AID No.4 of 2013
IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE

ATUL NARSIBHAI PATEL
VERSUS
ASSISTANT CONTROLLER OF PATENTS AND DESIGNS & ANR.

BEFORE:
The Hon'ble JUSTICE SOUMEN SEN
Date : 16th February, 2017.

Appearance:
Mr. Suvasish Sengupta, Adv.
Ms. Sanchalita Sarkar, Adv.

Mr. Rabi Prosad Mookerjee, Adv.

The Court: The instant appeal is arising out of an order dated 12th March, 2013 passed by the Learned Assistant Controller of Patent and Design whereby the registration of the Design being no.211639 in class 09-07 under the Designs Act, 2000 was cancelled.

The Assistant Controller allowed the application for cancellation of all the impugned design on a finding being arrived at that the registered design no.211639 dated 7th August, 2007 is not significantly distinguishable from combination of known designs and thereby not new or original. In other words, the cancellation was allowed in view of Section 4 (C) of the Designs Act, 2000.

The subject matter of dispute before the Assistant Controller was 'seal for packaging' under Class 09-07. The representation accompanying the registration of the petitioner consists of three sheets having front view and rear view in sheet no.1, side view and other side view in sheet no.2 and top and bottom view in sheet no.3. The novelty is claimed in the representation sheet no.1 in the shape and configuration of the seal for packaging. The statement reads:

> *"The novelty resides in the shape and configuration of the Seal for packaging more particularly in the portion marked "A" as illustrated".*

In the remaining representations, novelty is claimed to be residing in the shape and configuration of the seal for packaging.

Both the parties before the Controller have claimed that they have invented this unique design and the novelty resides in the shape and configuration of various plastic seals. While the appellant would contend that the seals for packaging were entirely for a different purpose and having a different ocular impression, the respondent no.3 has contended that the said design has been copied from a prior published design in respect whereof the respondent no.3 is having prior registration. It was contended that the impugned design is nothing but a copy of a previous known design and, thus, not new or original.

The two designs were compared by the Assistant Controller. It was observed that normally such seals are anchor type, temper evident with locking system. It generally consists of: a male

part having certain protruded fangs or anchors, a female part which is enable to hold the male part in its internal locking arrangement corroborating the structure of the male part and a connector between the male and female part which is normally reinforced with galvanized twisted wire. It is normally made of polycarbonate material. Material of construction of the article is not relevant, but it indicates why certain registered designs of the petitioner were registered in Class 3 under the old Act of 1911.

The Assistant Controller took into consideration all the designs disclosed by the parties in the proceeding and found that the prior design nos.179570 dated 27th May, 1999, 182372 dated 17th May, 2000, 205868 dated 1st September, 2006 and 205871 dated 1st September, 2006 are of relevance. These prior designs depict a plastic seal where novelty is claimed to be residing in shape and configuration of the seal in each of the designs.

Novelty of the impugned design was claimed to be residing in the shape and configuration of the female or the body part marked as portion "A" in the representation. The marked portion was found to be strikingly similar to the body part of the seal of prior design no.179570 even to the extent of provision of the circular inscription on the body. Size of the parts in the impugned article was slightly different. Male portion of the said article bearing the impugned design shows two sets of anchors and a V shaped cut on the top. The anchors are purely functional as

it has to be made in a shape corroborating the internal locking structure of the female part. The V shaped cut on the male part of the impugned design was suggested by a prior design 205871. This prior design 205871 also shows female part similar to that of the impugned design.

The novelty of a design can be claimed if it is established that the design features of the impugned design are not taught by the prior designs. If it is found that it is taught by a prior design it loses its claim of novelty. Unless it is established that there are significant features in the impugned design which were not capable of being taught or having other distinguishable features, a design would not be registered. It is no answer to an application for cancellation of the design that while considering the application for grant of design at the initial stage, the said designs were examined by the examiners and only on a satisfaction being recorded that it has unique and/or distinctive features, the said designs were registered. The legislatures were aware that at the time of registration it may not be possible for the registering authority to come across all the design not qualified to be registered if the conditions of Section 4 is attracted. In other words, a design shall not be registered if it is not new or original or has been disclosed to the public prior to the filing date or is not significantly distinguishable from known designs or combination of known designs. The right to challenge a registration of design is not

lost merely because it was registered by the authority. Section 19 of the Design Act, 2000 permits any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:-

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

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

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

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

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

A design does not become new or original if it is not significantly distinguishable from known designs or combination of known designs. In the instant case, it was found on a comparison of the features of the impugned design with the previously registered and published designs that the design features of the impugned design were taught by the prior designs particularly by registered design nos.179570 and 205871 in respect of the female/body as well as the male part respectively. Broad features are found to be same and the impugned design shows combination of

those previous designs. The parties have produced before this Court the applications containing the impugned design and the designs with which they are compared by the Controller. On an ocular impression, this Court is unable to come to a different conclusion than that was arrived at by the Controller. It can be said with certainty that the appellant's design is not significantly distinguishable from combination of known designs. The common feature in both the designs is of seal. The argument that as both the articles being different and registered under different class impugned design cannot be considered as previously registered and the scope of protection is different for both the types of designs is a desperate attempt to cover up the lack of novelty or newness and clear revelation that the design features of the impugned design were taught by the prior designs. The primary function of the article 'seal' is to use it as a lock for sealing. It is evident from the representation of the design that the appellant's article is a seal. This aspect of the matter was also considered by the Assistant Controller in its order very lucidly which reads as follows:

"The classification of goods is regulated by the Third Schedule framed under Rule 10 of the Designs Rules 2001 as amended by (Amendment) Rules 2008. Class 09 relates to Packages and containers for the transport or handling of goods and 09-07 relates to closing means and attachments. Down below the class 09-07, a note is given which reads thus:

Notes:- (a) Including only closing means for packages

(b) 'Attachment' means, for example, dispensing and dosing devices incorporated in containers and detachable atomizers.

Class 08 relates to tools and hardware, also with a note that (a) including hand-operated tools, even if mechanical power takes the place of muscular force; for example, electric saws and drills and (b) Not including machines or machine tools (Cl.15 or 31). Class 08-07 particularly relates to locking or closing devices. It is thus obvious that class 09 relates to packages containers and 09-07 relates to closing means for packages as well as attachments incorporated in containers etc. In this present proceeding, the article of impugned design and also the article of the petitioner's designs is of seal. Another pleading of learned counsel of respondent was that the seal of impugned design 211639 is meant for sealing packages likewise bags of customers were sealed in shopping complexes and thus use is different. I would see that if that is so, article of petitioner's design of seal could also be used for that purpose and vice versa. The primary function of the article 'seal' is to use as a lock for sealing. It is clearly evident from the representations of the designs that the respondent's article is a seal."

It is argued on behalf of the appellant that eye alone is to be the Judge of identity for the purpose of deciding whether a particular design has been accepted or not by another.

This aspect of the matter has long been settled. In ***Gammeter v. The Controller of Patents and Designs***, it was held by the Court:

> *The design should be protected provided it was not merely an analogous and that the test of novelty is the eye of the Judge who must place the two designs side by side and see whether the one for which novelty is claimed is new.*

The question of eye appeal came up for consideration in ***Interlego A.G. v. Tyco Industries Inc.,*** in relation to toys. The Court observed:

> *In relation, however, to an assessment of whether a particular shape or configuration satisfies the former and positive part of the definition, the fact that an important part of the very purpose of the finished article is to appeal to the eye cannot be ignored. …One starts with the expectation of eye-appeal, for part of the very purpose of the article is to have eye-appeal.*
>
> *You have to design so that the article in question will make an immediate visual appeal to a child or to the parent or other person buying for a child.*

The word 'new' in relation to a design means a design which is completely new in the sense that it is invented or created for the first time and was hitherto unknown. The word 'original' in relation to a design may mean a new application of an existing or known design to a subject matter. A design may not be new in the sense that it is completely new. It may be an existing or known design but has been applied to a particular article for the first time. A design between new and original has been discussed in ***Gammeter v. The Controller of Patents and Designs, AIR 1919 Cal.887.*** In this context, it was observed:

> *"A design in order to be new or original within the meaning of the Act, need not be new or original in the sense of never having been seen before as applied to any article*

whatever, there might be a novelty in applying an old thing to a new use, provided it is not merely analogous."

The sameness of features is to be decided by the eye, that is to say, by seeing the two and getting a total synoptic view of the same. The sameness of features does not necessarily mean that the two designs must be identical on all points and differ on no point. If the same shape or pattern, or one substantially similar, has previously been thought of in connection with any article of manufacture and the idea published, or registered, then the design will be deprived of its novelty. ***(Western Engineering Vs. Paul Engineering, AIR 1968 Cal 109)***

A design showing merely a combination of known features and without any real mental activity being required for its production is not registrable. ***(Sebel & Coy. Ld.,1959 RPC 12)***

Where the design is original, the designer conceives something new; but where the design is a mere trade variation of a previous design, then the designer could have merely kept an existing design in view and made some changes in that. In order to determine whether a design is new or original, there must be substantial difference from the design which was known or had been published prior to the date or registration of the earlier design. What is "substantial difference"? This is a question upon which no general principle could be laid down at all and it must depend upon the particular facts in each case. Sometimes, a small variation in the details of a design may be enough to make the

design different from an existing design, whereas in some cases even large alterations in detail may not make the two designs different. The court has to consider and look at the designs in question with an instructed eye and observe whether there is or is not such a substantial difference between the two. There must be a substantial novelty in the design having regard to the nature of the article and not a mere novelty of outline. ***(Ravinder Kumar Gupta v. Ravi Raj Gupta and Others, 1986 (6) PTC 50)***

The Hon'ble Supreme Court in **Bharat Glass Tube Limited v. Gopal Glass Works Limited, 2008 (10) SCC 657**, held that the expression "new or original" appearing in section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, "new or original" means that it had been invented for the first time or it has not been reproduced by anyone.

The appellant contended that the learned Assistant Controller erred in law by comparing different parts of eight prior published designs of the respondent no.2 registered in different classes while deciding the novelty of the impugned design. The learned Counsel referring to a decision in **Rosedale Associated Manufacturers Ltd. V. Airfix Ltd. reported at (1857) RPC 239 at page 245, 250** submits that for the purpose of attacking or deciding the novelty of a design, it is not permissible to make a mosaic of a number of prior art documents. It is argued that in the instant case, the features of the impugned design were never

disclosed in one single pre disclosed article and, therefore, the said judgement suffers from total non application of mind. The learned Assistant Controller has committed an error by comparing the impugned design with parts/portions of several other pre published designs and by accepting the contention of the private respondent that the impugned design is not significantly distinguishable from known designs or combination of prior registered designs of the respondent no.2 as the same is not permissible in law.

Further reference has been made to **Hills Vs. Evans 1862 31 L.J Ch. 457 at 463 Russel Clerk-Sixth edition - page 49,** wherein it has been stated that if a document is to constitute prior publication then a reader of it possessed of ordinary knowledge of the subject, must from his reading of the document be able to at least 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. Furthermore, the Assistant Controller has failed to appreciate that the impugned design has certain embellishments over the fundamental form which makes it distinguishable and the jaw portion of the male part of the impugned design is also different from the design no.179570 cited by the respondent no.2 herein. Further the female portion of the subject design is significantly distinct from the registered design nos.182371, 182372 and 193033 cited by the respondent no.2. The Assistant Controller failed to appreciate

that the producing the impugned design the appellant has added some features which makes the article eye appealing. In order to decide the novelty, a design has to be looked as a whole and ocular impression or eye appeal is the foremost criterion for deciding the novelty of a design. In this context it was held in the matter of **Amp. V Utilax 1971 RPC 103 at 113 (Russel Clerk-Sixth edition, page 49**, that "…where a design sets out to produce an article that would perform a particular function, but where in producing it he has added or applied some features of shape that are additional to or supplementary to what is functionally needed, with the result that in the finished article there are features that appeal to eye there may be a design which is registerable within the statutory definition..."

An unreported judgment of this Court in the matter of **AID No.1 of 2013 (M/s. Devans Modern Breweries Ltd. Vs. Controller of Patents & Designs & Ors.**) decided on 29th April, 2015 has been relied upon to show that if an article has an eye appeal, it cannot lose such appeal only because another article has eye appeal. The entire concept of "eye appeal" is, however, quite subjective.

The respondent has taken a preliminary point as to the maintainability of the appeal at the instance of the petitioner on the ground that the purported deed of assignment dated 24th January, 2013 and the purported application for entry of the name of the appellant in the Register of Designs. Section 30 read with

Rule 33 and 35 of the Design Rules, 2001 says the mandatory procedures for entry of assignment and transmission in register. In absence of the same, the appeal under Section 19(2) filed by the appellant/petitioner is not maintainable. The registration of certain designs are prohibited under Section 4 of the Designs Act, 2000 which (a) is not new or original; or (b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or (c) is not significantly distinguishable from known designs or combination of known designs; or (d) comprises or contains scandalous or obscene matter.

Section 19 of the Designs Act, 2000 says that any person interested may present a petition for cancellation of the registration of a design at any time after the registration of the design to the Controller on any of the grounds as mentioned therein. In the said grounds, four grounds are relevant for the adjudication of the said appeal. (i) That the design has been previously registered in India, or (ii) That it has been published in India or in any other country prior to the date of registration, or (iii) That the design is not a new or original design, or (iv) is not registrable under the Act of 2000.

The registered Design bearing No.179570 dated 27-5-1999 (Page 21-25 of AO) and 205871 dated 1-9-2006 (Page 62-68 of AO) in the

name of the respondent no.2 are identical and/or imitation and, therefore, prior registered and prior published and not novel and registered and is liable to be cancelled.

On the ground of maintainability the learned Counsel has referred to the decision in **Amit Jain vs. Ayurveda Herbal & Ors. reported at 2015 (63) PTC 121 (Del**.) and submits that the Hon'be Delhi High Court held that the plaintiff did not have any valid right to file the said suit unless the assignment is duly registered under Section 30 of the Designs Act, 2000.

On prior publication it is submitted in **The Wimco Ltd., Bombay Vs. M/s. Meena Match Industries, Sivakasi & Ors. reported at AIR 1983 DEL 537** that the word 'Published' used in Section 43 and 51(a) of the Designs Act, 1911 has not been defined in the Act. Publication within the meaning of the Act means the opposite party of being kept secret. It is published if a design is no longer a secret. There is publication if the design has been disclosed to the public or the public has been put in possession of the design.

Venus Industries vs. Magppie Exports reported at 2003 (26) PTC 312 (PO) has been relied upon in support of the argument that a public document must be considered as a prior public document with respect to the registered design and if on comparing to the instant registered design it appears that it is nothing but a mere trade variant than the impugned design cannot be considered as new or original. If on a comparison of the articles it is found to be

practically identical, the registration is required to be cancelled.

On the aspect of novelty, learned Counsel has relied upon the decision in **Brighto Auto Industries vs. B. Chawla & Sons reported at PTC (Suppl) (1) 851 (Del)** that in the matter of novelty, the eye has to be the ultimate arbitrator and the determination has to rest on the general ocular impression. To secure recognition for its newness or originality, it is imperative that the design identical with or even materially similar to the relevant design should not have been **published or registered previously**. A slight, trivial or infinitesimal variation from a pre-existing design will not qualify it for registration.

The same principle can be found in various decisions including **Western Engineering Co. vs. Paul Engineering Co.** reported at **AIR 1968 Cal 109, Gopal Glass Works Ltd. vs. Assistant Controller of Patents & Designs** reported at **2006 (33) PTC 434 (Cal.) and Reckitt Benkiser India Ltd. vs. Wyeth Ltd.** reported at **2013 (54) PTC 90 (Del. FB)**

A design is not registrable, inter alia, if it is found that it has been disclosed to the public in India or abroad by publication in tangible form or by use or in any other way prior to the filing of the application for registration.

Design is a conception, suggestion or idea of a shape and not an article. It if has been already anticipated it is not "new or original". Publication before registration defeats the

proprietor's right to protection under the Act. ***(Niki Tasha Pvt. Ltd. Vs. Faridabad Gas Gadgets P. Ltd., AIR 1985 Delhi 136)***

The features of shape, configuration, pattern and ornament, when applied to an article are design. What actually constitutes the design is, therefore, that peculiar combination and arrangement of lines which give such features. A design is necessarily part and parcel of the article manufactured.

The learned Counsel appearing on behalf of the petitioner referred to ***Bharat Glass Tube Limited Vs. Gopal Glass Works Limited*** reported at ***(2008) 10 SCC 657*** to submit that when a design is sought to be applied to an article unless two articles are simultaneously produced for examination, the controller could not have held that there was no novelty or originality in the design of the petitioner.

In ***Gopal Glass Works Limited v. Assistant Controller of Patents & Designs & Ors.*** reported at ***2006 (3) CHN 188*** originates from this court. In Paragraph 30 of the said judgment, it was observed that under the law presently in force in India, specifications, drawings and/ or demonstrations in connection with registration of a design do not per se constitute publications which prohibit future registration of that design. Had publication of design specifications by a registering authority, particularly a registering authority in a foreign country, in connection with registration of a design, in itself, amounted to prior publication, that would hit all future applications in India for

registration of designs, prior registration in India would not separately have been made a ground for cancellation of a registered design. Moreover, it is significant that Parliament consciously, made publication in a country other than India a ground of cancellation, in addition to publication in India, but expressly restricted the embargo of prior registration to registration in India. Registration in a country other than India has not been made a ground for the cancellation of a registered design.

Moreover, 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.

The relevant observations can be found in **Paragraphs 39 to 46** of the report which are:-

> *"39. The next question, in issue before this Court, is whether the finding of the respondent No. 1 that the document downloaded from the internet from the website of the Patent Office of the United Kingdom, might be taken as prior publication of the impugned design, is legally sustainable.*
>
> *40. 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.

41. 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.

42. 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.

43. 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.

44. In the case of Rosedale Associated Manufacturers Ltd. v. Airfix Ltd., reported in 1957 RPC 239, Lord Evershed M.R. held as follows:

> *"In this respect the test of prior publication of an 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."

45. The illustrations in the form of drawings downloaded from the website of the United Kingdom Patent Office depict the patterns that may be applied to glass sheets. The patterns may be same but the illustrations do not give the same visual effect as the samples of the glass sheets produced by the appellant in Court. There are also no clear unmistakable instructions or directions for production of glass sheets of the pattern illustrated.

46. The visual effect and/or appeal of a pattern embossed into glass sheets by use of embossing rollers could be different from the visual effect of the same pattern etched into glass sheets manually. The respondent No.1 has not considered these factors."

The aforesaid judgment was considered by a Full Bench of the Delhi High Court in ***Reckitt Benkiser India Ltd. v. Wyeth Ltd.*** reported at ***AIR 2013 Delhi 101 (FB)*** in Paragraphs 21 and 22 of the report which read:-

"21. We have reproduced a large number of paragraphs both of the judgments, of the learned Single Judge in Gopal

Glass work's case, and of the Supreme Court in the appeal from the judgment of Gopal Glass Work's case in Bharat Das Tools Ltd. because, it is only on the reading of these paras it becomes clear that the Supreme Court in no manner laid down an absolute rule that there can never be prior publication although in the public record of the Registrar of Design abroad a particular design is found to be registered. The Supreme Court in fact has specifically held that facts in each case have to be very minutely examined and Courts have to be extremely cautious by thoroughly scrutinizing the evidence in each case for deciding whether the public record available in Registrar of Design abroad could or could not be taken as prior publication, and in the peculiar facts of the case before the Supreme Court when we refer to paragraphs 45 to 47 it becomes clear that the Supreme Court approved the view of the learned Single Judge of the Calcutta High Court in Gopal Glass Work's case because even the Supreme Court found that sufficient evidence was not led on behalf of the objector to the registered design and that the documents downloaded through internet from the website of U.K. Patent Office did not add that amount of clarity for the same to be said to be prior publication for seeking cancellation on the basis of such alleged prior publication of a design registered in India.

22. What has been observed by the Supreme Court in the case of Bharat Das Tools Ltd. is reinforced by the following paragraphs of Russell-Clarke and Howe on Industrial Designs VIIIth Edition:

What counts as "published" for the purpose of calling into question the novelty of a later design registration? This is broader than the word at first suggests. It is by no means limited to the publishing of a design in a printed publication, although it includes that. 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. It is not, in fact, necessary that publication should be on paper; an oral disclosure, provided it is non-confidential, will amount to publication.

Re-registration of the same design for different articles, or a similar design for same or different articles.

A special exception existed to the general rule that the novelty of a design will be destroyed by the prior registration or publication of that design as applied to any kind of article. By S.4(1) of the RDA(A), the proprietor of a registered design was entitled to apply for registration of the same design, or a design with modifications or variations not sufficient to affect its identity, in respect of another article. His own previous registration, or the publication of his design as registered, does not then destroy the novelty of his new design registration in respect of the new article, but his term of protection is limited to the term of the original design. This, in effect, gave the proprietor of a design registration the ability to extend the scope of the registration during its lifetime to cover further articles, although in formal terms each application to protect his design on a new article will be a separate application leading to a separate design registration. It appears that his application for registration of the design on the new article must precede his actual use of the design on the new article. This is because, if he uses the design on an article which falls outside the scope of his earlier registration, then that will not 3-106 count as a publication "of the registered design", which is all that s.4(1) of the RDA(A)

shields him against as regards the novelty of his new application.

A person who makes an application to register a design and finds that it has previously been registered in respect of a different article was allowed to buy up the earlier design registration while his own application was still pending, and if he did so he could take advantage of this rule in the same way as if he had himself been the owner of the earlier registration all along.

The same rule applied to the registration (whether in respect of the same article or a different article) of a design which is not exactly the same as the earlier registered design, but has "modifications or variations not sufficient to alter the character or substantially to affect the identity thereof". However, this provision has been interpreted narrowly so that practically any significant change or difference between the earlier and later design will destroy the protective effect of this provision. For an applicant to rely on s.4(1)(b), the subject of his application must have substantial identity with his prior published design.

In Sebel Ltd's Application (No.1), it was held that substitution in the old design of a different stand did substantially alter the identity of the article (a rocking horse), and that the subsection did not apply. Since the stand had already been published in an advertisement showing it applied to another horse, it was held that design failed to qualify for novelty under s.1, the said stand being a mere trade variant. In Sebel Ltd's Application (No.2), a design was held not to fall within s.4 because the character of the design was different from the character of the applicant s earlier design. Thus it seems that the applicant s own earlier design may be sufficiently similar to destroy the

novelty of his later application for protection of his modified design, and yet too different to allow him to take advantage of the protection of RDA(A) s.4(1). This is an odd and unfortunate result if it is indeed correct.

Publication in documents In cases of publication of a design by prior use as applied to an article, normally the only questions which arise are whether it has been published at all (i.e whether the articles to which it has been applied have been disclosed to the public), and whether the design is similar enough to the design in suit to destroy the latter s novelty. But where the novelty of a design is tested against a prior published document, a number of additional questions can arise which do not arise in the case of a prior use.

First, it may not be clear whether or not the document discloses a design as applied to an article at all. A trade catalogue containing photographs or illustrations of articles to which a design has been applied may be a clear enough case.

But the publication in a document of a pattern or picture does not as such destroy the novelty of a design which consists of applying that pattern or picture to an article. For it to destroy the novelty of such a design, the paper publication must suggest explicitly or implicitly by context that the pattern or picture should be applied to an article.

Secondly, the pattern (if it is two-dimensional) or shape (if it is three-dimensional) of the design may not be clear from the document. Particularly in a case where it involves a written description rather than an explicit picture or illustration, there may be room for argument as to the precise nature of the design which the document discloses, before one can go on to ask whether or not it is similar enough to the later design to destroy novelty.

Thirdly, a paper publication may be shielded from destroying the novelty of a later design registration by the special provisions of subss.6(4)-(5) of the RDA(A). These provisions allowed the owner of copyright in an artistic work to exploit his work so long as he did not apply it industrially to an article, without his own exploitation of it counting against the novelty of his own later application for a design registration covering the artistic work as applied to an article.

Does the document disclose a design applied to an article?

In order to destroy the novelty of a design registration, an earlier design must be published "in respect of the same or any other article". Mere publication of the pattern which constitutes the design was therefore not sufficient to destroy the novelty of a design registration, which consisted of the application of that pattern to an article. In principle, the same holds true of the publication of a shape, although it is less easy to envisage cases where the publication of a shape does not implicitly convey the article to which that shape is to be applied. Thus, novelty may reside in the application of an old shape or pattern to new subject-matter. This was first laid down in the leading case of Saunders v Wiel. There, the design consisted of the handle of a spoon made to represent Westminster Abbey seen from a particular point of view. The design had actually been copied from a photograph of the Abbey.

The validity of the design was upheld, Bowen L.J. saying "It seems to me that the novelty and originality in the design, within this section, is not destroyed by its being taken from a source common to mankind...The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all

the world may resort. Otherwise, it would be impossible to take any natural or artistic object and to reduce it into a design applicable to an article of manufacture, without also having this consequence following, that you could not do it at all in the first place unless you were to alter the design so as not to represent exactly the original; otherwise there would be no novelty in it, because it would be said that the thing which was taken was not new. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew, nor an elephant unless you drew it and carved it of a kind which had never been seen. An illustration, it seems to me, that may be taken about this is what we all know as the Apostles spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking the figures of the Apostles, but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles figures so that they should be applicable to that particular subject-matter. How does a building differ from that? In no sense it seems to me.

It should be recalled that under the 1949 Act, if a pattern (or shape) has been published in respect of any article, the publication will destroy the novelty of any design which consists of the application of that pattern (or shape) to an article of any kind, however different it is from the kind of article to which the publication suggests that the design should be applied. However, the publication will not invalidate such later design registrations if it does not suggest the application of the pattern (or shape) to an article at all. Thus, a series of pictures published in a fine art catalogue would not destroy the novelty of a later design consisting of the application of one of those pictures to, say, the back of a chair, because a painting or picture

simpliciter is not an "article". But the same pictures published in a catalogue of patterns for application to wallpaper would destroy the novelty of such a later design registration, because wallpaper is an article.

What design is disclosed by a prior published document?

Assuming that a prior published document does satisfy the requirement that it discloses a design, i.e a shape or pattern, as applied or to be applied to an article, the next question may be what is the shape or pattern which it discloses? In some cases this will be clear, for instance where the publication contains explicit pictures or illustrations. However, it may be less clear and the disclosure may consist in whole or in part of written text which needs to be interpreted, or general instructions which can be put into practice in a variety of ways. In such cases the test to be applied is that borrowed from the pre-1977 patent law of anticipation, i.e that the prior art document must contain "clear and unmistakable directions" to make an article with the shape or pattern which is the same as , or similar enough to the registered design in suit to deprive it of novelty.

This was laid down in Rosedale Associated Manufacturers Ltd v Airfix Ltd. Lord Evershed M.R. said "In this respect the test of prior publication of an 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 sub-sequent 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 3-123 of 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."

On the same point Romer L.J. said:

"In Flour Oxidising Co v Carr & Co Parker J. (as he then was) said: „Where the question is solely a question of prior publication it is not, in my opinion, enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result. It must also be shown that the specification contains clear and unmistakable directions so to use it. These observations by Parker J. were cited with approval by Lord Dunedin in British Thomson Houston Co v Metropolitan-Vickers Electrical Co, and again (when delivering the judgment of the Judicial Committee) in Pope Alliance Corporation v Spanish River Pulp & Paper Mills, Ltd. In the latter case and at the same page Lord Dunedin posed the test as follows: „would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that Patent, if he had had the alleged anticipation in his hand, have said "that gives me what I wish"? It is true that these citations were related to anticipation of inventions, but it seems to me that they apply by analogy to alleged anticipation by "paper publications" of registered designs."

It is not permissible to make a mosaic of a number of prior documents for the purpose of attacking novelty. If the attack on novelty is to succeed, the design must be disclosed in the single prior document. If, however, one document contains a reference to another document, the two may be read together." (emphasis supplied)

The principle that emerges from the judicial decisions as well as from the authorities on the subject is that, in the event, it is found that the impugned design has substantial identity with the prior published design, it is liable to be cancelled. In order to claim novelty, there has to be a significant change or difference in the design, although, it may have a common source. A mere trade variant without significant and substantial noticeable features would destroy novelty. A drawing or publication of a design in any form must suggest explicitly or implicitly by context that the pattern or picture should be applied to an article.

There cannot be doubt that the said drawing is required to be applied to an article which is known and the prior disclosure by publication is of the pattern, shape and/or configuration which is applied to the same article.

The Single Bench decision in **Gopal Glass** (supra) held that in relation to designs, the expression 'original' includes designs which though old in themselves are new in their application. The relevant observations of the learned Single Judge, in this regard, can be found in **Paragraphs 34 to 37** which read:-

> "*34. In order to destroy the novelty of a design registration, prior disclosure whether by publication or use of any other way, must be of the pattern, shape and/or configuration applied to the same article. The use of the embossing roller, to emboss a pattern ornament or configuration on a glass sheet, a material totally different in composition, nature, fragility,*

durability and look from leather, rexin or even plastic, in itself, involves inventive ingenuity.

35. *In the case of Gammeter v. Patents Design Controller, reported in AIR 1919 Cal 887, relied upon by Mr. Sudipto Sarkar appearing on behalf of the appellant, Division Bench held as follows:-*

> *'….was the "Novelty" band for a purpose so different from and for a use so similar to the purpose and use of the bracelet that the design may be said to be new and original? To my mind the purpose and use of the band are entirely different from the purpose and use of the bracelet. The "Novelty" band is intended to attach a watch to the wrist. The object of wearing a watch on the writ is generally different from that of wearing a bracelet – one is for a useful purpose and the other is ornamental.*
>
> *The result is that all these facts lead me to the conclusion that although in view of the bracelet produced by Messrs Cooke and Kelvey, the shape of the "Novelty" band by itself cannot be said to be new and original, the application of it to a watch to be worn on the wrist was for a purpose so different from and for a use so dissimilar to the purpose and use of the bracelet that the design in question may be said to be original."*

36. *Design is defined in the 2000 Act to mean the features of shape, configuration, pattern, ornament or composition of lien or colours applied to any article whether in two dimensional or three dimensional or both forms, by any industrial process of means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or*

principle of construction, or anything, which in substance is a mere mechanical device.

37. The embossing rollers manufactured by the German Company are only the device for producing the impugned design. It is immaterial that the embossing rollers were not developed by the appellant. Furthermore, in relation to designs, the expression "original" include designs which though old in themselves are new in their application. The brochures of the German Company do not contain any photograph or illustrations of the impugned design on glass."

In the instant case, it cannot be said that the impugned design is new in its application.

In ***Saunders v. Wiel*** reported in ***Reports of Patent, Design and Trade Mark, Vol. X, No.4, Page 29***, it was held that new or original design not previously published did not require novelty in the idea of the design but novelty in the application of the design to some article of manufacturer. It is found that the design is novel in its application, its novelty is not destroyed but it is having been taken from source common to mankind.

It has to be remembered that the respondent No.1 is an expert body and has the required expertise to decide the matter.

The said authority on examination of both the designs held that the application of prior designs in the appellant's design is not original. Moreover, the documents disclosed in this proceeding contains clear and unmistakable directions that the design features of the impugned design were taught by the prior design particularly by registered design nos. 179570 and 205871 in

respect of the female/body as well as the male part respectively and broad features in the shape and configuration of these designs are same. The Appellate Court ordinarily will not interfere with the finding of the Controller unless it is perverse or the Controller has proceeded on some wrong principle. The Controller must, prima facie, be the judge of novelty having regard to its knowledge, expertise and experience in the matter and certainly in this case I see nothing on principle what the said Controller has done. This Court is of the view that the controller was justified in the circumstances in cancelling the registered design nos.211639 class 09-07 in respect of seal for packaging.

The appeal fails. However, there shall be no order as to costs.

(SOUMEN SEN, J.)

sp/sp2.