Bharat Glass Tube Limited vs Gopal Glass Works Limited on 1 May, 2008

Equivalent citations: (2008) 37 PTC 1, AIR 2008 SUPREME COURT 2520, 2008 AIR SCW 3509, 2008 CLC 883 (SC), 2008 (10) SCC 657, 2008 (8) SCALE 4, (2008) 5 MAD LJ 939, (2008) 8 SCALE 4

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Bench: A.K.Mathur, Altamas Kabir

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           CASE NO.:
Appeal (civil)  3185 of 2008

PETITIONER:
Bharat Glass Tube Limited

RESPONDENT:
Gopal Glass Works Limited

DATE OF JUDGMENT: 01/05/2008

BENCH:
A.K.MATHUR & ALTAMAS KABIR

JUDGMENT:
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J U D G M E N T CIVIL APPEAL NO. 3185 OF 2008 [Arising out of S.L.P.(C) No.16321 of 2006] A.K. MATHUR, J.

1. Leave granted.

2. This appeal is directed against the order dated 17.8.2005 passed by the Calcutta High Court whereby learned Single Judge has set aside the order passed by the Assistant Controller of Patents & Designs, Kolkata dated 20.9.2004 whereby the Assistant Controller has cancelled the registration of the respondent herein and held that there was no material on record to show that the design had previously been applied to glass sheets. It was also held by learned Single Judge that the order impugned considered with the materials on record, including in particular the computer print-outs clearly revealed that the respondent has only compared the pattern and/or configuration considered the visual appeal thereof, but not the visual appeal of the pattern and/ or configuration on the article. In other words, the Assistant Controller has not considered the visual appeal of the finished product. 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. This aspect was not considered. Aggrieved against this order passed by learned Single Judge, the present appeal has been filed by the appellant.

3. In order to appreciate the controversy involved in the present appeal, a few facts may be dilated here. The respondent herein claimed to carry on business inter alia of manufacture and marketing of figured and wired glass sheets since 1981. The respondent claimed to be the originator of new and original industrial designs, applied by mechanical process to glass sheets. According to the respondent, the glass sheets have eye catching shape, configuration, ornamental patters, get up and colour shades and the same were registered and/or were awaiting registration as industrial designs under the Designs Act, 2000 (hereinafter to be referred to as the Act of 2000) and the Rules framed thereunder. For production of glass sheets of the design registered as Design No.190336, two rollers are required. The rollers are manufactured by M/s. Dorn Bausch Gravuren GMBH of Germany (hereinafter to be referred as the German Company). According to the respondent the rollers are not only used for manufacture of glass sheets, but for various other articles including plastic, rexin and leather. The respondent placed an order on the German Company for supply of the rollers for launching a design of figured glass with new and novel features not produced before by anyone else. On or about 29.10.2002 the respondent applied to the Controller of Patents and Designs under Section 51 of the Act of 2000 for registration of the said design in Class 25-01. The said design was duly registered on 5.11.2002 and was to remain valid for a period of 10 years from the date of its registration. The respondent claimed the exclusive copyright in India on the said design applied to glass sheets. It was claimed that no other person has any right to apply the said design to glass sheets as the respondent has exclusive right over the said design on the glass sheets. The respondent marketed the glass sheets of the said design under the name of Diamond Square and that became popular amongst the customers soon after its launch in the market. After registration of the said design the respondent issued a notice on 21.5.2003 cautioning other manufactures from infringing copyright of the respondent in respect of the said registered design. But in the meanwhile the appellant and its associate IAG Co.Ltd started imitating the said registered design, as a result thereof the respondent was constrained to file a suit being Civil Suit No.1 of 2004 against the appellant in the District Court of Mehsana. The respondent obtained a restraint order restraining IAG Co. Ltd. from infringing the copyright of the respondent against the said design. In order to counter-blast the suit, the appellant herein filed an application under Section 19 of the Act of 2000 before the Controller of Patents & Designs for cancellation of registration of Design No.190336 in the name of the respondent mainly on the ground that the design has already been previously published in India and abroad and on the ground that the design was not new or original. The appellant primarily relied on a catalogue of the German Company and letter dated 10.9.2003 of the German company addressed to M/s. IAG Co. Ltd. the holding company of the appellant stating that the said German Company had developed design No.2960-9010 in the year 1992 and the other evidence relied on by the appellant was a document downloaded from the internet from the official website of the Patent Office of the United Kingdom on 22.9.2004 which indicated that the same design had been registered in United Kingdom in the name of M/s.Vegla Vereinigte Glaswerke Gmbh sometime in 1992. As against this the respondent filed an affidavit stating that the German Company has been engaged in the manufacture of engraving rollers and no other goods and it was contended that the company was not engaged in manufacture of the goods other than engraving rollers. It was contended that the company never manufactured engraved glass sheets by using engraved rollers. The respondent also relied on the communication dated 4.3.2004 of the German company confirming that the embossing rollers covered by Design No.2950-910 had been sold to the respondent on condition that all user rights available in India under Indian laws would vest

exclusively in the respondent and that the respondent would be entitled to exclusive user rights for at least five years. The German company was aware of the registration of the Design No.190331 and it had no objection to the design being marketed by the respondent herein. An affidavit was also filed by the Liaison Executive of the respondent company that he visited Germany and upon enquiry ascertained that M/s. Vegla Vereinigte Glaswerke Gmbh had never manufactured glass sheets of the design registered as Design No.2022468 in the United Kingdom. The respondent also objected to the admissibility of the materials alleged to have been downloaded from the United Kingdom Patent Office. It was also contended that in absence of corroborative evidence, such evidence cannot be tendered and it cannot be treated as admissible evidence. It was also contended that the German Company only manufactured rollers but did not produce glass-sheets prepared out of these rollers.

4. On the basis of the pleadings , learned Assistant Controller of Patents and Designs framed following three issues for determination:

> (i) Whether the design was not new or original in view of the fact that the roller bearing the design is published before the date of registration and the registered proprietor is not owner of design.
>
> (ii) Whether the design was published outside India as well as in India prior to the date of application.
>
> (iii) Whether the registered design was in public domain due to sale/use of the design prior to the date of application of the registered proprietor.

The first two issues were decided against the respondent and the third issue was not adjudicated since the evidence by way of affidavit was not taken on record on technical reasons. Hence, the Assistant Controller of the Patents and Designs set aside the registration of the respondent. Aggrieved against this order the respondent filed a regular appeal under Section 36 of the Act of 2000 before the High Court. Learned Single Judge after considering the matter reversed the finding of the Assistant Controller and dismissed the application filed by the appellant for cancellation of registration of the respondent herein. Aggrieved against this impugned order passed by learned Single Judge of the Calcutta High Court the present appeal was filed by the appellant-complaint.

5. We have heard learned senior counsel for the parties at length and perused the record. Before we proceed to decide on the merit of the matter, it would be profitable to refer to the relevant provisions of the Act. It may be mentioned here that in 1911 the Designs Act was passed by the then British Government in India. But with the advancement of science and technology and the number of registration of the design having increased in India, the Act of 1911 was amended wholesale by the Parliament and this new Act known as Designs Act, 2000 came to be introduced in the Parliament and the same was passed as such. The statement of objects and reasons read as under:

> " STATEMENT OF OBJECTS AND REASONS Since the enactment of the Designs Act, 1911 considerable progress has been made in the field of science and technology. The legal system of the protection of industrial designs requires to be made more

> efficient in order to ensure effective protection to registered designs. It is also required to promote design activity in order to promote the design element in an article of production. The proposed Design Bill is essentially aimed to balance these interests. It is also intended to ensure that the law does not unnecessarily extent protection beyond what is necessary to create the required incentive for design activity while removing impediments to the free use of available designs."

Section 2 of the Act of 2000 deals with the definitions and the Controller has been defined in Section 2 (b) as follows:

> " (b) "Controller" means the Controller-General of Patents, Designs and Trade Marks referred to in section
>
> 3."
>
> "Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered. Section 2 (d) defines design which reads as under :
>
> " (d) "design" means only the features of shape, configuration, pattern, ornament or composition of lines of colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-

section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause) of section 2 of the Copyright Act, 1957 (14 of 1957);"

> Section 2 (g) defines original which reads as follows:
>
> " (g) " 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;"

Section 2 (i) defines 'prescribed' which means prescribed by rules made under this Act. Section 2(j) defines ' proprietor of a new or original design' which reads as under:

> " (j) "proprietor of a new or original design".-
>
> (i) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed;

(ii) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(iii) in any other case, means the author of the design; and where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person."

Section 3 deals with the Controller and other officers. Section 4 deals with the prohibition of registration of certain designs which has relevant bearing on our case. It reads as follows:

" 4. Prohibition of registration of certain designs.- A design which-

(a) is not new or original; or

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

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

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

Section 5 deals with the application for registration of designs. Section 6 deals with the registration to be in respect of particular article. Section 7 deals with publication of particulars of registered designs. Section 9 deals with the certificate of registration which reads as under :

" 9. Certificate of registration.-

(1) The Controller shall grant a certificate of registration to the proprietor of the design when registered. (2) The Controller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate."

Section 10 deals with register of designs which reads as follows:

" 10. Register of designs.-

(1)There shall be kept at the patent office a book called the register of designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matter as may be prescribed and such register may be maintained wholly

or partly on computer floppies or diskettes, subject to such safeguards as may be prescribed. (2) Where the register is maintained wholly or partly on computer floppies or diskettes under sub-section (1), any reference in this Act to any entry in the register shall be construed as the reference to the entry so maintained on computer floppies or diskettes. (3) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act. (4) The register of designs shall be prima facie evidence of any matter by this Act directed or authorized to be entered therein."

Section 11 deals with copyright on registration which reads as under :

" 11. Copyright on registration. (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration. (2) If, before the expiration of the said ten years, application for extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years."

Section 12 deals with restoration of lapsed designs which reads as under :

" 12. Restoration of lapsed designs.- (1) Where a design has ceased to have effect by reason of failure to pay the fee for the extension of copyright under sub- section (2) of section 11, the proprietor of such design or his legal representative and where the design was held by two or more persons jointly, then, with the leave of the Controller one or more of them without joining the others, may, within one year from the date on which the design ceased to have effect, make an application for the restoration of the design in the prescribed manner on payment of such fee as may be prescribed.

(2) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary."

Section 17 deals with inspection of registered designs which reads as under:

" 17. Inspection of registered designs.- (1) During the existence of copyright in a design, any person on furnishing such information as may enable the Controller to identify the design and on payment of the prescribed fee may inspect the design in the prescribed manner.

(2) Any person may, on an application to the Controller and on payment of such fee as may be prescribed, obtain a certified copy of any registered design."

Section 18 deals with information as to existence of copyright which reads as under:

> " 18. Information as to existence of copyright.- On the request of any person furnishing such information as may enable the Controller to identify the design, and on payment of the prescribed fee, the Controller shall inform such person whether the registration still exists in respect of the design, and, if so, in respect of what classes of articles, and shall state the date of registration, and the name and address of the registered proprietor.
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> Section 19 deals with cancellation of registration which reads as under:
>
> " 19. Cancellation of registration.- (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:-
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> (a) that the design has been previously registered in India; or
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> (b) that it has been published in India or in any other country prior to the date of registration; or
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> (c) that the design is not a new or original design; or
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> (d) that the design is not registerable under this Act; or
>
> (e) that it is not a design as defined under clause (d) of section 2.
>
> (2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred."

Section 22 deals with piracy of registered design. Chapter VI deals with fees, notice of trust not to be entered in registers etc. with which we are not concerned. Section 32 in Chapter VII deals with the powers and duties of the Controller which reads as follows:

> " 32. Powers of Controller in proceedings under Act.- Subject to any rules in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a civil court for the purpose of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents, issuing commissions for the examining of witnesses and awarding costs and such award shall be executable in any court having jurisdiction as if it were a decree of that court."

Section 36 deals with the appeals to the High Court. Section 37 in Chapter VIII says that evidence can be tendered by affidavit or it can be by way of viva- voice in lieu of or in addition to evidence by

affidavit and the party may be allowed to cross-examine on the contents of the affidavit. Section 44 deals with reciprocal arrangement with the United Kingdom and other convention countries or group of countries or inter-governmental organizations. The Central Government in exercise of power conferred under sub-section (3) of section 1 of the Act of 2000 framed the rules known as The Designs Rules, 2001 (hereinafter to be referred to as the Rules of 2001). It has framed necessary rules to implement the provisions of the Act. Rule 11 says how the application is to be made for registration and says the mode of submission of application for registration. Rule 29 deals with the procedure how the cancellation of the registration can be made and a detailed provision has been made for implementation of Rule 29 of the Rules of 2001. Form of application for applying for registration is also provided as Form 1. Form 8 deals with the petition for cancellation for the registration of a design. This is the whole background of the Act.

6. In fact, the sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act. It has also laid down that if design is not new or original or published previously then such design should not be registered. It further lays down that if it 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 then such design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known designs, then such designs shall not be registered. It also provides that registration can be cancelled under section 19 of the Act if proper application is filed before the competent authority i.e. the Controller that the design has been previously registered in India or published in India or in any other country prior to the date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as defined in clause (d) of section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has already been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. These prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time. The new and original design when registered is for a period of ten years. Such original design which is new and which has not been available in the country or has not been previously registered or has not been published in India or in any other country prior to the date of registration shall be protected for a period of ten years. Therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is evident from the statement of objects and reasons and from various provisions of the Act. In this background, we have to examine whether the design which was registered on the application filed by the respondent herein can be cancelled or not on the basis of the application filed by the appellant. In this connection, the law of Copyright and Industrial Designs by P.Narayanan (Fourth Edition), Para 27.01 needs to be quoted.

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

" Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but the appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will increase sales". The object of design registration is to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods.

The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable at all, ought to be made the subject-

matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. Thus the primary concern, is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of article of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article. "

7. As mentioned above, the Assistant Controller primarily has taken into consideration the two evidence,

(i) that the design was registered way back 1992 by the German company on the roller to be used either on glass, or rexin or on leather, therefore it is not new and original and (ii) that the same design has been obtained in United Kingdom as is evident from the downloading of Patent website of the United Kingdom. On the basis of this two evidence, the Assistant Controller has held that the design which was registered on the application filed by the respondent herein was not a new and original. Therefore, on the application filed by the appellant, the Assistant Controller of Patents and Designs cancelled that design of the respondent.

8. Now, we shall examine to what extent the view taken by the Assistant Controller can be sustained and whether the view taken by learned Single Judge was correct or not. Now, coming to the first issue which has been framed by the Assistant Controller, the Assistant Controller found that M/s.Dornbusch Gravuren Gmbh, a German Company published a brochure bearing distinctive number 2960-910 for the first time on 10.9.1993 and the registered proprietor took the user's right and got it registered.

The Assistant Controller found that it is not the inventive ingenuity of the respondent and found that in order to register the design it should be new or original and the Assistant Controller found that there is insufficient evidence of originality and therefore, he came to the conclusion that the design is not a new and original one registered prior to the date of registration. Therefore, the question is whether the design is new and original. Section 4 which is couched in the negative terms, says that the design which is not a new or original then such design cannot be registered. Therefore, the question is the design which has been prepared by the German Company and which has been sold to the respondent which became the proprietor of it, is a new or original or not. In this connection, the burden was on the complainant to show that the design was not original or new. We have no hesitation in recording a finding that the burden was not discharged by the complainant. It only tried to prove on the basis of the letter of the German company that they produced the rollers and sold in market but it was nowhere mentioned that these rollers have been reproduced on the glass sheets by the German company or by any other company. 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 respondent company purchased the rollers from the German company and got it registered with the registering authority that by these rollers they are going to produce the design on the glass sheets. Design has been defined in section 2(d) which means that a feature of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process. That means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal. The definition of design as defined in section 2(d) read with application for registration and rule 11 with form 1 makes it clear that the design which is registered is to be applied to any finished article which may be judged solely by eye appeal. A conjoined reading of these three provisions makes it clear that a particular shape or a particular configuration is to be registered which is sought to be produced on any article which will have visual appeal. Such design once it is registered then it cannot be pirated by any other person. But the question is whether it is new or original. In the present case, the complainant relied on the correspondence of the German company which produced the rollers and sold it to the respondent herein and it gave the proprietary right to the present respondent company. 'Proprietor' as defined in section 2 (j) of the Act means that any person who acquires the design or right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired. Therefore, this right to reproduce this design on an article has been given by the German company to the respondent. But again the question is whether the complainant had discharged their burden to show that this design is not new or original. For this purpose, they only banked upon the letter of the German company which prepared these rollers and there is no evidence to show that the design which was reproduced on glass sheets was either produced by any other agency. Therefore, the expression that ' new or original' in this context has to be construed that whether this design has ever been reproduced by any other company on the glass sheet or not. There is no evidence whatsoever produced by the complainant either before the Assistant Controller or before any other forum to show that this very design which has been reproduced on the glass sheet was manufactured anywhere in the market in

India or in United Kingdom. There is no evidence to show that these rollers which were manufactured or originally designed by the company was marketed by this company to be reproduced on glass sheets in India or even in United Kingdom. This proprietorship of this design was acquired by this respondent from the German company and there is no evidence on record to show that these rollers were used for designing them on the glass sheets in Germany or in India or in United Kingdom. What is required to be registered is a design which is sought to be reproduced on an article. This was the roller which was designed and if it is reproduced on an article it will give such visual feature to the design. No evidence was produced by the complainant before the Assistant Controller that anywhere in any part of the world or in India this design was reproduced on glass or it was registered anywhere in India or in any part of the world. The German company only manufactured the roller and this roller could have been used for bringing a particular design on the glass, rexin or leather but we are concerned here with the reproduction of the design from the roller on glass which has been registered before the registering authority. Therefore, this design which is to be reproduced on the article i.e. glass has been registered for the first time in India and the proprietary right was acquired from the German company. We have gone through the letter of the German company and it nowhere says that this was reproduced on a glass sheet. No evidence was produced by the complainant that this design was reproduced on a glass sheet in Germany or in India. The contents of the letter are very clear. It shows that it was designed in 1992 and was marketed in 1993. But there is no evidence to show that this design was reproduced on glass sheet any where in Germany. Section 4 clearly says that the Controller will only register a design on application made under Section 5 by the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality and it further says that this application shall be in a prescribed form and the prescribed form has been given in form 1. Form 1 clearly says that the design is to be applied. Relevant column of the form reads as under :

> Insert number of class You are requested to register the accompanying in Class No .. in the name of .
>
> Insert (in full) the name Address and nationality . . . . . .
>
> .... . who claim(s) to be the proprietor thereof.
>
> State whether drawings, Four exactly similar of Photographs, tracings or the design accompany this specimens. request.
>
> Insert name of article or The design is to be applied articles to which the to design is to be applied or state trade description of each of the articles contained in the set.
>
> That shows that for name of the article on which the design is sought to be transcripted has to be mentioned at the time of registration. The respondent moved an application filling this form that this roller which has been manufactured by the German company with that design shall be reproduced on the glass. Therefore, when the application was filed by the respondent for registration, it was registered on the

basis that the roller which will be used by mechanical process will bring design on a glass which is registered. Therefore, what is sought to be protected is that the design which will be reproduced on the roller by way of mechanical process and that design cannot be reproduced on glass by anybody else. Now, the question is whether it is new or original design. For that it is clear that there is no evidence to show that this design which is reproduced on the glass sheet was either registered in India or in Germany or for that matter in United Kingdom. The expression,' design' has come up for interpretation in English courts. The expression, design is almost pari materia with the definition of design in the Indian context. The expression, 'design' in the English Act which is known as the Registered Designs Act, 1949 reads as under

:

" In this Act the expression,' design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged solely by the eye, but does not include

(a) a method or principle of construction or

(b) features of shape or configuration which

(i) are dictated solely by the function which the article has to perform, or

(ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part."

The history of this definition has been detailed by Russel- Clarke and Howe on Industrial Designs (Seventh Edition) at para 3.11 at page 74 which reads as under :

" 3-11. This definition contains a cumulative series of requirements, many of which have been the subject of judicial decision and analysis. The historical process by which this definition has evolved is of importance to its present day interpretation and application. Some of the more important embellishments to the definition, such as those dealing with eye appeal and methods or principles of construction, have found their way into the pre-2001 statutory definition as a result of the explicit adoption such requirements were held to be implicit in the earlier and less elaborate statutory definitions of "design". This manifests an intention by the legislature to adopt and make explicit the principles developed in those cases.

Xx xx xx 3.13. The words of the section are:" design means features of shape configuration, pattern or ornament applied to an article . ."(emphasis supplied). Thus a registrable design, as defined by the RDA (A), must have reference to some specific article to which it is to be applied. The design to be registered " is a shape, configuration or pattern to be applied a particular specified article". It can be readily

> seen that a particular pattern of surface ornamentation could be applied to wide range of different articles. An application for registration was not in respect of the pattern as such, but in respect of its application to the specific article named. If it was desired to register the same design, e.g. a surface pattern or decoration, in respect of a series of different articles (apart from the special case of articles which together form a set), then a separate application had to be made in respect of each article, and each application to register was numbered separately and treated as a separate and distinct application.

In the case of designs consisting of features of shape or configuration, there may of course be cases where the design is intrinsically applicable only to a specific kind of article. The article itself does not, however, constitute the design. In Dover v. Nurnberger Celluloid Waren Fabrik Gebruder Wolff, Buckley L.J. said:

> "Design means, therefore, a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied to an article by some manual, mechanical or chemical means. It is a conception, suggestion, or idea, and not an article, which is the thing capable of being registered . It is a suggestion of form or ornament to be applied to a physical body."

[Pugh v. Riely Cycle Co Ltd. (1912) 29 R.P.C. 196] Accordingly, it is submitted that a design is an idea or conception as to features of shape, configuration, pattern or ornament applied to an article.

Although that idea, while still in the author's head, may be potentially capable of registration, in fact it must be reduced to visible form to be identifiable, and until it is so reduced there is nothing capable of registration, It may be so rendered either by its being embodied in the actual article, or by its being placed upon a piece of paper in such a way that the shape or other features of the article to be made are clear to the eye. Whenever the means of identification (under some of the old Acts, provision was made whereby a mere verbal description could in some cases be accepted as sufficient), as soon as the idea is reduced to a form which is identifiable, there is something which is a "design", and which, if new or original, may be registrable."

Similarly our attention was also invited to para 27.07 of the law of Copyright and Industrial Designs by P.Narayanan (Fourth Edition) which reads as under :

> " 27.07. Design as a conception or idea "Design means a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied to an article by some manual, mechanical or chemical means mentioned in the definition clause. It is a suggestion of form or ornament to be applied to a physical body". It is a conception, suggestion or idea, and not an article, which is the thing capable of being registered. It may according to the definition clause, be applicable to any article whether for the pattern or for the shape or configuration or for the ornament thereof (that is to say of the article) or for any two or more of such purposes. The design, therefore, is not the article, but is the conception, suggestion,

> or idea of a shape, picture, device or arrangement which is to be applied to the article, by some one of the means to be applied to a physical body."

A design capable of registration cannot consist of a mere conception of the features mentioned in the definition, or in the case of an article in three dimensions, of a representation of such features in two dimensions It must, in such a case, in order to comply with the definition, consist of the features as they appear in the article to which they have been applied by some industrial process or means. An applicant for registration of a design has to produce a pictorial illustration of the idea or suggestion which he has to establish as new or original;"

> Therefore, the concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. Therefore, whenever registration is required then those configuration has to be chosen for registration to be reproduced in any article. The idea is that the design has to be registered which is sought to be reproduced on any article. Therefore, both the things are required to go together, i.e. the design and the design which is to be applied to an article. In the present case, the design has been reproduced in the article like glass which is registered. This could have been registered with rexin or leather. Therefore, for registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied. As in the present case the design sought to be reproduced on a glass-sheet has been registered and there is no evidence to show that this design was registered earlier to be reproduced on glass in India or any other part of the country or in Germany or even for that matter in United Kingdom, therefore, it is for the first time registered in India which is new and original design which is to be reproduced on glass sheet. Therefore, the submission of learned senior counsel for the appellant, Mr.Gupta cannot be accepted that this design was not new and original.
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> 9. In this connection, our attention was invited to the decisions of the Delhi High Court in 1981 PTC 239 [M/s. Domestic Appliances and Others v. M/s. Globe Super Parts] and 1983 PTC 373[The Wimco Ltd. Bombay v. M/s. Meena Match Industries, Sivakasi & Ors.]. In M/s. Domestic Appliances & Ors., M/s. Globe Super Parts, Faridabad manufactured gas tandoors and they got the design registered in respect of gas tandoor. The petitioners- M/s. Domestic Appliances & Ors. also manufacture gas tandoors under the trade mark 'Sizzler'. They were selling the same in Delhi market. The respondent filed a suit against the petitioners alleging inter alia infringement of the design and obtained temporary injunction restraining the petitioners from selling the seasonal goods. The petitioners filed an application under Section 51A of the Designs Act, 1911 for cancellation of the design No.145258 before the Controller of Designs, Calcutta. The cancellation was sought on the allegations that the design No.145258 was pre-published in India on the date of registration in as much as the respondents themselves were manufacturing and selling the gas tandoors earlier to the date of application for registration of design No.145258 and sold the same to

various parties in Delhi, Punjab, Haryana, Jammu & Kashmir & Uttar Pradesh and also advertised the said supercook gas tandoor in several newspapers. It was also alleged that the respondents were not the originators or the owners of the design. Therefore, it should be cancelled. This was resisted by the respondents. Similarly in this case here also it was alleged that this application has been filed as a counterblast to the suit filed by the respondent and it was also pleaded that the petitioners were not interested in cancellation of the design. In the suit certain issues were framed and the High Court held that there was no definite evidence produced by the parties that the design had been previously registered in India. It was also held that the respondents were manufacturing the gas tandoors of the impugned design prior to 1977 and ultimately the Court held that the gas tandoors of the impugned design had been sold prior to the date of its publication. In other words the design had been published for the first time in India in 1977. Therefore, this case was decided purely on the question of fact and no ratio has been laid down. Similarly in 1983 PTC 373, this was a case by the Wimco Limited, a public limited company which carried on business of manufacturing and selling match boxes. It was claiming that they were one of the famous manufacturers of matches and they developed a design and gave it a name as 'HOTSPOT' and made an application for registration under the provisions of the Designs Act,1911 and the same was registered. Thereafter a suit was instituted against M/s. Meena Match Industries, M/s. Thilgaraj Match Works and Ms. Sanjay & Co to restrain the defendants from manufacturing, producing, selling and/or marketing or offering for same match boxes bearing the impugned pattern/ design on the match boxes. After review of the evidence on record the Court held that the design given to M/s. Wimco was liable to be cancelled on the ground that it has been published in India prior to the date of registration and the design was not a new or original one. Therefore, this was also decided basically on the question of fact. Similarly in the present case, as we have discussed above, that this design which was registered in the name of M/s. Gopal Glass Works was not published in India or in Germany. Therefore, it was a new and original design.

10. The question of eye appeal came up for consideration in Interlego A.G. v. Tyco Industries Inc. ([1988] 16 R.P.C. 343). In that their Lordships have laid down important test in the matter of visual appeal of the eye. It was observed as follows:

" 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. That factor was one which was conspicuously absent from the articles upon which the courts were required to adjudicate in the cases of Tecalemit Ltd. v. Ewarts Ltd.(1927) 44 R.P.C. 503, Stenor and Amp and in the more recent Irish case of Allibert S.A. v. O'Connor [1981] F.S.R. 613, in all of which the claim to registration failed. It was one which was present in the case of Kestos where the claim to the validity of the design succeeded. It is present in the instant case. One starts with the expectation of eye-appeal, for part of the very purpose of the article is to

> have eye-appeal. That was aptly expressed by Whitford J. in relation to the same subject-matter as in this appeal in the case of Interlego A.G. v. Alex Folley (Vic) Pty.Ltd. [1987]F.S.R. 283 at page 298:-
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> " I would have expected a designer designing toys to have the question of the appeal of the toy to the eye, even in the case of a functional toy, in mind. Mr.Rylands who have evidence for the defendants said that when designing a functional toy it is necessary to have regard not only to suitability for purpose but to overall appearance. 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.""

One has to be very cautious unless two articles are simultaneously produced the Court then alone the Court will be able to appreciate. But in the present case no design reproduced on the glass-sheets was either produced before the Assistant Controller or before the High Court or before us by the appellant to appreciate the eye appeal. The appellant could have produced the design reproduced on glass-sheet it manufactured in United Kingdom or Germany. That could have been decisive.

11. Our attention was invited to Dover Ltd. v. Nurnberger Celluloidaren Fabrik Gebruder Wolff ([1910] 27 R.P.C. 498). This was a case in which the question was of the pattern or ornament of hand grip for cycle handles brought an action for infringement against a German firm of manufacturers, and against their London agents. The defendants admitted that they were selling cycle handles with the design resembling the plaintiffs' registered design but pleaded that the plaintiffs' registered design was not a new or original design not previously published in the United Kingdom and alleged that it was commonly known for many years prior to the date of the registration. Though the Single Judge held that the design was new and original having regard to the kind of article for which it was registered and that it had been applied by the defendants to the cycle handles sold by them but the Court of Appeal held that the design was not new or original within the definition of the Patents and Designs Act, 1907, and that the defendants had not infringed. Therefore, this case was decided on the question of fact and evidence lead by the parties. In this case, Buckley,J. observed as follows:

> " In my opinion, there is in this no originality. If, however, the Respondents' Counsel are right in saying that the Design is the whole thing as shown in the picture, then, it seems to me, that the Defendants have not infringed. Their handle is not divided into six panels but into nine panels. Their grooves are so much more shallow than the Plaintiffs' grooves as to be easily distinguishable from them. Fraudulent imitation there was certainly none; neither was there obvious imitation either.
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> In my judgment, this Act was intended to protect Designs which really have some merit by way of novelty or originality and not to give colour to such paltry and trivial claims as have been set up in this case. The appeal must, I think, succeed and the action be dismissed with costs."

Kennedy L.J. also took the similar view and observed as follows:

> " In the present case, as I have already said, if I rightly appreciate the evidence, a paneled hand grip with grooved divisions was not new, nor was the engine-turning of surfaces as an ornamentation of those surfaces new, for it had been applied to what I may, I think, fairly call the kindred surfaces of knife handles and penholders, where the hand grips them. I cannot find either novelty or originality in the Plaintiffs' Design by reason of such a combination."

Therefore, both the case was distinguishable on question of facts only.

12. Our attention was also invited to King Features Syndicate Incorporated and Frank Cecil Betts, the Personal Representative of Elzie Chrisler Segar, Deceased. V. O. & M. Kleeman Ld. ([1941] 58 R.P.C. 207). In this case also, action was brought for alleged infringement of certain copyright in certain drawings. It was contended by the defendants that they had not manufactured or imported and sold as alleged by the plaintiffs and there was no infringement. Leave was granted. The Court of Appeal allowed the appeal. The plaintiffs appealed to the House of Lords and the appeal was allowed. There also much turned on the question of evidence.

13. Our attention was invited to Gammeter v. Controller of Patents & Designs and others A.I.R.1919 Cal.887. Their Lordships discussed the concept of new and original. In that context, it was observed as follows:

> " 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. Where the design of a metal band called the "Novelty band,"

intended to attach a watch to the wrist, was similar in shape and configuration to a bracelet previously manufactured for ornamental purpose."

Their Lordships further held as follows:

> " Though the shape of the "Novelty" band by itself could not 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 similar to the purpose and use of the bracelet that the design in question might be said to be original. worn on the wrist was for a purpose so different from and for a use so similar to the purpose and use of the bracelet that the design in question might be said to be original."

Therefore, this case also depended on the appreciation of the material placed before the Court.

14. The next evidence which was lead by the appellant was a website had been downloaded from the United Kingdom Patent Office effecting patent that may be applied to glass sheets. No evidence has been produced to show that M/s.Vegla Vereinigte Glaswerke Gmbh had manufactured this design in glass sheet or not. It is only a design downloaded from the website of the Patent office in U.K. and it

is not known whether it was reproduced on glass-sheet in U.K. or not. In this connection, the Assistant Controller has only observed that he has made a visual comparison of the U.K. registered design No.2022468 with the impugned design No.190336 and he was satisfied that both the designs make same appeal to the eye and there was sufficient resemblance between the two designs. Therefore, the Assistant Controller held that the impugned design was prior published and it could not be said to be new or original. The Assistant Controller further observed that the proprietor of this design had not been able to make a difference between the U.K. design and the present design. This was not accepted by learned Single Judge of the Calcutta High Court and for the good reason. It was observed by learned Single Judge as under :

> " 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 clean unmistakable instructions or directions for production of glass sheets of the pattern illustrated.
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> 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.
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> The order impugned considered with the materials on record, including in particular the computer print outs clearly reveals that the respondent no.1 has only compared the pattern and/or configuration considered the visual appeal thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, the Respondent No.1 has not considered the visual appeal of the finished product. There are no materials on record to show that the design had previously been applied to glass sheets. On the other hand, an affidavit was sworn on behalf of the appellant by a Liaison Executive affirming that he had ascertained that the proprietor of the design registered in the United Kingdom had never manufactured glass sheets of the design registered."

From this it appears that in fact the pattern of the design which is reproduced on the glass-sheet and the design and the pattern which was reproduced on the glass-sheet of the United Kingdom was not common. The affidavit sworn on behalf of the respondent herein, the liaison Executive that he had ascertained from the proprietor of the design registered in United Kingdom and they have never manufactured glass-sheet of the design registered. This affidavit evidence of the Liaison Executive of the respondent company has remained un-rebutted. Secondly, the learned Assistant Controller has not properly compared the two designs that on what comparison he found that the same configuration or pattern are identical with that of the impugned design. Simply by saying visually one can liable to commit the mistake but if the comparison is to be judged whether the pattern of the United Kingdom and that of the present pattern is three dimension or not. Both the designs were placed before us as was done before the High Court also. Learned Single Judge recorded its finding after seeing both the designs that there is distinguishable difference between the two. Similar

attempt was made before us to show that both the designs i.e. one that is published in United Kingdom and the impugned design are identical. We have seen the original glass pattern produced before us and the photograph of the pattern produced on record. If the complainant was serious about the same, it could have produced the pattern which was reproduced on the glass-sheet in the United Kingdom and the pattern which is reproduced on the glass-sheet by the rollers of the design produced before us. If these two glass-sheets were placed before learned Single Judge or before us we would have been able to record the finding. The finding recorded by the Assistant Controller is most inconclusive and it does not give us any assurance that it was a proper comparison of the two patters by the Assistant Controller. Learned Single Judge of the Calcutta High Court had occasion to go through both the patterns and found that there is no comparison. Likewise, the glass-sheets were placed before us with all dimensions along with a copy of the print out of the United Kingdom and we are of opinion that there is no comparison between the two. From the visual appeal placed before us, learned Single Judge has rightly concluded that there is no comparison of pattern or configuration of two designs. We fully agree with the view taken by learned Single Judge. Hence on this count also the view taken by the Assistant Controller does not appear to be correct and the view taken by learned Single Judge of the Calcutta High Court is correct.

15. As a result of our above discussion, we do not find any merit in this appeal and the same is dismissed with costs of Rs.50,000/-(Rupees fifty thousand only).