relied upon certain other documents which can be presented in the following tabulated form:

S. No.	PRODUCT WITH REG. CERTIFICATE	list of documents	list of documents	list of documents	Plaintiff list of documents dt.
	4.7.05	27.07.05	18.10.05		dt. 29.04.05

1. SERVING 189685/Dt-7-02-2002 -- --

BOWL	Pg 109			
2. SEAL FOR BOWL	189687/Dt-7-02-2002	--	--	41, 42 & 43
	Pg 114			
3. SOUP SERVER WITH LADLE	186134/Dt-24-7-2001	114	70, 76	--
	Pg 119			
4. CRYSTALWAVE DIVIDED BOWL	188562/Dt-26-03-2002	4, 69, 93, 85	37, 62, 79	--
	Pg 121			
5. CONTAINER-MODULAR MATE ROUND	185951/Dt-5-07-2001	22, 23, 24, 25, 81, 97,	17, 33, 64, 73 98, 95	12, 34
	Pg 123			
6. CONTAINER-MODULAR MATE OVAL	172740/Dt-29-11-1996	30, 31, 32	--	4
	Pg 126			
7. CRYSTAL SHEER TUMBLER WITH LID	172739/Dt-29-11-1996	100, 101, 102, 103	--	36, 37, 38, 39, 40
	Pg 128			
8. CLASSIC SLIM LUNCH	176605/Dt-5-06-1998	99	8, 36	244 to 247, 131
	Pg 130			
9. "EXECUTIE LUNCH BAG"	185958/Dt. 5-07-2001	72, 39, 40, 53,		31
	Pg 134	40, 41, 87		
"LUNCH BOX WITH BAG"	185956/Dt. 5-07-2001	42, 43, 44, 88, 93, 97.		
	Pg 132			
10. "TRAVEL TWIN BAG"	185952/Dt. 5-07-2001			
	Pg 136			
"TARVEL TWINS WITH BAG"	185957/Dt. 5-07-2001	73, 48	48, 53, 87	--
	Pg 138			
11. "FREEZE-RMATE"	185972/Dt. 6-07-2001	56, 52	56, 57	5
	Pg 140			
12. FREEZE-RMATE (SMALL)	185975/Dt. 6-07-2001	--	56, 57	--
	Pg 142			
13. DONGA 1 Ltr. Does not have any registration certificate	14-18, 107-112, 104-106	--	19, 20	271 to 276

28. It would be clear from the aforesaid that main reliance of the defendants is on the revised new edition (c) 1989 "The Tupperware Cook". Most of the products are published in this book on the basis of which it is contended by the defendants that there is prior publication and as products in question are printed in the said book, no originality can be claimed by the plaintiffs. Since it had already been anticipated and, therefore, it is neither new nor original, though the plaintiffs have tried to contend that illustrations downloaded from the website of US Patent Office cannot be relied upon by the defendants as there are differences in the designs of the plaintiffs' products and the illustration downloaded from the website of US Patent designs, there is hardly any satisfactory

explanation given to the publication on these designs in the aforesaid book namely "The Tupperware Book".

29. At this stage, we are only to look into the matter giving our opinion on prima facie basis. There appears to be a serious dispute as to the validity of the design to be tried in the suit. In the case of Rotela Auto Components (P) Ltd. and Anr. v. Jaspal Singh and Ors. 2002 (24) PTC 449, the injunction was revised while observing as under:

29. Looking it from any angle from the documents placed on record the design has been pre-published and, therefore, it cannot claim protection. In view of the fact that registration of design is of recent date, the design having been published earlier the ground of defense as mentioned in Section 29 can be taken by the defendants pursuant to sub section (3) of Section 22 of the Design Act, 2000, therefore, no injunction can be granted as there is a serious dispute as to the validity of the design to be tried in the suit. Before closing the arguments affidavit has been filed by the defendants before the appropriate authority. The applicants are not entitled to the injunction. I, therefore, vacate the injunction order granted earlier....

30. Even if there is some improvement over the designs shown in the publications that would not, prima facie, make the work of the plaintiffs as original. In Sh. Ravinder Kumar Gupta v. Sh. Ravi Raj Gupta and Ors. 1986 PTC 50, this Court clarified this aspect and the vivid description of the law is found in the following passages from the said judgment:

...If the design was original then the designer must have conceived something new; if the design was a mere trade variation of a previous design, then the designer could be said to have merely kept an existing design in view and made some changes in that. It was further held that in order to determine whether a design was new or original there must be substantial difference from the designs which were known or had been published prior to the date of registration that that what such a substantial difference was, was a question upon which no general principle could be laid down at all and it must depend upon the particular fact in each case and further that in one case a quite small variation in the details of a design might be enough to make the design something quite different from an existing design. On the other hand it was observed there were cases even where quite large alterations in detail leave two designs for all practical purposes of the same and that the court has to consider and look at the designs in question with an instructed eye and say whether there was or was not such a difference between that which has been published previously and the registered design to say that at the date of registration there was a new or original design and therefore properly registered....

P.22...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.

P.24...it was observed that there must be not a mere novelty of outline but a substantial novelty in the design having regard to the nature of the article.

P.25...A trade variant is, therefore, some embellishment (useful or otherwise) which is known, and sometimes, though not always, used in connection with a particular class of article or class of work....

P.26. Thus, Mr. Anoop Singh submitted that change from sharp corner to a round corner is at best a trade variant and registration of the design should not have been permitted. He submitted that it was not disputed that sharp corner glass tiles with mottling effect were in existence much prior to the date of registration of the design.

P.28...By making the corners from sharp to round, it cannot be said that some new design has been created from one's own mind and though 'New' would be something you develop and which was not earlier in existence. It should be striking new design. Round corner tiles may look fresh, but I would not say that there is any novel idea involved in bringing out a tile with round corner.

31. Similarly the argument of 'originality' was brushed aside by this Court in B. Chawla & Sons v. Bright Auto Industries, when the Court found that there were only little variations in the products already existing. It observed that an addition to 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. Prima facie, therefore, claim under Designs Act does not appear to be sustainable.

32. Re-copyright infringement : The plaintiffs have 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 the plaintiff No. 1, all of which are the 'artistic works' created by the experts during the course of employment with plaintiff No. 1. The manufacture of each final product commences from the conceptualization of the idea for a design followed by the below mentioned tedious and lengthy process involving extensive research and application of labour, skill and judgment of the experts employed by the plaintiff No. 1:

a. Conceptualisation of the idea for a design with features and functions taken from a product brief.

b. Making of the line drawings/design sketches c. Making of the product drawings with detailed specifications d. Making of the mould drawings e. Building the mould f.

Manufacturing the Product

33. Affidavit of an expert employed by plaintiff No. 1 is also filed in which the manner of creation of designs in general by the plaintiff No. 1 and other related technical aspects are set out. It is explained that the creation of the artistic work in the form product drawings and the moulds by the plaintiff No. 1 is by a group of highly qualified, dedicated, trained, skilled and experienced professionals employed by the plaintiff No. 1 in the course of their business. These employees conceptualise and create the design for the entire range/repertoire of the end products under instructions and for and on behalf of plaintiff No. 1 during the course of their employment with plaintiff No. 1.

34. On this basis, the plaintiffs assert that the product drawings and moulds would qualify as 'artistic works' of the plaintiff No. 1 under the proviso of Section 2(c)(i) of the Copyright Act, 1957 and as the employees of the plaintiff No. 1 have created these works during the course of their employment, by virtue of Section 17 of the said Act, the plaintiff No. 1 has become the owner of the copyright in the said artistic work. The plaintiffs claim that in view of the provisions of Section 13 and 14 of the Copyright Act, they are entitled to bundle of exclusive right including the 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 plaintiff No. 1 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. Each mould costs approximately USD 200,000 to USD 1,000,000 (approximately equivalent to Rs. 88 lakhs to Rs. 4.4 crores) and has a life of 30 years which enables the plaintiff No. 1 to continue to use the moulds for many years to manufacture millions of its uniquely designed Tupperware Products.

35. The plaintiffs argue that infringing products of the defendants are an obvious imitation of the Tupperware Products and there is a material and sufficient degree of objective similarity tant 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. It is further submitted that the manufacture of infringing products having a striking resemblance to the Tupperware Products could have been achieved by the defendants by circumventing the tedious and lengthy process used for manufacture of the Tupperware Products by use of modern day computer techniques enabling the defendants to reproduce the product drawings as well as the moulds in a much more rapid manner and in form identical to the Tupperware Products. This 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 in order to ultimately reproduce the said assimilated designs in a tangible and finished

form i.e. the infringing products. The defendants appeared to have, by such use of computer technology, digitally mapped the shape of the Tupperware product by use of laser and thereby reproduced the product drawings of the respective Tupperware Product which the defendants appear to have used to reproduce and design the mould to manufacture the matching infringing product. Such reproduction and/or adaptation of the Tupperware Product drawings tantamounts to infringement of the copyright of plaintiff No. 1 in the artistic works namely the 'product drawings' based on which ultimately the engravings that is the 'moulds' are built. This conduct makes the defendants liable under the provisions of Section 51 read with Section 55 of the Copyright Act, 1957 for infringement of the copyright of plaintiffs in the artistic works forming part of the present suit.

36. The answer of the defendants, on the other hand, is that the plaintiffs have themselves given up their claim pertaining to use of colour or colour combination as appearing in the design while obtaining the registration of the designs under the Design Act. The question of claiming the said colour and colour combination by virtue of Copyright Act is, therefore, not permissible under the law and the case of alleged infringement of copyright under Section 45 of the Act is not maintainable. It is additionally argued that the copyright claimed by the plaintiffs ceased to exist under Section 15 of the Copyright Act which provides as under:

1. Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 1911(2 of 1911).

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

37. Reliance in this behalf is placed on the judgment of this Court in the case of Samsonite Corporation v. Vijay Sales 1998 PTC (18) 372.

38. The plaintiffs cannot deny that the drawings in question were prepared by the plaintiffs for the purpose of creating particular designs for the products to be launched. This is so stated explicitly by the plaintiff itself in the plaint. They have claimed copyright in the product in question on the ground that designs which are created involve, inter alia, the making of 'product drawings based on which mould drawings are made. The plaintiffs have also claimed that the manufacture of each final product commences from the conceptualization of the idea for a design followed by the below mentioned tedious and lengthy process involving extensive research and application of labour, skill and judgment of the experts employed by the plaintiff No. 1.

39. The various processes mentioned by the plaintiff start from conceptualisation of idea to the making of drawings and then moulds and leading to the manufacture of the product. It cannot be disputed that for preparing a design of a product in question, process has to be initiated from conceptualisation and then making of the drawings. Only because of this reason, is it possible to claim separate right under the Designs Act so far as final product manufactured is concerned and at the same time claim copyright under the Copyright Act in the drawings which were prepared for the purpose of creating design in a product. In *Samsonite Corporation v. Vijay Sales* (supra), this Court answered the question posed above in the negative. The relevant portion of the judgment may be reproduced below:

60. Dealing with the *Bayliners* case (supra), the learned Senior counsel for the plaintiffs submitted that if the plaintiff had made engineering drawings and if the plaintiff rely on those drawings then the ratio in that case would apply. I am not able to accept this contention because whatever be the nature of the drawings, the purpose and intention would be the relevant criterion to consider whether the drawings are design in the light of the provisions of the Designs Act and the Copyright Act, 1957. No argument is advanced on behalf of the plaintiffs that the ultimate purpose of the drawing was not for the purpose of manufacture but the drawings were made for keeping the artistic quality of the drawings. The distinction between the drawing for artistic purpose and manufacturing is ignored by the plaintiffs.

40. The highlighted portion from the aforesaid extract would indicate that the test is as to whether drawings were meant for the purpose of manufacture or the purpose was only to keep the artistic quality of the drawings. Only in the later category of cases, the drawings would qualify as artistic work under Section 2(c)(i) of the Copyright Act.

Similar issue came up before this Court again in the case of *Microfibres Inc. v. Girdhar & Co. and Ors.* 2006 (32) PTC 157 (Del.), wherein dicta in *Samsonite Corporation v. Vijay Sales* (supra) was followed with approval. In detailed analysis of the law on the point at hand was undertaken by the Court. It would be useful to refer to the following extract there from bringing out the distinction with remarkable clarity:

In India, we have special legislations governing the protection of different nature of rights. Insofar as the industrial designs are concerned, the protection is provided under the Designs Act, 2000, which came into force from May, 2001 and repealed the earlier Designs Act, 1911. An important and relevant aspect is that both under the old Act and the new Act, fabric designs on textile goods have been classified as proper subject matter of design protection by inclusion as a specific class in the Rules framed under the Acts. In the Designs Act of 1911, class 13 and 14 of the Fourth Schedule of the Rules dealt with printed or woven designs of textile goods other than checks and stripes and checks and stripes respectively. Such protection is now provided under

Class 05 of the new Design Rules of 2001.

Furthermore, the legislative intent is also to be kept in mind which is to provide protection for a certain period of time for commercial exploitation. Thus, nature of protection is quite different for an artistic work under the Copyright Act which is for the lifetime of the author/creator + 60 years. This is not so in the case of commercial exploitation as under the Designs Act and the Patent Act the period is much Lesser. In the present case, the configuration was made only with the object of putting it to industrial/commercial use.

The exclusion of an 'artistic work' as defined in Section 2(c) of the Copyright Act from the definition of 'design' under Section 2(d) of the Designs Act, 2000 is only meant to exclude the nature of artistic works like painting of M.F. Hussain. It is thus, the paintings, sculptors and such works of art which are sought to be specifically excluded from the new Act.

The observations of the learned Single Judge in S.S. Sarna Inc.'s case (supra) succinctly set out the concept behind excluding certain designs from protection under the Copyright Act which was to avoid any hindrance being caused to the manufacturer of sale and industrial articles. Thus, the intention of the legislature has been expressed as one to protect any artistic work which has to be commercially exploited by the owner of the copyright by not providing the protection under the Copyright Act, but under the earlier the Designs Act, 1911. A similar view was also expressed by another learned Single Judge of this Court in Samsonite Corporation's case (supra). To this extent, I see no difference between the intent under the old Act and the new Act, the handouts issued by the Design Office and the registrations made of textile fabrics both under the old Act and the new Act leave little manner of doubt that the protection for such configurations, design or works (by whichever name it may be called) is provided under the Designs Act. It is, thus, apparently clear that in the context of the Indian Law, it is the Design Act of 1911 or 2000, which would give protection to the plaintiff and not the Copyright Act. The application of mind and skill is not being denied nor the fact that the defendants have copied the same, but that would still not amount to the works in question being labeled as 'artistic work' within the definition of Section 2(c) of the Copyright Act and, thus, the protection is not available under the Copyright Act. Issue No. 1 is answered accordingly.

41. I may also take note of another judgment of this Court in the case of Polymer Papers Ltd. v. Gurmit Singh and Ors. 2002 (25) PTC 327 (Del.). That was a case where the effect of Section 2(c) of the Copyright Act and Section 11 of the Designs Act was considered by the Court. No doubt, in that case, the design in question was not registered under the Designs Act. However, the plaintiff's cause was predicated on Copyright Act and submission was that since the copyright in artistic works was not required to be registered, the action under Copyright Act was sustainable. This plea was not accepted by the Court. The Court 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 as defined in the Designs Act, 2000. The underlying message of this judgment is that the claim of copyright in the industrial drawings and designs which were being used for manufacturing purposes is not maintainable.

42. No doubt, the plaintiff has tried to argue that for creating the same designs, the defendant would have applied the technique of 'reverse engineering' inasmuch as striking resemblance to the Tupperware Products could have been achieved by the defendants by circumventing the tedious and lengthy process used for manufacture of the Tupperware Products by using computer techniques possibly by 2D or 3D scanning. This is a matter which would require evidence. May be on the basis of evidence led ultimately plaintiff is successful in showing that there is a copyright in the product drawings and the defendants have copied the said drawings thereby violating the copyright rights in creating their own products striking similar to the Tupperware Products. However, prima facie, it seems that once the drawings are made for creating the ultimate product design, the copyright in the said drawings cannot be claimed under the Copyright Act. May be this is the reason 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 underlying message is that copyright in an industrial design is governed by the Designs Act, 2000. If a design is registered under that Act it is not legible for protection under the Copyright Act. In such cases after the design is registered under the Designs Act, the protection given is not copyright protection but a true monopoly based on statute inasmuch as such designs were never protected by the common law. Exception may be in those cases where copyright had come into existence in respect of artistic drawings and subsequently those drawings were used as models or patterns to be multiplied by any industrial process. There, if the drawings became capable of registration as a design it would not result in copyright being fortified. See *Warner Brothers v. Roadrunner* 1988 FSR 292 However, if the intended industrial use of the work was contemporaneous with its coming into existence, Section 15 of the Copyright Act would apply. I may hasten to clarify that it is not suggested that if any design is registered, copyright under no circumstance exist in the drawings. Section 15 lays down that on registration of a design under the Designs Act, the copyright shall not subsist in that design and not in the drawings. Therefore, it is possible that when the moulded plastic article of novel shape is made from a working drawing, as in the instant case, the drawing may qualify as an original work entitled to copyright protection and, at the same time, a registered design for the shape of the article would be protected under the Designs Act. If an unauthorized copy is made of the article, it may constitute an indirect copy of the drawing and therefore may infringe the copyright.

43. Therefore, in a matter like this, where there may be serious dispute which needs evidence before the plaintiff is able to establish its copyright in the drawings meant for industrial designs, coupled with the fact that the plaintiff can be compensated in terms of money (which aspect is dealt with later at appropriate stage) it would not be safe to injunct the defendants.

44. Re-Passing off action : It is submitted by the plaintiffs that by virtue of the new and original designs of the Tupperware Products, the same have become extremely popular in the Indian market as well as in other countries worldwide and have acquired tremendous goodwill and reputation. The sales of these products, the amount spent on research and development etc. and various awards these products have already taken, noted above, on this basis it is submitted that the products of the plaintiffs are well known and have acquired household popularity because of their quality, technical and functional superiority. It is alleged that the defendants who are in the business of inter alia making household plastic containers are making the infringing products which is advertised to be 'Microwavable Crockery' made from food grade plastic material meant to be sold to the same class of consumers as Tupperware Products. The Defendants have infringed the design and copyright of the plaintiffs by manufacturing and selling infringing products have a striking resemblance in shape, configuration and pattern of the Tupperware Products. The Infringing Products which are goods used for household purposes being targeted to be sold to the same set of consumers as of the Tupperware Products. It is submitted that the defendants are leaning on the reputation and goodwill painstakingly built by the plaintiffs over many years.

45. It is further submitted that the 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, gives the impression as to deceptive or near similarities in the two designs. In view of the facts and circumstances stated hereinabove, it is submitted that 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 believe that the infringing products of the defendants are the products emanating from plaintiff No. 2 while in fact it is not so. It is submitted that the defendants have adopted the registered designs of the plaintiffs and applied them to its products as stated above with a view to cash in on the reputation and goodwill enjoyed by the plaintiffs and its products that is Tupperware Products manufactured with the registered designs. This is a case of confusion and amounts to the defendants passing off its infringing products as those of the plaintiff with a view to encash upon the goodwill and reputation of the latter. There has been conscious and substantial imitation of colour combination, get up and lay out of the Tupperware Products by the defendants which bares the designs of the defendants in causing confusion in the minds of customers. The infringing products are not only a substantial and material imitation of the

Tupperware Products mentioned in Table II thereby appealing to the eye as being deceptively similar but even the trade dress of the infringing products causes confusion as to the identity of the said products resulting in the likelihood of the same being mistook to be Tupperware Products.

46. The identical trade dress and get up is evident from a visual comparison of the products as follows:

i) The confusingly 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 namely the "Snack and Spare Box" being identical in design to the Tupperware product namely "Freezer mate" (700 ml) is also illustrative of the passing off being done 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' 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.

47. Submission of the defendants are 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'. Their claim is essentially based on Designs Act which is statutory nature. There is no common law right of passing off provided under the Designs Act. It is also submitted that the survey report can be considered only at the time of trial of the suit inasmuch as that is one side evidence procured by the plaintiffs to their advantage. It is also claimed that the defendants are using their own shape and configuration for manufacturing their products and various differences between the two products. Therefore, passing off action is liable to be dismissed. Reliance is placed on two judgment namely Tobu Enterprises Pvt. Ltd. v. Megha Enterprises and Anr. 1983-PTC-359 and Smithkline Beecham Consumer Healthcare GMBH and Ors. v. G.D. Rathore and Ors. 2002 (25) PTC 243 (Del).

48. The plaintiffs on the other hand assert that the right to sue for passing off is an independent right arises under the Common Law and is not dependent upon the Designs Act. This submission of the plaintiff appears to be correct. The common law right of passing off is distinct and is available de-hors 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 in the following words:

...If such a right is available to someone under the Common Law Rights that could well be enforced even though the same is not statutorily recognized under a statute.... I am therefore inclined to hold that passing off action is also available to case of design and such right could be enforced provided the same is available in accordance with law even in a case of design, for otherwise a latitude would be given to a manufacturer to misrepresent and to deceive unwary customers by manufacturing and selling its products as that of products of some other manufacturer and seller. Such course would also allow unscrupulous manufacturer or dealer to take recourse to confusing the unwary customers/public to purchase some goods which it was unwilling to purchase but being deceived and/or confused proceeded to purchase the same believing it to be products and goods manufactured and sold by the actual manufacturer or dealer....

49. However, the question is as to whether the case of passing off is made out. In an action of passing off, in order to succeed, the plaintiff has to prove that there is such a striking resemblance between the two products that the consumer would buy the goods of the defendants thinking the same to be of the plaintiff. To put it differently, what is to be shown is that the defendant is trying to confuse the customers by passing off its goods as that of the plaintiff. Case of the plaintiff as stated in the plaint itself negates this. It is alleged in the plaint that the plaintiff No. 2 came to know through its marketing personnel that infringing goods were being sold in India International Trade Fair 2004 at Pragati Maidan, New Delhi. It is alleged that during the said visit it was noticed that the salesman of the said defendants present at the stall were marketing the Signoraware brand of 'Microwave Crockery' by making assertions that the said Signoraware products, though were a look alike of Tupperware Products, but were being sold at half the price of the Tupperware Products. The salesman also asserted that the said defendants were selling almost all of the Microwave Crockery products similar to the Tupperware Products being sold in the market by the plaintiff No. 2 herein.

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 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. 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'. In Microfibres Inc. v. Girdhar & Co. and Ors. (supra), the Court denied injunction, inter alia, also on the ground that the two products were sold under a totally different trade name.

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. In Niky Tasha India Pvt. Ltd. v. Faridabad Gas Gadgets Pvt. Ltd. (1984) PTC (Del HC-DB), this Court refused the injunction at interlocutory stage while observing as under:

I take it to be well settled, both in India and England, that an interlocutory injunction will not normally be granted where damages will provide an adequate remedy should the claim succeed. Furthermore, I have always understood the rule to be that the court will not grant an interlocutory injunction unless satisfied that there is a real probability of the plaintiff succeeding on the trial of the suit; where the design is of a recent date, as in this case, no injunction should be granted. More so, when there is a serious question as to the validity of the design to be tried in the suit and an application for cancellation has been made. Where a person is entered as a proprietor of a registered design, that is under the Act no conclusive proof that the plaintiff is the proprietor of the design, but only a prima facie evidence that he is the proprietor. The plaintiff has this advantage that if no evidence at all is given then the certificate is sufficient evidence that he is the proprietor.

53. I may also reproduce following observation of Lord Denning in Hubbard v. Vosper (1972) 2 WLR 389:

In considering whether to grant an interlocutory injunction, the right course for a Judge is to look at the whole case. He must have regard not only to the strength of the claim but also to the strength of the defense and then decide what is best to be done. Sometimes, it is best to grant an injunction so as to maintain the status quo until the trial. At other times, it is best not to impose a restraint upon the defendant but leave him free to go ahead. For instance in *Fraser v. Evans* [1969] 1 QB 349 although the plaintiff owned the copyright, we did not grant an injunction, because the defendant might have a defense of fair dealing. The remedy by interlocutory injunction is so useful that it should be kept flexible and discretionary. It must not be made a subject of strict rules.

54. For this reason, it is not necessary to consider the other submission based on 'Unfair Competition' in detail, at interlocutory stage.

55. I am of the opinion that taking holistic view of the matter it is not a case where interlocutory injunction is the remedy when the case is primarily founded on the basis of rights under the Design Act and that right, prima facie, is not established. It is a case where damages would be more appropriate remedy if the plaintiffs ultimately succeed. The ex-parte injunction order is vacated subject to the following:

1. The Defendants shall file the statement of account of their sales, advertisement expenditure, profits etc. for the period from 1.5.2005 till 31.3.2007 within a period of six weeks.
2. They shall continue to file such statements annually, within two months of the expiry of the each financial year. For the financial year 2007-2008 (i.e. 1.4.2007 to 31.3.2008) the statement shall be filed by 31.3.2008 and so on.
3. The defendants shall not dispose of their immovable properties, machinery etc. or create third party rights therein without the prior permission of the Court. Affidavits of the Director(s) and/or responsible person(s) to this effect shall be filed within six weeks.