Brighto Auto Industries vs Raj Chawla on 24 December, 1976

Equivalent citations: ILR1978DELHI120, 1977RLR158

JUDGMENT

M.S. Joshi, J .Messrs (1) , B.Chawla & Sons a firm owned by Raj Chawla, is manufacturing rear view mirrors. Their design of this mirror was registered at No. 139585 in class I under the Designs Act, 1911 on 28-2-1972. The present petition has been preferred by Messrs Brighto Auto Industries, a partnership firm, engaged in manufacture of various articles, including rear view mirrors, for the cancellation of the aforesaid design. It has been urged that Messrs B. Chawla & Sons' design was not a new design, that it had no originality about it, that such designs were common in the market and that the respondents made a false claim as to their being originators of the said design before the Controller of Patents and Designs to obtain the impugned registration. According to the petitioners they are hindered in their trade by the registration of the aforesaid design and being aggrieved they are interested to apply for its removal from the register.

(2) The respondents have controverter the petitioners' pleas and urged that the design in question was invented by them after a good deal of hard labour.

(3) The parties have got the petition tried on the one following issue: "WHETHERthe design referred to in the petition is liable to be cancelled for the reasons stated by the petitioner?"

(4) Akil Ahmed, a partner of Messrs Brighto Auto Industries, has sworn an affidavit to the effect that he and his family have been in the trade of manufacture of mirrors for the last about twelve years, that he has been seeing auto mirrors rectangular, circular and round in shape since his childhood, that the respondents' mirror is a common type rectangular mirror with a slight curve on the upper side and mirrors with curves on the upper side were available in the market before the registration obtained by the respondents, that there is no novelty or newness in the respondents' design, that the respondents have filed a suit against the petitioners who are in the same trade and the respondents' competitors and, therefore, the petitioners are aggrieved and interested in getting the design in dispute cancelled- One Jagjit Singh has testified to support the petitioners' case that auto mirrors of the design of which Messrs B. Chawla & Sons have secured registration have no novelty or newness and he has been seeing such like mirrors in the market for the last many years. Rajinder Singh has stated on oath that Raj Chawla's registered design is of a mirror rectangular in shape, that he has been seeing such like mirrors since his school days, that he had a mirror of this type fixed on his cycle during those days and that no originality or newness can be claimed in respect of that design. Another affidavit filed by the petitioners is that of Sultan Singh who himself has been manufacturing mirrors for the last fifteen years under the trading style of Sultan Singh & Sons. According to, him the respondents' design is neither new nor original as rectangular mirrors have been in use ever since he has been in this trade. It has been alleged by

him further that a little curve on the upper side of a mirror rectangular in shape would not make its design new or original and that all manufacturers are having a mirror variation here and there in the mirrors produced and sold by them.

(5) Raj Chawla has asserted, on the other hand, that his firm had invented a mirror of a special design and got that design registered, that the relevant design was 'full of novelty' at the time of its registration and no mirrors of that design were available in the market before 28-2-1972- He has referred to the institution of a suit for permanent injunction to restrain the petitioners from manufacturing and selling auto mirrors like the one in question and an interim injunction issued against them. R. K. Bajaj and Ramesh Chander have lent corroboration to Raj Chawla's testimony with statements to the effect that mirrors of the design registered at No. 139585 were not being marketed before 28-2-1972.

(6) A 'design' is defined in section 2(5) of the Designs Act, 1911 in the folowing terms : "(5)'design' means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or Chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; 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-sec. (1) of S. 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in section 479 of the Indian Penal Code."

(7) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in India, register the design under Part Ii of the Act (Section On such registration a certificate of registration is issued to the proprietor of the design under section 45. When a design is registered the registered proprietor of the design shall, subject to the provisions of the said Act, have copyright in the design during five years from the date of the registration (Section 47). 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 High Court on any of the following grounds, namely : (i) that the design has been previously registered in India; or (ii) that it has been published in India prior to the date of registration; or (iii) that the design is not a new or original design (Section 51A).

(8) As already stated the Controller may register a design only if it is new or original not previously published in India. Vide rule 36 of the Designs Rules, 1933, the applicant may, and shall, if required by the Controller in any case so to do, endorse on the application and each of the representations a brief statement of the novelty he claims for his design. As per para 90 of the Instructions for the Guidance of Inventors and Applicants for the Grant of Patents and for the Registration of Designs in India (Patent Office Hand Book 13th Edition, page 229) a brief statement of the novelty claimed for the design should preferably be endorsed on the representations. For purposes of illustration the following have been stated to be suitable forms of the statement of novelty : "THEnovelty resides in the shape of the ash-tray, as illustrated. The novelty resides, in the shape or configuration of the

bookshelf as illustrated. The novelty resides in the groove (A) and the projection (B) as illustrated. The novelty resides in the ornamental surface pattern of the foot-ball as illustrated.Novelty is claimed for the floral ornamentation of the tea-pot as illustrated."

(9) In the present case the respondent did not enlighten the Controller as to on what grounds the design sought to be registered was claimed to be noval and the Controller too did not care to elicit this information. It has been proved on the record that in the early part of 1975 Akil Mohd. and Tajinder Kaur applied for the registration of a rear view mirror's design wholly identical; with the respondents' design and their request was granted by the Controller without the slightest reservation. Such casual handling of the petitioners' application would suggest that the respondents' prayer for the registration of their design too might have received similar cavalier attention.

(10) The one question that falls for our consideration is whether the respondents' design when registered in 1972 was new or original, now 'new' is taken generally to mean as different from what has gone before and 'original' as something originating from the author. Drawing a distinction between 'new' and 'original' Buckley L. J. said in Dover Ld. v. Nurnberger Celluloidwaran Fabrik Gebnider Wolff (27 R.P.C. 498) (1) that 'new' referred to a case where'the shape or pattern was wholly new in itself and on the other hand 'original' to the case where it was old but new in its application to the particular subject matter. The word 'original', according to the learned Judge "contemplates that the person has originated something, that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it shall be applied".

(11) It goes without saying that in the matter of novelty the eye has to be the ultimate arbiter and the determination has to rest on the general ocular impression. To secure recognition for its newness or originality it is imperative that a design identical with or even materially similar to the relevant design should not have been published or registered previously. A slight trivial or infinitesinal variation, from a pre-existing design will not qualify it for registration. Taking into account the nature of the article involved the change introduced should be substantial. It is not necessary to justify registration that the whole of the design should be new, the newness may be confined to only a' part of it but that part must be a significant one and it should be potent enough to impart to the whole design a distinct identity, unless registration is sought for the said part alone.

(12) It was laid down by lord Moulton in Phillips v. Harbro Rubber Company (37 R.P.C. 233) (2) that it is the duty of the Court to take special cast that no design shall be counted new or original unless it is distinct from what previously existed by something essentially new or original which is different from ordinary trade variants which may have long been common matters of taste or choice in the trade. It is well established that a registration cannot be deemed effective unless the design or configuration sought to be protected is new or original and not of a pre-existing common type. (Ram Sahai v. Angnoo, Air 1922 All. 496(3). Qadar Bakhsh v."Ghulam Mohammad, Air 1934 Lahore 709) (4) and The Pilot Pen Co. (India) Private Ltd., Madras v. The Gujarat Industries Private Ltd., Bombay, , Vide In the matter of Wingate's Registered Design No. 768, 611 (52 R.P.C. 126) (6) 'what a substantial difference is, is a question upon which no general principle can be laid down at all; it

must depend on the particular facts in each case. In one case a quite small variation in the details of a design may be enough to make the design something quite different from an existing design. On the other hand, there* are cases even where quite large alterations in detail leave two designs for all practical purposes the same. The Court has to consider and look at the design in question with an instructed eye and say whether there is or is not such a substantial difference between that which had been published previously and the registered design as to entitle the proprietor of the registered design to say that at the date of registration that was a new or original design and therefore properly registered.' For more instances of cases where inconsequential variations were ignored we may refer to Gramophone Company Ltd. v. Magazine Holder Company (28 R.P.C. 221) (7), Simmons v. Mathieson & Co. Ltd. (28 R.P.C. 486) (8), Alien, West & Co. Ltd. v. British Westinghouse Electric and Manufacturing Company Ltd. (33 R.P.C. 157)(9), Infields Ltd. v. Rosen and others (56 R.P.C. 163) (10), In the matter of an Application for the Registration of a Design by Monotype Corporation, Ltd. (No. 819943) (56 R.P.C. 243) (II) and M/s. Western Engineering Company v. M/s. America Lock Company .

(13) The counsel for the respondent has relied upon Kent and Thanet casinos Ltd. v. Bailey's School of Dancing Ltd. (1965 R.P.C. 482) (13) but that case proceeded on so very different grounds. There the plaintiff company had introduced a number of modifications in the design of a rotor table got registered by it. They had substituted 36 pockets for the original 37; excluded certain numbers, six in all, 5 and 24, 7 and 28 and 17 and 34; these particular numbers were selected because they provided three double width gaps as symmetrically located as possible, leaving sectors of 9, 10 and 11 numbers between them; they had retained alternate red and black colouration for the numbered spaces and applied a green colouration to the three double width spaces. In the circumstances Lloyd-Jacob, J., found 'if one looks at the design representations which accompanied this application, a pattern for the rotor rim is plainly observable, making, as it does, a definite appeal to the eye and which, judged on observation alone, is different from the only previously known rim pattern, that is, that of the roulette wheel, and different in recognisable respects, respects which are neither immaterial nor are they known trade variants. As a result, it seems to me, the design must be held to be valid if the statement of novelty is correctly construed in the narrow sense which I have indicated'. The case reported in Weggetti and Zambra v. W. F. Stanley & Co., Ltd. (42 R.P.C. 358) (14) was con,cemed with the design of a thermometer. The Court deciding the action noticed the plaintiffs had produced a useful article of commerce for a particular purpose, which, from its smallness and neatness, was reardily distinguisliable from the larger thermometers which had gone before; but that was found to be wholly immaterial. "The fact that the Plaintiffs have hit upon a useful shaped and useful sized thermometer for the particular purpose in hand", it was found "is no reason in law why the Defendants should not even copy such features of that Design as were common in the trade, nor is it any reason why they should not add to such Design any ordinary trade improvement or trade variant which is obvious as soon as the particular use to which the article is intended to be put is appreciated."

(14) In the case before me the respondents' counsel has conceded that there were mirrors available in the market rectangular in shape with rounded edges, width sides curved or sloping and the lower length side also sloping as is the case with their own design and the only change incorporated by them is a further curve in the sloping upper length side. The rear view mirrors previously selling in

the market did not carry this type of curvity in their upper side, it cannot be denied, but this innovation would appear by itself on a fair assessment to be too petty to earn for them the credit due to a new original design. The addition of the said small feature could not possibly have involved any appreciable intellectual endeavor and it shall have to be termed as a routine type of trade variation. I am constrained to find that the respondents' design being neither new nor original it does not deserve protection to the detriment of the trade in general and by granting the petition I order cancellation of the registration of the said design under Section 51A of the Designs Act, 1911. The parties are left, however, to bear their own costs.